

O/206/21

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF REGISTRATION NO. 2530242  
IN THE NAME OF KEITH GRAHAM FOR THE MARK:

**RASTA PASTA**

IN CLASS 30

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY AND  
REVOCAION UNDER NOS. 502754 & 502755 RESPECTIVELY

BY DRAGON CORP LIMITED

AND IN THE MATTER OF TRADE MARK APPLICATION NOS. 3374192 &  
3374193 BY DRAGON CORP LIMITED FOR THE RESPECTIVE MARKS:

**MANJAROS – RASTA PASTA**

&

**MANJAROS – RASTA RICE**

AND AN OPPOSITION THERETO UNDER NOS. 416410 & 416405  
BY KEITH GRAHAM

## Background and pleadings

1) Keith Graham (“KG”) is the registered proprietor of trade mark registration no. 2530242 for the mark **RASTA PASTA**. The trade mark was filed on 29 October 2009 and completed its registration procedure on 5 February 2010. It is registered in respect of the following Class 30 goods:

*Sauces for pasta and rice; sauces for pizza; preparations for making pasta sauces; pastes for use in the preparation of pasta foodstuffs; prepared and semi prepared pasta meals; pizzas.*

2) Dragon Corp Limited (“Dragon”) have raised a two-pronged attack against the registration, one being an invalidation and the other a revocation action claiming that the mark has not been put to genuine use.

### *The invalidation*

3) Dragon filed its notice of invalidation on 7 August 2019 which is directed only against the following goods: “prepared and semi prepared pasta meals”. The invalidation is based on the following sections of the Trade Marks Act 1994 (“the Act”), which are relevant in invalidation proceedings by virtue of s.47:

- **3(1)(d)**: that “the sign RASTA PASTA is and always has been “...customary in the current language or in the bona fide and established practices of the trade”<sup>1</sup>. Dragon goes on to state that “The phrase Rasta Pasta is and has always been the name or description of a pasta-based dish with a Jamaican influence or twist as served in many restaurants around the world, including the United Kingdom.”<sup>2</sup> Dragon provides further reasoning which I shall refer to later in this decision.

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<sup>1</sup> Para 6 of the statement of case

<sup>2</sup> Ditto para 7.

- **3(1)(c):** that the sign RASTA PASTA is directly descriptive of the goods. Dragon states that “there can also be no doubt that the word RASTA is also directly descriptive. It is used as an adjective to describe the following noun (“pasta”), as having a Caribbean or perhaps more specifically Jamaican influence, i.e. that the pasta meal has been created with a Jamaican influence or twist. An identical type of use of the word RASTA can be found in the phrase RASTA MOUSE as well as the Respondent claiming to be Britain’s favourite RASTA CHEF.”<sup>3</sup>
- **3(1)(b):** that for the same reasons set out under s.3(1)(d) the sign is also devoid of distinctive character and it “will not function as a badge of origin as it will, instead, be seen as the name of a (non-proprietary) type of pasta dish.”<sup>4</sup>

4) KG filed a counterstatement denying the claims made. Various submissions are made in defence of the registration, which I have read and will refer to where necessary. KG also refers to s.72 of the Act which states that since the mark is registered it is *prima facie* valid. Therefore, KG argues, it is for Dragon “to establish, on the balance of probabilities, that the grounds alleged under s.47(1) of the Act are met”.<sup>5</sup>

### *Revocation*

5) Dragon’s revocation was filed on 7 August 2019 and an amended statement of grounds on 28 August 2019. Revocation is sought under s.46(1)(a) of the Act. Accordingly, the “relevant period” is the 5 years following the date of completion of the registration procedure, namely 6 February 2010 to 5 February 2015. The date that revocation is sought is 6 February 2015.

6) KG filed a counterstatement denying that it had not genuinely used the registration during the relevant period. KG claims that “the use of the Mark is more than “notional”,

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<sup>3</sup> Para. 20 of the statement of case

<sup>4</sup> Para. 18 of the statement of case

<sup>5</sup> Para 4 of the counterstatement

it is “genuine use”.<sup>6</sup> KG also relies under the re-commencement of use proviso under s.46(3) of the Act. The effect of this is that since the application for revocation was filed on 7 August 2019 so if KG can establish genuine use after the five-year period set out above and before 7 May 2019, the registration will not be revoked.

### *The oppositions*

7) On 11 February 2019 Dragon applied for the mark **MANJAROS – RASTA PASTA**. It was allocated number 3374192 then accepted and published in the Trade Marks Journal on 22 February 2019 in respect of the following goods:

*Sauces for pasta; preparations for making pasta sauces; pastes for use in the preparation of pasta foodstuffs; prepared and semi prepared pasta meals; Pasta-based prepared meals; Meals consisting primarily of pasta; Prepared meals containing principally pasta; Prepared meals consisting primarily of pasta.*

8) KG opposes the trade mark based on s.5(2)(b) and 5(3) of the Act. The opposition is based on KG’s earlier trade mark registration no. 2530242 (**RASTA PASTA**) which is the subject of the invalidation and revocation proceedings outlined above, though KG relies only on some of the goods for which it is registered, namely:

*Sauces for pasta and rice; preparations for making pasta sauces; pastes for use in the preparation of pasta foodstuff; prepared and semi prepared pasta meals.*

9) Under s.5(2)(b), KG claims that the respective marks and goods are highly similar and so there is a likelihood of confusion.

10) For s.5(3), KG claims that use of Dragon’s mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of it’s earlier trade mark.

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<sup>6</sup> Para 8 of the counterstatement

11) On 11 February 2019, Dragon applied for the mark **MANJAROS – RASTA RICE**. It was allocated trade mark no. 3374193 and published on 22 February 2019 for the same goods listed above. This application was opposed by KG on the same basis.

12) Dragon filed a counterstatement denying the claims made and requested that KG provides proof of use of the earlier relied upon trade mark.

13) Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary. Dragon also filed written submissions of 6 April 2020. A hearing took place via video-link on 20 October 2020. KG was represented by Dr Roger Lowe of ip4all and Dragon represented by Jacqueline Reid, of Counsel, instructed by Penningtons Manches Cooper. Further submissions were filed after the hearing (January 2021) which I shall address separately.

### **Preliminary issue**

14) On 11 February 2020, Dragon filed a request for disclosure of “a complete copy of the results of the consumer testing undertaken by or on behalf of AB World Foods and any insights and reports derived from those results”.

15) Dragon stated that in the KG’s evidence it sought to rely upon exhibit TOPH3 which comprises an article from “Talking Retail” dated 9 June 2011. The article announces the launch of a pasta sauce by KG in the summer of that year. It is claimed that this suggests that that this is the date of KG’s first use. However, also within the exhibit, Mr Khan of AB World Foods (a sub-licensee of Mr Graham) stated that:

“Working with Levi we are continually looking to introduce innovative and exciting new products to develop the Levi Roots brand. During consumer testing we observed a strong and immediate emotional connection with Levi and Rasta pasta.”

16) Dragon argued that since the Article reported the outcome of consumer testing then such testing must have occurred prior to its publication in June 2011. Accordingly, the applicant requests disclosure of the document.

17) Whilst the parties did try to reach an agreement relating to the disclosure, an agreement was not reached hence why Dragon sought directions from the Registrar.

18) On 14 February 2020 the Registry wrote to Dragon refusing the request for disclosure stating that:

“The request has been considered, however it is the preliminary view of the Registry that the request should be refused.

Whilst the Tribunal does have the power of an official referee of the Supreme Court in respect of the discovery and production of documents, it is not something that is granted routinely or lightly. Therefore, we encourage the parties to reach some form of agreement in respect of the disclosure request.

In this instance we are not satisfied that an order for disclosure is justified and it is therefore refused. ‘Party B’ has not provided sufficient justification for the Tribunal to intervene. Bearing in mind the case pleaded, it is not clear how the results of the consumer testing undertaken would be material or useful in determining the matters due to be decided.”

19) A CMC subsequently took place on 4 March 2020, whereby I asked Dr Lowe to expand on the exact relevance of the document, the subject of the disclosure request. He argued that: 1) the document will help determine the first use of the mark and by whom which he claims to be a relevant factor for me to consider when deciding the substantive issues, 2) this prior use may be third parties who established some form of reputation which was not owned by Mr Graham, and 3) there are related proceedings involving a claim under s.3(1)(d) of the Act 1994 that the mark RASTA PASTA has become customary in the trade.

20) I also asked Dr Lowe whether he was aware of the number of people tested or what the document states, proves or indicates. Since he had not viewed the document, he could not provide any further indication.

21) Mr Picton-Howell was also present at the CMC and stated that the opponent did offer to produce the documents for Dr Lowe's consideration, subject to various restrictive covenants. This offer was refused by Dragon due to the costs requested by KG. I did explore the possibility of the document being evidenced under a confidentiality order, but Mr Picton-Howell said that its client did not own the document and he raised questions over whether the confidentiality order would be adhered to. Following the CMC, I issued a letter dated 11 March 2020 setting out the background as detailed above and concluded as follows:

“Having carefully considered the applicant's request, I am unpersuaded that the preliminary view to refuse disclosure should be overturned. These proceedings are opposition on sections 5(2)(b) and 5(3) of the Act. I do not see, and have not been offered any persuasive reason, why determining the first use or the first user would assist the opponent with its section 5(2)(b) claim. Moreover, as discussed during the CMC, if a third party believes that it has a prior claim to the sign RASTA PASTA, then it is for them to commence whichever action is most appropriate. They are not matters which have an impact on the opposition.

In relation to section 5(3), as I explained to Dr Lowe, the question I must address in claims under this section is whether the opponent, at the time the application was filed (11 February 2019), had a reputation for the goods claimed. It is a knowledge threshold which takes numerous factors into account. For example, the market share, geographical extent, promotion and duration of use. Accordingly, I am unpersuaded how disclosure of a document dated prior to June 2011 could help determine whether the opponent had a reputation or not on 11 February 2019. With regard potential third party reputation, that would be a separate claim to be made by a third party through different proceedings.

With regard to the mark RASTA PASTA being customary in the trade, once again I am unpersuaded how disclose of a document from June 2011 could

shed light on whether the mark has become customary in the trade. It seems to me that there is a vast amount of other evidence which may be more relevant to the matter to be decided.

Overall, as stated in the Trade Marks Work Manual, “Disclosure should only be ordered by the Tribunal insofar as the documents relate to matters in question in the proceedings. There will be no order for disclosure in relation to matters that will not affect the outcome of the case.”

**In view of the above, the request for disclosure is refused.**

**I take this opportunity to remind both parties that their current deadline to submit evidence strictly in reply is on or before 6 April 2020.”**

## **DRAGON’S EVIDENCE**

22) Dragon’s evidence consists of two witness statements, one being from Rafiq Ali with 5 exhibits and the other from its representative Dr Lowe with 18 exhibits.

23) Mr Ali states that, “in association with Tariq Younis, I am the managing mind of the restaurant business known as MANJAROS”<sup>7</sup>. Mr Ali states that he began working for Mr Younis in mid-December 2012. In April 2014 he took the restaurant over from Mr Younis and re-branded it as “MANJAROS”. By the time of writing the witness statement Mr Ali had 10 MANJAROS restaurants throughout the country serving “a blend of African and Caribbean flavours”<sup>8</sup>.

24) Mr Ali states that since April 2014 RASTA PASTA and RASTA RICE dishes have been offered at MANJAROS restaurants. To evidence this Mr Ali submits an undated copy of a menu<sup>9</sup> which does include reference to “Chicken Rasta Pasta” priced at £6.95. It describes the meal as “House special pasta with chicken, cooked in Manjaros’ sauce with peppers, onions, mushrooms and garlic. Served with seasoned garlic

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<sup>7</sup> Para. 4

<sup>8</sup> Para. 12

<sup>9</sup> Exhibit RA2

bread". There is also reference to "Vegetarian Rasta Pasta" priced at £5.95 which is described as having the MANJAROS sauce with various vegetables. The menu also includes reference to "Chicken Rasta Rice / Prawn Rasta Rice" which again lists the meat, fish and vegetables included with the "special Manjaros' sauce".

25) Exhibit RA3 to the witness statement consists of customer reviews left on Dragon's Facebook page about the Middlesbrough restaurant's Rasta Pasta dish. The earliest third-party review is from a customer recommending the "rasta pasta" dish. It is dated 10 January 2015 along with further references in April, June and July 2015. There is a further TripAdvisor post dated December 2015 which refers to "rasta pasta", describing the dish as "nose-running hot".

26) In terms of sales, Mr Ali states that for the period 21 November 2018 to 21 November 2019, sales of the RASTA PASTA and RASTA RICE dishes across nine of Dragon's restaurants amounted to £298,536.96 and £99,349.77 respectively.

27) Dr Roger Lowe is Dragon's representative. His witness statement annexes 18 exhibits, many of which I do not consider necessary to summarise and some I shall refer to later in my decision.

28) Notwithstanding the above, Dr Lowe states that "the Collins English Dictionary defines the word Rasta as a noun and an adjective and is short for Rastafarian" and that the:

"dictionary goes on to define the word Rastafarian as a noun and as an adjective as follows:

- a. NOUN – a member of an originally Jamaican religion that regards Raw Tafari (the former emperor of Ethiopia, Haile Selassie) as God.
- b. "ADJECTIVE of, characteristic of, or relating to the Rastafarians."

29) Dr Lowe also submits extracts from the website history.com which states that integral elements of Rastafarianism include, 1) the wearing of long hair locked in its natural, uncombed state, 2) dressing in the colours of red, green, gold and black (which

symbolise the life force of blood, herbs, royalty and African-ness and 3) eating an “I-tal” (natural vegetarian) diet.

30) A further extract from the website Maroon-news.co.uk dated 24 May 2016 headed “Cultural Appropriation: The Commodification of Rastafari Culture”<sup>10</sup> which, according to Dr Lowe, “confirms that the use of the word RASTA is now more commonly used as an adjective to describe the noun, to mean that the noun has a Caribbean look or influence”<sup>11</sup>. It is noted that the article begins with “Reggae music, dreadlocks, red, gold and green – these are all things associated with Rasta culture and rightly so...”.

31) That concludes my summary of Dragon’s evidence.

## **KG’s EVIDENCE**

32) KG’s evidence consists of two witness statements and 13 accompanying exhibits from Mr Picton-Howell who is a solicitor and consultant for Penningtons Manches Cooper LLP. He is also a director of Roots’ Reggae Reggae Sauce Limited and Levi Roots Reggae Reggae Foods Limited which he refers to as the “Roots” company. Levi Roots is the synonym of Keith Graham who became famous following his 2007 TV appearance on Dragon’s Den and his production of the Reggae Reggae sauce.

33) Mr Picton-Howell states that since appearing on Dragon’s Den KG has developed, manufactured, marketed and sold various food and beverage products. He states that in 2009 KG commenced preparations to expand into the pasta sauce category under the mark “RASTA PASTA”. Prior to launch, KG filed the trade mark registration, the subject of the revocation and invalidation claims.

34) He states that in 2011 KG launched the pasta sauce, under the sign RASTA PASTA, in the UK in Morrisons. Exhibit TOPH2 to the witness statement is an article from “The Grocer” website dated 11 June 2011, which states:

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<sup>10</sup> Exhibit RDL5

<sup>11</sup> Para. 11 of Dr Lowe’s witness statement

“He’s at it again! Reggae Reggae founder Levi Roots has now expanded into the pasta sauce category. Rasta Pasta sauce (rsp: £1.89), now in Morrisons, is described as “lightly spiced, with sun-ripened tomatoes, pineapple, guava and herbs”...”.

35) The exhibit also includes an article dated 9 June 2011 from “Talking Retail” which refers to “Rasta Pasta” sauce. At the foot of the article it identifies the “Source” of the article as being AB World Foods.

36) Mr Picton-Howell states that in 2018 KG launched the “Levi Roots” Caribbean snack pots which comprise of four flavours, namely Rasta Pasta, Reggae Reggae Noodles, Levi’s Curry Noodles and Caribbean Coconut Rice.

37) Exhibit TOPH4 consists of an article from the website planetzeus.co.uk dated 15 August 2018. It is headed “Launching Levi Roots Caribbean Snack Pots” and states “Are you a journalist or food blogger who has a love for the taste of the Caribbean? We want to hear from you!”. It goes on to refer to “Rasta Pasta” offering to send bloggers samples for them to review.

38) Exhibit TOPH5 consists of an article from the Sun Newspaper website dated 22 August 2018. It refers to and includes a picture of the RASTA PASTA snack pot with an RRP of £1.29.

39) Exhibit TOPH6 is a feature from the Aimia website (a sub-licensee of the Roots Companies) dated 28 August 2018 announcing the launch of the four snack pots, including RASTA PASTA.

40) Mr Picton-Howell states that the Roots companies sub-license the manufacture, marketing and distribution of the RASTA PASTA sauce and RASTA PASTA snack pot to AB World Foods and Aimia Foods respectively.

41) In terms of sales, Mr Picton-Howell states that from the records of AB World Foods<sup>12</sup> net sales of RASTA PASTA sauce in the UK between April 2011 and July 2016 totalled £520,010. These sales are broken down per month and it can be calculated that from February 2014 until July 2016 there were 27,149 items sold (each item being 6x350g jars) which totalled £88,966. Further, exhibit TOPH8 to the witness statement is a royalty report from AB World Foods to “one of the Roots Companies” for October 2015 totalling sales of £3,395 for RASTA PASTA sauce in the UK.

42) In respect of the snack pots, Mr Picton-Howell exhibits<sup>13</sup> a quarterly royalty report for the third quarter of 2018 (after the relevant period) which states that sales of RASTA PASTA snack pot by Aimia Foods in the UK was £2,221.

43) That concludes my summary of KG’s evidence.

## **Invalidation**

44) It is convenient for me to begin with the invalidation claim based on ss.3(1)(b), (c) and (d), which are applicable by virtue of s.47(1) of the Act, which are only against “prepared and semi prepared pasta meals”.

### *The law*

45) S.3 of the Act states:

“3(1) The following shall not be registered –

(a) signs which do not satisfy the requirements of section 1(1),

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose,

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<sup>12</sup> Exhibit TOPH7

<sup>13</sup> Exhibit TOPH9

value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

### **S.3(1)(d)**

46) Dragon’s claim is that the mark RASTA PASTA has become customary in the trade. This is also the main thrust of argument in respect of the other s.3 claims and therefore it does not just fall foul of s.3(1)(d) but consequently also ss.3(1)(b) and (c). It therefore seems sensible for me to first consider the s.3(1)(d) claim.

47) In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court summarised the case law of the Court of Justice under the equivalent of s.3(1)(d) of the Act, as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the *bona fide* and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly

refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (BSS, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (BSS, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, Merz & Krell, paragraph 35, and BSS, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, Merz & Krell, paragraph 37, and BSS, paragraph 40)."

48) In *Stash Trade Mark* BL O/281/04, Prof Annand (sitting as the Appointed Person) provided further guidance, stating:

"33. In the event, I do not believe this issue of the interpretation of section 3(1)(d) is central to the outcome of the appeal. "Customary" is defined in the Oxford English Reference Dictionary, 1995 as: "usual; in accordance with custom". In my judgment, the Opponent has failed on the evidence to prove that at the relevant date STASH contravened section 3(1)(d) as consisting exclusively of signs or indications which have become customary either in the current language or in trade practices for the goods concerned."

49) Since this is an invalidation action, I must bear in mind that the relevant date for assessing whether it is a customary term in the trade is the date that the application was filed, namely: 29 October 2009. Further, as correctly identified in KG's counterstatement, since the mark is registered, by virtue of s.72 of the Act, it is a *prima facie* valid registration and so the burden is on Dragon to establish that it was invalidly registered.

50) In light of the case law above, the relevant question is whether, on the relevant date (29 October 2009), the mark RASTA PASTA had 'become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought'. That question must be based on the perception of the average consumer of the goods in the UK, who are considered to be reasonably well-informed and reasonably observant and circumspect<sup>14</sup>. The goods in question are "prepared and semi prepared pasta meals". The average consumer for such goods in question will be the general public in the UK.

51) In the statement of grounds Dragon states that:

"12. The Applicant accepts the possibility that the use of the name of a dish could be in a proprietary manner, however, it remains the case here that a number of restaurants/chefs use the Mark in question as an indication of the style of dish and they also use it in the same manner as the name of other types of obviously generic types of dish, Irish Stew, Yorkshire Pudding, Scotch Broth, Lancashire Hot Pot etc."

52) It goes on to state:

"14. ...Whilst Rasta Pasta may not be on a par with the likes of Yorkshire Pudding, Lancashire Hot Pot, and/or Scotch Broth, in the Applicant's submission the level of use is sufficient to meet the customary test both in the current language and practices of the trade to designate the Invalid Goods."

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<sup>14</sup> For example, see para. 24 *Matratzen Concord AG v Hukla Germany SA, Case C-421/04*

53) Dr Lowe's evidence includes an article headed "The Future of Jamaican Fusion Food Is Now". It is dated 31 October 2017, which is well after the relevant date. I note that the article states:

"Today in New York City, one relatively newer Jamaican dish, rasta pasta, an Italian-meets-Jamaican dish of penne pasta topped with seasoned vegetables, fish or meat, has spread in the diaspora. The credit goes to chef Lorraine Washington, who first placed ackee pasta at her restaurant in Negril, Jamaica, in 1985. The food has no relation to Rastafarian culture, but you can find rasta pasta on menus in Toronto and New York."

54) A further article<sup>15</sup> dated 29 October 2012 from the website Jamaica-gleaner.com states that Chef Washington subsequently placed the Rasta Pasta dish she had created onto her menu in Jamaica from 1986 until 1997.

55) During the hearing, Dr Lowe highlighted that this evidence does not show the position in the UK, but he wanted to demonstrate the food's genesis. Specifically in relation to the UK, and prior to the relevant date, Dr Lowe provided the following evidence:

Exhibit RDL11: a search carried out on the internet archive website "The Way Back Machine" which shows that there are 20 websites which include the words "Rasta Pasta". None of them are co.uk nor do they show whether any of the sites were viewed from the UK.

Exhibit RDL12: a search carried out on the Wayback Machine for books and other digitally archived material for the term "Rasta Pasta" present prior to the relevant date. Dr Lowe states that, "The results show the global use of the phrase RASTA PASTA as the name of a pasta dish with Caribbean influence." There are very few (less than 10) titles referencing the UK, but it is not clear whether any of these books were for sale in the UK, how many were sold or

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<sup>15</sup> Exhibit RDL6.

any real corroborating material to demonstrate how they are relevant to determining the average consumer's perception.

Exhibit RDL13: a Cerberus IP<sup>16</sup> Report dated 25 July 2019 which states that they were instructed "to obtain a clear overview of goods and services within the restaurants/culinary sectors with names which include the terms RASTA, RASTA PASTA or RASTA RICE or variations in the United Kingdom". Dr Lowe specifically refers to a menu from the Rain Forest Café in London which lists RASTA PASTA as one of its dishes. The report states that "The earliest evidence of availability of the RASTA PASTA dish was identified on an archived page dated 11<sup>th</sup> December 2002."

56) Dr Lowe also seeks to rely upon an expert from the Vegetarian Times Complete Cookbook published in 1995. He states that the book was initially published in the US but then in "London" the following year. Other than saying that he had no problem procuring a copy of the book for these proceedings, he does not state how many copies were produced or sold in the UK.

57) As previously stated, the question for me to ask is whether, prior to October 2009, the mark RASTA PASTA is customary to members of the general public, in the UK. As identified by Ms Reid, Dr Lowe did refer to the dictionary definition of Rasta but did not submit the definition in evidence. The Collins English Dictionary defines Rasta as a countable noun for Rastafarian which is defined as "a member of a Jamaican religious group which considers Haile Selassie, the former Emperor of Ethiopia, to be God. Rastafarians often have long hair which they wear in a hairstyle called dreadlocks." In the evidence Rasta is described as associated with the Caribbean, dreadlocks and the combination of red, gold and green coloured clothing. This definition is also my understanding of the term and in my view one that consumers will be aware of. However, the question is whether RASTA PASTA is customary for the goods in question. There is no doubt in my mind that the answer to this question, for UK consumers, is no.

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<sup>16</sup> Cerberus are an IP analyst company which conducts, inter alia, trade mark use investigations.

58) The evidence relating to the UK is very limited showing very few instances of use of RASTA PASTA in the UK. I appreciate Dr Lowe wanted to provide historical context of the term RASTA PASTA being created in the US and staying on the menu from 1986 to 1997, along with the 20 or so websites which include RASTA PASTA, but none are co.uk domains and there is no information as to why they relate to the UK. The same can be said about the books evidenced at exhibit RDL12. Further, they do not shed any light back on the position in the UK at the relevant date.

59) As Ms Reid correctly identified, the only UK based evidence (other than Dragon's own use) which was prior to the relevant date appears to be limited to the Rain Forest Café in London. Further, the fact that the purpose of the Cerberus Report was to find use of RASTA PASTA and it only found very limited instances supports my conclusion that the term RASTA PASTA had not become a customary term to designate the goods in question at the relevant date. The s.3(1)(d) claim is dismissed.

### **S.3(1)(b) and (c)**

60) Dr Lowe effectively relies on the same arguments for ss.3(1)(b) and (c) as he does for s.3(1)(d). He argues that because the mark is customary, then it would follow that it is descriptive and therefore falls foul of s.3(1)(c) and devoid of distinctive character under s.3(1)(b).

61) Whilst I am conscious that each of the s.3 claims are independent of one another and require separate examination<sup>17</sup>, I do not consider the mark to contravene s.3(1)(b) or s.3(1)(c).

62) As can be seen from the dictionary definition the word RASTA does not describe the goods or a characteristic thereof. Whilst use of RASTA may be allusive or suggestive that the goods have a Caribbean, or Rastafarian influence, in my view this would not be considered descriptive in the minds of the average consumer. I find that the words are not descriptive by virtue of their dictionary definitions and there is no

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<sup>17</sup> *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P

evidence, for the reasons set out above, to support the claim that the mark is descriptive.

63) Turning to the s.3(1)(b) claim, whilst the combination of RASTA PASTA is not the most imaginative, the rhyming assonance does give it a degree of distinctive character and it is not objectionable under s.3(1)(b) of the Act.

## **INVALIDATION CONCLUSION**

**64) For the reasons set out above, the ss.3(1)(b), (c) and (d) claims, relevant by virtue of s.47, are dismissed.**

## **REVOCACTION**

65) The second line of attack against the registration is that the mark has not been genuinely used on the goods that it is registered for and should therefore be revoked under s.46(1)(a) of the Act. As previously stated, the relevant period for the revocation action is 6 February 2010 to 5 February 2015 and because KG relies upon s.46(3) if it can establish genuine use after this period, but before 7 May 2019, the registration will not be revoked. The relevant law states:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) .....

(d) .....

(2) For the purpose of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that -

- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
- (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

- (a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date.”

66) S.100 is also relevant, which reads:

“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.”

*The case law*

67) In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J 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 Kameradschaft ‘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 Merken 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].”

68) In *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.”

69) Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is not, therefore, genuine use.<sup>18</sup>

### *Consent*

70) Dragon has consistently argued that there are discrepancies in the “Corporate structure”<sup>19</sup> of KG. It is claimed that the arrangements between KG and, *inter alia*, Mr Picton-Howell means the company is “unidentifiable”<sup>20</sup>. In KG’s evidence it submitted

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<sup>18</sup> See, for example, *Naazneen Investments Ltd v OHIM*, Case T-250/13, EU:T:2017:633, Jumpman Trade Mark BL O/222/16 and Strada Del Sole Trade Mark BL O/528/15.

<sup>19</sup> Para. 32 of Dr Lowe’s witness statement.

<sup>20</sup> Ditto

a licence agreement<sup>21</sup> between KG (under the name of Levi Roots) and several other companies. Dr Lowe has forensically assessed the licence agreement and following the hearing filed further submissions highlighting the differences in company names and numbers. He argues that due to the company structure being unclear then the evidence provided should be given limited value.

71) The revocation (and proof of use in opposition proceedings) burden placed upon KG will be satisfied pursuant to s.47(2B) if it has been put to genuine use (my emphasis added), “by the proprietor or with his consent in relation to the goods or services for which it is registered”. There is no requirement that this consent be formalised or documented in a licence at all, let alone the licence KG has produced - albeit with what KG claims to simply contain a typographical error. It is clear from KG’s evidence that the use made of the earlier mark was with the consent of Keith Graham, particularly as the mark RASTA PASTA is used alongside his synonym Levi Roots. Therefore, I am satisfied that the use demonstrated in the evidence is with the consent of KG and that the licence discrepancies do not render the evidence as being of limited value.

### *Sufficient use*

72) An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>22</sup>

73) As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

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<sup>21</sup> Exhibit TOPH11 is a redacted copy of the Master Licence Agreement dated 27 July 2011 between KG and various other companies.

<sup>22</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

74) The evidence demonstrates that KG launched its pasta sauce in June 2011, under the sign RASTA PASTA, in the well-known supermarket Morrisons in the UK for £1.89.<sup>23</sup> This is further evidenced from the article<sup>24</sup> published in “Talking Retail” dated 9 June 2011. The evidence also shows that sales of the sauce totalled £520,010 from April 2011 to July 2016. These sales, combined with the advertising and examples of use, demonstrate sufficient use of the mark during the relevant period (6 February 2010 to 5 February 2015). During the hearing Ms Reid said that the goods sauces for pasta and sauces for rice are the same. In other words, consumers would purchase a sauce for “pasta” but would use it for “rice” and vice versa. I disagree with this assessment because applying such an approach would not be giving the words their ordinary and natural language. Further, from my own experience this argument is not accurate.

75) With regard to snack pots, by KG’s own admission these were not launched until 2018<sup>25</sup>. Whilst this is after the relevant period, because KG seeks to rely upon s.46(3) of the Act, such use is relevant.

76) In *Memory Opticians Ltd’s Application*, BL O/528/15, Professor Ruth Annand, as the Appointed Person, upheld the Hearing Officer’s decision to revoke the protection of the mark STRADA on the grounds that it had not been put to genuine use within the requisite 5 year period. There had in fact been sales of goods bearing the mark, but these were very low in volume (circa 40 pairs of spectacles per year) and all the sales were local from 3 branches of an optician. There was no advertising of goods under the mark, although the evidence indicated that they were only displayed in-store on occasions. The mark was said to have been applied to the goods via a sticker applied to the arms of a dummy lens. This level of use was held to be insufficient to create or maintain market under the mark. Consequently, it was not genuine use.

77) The evidence in relation to snack pots is considerably more limited than for the sauces. In terms of sales, the 3<sup>rd</sup> quarter royalty report for 2018 shows that UK sales of the RASTA PASTA snack pot totalled £2,221. I acknowledge that the snack pots

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<sup>23</sup> Exhibit TOPH2

<sup>24</sup> Ditto

<sup>25</sup> Mr Picto-Howell’s witness statement

were referred to in a bloggers article directed at the UK. However, the article is directed at bloggers to review the goods rather than evidence of actual sales. I also acknowledge the article in The Sun national newspaper website<sup>26</sup> which would have inevitably been viewed by potential customers. These factors are consistent with creating a market share, but the evidence demonstrates to me that KG had one sale totalling £2,221 and then no further sales were made. I do acknowledge that there is no *de minimus* rule and one sale could be sufficient to demonstrate genuine use. However, taking all of the evidence into account it does not sufficiently demonstrate the creation and preserving of a market share. Further, bearing in mind the guidance set out in the *Plymouth Life* case, if there were further sales or more widespread use then this could have been easily demonstrated, particularly as it was able to do so for its pasta sauces. Taking all of this into account, I do not consider there to be sufficient use in relation to snack pots.

#### *Form of the mark*

78) The form in which the mark was used was raised in the pleadings but pursued at the hearing. Notwithstanding this, taking the relevant case law<sup>27</sup> into account, any dispute to the form in which the mark was used the claim would have been dismissed since the use does not alter the distinctive character of the mark<sup>28</sup>.

#### *Fair specification*

79) In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of

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<sup>26</sup> Exhibit TOPH5

<sup>27</sup> *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

<sup>28</sup> S.46(2)

the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

80) In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not

constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

81) KG’s evidence demonstrates that it has genuine and consistent use of the mark RASTA PASTA for sauces. Therefore, I consider a fair specification to be *sauces for pasta*.

## **REVOCAION CONCLUSION**

82) I find that the application for revocation against trade mark registration no. 2530242 partially succeeds under s.46(1)(a). The registration is therefore revoked with effect from 6 February 2015 for all goods except for: Class 30 *sauces for pasta*.

## **OPPOSITIONS**

83) As set out in paragraphs 7 and 8 the oppositions are against MANJAROS RASTA PASTA and MANJAROS RASTA RICE, both of which were filed on 11 February 2019 and published on 22 February 2019.

84) The oppositions are based on s.5(2)(b) and s.5(3) of the Act. In Dragon’s counterstatement it requested that KG provides proof of use of its earlier relied upon registration. Along with s.100 as outlined above, the relevant provisions of the Act for the proof of use are as follows:

“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.”

85) As set out above, the relevant period for the proof of use in the opposition proceedings is the five-year ending with the date of application of the applied for marks, i.e. 12 February 2014 - 11 February 2019. Given my findings in the revocation action it is evident that, at best, KG may only rely upon sauces for pasta. This is because I did not find genuine use for the remaining goods for not just the revocation relevant period (6 February 2010 – 5 February 2015) but also any use after this was not sufficient to save the registration under s.46(3).

86) The evidence does demonstrate that from the beginning of the proof of use relevant period (February 2014) until July 2016 it sold 27,149 (6x350g) items totalling £88,966 in sales. I find that these consistent monthly sales for the first two years of the proof of use relevant period to be sufficient for KG to rely upon its earlier RASTA PASTA registration for Class 30 *sauces for pasta* only.

87) I shall begin with the s.5(2)(b) claim. The law states that:

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

(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”.

#### *The case-law*

88) The following principles 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 goods**

89) In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court 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”.

90) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(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.

91) The respective goods are:

<b>Applied for goods</b>	<b>Earlier goods</b>
<i>Sauces for pasta and rice; sauces for pizza; preparations for making pasta sauces; pastes for use in the preparation of pasta foodstuffs; prepared and semi prepared pasta meals; pizzas.</i>	Sauces for pasta

92) Both lists include the identical term *sauces for pasta*.

93) Ms Reid argues that sauces for rice and sauces for pasta are interchangeable. Whilst this was in the context of the proof of use claims, the point being argued is that consumers would purchase “sauces” for rice or pasta and they would then use it on either goods. This differs to my own experience of such goods, i.e. if I purchase sauce for pasta I would it put on pasta and never on rice and likewise for sauces for rice. They are similar in nature since they are both poured over goods to moisten or add flavour, though they differ insofar one is for pasta and one is for rice. Therefore, there are clear similarities in nature. Further, they would be sold in close proximity to one another, through similar trade channels. They are similar to a high degree. For the same reasons I find *sauces for pizza* to also be of **high similarity**.

94) The applied for *preparations for making pasta sauces* and *pastes for use in the preparation of pasta foodstuffs* are either the constituent parts that go into making the pasta sauce rather than the finished article or in respect of pastes a concentrated product which then gets made into a sauce. Therefore, they are similar in nature only

to the extent that are both foodstuffs and to be added to pasta. They are goods which would be sold in the same areas of a supermarket and likely to go through similar trade channels. Further, they are likely to be consumed by the same end user. I do not consider them to be in competition but overall the goods are similar to **a medium degree**.

95) The applied for *prepared and semi prepared pasta meals* are meals which are pasta based which are either pre-prepared or require cooking. They are similar in nature since they are also foodstuffs. There is a degree of competition since consumers would have the choice to purchase the prepared (or semi-prepared meal) or to cook one's own pasta and then add a sauce. They are sold in close proximity to one another in shops and supermarkets and the end users would be the same. Therefore, I find them to be similar to **at least a medium degree**.

96) The term *pizzas* cover ready to eat and pizzas which require cooking or warming up. Therefore, they are a prepared or semi-prepared meal rather than something such as *sauces for pasta* which are added to another product (pasta) to create the final meal. Therefore, there are some similarities in nature. They would be sold in close proximity to one another and likely to be sold through the same trade channels, particularly since they are both Italian inspired goods. However, they differ insofar that they are not in competition with one another nor are they complementary. They are similar to a **below medium degree, but not low**.

### **Comparison of marks**

97) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means

of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

98) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

Earlier:       **RASTA PASTA**

Applied for: **MANJAROS - RASTA PASTA**

99) Both marks are word only. The overall impression earlier mark lies in the combination of the two words. The applied for mark consists of the words MANJAROS and RASTA PASTA, separated by the “-”. In my view, they both make roughly equal contributions to the overall impression of the mark with MANJAROS being marginally dominant.

100) Dr Lowe argues that, “Both visually and aurally, the common presence of RASTA PASTA creates a degree of similarity. However, this must be tempered by party B’s submission as to its assessment of the overall impression of the marks, together with the fact that there is a key difference at the beginning of Party B’s mark which establishes a look and sound that is very different. The marks are visually and aurally similar to only a very low degree”. Ms Reid argues that since they both share the common elements RASTA PASTA, they are similar to a medium to high degree.

101) Clearly, the earlier mark is present in the applied for MANJAROS - RASTA PASTA mark, the only difference being the presence of “MANJAROS -”. Whilst I acknowledge that “MANJAROS –” is at the beginning of the mark and the presence of the “-”, I find since both marks share the words “RASTA PASTA” there is at least a medium degree of visual similarity.

102) Aurally, RASTA PASTA will be pronounced in the same way and therefore the only difference is the presence of MANJAROS which is at the beginning of the mark. The “-” will not be enunciated and therefore the marks are aurally similar to at least a medium degree.

103) Conceptually, Dr Lowe argues that “both marks contain an element which indicates that the goods comprise a pasta dish with a Jamaican influence. There is, though, a difference on account of the inclusion by Party B of the word MANJAROS. In Party B’s submission therefore, whilst conceptual similarity exists, this is on the basis of a non-distinctive concept.” Ms Reid argues that MANJAROS has no conceptual meaning and therefore it will be seen as a foreign word. I agree with Ms Reid that MANJAROS will have no meaning to the relevant public. In my view, the presence of RASTA is unusual for the goods in question, which will be remembered by the average consumer as a reference to Rastafarians, or Rastafarian culture. Therefore, I find them to be conceptually similar to a degree above medium but not high degree.

Earlier: **RASTA PASTA**

Applied for: **MANJAROS - RASTA RICE**

104) In terms of overall impression, my findings at paragraph 99 apply equally here. The word RICE rather than PASTA does not alter such findings.

105) Neither party made any detailed submissions with regard to the comparison of these marks, other than Dragon arguing that they must be even less similarity than with the other application assessed above.

106) Visually, both marks share the element RASTA which is followed by PASTA in the earlier mark and “MANJAROS –” in the applied for mark then followed by RICE. Taking all of these factors into account, I find that they are similar to a degree below medium but not low.

107) Aurally, RASTA will clearly be verbalised in the same way in each of the marks. Dr Lowe emphasises that the applied for mark begins with MANJAROS and that the

first part is most important. I find that the marks are similar to a degree below medium not low.

108) Conceptually, as previously stated, MANJAROS will have no meaning to the relevant public. Accordingly, since both marks share the RASTA concept, which is followed by RICE being a closely related foodstuff, I find the respective marks to be conceptually similar to a medium degree.

### **Average consumer and the purchasing act**

109) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

110) In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

111) As I have previously set out in the s.3 assessment, even after the proof of use conclusion, the average consumer for foodstuffs will be a member of the general public. Whilst Ms Reid is in agreement that members of the public are an average consumer, she also believes the trade to also be considered as an average consumer. As outlined above the average consumer is a legal construct who is reasonably well-informed and reasonably circumspect. The average consumer is predominantly the

general public, who will pay a lower degree of attention than the trade public. As the assessment of a likelihood of confusion is made in relation to the group paying the lower level of attention, it is against the general public that I shall make my assessment. I consider this group of average consumer to pay an average degree of care and attention.

112) The goods are likely to be purchased following a visual inspection of the goods and therefore visual considerations will be an important part of the selection process, although aural recommendations will also be taken into account.

### **Distinctive character of the earlier trade mark**

113) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

114) The level of distinctive character of a trade mark can vary, depending on the particular goods at issue: a mark may be more distinctive for some goods than it is for others. Distinctiveness can also be enhanced through use of the mark. There has been no explicit claim of enhanced distinctiveness, but evidence of use has been filed in support of the section 5(3) claim. This evidence has been summarised above and I am required to assess whether, at the relevant date of 11 February 2019, KG has demonstrated that it has an enhanced degree of distinctive character.

115) I have already found that KG has sufficiently demonstrated use of its earlier relied upon mark for pasta sauces. However, the sales figures provided only go up to July 2016 which is two and a half years prior to the relevant date to assess whether the mark's distinctive character has been enhanced by virtue of the use made of it. However, whether a mark has been genuinely used and whether its use has been such that its distinctive character has been enhanced are different. The evidence demonstrates that there have been sales totalling a little over £500k over a 5-year period, but the evidence does not demonstrate how widespread the sales are or the proportion of the relevant public who are aware of the mark, etc. Therefore, for all of these reasons, there is no doubt in my mind that the evidence does not demonstrate that the use made of the mark has enhanced its distinctive character.

116) In terms of inherent distinctive character, PASTA is clearly descriptive for pasta and pasta related goods. Therefore, the distinctiveness resides in RASTA plus the combination of RASTA and PASTA which forms a fanciful rhyme. Taking into account that the mark is not an invented word, does not include a device but is a combination of two English words, one of which is descriptive for certain goods, I find its inherent distinctive character to be below a medium degree of inherent distinctive character but not low.

### **Global assessment – likelihood of confusion**

117) During the hearing Ms Reid referred to the *Sazerac v Liverpool Gin Distillery* [2020] EWHC 2424 (Ch) case, citing the following paragraphs:

“73. I consider that there is a likelihood of a significant proportion of the bourbon markets in the UK and EU being confused about whether Eagle Rare and American Eagle are connected brands. It is common for connected brands to have similar names: see the examples given in para 69 above. The average consumer would be aware of the fact that brands have different expressions and connected products, and that distillers can make more than one brand. It is natural to consider, as Mr Allanson did when presented for the first time with "Yellow Rose" and "Heaven's Door", that there was a connection with the "Four Roses" and "Heaven Hill" brands. He had not heard of the smaller brands, so he approached this question in the same way that an average consumer would, though he accepted that with scrutiny of the label and using his expertise the difference could be established.

74. The position with Eagle Rare and American Eagle is similar, in that prior to American Eagle's launch there was no other bourbon in the relevant market using the name "Eagle" as part of its brand name. It is a distinctive component of the brand name. Another identical product in the same market with "Eagle" in its name would not only call Eagle Rare to mind but would be likely to cause the average consumer to assume that they were connected in some way. That is so even though American Eagle has a strong composite identity, because of the presence of the word "Eagle". I do not consider that the fact that American Eagle is Tennessee bourbon rather than Kentucky bourbon makes any difference, since the average consumer will not have this distinction in mind, and even if they did it would not negate the possibility of an economic link between the respective undertakings. It goes only to support the conclusion that the products would not mistakenly be thought to be the same.”

118) I consider this case to be of limited assistance to me because the goods in question were spirits, whiskey and whiskey bourbons and therefore I would expect the average consumer to take a higher degree of care and attention in purchasing them than pasta sauces.

119) When determining whether there is a likelihood of confusion, there is no scientific formula to apply. It is a global assessment where a number of factors need to be borne

in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

120) Turning to the case in hand, for both oppositions I have found that all of the respective goods are either identical or similar to varying degrees, with the lowest being below medium but not low. I have also found that the average consumer to be a member of the general public who will purchase the goods following a visual inspection, though I do not discount aural recommendations.

121) In terms of distinctive character, I concluded that KG's use has not demonstrated that its distinctive character has been enhanced by virtue of the use made of the mark. From an inherent perspective, I found that the earlier mark to have a below medium (but not low) degree of inherent distinctive character.

122) In terms of similarity between the respective marks, I found that the earlier mark was visually and aurally similar to the applied for MANJAROS – RASTA PASTA to at least a medium degree, and conceptually similar to a degree above medium but not high.

123) In respect of MANJAROS – RASTA RICE, I found that the earlier mark was visually and aurally similar to a degree below medium but not low, and conceptually similar to a medium degree.

124) Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. The existence of the word MANJAROS and –, placed before the words RASTA PASTA, will not go unnoticed by the average consumer and therefore there is no likelihood of direct confusion.

125) In respect of indirect confusion, Mr Iain Purvis Q.C., sitting as the Appointed Person, stated in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

126) In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

127) In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

128) Although the applied for mark begins with “MANJAROS –”, it is followed by the earlier mark (“RASTA PASTA”). Following the comments set out in *Whyte and Mackay*, they are clearly independently distinctive. Of course, it does not naturally follow that even if a mark is independently distinctive then there is a likelihood of indirect confusion. However, in this instance, taking all of the relevant factors into consideration, including the overall similarity of the marks, the varying degree of similarity between the goods and the degree of distinctive character the earlier mark, I find that there is a likelihood of indirect confusion. The words RASTA PASTA will be remembered and recognised should the average consumer encounter the respective

marks, and this risk is not mitigated by existence of the independent element MANJAROS.

129) Turning to the MANJAROS - RASTA RICE opposition, for the same reasons there is no likelihood of direct confusion. However, having considered all of the relevant factors, I consider there to be a likelihood of indirect confusion. Whilst I accept that the applied for mark includes “MANJAROS –”, which is not present in the earlier mark, the presence of RASTA followed by RICE, being another closely related foodstuff, is sufficient for the average consumer to believe they are economically linked. The word “MANJAROS” is likely to be viewed as the house brand, which is further separated from the RASTA RICE element by virtue of the dash. Therefore, in my view, the average consumer will know that the later mark is different from the earlier, but the existence of the shared word and concept of RASTA will be enough for consumers to conclude it is a brand extension.

**130) For the reasons set out above, both s.5(2)(b) claims against Dragon’s applications succeed.**

### **Section 5(3)**

131) Whilst KG has been successful in its oppositions, for the sake of completeness I shall consider its s.5(3) claim. The relevant law, applicable for invalidation proceedings by virtue of s.47, is set out as follows:

“(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.

132) Also relevant is s.5(3A) which states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

133) Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

#### *The case-law*

134) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant

consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases

where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

## Reputation

135) In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

136) As noted above, by virtue of their earlier filing dates, the opponent's marks qualify as earlier marks pursuant to s.6 of the Act. I have found that the opponent has satisfied the proof of use requirements pursuant to s.6A of the Act in relation to some of the goods relied upon.

137) The relevant date for the assessment under s.5(3) of the Act is the date of the applications i.e. 11 February 2019.

138) In determining whether the opponent has demonstrated a reputation for the goods in issue, it is necessary for me to consider whether its marks will be known by a significant part of the public concerned for the goods. In reaching this decision, I must take all of the evidence into account including "the market share held by the trademark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it."

139) In *Spirit Energy Limited v Spirit Solar Limited* - BL O/034/20 – Mr Phillip Johnson, as the Appointed Person, held that the opponent had not established a qualifying reputation for s.5(3) purposes. The opponent traded in solar energy equipment and installations and had used its mark in relation to such goods/services for 7 years prior to the relevant date in the proceedings. During the 5 years prior to the relevant date, it had installed solar energy generation equipment in over 1000 domestic homes and made over 700 installations for commercial customers. These sales had generated nearly £13m in income. However, there was limited evidence of advertising and promotion, and the amount spent promoting the mark had fallen in the years leading up to the relevant date. Additionally, the mark had only been used in South East England and the Midlands. Taking all the relevant factors into account, the Appointed Person therefore decided that such use of the mark was not sufficient to establish a reputation for the purposes of s.5(3).

140) Turning to the case in hand, KG has demonstrated sales of sauces for pasta totalling £520,010 for the period of April 2011 to July 2016. This is two and a half years prior to the relevant date. This means that the position at the relevant date is unclear and there certainly isn't sufficient evidence to support the claim that KG has the requisite reputation. Therefore, the s.5(3) claim falls at the first hurdle and is therefore dismissed.

## **OVERALL OUTCOME**

**141) Subject to appeal, the overall outcome of these consolidated proceedings is as follows:**

- **Dragon's invalidation action against trade mark registration no. 2530242 has failed.**
- **Dragon's application for revocation against trade mark registration no. 2530242 partially succeeds under s.46(1)(a), i.e. the registration is revoked with effect from 6 February 2015 for all goods except for: Class 30 sauces for pasta.**
- **KG's opposition against trade mark application numbers 3374192 and 3374193 have been entirely successful under s.5(2)(b). Therefore, the aforementioned trade mark applications shall be refused registration. The oppositions based on s.5(3) were dismissed.**

## **COSTS**

142) As can be seen from the above, KG has been entirely successful with its oppositions, where Dragon has failed in its invalidation claims and been partially successful in the revocation action. Therefore, KG has been more successful than Dragon and is entitled to a contribution towards its costs.

143) Both parties have requested costs in accordance with the published scale. However, At the hearing Ms Reid requested any costs award to reflect, 1) the "excessive amount of irrelevant evidence", in particular that covered by Dr Lowe, and 2) the very lengthy submissions which Ms Reid believed to be irrelevant. I do agree that parts of the evidence were unhelpful and unnecessary. Further, the submissions were also unfocussed. However, I do take into account that Dr Lowe is not a trade mark attorney and so is less versed in proceedings before the Tribunal. Taking these factors into account, along with Dragon's limited success and the unsuccessful request for disclosure resulting in a CMC, I award KG £3000 which is made up as follows:

*Invalidity*

Considering the statement of case and preparing the counterstatement £300

Preparing evidence and considering Dragon's evidence  
in relation to the invalidation £600

*Opposition*

Preparing a statement of case in the opposition proceedings,  
considering the other side's statement in the same proceedings £400

Preparing own evidence and considering and commenting  
on Dragon's evidence £1000

Official fees x 2 £400

Preparing for and attending the CMC £200

Preparing for and attending a hearing £900

TOTAL £3800

LESS

Dragon's partial success in the revocation action  
(this includes preparing the statement of case and considering  
the counterstatement, plus preparing evidence and  
considering and commenting on other side's evidence) £600

Preparing for and attending a hearing £200

**GRAND TOTAL £3000**

144) I therefore order Dragon Corp Limited to pay Keith Graham the sum of £3000.  
The above sum should be paid within twenty-one days of the expiry of the appeal

period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 26th day of March 2021**

**MARK KING**

**For the Registrar,**

**The Comptroller-General**