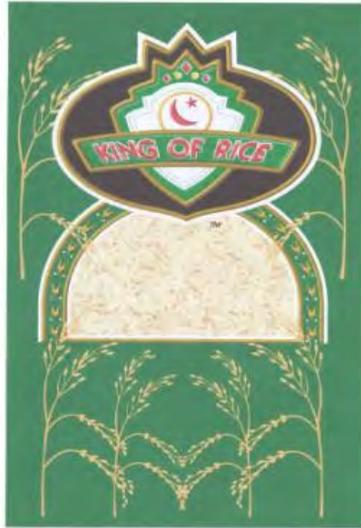


O-088-10

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2493966  
BY KHAN INTERNATIONAL TRADES TO REGISTER THE TRADE MARK**



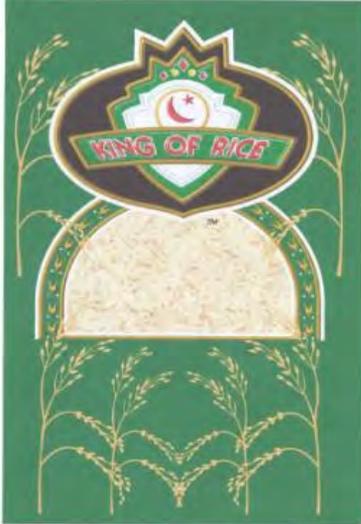
**IN CLASS 30**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 98595  
BY S & B HERBA FOODS LTD**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 2493966**

**By Khan International Trades (a partnership of Amanat Ulla Khan and Usman Ulla Khan) to register the trade mark**



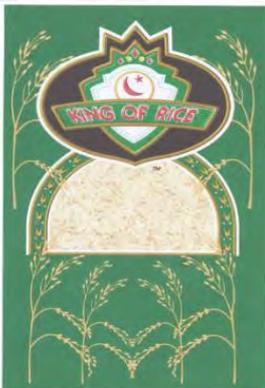
**and**

**IN THE MATTER OF Opposition thereto under No. 98595**

**by S & B Herba Foods Ltd**

**BACKGROUND**

1. On 30<sup>th</sup> July 2008 Khan International Trades ( a partnership of Amanat Ulla Khan and Usman Ulla Khan) of 36 Avondale Road, Birmingham B11 3JX (hereafter "Khan") applied to register the following trade mark:



2. The application is in respect of the following goods:

Class 30

Rice, flavoured rice, fried rice, foodstuffs made from rice; frozen prepared rice; breads, biscuits, cakes, pastry; rice; noodles; spices; prepared meals; sauces; naan breads; masala, roti; chapattis, poppadams, tacos, crisps; tortillas; cooking sauces, curry sauces

3. On 10<sup>th</sup> October 2008 the application was published for opposition purposes and on 9<sup>th</sup> January 2009, S & B Herba Foods Ltd of Berwick House, 8-10 Knoll Rise, Orpington, Kent BR6 OEL (hereafter "S & B") filed notice of opposition. The opposition is solely based on grounds under Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). I should mention that S & B are unrepresented in this action.

4. S & B rely on one earlier registration. The details of this trade mark are:

Trade Mark 2165831	Filing and registration dates	Specification
	<p>6<sup>th</sup> May 1998 and 4<sup>th</sup> December 1998</p>	<p>Class 30</p> <p>Flour and flour products; rice and rice products, foodstuffs consisting of or including rice.</p>

5. In their statement of case, S & B claim their mark has been used (and therefore upon which the opposition is based) on rice and rice products and foodstuffs consisting of or including rice. The opposition is only a partial one directed at the following goods:

Rice; flavoured rice; fried rice; foodstuffs made from rice; frozen prepared rice.

6. S & B say that these goods are identical or very similar to those upon which the opposition is based. As far as the respective marks are

concerned, they say the verbal elements, RICE KING and KING OF RICE, are conceptually identical. Moreover the marks are visually very similar as both contain a crown and banner with the brand name within.

7. Khan duly filed a counterstatement on 6<sup>th</sup> March 2009 through its attorneys. They put S & B to proof of their genuine use of the earlier mark during the relevant period and said the respective marks are visually very different and that they are conceptually different as the term RICE KING has a relatively well known meaning as a white male who dates/marries Asian women, whereas KING OF RICE means simply, “the chief or leader of rice”, “the number 1 rice....”. They also say the applicant’s mark is part of a family of “KING OF...” marks, one of which is registered, 2392728, being KING OF SPICE. In conclusion, they say the opposition should fail entirely.
8. Evidence was filed by S & B which I shall summarise below. Submissions have been filed by both parties. Submissions (in lieu of evidence) dated 31<sup>st</sup> July 2009 by Khan’s attorneys include certain print outs from the internet as regards the meaning of the words, ‘RICE KING’. I may just mention that Khan’s attorneys also filed, separately, concluding submissions dated 12<sup>th</sup> January 2010 which largely reiterate their submissions in lieu of evidence filed earlier. Neither party asked to be heard. All submissions and evidence will be taken into account in my decision. Both parties ask for an award of costs. I make this decision after careful consideration of the papers.

## **DECISION**

### **Proof of use**

9. The Trade Marks (Proof of Use, etc) Regulations 2004 apply in respect to the Section 5(2) (b) grounds of this case. The provision reads as follows:

#### **“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 of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the 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, ...

...

(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...”

10. With a registration date of 4<sup>th</sup> December 1998, it is clear that under Section 6(1) of the Act, S & B’s mark is an earlier trade mark. Further, as it completed its registration procedure more than five years before the publication of the contested mark (being 10<sup>th</sup> October 2008), it is subject to the proof of use requirement set out in section 6A of the Act. The relevant 5 year period ends on 10<sup>th</sup> October 2008 and starts on 11<sup>th</sup> October 2003. It is at this point that I shall summarise and comment upon S & B’s evidence of its own use.

### **Evidence from S & B**

11. This takes the form of a witness statement dated 23<sup>rd</sup> June 2009 from Peter J Cattaneo, Managing Director of S & B Herba Foods, based in Orpington in Kent. He says the earlier mark has been in use in the UK

since the date of registration, 4<sup>th</sup> December 1998. His precise words are:” The trade mark No 2493966 “RICE KING” has been in use in the United Kingdom since the date of its registration, that is to say 04/12/98.” He says the mark has always been used for the goods “rice” and has been used throughout the UK. Its use has been in the Ethnic Catering Sector and annual sales of goods in the last year amounted to £210,000. Exhibit PJC1 consists of a sample number of invoices showing sales of rice during the years prior to date of publication.

12. There are three sample invoices comprising PJC1. They are all addressed to a single firm, L T H Limited of Wellington House, Wellington Street, Newcastle upon Tyne NE4 5SY. The invoices are dated 22<sup>nd</sup> November 2006, 21<sup>st</sup> February 2007 and 8<sup>th</sup> February 2008. The product described on each of the invoices is the same: “20kg LG RICE “ RICE KING” HESSIANS”. The Unit on the first invoice is 1,200 bags/cases, together weighing 24,000.00 kgs, and having a value of £12,120.00. On the second invoice, it is 1,100 bags/cases (divided into three batches of 200, 150 and 750 each), having a weight of 22,000 kgs and value of £11,110.00. On the third invoice it is 1,300 bags/cases, having a weight of 26,000 kgs and value of £13, 130.00.
13. Exhibit PJC2 is a single invoice to the same firm, but dated 23<sup>rd</sup> February 2009, outside the relevant period. The same product information as above is given; the Units are 1,300 (two batches of 443 and 857 each), total weight 26,000 kgs and having a value of £21,450.00.

#### *Use of the mark as registered*

14. This evidence has been challenged by Khan in its submissions dated 31<sup>st</sup> July 2009 (filed in lieu of evidence) on the basis that it does not show evidence of use of the mark *as registered*. There is no evidence (exhibits) showing the mark, in the form registered, in actual use.
15. At this point, I should like to draw at some length on helpful comments made in a recent case, *SANT AMBROEUS*, BL O/ 371/09 which, whilst dealing with genuine use in the context of a revocation application, is relevant in the current proceedings. In this case, the appointed person says:

“64. By virtue of section 100 of the Act, the evidential burden of showing what use has been made of the Mark lies with the proprietor. In this case, G&D did not submit any evidence to counter that of the proprietor, and so the question for the hearing officer was whether the proprietor’s evidence was sufficient to discharge that burden.

65. A comprehensive exposition on the approach to proving use in revocation actions was set out by Richard Arnold QC (as he then

was, sitting as the Appointed Person) in *EXTREME Trade Mark* [2008] RPC 2, starting at [24]. In relation to witness evidence, at [31] he drew a distinction between a “bare assertion” such as, “I have made genuine use of the trade mark” on the one hand, and a statement “by a witness with knowledge of the facts setting out in narrative form when, where, in what manner and in relation to what goods or services the trade mark has been used” on the other. The former would not be sufficient evidence of the use claimed, whereas the latter could be.

66. The decision in *EXTREME* went on to discuss the extent to which evidence given in a witness statement should be accepted in the absence of a challenge by way of cross-examination or contradictory evidence from the other side, as follows:

“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 ... it is not open to the opposing party to invite the tribunal to disbelieve the witness’s evidence.

37. Despite this, it is not an uncommon experience to find parties in registry hearings making submissions about such unchallenged evidence which amount to cross-examination of the witness in his absence and an invitation to the hearing officer to disbelieve or discount his evidence. There have been a number of cases in which appeals have been allowed against the decisions of hearing officers who have accepted such submissions. .... I consider that hearing officers should guard themselves against being beguiled by such submissions (which is not, of course, to say that they should assess evidence uncritically).”

67. These observations led to the Registry publishing Tribunal Practice Notice 5/2007, which warns parties that they should not invite hearing officers to disbelieve the factual evidence of a witness without that witness having had the opportunity to respond to the challenge either by filing further written evidence or by answering the challenge that his or her evidence is untrue in cross-examination. The Notice also talks about the question of whether cross-examination is proportionate in any particular case, and then states at paragraph 5:

“5. Factual evidence which is obviously incredible can be challenged on the basis that it is untrue whether or not the witness has been cross examined or given prior notice of the challenge to the truth of his or her evidence.” “

16. In this case, the witness giving evidence is the Managing Director of S & B, Mr Cattaneo. In this role, I have no doubt he would be familiar with the facts. As I have said, he says that the trade mark 2493966 “RICE KING” has been in use since its registration but there are no exhibits to demonstrate use of the mark in the form *registered*. He goes on to say upon what goods it has been used, the sector in which the mark has been used and annual sales for the previous year. Mr Cattaneo’s exhibits plainly show use only of the words “RICE KING”. Khan’s challenge is, however, that Mr Cattaneo has not shown that he has used the mark *as registered*, or in a form “differing in elements which do not alter the distinctive character of the mark in the form in which it was registered”. This challenge was not by way of ‘late ambush’ without forewarning; it was during the evidential rounds, giving S & B ample time to reflect and to address the issue.
17. The critical question for me is whether, *in the light of Khan’s challenge*, Mr Cattaneo can be said to have discharged the evidential burden placed upon him, by virtue of section 100, to show use of the mark in the form registered. I do not believe in the circumstances I can say that Mr Cattaneo’s original narrative account, completely unsupported as it is by any actual exhibits showing the mark *as registered* in use, discharges the burden that Khan’s challenge places him under. Opportunity was there for Mr Cattaneo to respond and dispel all remaining doubt on the matter, but he has clearly stood by his original account and exhibits. Specifically, there is no evidence of, eg labels used or photographs of the bags or sacks upon which the mark as registered may have appeared.
18. That said, concerning the *words only*, “RICE KING”, I regard Mr Cattaneo’s narrative account, combined with the actual exhibits (the invoices) to which I have referred, to be plainly sufficient to discharge the evidential burden. It is not bald assertion nor obviously incredible and there is no contradictory evidence from Khan. I accept that Mr Cattaneo’s company has supplied rice in the UK under the name “RICE KING” (as proven by the exhibits).

*Use of the words “RICE KING”*

19. I have however accepted that Mr Cattaneo’s evidence does show use of the words ‘RICE KING’ in relation to the supply of rice. The question then is whether use of the words *only* amount to 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". This test has been broken down by the appointed person in the *NIRVANA* case (BL O/262/06) as follows:

“33. .... The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”

20. In formulating this test the appointed person had regard to a number of authorities, both European and derived from the Courts of the United Kingdom. Amongst them was the decision of the Court of Appeal in *Bud/Budweiser Budbrau* [2003] RPC 25. Of relevance are the statements of Lord Walker of Gestingthorpe where he stated:

“43. ...The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?”

44. The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry:

‘Bare ruin'd choirs, where late the sweet birds sang’

is effective whether or not the reader is familiar with Empson's commentary pointing out its rich associations (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45. Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of ‘whose eyes? - registrar or ordinary consumer?’ is a direct conflict. It is for the registrar, through the hearing officer's specialised experience and judgement, to analyse the ‘visual, aural

and conceptual' qualities of a mark and make a 'global appreciation' of its likely impact on the average consumer, who:

'Normally perceives a mark as a whole and does not proceed to analyse its various details.'

The quotations are from para [26] of the judgement of the Court of Justice in Case C-342/97 *Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BV* [1999] E.C.R. I- 3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance."

21. Also of relevance are the comments, in the same decision, of Sir Martin Nourse; where he stated at paragraph 12:

"Mr Bloch accepted that, in relation to a particular mark, it is possible, as Mr Salthouse put it, for the words to speak louder than the device. However, he said that it does not necessarily follow that the entire distinctive character of the mark lies in the words alone. That too is correct. But there is yet another possibility. A mark may have recognisable elements other than the words themselves which are nevertheless not significant enough to be part of its distinctive character; or to put it the other way round, the words have dominance which reduces to insignificance the other recognisable elements...."

22. To apply these cases to the present circumstances, I have already said I accept that the words 'RICE KING' have been used in relation to the supply of rice. The second question, as the appointed person says, breaks down into sub- questions. The first of these is what is the distinctive character of the registered trade mark ?

23. The registered trade mark is a composite trade mark, having a number of different elements. The central feature is a slightly stylised, but instantly recognisable, crown device with a slightly oval background. Around the outside, and featuring very prominently are six foreign characters, not unlike Chinese characters, in groups of two. There is nothing in the evidence or submissions to say what these characters mean or what their significance is. Beneath the crown device are the words, surrounded by a lozenge border, in capitals and prominently displayed, "RICE KING".

24. The words "RICE KING" are distinctive. I hesitate to say highly distinctive, since the word 'RICE' is of course descriptive. Nevertheless, the combination, to an English speaking consumer, is unquestionably distinctive. The other elements of the composite mark are also potentially distinctive – either separately, or in combination with each other or as part

- of the whole. Both the foreign characters and the crown device are not 'drowned out' by the words; they are not insignificant or mere 'decoration'. Instead, they contribute to the *overall impression* given by the mark as a totality. Given the foreign lettering in particular, that overall impression, upon the average consumer, will be one of a mark used on products aimed at an ethnic market, or having Far Eastern (possibly Chinese) origin. Such an impression would not be conveyed by the words 'RICE KING' alone.
25. The differences between the mark as registered and that actually used plainly lie in the additional elements in the registered mark which I have outlined above, the crown against the oval background and the foreign characters, which are all missing from the words only as used.
26. I have said in para 24 above that the additional elements contribute, and in what way, to the overall impression of the mark as registered. On that basis, I must then conclude that use of the words alone does not comprise "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."
27. I am reinforced in this conclusion when I bear in mind the purpose of an opponent having to demonstrate genuine use of a mark as registered or in a form differing in elements which do not alter the distinctive character. That is, to allow an opponent to properly rely on *variations* in the way in which the mark is used, when exploiting it commercially, for example so as to enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned, *provided* that the distinctive character of the mark remains the same: Court of First Instance (now General Court) Case T-194/03 *Il Ponte Finanziaria SpA v OHIM* at [50]. In this way, an opponent or proprietor can also avoid the need to register every different *variant* of his mark in which the differences do not alter its distinctive character. But variants that go beyond that test, even if the differences are only "slight", will need to be registered separately to be protected: *BUD* at [22]-[23]; Case C-234/06P *Il Ponte Finanziaria SpA v OHIM* [2008] ETMR 13 at [86]. It cannot be said that the mark as shown to used in this case, the words only 'RICE KING', represents a '*variant*' of the mark as registered; instead it represents but one *element* of the composite mark as registered. It does not matter either that that element may be the single, dominant and distinctive element; the fact is that S & B opted to register the mark as a composite, wherein the overall impression conveyed reflects a number of different elements comprising the whole.
28. Having arrived at this conclusion, the opposition necessarily fails, the opponent having failed to meet the proof of use provisions. As such there is no need for me to proceed to consider the opponent's arguments under section 5(2)(b) of the Act.

### **Costs**

29. The opposition having failed, Khan International Trades ( a partnership of Amanat Ulla Khan and Usman Ulla Khan) is entitled to a contribution towards its costs on the following basis:

Considering notice of opposition	£200
Statement of case in reply	£300
Considering evidence	£500
Providing submissions	£300
Total	£1,300

30. Accordingly, I order S & B Herba Foods to pay to Khan International Trades (a partnership of Amanat Ulla Khan and Usman Ulla Khan) the sum of £1,300. 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 12 day of March 2010**

**Edward Smith  
For the Registrar,  
the Comptroller-General**