

**O-107-17**

**TRADE MARKS ACT 1994**

IN THE MATTER OF CONSOLIDATED PROCEEDINGS:

APPLICATION NO 3099108 IN THE NAME OF TELUGU NRI FORUM AND  
OPPOSITION NO 404744 THERETO BY TELUGU NRI FORUM CORPORATION

AND

APPLICATION NO 3099266  
IN THE NAME OF TELUGU NRI FORUM CORPORATION AND  
OPPOSITION UNDER NO 404665 THERETO BY TELUGU NRI FORUM



## Background

1. This decision concerns two consolidated proceedings:

1. Application No 3099108 which has a filing date of 13 March 2015 and stands in the name of Telugu NRI Forum (“Forum”). It seeks registration of the mark shown on the cover of this decision in respect of the following services:

Class 41:

Academies [education]; Academy education services; Academy services (education-); Adult education services; Adult education services relating to environmental issues; Adult education services relating to law; Adult education services relating to management; Advisory services relating to education; Advisory services relating to entertainment; Advisory services relating to publishing; Advisory services relating to the organisation of sporting events; Arrangement of seminars for educational purposes; Arranging and conducting of educational seminars; Arranging for students to participate in educational activities; Arranging for students to participate in recreational activities; Arranging group recreational activities; Arranging of award ceremonies; Arranging of competitions for cultural purposes; Arranging of competitions for education or entertainment; Arranging of competitions for educational purposes; Books (publication of-); Books (Publication of -); Career information and advisory services (educational and training advice).

Following publication of the application in the *Trade Marks Journal* on 8 May 2015, notice of opposition was filed by Telugu NRI Forum Corporation (“Corp”). There is a single ground of opposition brought under the provisions of section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Corp claim to have an earlier right, which it is agreed is identical to the mark shown on the front cover of this decision and which it claims it has used “throughout UK and also around the globe” since 19 March 2014. I shall return later to the services on which its claim is based.

Forum filed a counterstatement in which it denied the claims made.

2. Application No 3099266 which has a filing date of 14 March 2015 and stands in the name of Corp. It seeks registration of the mark shown on the cover of this decision in respect of the following services:

Class 45:

Social work services; Social networking services

Following publication of the application in the *Trade Marks Journal* on 3 April 2015, notice of opposition was filed by Forum relying on grounds under sections 5(1), 5(2)(a), 5(2)(b), 5(3), 5(4)(a) and 5(4)(b) of the Act. Its claims under sections 5(1), 5(2) and 5(3) of the Act are based on its earlier mark no 3099108. Its claim under section 5(4)(a) is based on an earlier right identical to the mark shown on the front cover of this decision which it claims was first used on 15 March 2014 throughout the UK. Its claim under section 5(4)(b) is made on the basis that it owns the copyright in the mark.

Corp filed a counterstatement denying each of the claims made.

2. The proceedings were consolidated. Both parties have filed evidence with Corp also filing written submissions. Matters came before me for a hearing where Forum was represented by Mr Vishnu Alluri and Corp was represented by Mr Jamie Muir Wood of Counsel instructed by Marsans Solicitors & Advocates.

### **The evidence**

3. The evidence consists of the following:

#### Forum's evidence:

A witness statement by one of its Directors, Dr Soma Sekhara Rao Vemuri dated 14 March 2016 with exhibit A;

A second witness statement of Dr Vemuri dated 6 June 2016 with exhibit SSRV1;

A witness statement of Mr Surya Prakasa Rao dated 6 June 2016 with exhibit SPR1;

Two witness statements each by other directors, namely Mr Hariprasad Kuttambakan, Mr Kiran Kumar Mummaneni, Mr Chandra Sekhar Chandra and Mr Balanandam Kakarla. The first are dated 14 March 2016, the second 16 May 2016. Each of them are identically worded and merely confirm they have read each of Dr Vemuri's witness statements and exhibits and agree with them.

Corp's evidence/submissions:

An affidavit by Mr Vishnu Alluri dated 9 February 2016;

An affidavit by Mr Venkata Ramesh Vudathu dated 1 February 2016;

An affidavit by Mr Venkatarama Mondeddu dated 5 February 2016;

An affidavit by Mr Venkat Adusumalli dated 4 February 2016;

An affidavit by Mr Suresh Karothu dated 5 February 2016;

A second affidavit by Mr Alluri dated 9 February 2016 along with written submissions and exhibits:

A third affidavit by Mr Alluri dated 3 June 2016 with further written submissions and exhibits.

4. This amounts to a fairly large volume of material. As can be seen, the names of the respective parties are very similar and the evidence shows that the parties do not always use their full company names but use shortened versions of them or refer to them in other ways (e.g. by the use of UK Chapter). Further, at the hearing, the parties claimed that some of the evidence filed on behalf of one party was, in fact, material belonging to the other. Additionally, the evidence contains references to individuals using their full names, part of their names or with honorific titles. Furthermore, a number of allegations have been made that some of the material filed in evidence is not genuine but has been created to deceive. I do not intend to summarise the evidence here but will refer to both it and the submissions as necessary and deal with the various issues raised as appropriate later in this decision. That said, for the avoidance of any doubt, I confirm that I have read (and, in the case of a USB stick, have viewed) all of the evidence filed.

## The opposition to application no 3099108

5. I intend to consider, first, Corp's opposition to Forum's application no 3099108. As indicated above, there is a single ground of opposition brought under the provisions of section 5(4)(a) of the Act which states:

"A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of "an earlier right" in relation to the trade mark."

6. Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

7. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

8. The earlier use by the claimant must relate to the use of the sign for the purposes of distinguishing goods or services. For example, merely decorative use of a sign on a T-shirt cannot found a passing off claim: *Wild Child Trade Mark* [1998] RPC 455 (AP).

9. The first element which Corp has to satisfy is to show that it has goodwill. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) the Court stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of

a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

10. Corp claim to have used the mark since 19 March 2014 “Throughout UK and also around the globe”. In *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others*, [2015] UKSC 31, Lord Neuberger (with whom the rest of Supreme Court agreed) stated (at paragraph 47 of the judgment) that:

“I consider that we should reaffirm that the law is that a claimant in a passing off claim must establish that it has actual goodwill in this jurisdiction, and that such goodwill involves the presence of clients or customers in the jurisdiction for the products or services in question. And, where the claimant's business is abroad, people who are in the jurisdiction, but who are not customers of the claimant in the jurisdiction, will not do, even if they are customers of the claimant when they go abroad.”

And later said, at paragraph 52:

“As to what amounts to a sufficient business to amount to goodwill, it seems clear that mere reputation is not enough, as the cases cited in paras 21-26 and 32-36 above establish. The claimant must show that it has a significant goodwill, in the form of customers, in the jurisdiction, but it is not necessary that the claimant actually has an establishment or office in this country. In order to establish goodwill, the claimant must have customers within the jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere. Thus, where the claimant's business is carried on abroad, it is not enough for a claimant to show that there are people in this jurisdiction who happen to be its customers when they are abroad. However, it could be enough if the claimant could show that there were people in this jurisdiction who, by booking with, or purchasing from, an entity in this country, obtained the right to receive the claimant's service abroad. And, in such a case, the entity need not be a part or branch of the claimant: it can be someone acting for or on behalf of the claimant.”

11. The claimant in that case did not have any goodwill in the UK that would give it the right to prevent BSkyB from using the name "NOW TV" in relation to its internet protocol TV service. This was because the customers for Starbucks' broadcasting services under the name NOW were based in Hong Kong. The services could not be bought here. The fact that the service was sometimes accessed via the internet by Chinese speakers in the UK did not mean that Starbucks had customers here.

See also the judgments of the Court of Appeal in *Budweiser* [1984] F.S.R. 413 at 463 and *Hotel Cipriani SRL and Others v Cipriani (Grosvenor Street) Limited and Others*, 2010 EWCA Civ 110 (CA).

12. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

"27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the

hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

13. Whilst the above case law refers to “goods” the same will hold true as regards the provision of services and, with it in mind, I go on to consider Corp’s claim in more detail. In its Notice of Opposition, Corp sets out its claim to have used the mark as follows:

“Class 45-Social networking services: Established a global Telugu network via an organisation called “Telugu NRI Forum Corporation –traded as Telugu NRI Forum” using social media and various other technological channels.

Class 45-Service events:

-Clean & Green program in Ch Pothepalli and surrounding 4 villages. We evolved this concept before government started Swatch Bharat, thereby setting an example.

-Burial ground for Ch Pothepalli and surrounding 7 villages –this is first ever program in villages and we did this with a belief that everyone should live and die with dignity, irrespective of their wealth.

-Operation Suhrud (phase 1 & 2) which covered emergency relief operations & livelihood programs for victims of cyclone –Hudhud- this was a major program involving nearly 200 volunteers in all 3 regions reaching remotest areas etc

- Smart village adoption in Andhra Pradesh
- Bio-toilet program in Sathenapalli village, Gunturu Dist, Andhra Pradesh India

Class 41-Cultural events; Ugadi in UK Parliament in 2014 & 2015 (first ever Telugu Festival done in such grand scale in a Western Parliament, with 14 MPs present).

Class 41-Women's wing educational seminars: Presentation in various seminars and fighting on women's issues, on various platforms in American associations, on behalf of Telugu NRI Forum.

Class 41 –Investment support and seminars: Conducted investment seminars in Switzerland & various meets in UK, helping many organisations to invest in Telugu states. Aqua Park development in Visakhapatnam & Smart City Srikakulam development in agreement with AP govt, are some of our initiatives.

Class 41-Language/academic courses: Cultural orientation especially on Telugu language development for kids in London & Switzerland; continue political endorsements across the globe, smart villages adoption etc.

Class 41 –Award ceremonies: Recognising highly successfully Telugu people across the globe and honouring them via various excellency awards in various categories like in career, academic, business etc

Non-class –Chapter events across the globe: Activities in various other chapters across the globe in USA, Switzerland and India.

Non-class –Political awareness and campaign: Worked closely with Modi Govt & TDP Govt during NDA elections as we believed they are the right choice to serve public. Provided strategies and ideas on how to bring Pawan Kalyan and Rajinikanth to NDA fold, six months before Janasena was formed. Active endorsement of politicians & Parties, who would help Telugu community in UK, USA and other regions.”

14. Whilst I have set out in full Corp's claim to have used the mark, the vast majority of the activities it claims to have undertaken appear to have taken place outside the UK. As I have already indicated, this decision is concerned only with Corp's claimed

goodwill in the UK. It is a matter for Corp to show that it had that goodwill at the relevant date. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.’

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is

that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

With this in mind, I go on to consider Corp’s evidence.

15. In his first affidavit, Mr Alluri states he joined the organisation on 16 March 2014 and that he has been a “sleeping member of this organization since then.” He makes no statement about any trade by Corp under its claimed earlier right (whether in the UK or elsewhere) but attached to his affidavit are a number of exhibits. Many of them refer to activities which have taken place in other countries, mainly India, so do not assist in establishing the position in the UK. In relation to other material, there is:

- Document 1, said to “consist of several Screen Shots taken from Facebook Chats or Emails or Scanned Brochures”. There are 30 pages including the cover page. Much of it is undated and some of it is in a foreign script which I do not recognise and for which no translation has been provided.

At page 2 is what appears to be a screenshot showing a list of 13 emails in an unidentified email (Gmail) inbox. The screenshot is not dated but the emails listed are dated between “3/8/14” and “3/29/14”. Whilst only a small amount of the text in each email can be seen, most appear to be emails of the sort sent or received when setting up a new email account, though one entry, dated 3/28/14, is from CASSIDY Heather and reads:

“South Indian Festival Ugadi: Tuesday 1<sup>st</sup> April 6pm to 8pm Committee Room 14-Thank you for your invitation for Anne Mo”.

At page 3 is a screenshot of a Facebook chat page. One entry, dated 8 March 2014, shows a message from “Kal Inam” which, as written, states:

“as I said we have recently foremd telugu nri form only for development of andhra website etc is under development/ please feel free to fwd u r suggestions inputs etc / @shekar vemuri: konchem mee introduction isthara”.

No explanation is provided to show how this relates to Corp but it would appear to be an internal email relating to the setting up of a website.

At page 4 is a printout of an email from “Ramesh Vudathu” sent on 28 March 2014 entitled “Sponsorship request for Ugadi event”. The email begins:

“The preparations for the Ugadi are going in full fledged with all your support. We have kept no entry fee for the event to ensure everyone has a fair chance to visit the Parliament. However, the costs involved are huge and to this extent any sponsorship to few of the items below will help us immensely in upfront.”

The email goes on to list various things “available to be sponsored” such as “Venu Buna and team –(Invitations & postage sponsorship) -£90” and “Vijaya babu/Rajeev (Satyam) Team –(Banner sponsorship) £70”. The email shows it was sent or copied to some 17 addressees including to Mr Vudathu himself.

At page 11 is a printout of a Facebook messages page. On 10 March 2014, “Chandrasekhar Buddha” wrote:

“hey guys i think we need to move fast as elections are approaching...after elections we cant do anything then alligning with new govt no point of dragging things till last minute if any one know any university or college ppl get permissions to give presentation so that we can do mass communication and motivate students to select correct candidate”.

There is no evidence to show who may have seen this message. Whilst “elections” are mentioned in the text, there is no explanation of which elections these may have been or where they took place or that the message related to UK universities or colleges. The message mentions the giving of presentations but there is no evidence that any presentations actually took place.

At page 12 is a printout of a Facebook messages page. On 10 March 2014 Sekhar Vemuri wrote:

“Good In the name of Telugu NRI forum we will do work at ground level calling universities and colleges as suggested by Chandra gaaru I will study how ABN channel conducting youth programmes at ground level”.

Again, there is no evidence that this relates to any UK university or college nor is there anything to indicate that Corp has carried out any services under the mark as a result of “calling” any such educational establishments.

At page 19 is what appears to be a copy of a page taken from *Asian Lite* from an unknown date in 2014. Whilst much of the text is in a foreign script which I do not recognise, I can see that the page shown bears an advertisement for “Celebrating Ugadi @ British Parliament”. The text is very small and poorly presented such I am unable to read all of it but I can see that “Telugu NRI Forum UK Chapter” invites people to the Ugadi Festival described as an “Historic Event for the very first time celebrated at the Houses of Parliament UK” and requests “RSVP: Places are limited Please confirm your attendance by 28 March 2014”. No evidence is given of the circulation of this publication.

At page 20 is another copy of an invitation to the Ugadi Festival (said to be New Year’s Day Celebrations for the South Indian Community) in the Houses of Parliament taking place on 1 April 2014. No information is given as to the form of this invitation or who may have received it or how but places are said to be limited and the contact is said to be “TELUGU NRI FORUM Ramesh \_vudathu” at a Hotmail account.

At page 21 is a copy of an advertisement showing the mark. The advertisement is for a “Seminar on New Capital for AP” due to take place on “3/28/14”. No information is given of where this advertisement may have appeared or who made have seen it nor is any indication given of whether the seminar actually took place and, if so, who or how many people may have attended it. The advertisement states that the seminar is due to take place at “Sri Krishna Vilas” though where this venue might be, in terms of a particular town or country, is not explained.

- Document 2 is said to be Expense Receipts. At page 2 it shows the purchase by “venkata VUDATHU” from vistaprint.com of two vertical banners showing “Ugadi Celebrations 2014” at a cost of £36.03 on 19 March 2014.

16. The substance of the affidavits of Mr Vudathu, Mr Mondeddu, Mr Adusumalli and Mr Karothu are each identical. In relation to the mark, each states “Since March 2014 we are using it for our global activities”. None of them give any details about those activities nor do they give any information which establishes what the position might have been in the UK at any particular date.

17. Mr Alluri’s second affidavit gives no information about any use of the mark but there is a 50 page exhibit consisting of “several Screen shots taken from Facebook or Emails or Scanned brochures or Photos.” Again, most of the pages are undated and their source is not given or they refer only to matters outside the UK.

18. At page 23 is an advertisement which shows “IFA Indian Friends Of Atlanta” [is] offering [a] seminar on College planning & financial planning” on May 31<sup>st</sup>. The year is not given and there is nothing to show where they are based, though the mention of Atlanta could suggest it is of US origin. Whilst the print is poor, it appears to show the mark, with others, at the bottom of the page. The source of the advertisement is not given and, whilst it shows the seminar is taking place at “Taste of India”, no indication is given of where, in terms of a specific town or country, this might be nor is there any evidence the seminar took place or who or how many people may have attended. At page 27 is an article which gives details of a meeting of orthopaedic surgeons (the

16<sup>th</sup> Annual Conference) taking place at the Tower Hill Grange Hotel in London on 11 and 12<sup>th</sup> July (year not given) “with support from Telugu NRI Forum”. Whilst the mark is shown, with another, at the top of the page, no explanation is given of how this event relates to Corp and its claimed activities.

19. Mr Alluri’s third affidavit makes no reference to any use of the claimed earlier right by Corp but again, he has filed a number of exhibits.

- Document 1 consists of 25 pages said to be “Screen Shots taken from Emails or Scanned brochures and so on”. Some of the pages, e.g. an advertisement from *Asian Lite* at page 5, appear to duplicate earlier exhibited material but the majority of them either make no reference to any use made of the earlier right claimed by Corp, are not dated or are dated after the relevant date or the source is not given.
- Document 2 consists of 32 pages containing “Translating agency (Sri Krishna Solutions) Report from pages 2 to 5 and investigating agency (UK Private Investigators) Report from pages 6 to 32”. None of this material refers to any use of the earlier right claimed by Corp but it appears to call into question the authenticity of various documents.
- The third exhibit is a USB stick said to contain “a video “Surya Prakash Whom So Ever letters Comparison”. Again, there is no reference to any use of the earlier right claimed by Corp and the content calls into question the authenticity of documents.

20. There may be no “absolute requirements” as to the nature of the evidence which needs to be filed when a party brings proceedings under section 5(4)(a) of the Act, however, there must be evidence that shows at least a prima facie case that it has acquired the requisite goodwill or reputation in the UK at the relevant date for the goods or services claimed. The goods and/or services in relation to which Corp claims to have used the mark in the UK is not well defined and, whilst there is an amount of evidence regarding various projects carried out in India, despite a very careful review of all of the material which it has filed, I have found no evidence that Corp has shown it has even a prima facie case that it has acquired any goodwill or reputation in the UK

at any time, and certainly not at the relevant date in relation to any particular goods or services. As set out above, there is some, very limited, evidence that a few individuals made contact between themselves by email and discussed various matters such as holding a celebration (Ugadi) in the Houses of Parliament. As I indicated above, both parties made a claim that particular elements of the evidence was their material and the invitation to the Ugadi Festival is such material. I do not consider it necessary to determine the ownership point. This is because the evidence includes copies of an invitation and there are some undated prints of photographs apparently taken at the celebration but there is no evidence to show who may have attended the celebration or what took place during it. Whoever organised it, the fact that a celebration may have taken place in the Houses of Parliament is not sufficient to establish goodwill in relation to any particular goods or services and certainly not one that accrues to Corp at the relevant date. There is also some, again very limited, evidence that someone suggested making contact with unnamed universities apparently with a view to making presentations to students on political matters, however, for the reasons given above, this evidence also fails to show Corp has the requisite goodwill in the UK in any goods or services at the relevant date. As to the allegations that some of the material in evidence is not genuine but has been created in order to deceive, I again do not consider it necessary to make a determination as none of this material shows that Corp has the requisite goodwill in the UK in any goods or services at the relevant date. There is, for example, no evidence of turnover or advertising expenditure in relation to any specific trade and no evidence from customers or the trade.

21. Absent evidence of goodwill in the UK at the relevant date in relation to the services claimed, Corp's objection to application 3099108 founded on section 5(4)(a) of the Act fails.

### **The opposition to application 3099266**

22. As indicated above, Forum's opposition to Corp's application no 3099266 is brought on a number of grounds. At the hearing, Mr Muir Wood confirmed that Forum was not prepared to drop any of the grounds of opposition but, in terms of the objections under section 5(1), 5(2)(a) and 5(2)(b), he focussed on the objection under

section 5(2)(a) of the Act. Given that there is no dispute that the marks are identical, I shall follow that line as it presents Forum with its strongest of these three grounds.

23. Section 5(2)(a) of the Act states:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the 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”.

24. What constitutes an “earlier mark” is set out in section 6(1) of the Act which states:

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

- (a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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,

- (b) a Community trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), (ba) a registered trade mark or international trade mark (UK) which-

- (i) has been converted from a Community trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and

- (ii) accordingly has the same claim to seniority, or

- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of

the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

25. As can be seen above, the application relied on by Forum under this ground has an earlier filing date (albeit just one day earlier) but has not yet achieved registration. In line with the provisions of section 6(2) of the Act it would be an earlier trade mark if registered and Forum is entitled to rely on it under this ground in respect of the services within its specification on a notional basis and without having to prove that it has used the mark in relation to any of those services.

26. In determining whether there is a likelihood of confusion, I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely

upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of the respective marks**

27. As I indicated above, there is no dispute that the marks are identical.

### **Comparison of the respective services**

28. Whilst, in its notice of opposition, Forum relied on each of the services of its application, in his skeleton argument and at the hearing, Mr Muir-Wood sought to rely on a more limited set of services. With that in mind, the respective services are as follows:

<b>Forum’s earlier specification as relied upon</b>	<b>Corp’s specification as applied for</b>
<p><b>Adult education services; Adult education services relating to environmental issues; Adult education services relating to law; Adult education services relating to management; Advisory services relating to education; Career information and advisory services (educational and training advice).</b></p> <p>Advisory services relating to the organisation of sporting events; Arrangement of seminars for educational purposes; Arranging and conducting of educational seminars; Arranging for students to participate in educational activities; Arranging for students to participate in recreational activities; Arranging group recreational activities;</p>	<p>Social work services; Social networking services</p>

29. The Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, stated at paragraph 23 of its judgment that:

“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 intended purpose and their method of use and whether they are in competition with each other or are complementary”.

30. The relevant factors identified by Jacob J. in the *Treat* case, [1996] R.P.C. 281, for assessing similarity are:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

31. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant

language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

32. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. stated:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

33. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. stated:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

34. In *Kurt Hesse v OHIM*, Case C-50/15 P, The CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or 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".

35. In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree

in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

36. Mr Muir Wood submitted in his skeleton argument that those of Forum's services which I have highlighted in bold in the above table are similar to *Social work services* as included in Corp's application. He submitted that both have similar uses, namely providing advice to members of the public to assist them with aspects of their personal lives, both will be used by the same members of the public, the physical natures of the services are therefore similar and they are likely to reach users through similar trade channels, namely the internet, physical publications, interactions with providers of the services and word of mouth. At the hearing, he submitted:

“...they are provided to similar members of the public and they are likely to be provided by similar entities. Local authorities might provide educational services and also social work services. Charities might provide educational advisory services and social work services, giving social work services its strict but broad meaning...social work services is provisional services to members of the public by local authorities or charities to assist them with their livelihoods...In my submission, that is similar to local authorities or charities

providing educational or career information and advisory services. They are not identical but there are similarities between the types of people that you might approach or you might provide those services and the people who would seek those services...”

37. In relation to those of Forum’s services which are in plain text in the above table, Mr Muir Wood submitted in his skeleton argument that they are similar to Corp’s *social networking services*. He submitted that both have similar uses, namely the provision of a service which will encourage interaction between members of the public. He submitted that the users, members of the public, will be the same, the physical nature of the services are therefore similar and they are likely to reach users through the similar trade channels, namely the internet, physical publications and word of mouth. At the hearing, he expanded on this submission and said:

“All those services have similar uses in that the idea behind them is to provide a service for members of the public to encourage interaction between members of the public. The target audience of the services is the same and the physical nature is similar. It is not like a service and goods where one is on a shelf in the supermarket and one is a service offered through a different trade channel. Furthermore, they are offered through similar trade channels through adverts, or can be offered through similar channels through adverts in the physical press, in media and through word of mouth. For those reasons, I submit that there are high similarities, if not identity between those services.”

He went on to submit:

“...there is no reason why those organising group recreational activities would be necessarily different from those organising social networking services. The people organising either of those events, in my submission, those are perhaps different words for putting forward the same type of service, the idea of organising a recreational activity at which members of the public can attend. It is not limited to adults or students. It is similarly broad to the broad social networking services for which the application is sought, and therefore it would be similar entities who might be offering those services.”

38. When I challenged him, Mr Muir Wood accepted that the fact that various services may each be advertised through newspapers and the internet does not mean they are provided through the same trade channels or make them similar.

39. For his part, Mr Alluri denied the respective services are similar. The transcript of the hearing records that he submitted:

“They are different because the IPO identify that they are different. That is where they are different in two different classifications, clause 41 and clause 45.”

40. I reject Mr Alluri’s submission. Whilst it is permissible to take into account the class number when assessing the *meaning* of the description of goods or services included in an application (see *Altecnic Ltd’s Trade Mark Application* [2002] RPC 34 (COA)), the question of whether goods and/or services are similar and, if so, to what extent is determined not on the basis of the particular class(es) in which they have been recorded but on the basis of the case law as set out above. Mr Muir Wood’s submissions require further consideration in line with the case law set out above and I go on to compare the respective services with this case law in mind noting that neither party has filed evidence regarding the similarity or otherwise of the respective services for which each has applied.

41. *Social work services* includes services which are intended to safeguard vulnerable individuals or families by e.g. providing practical help to those individuals or families with personal, physical or emotional needs. It also includes services which otherwise support individuals or communities by promoting social change and development with the aim of achieving improved outcomes for them. The services are provided to those individuals, families or communities deemed in need of such assistance and by specialist suppliers who, I am aware, may be subject to various regulatory or statutory restrictions such as those set out in the POVA scheme or the Working with Children Regulations. *Adult education services; Adult education services relating to environmental issues; Adult education services relating to law; Adult education services relating to management; Advisory services relating to education; Career information and advisory services (educational and training*

*advice*) are services which educate (or provide information and advice on education). They are services used by the general public in some way interested in the topic areas and provided by specialist educational providers. Whilst some social work may involve an element of personal development, the users of the respective services are different and the core meaning and purpose of the respective services differ as will their natures. The respective services are not in competition nor do I consider them to be complementary and they will be provided by separate undertakings. I find they are dissimilar services.

42. *Social networking services* are services which enable their users, who are members of particular communities or those with shared interests, to connect with each other primarily through dedicated websites or technology-based applications. I can see no way in which they have any similarity to *advisory services relating to the organisation of sporting events*. The users, uses and natures differ and the respective services are not in competition nor complementary. Whilst both may be provided e.g. via the internet, the respective services will be provided by different undertakings. These respective services are dissimilar.

43. As for the comparison between *social networking services* and *arrangement of seminars for educational purposes, arranging and conducting of educational seminars, arranging for students to participate in educational activities, arranging for students to participate in recreational activities and arranging group recreational activities* these latter services are organisational ones by which preparations are made to enable various seminars and activities to take place. They are services which will be used by those seeking to deliver the seminars or activities. Again, whilst the respective services may each be provided e.g. via the internet, they have different uses, will be provided by different undertakings to different users and are neither in competition nor complementary. The respective services are dissimilar.

44. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is

served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

45. As I have found the services relied on by Forum to be dissimilar to those for which Corp seeks registration, there can be no likelihood of confusion. The opposition based on section 5(2)(a) of the Act fails. As this represented the strongest of Forum's grounds (insofar as section 5(1) and 5(2)(b) objections were also relied on), I dismiss the grounds of opposition under sections 5(1) and 5(2)(b) of the Act.

**Forum's objection to Corp's application No 3099266 under section 5(4)(a) of the Act**

46. Earlier in this decision, I set out the provisions of section 5(4)(a) of the Act and the case law that is relevant to it. It is not necessary for me to repeat it here. In its notice of opposition, Forum claims to have used its mark since 15 March 2014 throughout the UK. The mark it relies on is identical to that set out on the front page of this decision. In response to the question requiring it to specify on which goods or services it has used this mark, Forum has answered "All goods and services". In setting out the reasons why it considers Corp's application to be objectionable under this ground, it states:

"The trade mark has been used by Telugu NRI Forum since March 2014, which is when the company began operating as a private limited company in the U.K. (Company Registration Number: 08936815). Through numerous projects which have been conducted by Telugu NRI Forum, the company now has a reputation for providing development to the Telugu people of India. This reputation exists within the UK, in particular with people from the Telugu group who reside in the UK."

47. Neither of these statements provide much clarity on the extent of its claim but whatever the goods and/or services relied on, and for reasons that will become clear, its opposition under this ground fails.

48. As set out above, the first requirement under this ground is for Forum to show that it has the necessary goodwill in the UK. Whilst Forum has filed a large number of witness statements, only those of Dr Vemuri make any mention of the use of the mark relied on.

49. In his first witness statement, Dr Vemuri states that Forum:

“is a charitable organisation with chapters around the world. Its mission is to improve the lives of the Telugu community. [Forum] has been instrumental in the developing regions and improving communities in India. [It] has successfully overseen projects in India, including installing BIO-Toilets and developing smart villages, which have been accomplished through [it] and its members.”

He goes on to state that Forum has:

“...organised, arranged and advised on a number of activities and initiatives for the Telugu Community in India. [It] was involved in the installation of BIO-Toilet’s (sic) and developing smart villages in partnership with the AP Government and Government of India. In fact, I had personally started the BIO-Toilet project in Andhra Pradesh in India under [Forum]. I also started the smart village developments in India...

Mr Chandra, a director of [Forum] also undertook a smart village development in India.

The initiatives in India were accomplished (sic) through the contacts that the members and myself had in India. The funds for the projects were made available by me.

[Forum] has arranged and advised on entertainment events. A recent example, [Forum] was a partner of the Welcome Modi event that took place in the UK in November 2015. The underlining principle of the event was to

promote India. The event was a success, which was well publicised in the news.

[Forum] have a number of other projects in the pipeline...”

50. In his second witness statement, Dr Vemuri states:

“[Forum] has organised a number of events as well as having successfully implemented a number of projects. We initiated the introduction of bio-toilets, the first of their kind, in Phanidam Village, Sattenapali, Andhra Pradesh.”

51. Dr Vemuri exhibits material which he states are “copies of posters, adverts, articles and photographs exhibiting the projects and events that [Forum] had successfully implemented.” (pages 94-102 of Exhibit SSRV1).

52. At page 94 is what appears to be an advertisement. The only text on it that I can understand is that which announces a visit by a Dr Kodela gari to the Nordic countries in May 2015. No information is given of where this advertisement may have appeared or who or how many people would have seen it. Whilst it shows what appears to be the mark relied on and Forum’s name appears on it, no explanation is given as to how it relates to any goods or services provided by it.

53. At page 95 is an article entitled “Sattenapalli as Swachhanapalli”. It appears to show a biography of an Indian politician. The article is undated and no information is provided to show where or when it may have been published. It makes no reference to Forum, its mark or its activities.

54. At page 96 is what appears to be a copy of an advertisement. The text is in a language I do not recognise though underneath it the words “Smart Village Smart Ward Program” appear. I can see no reference to Forum or its mark, it is not dated and there is no information provided to show where or when it may have been published.

55. At page 97 are what appears to be collage of a number of advertisements along with an article. The text of the article is in a language I do not recognise. The advertisements also contain text in what I presume is the same language but do make reference to the opening of Bio-Toilets in India. They also refer to Forum and show what I take to be the mark (the print is small and not clear). In between the advertisements is the typewritten date "21.2.2015". No information is provided to show where these items may have appeared or who or how many people may have seen them.

56. At page 98 is an article about the opening of the bio-toilet. Again, there is no indication of where this article may have appeared (or when) or who may have seen it.

57. Page 99 consists of a series of eight undated images. The quality of them is very poor though I can see they each show a group of people.

58. Page 100 is a short article, with images, of a bio toilet in Andhra Pradesh. No information is given as to where or when this article may have been published or who may have seen it.

59. Page 101 is a copy of a photograph. It shows a group of men alongside an advertising banner. Whilst the quality of the print is again poor I can see that it shows Forum's name along with what I take to be the mark. Underneath this appear UK, Europe, USA, Middle East and Asia and the words "We work for Telugu Community Globally". The photograph is undated and no other information is provided.

60. Page 102 is an article entitled "Telugu NRI Forum Successfully Partners with APNRT Inc". It bears the typewritten date 25/11/2015. The article reports that Forum has partnered with APNRT's roadshows in the UK, and that its general secretary participated in "the roadshow in West London on Sunday". The article goes on to refer to the "smart village program" for the adoption of at least 30 villages following the roadshow and dinner in Manchester "on Monday evening attended by more than 60 professionals". It also reports on a meeting between a UK MP and some members of Forum "on Wednesday morning". There is no further detail provided to

show where this article may have been published nor anything which explains who the individuals concerned may have been.

61. Forum's claim under this ground is that it has used its mark since 15 March 2014, however, the evidence does not support this. I accept that the mark has appeared in a number of articles and/or advertisements but there is no evidence that any of these have been published in the UK and, where dated, much of the material post-dates the relevant date. Forum claims that the mark is well-known among the Telugu people who reside in the UK but no evidence is given to support this and there is no explanation of who or how many people this might be. The evidence does not show any use of the mark in the relevant UK market. As I indicated above, when considering Corp's objection under section 5(4)(a) of the Act, there may be no "absolute requirements" as to the nature of the evidence which needs to be filed when a party brings proceedings under section 5(4)(a) of the Act, however, there must be evidence that shows at least a prima facie case that it has acquired the requisite goodwill or reputation in the UK at the relevant date in the course of trade in the goods or services claimed. Forum have failed to show even a prima facie case. The objection under section 5(4)(a) of the Act is dismissed.

### **Forum's objection to application 3099266 under section 5(3) of the Act**

62. Section 5(3) states:

"(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

63. The relevant case law is to be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal*

*v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*.

Whilst I have those cases in mind, it is not necessary for me to set them out in detail here because the objection under this ground has no prospect of success.

64. Earlier in this decision, I set out a summary of Forum's evidence insofar as it relates to the use claimed to have been made of its mark. For the reasons given above, that evidence does not show that Forum has the reputation in the UK which is needed in order to be able to succeed under this ground. I dismiss this ground of opposition.

### **Forum's objection to application no 3099266 based on section 5(4)(b) of the Act**

65. The relevant section of the Act states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) ...

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

66. In his witness statement, dated 14 March 2016, Dr Vemuri states:

“The logo, which is the subject of this trade mark application, was created for [Forum] under my instructions. On behalf of [Forum] I hired a DTP professional, Mr Surya Prakash Rao of Prakesh Graphics, India to develop the logo exclusively for [Forum]... I paid for the design of the Logo”

67. Dr Vemuri exhibits a number of documents. The first is a copy of an agreement (Exhibit A page 13) which he states was made between him and Prakesh Graphics whose address is given as being in Andhra Pradesh, India. The agreement is presented on paper headed with Dr Vemuri's name and his address in Cheshire. The document bears a date of 15 March 2014 and is headed "Logo Design Agreement between Dr. Soma Sekhara Rao Vemuri and Mr. Surya Prakasa Rao (Prakash Graphics)". The document lists Dr Vemuri as the "logo owner" and Mr Rao as the "logo designer" and identifies the "project" as being "'Telugu NRI Forum" Logo design". The cost of the project is said to be "Rs. 25,000.00 including taxes, salaries, wages and all related expenditure [for which] Payments will be arranged in 2 or 3 instalments" by Dr Vemuri. The agreement sets out details of the ownership of "Work Product" as follows:

"a. All drawings, specifications and other documents and electronic data, idea provided by Dr. Soma Sekhara Rao Vemuri, for the Project and furnished to Owner under the Comprehensive Agreement or this Agreement are deemed to be work for hire and the property of Owner.

b. Mr Surya Prakasa Rao, will take up all Design work by himself or its Design Consultant(s) for the Project.

c. Mr Surya Prakasa Rao will hand over all kind of designs, drawings, and any other related work regarding logo to Dr. Soma Sekhara Rao Vemuri.

d. Dr. Soma Sekhara Rao Vemuri has all kind of rights to use Logo designs. Mr. Surya Prakas Rao doesn't have any right or use of complete logo design or part of it or any rough designs in any form will not be acceptable."

68. The document shows it to have been signed by Dr Vemuri and Mr Rao on 15 March 2014. The document as written states:

"Contract Time: Work shall be commence immediately and final design will be will be handover to Dr. Soma Sekhara Rao Vemuri on or before 15<sup>th</sup> May 2014."

At page 12 of the same exhibit is a copy of a letter on Prakash Graphics headed paper. It is dated the same day (15 March 2014), is addressed “To whom so ever it may concern” and states:

“I under signed Mr. Surya Prakasa Rao of Prakash Graphics hereby state that I am working for [Forum]. On behalf of Soma Sekhara Rao Vemuri of [address given] I have designed the logo and the art work for the exclusive use of [Forum]. I hereby confirm that this logo & designed art work is the property of [Forum].”

Underneath this text is an image. The quality of the reproduction is poor but it appears to me to be a representation of the mark at issue in these proceedings. The document bears Mr Rao’s signature. I will return to this document below.

69. At page 14 of the same exhibit is a copy of what Dr Vemuri states is “Poof (sic) of payment”. It takes the form of a copy of a remittance confirmation slip though ICICI Bank and is dated 5 March 2014. It confirms the transfer of some £98 from Soma Vemuri to Surya Rao. The slip indicates that the purpose of the money transfer is “Towards family maintenance and savings”.

70. Corp does not dispute that Dr Vemuri gave instructions to Mr Rao to create the design but say he did so on its behalf and that the copyright belongs to them. Corp also casts doubt on the authenticity and relevance of the documents exhibited by Dr Vemuri. It submits:

“the logo is the brain child of six individuals who wished to take it to global level: these are the founding members who include Venkat Mondeddu, Venkat Adusumalli, Suresh Karothu and Partha Chaitanya from USA, Ramesh Vudathu & Kalyani Inempudi from UK.”

71. In his affidavit dated 1 February 2016, Mr Vudathu states:

“I am one of the founders of [Forum]. Myself and Miss. Kalyani Inempudi (Kalyani) from UK and Mr. Venkatarama Mondeddu (Venkat), Mr. Venkat

Adusumalli (Adusumalli), Mr. Suresh Karothu (Suresh), Mr. Partha Chaitanya Pabbu (Partha) from USA founded the non-profit organization Telugu NRI Forum worldwide, in Feb 2014.”

He goes on to state:

“The name Telugu NRI Forum was suggested by Venkat during our group discussions. The words Heritage, Prosperity, Transparency and their equivalent translations in Telugu language script Samskruti, Pragati, Swachatha was the idea of mine. The background Indian Folk Art (Rangoli/Muggulu) was the idea of Kalyani. The ring around female figure was the idea of Adusumalli. The female figure representing the mother of Telugu language was the idea of Suresh, which is part of the initial logo designed by him for [Forum]. We took [Dr Vemuri’s] help and passed all the above information to him and his graphic designer. The graphic designer created the image for us.”

72. Exhibited as Document 1 to Mr Alluri’s affidavit dated 9 February 2016 are a number of screenshots. At pages 8 to 12 are extracts of what appears to be Corp’s Facebook messenger page. These include the following exchange of messages which I present as written:

“9 March 2014

Venkat Mondeddu: Anyone has the logo that suresh sent? (It is followed by another post from him showing a logo which, whilst clearly not the same, has a good deal of similarity to the logo the subject of these proceedings.)

...

Sekhar Vemuri: Do you need small logo but same photo. I will ask web designer now.

Venkat Mondeddu: Yes

Chandrasekhar Buddha: Yes small logo. let me upload default logo so that designer can create logo with same size

Venkat Mondeddu: Thanks Sekhar garu for pitching in

Sekhar Vemuri: can u please upload to doctor@asianlite.com he will be able to do and send asap, You both working hard, I should say to you

Chandrasekhar Buddha: we need 300 px width \* 100 px height

Venkat Mondeddu: logo sent to ur email Sekhar garu

...

Kal Inam: shekar garu 3 words for logo (just spoken Ramesh) heritage, prosperity, transparency

Ramesh Vudathu: In Telugu they can be translated as Sanskriti, Pragatu, Swatchatha

Sekhar Vemuri: Sounds nice. We will go launching auspicious day like kiran or Pawan party

...

10 March 2014

Kal Inam: both @shekar vemuri garu@ did u liked those 3 words? Given by ramesh garu last night? If yes v can add them in the logo chalo tttyl

Sekhar Vemuri: Sure web doing both Telugu and English. He will send by today Please get ready the content 12<sup>th</sup> March date is auspicious launch on same day with the content Aim for both Telugu regions

...

Ramesh Vudathu: Sekhar Garu thx for ur efforts. I will send 200 words today for firm registration and also will pay the money for it. Please our PRAGATI as

the first word. Please put PRAGATI as the first word. Pragati Sanskriti Swatchatha”

73. At pages 13, 14 and 15 are copies of various emails. The first is dated 17 March 2014 and is an exchange between doctor@asianlite.com which, it is not disputed, is Dr Vemuri’s email address and Mr Vudathu. It states:

(From Mr Vudathu)

“If you don’t mind try to get the logo today. I shall order the banners immediately after that. Regards...”

(Response)

“Sure Ramesh gaaru”

74. The other emails were sent from Mr Vudathu to Mr Adusumalli, Mr Partha, Mr Mondeddu, Mr Inam, Mr Korothu, Mr Buddha and doctor@asianlite.com. The first is dated 17 March 2014, shows a logo with similarities to the logo at issue in these proceedings and states:

“Team, Please find attached a very good logo designed by Sekhar Vemuri garu. Please let me know your comments and feel free to use it for our Telugu NRI Forum.”

The second is dated 18 March 2014 and shows three slightly different but very similar logos. The text states:

“First logo has swastika. Second one has temple and ongole gitta along with muggulu design inside (as asked by adusumalli garu) third one has muggulu inside the design (behind telugu talli). Any more ideas? I like the second one :) Thanks Sekhar garu for his efforts.”

It is clear from the above exchanges that Dr Vemuri had some, albeit brief, contact with others who are said to members of Corp regarding logos.

75. Exhibited to Mr Alluri's affidavit of 3 June 2016 is a USB stick. It contains what Mr Alluri describes as "a video "Surya Prakash Whom So Ever letters Comparison"". The video essentially calls into question the authenticity of the document referred to above which forms page 12 of Exhibit A of Dr Vemuri's witness statement dated 14 March 2016 which is the signed statement of Mr Rao. Amongst other things, the video notes that differing fonts are used in the document, particularly in relation to the reference to Forum's name.

76. Whilst I understand Corp's concerns, I do not consider it necessary to make a determination on this point. This is for two reasons. First, as I indicated above, the exhibited document is not an original but a copy. Secondly, despite it indicating it was signed by Mr Rao on the same day as the exhibited agreement between him and Dr Vemuri, the two documents are fundamentally at odds with each other. The agreement indicates Mr Rao is working for Dr Vemuri (with the ownership of the logo residing with Dr Vemuri) whereas the letter indicates Mr Rao is working for Forum and the logo is the property of Forum. Mr Rao has also filed evidence in these proceedings. He states that he received his instructions from Dr Vemuri and entered into a contract with him "to formalise our arrangement and my instructions". He exhibits a copy of the agreement and the letter which appear identical to those exhibited by Dr Vemuri. Neither Dr Vemuri nor Mr Rao give any explanation for the apparent discrepancy between the two documents and it is not otherwise explained in any other part of the evidence. Forum's own evidence is therefore in direct contradiction with itself. Neither am I persuaded by the evidence in the form of the payment slip given the indication on it that the transfer of money was for family maintenance and savings. In contrast, Corp's evidence shows that Dr Vemuri was in contact with a number of its officers in early March 2014 in relation to the design and creation of the logo and that various people within Corp were aware that Dr Vemuri was liaising with a designer to create a logo. Whatever Mr Rao may have been told by Dr Vemuri does not necessarily reflect the true position and, from Mr Rao's letter and the agreement that both Mr Rao and Dr Vemuri signed (both documents dated the same day) it appears that the position on ownership even between the two of them was not clear. Whilst the evidence before does not enable me to find that the ownership of any copyright vests with Corp, when taken as a whole, I do not consider that Forum has established, even on the balance of probabilities, that it

owns the copyright in the mark and its objection under section 5(4)(b) of the Act is dismissed.

## **Summary**

77. Corp's opposition to Forum's application under no 3099108 brought on grounds under section 5(4)(a) of the Act fails. Subject to any successful appeal, the application will proceed to registration.

78. Forum's opposition to Corp's application under no 3099266 brought on grounds under sections 5(1), 5(2)(a), 5(2)(b), 5(3), 5(4)(a) and 5(4)(b) of the Act fails. Subject to any successful appeal, the application will proceed to registration.

## **Costs**

79. Two separate case management conferences ("CMC") took place during the pendency of the proceedings. The first was appointed to provide directions to both parties as to the conduct of proceedings and I do not propose to favour either party with an award of costs in respect of it. The second was as a result of Forum's request for an extension of time to file evidence. That request was granted despite Corp's objection to it. The CMC itself was brief and the issue was not a complex one and I do not propose to favour either party with an award of costs in respect of it. In the substantive proceedings, neither party has been successful in its respective opposition. Whilst Forum's opposition was based on many more grounds than those of Corp, taking into account the nature of the evidence filed, I do not consider this materially affects my decision that each party should pay its own costs in the substantive proceedings.

**Dated this 8th day of March 2017**



**Ann Corbett**

**For the Registrar**

**The Comptroller-General**