

O-018-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION Nos. 2355692 & 2355693  
BY CROWN ORIENTAL FOODS LIMITED  
TO REGISTER THE TRADE MARKS**

**SITAR &**



**IN CLASSES 29, 30 & 32**

**AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS  
THERE TO UNDER Nos. 93166 & 93168  
BY HUNTER FOODS LIMITED FZCO**

## **BACKGROUND**

1) On 12 February 2004, Crown Oriental Foods Ltd of 7 St. Andrews Road, Golders Green, London, NW11 0PH applied under the Trade Marks Act 1994 for registration of the trade marks

**SITAR**

&



2) Both marks were applied for in respect of the following goods:

In Class 29: Meat, fish, poultry and game; products made from meat, fish, poultry and game; seafood and seafood products; preserved, dried, cooked, canned and frozen fruits and vegetables; snacks and snack foods; prepared meals; ready meals; fruit crisps and chips; vegetable crisps and chips; pulses; dhals; bombay mix; prepared nuts and mixtures of prepared nuts and dried fruits; nut products; pickles; sauces.

In Class 30: Preparations made from flour, cereals, grains and rice; flour; dried or cooked pasta; rice; noodles; processed cereals; processed grains; bread, poppadoms, naan bread; snacks and snack foods; prepared meals; ready meals; tea, cocoa, coffee; beverages; syrups; biscuits, cakes; confectionery; chutneys, sauces, salt for food; vinegar; flavourings other than essential oils; spices, savoury pastes; popcorn.

In Class 32: Mineral and aerated waters; fruit and vegetable drinks and juices; syrups, essences and extracts for making beverages; non-alcoholic beverages, namely drinking waters, flavoured waters, soft drinks, energy drinks and sports drinks.

3) On 4 February 2005 Hunter Foods Limited FZCO of P.O.Box 17022, Jebel Ali Free Zone, Dubai, United Arab Emirates filed notice of opposition to the application. The grounds of opposition are in summary:

The opponent is the proprietor of UK trade mark number 2174958 for the mark SHIKAR in relation to goods in Classes 29 & 30. The opponent claims that the mark in suit offends against Section 5(2)(b) of the Trade Marks Act 1994.

4) The applicant subsequently filed a counterstatement denying the opponent's claims.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 21 November 2006 when the opponent was represented by Mr Brandreth of Counsel instructed by Messrs Swindell & Pearson and the applicant was represented by Ms Clarke of Counsel instructed by Messrs Wildbore & Gibbons.

## OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 20 October 2005, by Bharat Narayan the Chairman and Managing Director of the opponent company. He states that the opponent first used the mark SHIKAR in the UK in 1998 and that they have used it since this date. The mark was first used on lentil poppadums in 1998, then in 2001 on corn poppadums. Then in October 2002 the opponent's launched "Potato Savoury Grills" also under the SHIKAR trade mark. He provides a number of exhibits as follows:

- BN1: Copies of two invoices dated October 1998 which relate to SHIKAR poppadums addressed to a company in the UK.
- BN2: Invoices dated between 1999- 2001 relating to SHIKAR poppadums addressed to a company in the UK.
- BN3: Invoices dated between 2002- February 2004 relating to SHIKAR poppadums and savoury grills addressed to a company in the UK.
- BN4: A copy of a label used in the UK in 1988/1999 showing use of the mark SHIKAR.
- BN5: A copy of a press release, dated September 1999, which shows use of the SHIKAR trade mark on poppadums.
- BN6: A copy of an article from *The Food Finder* magazine dated Winter 1999/2000. Unfortunately, the article does not mention the opponent's products.
- BN7: A copy of a sheet which is said to be part of a leaflet issued in 1999. It shows use of the mark SHIKAR on poppadums.
- BN8: A copy of a label said to have been used in 2000/2001(although it is not dated) which shows use of the mark SHIKAR on poppadums.
- BN9: A copy of a press release, dated May 2001 which shows use of the SHIKAR trade mark on poppadums.
- BN10: Copies of two current labels showing the mark SHIKAR, used on potato grills.
- BN11: A Copy of a current label showing the mark SHIKAR, used on poppadums.
- BN12: A print out showing the delivery number of cases of SHIKAR poppadums delivered in the period February 2000-May 2000 to stores such as, inter alia, *Safeway, Budgen, Sainsbury and Waitrose*.

- BN13: A copy of an order from the UK distributor ordering a number of container loads of SHIKAR poppadums from the opponent company, dated June 2000.
- BN14: A copy of a sheet showing case sales for the period January 2000-December 2000. This shows sales of 11,300 cases of poppadums. It does not state to whom the items are sold or where they are to be shipped.
- BN15: A copy of an order from the UK distributor for \$20, 850 worth of poppadums under the SHIKAR brand, dated February 2003.

## **APPLICANT’S EVIDENCE**

7) The applicant filed a witness statement, dated 28 February 2006, by Kishore Pagarani the Managing Director of the applicant company. He states that he was aware of the opponent’s mark at the time of making the application in suit as his company used to purchase from the opponent. He states that:

“The word SHIKAR in Hindi means “hunter” i.e. the name of the opponent. The word SITAR is the name of an Indian stringed musical instrument and is very well known as such in the United Kingdom, appearing in numerous directories.”

8) At exhibit KP1 Mr Pagarani provides definitions of SITAR from the Concise Oxford Dictionary, Collins Dictionary of the English Language and Collins Gem English Dictionary. All state that the word relates to an Indian stringed instrument.

9) Mr Pagarani states that the mark in suit has been in use since July 2004 and goods under the mark are sold via retail stores such as Tesco, ASDA, Morrisons and Sainsbury. He states that the products of both companies have co-existed in the marketplace and there has been no confusion.

10) That concludes my review of the evidence. I now turn to the decision.

## **DECISION**

11) The sole ground of opposition is under section 5(2)(b) which reads:

“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.”

12) An “earlier trade mark” is defined in section 6, the relevant parts of which state:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

13) The opponent is relying upon UK trade mark 2174958 which has an effective date of 14 August 1998, and is clearly an earlier trade mark.

14) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux B.V* [2000] E.T.M.R 723. It is clear from these cases that:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*;
- (b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*;
- (h) further, 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; *Marca Mode CV v Adidas AG & Adidas Benelux B.V.*;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

15) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's marks and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

16) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchin Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

“17. The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

17) The opponent has filed evidence of use of its mark in the UK. However, the evidence is scant and does not include turnover figures, the opponent's market share or any independent evidence of its reputation under this mark in the UK on the goods in question. In my opinion, the opponent's mark is inherently distinctive for the goods for which it is registered. However, I do not accept that the opponent has provided evidence to support its contention that it should benefit from an enhanced reputation.

18) The opposition was filed on 4 February 2005. I must therefore consider the position under The Trade Marks (Proof of Use, etc.) Regulations 2004. Paragraph four of which states:

“4. After section 6 there shall be inserted -

**6A Raising of relative grounds in opposition proceedings in case of non-use**

(1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be

treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects -

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).".

19) As the mark that the opponent is relying upon was registered more than five years prior to the publication dates of 5 November 2004 (2355692) and 12 November 2004 (2355693) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of the mark has been made.

20) The opponent's evidence of use is contained within exhibit PF1 which is detailed at paragraph 6 above. The applications were published on 5 November 2004 and 12 November 2004 and so the opponent must show use within the periods 5 November 1999 – 4 November 2004 and 12 November 1999 – 11 November 2004. The opponent's evidence at exhibits BN1-BN15 are the only corroborative evidence to the statement of Mr Bharat Narayan that goods were sold in the UK. Of these exhibits some are undated, others are prior to the relevant periods whilst others do not show use of the opponent's mark. The relevant invoices are at BN2&3 which show poppadums and savoury grills (potato crisps/chips) being supplied, BN9 a press release which refers to poppadums, BN12 which refers to the delivery of poppadums and BN13 which is an order for poppadums.

21) At the hearing Ms Clarke made a number of very lengthy submissions seeking to persuade me that the evidence did not show use in the UK. She carried out a forensic analysis of each of the exhibits. However, I cannot overlook the actual statement filed by the opponent which states categorically that the goods were sold in the UK. The applicant chose not to file any evidence questioning the validity of the opponent's evidence and did not seek to cross examine him on his evidence. I agree that some of the exhibits are not dated, and perhaps the opponent could have filed evidence from retailers. However, it is seldom that the Registry is provided with evidence which is perfect and it is accepted that this is the reality in which the Registry must live. In my opinion the opponent has done just enough for its claim to have sold poppadoms and potato crisps/chips in the UK during the relevant period to be accepted. For the purposes of the comparison of goods the opponent's specification will be regarded as comprising "poppadums and potato crisps/chips".

22) I shall now consider the specifications of the two parties. The specifications of the applicant's marks are identical and so they can be dealt with as a single specification. In the statement of grounds the applicant's goods in Class 32 were not opposed. At the hearing it was accepted by the opponent that as it had not shown use with regard to "ice-lollies, fruit-flavoured ices, fruit-flavoured frozen drinks" there is therefore no opposition to "beverages" in Class 30 of the applicant's specification. I also take into



account the evidence of use filed by the opponent which shows use of their mark on poppadoms and potato crisps/chips only. I have therefore amended the specifications of both parties to reflect the actual comparison which needs to be made. For ease of reference they are reproduced below:

Applicant's specification being opposed	Opponent's specifications
In Class 29: Meat, fish, poultry and game; products made from meat, fish, poultry and game; seafood and seafood products; preserved, dried, cooked, canned and frozen fruits and vegetables; snacks and snack foods; prepared meals; ready meals; fruit crisps and chips; vegetable crisps and chips; pulses; dhals; bombay mix; prepared nuts and mixtures of prepared nuts and dried fruits; nut products; pickles; sauces.	In Class 29: Poppadoms, potato crisps, potato chips.
In Class 30: Preparations made from flour, cereals, grains and rice; flour; dried or cooked pasta; rice; noodles; processed cereals; processed grains; bread, poppadums, naan bread; snacks and snack foods; prepared meals; ready meals; tea, cocoa, coffee; syrups; biscuits, cakes; confectionery; chutneys, sauces, salt for food; vinegar; flavourings other than essential oils; spices, savoury pastes; popcorn.	In Class 30: Poppadoms, potato crisps, potato chips.

23) In carrying out the comparison of the specifications of the two parties I take into account the factors referred to in the opinion of the Advocate General in *Canon*; [1999] E.T.M.R. 1. In its judgement, the ECJ stated at paragraph 23:

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

24) Ms Clark also made a number of contentions regarding the similarity of the goods in the respective specifications. However, I did not find these useful in reaching my conclusions. With regard to the applicant's Class 29 goods, I regard the following listed at A to be identical, those listed at B to be quite similar, and those at C to be at the margin of similarity to the opponent's revised specification shown above:

- a) Cooked vegetables; snacks and snack foods; fruit crisps and chips; vegetable crisps and chips; bombay mix; prepared nuts and mixtures of prepared nuts and dried fruits; nut products
- b) Preserved, dried and cooked fruits; preserved and dried vegetables;
- c) Canned and frozen vegetables; canned and frozen fruits: meat, fish, poultry and game; products made from meat, fish, poultry and game; seafood and seafood products; prepared meals; ready meals; pulses; dhals; pickles; sauces.

25) Moving onto the applicant's Class 30 goods, I regard the following listed at A to be identical, those listed at B to be similar and those at C to be at the margin of similarity:

a) Preparations made from flour and rice; poppadums; snacks and snack foods; biscuits, cakes; confectionery; popcorn.

b) naan bread

c) : Preparations made from cereals and grains; flour; dried or cooked pasta; rice; noodles; processed cereals; processed grains; bread, prepared meals; ready meals; tea, cocoa, coffee; syrups; chutneys, sauces, salt for food; vinegar; flavourings other than essential oils; spices, savoury pastes;

26) I now turn to the marks of the two parties. For ease of reference I reproduce them below.

Applicant's mark	Opponent's mark
2355692 <b>SITAR</b>	<b>SHIKAR</b>
23355693 	

27) In the comparison of marks I shall use the applicant's mark No. 2355692 as this has no stylisation and provides the opponent with its strongest case.

28) Both parties accepted that the average consumer would be a member of the general UK public. The opponent contended that the items covered by both parties specifications are low cost items and would be purchased without a great deal of attention being paid to them. Whilst I accept that such items would not command the same level of attention as a purchase such as a car I do not believe that such items are purchased without the consumer giving some consideration to the purchase. These days, consumers are far more fastidious when selecting foods as a result of the very considerable media coverage regarding health issues concentrating on precisely what is found in food items.

29) Whilst both marks begin with the letter "S" and end with the letters "AR" there are clear visual differences between the marks. Phonetically the applicant's mark consists of two syllables "SIT" and "AR" whereas the opponent's mark although two syllables consists of "SHIK" and "AR". The beginnings are quite different with the applicant's being a hissing sound compared to the "hushing" sound of the opponent's mark. Mr Brandreth, for the opponent, contended that differences in spelling of what are clearly foreign words will not have the same significance for the average UK consumer. He used as an example the poppadom which is shown as having fifteen different spellings according to the Oxford English Dictionary website. However, to my mind this is not on all fours with the instant case. In the example provided,

poppadom, all fifteen examples would be pronounced in virtually the same way. In the instant case there is, in my opinion, a significant difference both visually and phonetically in the words which would be noted by the average UK consumer.

30) Conceptually the applicant's mark is a reasonably well known word, being the name of an Indian stringed instrument which has been common in the UK since the days of the Beatles. The applicant states that the opponent's mark is the Hindi word for "hunter". Given that the average consumer of the goods of the two parties would be the average UK citizen I do not accept that the majority would be aware of the meaning of the opponent's mark and would view it as an invented word. The opponent contended that both would be seen as Indian words and so there was conceptual similarity. Whilst I accept that the average consumer might view both words as being of Indian origin this does not overcome the fact that one would be identified as relating to a stringed instrument whereas the other would have no meaning.

31) Taking account of all the above, and also the dictum of imperfect recollection, it is my opinion that the differences between the marks far outweigh the minor similarities.

32) In carrying out the global comparison I shall regard the goods of the two parties as identical as this provides the opponent with its strongest case. In my opinion there is no likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore fails.

33) As the applicant is successful they are entitled to a contribution towards their costs. I order the opponent to pay the applicant the sum of £1,500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 12th day of January 2007**

**George W Salthouse  
For the Registrar  
the Comptroller-General**