

O-384-13

**TRADE MARKS ACT 1994**

**In the matter of (1) United Kingdom Trade Mark Application No 2576986**

**Pooja Sweets & Savouries stylised words, and**

**(2) UK Trade Mark Registration No 2401680**

**Pooja Sweets & Savouries composite device**

**both in classes 29, 30, 35, 43**

**in the name of Pooja Sweets & Savouries Limited**

**-and-**

**In the matter of consolidated**

**(1) Opposition No 102596, and**

**(2) Application for a declaration of invalidity No 84010**

**by Pooja Sweets Limited**

**Mr Tim Austen, of counsel, (instructed by Bison Rivers) appeared on behalf of Pooja Sweets & Savouries Limited.**

**Ms Heema, of counsel, appeared on behalf of Pooja Sweets Limited.**

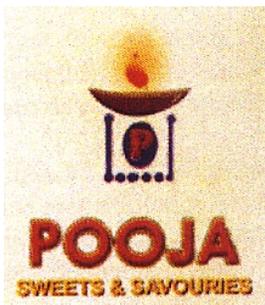
**Hearing date: 18 June 2013.**

**Written submissions were received on 6 September 2013 in relation to evidence filed after the hearing.**

1) In 2007 Pooja Sweets & Savouries Limited (Tooting) became aware that company number 6364901 had incorporated under the name Pooja Sweets & Savouries Limited (Wolverhampton). The incorporation took place on 10 September 2007. At the time of the incorporation the company had an address in Middlesex. The officers of the company were Illa Shah and Talukder Miah, both of the same address in Middlesex. Tooting made a complaint to Companies House. Companies House decided that the company name was too like that of Tooting and, on 5 November 2007, directed that the company should change its name. On 24 January 2008 the name of the company was changed to Pooja Sweets Limited. As of 19 May 2012 the company was dormant. At this date, it also had an address in Wolverhampton and is the undertaking attacking the registration and application of Tooting. The company is now active.

2) Tooting became aware of a business using a trade mark similar to the trade mark that it had been using; a business that was providing the same types of goods, Wolverhampton. Tooting approached Wolverhampton to ask it to change its name. Edwin Coe was then instructed by Tooting to assist it. Imran Salim states that Tooting tried to reach a settlement with Wolverhampton. A meeting was arranged with Mr Joshi, of Wolverhampton, and his advisers in the offices of Edwin Coe for 12 January 2011. Mr Joshi did not attend and so there was a discussion with a Mr Shah. Imran Salim states that it became clear during the meeting that Mr Joshi, albeit conveyed through his advisers, objected to Tooting using the name Pooja as the Salim family<sup>1</sup> is Muslim and use of the name by Tooting would be against principles of morality and that Hindus would be misled by the name of the business. Imran Salim states that he is troubled that a commercial dispute has been turned into “a groundless religious and racial dispute”.

3) On 9 March 2011, Wolverhampton filed an application for a declaration of invalidation of Tooting’s trade mark registration, no 2401680. The registration is for a series of two trade marks:



No claim or limitation to colour is made in respect of the first trade mark. The application for the registration of the trade marks was made on 16 September

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<sup>1</sup> Tooting’s business is run for the most part by Naila Salim, Shahid Salim and Imran Salim.

2005 and the registration procedure was completed on 3 November 2006. The trade marks are registered for:

Class 29

*Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats; dried herbs; prepared meals and snacks included in this class.*

Class 30

*Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; prepared meals and snacks included in this class.*

Class 35

*The bringing together, for the benefit of others, of a variety of foods and drinks and preparations for foods and drinks, enabling customers to conveniently view and purchase those goods; mail order retail services connected with foods and drinks and preparations for foods and drinks; the bringing together, for the benefit of others, of a variety of foods and drinks and preparations for foods and drinks, enabling customers to conveniently view and purchase those goods from a catalogue or by mail order or by means of telecommunications; electronic shopping retail services connected with foods and drinks and preparations for foods and drinks; information, consultancy and advisory services including helpline services relating to all the aforesaid services.*

Class 43

*Services for providing food and drink; restaurant, takeaway, cafe and bar services; catering services; sandwich and snack bar services; preparation and serving of food and beverages; information, consultancy and advisory services including helpline services relating to all the aforesaid services.*

The application for invalidation was served upon Tooting on 9 May 2011.

4) On 31 March 2011, Tooting applied to register a series of two trade marks:

**POOJA**  
SWEETS & SAVOURIES



No claim or limitation to colour is made in respect of the second trade mark. The application for the registration of the trade marks was made on 31 March 2011. The trade marks were published on 29 July 2011 with the following specification:

Class 29

*Preserved, frozen, dried and cooked fruits and vegetables; Asian fruit, vegetables and savouries; jellies, jams, compotes, fruit sauces, preserves; eggs, milk and milk products; edible oils and fats; dried herbs; prepared, cooked and frozen meals and snacks included in this class; cold savoury snacks (chaat); prepared nuts; nut products; Bombay mix; potato snack products; pickles.*

Class 30

*Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; prepared, cooked and frozen meals and snacks included in this class; chutneys; cream cakes, fresh cream cakes, iced cakes; ice cream including kulfi; frozen cakes, confectionery, desserts, pastries and yoghurt; Asian sweets and confectionery; breads including buns, bread bases, biscuits, bread rolls, bread sticks, fruit breads, garlic bread, pita bread, naan bread, chapattis, poppadoms, parathas, unleavened bread, wholemeal bread, baguettes, croissants, sandwiches, bagels and wraps.*

Class 35

*Advertising; business management; business administration; office functions; retail services connected with foods and drinks and preparations for foods and drinks; the bringing together, for the benefit of others, of a variety of foods and drinks and preparations for foods and drinks, enabling customers to conveniently view and purchase those goods; mail order retail services connected with foods and drinks and preparations for foods and drinks; the bringing together, for the benefit of others, of a variety of foods and drinks and preparations for foods and drinks, enabling customers to conveniently view and purchase those goods from a catalogue or by mail order or by means of telecommunications; electronic shopping retail services connected with foods and drinks and preparations for foods and drinks; information, consultancy and advisory services relating to all the aforesaid services.*

Class 43

*Services for providing food and drink; restaurant, takeaway, cafe and bar services; catering services; sandwich and snack bar services; preparation and serving of food and beverages; services for the provision of fast foods including Asian foods; information, consultancy and advisory services relating to all the aforesaid services.*

5) The grounds of invalidation and opposition are very similar. The grounds are diffuse and rambling. Unfortunately, at the hearing, Ms Heema, counsel for Wolverhampton, gave the grounds no greater specificity or precision. She did not specifically refer to certain of the grounds and others she continued to maintain, despite the evidence and facts of the case clearly showing that they had no legs upon which to run. This lack of precision was not aided by the receipt of two separate skeleton arguments; the second after the deadline. The second skeleton argument relied upon, inter alia, guidelines from the World Intellectual Property Organisation, which are neither binding nor persuasive.

6) Wolverhampton has attacked all of the goods and services of the registration and the application without distinction.

7) Wolverhampton attacks under sections 3(1)(b), (c) and (d) of the Trade Marks Act 1994 (the Act) which state:

Section 3(1) of the Act states:

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

.....

(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, 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.”

8) In relation to the registration, under section 3(1)(b) of the Act, Wolverhampton claims that the trade marks are generic. It claims that SWEETS & SAVOURIES are used in a functional manner, referring to opposite tastes. It claims that the trade marks include a lamp design, which is a major Hindu religious symbol. Wolverhampton claims that POOJA, which may also be spelt puja, gives the trade marks a religious quality or acts "as an approval mark". In relation to section 3(1)(c) of the Act, Wolverhampton claims that POOJA immediately indicates or suggests purity of the ingredients and devotion in the manner of preparation, or "proper religious approval". Wolverhampton claims that "[t]he public and different generations of immigrants to the UK have therefore been led to believe that a certain type of product is being sold or available through that undertaking and essentially holy or blessed". Wolverhampton claims that pooja is used in relation to sweets and savouries which are exchanged at Hindu festivals. In relation to section 3(1)(d) of the Act, Wolverhampton claims that all of the words of the trade marks have been used in trade locally and worldwide for centuries. It claims that there are numerous sweet and savoury snacks that Hindus consume at poojas or major Hindu festivals. Wolverhampton claims that it is established practice and customary for traders who provide sweets and savouries for the purpose of pooja to "be called Pooja sweets and similar marks".

9) The basis of the claims under section 3(1) in relation to the opposition is fundamentally the same.

10) Wolverhampton attacks under section 3(6) of the Act. Section 3(6) of the Act states:

"A trade mark shall not be registered if or to the extent that the application is made in bad faith."

11) In relation to the registration, Wolverhampton claims that the application was made in bad faith as the application included meat products whereas Hinduism advocates vegetarianism. It claims that during poojas, food must be especially pure, since it is offered to Hindu deities and may be distributed in temples. Wolverhampton claims that pundits and strict Hindus are vegetarian. It claims that no devotee would wish for meat or fish products to be associated with pooja. Wolverhampton claims that the nature of the trade marks imply that the ingredients respect the Hindu religion and that the preparation is done with devotion and love of the Hindu faith. It states that in the case of the proprietor this is not the case. Wolverhampton claims that it is "contrary to the principles of equity, the rule of law and the human right to religion that any Hindu, Pundits, temple or Hindu trader and devotees should have their own religious words and symbols subject to IP or the economic rights of a non-Hindu who has appropriated it through simple registration".

12) In relation to the section 3(6) attack on the application, Wolverhampton relies upon all of the grounds it has raised under sections 3(1)(b), (c) and (d), 3(3)(a),

3(3)(b), 3(3)(6)(sic) and 5(4)(a) of the Act and “further UK Laws, EU Laws and Human Rights Law”. It states that “these reasons were generally known to the Applicant prior to its application to register the mark applied for”. Wolverhampton claims that the trade marks of the application are almost identical to those of the registration in relation to which it has filed an application for invalidation. Wolverhampton claims that Tooting knew that it was seeking to invalidate the registration. Wolverhampton claims that Tooting are Muslims and not vegetarians and that the specification remains in conflict with the notion of devoutly prepared food fit for pooja. Wolverhampton states that it believes that the application was made with the intention of circumventing the trade mark invalidation process.

13) Wolverhampton attacks under sections 3(3)(a) and (b) of the Act, which state:

“(3) A trade mark shall not be registered if it is-  
(a) contrary to public policy or to accepted principles of morality,

or

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service)”

14) Wolverhampton claims that pooja is a key word in Hinduism and its registration and appropriation is offensive to Hinduism. Wolverhampton claims that the trade marks are deceptive as they give the impression that the food is prepared by devout Hindus and is fit for poojas and pure enough for offering in temples.

15) Wolverhampton claims that the trade marks are unlawful under the Trade Descriptions Act 1968 and the Consumer Protection for Unfair Trading Regulations 2008. These grounds do not add anything to the claim that the trade marks are of such a nature as to deceive the public (as per section 3(3)(b)).

16) Wolverhampton attacks the trade marks under section 3(4) of the Act, which states:

“(4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community law.”

It claims that the trade marks breach the rights of Hindus to manifest the Hindu religion as guaranteed under article 9 of the “Convention for the Protection of Human Rights and Fundamental Freedoms (freedom of thought, conscience and religion).” Wolverhampton claims that the trade marks also breach articles 1 and 14 of the Convention.

17) In relation to the invalidation, Wolverhampton also refers to provisions of Directive 2008/95/EC of the European Parliament and the Council of 22 October 2008 (the Directive). These for the most part simply reiterate the grounds made under the Act, which implements the Directive. Included in this part of the grounds is a reference to article 3(1)(a) – signs which cannot constitute a trade mark. As Arnold J held in *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418(Ch), this part of the Act relates to signs incapable of distinguishing any goods or services. On the basis of the pleadings and the evidence there is no basis for such a claim.

18) Wolverhampton also prays in aid article 3(2)(b) of the Directive; this part of the Directive is discretionary on member states and has not been implemented in the United Kingdom and so cannot form the basis of a ground of invalidation. Wolverhampton also prays in aid article 4(4)(c)(iii) of the Directive, which relates to copyright. (It has not pleaded the United Kingdom implementation of this part of the Directive, section 5(4)(b) of the Act.) Wolverhampton claims that the trade marks infringe the copyright of Hindu religious scriptures. To infringe copyright there needs to be an author and a work, neither of which is identified; a word does not constitute a work. The word *pooja* is not owned by anyone. This ground of invalidation has, therefore, no basis. (There are also time limits to the duration of copyright.)

19) Wolverhampton relies upon section 5(4)(a) of the Act which states:

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

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

The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

“The law of passing off can be summarised in one short, general proposition: no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public

(whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

20) In the opposition, Wolverhampton relies upon a word and device trade mark:



21) In the application for invalidation it also relies upon the word only trade mark: POOJA SWEETS & SAVOURIES.

22) Wolverhampton claims that Mr Ram Joshi started using the above trade marks in 2003 in Wolverhampton. It claims that the trade marks have been used in relation to:

dried and cooked fruits and vegetables, jellies, jams, eggs, milk and milk products, edible oils and fats, dried herbs, prepared meals, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking powder, salt, mustard, vinegar, sauces (condiments), spices, ice, prepared meals, non-alcoholic drinks, fruit drinks and fruit juices, syrups for making beverages, advertising, provision of business information, services for providing food and drink, restaurant, bar and catering services.

Parts of the grounds given by Wolverhampton have nothing to do with the law of passing-off. Wolverhampton claims that Mr Joshi, trading as Pooja Sweets & Savouries, has through his use “acquired unregistered common law rights in the trade mark”.

23) Tooting filed counterstatements denying the grounds of invalidation and opposition. In these grounds it noted that pooja has many meanings, including ritual worship and a girl's name. Tooting claims that it has been trading under the trade marks of the registration and/or the application since 1996.

### *Evidence of Tooting*

24) In 1993 Shahid Salim began to work for Prashad Sweets, based at 168, Upper Tooting Road. In 1996 Shahid Salim and a family friend, Dipta Patel purchased the business of Chetnas at 170, Upper Tooting Road. This business started on 24 May 1996. Shahid Salim describes Ms Patel as a silent partner. It was decided to use the name Pooja Sweets for the business. Shahid Salim states that the name was chosen as it was in keeping with the existing trade in making vegetarian sweets and savouries. Shahid Salim also states that he used the nickname Pooja for Ms Patel.

25) In 1997, Manishaben Patel, a Hindu, joined the business. Shahid Salim describes her as an invaluable person to the family. Also in 1997, Tooting signed an agreement to share premises in Green Street, E7.

26) Since 1998 Tooting has been advertising with Litt Media, which operates Sunrise Radio, Kismat Radio, Buzz Asia and Punjab Radio. Tooting has also been advertising in the weekly paper Gujarat Samachar, published from London, for over 15 years; it has also advertised in Diwali special magazines from the same publisher.

27) In 2001, Prashad Sweets of 168 Upper Tooting Road was purchased and this was branded Pooja Sweets & Savouries. The premises at 170 Upper Tooting Road operated as Pooja Chaat House, specialising in Indian style cold savoury snacks. In 2002, Pooja Chaat House was moved to Pooja Sweets & Savouries at 168 Upper Tooting Road. On 21 June 2002 the Pooja Chat House section was inaugurated by Ravi Sharma Ji and Sarita Sabharwal of Sunrise Radio, the latter presented a show from the business premises on the radio.

28) Shahid Salim states that the success of the business led to its incorporation as Pooja Sweet & Savouries Limited on 18 October 2002. The business has continued to operate as a limited company.

29) Prior to 2002, the business at 170 Upper Tooting Road was renamed Shireen Mahal as a way of catering predominantly for the Muslim community; that business also serves sweets and savouries. The businesses at 168 and 170 were merged in April 2004 to trade under the common name Pooja Sweets & Savouries; both also incorporating the Shireen Mahal name.

30) In 2005, Ms Patel was made a director of the company to recognise her part in the business.

31) On 14 September 2009 the name of the company was changed to Pooja Sweets & Savouries Limited.

32) On 24 March 2011 a second shop was opened in Kingsbury NW9.

33) Vegetarian sweets and savouries are supplied to all religions and Tooting supplies goods for festivals, celebrations, group meetings and special events.

The religious background of Tooting is well-known to its customers. Tooting also produces and sells goods under the Pooja Sweets & Savouries brand for special cultural and religious festivals, with ingredients which are appropriate for these events.

34) Naila Salim states that at no time has Tooting misled the Indian/Hindu community as to the background of the business. The Hindu customers of the business have never complained about the products that Tooting sells. A picture of Naila Salim appears on Tooting's website which shows her in Islamic dress.

35) The business celebrates Diwali, Eid and Christmas.

36) Tooting has used POOJA since 1996 in relation to sweet and savoury products; including samosas, pakorahs, Lebanese sweets, cakes, bakery items, hot and cold savouries, nut allergy products and sweets and goods that are for specific times of the year, such as Diwali and Ramadan.

37) A number of letters have been submitted by Tooting. The ones referred to in this paragraph have, for the most part, been solicited for the proceedings. They will be treated as hearsay evidence. Letters from B4U Network Ltd and Asia TV Limited comment in very much the same terms about their relationship with Tooting and that they have obtained sweets for special events such as Diwali<sup>2</sup>. (The two letters being written in almost identical terms lessens the weight that can be attributed to them.) Nailesh Patel of the South London Association has provided a letter advising that Tooting has supplied completely vegetarian catering for its functions for 14 years. A letter from the *Punjab Mail International* advises that Tooting has been advertising with the magazine and that Tooting supplies sweets to the Punjabi Sikh community. A letter from the Hindu Society advises that Tooting has supported the society by advertising in its brochure each year. The society also advises that it recommends Tooting's products to its members. The Caribbean Hindu Society sent a letter on 30 April 2012 to Tooting in thanks for a "contribution of sweets, which was very much appreciated by all of our members who attended the Temple for the Nawratri<sup>3</sup> event" (not a letter solicited for the proceedings). A letter from the Khalsa Centre advises that it has been buying sweets and savouries from Tooting since it opened in 1996. The products provided have been vegetarian. The sweets and savouries have been used at small private functions, at large Sikh festivals and at weddings. The centre is not concerned that the owners are Hindu and Muslim, only that the products are vegetarian. A letter from Media Bazaar Limited advises that Tooting has been advertising in *Cineblitz* magazine since 1996. It advises that Tooting's sweets are often used by it during its annual Diwali puja ceremonies. A letter from Pravin Pattni of Minar Jewellers advises that during Diwali he has purchased sweets from Tooting for personal consumption and for his customers.

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<sup>2</sup> A Hindu festival.

<sup>3</sup> A Hindu festival.

38) Tooting's business has been promoted by flyers, calendars, bags and advertisements in the media. The calendars have included details of both Hindu and Muslim festivals.

39) Tooting has been given "Good Neighbour" status by Tooting Together, a vehicle of Wandsworth Council (Imran Salim 1 page 118). The advertising has made it plain that Tooting caters for festivals such as Eid, Diwali and Christmas (see Imran Salim 1 page 125 for example – the advertisement in *Nawai Jung* newspaper also uses the trade mark the subject of the application<sup>4</sup>). This advertising has been, inter alia, in media aimed at persons with an ethnic origin from the Indian sub-continent. Tooting has advertised since 1998 on Sunshine Radio, Kismet and Buzz Asia. It has advertised on the following television channels: Prime TV, B4U, B4U Music, Islam Channel, Colours TV, Asia TV Ltd t/a zz tv, Sony Max, Sony Entertainment Television, Takbeer TV, NTV, Venus TV, Geo, Star Plus, Noor TV and DM Digital Global Television Network Limited. Exhibit 181 to Imran Salim 1 consists of a flash drive that has a number of radio and television advertisements. The television advertisements include specific advertisements for Eid and Diwali. (In the context of the section 3(1) objections to the trade mark registration, it is noted that the advertisement includes a picture of a lamp.) Tooting was active in the Tooting Foodival 2009 (Imran Salim 1 pages 160 and 161).

40) In a witness statement, Gopal Gobiratnam states that he is editor in chief of *Oru Paper*, a bilingual newspaper published in London. He states that Tooting has been advertising in his newspaper since 2010. Ali Raza is the general manager of Prime TV. Ali Raza states that Prime TV is one of the most established and long running ethnic television channels (Sky 792). The channel caters to both the Muslim and Hindu communities. He states that Tooting has advertised on the channel. Jayantibhai Solanki is the advertising manager of Asian Media & Marketing Group. He states that Tooting has been advertising in its publications for 15 years.

41) Tooting has been mentioned in the *Financial Times*, in an article from 6/7 June 2009 on samosas. Inter alia, articles about Tooting or referring to Tooting have appeared in *Tandoor Magazine* (a magazine that proclaims that it is mailed directly to all of the curry restaurants in the European Union) and *The Post* (a newspaper for Mitcham, Morden & Wimbledon). A press article about sub-continental confectioners, exhibited at Imran Salim 1 page 162, without reference to the publication in which it appears, includes a reference to Tooting:

"Pooja is one of my favourites (170 Upper Tooting Road). Although the owners are Pakistani, Pooja specialises in Gujarati sweets and also sells savoury snacks such as a range of Bombay mixes with gram flour vermicelli, *dhal* of different types, nuts and sultanas....."

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<sup>4</sup> It is noted that the ® symbol appears after Pooja although this particular trade mark is not registered, however, this is not the norm.

42) Tooting was a finalist in the Wandsworth Business Awards 2005.

43) The evidence includes photographs of the staff of Tooting, which include Naila Salim in traditional Muslim dress (eg Imran Salim 1 page 188). Tooting has promoted its business at various Muslim events eg a Family Funday and an event explaining Islam (Imran Salim 1 pages 206 and 210). Naila Salim accompanied the MP for Tooting, Sadiq Khan, to a reception held in Downing Street in June 2008. At pages 213 et seq of Imran Salim 1 are photographs of Naila Salim with the then prime minister, Gordon Brown, and photographs of her outside 10, Downing Street. At page 217 of Imran Salim 1 is a page from *Moving Here Stories* from sometime in late 2003/early 2004 (as per page 218 of Imran Salim 1). In the article Naila Salim tells about her life in Tooting and about the Pooja business. She comments upon how busy the business is at Diwali. Tooting has been mentioned in *Tooting town centre news* (page 242 to Imran Salim 1).

44) Tooting has had a website at [poojasweets.com](http://poojasweets.com) since 2003. Pages 46 – 68 to Imran Salim 1 give details and examples of the website from the Wayback Machine. These examples show use of the trade mark of the registration as of 27 July 2003. The pages also show use of the trade mark the subject of the application; the first use shown in the exhibit is 26 September 2003. In the “about us” section of the website, the visitor is advised that the business was started in 1996 by “Dipti Patel, an Indian and Shahid Salim and Naila Salim of Pakistani National”.

45) The Pooja signage has been prominent on the premises in Tooting, as is shown by many photographs eg pages 235 and 238 showing “existing signage” and pages 243 and 247 to Imran Salim 1.

46) Manishabel Patel, a Hindu employed by Tooting, states that Pooja is not a sacred term and that many Hindus eat meat. Pundit Shyam Sunder Sharma has been working as a Hindu priest in the United Kingdom since 2002. He does not see that there is anything that precludes Tooting using the term Pooja and states that he has been purchasing sweets from Tooting since 2002. Pundit Ravi Sharma has been a Hindu priest for 40 years. He does not consider that there is anything to stop a non-Hindu using the words Puja or Pooja in relation to a business or as a forename. Indeed, Pundit Ravi Sharma states that Pooja is a very suitable name for the vegetarian sweet shop. In an e-mail from Pundit Ravi Sharma adduced by Wolverhampton, he states:

“I think it is more a commercial dispute than the religious matter.”

47) In a witness statement, Rajan Bhatia of Mazza, states that Mazza manufactures pure vegetarian sweets, snacks and savouries. Mazza has been supplying Tooting since 2004. Rajan Bhatia attaches a list of businesses that use the name Pooja in India. He states that the majority of the sweets are manufactured for Tooting by Mazza. Rajan Bhatia supports Tooting in continuing its business under its name. Mazza is run by “devoted and practicing Hindus and

strictly vegetarians". A witness statement has been supplied by Mahendra Thaka, president of the Sarvodaya Hindu Association, which has around 325 families registered with it in Kingston-upon-Thames. The association has purchased sweets and snacks from Tooting for more than 10 years. It buys these for events such as Shivrati, Ramnavami, Janmastmi, Diwali and Navratri. The association has members with both liberal and orthodox views and it needs to satisfy both sets. The association has been completely satisfied with the goods of Tooting and the executive committee is fully aware of the religious and cultural backgrounds of the proprietors and staff of Tooting. In a witness statement, Parag Pandya states that he and his family regularly buy mithai (sweets) from Tooting for the local Hindu temple and for special religious occasions. Sudarshan Singh Bharje is chairman of the Apna Elderly Social Group and a devout Hindu. Sudarshan Singh Bharje states that Tooting's products are well-known to be vegetarian. The association celebrates many festivals for which Tooting supplies the catering: Diwali, Vaisakhi, Indian republic days, Christmas and birthdays. He states that it is known that the proprietors are Muslim and Hindu. Nagendram Seevaratnam is spiritual leader and founder of Sivayogam, which owns two Hindu temples; one in Tooting and one in Wembley. Nagendram Seevaratnam states that the products of Tooting are vegetarian and that more than 90% of the congregation offering sweets at the temple in Tooting purchase them from Tooting. He states that Pooja means service and that his nephew has named his daughter Pooja. Rabin Aich is founder of the Tooting Durga Puja Committee. For 25 years the committee has been organising an annual Hindu festival in the Tooting temple. Guests and devotees buy their various boxes of sweets from Tooting for their offerings to the gods and goddesses. Rabin Aich states that "Tooting not only supply their sweets in hundreds for our puja festivals but also supply fresh and delicious vegetarian meals". Bhependra Patel, a director of Sapna Products Limited, states that his company has been supplying Tooting with frozen vegetarian snacks since 2003; prior to this, from 1996, Oriental Foods Limited, of which he was a joint owner, supplied products to Tooting. Bhupendra Patel states that in his 16 years acquaintance with Tooting he has not heard a single derogatory comment "from businesses, consumers or the local and extended communities and in particular of any complaints or objection relating to the use of the company name by its non Hindu founder". He states that Tooting sells only pure and unadulterated vegetarian food. Chandrakant Shah is chairman of a voluntary group called Balham Milap Group. The group purchases the products of Tooting for its gatherings as well as for religious celebrations. There are further witness statements with similar statements from Shabaz Ahmed of UK Snacks Ltd and Mahendra Thakar in his rôle as chairman of Global Arts, Indrajit Patel of Tooting Business Network, Naveed Ahmed of Bina Supplies Limited, Sunil Pandya of Anand Pan Centre & Ice Cream Parlour, Farhad Ahmed MBE chairman of Balham & Tooting Community Association and Abdul Razaak Osman, treasurer of the Tooting Islamic Centre.

*Evidence of Wolverhampton*

48) Mr Ram Joshi, the owner of Wolverhampton, has given evidence. Mr Joshi began using Pooja in relation to cooked food products and catering services in September 2003. He states that he uses Pooja Sweets & Savouries in relation to the business. Pictures of the outside of the shop simply show Pooja Sweets on the signage. As both "sweets and savouries" and "sweets" are without distinctive character for the goods and services, and the issues in these proceedings relate to use of Pooja, nothing turns upon this. Mr Joshi states that when he started the business he wished to target the Hindus in the region and supply them with foods that are suitable for poojas. He states that he uses pooja as it is an auspicious name and immediately descriptive for the end customer. Mr Joshi states that he uses Pooja in relation to all of his products, packaging and catering services. The products are vegetarian and, Mr Joshi states, suitable to be used as prashad for anyone having a pooja at home. Prashad is the type of food that is given as an offering at poojas, as Mr Joshi confirmed under cross-examination:

"A. Yes.

Q. As I understand it, you sell sweets.

A. Yes, sweet and savoury.

Q. Absolutely. If such sweets are appropriate to be offered to the gods, you might call them prashad?

A. Yes.....

.....

Q. In the final paragraph, Mr. Mehan says, "Every year, Ram donates money to the temple and donates sweets on special and auspicious occasions."

A. Yes.

Q. That is correct?

A. That is correct.

Q. Then he says, "They are offered during Pooja to the deities and as Prashad for devotees."

A. Yes.

Q. That is right, is it not?

A. Yes.

Q. As I understand from this -- I am sorry, but my Hinduism is not necessarily that good -- Pooja is the name of the act of worship in Hinduism and Prashad is the name of the offering. Pooja is quite an auspicious name; is that right?

A. It is my daughter's name."

49) Anyone handling the food of Wolverhampton is a Hindu. Mr Joshi states that his family is very strict about food used for prashad. He states that a Hindu wedding requires angni pooja to be performed, where the couple walk around the sacred fire together. The food offerings are part of the ceremony and the bride and groom place sweets into each other's mouth (something that can be seen in the television advertisements of Tooting). Mr Joshi emphasises what the staff in

Wolverhampton do when a customer comes in for prashad; special precautions/actions have to be taken. This shows that not everything sold under the shop under the name pooja is prashad. Mr Joshi clearly distinguishes between two types of product. Mr Joshi comments upon the business of his shop and its position in the community. However, owing to the findings that are made in relation to passing-off and senior user, there is no need to summarise that part of the evidence.

50) Mr Joshi states “[t]he owners of the company in Tooting, who are Muslim from Pakistan have registered a sacred Hindu name and by this are mocking Hinduism”. Mr Joshi states that “[w]hen you label cooked food products with the word Pooja, it’s automatic for a customer to think that the food can be used for Pooja”. Mr Joshi states that “[t]hey shouldn’t be using the same name [pooja] as they are soiling it”. Mr Joshi states that if an “unsuspecting Hindu seeing the Pooja marked food shop in Tooting would think that it would be suitable for Pooja”. At the same time Mr Joshi makes it clear that it is the prashad food that he sells that is suitable for pooja but he sells non-prashad food and he states all his food and services are sold under the name Pooja. Consequently, Wolverhampton’s position is that it can sell food under the name pooja that is not suitable for pooja and this is not deceptive but when Tooting does this it is deceptive.

51) Mr Joshi states that there are many poojas in the Hindu calendar throughout the year.

52) In a ‘to whom it may concern letter’ from Shree Krishnan Mandir Committee in Wolverhampton (RJ2) the following is written:

“The term puja is now used to include all forms of ceremonial worship, ranging from the simply daily offerings of flowers, fruit, leaves, rice and sweetmeats and water to deities in homes and temples.”

53) In another ‘to whom it may concern letter’ (RJ6), Gavan Datt Shastri describes Pooja as “primarily an individual act rather than a communal one, as it involves making personal offering to the deity”. In another ‘to whom it may concern letter’ (RJ7), Jai Dev Mehan writes that “Pooja means to worship God, to praise God, to think about God”.

54) Exhibited at RJ54, pages 169 and 170, is a description of puja (and archana):

“A puja is a religious ceremony performed in temples or in homes that involves worship through the use of a sacred image. At its most basic level of understanding, puja is a symbolic means of communication, a way to reach out to higher powers. There are many ways that we can reach out to divinity: through prayer, meditation, acts of charity, and so forth, but one of the most import and common means is through ritual. In fact, ritual is the

foundation of worship and all religions employ rituals as a means to contact the Divine. The Christian Eucharist, the Jewish Seder (passover meal), the Islamic practice of bowing towards Mecca, the Buddhist use of the prayer-wheel and, of course, the Hindu puja are all important uses of ritual that allows a worshipper to communicate with higher powers. The word puja derives from the Sanskrit root puj, to honor or respect.

A puja can be short or long, lasting minutes or days, simple or elaborate, involving just the worshipper or many priests and guests, but in every case puja involves the invocation of a Deity as "a guest" in the home, temple or heart of the performer. A puja usually employs some kind of sacred image or photo, which serves as a focal point wherein the "spirit" of the Deity is invited to reside for the duration of the ceremony. The sacred image or photo serves as a kind of "receptacle" to house the spirit of the Deity. The image is usually made of metal, wood or, now a days even plastic, but it could even be just a sketch of a Deity drawn on the ground in sand or earth. One can think of the sacred image as an icon that becomes "switch on" or "surcharged" with the spirit of the Deity during the time of puja. Sometimes, instead of using a specific sacred image or photo, just a coconut with leaves in a copper pot is used as a "generic" receptacle. Any God or Goddess can then be invited into this receptacle for the ritual. Puja can be viewed as either the Deity coming down to man and appearing in a form comprehensible to human beings, or man creating a symbolic form of the Deity that is then used to reach out towards the Deity. In other words, puja can be either a descending process or an ascending process. This is a matter of theology and faith.

Once a particular Deity was been evoked, puja is simply the receiving and adoration of that God or Goddess as a guest. The Deity is then worshiped in a logical and loving manner as one would treat a human guest. A formal puja usually involves 16 separate offerings made to the Deity, but could also involve as many as 27 items of worship or as few as just a couple of items. These items include welcoming and seating of the Deity; washing the feet, hands and mouth; bathing, dressing, ornamentation of the Deity; feeding and worship with incense, lamps and prayers and finally, sending back or releasing the Deity from the receptacle. In its more simple form, puja may only include incense and a lamp. The process is totally malleable and can easily be adjusted to suit the conditions of the worshipper.

Pujas are performed both in temples (mandirs) and in private homes. In temples, they are usually associated with the daily worship of the temple's sacred images and are performed only by priests. They are also performed on special festival days or upon request of individuals by temple priests. In homes, pujas are performed for special occasions such as anniversaries, graduations, the birth of children, memorial days, or

simply for general prosperity and peace within the family. In this case, the family members themselves perform the puja under the guidance of a priest. Commonly performed pujas include Ganesha, Satya Narayana, Durga, and Lakshmi pujas. In fact, a puja can be performed for any God or Goddess or even a combination of Deities. Perhaps the most important part of a puja is the final blessing by the priest and the distribution of prasada at the end. The purpose of a puja is to evoke the presence of a Deity and then to receive the blessing of that Deity. One of the jobs of the priest is to give these blessings. Prasada is the blessed food that has been offered to the Deity during the puja. This food is then offered to all those who have attended the puja. Prasada is the blessing of the Deity.

Hinduism is full of many sacred rituals and colorful ceremonies. These include weddings, the naming of children, hair cutting ceremonies and funerals. Collectively, these ceremonies are called samskaras, rites of passage. Pujas always form the basis of Hindu samskaras and during the course of a marriage, for example, many small pujas will be performed. There may be a dozen pujas contained within the one large marriage ceremony and these pujas involve the invocation of various Gods and Goddess to bless the couple and even the worship of ancestors, pitri-puja, to give blessings to the couple.

#### Archana

Akin to puja is archana. Technically, archana and puja are the same thing and the words could be interchanged, however, in practice puja generally refers to a more formal "sit down" ceremony, while archana is a ceremony performed by a temple priest on a "walk-in basis." Typically, a devotee will come to a temple with a basket of fruits and flowers and perhaps a coconut and the priest will offer these items to the Deity on the altar along with a lamp and prayers. The devotee will then receive the food offerings back as a prasada or blessings from the Deity. This is archana."

55) Exhibited at RJ58 are pages from the website of Hindu Janajagruti Samiti. The website appears to be a vehicle for extreme Hindu views; eg at page 196 the following appears:

"Insolent anti-Hindu Muslims target Hindus, although they are innocent, finding some trivial excuse to pick up a fight with them. There have been a number of such incidents but the police, dancing to the tune of elected representatives, do not take any stringent action which encourages Muslims; therefore, Hindus need to unit now and get ready to fight back and pay Muslims in the same coin."

The website appears, from the extracts, to be largely devoted to recording alleged crimes of Muslims; there are also attacks upon the Congress party and

encouragement to protest against the Communal Violence Bill, which is described as being anti-Hindu.

56) Mr Joshi refers on two occasions to the prosecution of Poojah Caterers of Wellingborough for breaches of hygiene regulations. Poojah Caterers is a supplier to Tooting but has no other connection to Tooting, this prosecution has no bearing upon the standing of Tooting. It can hardly be responsible for the actions of one of its suppliers. Ms Heema raised the matter with Imran Salim during cross-examination:

“Q. Your suppliers, every Thursday, are Pooja Caterers, are they not?

A. Every Thursday. They could come earlier ----

Q. They do come; right? Are you aware that Pooja Caterers were prosecuted by the Council for rat infestation?

A. That was a separate warehouse.

Q. So why did you continue using them?

A. Because, like I said, that was a separate warehouse that you lot kept going on about. You kept going on saying that they have been prosecuted etc. That is fine, but that warehouse was a separate warehouse and they ----“

57) Mr Joshi has also agreed that pooja is used in Buddhism as well as Hinduism; so it is not a word exclusive to Hinduism in relation to religion.

58) Exhibited at RJ97 is a download from the Internet in relation to prasada, another name for prashad. It gives details of what food is appropriate to be classified as prasada. It is noted that the food cannot include onions, garlic or mushrooms. Wolverhampton sells, inter alia, onion bhajis; again it can be seen that not all of the food sold by it is prashad. The prohibition on onions and garlic is also referred to in the material exhibited at RJ103.

59) Exhibited at RJ109 are 20 declarations. There is no information as to how the signatories were chosen. It could be that these are friends or acquaintances of Mr Joshi or Mr Shah, who has been representing Wolverhampton; although not a lawyer. The signatories include a Muslim and a Christian; so it is difficult to see how they can make declarations in relation to Hinduism. There is nothing to allow for the declarations to be considered as representative of Hindus in the United Kingdom. All of the declarants, who make their declarations on the basis of various religious texts, state the same thing in the same words. In *Re Christiansen's TM* [1885] 3 RPC 54 at 60 Lord Esher MR stated:

"Now, to my mind, when you have evidence given upon affidavit, and you find a dozen people, or twenty people, all swearing to exactly the same stereotyped affidavit, if I am called upon to act upon their evidence, it immediately makes me suspect that the affidavits are then not their own views of things and that they have adopted the view of somebody who has

drawn the whole lot of the affidavits, and they adopt that view as a whole and say 'I think that affidavit right' and they put their names to the bottom."

60) Exhibit RJ109 is an attempt to adduce a survey outwith the necessary disciplines and without the permission of the hearing officer. Survey evidence is the subject of Tribunal Practice Notice 2/12:

### **“Survey evidence**

In *esure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 the Court of Appeal considered survey evidence and expert witness evidence:

#### **Arden LJ:**

“62. Firstly, given that the critical issue of confusion of any kind is to be assessed from the viewpoint of the average consumer, it is difficult to see what is gained from the evidence of an expert as to his own opinion where the tribunal is in a position to form its own view.....If more cogent evidence of customer perception is needed, the traditional method of consumer surveys must (subject to my second point) carry more weight and is to be preferred.....

63. ....There is much to be said for the practice initiated by the late Pumfrey J (as he then was) in *O2 Ltd v Hutchison 3G Ltd* [2005] ETMR 61, and subsequently followed by Rimer J in *U K Channel Management Ltd v E!Entertainment Television Inc* [2008] FSR 5. Under this practice, case management directions are given at an interim stage requiring the parties to seek the directions of the court as to the scope or methodology of any proposed consumer survey that the parties may desire to put in evidence at trial. Those directions can then be given in advance of the trial (see, for example, the further proceedings in the *U K Channel Management* case given by Lewison J, [2007] EWHC 2339 (Ch)). “

#### **Kay LJ:**

“82. Where litigation is commenced in the ordinary courts, the calling of expert evidence is now controlled by CPR 35.1. As I understand it, that does not apply to proceedings before a hearing officer in the Trade Marks Registry. Perhaps it should. However, even without its express application, it must be open to the Trade Marks Registry to control the nature and quality of evidence sought to be adduced before it as expert evidence. It should be encouraged to ensure that the sort of evidence that has attracted the disapproval of all three members of this court is excluded. In a case such as this, neither a hearing officer nor a judge in the Chancery Division requires the assistance of an “expert” when evaluating the likelihood of confusion from the standpoint of the average consumer.”

## Survey evidence

The production of survey evidence increases costs for all parties; as the party not producing the survey has the costs of considering the survey evidence.

The production of survey evidence will normally also give rise to delay in the prosecution of proceedings.

If a party intends to draw conclusions from a survey, based upon its statistical validity, it will be necessary to furnish evidence from a suitable expert; adding further to costs and delay.

If a party wishes to adduce survey evidence it must seek the permission of the hearing officer. In seeking the permission of the hearing officer it must advise the hearing officer of all details of how it is intended for the survey to be conducted eg:

- The purpose of the survey
- The questions that are to be put.
- What those interviewed are to be shown as stimulus material.
- The nature of the population sample, in terms of size, social class, gender and location.
- The types of persons who will conduct the survey.
- The instructions that will be given to those people.
- The types of locations where the survey will be conducted.
- Whether it is intended that statistically based conclusions are expected to be drawn from the survey

The hearing officer will consider whether the proposed survey is likely to have any determinative effect upon the proceedings.

If the hearing officer gives permission for survey evidence to be adduced, it will be necessary for it to conform to the criteria set out in the head note to *Imperial Group plc & Another v. Philip Morris Limited & Another* [1984] RPC 293:

“If a survey is to have validity (a) the interviewees must be selected so as to represent a relevant cross-section of the public, (b) the size must be statistically significant, (c) it must be conducted fairly, (d) all the surveys carried out must be disclosed including the number carried out, how they were conducted, and the totality of the persons involved, (e) the totality of

the answers given must be disclosed and made available to the defendant, (f) the questions must not be leading nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put, (h) the exact answers and not some abbreviated form must be recorded, (i) the instructions to the interviewers as to how to carry out the survey must be disclosed and (j) where the answers are coded for computer input, the coding instructions must be disclosed.””

61) There has been no conformity in any shape or form with these requirements. All that the exhibit shows is that a certain number of persons have signed to a set of words. It is not uncommon for counsel, faced with a survey without validity, to fall back on the claim that it is merely being used as a witness gathering survey. Such witnesses, not being obtained from a valid survey, cannot be considered to be representative of the population; as the judgments of the Court of Appeal in *Marks and Spencer PLC v Interflora Inc and Interflora British Unit* [2012] EWCA Civ 1501 and *Interflora Inc and Interflora British Unit v Marks and Spencer Plc* [2013] EWCA Civ 319, make clear.

62) The declarations signed included, inter alia, the following:

“The word “POOJA” and/or any word visually similar, or phonetically equivalent when transmitted, pronounced or presented via any form of communication method, is nonetheless highly religious in meaning and sacred in Hinduism, with a distinct ancient origin and identity the continues to exist today. POOJA has consistently been and remains to be a religious word, comprising of religious goodwill, regardless of how it may be or is currently written, typed, communicated, transliterated, transmitted or disseminated today, and regardless of size colour, dimension, shape, visual, flat or 3D representation, the word in irrevocably a sacred word in the Hindu faith.

“To my/our knowledge, POOJA is a religious word in the Hindu faith, symbolic associative and globally famous. I believe that it is offensive or immoral to a significant number of devout Hindus in the UK and elsewhere if registered as an exclusive trade mark.”

The declarant can sign up to the words of Wolverhampton and, on this basis, sign up to a personal view, but is not in a position to give the view of a “significant number of devout Hindus in the UK”. There is also no clarity as to what the drafter of the declarations means by significant or devout, or what the signer means as he has simply put a signature to a prepared document.

63) Mr Joshi in his witness statements dismisses all those Hindus who support Tooting; it could be inferred that these are not devout in the view of Mr Joshi, but that is his view. It is unknown in what context the declarations were sent and

what the declarants were told. In the evidence of Dr Sharma, who also signed a declaration, he makes statements about Tooting in relation to which he has no basis and which, in fact, it can be seen from the evidence of Tooting, are inaccurate. Consequently, the objectivity and knowledge of Dr Sharma must be treated with circumspection.

64) One of those whose name is on a declaration, but not his signature, is Anil Bhanot of Hindu Council UK.

65) The sorts of claims being made in the declarations, re the view of Hindus, require proper survey evidence and so one returns to the requirements for a survey.

66) It is difficult to square the claims made in these declarations with Wolverhampton using it as the name of its business. If pooja is holy, why and how can it be used by Wolverhampton as a business name for commercial purposes? It is equally difficult to square these claims with Wolverhampton's claim to goodwill in relation to Pooja and its claim that it can prevent the use by others of the word owing to the goodwill.

67) At the end of the exhibit are 8 pages of signatures. It is not known what these signatures are supposed to represent. There is an enormous mixture of persons, including: David Brian Jones, a water engineer; Samantha Macleod, a housewife; Sarah Watson, a Lutheran.

68) Included in exhibit RJ145 are pages from Wikipedia headed "Anti-Hinduism". These pages are indicative of various parts of evidence of Wolverhampton, which attempt to cast the actions of Tooting not as creating or maintaining a business but as being designed to attach Hinduism or mislead Hindus eg the statements of Dr Sharma and Mr Bhakri. Anil Shah has given a witness statement in his capacity as the accountant for Mr Joshi since 1989. Mr Shah also considers it appropriate to make statements with no evidential basis; wherein he states that Tooting is "trying to free ride on the Hindu religion and turn it into a commodity". He also makes the somewhat bizarre comment that "[t]here is no indication that the word POOJA has been assigned to them or sold to them by the Hindu faith and no such transaction appears on the accounts". He does not explain the law that allows the assignment of a word. Assignment of a trade mark can take place and assignment of the goodwill in a business but not a word per se.

*Witness statement of Dr Raj Pandit Sharma*

69) Dr Sharma describes himself as a practising Hindu minister of religion (pandit). Dr Sharma describes himself as the head of the Hindu Priest Association in the United Kingdom. Anil Bahnot of the Hindu Council UK, which Mr Joshi considers a representative body, has stated:

“In fact Raj Pandit Sharma’s Hindu Priest Association has to my knowledge only one member, himself.”

70) Dr Sharma describes himself as a “widely recognised expert on the Hindu religion, our scriptures, sacred texts and regulations”. He is the general secretary of the National Council of Hindu Temples, UK; exhibited at RS1 is a list of the members of the body; there are 88 members. He states that he makes his statement in his official capacity. Dr Sharma states that he is the chief priest of the United Kingdom’s largest Hindu Temple, the Shri Sanatan Hindu Mandir in Wembley. Dr Sharma states that he appears on Radio 4’s *Thought for the Day* and is a regular guest on BBC1’s *The Big Questions*. Dr Sharma is a participant in a weekly television programme broadcast across the world from MATV studios in London which addresses matters related to the Hindu community. He is the Hindu faith advisor of the National Association of Standing Advisory Councils.

71) Dr Sharma comments upon the meaning of pooja and its etymological derivation.

72) Dr Sharma states that a product sold by Tooting came to his attention during a pooja ceremony. He states that printed upon the outside of the box was Shireen Mahal. He states that he recognised that this was not produced by a Hindu establishment and so refused to allow the sweets to be used to perform the pooja service. Dr Sharma states that those preparing the sweets would not be conversant in the Hindu scriptural protocol regarding the preparation for food offerings for poojas. He states that, moreover, “they would be impure for having consumed forbidden substances such as beef”. He states that touching the sweets meant for pooja would be defiling them. Dr Sharma states that food items from a Muslim establishment are completely unfit for offerings to Hindu deities and for prashad.

73) Dr Sharma gives his view of the business of Tooting. He does not give details as to from where this knowledge comes. Dr Sharma states that Tooting was originally called Shireen Mahal and changed its name to mislead Hindus. The matter of the name is inaccurate, as the evidence of Tooting shows that it first used the name Pooja and has used Shireen Mahal in tandem with Pooja at times. Dr Sharma gives no basis for the statement that the name was changed, which it was not, in order to mislead Hindus. Dr Sharma states that he believes that the name change, which there was not, was effected for purely financial reasons.

74) Dr Sharma states that food suitable for pooja is comparable to Kosher products, this food is called prashad. Consequently, pooja is not an equivalent of Kosher, prashad is analogous to kosher; they're being rules about its constituents and preparation.

75) Dr Sharma states that Pooja is a name commonly given to Hindu girls. He states that the name is exclusively given to them. He gives no substantiation to this claim; clearly, there is nothing stopping anyone of any religion or no religion calling a child Pooja.

76) Taking into account matters which are outside of the knowledge of Dr Sharma eg the history of Tooting's business, in relation to which he makes statements, the presumptions and assertions he makes about the motivation of Tooting; the evidence of Dr Sharma must be viewed with caution. However, it confirms other evidence that food prepared for poojas is called prashad.

*Witness statement of Kanubhai Patel*

77) Mr Patel describes himself as a devout Hindu. He has known Mr Joshi since 1976 and is a regular customer of Wolverhampton's shop. He gives details of his daily routine. He comments upon his belief about the business of Tooting, after discussing the matter with Mr Joshi. Mr Patel is of the view that it is not right that Tooting uses the word pooja as Muslims are involved in the business.

*Witness statement of Ravi Rai Bhakri*

78) Mr Bhakri is a local government employee and a local councillor. Mr Joshi is a family friend. Mr Bhakri comments on his rituals in relation to performing poojas. Mr Bhakri states that, what he describes as pooja foods, are sold by some temples. He comments upon his knowledge of the business of Wolverhampton. Mr Bhakri states that Wolverhampton uses the pooja name on all of its products, packaging and advertising; so this will include non-prashad foods. Mr Bhakri states that, as a female forename, Pooja is exclusively Hindu; as with the evidence of Dr Sharma there is nothing stopping anyone calling a child Pooja. Mr Bhakri gives his views of the motivation of Tooting for using the name Pooja. This is pure speculation, however, it is reflective of the mind-set of Mr Bhakri. He states that Tooting uses the name to mislead the Hindu community; with no evidence of this. Mr Bhakri goes onto to state:

“From my knowledge of history, in “*Aurangzeb's*” time (one of the Mughul Emperor's), he forcefully converted Hindus into Muslims. With History as our witness, he used to eat his evening meal only when he had converted a certain number of Hindus, measured by 25kgs of the initiation sash traditionally worn by the Hindus, which he would rip from them. This procedure in violation of our rights was stopped by one of the Gurus who gave up his life to protect his fellow Hindus.”

*Witness statement of Jay Lakhani*

79) Mr Lakhani is one of the directors of the Hindu Council UK, Director of the Hindu Academy and the Executive of the Religious Council of England and Wales. He comments upon the meaning of pooja, a matter that has been covered in many other parts of the evidence. He states that food offered during pooja becomes sanctified as sacred food after the ceremony and is then called prashad. He states that pooja samagri and naivedya are “artefacts used as offerings to Hindu deities”. Mr Lakhani believes that the name Pooja Sweets and Savouries immediately gives rise to the perception that it relates to a Hindu shop and that food “must be Hindu, sanctified with devotion, and also that the shopkeepers must be devout Hindus”. The persons who frequent the business of Tooting do not appear to have this belief; this includes many Hindus. The visitors of the shop know full well that Muslims are involved in the business. Indeed, Naila Salim is very much the public face of the business, even visiting the prime minister. In his evidence, Mr Joshi distinguishes his general line of food from that which is prashad.

80) Mr Lakhani states that he would expect pooja foods to be vegetarian and to be prepared by devout Hindus in the same way that halal or kosher are used by Muslims and Jews. He makes a further analogy with Judaism and Islam but with no evidential basis nor does he explain his knowledge of either of these religions. From the evidence of Mr Joshi it appears that if there is an analogous term to kosher, in terms of dietary rules, it is prashad and not pooja.

81) Mr Lakhani states that pooja is central and key to the Hindu religion.

*Cross-examination*

82) Naila Salim, Shahid Salim and Imran Salim, of Tooting, were cross-examined. They were honest, straightforward witnesses. Mr Joshi, of Wolverhampton, was cross-examined. He appeared an honest, straightforward witness. However, the evidence filed after the hearing, brings into some doubt certain of the statements and claims that he has made.

83) The cross-examination of the witnesses has had no material effect on the outcome of the proceedings.

*Evidence adduced after the hearing*

84) Mr Sahid Salim filed a witness statement after the hearing. He states that in 2007 Tooting was approached by a firm of printers based in Birmingham. He states that the firm offered to undertake printing for Tooting as it had already done work for it in Wolverhampton. Tooting did not have a shop in Wolverhampton. Mr Salim states that at the time Tooting had a book keeper, Mr Anil Kapacee. Mr Kapacee travelled to Wolverhampton on behalf of Tooting to look at the shop that the printers took to be part of Tooting’s business. He took

photographs of the shop, copies of which are attached. The purpose of the evidence is to exhibit the following notice which was in the window of the shop:

WE CATER FOR VEGETARIAN  
&  
NON- VEGETARIAN  
FOOD FOR  
WEDDINGS, BIRTHDAYS,  
PARTIES & ALL  
OTHER OCCASIONS!!

The context of its position can be seen below:



85) Mr Salim states that Mr Kapacee left Tooting's employment in 2008, when he returned to his native Kenya. Consequently, he is sure that the photograph was taken in 2007 or 2008.

86) This evidence was considered pertinent by Tooting, as Mr Joshi had emphasised that his business was strictly vegetarian and he had commented that that the business of Tooting was not restricted to vegetarian foods.

87) Wolverhampton filed evidence in reply to this evidence. Mr Joshi states that the notice was in his shop window. He states that a friend, Mr Rehan, asked him to advertise for him and that at no point did Mr Joshi prepare any non-vegetarian products or allow anyone else to prepare or bring non-vegetarian products into his shop. Mr Joshi states that the notice was in the window for approximately two months and that he forwarded any enquiries to Mr Rehan. Mr Joshi states that he was very uncomfortable with the notice being in the window and in August 2007 he advised him that he would remove it. Mr Joshi states that he was trying to help Mr Rehan.

88) Mr Joshi states that he has only ever used one firm of printers in Birmingham, Dr Print, and it did not approach Tooting in 2007. Mr Raghbir Nandra, managing director of Dr Print, states that he supplied printing services to Tooting until 2003 and that he has supplied printing services to Wolverhampton since it opened. Mr Nandra states that neither he nor any of his employees or anyone associated with his business has contacted Mr Salim since 2003.

89) Mr Jaswinder Pal Rehan, owner of Jolly Catering Limited, states that he repeatedly asked Mr Joshi to advertise his business in his shop. Mr Rehan states that Jolly Catering started in 2002 but was not doing much business in its first years. Mr Rehan states that Mr Joshi reluctantly agreed to put the notice in his shop window in June 2007 and that Mr Rehan would liaise with any customer queries for non-vegetarian catering directly and that neither Mr Joshi nor his business would be involved in the “discussions”. Mr Rehan states that the notice was in the window for approximately two months and that he did get a handful of enquiries as a result. Mr Rehan states that no orders were handled or received from Mr Joshi or his staff for non-vegetarian products.

90) Mr Joshi also exhibits a “to whom it may concern letter” from Wolverhampton City Council dated 11 July 2013, which advises that Wolverhampton only produces and supplies vegetarian food products. This letter does not assist in relation to the position in the past or the notice that was in the window.

91) In written submissions, Mr Austen comments that Wolverhampton had repeatedly raised the association between pooja and vegetarianism and that Mr Joshi had referred to this when being cross-examined. In the statement of grounds Wolverhampton had also referred to the association between pooja and vegetarianism. Mr Austen submits that, therefore, Mr Joshi would seek to avoid any suggestion that he was associated with non-vegetarian food.

92) Mr Austen submits that the average consumer seeing the notice in the window would understand that Wolverhampton supplied non-vegetarian food. He

submits if the notice related to a third party it would have presumably said so. Mr Austen notes that the notice uses “we cater”. There is no indication that the food would come from a third party. He submits that, at best, it is likely that Wolverhampton sold the non-vegetarian products, even if they were originally produced by Jolly Catering. Mr Austen states that Jolly Catering was incorporated on 26 August 2008. He submits that it is likely that it was not trading at all until 2008.

93) Mr Austen submits that if the evidence of Mr Joshi and Mr Rehan is to be believed there are three possible explanations for the course of action:

a) Mr Rehan did not understand the meaning of pooja in the context of Wolverhampton’s business and was, therefore, not aware that pooja had religious significance, in particular, with the consumption of non-vegetarian food. If this is the case, Mr Rehan more closely represents the average consumer for the purposes of the trade marks. Such an average consumer would not find the use of pooja in the trade marks as offensive but understand it to be highly distinctive.

b) Mr Rehan understood the meaning of pooja in the context of the name of Wolverhampton’s business but did not understand it to signify anything other than simply the act of Hindu worship and certainly not carrying the connotations of devotion that would imply offence to the average consumer if used as a trade mark, even with respect to non-vegetarian products. If this is the case, Wolverhampton has misrepresented the correct religious interpretation of pooja and there is no reason why the trade marks are not registrable.

c) Mr Rehan understood the meaning of pooja and the great offence it would cause if it were used in conjunction with non-vegetarian food. Nevertheless, he continued in his efforts to persuade Mr Joshi to compromise his religious beliefs in order to advertise his business, when he could easily have found alternative locations for the advertisement, unconnected with Wolverhampton’s business. Mr Austen submits that this is scarcely believable.

94) Mr Austen submits that in this light, Wolverhampton’s evidence has grossly misrepresented the position of the average consumer; not only does Mr Joshi use the purportedly offensive and immoral trade mark himself (or at least the words contained therein), but he advertised non-vegetarian food from his premises, contrary to his beliefs.

95) In its written submissions, Wolverhampton comments, inter alia, on the contradiction between the statement of Mr Salim in relation to the printers and that of Mr Nandra.

96) The evidence shows that a notice was put up in the window of the shop in which the first person plural was used in relation to non-vegetarian food; a notice

that made clear reference to non-vegetarian food. There was no indication of a contact number, name or address upon the notice. Any person viewing the notice would believe that the shop was supplying non-vegetarian food. Mr Joshi emphasises in his evidence how important vegetarianism is but associates his business with non-vegetarian foods. If his version of events is correct, he advertises wares that are in complete contradiction to his beliefs which he makes clear that he holds strongly. This evidence must bring into question as to how much weight can be given to the evidence of Wolverhampton in relation to the outrage that members of the Hindu community would feel in relation to the use of pooja as a trade mark.

*Section 5(4)(a) of the Act – passing-off*

97) The conflict under section 5(4)(a) of the Act relates to the use of the sign POOJA in relation to the businesses of the undertakings. Ms Heema attacked the evidence showing use of the sign by Tooting. The main leg of her attack is that Tooting has used other signs in relation to its business. This is the case but there is no requirement that a business only uses one sign. The evidence shows regular and long term use of the sign POOJA in relation to the business of the Salims and then in relation to the business of Tooting. The use shown is in relation to the signage of the premises and in relation to containers in which food products are placed and in advertising. Ms Heema attacked the basis of the goodwill in that Tooting did not produce all of the products that it sold. The evidence shows that Tooting does produce goods on its premises, this includes the advertisements for cooks. If it buys goods from outside and then they are sold, without the sign of the outside producer upon them, under the aegis of POOJA this will establish goodwill in relation to the business associated with the sign upon which use is claimed. (If this were not the case all of the major supermarkets in the United Kingdom would find themselves without goodwill in relation to goods that they sold under their name but did not produce themselves.)

98) Ms Heema questioned the establishment of the date of the first use of the sign Pooja by Tooting. The key matter here is to establish a date prior to the claim of earliest use by Wolverhampton, which was around September 2003. Tooting has supplied letters from businesses which have dealt with it. (These letters were solicited as a result of the proceedings and so are treated as hearsay.) Inter alia the following letters are exhibited to Imran Salim 1:

Page 95 – Patel Brothers advise that they have been supplying Pooja Sweets & Savouries since 1996 with oils, flour, spices and vegetables on a weekly basis.

Page 96 – Litt Media advises that Pooja Sweets & Savouries has been advertising with it since 1998.

Page 97 – HSBC advises that there was a sole trader account for Mr Shahid Salim, trading as “Pooja Sweet and savory” since 24 July 1996 and the legal status was changed with the incorporation of the limited company to Pooja Sweet

& Savouries Ltd and the account was in the name of the limited company since 3 March 2003.

Page 105 – Khalsa Centre advises of its knowledge of Pooja Sweets & Savouries since 1996.

99) Pages from archive.org (Imran Salim 1) show use of the trade mark of the registration on the website poojasweets.com as of 14 June 2003 and 27 July 2003 (pages 49 and 47) Pages 131 and 132 of Imran Salim 1 show the use of POOJA in 1998. Page 113 of Imran Salim 1 is a flyer listing foods supplied by Pooja Sweets & Savouries. The flyer bears an 0181 telephone number, so it will have emanated from prior to 22 April 2000, when the London codes changed. (The flyer advertises best quality vegetarian food). In Imran Salim 2 details of annual turnover and accounts are given from 1997 to 2011, as well as copies of the accounts. No accounts for 2002 were supplied. Mr Imran Salim, on cross-examination, stated that these accounts had not been supplied as Tooting no longer had them. The figures in relation to turnover and promotion are respectively as follows, exclusive of VAT:

1997	94,962
1998	155,286
1999	200,876
2000	213,028
2001	206,685
2003	360,912
2004	407,588
2005	528,401
2006	597,564
2007	656,433
2008	727,206
2009	806,082
2010	852,663
2011	923,462

1997	1,474
1998	600
1999	3,109
2000	4,265
2001	7,567
2002	9,049
2003	Nil
2004	13,450
2005	18,352
2006	12,714
2007	27,230
2008	58,630

2009	54,674
2010	41,308
2011	72,994

100) In relation to passing-off, certain of Ms Heema's submissions were bordering upon the desperate. She referred to photographs of the premises shown at pages 189, 191, 195, 197 and 199 of Imran Salim 1 taken at night. The photograph clearly shows POOJA in large fluorescent lights on the signage of the shop. Ms Heema then argued that during the daytime an awning was pulled out and so the sign could not be seen. Even if it were, the person entering under the awning could see the signage. Also there is a further sign, at 180 degrees, above where any awning would be, which would be seen. The evidence also shows use on boxes and in advertising. Page 201 also shows the premises showing the POOJA sign during daylight, with no awning.

101) Ms Heema submitted that owing to the nature of the sign POOJA that Tooting could not have goodwill in relation to it, that it is not a sign in which anyone can claim rights. This is difficult to understand. Firstly, this is a question of fact. Does Tooting have a business and so goodwill? The answer is yes. Is the sign POOJA used in relation to that business? The answer is yes. These are questions of fact and the facts are clearly established. Consequently, for the purposes of the law of passing-off it has goodwill. At the same time as submitting that no one person can claim rights in the sign POOJA, Ms Heema submitted that Wolverhampton can claim rights in it. As it was put to her on a number of occasions, the claim under section 5(4)(a) means that Wolverhampton claims, first it has rights in the sign POOJA (as a locus standi is required in relation to relative grounds<sup>5</sup>) and that the use of POOJA by Tooting is liable to be prevented owing to the earlier rights of Wolverhampton. In effect, Ms Heema was submitting that Wolverhampton could successfully seek injunctive relief to prevent the use of POOJA by Tooting owing to the rights of Wolverhampton. So, no one could have rights in POOJA but Wolverhampton could still have rights in it. Ms Heema then tried to make a comparison with the Parma ham case; in her skeleton she referred to *Consorzio del Prosciutto di Parma v Marks & Spencer Plc* [1991] RPC 351, an action which was struck out by the Court of Appeal. As the action was struck out it is difficult to gain support from this judgment. The argument that she was submitting appeared to be based on a quality that was being undermined by a later user. It would appear that her arguments would find more support from the actions that have been taken in relation to the use of Champagne eg *Taittinger SA v Allbev Ltd* [1993] FSR 641. However, in that case the claimant had goodwill (the case being brought by a Champagne house as a trade association would not have the required locus standi) and the matter turned effectively upon dilution.

102) In relation to the claimed goodwill of Wolverhampton, Mr Austen argued that the use by Mr Joshi prior to that by Wolverhampton could not be taken into

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<sup>5</sup> The Trade Marks (Relative Grounds) Order 2007

account as there was no deed of assignment transferring the goodwill in the business of the sole trader to that of the limited company. This is a two edged sword, to some extent, as the same applies to Tooting where the goodwill would originally would have been with Mr Shahid Salim and then with Tooting. In the real world it is most unlikely that a sole trader who continues his business as a limited company would draw up a deed of assignment of goodwill. In the cases of both Wolverhampton and Tooting there has been a continuum of business, there has been no change in how the businesses act. It can be inferred in both the case of Wolverhampton and Tooting that the goodwill of the businesses was passed onto the limited companies. (In the case of Tooting this position is strengthened by the letter from HSBC at page 97 to Imran Salim 1.) If this were not to be inferred, the parties would have been asked to file witness statements to state that the goodwill had been passed onto the limited companies. In relation to Tooting, the limited company's activities started prior to the activities of Mr Joshi and so it is not reliant upon the goodwill of Mr Shahid Salim as a sole trader.

103) Mr Geoffrey Hobbs QC, sitting as the appointed person, in *Lee Alexander McQueen v Nicholas Steven Croom* BL O/120/04 held:

“45. I understand the correct approach to be as follows. When rival claims are raised with regard to the right to use a trade mark, the rights of the rival claimants fall to be resolved on the basis that within the area of conflict:

- (a) the senior user prevails over the junior user;
- (b) the junior user cannot deny the senior user's rights;
- (c) the senior user can challenge the junior user unless and until it is inequitable for him to do so.”

Tooting has been using the sign POOJA since 1996 in relation to sweets and savouries and in relation to the retailing of those products. **Tooting is the senior user to Wolverhampton and so the claim of Wolverhampton in relation to section 5(4)(a) of the Act is dismissed in relation to both the application for invalidation and the opposition.**

## Section 3(1)(b), (c) and (d) objections

### *The registration*

104) Tooting has argued that there are other meanings of Pooja eg a female forename. However, in relation to section 3(1)(c) of the Act this is not pertinent. In *Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr. Company* Case C-191/01 P, the CJEU outlined the basis for an objection under section 3(1)(c) of the Act:

“29. Article 7(1)(c) of Regulation No 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods or of rendering of the service, or other characteristics of the goods or service are not to be registered.

30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under Article 7(3) of Regulation No 40/94.

31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of Article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 73).

32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

Consequently, that Pooja is a female forename as well as being a religious ritual is not pertinent to the section 3(1)(c) objection. The purpose behind section 3(1)(c) is the public interest that signs or indications relating to the characteristics of goods or services should not be reserved to one undertaking. It is established that certain foods are offered for use in poojas as offerings to the gods and goddesses. Consequently, pooja in relation to such foods, or the services offering such foods, would relate to an intended purpose. The evidence shows that poojas are regularly conducted in the United Kingdom by Hindus. The Hindu population of England and Wales in 2001 was 1.2% (RJ43 page 93). The size of this population does not affect the issue as to whether the term is descriptive of a characteristic of the goods and services and, consequently, should not be reserved to one undertaking. The evidence of Tooting shows that it regularly supplies foodstuffs for poojas. Registration of pooja, therefore, would reserve to one undertaking a word that relates to an intended purpose and so would be contrary to section 3(1)(c) of the Act.

105) For section 3(1)(c) of the Act to bite, the trade mark must consist **exclusively** of a sign or indication which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods or of rendering of the service, or other characteristics of the goods or services. In the case of the registration, the trade marks do not consist exclusively of the word Pooja. The words sweets and savouries are simple descriptors for food stuffs. However, there is a prominent device element. Wolverhampton argues that part of the device is of a lamp; lamps are used in Hindu ceremonies (see RJ57 page 185) and, indeed, in Tooting's television advertisement for Diwali, it makes use of a device of a lamp. However, the device consists of far more than this: the two uprights, the broken line, the letter P in a circle. Wolverhampton argues that the colours of the trade mark in colour are used in Hinduism. Exhibit RJ133 relates to colour symbolism in Hinduism and refers to red, saffron, green, yellow, white and blue. If Tooting were to avoid all of these colours, its palette would be very limited. The colours of the first mark: are red, orange, yellow and brown. However, the trade marks are not limited to colours and the colours of the first mark of the series do not give it its distinctiveness. The device itself would not be subject to objection under section 3(1)(c) of the Act. The device element is not a mere fig leaf as per the judgment of Arnold J in *Starbucks (HK) Limited, PCCW Media Limited and UK Broadband Limited v British Sky Broadcasting Group PLC, British Sky Broadcasting Limited and Sky IP International Limited* [2012] EWHC 3074 (Ch):

"116. Taking all of the evidence into account, I conclude that the CTM is precluded from registration by Article 7(1)(c) in relation to the services in issue because NOW would be understood by the average consumer as a description of a characteristic of the service, namely the instant, immediate nature of the service. The figurative elements of the CTM do not affect this conclusion. In the alternative, if the inclusion of the figurative elements means that the CTM does not consist exclusively of the unregistrable word

NOW, I consider that the CTM is devoid of distinctive character and thus unregistrable by virtue of Article 7(1)(b).”

106) Considering the trade marks of the registration in their entirety, the grounds of objection under section 3(1)(c) must fail. On the same basis, of exclusivity, there can be no basis for objection under section 3(1)(d) of the Act.

107) In *Libertel Groep BV v Benelux-Merkenbureau* Case C-104/01:

“62 It is settled case law that the essential function of a trade mark is to guarantee the identity of the origin of the marked goods or service to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (see *Canon*, para.[28], and *Case C-517/99 Merz & Krell [2001] E.C.R. I-6959*, para.[22]). A trade mark must distinguish the goods or services concerned as originating from a particular undertaking. In that connection, regard must be had both to the ordinary use of trade marks as a badge of origin in the sectors concerned and to the perception of the relevant public.

63 The relevant public, as defined in para.[46] of this judgment, is made up of average consumers, reasonably well informed and reasonably observant and circumspect.”

In *Eurohypo AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-304/06 P, the CJEU stated:

“41 As regards a compound trade mark, such as that at issue in the present case, the assessment of its distinctive character cannot be limited to an evaluation of each of its words or components, considered in isolation, but must, on any view, be based on the overall perception of that mark by the relevant public and not on the presumption that elements individually devoid of distinctive character cannot, on being combined, have a distinctive character (see, to that effect, *Case C-329/02 P SAT.1 v OHIM [2004] ECR I-8317*, paragraph 35). The mere fact that each of those elements, considered separately, is devoid of any distinctive character does not mean that their combination cannot present such character (*Case C-37/03 P BioID v OHIM [2005] ECR I-7975*, paragraph 29).”

In this case the elements of the device of the registered trade marks are not separately without distinctive character and the device element as a whole has clear distinctive character. The trade marks of the registration, considered in their entirety, are not devoid of any distinctive character and the grounds of objection under section 3(1)(b) of the Act must fail.

**108) The grounds of invalidation under sections 3(1)(b), (c) and (d) of the Act are dismissed.**

### *The application*

109) The basis of the objection of Wolverhampton relates to foodstuffs that may be offered at poojas. However, its attack is against all of the goods and services from *baking-powder* to *business management*. The submissions of Ms Heema brought no specificity to the attack. The objection will be considered within the parameters of the evidence.

110) In relation to the trade marks of the application, the trade marks consist of pooja and sweets and savouries. Sweets and savouries are descriptive of food stuffs and services relating to such food stuffs and also are goods which are given as offerings at poojas. The stylisation of the trade marks is so limited that it will not give the least modesty, unlike a fig leaf. Consequently, in relation to foods that could be offered at poojas and services relating to the offering of such foods, the trade marks are subject to objection under section 3(1)(c) of the Act.

111) In *Koninklijke KPN Nederland NV v Benelux Merkenbureau* Case C-363/99 the CJEU stated:

“86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.”

Consequently, those goods and services which are the subject of objection under section 3(1)(c) of the Act, must also be subject to objection under section 3(1)(b) of the Act.

112) In *Telefon & Buch Verlagsgesellschaft mbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-322/03 the GC stated:

“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)."

113) To fall foul of section 3(1)(d) of the Act Pooja "must have become customary in the current language or in the bona fide and established practices of the trade to designate the goods" for which protection is sought. In *Stash Limited v Samurai Sportswear Ltd* BL O/281/04 Professor Annand, sitting as the appointed person, stated:

"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."

114) Ms Heema was asked on a number of occasions to identify the evidence which showed pooja being used in trade. She identified two instances. One of these was the use by Wolverhampton and the use by Poojah Caterers of Wellingborough, who are suppliers to Tooting. Mere use of a term does not make it customary ie usual or the usage general<sup>i</sup>. The comments of Floyd J in *Nude Brands Limited v Stella McCartney Limited and others* [2009] EWHC 2154 (Ch):

"29. Whilst the use by other traders of the brand name NUDE in relation to perfume may give those traders relative rights to invalidate the mark, it does not give those rights to any defendant. I am not at this stage persuaded that this evidence has a bearing on any absolute ground of invalidity. It certainly does not go as far as establishing ground 7(1)(d) - customary indication in trade. Ground 7(1)(b) is concerned with the inherent character of the mark, not with what other traders have done with it. The traders in question are plainly using the mark as a brand name: so I do not see how this use can help to establish that the mark consists exclusively of signs or indications which may serve to indicate the kind or

quality or other characteristics of the goods, and thus support an attack under 7(1)(c).”

Ms Heema also referred to pictures of offerings at poojas; this is not use in the trade.

**115) The ground of objection under section 3(1)(d) of the Act against the application is dismissed.**

116) The following goods and services of the application are of a nature that they could be offered or used at poojas or are services that supply goods for offering at poojas and so fall foul of section 3(1)(b) and (c) of the Act:

**Class 29**

*Preserved, frozen, dried and cooked fruits and vegetables; Asian fruit, vegetables and savouries; jellies, jams, compotes, fruit sauces, preserves; milk and milk products; prepared, cooked and frozen meals and snacks included in this class; cold savoury snacks (chaat); prepared nuts; nut products; Bombay mix; potato snack products; pickles.*

**Class 30**

*Preparations made from cereals; bread and confectionery, ices; sauces (condiments); prepared, cooked and frozen meals and snacks included in this class; chutneys; cream cakes, fresh cream cakes, iced cakes; ice cream including kulfi; frozen cakes, confectionery, desserts, pastries and yoghurt; Asian sweets and confectionery; breads including buns, bread bases, biscuits, bread rolls, bread sticks, fruit breads, garlic bread, pita bread, naan bread, chapattis, poppadoms, parathas, unleavened bread, wholemeal bread, baguettes, croissants, sandwiches, bagels and wraps.*

**Class 35**

*Retail services connected with foods and drinks and preparations for foods and drinks; the bringing together, for the benefit of others, of a variety of foods and drinks and preparations for foods and drinks, enabling customers to conveniently view and purchase those goods; mail order retail services connected with foods and drinks and preparations for foods and drinks; the bringing together, for the benefit of others, of a variety of foods and drinks and preparations for foods and drinks, enabling customers to conveniently view and purchase those goods from a catalogue or by mail order or by means of telecommunications; electronic shopping retail services connected with foods and drinks and preparations for foods and drinks; information, consultancy and advisory services relating to all the aforesaid services.*

## Class 43

*Services for providing food and drink; restaurant, takeaway and cafe services; catering services; preparation and serving of food and beverages; services for the provision of fast foods including Asian foods; information, consultancy and advisory services relating to all the aforesaid services.*

117) The finding in relation to section 3(1)(b) of the Act is made on the basis of the judgment of the CJEU in *Koninklijke KPN Nederland NV v Benelux Merkenbureau* ie a finding under section 3(1)(b) of the Act is an automatic sequitur of a finding under section 3(1)(c) of the Act. The position under section 3(1)(b) on its own cannot be any better for Wolverhampton. As per *Libertel Groep BV v Benelux-Merkenbureau*, section 3(1)(b) of the Act has to be considered on the basis of the average consumers for the goods and services of the application. The average consumer for the goods and services of the application is the public at large and the public at large will have no knowledge of the word pooja, let alone its meaning. Consequently, pooja has no connotations for the average consumer.

### *Section 3(6) of the Act*

118) In *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch) Arnold J considered the general principles relating to filing an application in bad faith:

“130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C-529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which

must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48).”

119) Prior to filing the applications, Tooting had been using the trade marks for a number of years; without any objection. Wolverhampton claims that the application was made to circumvent the application for invalidation that it had made; without any evidence. (The application for invalidation had not been served on Tooting at the time of the filing of the application for registration). It is noted that Tooting had been using the trade marks the subject of the application for many years prior to filing the application for registration, and the dispute with Wolverhampton. Applying to register a trade mark, which a party has been using for many years, without objection, is commercially prudent. Wolverhampton also claims that the applications were made in bad faith owing to the other objections that it has raised; which makes a finding on that basis contingent on another finding. That a trade mark may be objected to on various grounds does not give rise to bad faith. Taking into account what Tooting knew at the time of the filing of the two applications and what it had been doing prior to the filing of the applications; the reasonable and experienced person in business would not see the applications as being made in bad faith but would see them as being the result of a sensible and acceptable commercial decision.

**120) The ground of objection under section 3(6) of the Act against the registration and the application are dismissed.**

*Sections 3(3)(a) and (b) of the Act*

121) The section 3(3)(a) case revolves around a religious issue. Both parties have adduced evidence in relation to this; evidence which gives conflicting views. It is not possible to ascertain how representative of Hindus the evidence of either party is.

122) Religions have many different bodies and some are more representative of the general view of those who hold the beliefs than others. In relation to the representative nature of the evidence of Wolverhampton a blind eye cannot be turned to certain of the evidence, which appears to be Islamophobic. Exhibited at RJ58 are pages from the website of Hindu Janajagruti Samiti. Within the context of the proceedings it is not possible to see why these pages were adduced (although page 213 does have a reference to pooja). The content of the website appears to be Islamophobic. In the witness statement of Ravi Rai Bhakri at paragraph 11 the following appears:

“From my knowledge of history, in “*Aurangzeb’s*” time (one of the Mughul Emperor’s), he forcefully converted Hindus into Muslims. With History as our witness, he used to eat his evening meal only when he had converted a certain number of Hindus, measured by 25kgs of the initiation sash traditionally worn by the Hindus, which he would rip from them. This procedure in violation of our rights was stopped by one of the Gurus who gave up his life to protect his fellow Hindus.”

In Ram Joshi 3 at paragraph 91 the following appears:

“I believe that they want to monopolize this sacred word, not just to take commercial advantage of Hindus, but ultimately to destroy the authentic meaning of POOJA, divide Hindus and debase the Hindu faith by converting it from its religious meaning into a commodity for their exclusive use and control.”

There is no evidence as to how the witnesses for Wolverhampton were found or chosen. It would appear that the evidence may have been gleaned from the acquaintances of Mr Joshi and, possibly, Mr Shah, who has been acting as his representative in the proceedings. (Mr Shah does not appear to be a lawyer.) Consequently, there is nothing to suggest that the views are representative of the Hindu community in the United Kingdom. It is also to be noted that several of the witnesses make statements about the business of Tooting which are inaccurate and which makes unsubstantiated claims about the motivation of Tooting in choosing the trade marks under which it conducts business.

123) In relation to the evidence for Tooting from Hindus, Mr Joshi simply dismisses the evidence of the witnesses (Ram Joshi 3 paragraphs 82 to 87). If

the witnesses do not agree with his view of the issue they lack credibility or are wrong, according to Mr Joshi.

124) Both parties have referred to e-mail correspondence with the Hindu Council UK and the National Council of Hindu Priests UK. Both parties have given only parts of the correspondence. Both parties have omitted parts of the correspondence. The first e-mail was sent by Tooting on 8 May 2012:

“My name is Salim. I am the Director of Pooja Sweets & Savouries Ltd along with my Hindu partner Mrs Dipta Patel since 1996 we have been in this business in south London and are famous for our strictly pure vegetarian sweets and savouries and our opening with Ravi Sharma and Sarita Sabharwal live over sunrise radio.

We have been approached by Hindu priest who is objecting our name stating being Muslim we are not allowed to use the name POOJA SWEETS.

I am very distraught by this as on one side we have a well established business but on the other side we have a threat to the same because of our religion and choice of name.

Quoting from the Hindu scriptures, Pandit Raj Sharma has given very divisive recommendations about our business which includes both Hindu and Muslim staff and is being run by Hindu Muslim partnership. Not to talk of Hindu religion, I even don't have knowledge of Islamic scriptures. It's difficult for to me to discern justification of Pandit Raj's treatise against us. Pundit Raj has quoted from Hindu scriptures to harm and damage our business. As a layman, I can make out that God is all merciful and compassionate and can't testify an act of snatching livelihood and sustenance from us and our staff.

Revered Pandit Krishna Kant jee, please derives and spare an iota of compassion from your most sacred and holy name and use your Gnostic intellect of a Brahmin to redeem us from this torture and exploitation. This effort of yours will be helping to strengthen cohesion and unity between Hindu and Muslim community and overall British community. We take shelter under the umbrella of your spirit of benevolence and compassion.

Your clarification of the same would be greatly appreciated with reasons for your justifications.”<sup>6</sup>

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<sup>6</sup> Although this letter was not included with the response, part of a copy of a letter in the same terms was exhibited to the witness statement of Pundit Ravi Sharma who gives evidence for Tooting.

125) In an e-mail of 9 May 2012 (Imran Salim 1 page 101) from Anil Bahnot of the Hindu Council UK, the following was written:

“Salim ji – please use this letter to counter Dr Raj Pandit Sharma’s statement to the Trade Standards Authority. As for Dr Raj Pandit Sharma using his weight with his position in the National Council of Hindu Temples I will inform their Trustees but in the meantime rest assured that the advice given below comes from the Hindu Priests Council in the UK. In fact Raj Pandit Sharma’s Hindu Priest Association has to my knowledge only one member, himself.

Raj Pandit’s statement is farcical and although or Lawyer Director is still looking into it I’d be surprised if it does not contravene the laws in the UK.”

126) Exhibited at RJ45 is a list of the organisations that are members of the Hindu Council UK, which Mr Joshi describes as a lengthy list (Ram Joshi 2 paragraph 8). The Hindu Council UK is representative of a good many Hindu organisations. In an e-mail, of the same date, from Acharya Krishan Kant Attri of the National Council of Hindu Priests UK, the following was written:

“On behalf of The National Council of Hindu Priests UK, after consulting with my colleagues, we find nothing wrong in calling your business “Pooja Sweets and savouries Ltd”.

As you have assured us the items that you sell at the place of your business are strictly pure vegetarian and that should suffices.

We are aware of a number of businesses belonging to Muslims in partnership with Hindus have been supplying food items to the Hindus.

Those members of the Muslim communities who are engaged in this type of Business are fully aware of the Hindu traditions and values.

Our members are very happy to see that members of both Hindu and Muslim community have been working together to make contribution in the economic regeneration in Britain.

We sincerely hope that our comment will put an end to this misunderstanding and encourage you to continue to serve our multi faith society.”

127) In an e-mail from Anil Bhanot the following is written:

“As you know we were contacted by Salim ji to give a statement on the use of the word Pooja and its use by a Muslim run Vegetarian sweet shop.

The National Council of Hindu Priests gave their learned opinion as below.

Later however I was approached by Shri Ram Joshi of Pooja Sweets in Wolverhampton who explained to me actually it is he was being asked to drop the name Pooja from his shop where he had been trading for many years before Salim ji started, only that Salim ji has registered the name as a trademark or something like that.

This is a gross injustice to Shri Ram Joshi ji.

Not only I am angry that I was misled by Salim ji but to try and trademark or patent a name like Pooja created by our first seven Rishis is something beyond my comprehension. What is the world coming to?

I am sending this email so that the parties will see to it that they resolve some petty differences but Hindu Council UK will give evidence at the highest court to preserve our tradition and uphold our values. We are no longer living in time of the dark last millennium where the oppressor had no compulsion to invade and impose their ideologies on a great Dharmic civilisation, a civilisation that considered, as Pandit Ravi Sharma ji reminds us often, a guest as a god and no less, but to abuse our tradition, our Parampara, in this day and age it cannot be allowed for whatever reason be it commercial or otherwise.

We come from a tradition where we even give Yoga and Ayurveda for others at no real cost to anyone as it is a gift from Rishis. I am incensed to see our traditions violated by it by our own people or by any one else and under the pretext of some confined rules of a government. We Hindus respect the laws but not about our own Sewa and Yajna based traditions, for those we hold to be supreme.

We write to the lawyer retained by Shri Ram Joshi ji to set the record straight but I hope Salim ji will see sense in sorting out amicably and I have no problem in involving the Muslim Council of Britain in all this should he request so.

A trademark including the word 'Pooja' will not be acceptable to the British Hindu Community."

128) An e-mail was sent by Ravi Sharma which reads:

"...thanks for your letter full of emotions and anger. As a priest, my honest opinion is that Pooja or Puja word is as universal as the Sanatan Dharam is, the way of life for all in the world. Who started the business first and who is trying to mislead, I have not gone that far to be the judge in this

matter. Leaving commercial interest for them to sort out, the true explanation of the word should not be changed. The shop in London is owned by the Hindu and Muslim partners and cater purely vegetarian food.

They have repeatedly assured me that they have no objection to the Wolverhampton business with the similar title.

Mr Joshi has not spoken to me, but his sister recently told me that both parties are willing to sort out ASAP.

I think it is more a commercial dispute than the religious matter.

I am a very busy person but still can arrange their meeting at Mr Joshi's sisters-residence with the consent of both parties."

129) A further e-mail was sent by Anil Bhanot which reads:

"It is best this matter is sorted amicably through a meeting.

I am afraid that I will get angry if people begin to register trademarks of words like Pooja or Om or Yoga or such auspicious words that Hindus use to connect to their God. Once people take this route it is no longer a commercial matter but as far as I am concerned it then becomes a religious matter. I am in HCUK only to protect the Hindu silent majority and the key word there is silent.

On that note Pandit Madhu Shastry ji just rang and he said he has met Shri Ram Joshi ji and on his behalf it prepared to come to London to have a meeting with Salim ji to help sort out the issue.

I am sure he will contact you Ravi ji.

Thank you for your intervention."

130) Exhibited at page 617 to Ram Joshi 3 is a letter from the National Council of Hindu Priests UK dated 9 October 2012:

"Thank you very much for your letter dated 28th September 2012 giving detailed explanation about the dispute in question.

Right on the onset I would like to inform you that we were not provided with the details of this matter.

Therefore we would like to disassociate with this dispute.

Our letter of support was given in good faith supporting business partnership between Hindu and Muslim families.

We sincerely hope that the contents of our email will be discarded.

On behalf of the above council I would like to confirm that we do not wish to be a party to the dispute in any form.”

131) Wolverhampton has not exhibited the letter that it sent to Anil Bhanot. It would appear to claim that it was the earlier user of Pooja, this is not the case. Tooting may be considered somewhat disingenuous in its e-mail of 8 May 2012. However, taking into account the nature of the grounds of invalidation and opposition, eg under the Trade Descriptions Act, it would be reasonable to state that Wolverhampton was not only seeking to invalidate the registration and stop the application being registered, but to stop Tooting using the name that it had been using since 1996. The National Council of Hindu Priests UK did not wish to be involved in a commercial dispute but this does not gainsay what it had written re the use of Pooja by Tooting. Ravi Sharma considers the issue a commercial matter rather than a religious matter. In the absence of the letter from Wolverhampton to Anil Bhanot, it is not possible to know what was written and how this influenced his reaction. However, from the comments of Anil Bhanot, it would appear that the letter he received advised that Wolverhampton was the first user and that it was not trying to stop Tooting from using Pooja; neither of which propositions is supported by the evidence and the pleadings. In his last e-mail, Anil Bhanot refers to Pooja, Om and Yoga as being “auspicious words that Hindus use to connect to their God”. This is not the same as calling them religious words, they are words used in relation to religion. Analogy can be a dangerous tool, however, would the same objections apply to the use of om and yoga as trade marks?

132) The National Council of Hindu Priests UK does not see that the use by Tooting gives rise to any problems. The last two e-mails of Anil Bhanot lack context owing to the absence of the letter that led to them, a letter that would have made statements that are contrary to the evidence and the pleadings; also that Anil Bhanot puts pooja on a par with om and yoga.

133) It is also necessary to bear in mind that despite all the claims of Mr Joshi in relation to the importance of vegetarianism, he associated his shop with non-vegetarian foods (as per the evidence filed after the hearing).

134) In *Kerly's Law of Trade Marks and Trade Names* (fifteenth edition), the position in relation to section 3(3)(a) is summarised as follows at 8-195 et seq:

“In the United Kingdom, more specific guidance on the correct approach was given in Ghazilian's Trade Mark Application:

The dividing line is to be drawn between offence which amounts only to distaste and offence which would justifiably cause outrage or would be the subject of justifiable censure as being likely significantly to undermine current religious, family or social values. The outrage or censure must be amongst an identifiable section of the public and a higher degree of

outrage or censure amongst a small section of the community will no doubt suffice just as lesser outrage or censure amongst a more widespread section of the public will also suffice.

In that case it was also emphasised that s.3(3) was not concerned with political correctness but with principles of morality, a different and less readily invoked standard. The test is objective: using the concept of a right-thinking member of the public, it must be assessed whether the mark in question would cause outrage or censure amongst a relevant section of the public, if, for example, they saw the mark on an advertising poster. If the mark has actually been used, then the best barometer of public opinion is evidence resulting from actual use in the market.”

135) Pooja is used as a female forename by Hindus and so can hardly be considered to be a word that usage outside of a religious context can be seen to be verboten. Although not direct analogies, it is noted that Jesús is a common forename in Hispanic countries and Christ is a Germanic surname; there is a chain of jewellers with the name Christ Schmuck (Schmuck meaning jewellery). That a word has a link to religion does not make it fall foul of section 3(3)(a); it will depend on the word, the context and the goods and/or services.

136) In his evidence Imran Salim refers to Puja being registered in the United Kingdom for class 3 goods and that there are several United States trade mark registrations that include the word puja. The registration of trade marks including the word puja cannot be determinative, or even indicative, in relation to these proceedings. It is necessary to consider the issue on the facts and evidence of this case. Imran Salim also refers to other businesses using pooja. All but one of these appears to be outside the United Kingdom. However, taking into account the claims of Wolverhampton, it is of some interest that businesses in India use pooja: Pooja Exports International based in Kolkata sells clothing, Pooja Kennel based in Pune sells dogs and there is a Pooja Hospital in Mumbai. There is no indication of outrage in relation to such use in a predominantly Hindu society.

137) In BL O/021/05, Mr Geoffrey Hobbs QC, sitting as the appointed person, stated:

“20. I agree with the proposition advanced on behalf of the Applicant to the effect that religious significance is not always or necessarily sufficient to render a mark unregistrable under Section 3(3)(a). However, branding which employs words or images of religious significance can quite easily have a seriously troubling effect on people whose religious beliefs it impinges upon and others who adhere to the view that religious beliefs should be treated with respect in a civilised society ....”

138) In BL O/137/06, Mr Richard Arnold QC, sitting as the appointed person, stated:

“90 Furthermore, I agree with the hearing officer that the best barometer of public perception is evidence resulting from actual use in the market. In the present case, apart from the mysterious reference in the *Delete expletives?* report, the evidence resulting from actual use is really all one way. By January 2005 over 16 million items of FCUK branded clothing had been sold. In addition the brand had been licensed for use on a variety of other products, and there had been retail sales of over £60 million of FCUK branded products other than clothing in the year ending January 2005 alone. It was estimated that by that date FCUK products were on sale in over 6,300 stores in the United Kingdom. These outlets included Boots, House of Fraser, John Lewis, Harrods and Selfridges. There has been widespread poster, print, television and cinema advertising of the brand. FCUK has been used in connection with sponsorship of ballet, theatre and other cultural events. FCUK branded clothing has even been shown in a photograph on the front page of The Daily Telegraph newspaper. With exposure on this scale, if the mark FCUK was significantly offensive to a section of the public, there would be evidence of this. There is not. On the contrary, French Connection's evidence includes a series of letters from a number of prominent retailers and licensees commenting on Mr Woodman's application. The comments of David Kneale, the Chief Commercial Officer of Boots, are representative:

“Neither I nor my colleagues have ever considered the FCUK brand in bad taste, let alone offensive ...  
If we felt that being associated with the brand FCUK as licensees of the brand or stockists would be detrimental to the Boots brand we would not have entered into that association let alone given the FCUK products the significant prominence we have in our stores, catalogues and advertising.”

A number of the retailers expressly state that they have had no complaints from their customers. The same is said by Alexandra Shulman, the editor of Vogue magazine, which by November 2004 had carried FCUK advertising for over seven years.”

139) Tooting has used POOJA in relation to its business since 1996. It has used POOJA in a multi-cultural area. Its products have been bought by Hindus, they have been bought by Hindu religious groups. Tooting has been prominent in its local community. The evidence shows that it is well-known in its local community and is well respected in it. Ms Salim has met the then prime minister. Tooting's profile has been high in relation to advertising before members of the Hindu community in print, radio and television. Despite the claims of Wolverhampton, no one has complained, no one has objected until Wolverhampton commenced these proceedings. None of these complaints was spontaneous. It has been clear to those who have purchased the goods of Tooting that the Salim family are from a Muslim background; again no one has objected to this. **The proof is in**

**the pudding, as with BL O/137/06, registration of the trade marks neither is nor would be contrary to public policy or principles of morality, subject to one proviso.**

**140) The evidence of Tooting shows that all of the goods that it has supplied in relation to its trade marks have been suitable for vegetarians. Many of those who have supported the case of Tooting have noted that the goods have been suitable for vegetarians. Consequently, on the empirical basis presented, this pudding must be suitable for vegetarians and the specifications of the application and registration appropriately limited. (Revised specifications, taking into account all objections, will be given at the end of the decision.)**

141) The section 3(3)(b) has two main strands. One strand is that those running the business of Tooting are Muslim. In *Fianna Fail and Fine Gael v Patrick Melly* BL O/043/08 Mr Geoffrey Hobbs QC, sitting as the appointed person stated.

“43. The objection to registration under Section 3(3)(b) of the Act depended upon the existence of a serious risk that use of the denominations FIANNA FAIL and FINE GAEL in the manner envisaged by the opposed applications would deceive consumers as to the nature or the attributes of the goods or services presented to them under and by reference to those denominations. Section 3(3)(b) prevents registration on the basis of ‘absolute’ rather than ‘relative’ deception. That is to say, it strikes at misrepresentations as to what is being made available rather than misrepresentations as to who is responsible for making it available.”

Consequently, the background of those who are making the goods and services is not pertinent to the issue; it is what is being made available that is pertinent.

142) In *HUP Usługi Polska sp. z o.o. v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 248/05, the GC stated:

“64 Fourthly, as regards the fourth part of the plea, according to the case-law relating to Article 3(1)(g) of Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), the wording of which is identical to that of Article 7(1)(g) of Regulation No 40/94, the circumstances for refusing registration referred to in Article 7(1)(g) of Regulation No 40/94 presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived (see Case C-259/04 *Emanuel* [2006] ECR I-3089, paragraph 47 and the case-law cited).

65 In the present case, the Board of Appeal found, in paragraph 18 of the contested decision, that the intervener’s mark was not deceptive and should not therefore be cancelled in accordance with Article 51(1)(a) of

Regulation No 40/94, read in conjunction with Article 7(1)(g) thereof. According to the Board of Appeal, Article 7(1)(g) of Regulation No 40/94 implies a sufficiently specific designation of potential characteristics of the goods and services covered by the trade mark. Only where the targeted consumer is made to believe that the goods and services possess certain characteristics which they do not in fact possess will he be deceived by the trade mark. The Board of Appeal stated that, since it had already established that the message communicated by the intervener's mark was not clear enough to designate any clear characteristics of the goods and services claimed, that message could not be considered to be deceptive.

66 The applicant's claim that, because of the clear message which it contains, the intervener's mark will deceive the public if the goods and services actually offered do not have any connection with 'manpower in the sector of information technology' cannot invalidate the Board of Appeal's finding.

67 The applicant does not state which characteristic of the goods or services in question conveyed by the intervener's mark they do not in fact possess. Contrary to the applicant's claim, as was stated in paragraph 44 above, the intervener's mark does not convey a clear message concerning the goods and services in question or their characteristics but, at the very most, hints at them.

68 In particular, the intervener's mark cannot be understood as being equivalent to 'manpower in the sector of information technology'. Although it may call to mind, to a certain extent, something connected with information technology and a workforce, it is not a designation which is sufficiently specific to be capable of giving rise to actual deceit or a sufficiently serious risk that the consumer will be deceived.

69 Furthermore, consumers are, in any event, able to assess directly, when choosing the goods or services in question, whether they relate to information technology or are connected with a workforce. They are not therefore generally characteristics to which a serious risk of deceit may apply.

70 It follows from all of the above that the fourth part of the applicant's plea and, therefore, the single plea in law must be rejected, and accordingly, the action in its entirety dismissed.

In *Alberto Severi v Regione Emilia-Romagna* Case C-446/07, the CJEU stated:

"61 It is clear from the Court's case-law that, in order to assess the capacity to mislead of a description to be found on a label, the national court must in essence take account of the presumed expectations, in light

of that description, of an average consumer who is reasonably well informed, and reasonably observant and circumspect, as to the origin, provenance, and quality associated with the foodstuff, the critical point being that the consumer must not be misled and must not be induced to believe, incorrectly, that the product has an origin, provenance or quality which are other than genuine (see, to that effect, Case C-470/93 *Mars* [1995] ECR I-1923, paragraph 24; *Gut Springenheide and Tusky*, cited above, paragraph 31; and Case C-220/98 *Estée Lauder* [2000] ECR I-117, paragraph 30).”

143) The other strand tries to equate pooja with prashad, a conflation that cannot be made. The trade marks of Tooting do not convey a clear message that the goods and services are prashad. Although it can in no way be determinative of the issue, it is to be noted that Wolverhampton uses pooja in relation to non-prashad goods, and Mr Joshi emphasises that he is a strict Hindu. In the many years of use of its trade marks of Tooting, there has been no complaint of deception. Those who, according to Wolverhampton, would be deceived, members of the Hindu community, have been visiting the premises of Tooting and purchasing food products from them with no indication of deception or complaint. The very opposite is the case, a number of them have been happy to support Tooting in these proceedings.

**144) The ground of opposition under section 3(3)(b) of the Act is dismissed.**

*Section 3(4) of the Act*

145) Wolverhampton claims that the trade marks of Tooting breach the rights of Hindus to manifest the Hindu religion as guaranteed under article 9 of the “Convention for the Protection of Human Rights and Fundamental Freedoms (freedom of thought, conscience and religion).” Wolverhampton claims that the trade marks also breach articles 1 and 14 of the Convention.

146) Section 13 of the Human Rights Act 1998 states:

“13 Freedom of thought, conscience and religion..

(1) If a court’s determination of any question arising under this Act might affect the exercise by a religious organisation (itself or its members collectively) of the Convention right to freedom of thought, conscience and religion, it must have particular regard to the importance of that right.

(2) In this section “court” includes a tribunal”

Consequently, the Human Rights Act has application to the Act.

147) Article 1 of the European Convention of Human Rights does not relate to specific rights and is not included in the Human Rights Act<sup>7</sup>.

148) Article 9 states:

“1 Everyone has the right to freedom of thought, conscience and religion; this right includes freedom to change his religion or belief and freedom, either alone or in community with others and in public or private, to manifest his religion or belief, in worship, teaching, practice and observance.

2 Freedom to manifest one’s religion or beliefs shall be subject only to such limitations as are prescribed by law and are necessary in a democratic society in the interests of public safety, for the protection of public order, health or morals, or for the protection of the rights and freedoms of others.”

Article 14 states:

“The enjoyment of the rights and freedoms set forth in this Convention shall be secured without discrimination on any ground such as sex, race, colour, language, religion, political or other opinion, national or social origin, association with a national minority, property, birth or other status.”

149) It is not understood how article 14 has any pertinence to these proceedings.

150) The registration of the trade marks of Tooting cannot have any effect in relation to article 9 1. The registration of the trade marks of Tooting will not limit the freedom of Hindus to manifest their religion, the registration will have no effect upon their abilities to perform and attend poojas.

**151) The grounds of opposition under the Human Rights Act 1998 are dismissed.**

*The effect on the specifications of Tooting*

152) As per the finding in relation to section 3(3)(a) the registration of Tooting is to be the subject of a limitation. It is to read:

Class 29

*Preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats; dried herbs; prepared meals and snacks included in this class; all being suitable for vegetarians.*

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<sup>7</sup> Article 1 states: “The High Contracting Parties shall secure to everyone within their jurisdiction the rights and freedoms defined in Section I of this Convention.”

Class 30

*Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; prepared meals and snacks included in this class; all being suitable for vegetarians.*

Class 35

*The bringing together, for the benefit of others, of a variety of foods and drinks and preparations for foods and drinks, enabling customers to conveniently view and purchase those goods; mail order retail services connected with foods and drinks and preparations for foods and drinks; the bringing together, for the benefit of others, of a variety of foods and drinks and preparations for foods and drinks, enabling customers to conveniently view and purchase those goods from a catalogue or by mail order or by means of telecommunications; electronic shopping retail services connected with foods and drinks and preparations for foods and drinks; all of the foods and drinks being suitable for vegetarians; information, consultancy and advisory services including helpline services relating to all the aforesaid services.*

Class 43

*Services for providing food and drink; restaurant, takeaway, cafe and bar services; catering services; sandwich and snack bar services; preparation and serving of food and beverages; all being suitable for vegetarians; information, consultancy and advisory services including helpline services relating to all the aforesaid services.*

As per the findings in relation to section 3(1)(c) and 3(3)(a), the specification of the application is to be limited as follows:

Class 29

*Eggs, edible oils and fats, being suitable for vegetarians; dried herbs.*

Class 30

*Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour; pastry, being suitable for vegetarians; honey, treacle; yeast, baking-powder; salt, mustard; vinegar; spices; ice.*

Class 35

*Advertising; business management; business administration; office functions; information, consultancy and advisory services relating to all the aforesaid services.*

Class 43

*Bar services; sandwich and snack bar services; all being suitable for vegetarians; information, consultancy and advisory services relating to all the aforesaid services.*

### **Costs**

153) Mr Austen sought costs outwith the scale. In *West t/a Eastenders v Fuller Smith Turner PLC* [2003] EWCA Civ 429 Pumfrey J, sitting in the Court of Appeal, decided that, in awarding costs, the success in relation to separate grounds and the evidence adduced in relation to those grounds should be taken into account. In this case Wolverhampton has lost on most of the grounds. Tooting has been burdened by confused and unclear pleadings. A large part of the evidence of Wolverhampton was without pertinence to the proceedings eg there was much evidence about Sanskrit and its relationship to Indo-European languages. Wolverhampton put in a lot of evidence about its own business for the purposes of passing-off but there was clearly no basis for such a claim. The nature of the evidence and the manner in which Wolverhampton has conducted these proceedings has put an unnecessary and unacceptable burden upon Tooting. It is appropriate to make an award of costs outwith the scale in favour of Tooting. Tooting has two weeks from the date of the issue of this decision to file a breakdown of its costs in relation to these proceedings. A copy should be sent at the same time to Wolverhampton. Wolverhampton has two weeks from the date of receipt of the breakdown of costs to make submissions in relation to the quantum of costs given in the breakdown. **The submissions of Wolverhampton are to be strictly limited to this matter.**

153) The period of appeal for this decision will run from when it is issued; it is not stayed pending the issue of a supplementary decision on costs.

**Dated this 24th day of September 2013**

**David Landau  
For the Registrar  
the Comptroller-General**

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<sup>i</sup> Other language versions of the Directive make this clear eg:

las marcas que se compongan exclusivamente de signos o indicaciones que se hayan convertido en **habituales** en el lenguaje común o en las costumbres leales y constantes del comercio;

and:

les marques qui sont composées exclusivement de signes ou d'indications devenus **usuels** dans le langage courant ou dans les habitudes loyales et constantes du commerce;

and

Marken, die ausschließlich aus Zeichen oder Angaben zur Bezeichnung der Ware oder Dienstleistung bestehen, die **im allgemeinen Sprachgebrauch** oder in den redlichen und ständigen Verkehrsgepflogenheiten üblich geworden sind.