

O-232-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2594234
BY GOURMET OF LONDON LTD
TO REGISTER THE TRADE MARK**



IN CLASS 30

AND:

**OPPOSITION THERETO UNDER NO. 103614
BY IMTIAZ AHMAD**

BACKGROUND

1. On 13 September 2011, Gourmet of London Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 20 April 2012 for the following goods in class 30:

Traditional Pastries and sweets from Pakistan, in particular Multani Sohan Halwa.

2. On 19 July 2012, Imtiaz Ahmad filed a notice of opposition. Mr Ahmad’s opposition is based upon a single ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) for which he relies upon all of the goods in the following trade mark registration:

UK TM no. 2526731 for the trade mark:



applied for on 21 September 2009 and registered on 25 December 2009 for:

Class 29 - Prepared meals, soups, milk products, crisps.

Class 30 - Prepared food, drinks, pastry, confectionery, pizza, pies and pasta dishes.

Class 32 - Preparing non alcoholic drinks.

Class 43 - Services for providing food and drinks, restaurant, bar and catering services.

3. On 28 September 2012, the applicant filed a counterstatement in which it said, inter alia:

“4.3. The elements in common between the marks are the words GOURMET and HALWAI. Taking each in turn:

the word GOURMET is an extremely common word in relation to food products in view of its common English meaning e.g. “Gourmet is a cultural ideal associated with the culinary arts of fine food and drink” (Wikipedia); “a person who cultivates a discriminating palate for the enjoyment of good food and drink” (Collins English Dictionary). Therefore this element has a low level of distinctiveness in relation to the goods in both marks. This is reduced further by the presence of 361 other UK and Community marks on the register containing the word GOURMET.

The word HALWAI is also descriptive in relation to confectionery as it refers to confectioners and sweet-makers in India. Wikipedia states that “the name is derived from the word halwa, a popular sweet made of flour, clarified butter (ghee), sugar, almonds raisins and pistachio nuts and also frequently saffron”. Therefore this word has a low level of distinctiveness in relation to both trade marks.

Therefore it is submitted that the presence of the word GOURMET and HALWAI in both marks is not sufficient to create a likelihood of confusion between them.

4.4. Therefore the overall impression given by the respective marks is different and there would be no likelihood of confusion, including a likelihood of association, despite the fact that the goods are similar to those of the opponent’s mark...”

4. Whilst neither party filed evidence, both filed submissions during the evidential rounds, and whilst neither requested to be heard Mr Ahmad filed submissions in lieu of attendance at a hearing; I will refer to these various submissions as necessary below.

DECISION

5. Section 5(2)(b) of the Act reads as follows:

“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, or

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

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

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if

registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

7. In these proceedings Mr Ahmad is relying upon the trade mark shown in paragraph 2 above, which constitutes an earlier trade mark under the above provisions. Given the interplay between the date on which the application was published and the date on which Mr Ahmad’s registration completed its registration procedure, Mr Ahmad’s registration is not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

Section 5(2)(b) – case law

8. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* -BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

Comparison of goods

9. Although in his notice of opposition Mr Ahmad relies upon all of the goods and services in his earlier trade mark, in his submissions he only refers to the goods in class 30. With that in mind, the goods to be compared are as follows:

Mr Ahmad's goods in class 30	Applicant's goods
Prepared food, drinks, pastry, confectionery, pizza, pies and pasta dishes.	Traditional Pastries and sweets from Pakistan, in particular Multani Sohan Halwa.

10. Whilst in its counterstatement the applicant appears to accept that the competing goods are similar, it does not indicate to which of Mr Ahmad's goods it is referring. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 the General Court said:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

11. As all of the applicant’s goods would, in my view, be encompassed by (at least) the phrase “prepared food” in Mr Ahmad’s earlier trade mark, the competing goods are, on the principles outlined above, identical.

The average consumer and the nature of the purchasing process

12. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and then to determine the manner in which these goods will be selected by the average consumer in the course of trade. The goods at issue in these proceedings are foodstuffs. As the specification of Mr Ahmad’s trade mark is not limited in any way, the average consumer will be the general public who will, for the most part, self select the goods from a range of retail outlets such as supermarkets, convenience stores and bakers. The parties agree (as do I), that it is the visual aspect of the competing trade marks that is likely to dominate the selection process. As the goods at issue are low cost items which will be bought on a fairly regular basis, the degree of attention paid to their selection is likely to be low.

Comparison of trade marks

13. The competing trade marks are as follows:

Mr Ahmad’s trade mark	Applicant’s trade mark
	

14. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

15. The applicant's trade mark consists of the words "OF LAHORE" presented in block capital letters in white, the word "gourmet" presented in a larger lower case cursive script also in white and the word "HALWAI" presented in black in block capital letters; these elements are presented against an orange rectangular background. In its submission the applicant states: "The mark has a professional uniform finish, generated via a computer by a graphic designer..." Given the size and descriptive/geographical nature of the words "OF LAHORE", it is the stylised word "gourmet" and, to a lesser extent, the word "HALWAI" which are, in my view, the dominant elements of the applicant's trade mark.

16. Mr Ahmad's trade mark is presented in black and white and appears to be hand drawn. It also consists of the word "gourmet" presented in a larger lower case cursive script and is accompanied by the words and symbol "Halwai & Bakers". Given that the symbol and word "& Bakers" is wholly descriptive, it is, once again, the stylised word "gourmet" and the word "Halwai" which are, in my view, the dominant elements of Mr Ahmad's trade mark.

17. Turning now to distinctiveness, in its submissions the applicant argues that the word gourmet has a "low level of distinctiveness." Bearing in mind the very well known meaning of the word gourmet in relation to foodstuffs, I think that the word per se has very little if any distinctive character. As to the word Halwai, in its counterstatement the applicant argues, by reference to an extract from Wikipedia, that this word is descriptive of confectionery as it relates to confectioners and sweet makers in India. In its submissions, it also provides a screen shot of a Google search for the term "halwai uk"; the quality of this extract (which appears to refer to a number of positions for pastry chefs) is very poor. If the applicant wished to rely upon such evidence it should have been attached as an exhibit to a witness statement, it should not have been filed as part of its submissions.

18. Although the "evidence" from the applicant leaves a great deal to be desired, as it raised the issue of the non-distinctive/descriptive nature of the word Halwai in both its counterstatement and submissions, and as the opponent has not (as far as I can tell) challenged or even commented upon it, I am prepared to accept that the word Halwai has the meaning the opponent suggests. As I have already concluded that the word gourmet per se will have very little if any distinctive character, it is a dominant but not

distinctive element of both trade marks. As the words “OF LAHORE” and “& Bakers” are either de minimis/descriptive (or both), they are neither distinctive nor dominant elements of either trade mark; that leaves the word Halwai. For those average consumers familiar with this word, it will be a less dominant and non-distinctive element of the competing trade marks. For this average consumer the distinctiveness of both parties’ trade marks must lie in the stylisation of the word gourmet and the manner in which the various elements are configured. However, for those average consumers unfamiliar with the word Halwai, it may be treated as, for example, an invented word or surname, and will in those circumstances, be a distinctive if not dominant element of both parties’ trade marks.

Visual similarity

19. In its submissions the opponent describes the visual similarity in the following terms:

“3...What is more apparent is that both marks appear in script form. There are elements of visual similarity in the placing of the letters. In each case the G appears as a script mark with a curling upper tail and with a circular element to the G that connects at the bottom. The R has a tail that goes over and above the M. The word HALWAI appears below. The H starts directly below the letter U and the letter I at the end of HALWAI ends below the second stroke of the M...”

20. Notwithstanding the differences between the computer generated/hand written nature of the competing trade marks, the similarity in the presentation of the word gourmet in the competing trade marks together (albeit to a lesser extent) with the placement of the word HALWAI, results in a high degree of visual similarity overall.

Aural similarity

21. While it is possible that both parties’ trade marks will be referred to as totalities i.e. gourmet HALWAI OF LAHORE and gourmet Halwai & Bakers (which would result in a high degree of aural similarity in any case), more likely, in my view, they will be referred to as gourmet Halwai i.e. they will be aurally identical.

Conceptual similarity

22. In its submission the applicant says:

“It is also denied that there are no conceptual differences between the marks. Again, the marks must be considered as a whole. The [applicant’s] mark when taken as a whole, gives the impression of a particular business entity originating in or connected to the place, Lahore. In contrast, the [Mr Ahmad’s] trade mark when taken as a whole will be interpreted as referring to a gourmet product e.g. Halwai or bakery goods...”

23. In his submissions Mr Ahmad says:

“11...Rather the application gives the impression of being a branch or subdivision of the registration and both marks can be interpreted as referring to products...”

24. The inclusion in both parties' trade marks of the well known word gourmet will create similar conceptual imagery in the mind of the average consumer. For those average consumers familiar with the word Halwai this will further define the nature of the goods, and the applicant's trade mark is, as the applicant suggests, likely to convey the impression of gourmet halwai products from an undertaking based in or connected with Lahore. For the same average consumer Mr Ahmad's trade mark is likely to convey an image of a baker or bakery that produces gourmet halwai products. However, for the average consumer unfamiliar with the word Halwai the conceptual picture of the respective trade marks may be one of, for example, a gourmet product produced by a baker or bakery called Halwai or of a gourmet product produced by an undertaking called Halwai based in Lahore. Regardless of exactly how the competing trade marks are construed, they are, in my view, likely to be conceptually similar to a high degree.

Distinctive character of Mr Ahmad's earlier trade mark

25. I must now assess the distinctive character of Mr Ahmad's earlier trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the goods for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. I have already concluded that the word gourmet is likely to lack distinctive character. For those average consumers familiar with the word Halwai it too is likely to lack distinctive character. As I further concluded that the symbol and word “& Bakers” would be wholly descriptive, for this average consumer whatever distinctive character Mr Ahmad's earlier trade mark possesses must lie in the degree of stylisation present and the manner in which the various elements are configured. Considered in this context, Mr Ahmad's earlier trade mark is, in my view, possessed of a low degree of inherent distinctive character. For those average consumers unfamiliar with the word Halwai, its presence increases the degree of inherent distinctive character, although given its size relative to the word gourmet, in my view, to a limited degree.

Likelihood of confusion

26. In determining whether there is a likelihood of confusion, 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 vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of Mr Ahmad's earlier trade mark as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind.

27. Earlier in this decision I concluded that: (i) the competing goods were identical, (ii) the average consumer would select the goods by predominantly visual means and would pay a low degree of attention when doing so, (iii) the competing trade marks were visually and conceptually highly similar and at least highly similar aurally and (iv) Mr Ahmad's trade mark was possessed of (at worst) a low degree of inherent distinctive character.

28. In reaching a conclusion on the likelihood of confusion, I remind myself that the applicant's trade mark is presented in colour. However, as Mr Ahmad's trade mark is presented in black and white this does not, for the reasons given by Mann J in *Specsavers International Healthcare Ltd v Asda Stores Ltd (No. 2)* [2011] FSR 1, assist in distinguishing the competing trade marks. Finally, I also bear in mind that in its submissions the applicant says that it has used its trade mark and there have been no instances of confusion. However, as neither party has filed any evidence in these proceedings this is not a factor that assists the applicant.

29. Having weighed the various factors, I have come to the conclusion that when considered from the standpoint of the average consumer familiar with the word Halwai, and notwithstanding the non-distinctive/descriptive nature of the words gourmet and Halwai in the competing trade marks and the low degree of inherent distinctive character Mr Ahmad's trade mark enjoys, the similarities in the competing trade marks are simply so great that a likelihood of direct confusion i.e. where the applicant's goods will be mistaken for those of Mr Ahmad is inevitable. I reach the same conclusion in relation to an average consumer for whom the word Halwai will operate as a distinctive if not dominant element, because in those circumstances the word Halwai will, regardless of its size, be the only element in both parties' trade marks likely to be accorded trade mark significance.

Overall conclusion

30. Mr Ahmad's opposition succeeds in full.

Costs

31. As Mr Ahmad has been successful he is entitled to a contribution towards his costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to Mr Ahmad on the following basis:

Preparing a statement and considering the applicant's statement:	£200
Opposition fee:	£200
Written submissions:	£300
Total:	£700

32. I order Gourmet of London Ltd to pay to Imtiaz Ahmad the sum of **£700**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3rd day of June 2013

C J BOWEN
For the Registrar
The Comptroller-General