

O/1111/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003597639

BY MOHAMMED HAMZA

TO REGISTER



IN CLASS 29

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 426827 BY

KILLINGHAMS INVESTMENTS LTD

BACKGROUND AND PLEADINGS

1. On 19 February 2021, Mohammed Hamza (“the applicant”) applied to register the trade mark shown on the cover of this decision (“the applicant’s mark”) in the UK for the following goods:

Class 29: Milkshakes; Burgers; Chicken burgers; Meat burgers; Vegetable burgers; Meat products being in the form of burgers.

2. The applicant’s mark was published for opposition purposes on 11 June 2021 and, on 13 September 2021, it was opposed by Killingham Investments Ltd (“the opponent”). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under the 5(2)(b) and 5(3) grounds, the opponent relies upon the following mark:

HOLLYWOOD SHAKES

UK registration no. 2580215

Filing date 5 May 2011; registration date 21 October 2011

Relying on some goods only, namely:

Class 29: Meat, fish and poultry; milk and milk products; milkshakes; flavourings for milkshakes; milk-based drinks; milk-based desserts.

3. In respect of the 5(2)(b) ground, the opponent pleads that the goods in the applicant’s specification are identical and/or highly similar to the goods relied upon. Further, the opponent pleads that the parties marks are “identical and share visual similarity”. Under the question wherein the opponent was asked to give details as to why it considered there to be a likelihood of confusion between the marks at issue, the opponent stated that as a result of the above, consumers would select the goods of the applicant on the mistaken belief that they were visiting the opponent. The opponent claims that this would result in loss of business for the opponent and allow for the applicant to ride on the coat-tails of the opponent’s brand. Such arguments are those that one would expect to see under 5(3) and

5(4)(a) grounds, not under 5(2)(b). On this point, the opponent has not expressly pleaded the existence of a likelihood of confusion. However, by virtue of relying on the 5(2)(b) ground, I will proceed on the basis that it has adequately pleaded such.

4. Under the 5(3) ground, the opponent claims to have a reputation in the goods relied upon and that the relevant public would strongly link the applicant's mark to the opponent's due to their levels of identity/similarity. As a result, the opponent claims that the applicant will gain an unfair advantage from the distinctive character and repute of the opponent's mark. Further, the opponent claims that use of the applicant's mark will cause detriment to the reputation of the opponent's mark and to the distinctive character of the same.
5. Lastly, under the 5(4)(a) ground, the opponent relies on the unregistered trade mark of 'HOLLYWOOD SHAKES' which it claims to have used throughout the UK since 5 May 2011 in respect of the following goods:

Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products, edible oils and fats; prepared meals; soups and potato crisps; milkshake; flavourings for milkshakes; milk-based drinks; milk-based desserts.

6. The opponent claims that as a result of the use of its 'current get-up' since 2011, it has built up a substantial level of goodwill and reputation in the UK. If the applicant is permitted to use his mark, the opponent claims that it would misrepresent to consumers that the goods of the applicant originate or are associated with the opponent. As a result of this misrepresentation, the opponent claims that it will suffer damage through diversion of sales.
7. The applicant filed a counterstatement wherein he made some concessions in respect of the goods at issue and the similarity of the marks at issue. I will deal with these points where necessary below. Those concessions aside, the applicant

maintained his denial of all of the claims against his mark and requested that the opponent provide proof of use in respect of its mark.¹

8. The opponent is represented by Trademark Legal Ltd and the applicant is represented by Alison Law Solicitors. Both parties filed evidence. No hearing was requested and neither party elected to file written submissions in lieu. This decision is taken following a careful perusal of the papers.
9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

10. The opponent filed evidence in the form of the witness statement of Mr Anjam Saddiq dated 6 September 2022. Mr Saddiq is the director of the opponent's legal representative and is, therefore, duly authorised to file evidence on its behalf. Mr Saddiq's evidence is accompanied by five exhibits, being those labelled HS1 to HS5.
11. The applicant's evidence came in the form of the witness statement of Mr Mohammed Hamza dated 5 October 2022. Mr Hamza is the applicant in these proceedings and his statement is accompanied by twelve exhibits, being those labelled MH1 to MH12.
12. I do not propose to summarise the parties' evidence here. However, I have taken them all into consideration in reaching my decision and will refer to them below, where necessary.

¹ In the event that the opponent failed to prove use of its mark, the relevance of the concessions referred to here will fall away.

DECISION

Proof of use

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

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

(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.”

14. The relevant statutory provisions are as follows:

“Section 6A

“(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 relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(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 relevant period 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

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

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

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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.”

15. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

16. Given its filing date, the opponent’s mark qualifies as an earlier trade mark under the above provisions. The opponent’s mark completed its registration process over five years prior to the filing date of the applicant’s mark and given that the applicant requested proof of use, it is subject to the proof of use requirements.

17. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV*

[EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

18. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the opponent's mark is the 5-year period ending with the

filing date of the applicant's mark, being 19 February 2021. Therefore, the relevant period for this assessment is 20 February 2016 to 19 February 2021.

19. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real"² because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark" is, therefore, not genuine use.

20. As I have discussed above, the opponent relies on the mark subject to proof of use under both its 5(2)(b) and 5(3) grounds. Therefore, if it fails to provide proof that it has genuinely used its mark, its reliance upon both grounds will fail leaving only the 5(4)(a) ground (which is not reliant upon any earlier registered mark but, instead, an unregistered earlier right).

Form of the mark

21. The narrative evidence before me make reference to the opponent's business as 'HOLLYWOOD MILKSHAKES'. Further, there are repeated images of the following sign throughout the evidence:



22. There does not appear to be any evidence before me regarding the use of the mark actually relied upon, being 'HOLLYWOOD SHAKES'. In respect of the form of the mark, I have reservations as to whether the variant use shown above would be an acceptable variant use (in accordance with *Lactalis McLelland Limited v Arla Foods*

² *Jumpman* BL O/222/16

AMBA, BL O/265/22) for all of the goods relied upon. However, as it represents the opponent's best case I will proceed on the basis that it is an acceptable variant.

Sufficient use

23. Before assessing the evidence before me, I consider it necessary to discuss the way in which the opponent has referred to the relevant period throughout its evidence. It appears to me the opponent considers the relevant period to be between 2011 and 2022. I say this on the basis that when reproducing its turnover figures between 2011 and 2022, the evidence explains it as being “turnover in royalties in the relevant period”.³ Further, when claiming to have undertaken publicity efforts, the opponent has provided an article from 2014 that the evidence refers to as being “in the relevant period”.⁴ As above, the relevant period is 20 February 2016 to 19 February 2021 so plainly the assertion of the relevant period by the opponent is incorrect. As such, I will treat the opponent’s references to activities within the relevant period with caution. For the sake of clarity throughout the remainder of this decision, I will refer to the opponent’s incorrectly claimed relevant period as simply “the claimed period”.

24. The opponent’s evidence sets out that it began using its mark at its Bradford store in May 2011. By 2017, the opponent expanded to locations in Leeds, London and Manchester but doesn’t specify precisely when each venue opened. These locations are repeatedly referred to as shops or stores but having considered the Twitter evidence of the opponent,⁵ it appears as though the opponent operates as a restaurant or venue called ‘Pasha’. Despite this, the evidence does include references to goods sold under the opponent’s mark. For example, I note that the post shown in the Twitter evidence is confirmed as being posted for the purpose of promoting the opponent’s ‘Hollywood Milkshakes’ brand at its Leeds branch. This post is dated 21 July 2017, being within the relevant period, and while it does not show a full menu of goods offered, it does make reference to goods such as milkshakes, desserts, waffles, crepes, sandwiches, hot drinks, mocktails and hot

³ See paragraph 5 of the witness statement of Mr Saddiq

⁴ See paragraph 4 of the witness statement of Mr Saddiq

⁵ HS2

food. I accept that this evidence is capable of demonstrating the range of goods sold under the opponent's branding during the relevant period, it appears to only have one re-tweet and no likes or comments. Therefore, beyond its assistance in demonstrating goods offered, its value as a promotional or marketing activity (which, as per the narrative evidence, was the reason for its inclusion in the evidence) is very limited.

25. Throughout the evidence, reference is made to the fact that the opponent sponsors world champion boxer Amir Khan. In support of this, the opponent has provided images from a boxing match wherein the opponent's branding appears on Amir Khan's shorts (as well as a range of other brands).⁶ Following these images (but within the same exhibit) is a write-up which confirms that Mr Khan is a brand ambassador for the opponent. However, beyond this, the write-up is not legible due to the quality of the copy provided. Turning back to the images, this fight is confirmed in the narrative evidence as having taken place on 3 May 2014, being before the relevant period. In addition to this evidence, the opponent has provided a print-out of a Daily Mail article which discusses the same fight as shown in the aforementioned photographs and confirms that it took place in Las Vegas, Nevada.⁷ This is outside of the relevant territory for all of the grounds relied upon under the present opposition. On this point, I note that there is nothing in the evidence to suggest any further promotional activities (involving Mr Khan or otherwise) during the relevant period. This evidence is, therefore, of no assistance here.

26. The evidence sets out that while the business began by selling milkshakes, by the time the Leeds branch was open, it diversified into selling a wide variety of food and drink products ranging from cooked beef, fish and chicken burgers. This is supported by the list of food and drink on the Twitter post discussed above and, further, a copy of the opponent's menu is provided that the narrative evidence states as showing the full range of products offered at all of the opponent's stores.⁸ Having considered the menu, I note that it shows for sale beef burgers, milkshakes,

⁶ HS1

⁷ HS5

⁸ HS3

fries, drinks and cheesecake desserts. In further support of the additional goods offered at the stores, I note that an image of a box of frozen chicken burgers which bears the wording 'HOLLYWOOD SHAKES' is provided.⁹ The narrative evidence confirms that this was used throughout the relevant period.

27. The opponent then discusses its turnover in royalties during the claimed period. Despite the fact that the majority of the turnover is irrelevant to the present assessment, I have reproduced it in its entirety below.

| Year | Turnover (£) | Year | Turnover (£) |
|------------------|---------------|------------------|----------------|
| 2011/2012 | 5,250 | <u>2017/2018</u> | <u>36,520</u> |
| 2012/2013 | 7,500 | <u>2018/2019</u> | <u>37,625</u> |
| 2013/2014 | 15,545 | <u>2019/2020</u> | <u>38,196</u> |
| 2014/2015 | 27,365 | <u>2020/2021</u> | <u>19,835</u> |
| 2015/2016 | 33,892 | 2021/2022 | 44,928 |
| <u>2016/2017</u> | <u>33,892</u> | Total: | 300,548 |

28. Of the above figures, only those I have underlined are relevant to the present assessment. I have calculated these figures as covering £166,068 in 'royalties'. On this point, I note that the reference to the years covered are vague (2016/2017 and 2020/2021) and I have no way of determining what dates each year covers. As a result, it is likely that some of the figures for 2016 and 2021 fall outside of the relevant period. While I have no way to determine precisely how much, this is an issue I will bear in mind in my overall assessment of use.

29. The narrative evidence sets out that the opponent has generated publicity in the form of articles which appeared in national newspapers and worldwide TV screens during the claimed period. This is a relatively broad statement that is only supported by the provision of one article, being the Daily Mail article regarding Amir Khan that I have discussed above. The article itself is undated but, as above, the narrative evidence confirms that the fight took place in 2014, being before the relevant period. Given that the article appears to be a report on that fight, it is likely

⁹ HS4

that it was published at around that time. Even ignoring the fact this evidence is from prior to the relevant period, I am not entirely sure that the fact that Mr Khan's shorts have the opponent's branding on them (along with other brands) is something that will be noticed by anyone reading the article, thereby limiting its evidence here.

30. In further support of the opponent's claim to undertake promotional activities, the narrative evidence sets out that its advertising spend was roughly £100,000 during the claimed period. Given my issues with the opponent's claimed period, I am not willing to accept that the reference to an expenditure of £100,000 covers the relevant period at issue. Instead, I consider it reasonable to suggest that it covers the entirety of the opponent's advertising spend between 2011 and 2022. As such, only a portion of this spend will be relevant here. However, I have no way to determine how much.

Conclusions on use

31. While I have no evidence on the issue of the relevant market in the UK for the goods at issue, it is my view that it is likely to be a very large one involving frequently purchased goods that attract a high volume of sales with. I would estimate, a turnover of upwards of a billion pounds per annum. As a starting point, £166,068 in total turnover over a five year period reflects a low level of turnover in comparison to the size of the market at issue. I appreciate that, as set out in the case law cited above, evidence of use need not be quantitatively significant in order for it to be genuine. However, the scale of the use before me is not the primary issue facing the opponent. In considering the evidence before me, I am of the view that the primary issue relates to the fact that the turnover referred to is not broken down in any way. I consider this to be a particularly problematic issue on the basis that the evidence shows that the opponent operates a business that sells a wide range of goods that goes beyond the goods covered by the opponent's specification. I will explore this issue in more detail below.

32. As I have discussed above, the opponent's narrative evidence confirms that it sells beef burgers, chicken burgers and fish burgers. In addition, the Twitter post

provided demonstrates that it sells milkshakes, desserts, waffles, crepes, sandwiches, hot drinks, mocktails and hot food. Lastly, I note that the opponent has provided a copy of its menu which, for illustrative purposes, is as follows:



33. Clearly, the goods offered by the opponent cover a broad range of drinks and foodstuffs. Such a broad array of goods renders my assessment of genuine use somewhat difficult on the basis that the goods sold by the opponent cover a wider range of goods than those covered by the opponent’s specification. On this point, I remind myself that the goods for which the opponent is required to prove use are “meat, fish and poultry”, “milk and milk products”, “milkshakes”, “flavourings for milkshakes”, “milk-based drinks” and “milk-based desserts”.

34. Based on the evidence before me, the opponent clearly offers milkshakes for sale. However, this is the only good offered that can be said to fall within the opponent’s specification. The mark is not registered for fries, drinks (specifically those covered in the above menu) or mocktails. Further, there is no clarification as to what goods are precisely covered by the Twitter account’s reference to desserts, hot drinks sandwiches or hot food. While the desserts or hot drinks may be milk-based and, therefore, potentially of assistance, I have nothing to confirm whether they are or

not. Without anything confirming this in the evidence, I am not willing to infer as such as they could equally be non-milk based desserts/drinks. To make such an inference would, in my view, be purely speculative and unreasonable.

35. In respect of the opponent's claim to sell beef, chicken or fish burgers, I am not convinced that these are covered by the specification at issue. I appreciate that the mark is registered for 'meat, fish and poultry' and while beef, chicken and fish burgers clearly contain meat, they are the finished articles that are likely include other types of foodstuffs such as buns, cheese, sauces and other toppings with the latter two being items specifically offered in the above menu. So while the burgers offered by the opponent may share a degree of similarity with "meat, fish and poultry", that is not the test I must apply here. On the contrary, I consider that these products fall within two distinct categories of goods. As such, sales of burgers in a restaurant or takeaway setting is not the sale of "meat, fish and poultry" and, therefore, the reliance upon the sale of burgers (be that beef, chicken or fish) is of no assistance to the opponent.

36. As for the range of dessert goods offered, I do not consider that cheesecakes, waffles or crepes are milk-based desserts. I appreciate that these desserts may contain milk or other forms of dairy (which may be created from milk) as ingredients. However, I do not agree that simply because a dessert may contain milk, it is a 'milk-based dessert'. If it was, this would offer far too broad a level of protection for the term, especially given the wide variety of desserts that consist of milk or dairy ingredients that exist in the marketplace. As such, I do not consider the offer of these goods for sale by the opponent is of any no assistance here.

37. Circling back to the turnover figures provided, I remind myself that, as a starting point, the turnover figures of £168,068 represent a low level of sales. Again, I repeat what I have above in that use need not always be quantitatively significant. However, this turnover reflects the entirety of the opponent's business and is not broken down in any way. This is a significant issue on the basis that the goods offered for sale, as discussed in detail above, go beyond what is covered by the opponent's specification. As such, the £166,068 turnover during the relevant period can be said to stem from sales associated with beef burgers, chicken burgers, fish

burgers, milkshakes, desserts, waffles, crepes, sandwiches, hot drinks, mocktails, hot food, cold drinks, fries and cheesecakes. Without any breakdown of these figures and how they relate to the goods sold, it is not possible for me to accurately determine the level of sales before me. Therefore, I am unable to determine how much sales have stemmed from actual goods that are covered by the opponent's specification.

38. In respect of this issue, I remind myself not only of section 100 of the Act (cited above) but the case of *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision,

what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

39. Additionally, I remind myself of the case of *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

40. In the present case, I am of the view that information as to the breakdown of sales made by the opponent’s business is likely to have been known to the opponent and would have been readily available to it when compiling its evidence of use. In the absence of any breakdown of sales (and as suggested by the case law cited above), I am entitled to be sceptical of the evidence before me. On this point, I appreciate that there are instances wherein a Hearing Officer in proceedings before the Tribunal is able to collate various items of evidence in order to paint a picture of genuine use. However, in the present case, I do not consider that it is possible (or reasonable) for me to evaluate the evidence before me in order to determine the accurate the scope of protection that should be afforded to the opponent. Put simply, a turnover of £166,068 over five years for the wide range of goods that the opponent claims to sell is low and coupled with the fact that the majority of this turnover likely stems from sales of goods not included in the proprietor’s specification, I do not consider that it is sufficiently solid to assist the opponent’s case that it has genuinely used it mark.

41. While the turnover figures are not reflective of the entirety of evidence, the additional evidence provided is of very little assistance also. For example, there is evidence before me regarding promotion and advertising which contains just one example of an advertising attempt by way of sponsoring boxer Amir Khan. Even ignoring the fact that this is just one example, it occurred prior to the relevant period so is of no assistance. I also note that the opponent claims that its advertising spend was roughly £100,000. I have highlighted my issues with claimed period above and, as such, I am not content to conclude that this advertising expenditure relates solely to the spend during the actual relevant period. As such, it covers a

period of 11 years. Equating that to the relevant period at issue here, this is reflective of a very low level of expenditure.

42. Taking all of the above into account, I am not satisfied that the opponent has provided sufficiently solid evidence to support its claim that it has genuinely used its mark in relation to the goods at issue during the relevant period. As such, the opponent is not permitted to rely on its earlier mark for the same of the 5(2)(b) or 5(3) grounds. Therefore, the reliance upon those grounds fails.

43. As a result of the above, I now only have the 5(4)(a) ground to consider.

Section 5(4)(a)

44. Section 5(4)(a) of the Act reads as follows:

“(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) 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, where the condition in subsection (4A) is met,

(aa)

(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.”

45. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of

application for registration of the trade mark or date of the priority claimed for that application.”

46. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

47. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation¹ 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 indicium which is the same or sufficiently similar that the defendant’s goods or business are from the same source² or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which 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 claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (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 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.”

Relevant Date

48. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander Q.C., as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“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.’ ”

49. The applicant’s mark does not have a priority date. I note that the applicant has filed evidence that he began using his mark on 1 February 2021 when he opened his restaurant. The applicant has filed evidence of images of his store and screenshots taken from the business’s social media pages.¹⁰ While these images and screenshots are not dated, I have no reason to doubt that the applicant’s restaurant opened on this date and, therefore, it is an earlier date that is capable of being deemed the start of the behavior claimed about. The relevant date is, therefore, 1 February 2021. Having said that, I do not consider much turns on this as the filing date of the applicant’s mark (which, as set out in the case law cited above, would be the relevant date by default) is 19 February 2021, being just 18 days after the claimed first use.

Goodwill

50. The first hurdle for the opponent is that it needs to show that, at the relevant date, it had the necessary goodwill in its business and that the sign relied upon was distinctive and/or associated with that goodwill. Goodwill was described in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

¹⁰ MH1

“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.”

51. 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.”

52. 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.”

53. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

54. Before proceeding to consider goodwill, I remind myself that the applicant relies on the sign ‘HOLLYWOOD SHAKES’ that it claims to have used throughout the UK since 5 May 2011 for the following goods:

Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk

and milk products, edible oils and fats; prepared meals; soups and potato crisps; milkshake; flavourings for milkshakes; milk-based drinks; milk-based desserts.

55. Goodwill arises as a result of trading activities. I have discussed the full extent of the opponents' evidence when considering the issue of genuine use above. That same evidence is relevant here. In respect of the present ground, the issue surrounding the claimed period (being that which I have discussed at paragraph 23 above) remains relevant here, but only insofar as it relates to the earlier evidence prior to 20 February 2016 (being when the relevant period for my use assessment began). Given that the claimed period includes evidence from beyond 2021, it inevitably includes figures from after the relevant date

56. As a result of what I have said in the aforementioned paragraph, the scope of the turnover figures and advertising spend is expanded beyond just the five year period covered by the genuine use assessment. As a result, the turnover figures relevant to my consideration of the existence of goodwill stand at £255,620. This figure discounts sales from 2021/2022 on the basis that the relevant date falls in February 2021 and given that some 2021 figures are included in the 2020/2021 value provided, it is reasonable to assume that the 2020/2021 figures are sufficient. On this point however, it may be the case that some 2020/2021 figures fall from after the relevant date as I have no clarity as to precisely when these date ranges fall. As for the advertising spend, I remind myself of the applicant's claim that this totalled £100,000 but given that this was for the entirety of the claimed period, I am of the view that it is likely to include some spend after the relevant date, albeit not much.

57. I appreciate that the scope of trading activities before me under the present ground are at a higher volume and for a longer period of time than those relevant to the genuine use point discussed above. While that may be the case, the activities remain at a low level. On this point, I remind myself that small businesses which have more than a trivial goodwill can protect signs which are distinctive of those

businesses under the law of passing off even though the goodwill and reputation may be small.¹¹

58. Even taking account of what I have said in the preceding paragraph, the issue regarding the imprecise nature of the evidence in respect of the goods sold when compared against those relied upon remains relevant to the present ground. As such, I am of the view that the lack of clarity from the opponent is a significant issue to its claim to have accrued a protectable level of goodwill in its business as a result of sales associated with the goods relied upon. On this point, I note that the opponent relies on a broader range of goods than it did under the 5(2)(b) ground, however, this does not escape the imprecise and insufficiently solid nature of the evidence before me. For example, even if it could be said that burgers and fries fall within the term 'prepared meals',¹² it remains a significant issue for the opponent that it is not possible for me to determine the level of trading activities insofar as they relate to those goods.

59. So again, it may very well be the case that there exists a higher level of trade over a longer period of time under this ground. However, I cannot ignore the issue regarding the imprecise and vague nature of the evidence. Put simply, the evidence is entirely inconclusive as to the extent that the opponent's trading activities actually relate to the goods relied upon. When taking into account the issue with the lack of breakdown, I am not willing to find that the level of trading activities in the evidence before me can be said to relate solely to the goods relied upon. Further, I have no way to break down the turnover in such a way that would help me make such a determination in favour of the opponent. As a result, I am unable to conclude that the opponent enjoyed a protectable level of goodwill in its business as at the relevant date (be that 1 or 19 February 2021).

60. Without the existence of a protectable level of goodwill, there can be no misrepresentation. Therefore, the opponent's reliance on its 5(4)(a) ground fails.

¹¹ See, for example, *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590

¹² My primary position is that they do not. This is on the basis that a prepared meal is a pre-packaged complete meal that requires no preparation besides heating it up in a microwave or an oven. While burgers and/or fries may form part of a completed and prepared meal, they are not sold as such. On this point, I have no evidence before me to suggest that the sale of burgers and fries in the form of prepared meals is common in the trade to the point that it could reasonably be said that 'prepared meals' covers burgers and fries.

CONCLUSION

61. The opposition has failed in its entirety and the applicant's mark may, subject to any appeal, proceed to registration for all of the goods applied for.

COSTS

62. As the applicant has enjoyed a greater degree of success, he is entitled to a contribution towards his costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£700** as a contribution towards his costs. The sum is calculated as follows:

| | |
|---|-------------|
| Considering the notice of opposition and filing a counterstatement: | £200 |
| Considering the opponents' evidence and preparing its own evidence: | £500 |
| Total: | £700 |

63. I hereby order Killingham Investments Ltd to pay Mohammed Hamza the sum of £700. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 23rd day of November 2023

A COOPER
For the Registrar