

O-019-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 82530
IN THE NAME OF RAJ FOODS LIMITED
FOR A DECLARATION OF INVALIDITY IN RESPECT OF
REGISTRATION NO 2315909 IN THE NAME OF
MASALA WORLD LIMITED**

Trade Marks Act 1994

IN THE MATTER OF application No 82530 in the name of Raj Foods Limited for a Declaration of Invalidity in respect of Registration No. 2315909 in the name of Masala World Limited

BACKGROUND

1. Registration number 2315909 is for the mark MASALA and is registered in the name of Masala World Limited in respect of the following goods:

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|----------|--|
| Class 29 | Fresh meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; herbs and pickles; preserves; croquettes, fruit, fruit salads, vegetable juices for cooking, lentils, milk-based beverages and mixes therefor, nuts, peanuts, peas, salads, vegetables, vegetable salads, yoghurt, drinking yogurt; foodstuffs comprising or made from any of the aforesaid goods. |
| Class 30 | Coffee, tea, cocoa, sugar, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread, pastry and confectionery, ices; honey, treacle, yeast, baking powder; salt, mustard; vinegar; concentrates, flavourings and mixes for making beverages; chocolate-, coffee-, and cocoa - based beverages; condiments, farinaceous foods, flakes (maize), gravies, halvah, ice cream, infusions, meal, noodles, pastries, peanut confectionery, pizzas, puddings and desserts, sandwiches, sherbets and sorbets, tarts, tea, tea-based beverages, turmeric for food; foodstuffs comprising or made from any of the aforesaid goods. |
| Class 32 | Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; non-alcoholic aperitifs, beverages and cocktails; fruit and vegetable drinks, extracts and juices, fruit nectars, lemonades, sherbets (beverages), whey (beverages). |

2. On 21 June 2006, Raj Foods Limited filed an application to invalidate the registration, the grounds being in summary:

1. Under Sections 3(1)(b)(c) and (d)

“2. The Oxford English Dictionary defines the word “masala” as;

“any of a number of spice mixtures ground into paste or powder for use in Indian cookery”.

The word is therefore wholly descriptive and non-distinctive in relation to Indian food or cookery. The words in common use in the food industry as a description of a number of Indian dishes, for example tikka masala, garam masala and tandoori masala.

A search of Google located a large number of references to “masala” including a number of definitions and examples of common uses of the word. One definition states that masala is a Hindi word meaning “something like mixture”. Other definitions also refer to the word meaning a blend or mixture of any number of spices. Indeed these spices and the term “masala” appear to be in common use in respect of both food and beverages, for example tea.

The Applicant therefore submits that the word “masala” should never have been registered as a trade mark and should be free for use by all in relation to food, in particular Indian food, and beverages.”

3. With the Statement of Grounds the applicants filed various items of printed matter to support their claims.
4. The registered proprietors filed a counterstatement in which they deny the grounds on which the application is based.
5. Both sides ask that an award of costs be made in their favour.
6. Only the applicants filed evidence in these proceedings which insofar as it is relevant I have summarised below. Neither side took up the offer of a hearing, instead electing to file written submissions in lieu of a hearing. After a careful study of the evidence and submissions, I now go on to give my decision.

Applicant’s evidence

7. This consists of two Witness Statements. The first is dated 26 January 2007 and comes from Rajendra Kumar Radia, Managing Director of Raj Foods Limited.
8. Mr Radia says that for the past 23 years his company has been trading in prepared meals primarily to the health and social services sector in the UK. He says that many of these meals are curry-based, stating that all such meals are prepared using a masala sauce. Mr Radia refers to Exhibit RKR1, which consists of two invoices from 2000 and 2001. These have a list of product descriptions for, amongst other things, curry dishes, a number of which mention MASALA.
9. Mr Radia refers to the increasing popularity of Indian food in the UK, in support providing a print from the Food Standards Agency website as Exhibit RKR2. He refers to a paragraph entitled “Dish of the Day” which states “The popularity of Indian food in the nineties led to Chicken Tikka Masala being declared Britain’s national restaurant dish in April 2001.” Mr Radia draws attention to the statement that curry was increasingly cooked in the home and accounted for a quarter of all frozen convenience meals bought.

10. Mr Radia goes on to refer to Exhibit RKR3, which consists primarily of extracts from a book entitled “The Complete Asian Cookbook” that was first published in 1976. Mr Radia draws attention to the fact that a number of the recipes mention masala in their description in terms such as “garam MASALA”, “MASALA paste” and “MASALA powder”. Exhibit RKR4 consists of an extract from another book entitled “Curry - A tale of cooks and conquerors”. This contains a recipe for Chicken tikka MASALA that includes garam MASALA in the ingredients. There is nothing by which to date this book although Mr Radia says that it was published in 2006.

11. Exhibit RKR5 consists of an extract taken from the Guardian Unlimited website on 19 April 2001. This reports a speech by Robin Cook, at that time the Foreign Secretary, in which Mr Cook said “Chicken Tikka Massala is now a true British national dish....Chicken Tikka is an Indian dish. The Massala sauce was added to satisfy the desire of British people to have their meat served in gravy.” Exhibit RKR6 consists of a print of a news story taken from the BBC website on 27 October 2006, reporting a shortage of chefs. The article gives details on the size of the market for Indian food. Exhibit RKR7 consists of a print taken from the website of The Guild of Bangladeshi Restaurateurs, also on 27 October 2006, which states that there are over 8,500 Indian restaurants in the UK selling over 2 million meals each week. Neither of these articles mentions MASALA, seeming to have been provided to put the Indian food market into context rather than show that MASALA is generic for such goods. Exhibit RKR8 consists of a print taken from the curryhouse.co.uk website on 18 December 2006, entitled “A brief history of Curry.” This is an article written in 1998 and sets out the history and development of the curry, the final paragraph stating “...the most popular curry in UK restaurants is Chicken Tikka Masala.”

12. Mr Radia refers to Exhibit RKR9, which in part consists of prints taken from the websites of Tesco, Sainsburys and ASDA in October 2006. These show use of MASALA in relation to Tikka MASALA sauces and pastes, various Tikka MASALA prepared meals, both as own brands and from a selection of named brand traders. The Exhibit also includes prints taken from websites in November 2006 giving details of recipes and products that are referred to as being MASALA, or MASALA being used in the name of a restaurant or business. Exhibit RKR10 consists of prints taken from the website of Natco-Online.com, a site for Indian cooking enthusiasts. The site advertises MASALAS, and under a heading “Masalas and Curry Mixes” refers to a range of “ready-mixed spices used as the base for sauces, as marinades or as seasoning,” It also offers MASALA ready prepared meals. Exhibit RKR11 consists of a collection of menus from various restaurants, some general cuisine, others being Indian specialists. Each offers meals described using the term MASALA or MASSALA.

13. Mr Radia goes on to refer to a decision from the OHIM Boards of Appeal concerning the mark TIKKA TIKKA, Mr Radia asserting that there is little difference between the term TIKKA and MASALA; both are commonly used in referring to Indian food.

14. The second Witness Statement is dated 13 February 2007 and comes from Babu Shah, the proprietor of Top-)p (Foods) Limited, which Mr Shah describes as importers and exporters of Indian and continental foods.

15. Mr Shah says that his company has been importing MASALA spice into the UK since 1976 for a “number of manufacturers in Indian.” which probably means Indian foods. He says that the word MASALA is a general term for “mixed spice” and is used by many companies manufacturing and selling such spices. Mr Shah states that MASALA is well known both in the trade and by the public as referring to a mixture of spices or as part of the names of various Indian dishes and is merely a descriptive word. He refers to Exhibit BS1, which consists of a letter dated 22 December 2006 that he sent to Rachael Harrison of Venner Shipley. This lists various brand names that use MASALA in their product descriptions which Mr Shah says are products “available freely from independent Grocery Stores and big supermarkets.” The letter ends stating that MASALA is a common generic word which in Mr Shah’s opinion cannot be registered.

16. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

WRITTEN SUBMISSIONS

17. I mentioned earlier that both sides had filed written submissions in lieu of attending a hearing. The applicants challenged contents of the Counterstatement, and paragraphs 4, 41(a), 4(1)(b), 4(1)(c), 4(ii), 5 and 6 of the registered proprietor’s written submissions on the basis of the decision in the *Extreme* trade mark case (BL O-161-07). I shall refer to this case in the substantive decision.

18. In an official letter of 12 December 2007 the parties were informed that having given the matter full consideration the Counterstatement will stand as filed, but that the paragraphs in the written submissions referred to above will be disregarded. The letter informing the parties contained the caveat that this decision did not preclude consideration of all or any of the points raised by the registered proprietors where case law and precedent required this.

DECISION

19. The application is made under Section 3(1) of the Act. The relevant sections read as follows:

“3.- (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.”

20. There is no claim that the mark applied for has become distinctive by virtue of the use made of it. But in any event there is no evidence of it having been used prior to the relevant date, so the proviso is not relevant in these proceedings. In the judgment issued in respect of Joined Cases C-53/01 to C-55/01 *Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003), paragraphs 37, 39 to 41 and 47, the European Court of Justice (ECJ) summarized the considerations in respect of assessing distinctiveness under Article 3(1)(b), which corresponds to Section 3(1)(b) in the following terms:

“37. It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods or services of one undertaking from those of other undertakings.

39. Next, pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning 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 products of other undertakings (see *Philips*, paragraph 35).

41. In addition, a trade mark’s distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court’s case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C- 210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).”

21. Whether the mark is represented graphically is not an issue; it clearly is. The question under Section 3(1)(b) is one of distinctiveness, which as paragraph 40 of *Linde* makes clear, requires that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings.

22. In *SAT.1 SatellitenFernsehen GmbH v. OHIM* (Case C-329/02 P) [2005] 1 C.M.L.R. 57; [2005] E.T.M.R. 20, at [23]) the ECJ stated that a mark has to fulfil its essential function “to guarantee the identity of the origin of the marked product to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.” The ECJ went on to hold:

“41 Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings.

42 Where a trade mark which does not fall foul of the ground of refusal laid down in Article 7(1)(c) of the regulation is none the less devoid of distinctive character within the meaning of Article 7(1)(b) thereof, the Office must also set out the reasons why it considers that that trade mark is devoid of distinctive character.

43 However, in this case, the Office merely stated in the contested decision that the elements "SAT" and "2" were descriptive and in current usage in the sector of media-related services, without stating in what way the term "SAT.2", taken as a whole, was not capable of distinguishing the services of the appellants from those of other undertakings.

44 The frequent use of trade marks consisting of a word and a number in the telecommunications sector indicates that that type of combination cannot be considered to be devoid, in principle, of distinctive character.”

23. In a judgment issued in respect of Case -191/01 P *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM), the *Doublemint* case, the ECJ gave the following guidance on the scope and purpose of Article 7(1)(c) of the Community Trade Mark Regulation, equivalent to Article 3(1)(c) and Section 3(1)(c):

“28. Under Article 4 of Regulation No 40/94, a Community trade mark may consist of any signs capable of being represented graphically, provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

29. Article 7(1)(c) of Regulation No 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of the goods or of rendering of the service, or other characteristics of the goods or service are not to be registered.

30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very

nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under article 7(3) of Regulation No 40/94.

31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p.1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I- (3161), paragraph 73).

32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

24. The guidance of the ECJ in Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ETMR 57, was helpfully summarised by Mr David Kitchin QC (as he then was) sitting as the Appointed Person in *Simply Click* trade mark BL O-249-05) where at paragraph 17 he said:

“First, it is in the public interest that a sign which is descriptive of a characteristic of the services in respect of which registration is sought may be freely used by all. Second, it is not necessary that the descriptive sign is actually in use at the time of the application for registration; it is sufficient that it could be used for such purposes. Third, a sign must be refused for registration if at least one of its possible meanings designates a characteristic of the services concerned. Fourth, it is irrelevant that there may be other, more usual, signs or indications for designing the same characteristic of the services. Fifth, it is irrelevant whether the characteristic of the services which may be the subject of the description is commercially essential or merely ancillary. Finally, a mark consisting of a word composed of elements, each of which is descriptive of a characteristic of the services, is itself descriptive of that characteristic unless there is a perceptible difference between the word and the sum of its parts.”

25. Although referring to services, the guidance is equally applicable to goods. From the above cases it is clear that the prohibition to registration under Section 3(1)(c) of the Act relates to signs that may not be being used as a designation of a characteristic of the relevant goods or services, but nonetheless could be apt for such use. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the goods in question.

26. In *Merz & Krell GMBH & Co* (C-157/99) [2002] E.T.M.R. 21 relating to Article 3(1)(d), equivalent to Section 3(1)(d), the ECJ stated at paragraph 41:

“It follows that Article 3(1)(d) of the Directive must be interpreted as meaning that it subjects refusal to register a trade mark to the sole condition that the signs or indications of which the trade 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. It is immaterial, when that provision is applied, whether the signs or indications in question describe the properties or characteristics of those goods or services.”

27. In the *STASH Trade Mark*, (BL 0-281-04, Professor Ms Ruth Annand sitting as the Appointed Person (at paragraph 30) stated:

“On my reading, there are two separate limbs of section 3(1)(d). A mark must be refused registration if, in relation to the goods or services applied for, it has become customary:

- (a) in the current language; or
- (b) in the bona fide and established practices of the trade.

It is clear from the proviso to section 3(1), that the general objection to marks which fall within section 3(1)(b) – (d) is that they are lacking in distinctive character (*Case C-299/99 Koninklijke Philips Electronics NV v. Remington Consumer Products Ltd* [2002] ECR I-5475, para. 58) . If the relevant public has come to view a sign in current language use as a generic name for the goods or services in question, then the objection is satisfied because the mark is prima facie lacking in distinctive character. An added requirement that the name must have become customary also in the current language of the trade is superfluous. I note that the District Court of The Hague, Civil Section D, expressed a similar view on parallel legislation in *Healing Herbs Limited v. Bach Flower Remedies Limited*, Case 02/244, 30 June 2004.”

28. Professor Annand highlighted the need to examine each ground for refusal separately, and to identify the relevant public at an early stage.

29. Accordingly, Section 3(1)(d) of the Act applies where the mark consists of a sign which has become customary in the current language or in the bona fide and established practices of the trade. The “trade” is the one that is concerned with the goods or services covered by the registration. The sign must be being used by consumers or by traders in the sense described to designate such goods or services,

but does not have to be for the purpose of designating their characteristic to fall within the prohibition.

30. The application is for foodstuffs and beverages which are about as everyday an item of goods as it is possible to get. They are products that are readily available in the supermarkets, convenience stores and delicatessens found on most high streets, and also as prepared meals served in restaurants, café's and the like. Whilst some foods will be less frequent purchases, and special types such as halal and kosher may be purchased by particular groups, such goods are an essential requirement for daily life for people from all walks of life. I do not consider that there would be any argument that in respect of food and drink the consumer base consists of the public at large.

31. The applicant's objection is that "MASALA" is a word that describes "...spice mixtures ground into paste or powder for use in Indian cookery" and is therefore "wholly descriptive and non-distinctive in relation to Indian food or cookery." They assert that MASALA is in common use in the food industry as a description of a number of Indian dishes and products, for example tikka MASALA, garam MASALA and tandoori MASALA, and should be free for use by all in relation to food, in particular Indian food, and beverages. I will first turn my attention to the objections based on Section 3(1)(c) and 3(1)(d) of the Act, for if the application succeeds on these grounds it must follow that the mark is devoid of distinctive character and as a matter of logic the application must also succeed under Section 3(1)(b).

32. With their Statement of Case the applicant's provide an extract taken from The Oxford English Dictionary, which defines the word "masala" as follows:

"any of a number of spice mixtures ground into paste or powder for use in Indian cookery".

33. From a purely intellectual perspective this definition would seem to place MASALA as being a generic description for goods that are spices or spice mixtures. This is supported by the results of a search of Google for examples of common uses of MASALA. One states this to be a Hindi word meaning "something like mixture", others say that MASALA means a blend or mixture of any number of spices.

34. The primary evidence comes from Mr Radia, for 23 years a trader in prepared meals primarily to the health and social services sector in the UK. He says that many of these meals are curry-based using a masala sauce. The invoices shown as Exhibit RKR1 include a list of product descriptions including curry dishes, a number of which mention MASALA.

35. The registered proprietor's did challenge Mr Radia's evidence in the course of the proceedings, either by filing evidence themselves or by cross-examination, but did seek to do so in their Written Submissions. In *Extreme Trade Mark* (BL O/161/07), Mr Richard Arnold QC sitting as The Appointed Person, considered whether the strict rules of evidence apply to the Registrar's tribunal. The relevant part of his decision is as follows:

“Unchallenged evidence

33. *Phipson on Evidence* (16th ed) states at paragraph 12-12:

“In general a party is required to challenge in cross-examination the evidence of any witness of the opposing party if he wishes to submit to the court that the evidence should not be accepted on that point. The rule applies in civil cases as it does in criminal. In general the CPR does not alter that position. This rule [sic] serves the important function of giving the witness the opportunity of explaining any contradiction or alleged problem with his evidence. If a party has decided not to cross-examine on a particular important point, he will be in difficulty in submitting that the evidence should be rejected.

However the rule is not an inflexible one...”

34. The authority cited in support of this statement of the law is the decision of the House of Lords in *Browne v Dunn* (1894) 6 R 67. The relevant passages from the speeches are set out in the judgment of Hunt J in *Allied Pastoral Holdings v Federal Commissioner of Taxation* (1983) 44 ALR 607, the material parts of which are quoted in the judgment of the Court of Appeal in *Markem Corp v Zipher Ltd* [205] EWCA Civ 267, [2005] RPC 31 at [59]-[60].

35. In my judgment the learned editors of *Phipson* are correct to say that the rule is not an inflexible one. There are at least two well-established exceptions to it. The first is that, as the speech of Lord Herschell LC in *Browne v Dunn* makes clear, it may not be necessary to cross-examine on a point if the witness has been given full notice of it before making his statement. As I pointed out in *BRUTT Trade Marks* [2007] RPC 19 at [23], this may be significant in registry proceedings where evidence is given sequentially. The second is that a court is not obliged to accept a witness’s evidence in the absence of cross-examination if it is obviously incredible: see *National Westminster Bank plc v Daniel* [1993] 1 WLR 1453.

36. Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness’s evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness’s evidence.”

36. To my mind Mr Radia, and indeed Mr Shah are ideally placed to be able to give evidence relating to the relevant trade. There is no reason to doubt the veracity of any of their evidence which, in any event, is adequately supported by the accompanying exhibits.

37. The print from the Food Standards Agency website (RKR2) dating from April 2001, and the Guardian Unlimited website (RKR5) on 19 April 2001, refer to Chicken Tikka MASALA as being declared Britain's "national restaurant dish" and "a true British dish." The item from the Guardian website is a report of a speech by the then Foreign Secretary, Robin Cook, in which Mr Cook is reported to have said "...The Massala sauce was added to satisfy the desire of British people to have their meat served in gravy."

38. Extracts from two cookbooks "The Complete Asian Cookbook" that was first published in 1976 and "Curry - A tale of cooks and conquerors" stated to have been published in 2006 have been filed (RKR3 and RKR4). These contain recipes that mention MASALA in their description in terms such as "garam MASALA", "MASALA paste", "MASALA powder" and "chicken tikka MASALA" the latter including garam MASALA in the listed ingredients. An article written in 1998 taken from the curryhouse.co.uk website on 18 December 2006, entitled "A brief history of Curry" sets out the history and development of the curry, the final paragraph stating the most popular dish in UK restaurants is Chicken Tikka Masala.

39. As I have said earlier, foodstuffs are an everyday item and a regular and essential purchase for the public in general. This is illustrated by Exhibit RKR9, which in part consists of prints taken from the websites of Tesco, Sainsburys and ASDA, some of the leading providers of groceries and foodstuffs in the UK. These show use of MASALA in relation to Tikka MASALA sauces and pastes, various Tikka MASALA prepared meals, both as own brands and from named brand traders.

40. Mr Radia's evidence is supported by a Witness Statement from Babu Shah, the proprietor of a company that since 1976 has been importing and exporting Indian and continental foods. Mr Shah says that the word MASALA is a general term for "mixed spice" and is well known both in the trade and by the public as referring to a mixture of spices or as part of the names of various Indian dishes; it is merely a descriptive word. Mr Shah provides a list of MASALA products that he says are freely available from independent Grocery Stores and big supermarkets. The extracts from the websites were printed after the date on which the mark in suit was applied for and bear no other information that allows them to be placed in time. The same is the case in respect of the menus and the information contained in Mr Shah's statement; these contain no means by which to date the use of MASALA referred to. Even so, on the basis of the other evidence that shows use of MASALA for many years prior to the relevant date in these proceedings, it would be reasonable to infer that they are representative of the position at that date.

41. If Mr Radia is to be believed, and I see no reason not to, there can be little doubt that the market for Indian food in the UK is very significant, with there being over 8,500 Indian restaurants selling over 2 million meals each week. Clearly, if MASALA is used as a description of a spice mixture and food products using these as an ingredient, the awareness of this will be widespread within the industry, and also amongst consumers.

42. On my assessment there is ample evidence to show that at the time of filing the application, the word MASALA was in everyday use, both within industry and in the market in relation to spices, particularly spice mixtures, in powder, and paste form, and also in relation to sauces and prepared meals that have the MASALA spice mixture as a significant ingredient. In relation to such goods the term must be considered to 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. Even if I were found to be wrong in this, there cannot be any doubt that MASALA is a word that may serve in trade, to designate the kind, intended purpose, or some other characteristics of goods that are, or use MASALA in the forms I have described, but is this the case in relation to the goods covered by the registration?

43. Turning first to the statement of goods for Class 29 and Class 30 of the subject registration. The descriptions “cooked vegetables” in the Class 29 specification, and “foodstuffs comprising or made from any of the aforesaid goods” found in both the Class 29 and Class 30 specifications are all capable of encompassing foodstuffs prepared in a MASALA sauce or style, such as “chicken tikka masala”, “vegetable tikka MASALA”. The same is the case in relation to Class 30, where the description “preparations made from cereals” would encompass products that are substitutes for meat, for example, for consumption by vegetarians, and potentially, also MASALA prepared foods. That being the case, I consider the word MASALA to be wholly descriptive of a characteristic of such goods and open to objection under Section 3(1)(c).

44. It is also the case that the term MASALA is “exclusively a sign or indication which has become customary in the current language or in the bona fide and established practices of the trade” in relation to goods of the registration that are prepared in a MASALA sauce or style. The evidence contains a number of examples where the food industry and those associated can be seen to be using MASALA to describe a spice mixture in various forms, and also in relation to prepared meals. It may well be that these meals do not have MASALA spices as a constituent, but that is immaterial (*Merz & Krell GMBH & Co*). Accordingly, the ground under Section 3(1)(d) also succeeds in respect of “cooked vegetables” in the Class 29 specification, and “foodstuffs comprising or made from any of the aforesaid goods” found in both the Class 29 and Class 30 specifications.

45. The applicants also allege that the term MASALA is a term used in connection with tea. This is borne out by the pages provided with the Statement of Case which refer to a type of tea called “MASALA CHAI”, the name being an indication of some form of spice content, albeit not necessarily the MASALA spice combination. I am conscious that this information is not evidence in the terms required by the UK Act. Nonetheless the registered proprietors did not challenge this claim. Accordingly, in relation to the “tea and tea-based beverages”, and also “infusions” (which would include MASALA tea) covered by the Class 30 specification, the word MASALA will be wholly descriptive, and open to objection under Section 3(1)(c). However, as there is no evidence of its use in the relevant trade, the ground under Section 3(1)(d) is dismissed.

46. This leaves the goods covered by Class 32 of the registration. On my assessment

there is nothing that shows MASALA may serve in the trade to designate any characteristic of the goods listed, let alone any evidence that it has become customary in the current language or in the bona fide and established practices of the trade. I see no reason why, in relation to the goods in this class the word MASALA should be considered to be devoid of any distinctive character. Therefore, in relation to the goods listed in Class 32 the grounds under Section 3(1)(b), 3(1)(c) and 3(1)(d) are dismissed.

47. In summary. In relation to “cooked vegetables” in the Class 29 specification, “preparations made from cereals” in the Class 30 specification, and “foodstuffs comprising or made from any of the aforesaid goods” in both the Class 29 and Class 30 specifications, the grounds under Section 3(1)(b), 3(1)(c) and 3(1)(d) are successful. In respect of “infusions” and “tea and tea-based beverages” covered by the Class 30, the ground under Sections 3(1)(b) and 3(1)(c) succeed, but the ground under Section 3(1)(d) is dismissed. Accordingly, these terms must be deleted from the statements of goods. For all other goods the grounds under Section 3(1)(b), 3(1)(c) and 3(1)(d) are dismissed.

48. The implementation of this decision does not require any re-wording of the specifications, merely the a deletion of specific terms that have been found to be open to objection. In accordance with the decision of Mr Richard Arnold Q.C sitting as the Appointed Person in *Sensornet* Trade Mark (Case O/136/06) and the Opinion of the Advocate General in Case C-239/05 *BVBA Management, Training en Consultancy v Benelux-Merkenbureau*, the deletion of these terms can be performed without the need for the filing of a Form TM21 on the part of the registered proprietor.

49. In their written submissions the applicants allege that if MASALA were to be used in relation to products that do not incorporate “MASALA” spice mixtures, this would mislead the consumer. That may, or may not be the case, but this is not a ground that has been pleaded and I do not propose to give it any consideration.

50. The application has been successful, but only in a small part. The registered proprietors sought to defend the entirety of the registration and have lost, but as I have said, only in relation to a small number of goods. Having been successful the opponents would ordinarily be entitled to a contribution towards their costs, but in these circumstances I deem it appropriate to make no award of costs.

Dated this 25th day of January 2008

**Mike Foley
for the Registrar
the Comptroller-General**