

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2228391 BY
MERCHANT INTERNATIONAL TRADING LIMITED
TO REGISTER A TRADE MARK IN CLASSES 33**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 52412
BY ABDUL AHAD**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2228391
by Merchant International Trading Limited to
register a trade mark in Classes 33**

AND

**IN THE MATTER OF Opposition thereto
under No. 52412 by Abdul Ahad**

BACKGROUND

1. On 6 April 2000, Merchant International Trading Limited applied to register the word JAIPUR as a trade mark in Class 33.
2. The application was examined, accepted and published for the following specification of goods:

“Alcoholic beverages except beers.”

3. The application is opposed by Abdul Ahad. The opponent is the proprietor of registration No. 2019821 for the trade mark JAIPUR registered with effect from 5 May 1995 in respect of: “Prepared meals; takeaway meals; all being prepared on the premises where they are sold” in Class 29, and “Restaurant services; catering services” in Class 42. In view of the opponent’s earlier rights, objection is said to arise under Section 5(2)(a) of the Act. Objection is also said to arise under Section 5(4)(a) of the Act, in that use of the applicants’ trade mark is liable to be prevented by the law of passing off. The opponent’s comments in their Notice of Opposition in this regard are as follows:

“3. The opponent is also the proprietor of a restaurant in Milton Keynes called JAIPUR. His restaurant has been trading under the name JAIPUR for over twelve years.

4. The opponent has been using the mark JAIPUR extensively in connection with the promotion of his restaurant. In particular, the JAIPUR trade mark is promoted strongly throughout the restaurant, and appears on all of the bottles of house wine sold in the restaurant. The restaurant has established a reputation throughout the whole of the country owing to the excellence of its food. The opponent has therefore acquired considerable goodwill in the trade mark JAIPUR in relation to his restaurant, and the wine sold under the trade mark JAIPUR in his restaurant.”

4. The applicants filed a counterstatement in which they acknowledge the existence of the opponent’s registration; the grounds of opposition are, however, either denied or not admitted.

5. Only the opponent filed evidence in these proceedings; both parties seek an award of costs. In accordance with Trade Marks Registry practice, I reviewed the case and advised the parties that, in my view, it was not necessary for a Hearing to be held to decide the matter; the parties were however told of their right to be heard. In the event, neither party requested a Hearing. In a letter dated 16 August 2002, the opponent's Attorney's Urquhart Dykes & Lord filed written submissions; I take these into account in reaching my decision below.

Opponent's evidence

6. This consists of a witness statement dated 13 November 2001 by Katherine Lindsay Gifford Nash. Ms Nash explains that she is a technical assistant in the employ of Urquhart Dykes & Lord who are the opponent's professional representatives in these proceedings. Ms Nash states that unless otherwise indicated, the facts in her statement are from her own personal knowledge. The following points emerge from Ms Nash's witness statement:

- that in order to achieve acceptance of his JAIPUR trade mark, the opponent had to file evidence of the use that had been made of the trade mark. Exhibit KLG2 consists of a draft (ie. unsigned and undated) copy of a statutory declaration which appears to have been prepared in relation to what was then Application No. 2019821.
- having noted that the trade marks the subject of the application and registration are identical, Ms Nash says:

“3. Prepared meals and alcoholic beverages are often enjoyed together. Most restaurants are licenced to sell alcoholic beverages to their patrons. Restaurants licenced to sell alcoholic beverages will usually have a house wine. The labels on the house wine may be specifically designed for the restaurant. I am informed that bottles of house wine bearing the mark JAIPUR are sold at Mr Ahad's JAIPUR restaurant. Photographs of the bottles of house wine sold at Mr Ahad's restaurant are shown in exhibit KLG3. Accordingly, there is a likelihood of confusion on the part of the public between the marks, which includes a likelihood of association with the earlier mark.” I note that exhibit KLG3 is undated.
- exhibit KLG4 consists of copies of correspondence between the applicants and the Trade Marks Registry during the ex-parte examination phase of the application in suit. Ms Nash notes that a number of the opponent's trade marks (including 2019821) were raised as citations by the Trade Marks Registry and that in a letter dated 26 May 2000 the Attorneys acting for the applicants agreed to amend their specification of goods to read: “Alcoholic beverages except beers and wines” to overcome the various citations. Ms Nash also notes that during the further prosecution of the application in suit, the applicants elected to proceed for the specification as filed. In her view the application was accepted without the conflict with the registrations being addressed.

7. That completes my review of the evidence filed in so far as I consider it necessary.

DECISION

8. I shall deal first with the objection based on Section 5(2)(a) of the Act; this reads as follows:

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

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

(b)

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

9. An earlier right is defined in Section 6 of the Act, the relevant part of which states:

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

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

(b)

(c).....”.

10. In these proceedings the opponent relies on registration No. 2019821 dated 5 May 1995 (details of which is set out below) which qualifies as an “earlier trade mark” within the meaning of Section 6(1)(a) of the Act.

11. In determining matters under Section 5(2) I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

12. For convenience, the respective trade marks and the goods and services for which they are respectively registered and applied for are as follows:

opponent’s trade mark:	applicants’ trade mark
JAIPUR	JAIPUR

opponent's goods/services	applicants' goods
Prepared meals; takeaway meals; all being prepared on the premises where they are sold. (Class 29) and Restaurant services; catering services.(Class 42)	Alcoholic beverages except beers (Class 33)

Similarity of goods/services

13. In their counterstatement the applicants' comment as follows:

“3. In any event, although it is acknowledged that the mark applied for is identical with the opponent's mark, the mark applied for is to be registered for “alcoholic beverages except beer” in class 33. The opponent's mark is registered in respect of: “prepared meals; takeaway meals; all being prepared on the premises where they are sold” in class 29 and “restaurant services; catering services” in class 42. “Alcoholic beverages” are clearly not similar to “prepared meals; takeaway meals; all being prepared on the premises where they are sold”, since the uses and physical nature of the respective goods are different, they reach the market through different channels and they are not competitive or substitutes for each other. Additionally, there is no nexus between “alcoholic beverages” and “restaurant services; catering services”. The mark applied for is to be registered in respect of goods clearly differing from the goods and services of the opponent's mark, and there is no likelihood of confusion and/or association on the part of the public. Registration of the mark applied for would not be contrary to any of the provisions of section 5(2) of the Act.”

14. In order to decide this question one ordinarily looks to the comments of Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case) [1996] RPC 9 and the comments of the Court in the *Canon* case mentioned above. In *Treat*, Jacob J identified the following as factors to be considered when determining the similarity or otherwise of goods:

- (a) The uses of the respective goods or services;
- (b) The users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets, and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are in competition with each other; that enquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or the services in the same or different sectors.

15. I acknowledge that in view of the *Canon* judgment the *Treat* case can no longer be wholly relied upon, but the Court of Justice did say that said the factors identified by the government of the United Kingdom in its submissions (which are those listed in *Treat*) are still relevant in respect of a comparison of goods. Suitably adapted, the same is true of services and also the relationship between goods and services.

16. However, in these proceedings I also have the benefit of the Trade Mark Registry's long established practice of citing "alcoholic beverages except beer" in Class 33 against "restaurant and wine bar services" in Class 42; the clash between the two classes being specifically in relation to "wine". The rationale behind this practice stems from the propensity of restaurants and wine bars to trade in "house wines" under the same trading name as the restaurant or bar itself. From only a very cursory review of the various *Treat* criteria mentioned above (ie. same uses, same users, complementary nature of the goods and services) one can immediately see that the Trade Mark Registry' practice represents a sensible approach to the matter. There is however no clash between goods in Class 33 and the opponent's goods in Class 29; in this regard, it is, I think, fair to say that the opponent's submissions in these proceedings concentrate in the main on the clash between the applicants' goods and the opponent's services in Class 42. That being the case, I have no difficulty in concluding that there is no clash between the goods of the application in suit in Class 33 and the opponent's goods in Class 29, but that there is a clash between "wine" covered by the phrase "alcoholic beverages except beer" in the application and the term "restaurant services" appearing in the opponent's specification of services in Class 42.

Distinctive character of the opponent's mark

17. In her witness statement Ms Nash states:

"In order to achieve acceptance of the mark JAIPUR for the above mentioned goods and services, evidence of use was filed. Exhibit KLG2 is a copy of Mr Abdul Ahad's statutory declaration, excluding copies of exhibits AA4 and AA5, which are missing from our file records. The statutory declaration shows that through his use of the mark, Mr Abdul Ahad has acquired substantial goodwill and a considerable reputation in the mark JAIPUR for prepared meals, take away meals, restaurant services and catering services."

18. But the documents provided in exhibit KLG2 are neither sworn nor dated. As such they are of no assistance to the opponent (or to me) in establishing an enhanced penumbra of protection; it is therefore the inherent distinctiveness of the opponent's trade mark that I must consider. In the absence of any evidence on this point, I can only proceed on the basis that the opponent's JAIPUR trade mark is a good and registrable trade mark in respect of all the goods and services for which it is registered (Section 72 refers); consequently in reaching my decision I propose to accord it neither an enhanced or reduced penumbra of protection.

Similarity of marks

19. The respective trade marks are identical, which the applicants acknowledge in their counterstatement.

Conclusion on Section 5(2)(a)

20. The respective parties trade marks are identical and I have found that the goods the subject of the application in suit (in so far as they include “wines”) are similar to the term “restaurant services” appearing in the opponent’s specification of services in Class 42. However, this is not an end to the matter. As mentioned above, exhibit KLG4 consists of copies of correspondence between the applicants and the Trade Marks Registry during the ex-parte examination phase of the application in suit. I note that in response to the Official letter of 30 June 2000 which requested further information under the provisions of rule 57 of the Trade Marks Rules 2000, the applicants’ Attorneys Murgitroyd & Company responded in a letter dated 17 July 2000. In the letter they said:

“Further to your request under Rule 57 we enclose a copy of the proposed label for the product. Unfortunately, brochures illustrating use of the label on the goods available as yet.”

A copy of the label provided is reproduced below:



21. From this I conclude that the applicants’ propose to use their JAIPUR trade mark in relation to pink gin (Jaipur, the city in Rajasthan, is I understand known as the “Pink City”). Article 13 of Council Directive 89/104/EEC provides as follows:

“Grounds for refusal or revocation or invalidity relating to only some of the goods or services.

Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark

has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods and services only.”

22. It is now well established that the provisions of Article 13 are binding upon the Registrar as the person whose task it is to implement the Directive on behalf of the State in the United Kingdom (see the comments of Mr Geoffrey Hobbs QC acting as the Appointed Person in Opposition No. 51248, *Health Perception (UK) Limited v Almirall-Prodesfarma, S.A* - BL 0/371/02). In view of the information provided by the Applicants attorneys, in relation to “the product” during the ex-parte examination of the application, together with the requirements of Article 13, it appears to me that this application would be acceptable, if, the applicants restricted their specification of goods to “Gin”. Such an amendment would, in my view, avoid any conflict with the opponent’s earlier right.

23. The final objection is based on Section 5(4)(a) of the Act. This reads as follows:

“5- (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, or..”

24. The jurisprudence on the common law tort of passing off insofar as the Trade Marks Registry is concerned is clearly set out by Geoffrey Hobbs QC acting as the Appointed Person, in *Wild Child* [1998] 14 RPC, 455:

"A helpful summary of the element of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 731 is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation."

The restatement of the elements of passing off in the form of this classical trinity has been referred as providing greater assistance in analysis and decision than the

formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition of 'passing off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

25. As noted above, the documents provided in exhibit KLG2 are neither sworn nor dated. As such they are of no assistance to the opponent in establishing a case under this head; consequently, the opposition based on Section 5(4)(a) of the Act is dismissed.

26. In view of my comments at para 22 above, the applicants should file within one month of the expiry of the appeal period from this decision a Form TM21 to restrict their specification to "Gin". If no Form TM21 is filed within the period set the application will be refused in its entirety.

27. The opposition to the application has partly succeeded and the opponent is entitled to a contribution towards his costs; I order the applicants to pay to him the sum of £900. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30TH Day of October 2002

**M KNIGHT
For the Registrar
The Comptroller-General**