

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 1516333
IN THE NAME OF TRADELINK (LONDON) LIMITED**

AND

**IN THE MATTER OF AN APPLICATION FOR A
DECLARATION OF INVALIDITY (No 9466)
BY EAST END FOODS PLC**

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Declaration of Invalidity (No 9466) by
East End Foods Plc**

15
DECISION

On 12 March 1997 East End Foods Plc applied under Section 47 of the Trade Marks Act
1994 for a declaration of invalidity in respect of the following mark.



40 The mark is registered in Class 30 for a specification of goods which reads "saffron, spices,
tea, papads, papadams". The registration stands in the name of Tradelink (London) Ltd.

The grounds are in summary:

- 45
- (i) under Section 47(1) in that the mark was of such a nature as to deceive the public and was thus registered in breach of Section 3(3)(b)

(ii) also under Section 47(1) in that the application was made in bad faith and was registered in breach of Section 3(6)

5 (iii) under Section 47(2)(a) in that the mark was registered in breach of Section 5(2) having regard to the applicants' earlier trade mark.

Details of the earlier trade mark referred to above are as follows:

10	No	Mark	Class	Journal	Specification
15	1496198	RUBY	29	6013/1047	Meat; dried fish, poultry and game; meat extracts; fruit and vegetables, all being preserved, dried or cooked; jellies and dairy products; jams; eggs; milk; edible oils and edible fats; food preserves; pickles; lentils, dall, moong, moth; all included in Class 29

20 I should also say that both in their statement of grounds and at various points in the evidence the applicants refer to provisions of the old law, in particular Sections 11 and 12 of the Trade Marks Act 1938 and the tests applicable under those provisions. Paragraph 18(2) of Schedule 3 to the Trade Marks Act 1994 (Transitional Provisions) indicates that:

25 "(2) For the purposes of proceedings under Section 47 of this Act (grounds for invalidity of registration) as it applies in relation to an existing registered mark, the provisions of this Act shall be deemed to have been in force at all material times.

30 Provided that no objection to the validity of the registration of an existing registered mark may be taken on the ground specified in subsection (3) of Section 5 of this Act (relative grounds for refusal of registration: conflict with earlier mark registered for different goods or services)."

35 The proviso has no part to play in these proceedings but it is clear from the first paragraph that I must consider the matter on the basis that the provisions of the Act are deemed to have been in force. I do not, therefore, propose to make any further reference to the applicants' comments in relation to the old law.

40 The registered proprietors filed a counterstatement denying the above grounds and making a number of observations in relation to background circumstances notably the assignment of the earlier trade mark from the original applicants to the current proprietors (so far as I can see nothing turns on this point).

Both sides ask for an award of costs in their favour.

45 Only the applicants have filed evidence. The matter came to be heard on 28 April 1999 when Mr Doshi represented the registered proprietors and Mr T Mitcheson of Counsel instructed by

Forrester Ketley & Co represented the applicants.

Applicants' evidence

5 The applicants filed declarations as follows:-

Trilok Singh Wouhra - 10 October 1997

Christopher Anthony Symes - 29 October 1997

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Certain key dates emerge from the evidence and it will be convenient to set these out for ease of reference:

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- | | | |
|--------------|-----------------|---|
| 3 April 1992 | - | applicants' earlier trade mark (No 1496198) filed (and subsequently registered) |
| April 1992 | - | applicants say that they have used their mark from 'at least' this date |
| 20 | 20 October 1992 | - registered proprietors filed the mark now under attack |
| | 18 April 1995 | - applicants filed a new application in Class 30 which has the registered proprietors' mark cited against it. |

25 I do not propose to review the whole of Mr Wouhra's declaration the early part of which is concerned with background information which is either not in dispute or is not directly relevant to the issues before me. In relation to similarity of goods and having regard to the specification of the registered mark he makes the following observations:

30 "**Saffron** (covered by the Later Mark), is defined in the Oxford English Dictionary (OED) as a product of plant origin, and used for colouring and flavouring. There is now produced and shown to me marked "Exhibit TSW1", a copy of page 30 of the relevant section of the OED.

35 Saffron would therefore in my opinion be considered similar to **vegetables**, particularly dried vegetables, (covered by the Earlier Mark) because vegetables are defined as plants cultivated for food by the OED. There is now produced and shown to me, marked "Exhibit TSW2", a copy of page 73 of the relevant section of the OED. As an example, it is possible to obtain dried onions for culinary purposes and in particular for
40 use in flavouring.

Furthermore, dried vegetables are likely to be sold through similar trade channels as saffron, and manufacturers of saffron and such vegetables may well be in competition with one another.

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Spices, covered by the Later Mark, are also of vegetable origin (as defined by the OED), and should also be considered similar in my opinion to dried vegetables

(covered by the Earlier Mark). There is now produced and shown to me, marked "Exhibit TSW3", a copy of page 589 of the relevant section of the OED. Both spices and vegetables are used for culinary purposes and for adding flavour to a wide variety of dishes. Spices and dried vegetables are likely to be sold through similar trade channels.

Additionally, spices are also in my opinion similar to "pickles and food preserves" (also covered by the Earlier Mark), as both pickles and food preserves could also be used for adding flavour to culinary dishes, and both pickles and fruit preserves usually include a number of spices as ingredients.

Papads and papadams (covered by the Later Mark) are in my opinion similar to lentils (covered by the Earlier Mark). Lentils are a primary ingredient of papads/papadams. Papads/papadams would be likely to be sold through similar trade channels to lentils. There is now produced and shown to me marked "Exhibit TSW4", a copy of page 667 of the Oxford English Dictionary."

The remainder of Mr Wouhra's declaration is concerned with the applicant company's use of their mark RUBY. Much of it relates to the period after the material date in these proceedings, that is to say the filing date of the mark under attack (20 October 1992) and does not assist the applicants. Mr Wouhra does however give total company turnover for the year to 31 March 1993 (and thus spanning the period before and after the relevant date) as being £4,329,544 of which approximately one quarter (£1,082,386) is said to relate to products sold in relation to the trade mark RUBY.

Mr Wouhra says that the company spent £126,915 promoting their own brand goods in the year to 31 March 1993 and approximately a quarter of this relates to RUBY products. I should add that this information was contained in a clarificatory statutory declaration which I admitted at the hearing. He goes on to say that East End Foods have become well known in the trade for the production and sale of a wide variety of Eastern and Afro-Caribbean foods in relation to the mark. He exhibits samples of packaging and labelling material, a price list and promotional items (TSW5 to 8). The relevance of the material is doubtful and I note that earlier in his declaration (made in October 1997) he refers to the fact that the company "have recently through natural progression expanded the range of products sold by reference to this mark". I note also that Mr Symes refers to instructions received in March/April 1995 to file a new trade mark application in view of the applicants' "intention to produce a wider variety of goods for sale under the trade mark RUBY than was covered by their existing registration No 1496198". It seems from this that the trade prior to the material date was in the Class 29 goods only.

Mr Symes also deals at some length with the background to this action. Again this is not in dispute and does not need to be reviewed here. He goes on to deal with issues of similarity of goods drawing on the established JELLINEK test (63 RPC 59). I will deal with the tests to be applied later in this decision. He makes the following general observations on the respective sets of goods:

"As regards the nature and composition of the goods covered by the Earlier Mark and

by the Cited Mark, this test would appear to be satisfied on the basis that all of the goods are foodstuffs. Moreover, as regards the respective uses of the foodstuffs concerned, several of the goods covered by the Earlier Mark comprise a major component in Eastern/Indian cooking which, as mentioned above, is the primary area of interest to East End Foods. Similarly, saffron, spices, papads and papadams are also used specifically in connection with the preparation of such Eastern/Indian dishes, such that the "respective uses" test would also seem to be satisfied in respect of the goods. In summary, when preparing one of several Eastern/Indian meals, a number of goods covered by the Earlier Mark **and** a number of goods covered by the Cited Mark would be very likely to be used in conjunction with one another."

The remainder of Mr Symes' evidence deals with the results of visits to various supermarkets undertaken by his assistant to establish whether the respective goods would be sold through similar trade channels. A selection of photographs is exhibited as a result of these researches as follows:

- CAS 1 - photographs taken at Safeway in Harborne
- CAS 2 - photographs taken at Sainsbury's in Selly Oak
- CAS 3 - photographs taken at Safeway in Kings Heath
- CAS 4 - photographs taken at Sainsbury's in Kings Heath

The purpose of the photographs is to demonstrate that the parties' respective goods would be positioned adjacent, or in close proximity, to one another. I do not propose to itemise each and every example but the following will give an indication of the claims made - spices sold adjacent to edible oils and fats, and pickles; herbs/spices, papads, and papadams in close proximity to pickles; spices and saffron in close proximity to meat and poultry; papads and papadams close to edible oils and fats.

The conclusion Mr Symes asks me to draw is that the parties' goods are similar and as a result an objection should have been raised during the prosecution of the case.

That completes my review of the evidence.

Section 47(1) and (2) of the Act read as follows:

"47.- (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground -

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

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

10 unless the proprietor of that earlier trade mark or other earlier right has consented to the registration."

The objections under Sections 3(3)(b) and 3(6) were not pursued at the hearing.

15 Mr Mitcheson suggested that the former which was linked with a reference to Section 11 of the 1938 Act should have referred to Section 5(4) having regard to the applicants' use. I do not think the matter could have been considered on that basis absent a clarifying amendment to the statement of grounds. In the event the application fails on both the Section 3 grounds.

20 The main ground of objection is in relation to Section 47(2)(a) in that the applicants say they have an earlier trade mark to which the conditions set out in Section 5(2) apply. It is immediately apparent that the respective marks are not identical so it is in fact paragraph (b) of Section 5(2) which I need to consider. This reads.

25 "(2) A trade mark shall not be registered if because -

(a)

30 (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

35 Mr Mitcheson took me to a number of cases in support of his submissions.

The correct approach to the interpretation of the expression "a likelihood of confusion on the part of the public" as used in article 4(1)(b) and section 5(2) was considered by the European Court of Justice in Case C-251/95 *Sabel BV v. Puma AG, Rudolf Dassler Sport* [1998] R.P.C. 199. The way in which the presence or absence of a "likelihood of confusion" should be assessed was identified in paragraphs 23 and 24 of the judgment of the court at 223:

45 "... Article 4(1)(b) of the Directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign,

of the degree of similarity between the trade mark and the sign and between the goods or services identified'. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

5 That global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - 'there exists a likelihood of confusion on the part of the public' - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

15 In that perspective, the more distinctive the earlier mark the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that the two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public."

20 I also find the following observations of Geoffrey Hobbs QC (sitting as the Appointed Person in BALMORAL Trade Mark 1999 RPC 297) useful in relation to the approach to be adopted:

25 "The tenth recital to the Directive and these observations of the Court of Justice indicate that an objection to registration under section 5(2) of the Act should be taken to raise a single composite question: are there similarities (in terms of marks and goods or services) which would combine to create a likelihood of confusion if the "earlier trade mark" and the sign subsequently presented for registration were used concurrently in relation to the goods or services for which they are respectively registered and proposed to be registered?"

30 Finally as regards the general considerations to be borne in mind it is useful to record the following part of the European Court of Justice's judgment in Canon Kabushiki Kaisha v MGM Inc reported in 1999 RPC 117:

35 "22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.

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

The passage quoted above from Sabel v Puma indicates that the more distinctive the earlier mark the greater will be the likelihood of confusion. Before turning to the evidence and submissions I will consider briefly whether the applicants' mark can be said to have "a particularly distinctive character, either per se or because of the reputation it enjoys with the public". In a further passage in Sabel v Puma (at page 224 line 25 et seq) it was noted that:

"However, in circumstances such as those in point in the main proceedings, where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion."

The applicants' mark is a dictionary word and it is not accompanied by any other matter which might serve to give it an added imaginative content. The inherent characteristics of the mark are not such, in my view, as might give rise to any special consideration. In terms of recognition of the trade mark on the market Mr Wouhra says that:

"East End Foods have become well known in the trade for the production and sale of a wide variety of Eastern and Afro-Caribbean foods in relation to the Trade Mark, such as meat and non-meat cooking pastes, lentils, mangos, callaloo, basmati rice, urid beans, chana dall, split peas, split lentils, moong, milk powder, green pista, papads, papadams (including green chilli, garlic, madras, punjabi masala, black pepper, plain, jeera papads) (hereinafter referred to as "the Goods")."

This suggests that the applicants' business has developed in such a way that their reputation may now extend to a wider range of goods within the Eastern and Indian food trade. Had such a reputation been established at the material date in these proceedings (20 October 1992) it might have assisted their case under Section 5(2). But on the evidence before me the applicants only started to use their RUBY mark in or about April 1992 that is to say just 6 months before the registered proprietors filed their application. It is by no means clear what goods the mark was applied to at that time. I can only assume that it was goods within their Class 29 specification. Mr Wouhra's above comments in relation to development of his company's trade (his declaration was made in October 1997) appear to relate to later events. This is consistent with the fact that their new application was not made until 18 April 1995 and Mr Wouhra's comment that East End Foods "have recently through natural progression expanded the range of products sold by reference to their mark" (my emphasis). In short I approach the matter on the basis that the earlier mark does not have a particularly distinctive character in the sense of meriting a wider ambit of protection either per se or because of the reputation established at the relevant date.

Mr Mitcheson submitted in relation to the respective marks that the word RUBY was the key element by which the registered proprietors' mark would be known and that the star device was a common feature in marketing. I do not think I should so easily dismiss the totality of the registered proprietors' mark. The device element with the letter R at its centre creates a strong visual image and is a feature which is unlikely to be ignored by customers. Nevertheless within the context of the composite test the registered proprietors might still face some difficulty if their case rested solely on the ability of their mark to distinguish their goods from those of the applicants.

It was not altogether surprising, therefore, that submissions at the hearing concentrated primarily on issues to do with the goods. Mr Mitcheson rightly conceded that no objection arose in relation to 'tea'. He, therefore, put his case on the basis of a comparison of the remaining goods in the registered proprietors' specification with various items within the specification of the applicants' earlier mark. In doing so he reminded me that it was sufficient if the applicants established the possibility of confusion. The above extract from Canon v MGM refers to particular factors which need to be taken into account in assessing similarity. Mr Mitcheson referred me also to the Registry's Work Manual and the following passage from British Sugar plc v James Robertson & Sons Ltd (the TREAT case), 1996 RPC 281, (and recognising that TREAT must be read in the context of Canon v MGM):

"Thus I think the following factors must be relevant in considering whether there is or is not similarity:

- (a) the respective uses of the respective goods or services;
- (b) the respective users of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the respective trade channels through which the goods or services reach the market;
- (e) 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;
- (f) 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."

As a general proposition Mr Mitcheson submitted that both parties' goods fell within the heading of Indian or Eastern foodstuffs. He supported this general view of the matter by a number of more particularised claims based on particular items in the respective specifications. As a result it is said that the uses and users of the goods are the same. Although the parties' goods do not share any very obvious physical characteristics it is nevertheless contended that pickles, for instance, may incorporate spices, and lentils are a primary ingredient in papads/papadams. The applicants say that trade channels overlap both at the manufacture, wholesale and retail levels. The photographic evidence from supermarkets is said to support the view that the respective goods would be co-located or sited in adjacent areas of stores. Furthermore certain of the goods are closely associated in the sense that they complement, or are used with, one another.

There are some attractions in following Mr Mitcheson's line of argument and at a high level of generality there is no doubt that there would be users in common for the respective goods.

But there are inherent dangers in trying to identify general headings which might serve to encompass goods which in other respects would be considered to have little in common. Thus the suggestion that saffron and spices on the one hand and dried vegetables on the other are similar because they are both of plant origin seems to me to be a wholly unreliable basis for considering the matter. Nor can I conceive that the average consumer would regard them as similar simply because they contribute to flavouring or can be used as flavourings. As most foodstuffs contribute to flavouring in some way this would bring very broad categories of otherwise disparate foodstuffs into conflict. In practice the uses and physical characteristics of saffron and spices are quite distinct from any of the goods covered by the applicants' specification. By the same token I cannot see that papads and papadams have anything in common with the applicants' goods. I note that lentils are said to be a primary ingredient of papads/papadams but that in itself does not take the applicants very far (cf Spillers Ltd's application, 1953 RPC 51 where flour and bread were held to be different goods). More generally the terms 'lentils, dall, moong, moth' in the specification of the applicants' own registration can, it seems, broadly be characterised as pulses. As such they do not appear to have anything much in common with the goods of the registration under attack.

In terms of trade channels the applicants mainly rely on the photographs taken at retail sites. It may well be that there is some overlap at the wholesale level (many quite different goods will share this trade connection) but I am not persuaded that there is a proven link at the manufacturer/producer level. I note that Sharwoods sell (condiment) pickles and papadams but for reasons which I will elaborate on below I do not think this establishes the proposition put forward by the applicants.

I have recorded in the evidence summary some of the examples of adjacently displayed goods identified by the applicants as a result of visits to various supermarkets. Some of the examples seem to me to be quite hopeless in furthering the applicants' argument (spices sold opposite fish and poultry for instance). The high point of their case is in my view the supermarket displays showing groupings of items associated with Indian cooking. Thus papads, papadams and spices can be seen displayed on shelves in close proximity to various pickles and chutneys. Even so this does not in itself establish that there will be confusion between spices which are normally sold in whole or ground form for use in the cooking process and pickles or chutneys which serve as an accompaniment to a meal. There is a further difficulty from the applicants' point of view. The 'pickles' of their Class 29 specification would be pickled vegetables (such as pickled onions, pickled beetroot etc) and not chutney-like foodstuffs which, as prepared condiments, are proper to Class 30. I do not accept Mr Mitcheson's submission that pickled vegetables include condiments because a chutney may, for instance, include a chopped onion. Although it is true that chutney type condiments may include fruit or vegetables such as onions they are quite different in nature to pickled fruit or vegetables and the evidence does not support the claim that manufacturers might be expected to be in both areas of trade or that retailers place them together on the shelves. The sort of retail trade connection the applicants seek to make is not, therefore, apparent on the basis of the information before me.

The final TREAT criterion relates to whether the goods are in competition with each other. In my view they are clearly not. They serve different purposes and would not represent alternative or substitute purchases for customers. Although it is said that items such as papadams and pickles are complementary in the sense that one is often eaten with the other,

for the reasons given above I do not consider that the applicants' specification covers condiment type pickles and in any case applying such a test could, I think, produce some rather improbable results.

5 In summary I can see nothing on detailed comparison of the respective goods which leads me to the conclusion that the applicants invite me to accept. The applicants' more recent trading activity does appear to bring them into areas which results in overlap between the goods but this does not assist them at the relevant date in these proceedings. I, therefore, find that in terms of the tests and guidance contained in the reported cases referred to the mark in suit was
10 not registered in breach of Section 5(2) having regard to the applicants' registration in Class 29.

As the registered proprietors have successfully defended their registration they are entitled to a contribution towards their costs. I order the applicants to pay them the sum of £435.
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Dated this 14th day of May 1999

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M REYNOLDS
For the Registrar
the Comptroller General