

O/619/20

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO. UK00003359409
IN THE NAMES OF IDRIS SHAK, KIBRIA AHMED,
MUHAMMAD HABIBUR RAHMAN, ABDUL JABBAR MADBAR AND SHAMIMA
BEGUM MATIN
FOR THE FOLLOWING TRADE MARK:



IN CLASS 43

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 502517 BY FAMOUS FOOD LTD

BACKGROUND AND PLEADINGS

1. Idris Shak, Kibria Ahmed, Muhammad Habibur Rahman, Abdul Jabbar Madbar and Shamima Begum Matin (“the proprietors”) are the registered owners of the trade mark shown on the cover of this decision (“the contested mark”). The contested mark was filed on 7 December 2018 and entered into the register on 1 March 2019. It stands registered for the following services:

Class 43: Restaurant services; the provision of food and drink to eat-in; take-away food and drink services; Catering; Cafés, Bars.

2. On 22 March 2019, Famous Food Ltd (“the applicant”) applied to have the contested mark declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”). The applicant relies upon sections 5(2)(b) and 5(3) of the Act.

3. Under sections 5(2)(b) and 5(3), the applicant relies on the following trade mark:

BABURCHI NANNA MIAH HAZI NANNA BIRYANI Traditional foods of old Dhaka
UK registration no. 3011954

Filing date 28 June 2013; registration date 11 October 2013

Relying on all services for which the mark is registered, namely:

Class 43: Catering (Food and drink -); Catering for the provision of food and beverages; Catering of food and drinks; Catering services; Catering services for the provision of food; Fast food restaurant services; Fast-food restaurants; Food cooking services; Food preparation; Food preparation services; Food service apparatus (rental of -); Preparation of meals; Salad bars; Self-service cafeteria services; Self-service restaurants; Services for providing food and drink.

4. Under the section 5(2) ground, the applicant claims that the use of the same name and product with the same services will lead to a likelihood of confusion on the part of the wider public. Further, under its section 5(3) ground, the applicant claims that

use of the contested mark would take unfair advantage of, or be detrimental to, the distinctive character and/or repute of the applicant's mark.

5. The proprietors filed a counterstatement denying the claims made and put the applicant to proof of use of its mark.
6. The applicant is represented by Prime Accountants and the proprietor is represented by Londonium Solicitors. Both parties filed evidence. No hearing was requested and only the proprietors filed written submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.

PRELIMINARY ISSUE

7. In its invalidation application, the applicant states that, "The Trade Mark "Baburchi Nanna Miah Hazi Nanna Biryani Traditional foods of old Dhaka" is used so that any part of name or context can be protected." While not pleaded expressly, the applicant seems to be arguing that by registering its mark as a whole, protection is granted to each individual part of that mark. The applicant reiterated this argument in its evidence. Whilst trade marks may contain multiple components, and whilst there are circumstances in which individual components can have an independent distinctive character which materially affects the likelihood of confusion with another trade mark, the assessment must be based on the trade marks as wholes. Accordingly, I will assess the applicant's mark's distinctive character, overall impression and similarities with the contested mark in accordance with established case law that is set out in further detail throughout this decision.

EVIDENCE

8. As above, both parties have filed evidence and I will summarise their most pertinent points below. I have read all of the evidence.

The applicant's evidence

The witness statement of Mr Md Matab Uddin dated 3 February 2020

9. Mr Uddin is the director of the applicant, a position which he has held since 2012. He states that the applicant trades as 'Nanna Biryani' and operates two restaurants. It is unclear from the evidence where the first restaurant was located but I note that in the application for invalidity, the applicant states that it was located in Whitechapel, London. The evidence sets out that the applicant, trading as Nanna Biryani, opened its second branch in Manor Park, Stratford. Mr Uddin states that 'Nanna Biryani' is a famous chef from Dhaka, Bangladesh who is renowned for making Biryani, a traditional Bangladeshi dish. The applicant purchased the rights to use this name in the UK and started using it on 24 July 2012. Mr Uddin states that the business grew rapidly and that it became loved and appreciated by the Bengali community in the UK.
10. Mr Uddin sets out that the applicant has invested money in advertising the brand via adverts on Bengali TV, leafletting and in newspapers. He states that money was also invested in attendance at a community festival. No figures regarding this expenditure are provided.
11. A copy of the applicant's table menu is exhibited to Mr Uddin's statement.¹ I note that it includes the words 'Nanna Biryani Restaurant', which is incorporated into a logo on the centre of the menu's cover, with the words 'TRADITIONAL FOODS OF OLD DHAKA' shown rotated upwards and to the right of the menu's cover.
12. Also exhibited to the statement are the applicant's annual reports and unaudited accounts for the years ending 31 July 2018 and 31 July 2017.² There are also three photographs exhibited that show the exterior and interior of the restaurant.³ Of these, I note that the shop front shows a sign that is made up of several elements, two of which are the words 'NANNA BIRYANI' which is displayed in a large white font and the words 'TRADITIONAL FOODS OF OLD DHAKA', which is displayed above but in a much smaller font. I also note that the 'Nanna Biryani Restaurant' logo that I have mentioned at paragraph 11 above is shown on the front signage and within the restaurant itself.

¹ Exhibit 1

² Exhibit 2

³ Exhibit 3

13. Sales figures of the applicant are exhibited to Mr Uddin's statement⁴ and these show sales figures of £38,469 for the year ending 31 July 2018, £81,842 for the year ending 31 July 2017 and £79,936 for the year ending 31 July 2016.
14. Finally, Mr Uddin exhibits a copy of an invoice and utility bill. The invoice is dated 23 June 2019 and shows the purchase by the applicant of goods such as rice, firni mix, masala, halim mix and masala powder in bulk. I note that the name of the invoice is "Nanna Biryani – Romford Road". The invoice is dated after the relevant date and, therefore, does not assist the applicant. In respect of the utility bill, I note that is dated 19 February 2019 and is addressed to 'Nanna Biryani'.

The proprietors' evidence

The witness statement of Idris Shak dated 16 March 2020

15. Mr Shak is one of the proprietors. He states that the applicant has failed to provide any documentation in relation to the rights to use the name 'Nanna Biryani' in the UK. While not expressly pleaded, if it is the case that Mr Shak is attacking the validity of the applicant's ownership of the mark, I note that the applicant is the registered owner of the mark and the proprietors have advanced no evidence that casts doubt on the validity of the recorded ownership of the mark.
16. Mr Shak goes on to discuss the applicant's mark as registered and the differences between the marks. I will not set these comments out in full here but will refer back to them below when assessing the form of the applicant's mark and the similarity of the marks, respectively.
17. Mr Shak has also exhibited a menu of the food offered by the proprietors⁵ and has set out that the designs of the menus are different. I note that the menu is undated. Further, Mr Shak states that the proprietors do not offer the same class of service, the same product, nor do they take advantage of any claimed reputation of the applicant. Mr Shak states that the foods sold by the parties' respective services are prepared differently using different techniques.

⁴ Exhibit 4

⁵ Exhibit IS3

18. The claim that the proprietors' cuisine will diminish the quality and authenticity of the applicant's business is disputed. On this point, Mr Shak states that the proprietors' food is authentic and has its own level of reputation. To support his point, he exhibits a printout from the proprietors' website that discusses the history of the food offered by the proprietors.⁶ I note that the printout is undated.

19. Finally, I note that Mr Shak has exhibited the financial records of BDF Food Ltd.⁷ However, BDF Food Ltd is not a party to these proceedings and, in any event, the financial records of the proprietors are not relevant to these proceedings.

DECISION

20. Section 47 of the Act states as follows:

“47. –

(1) [...]

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

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

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

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

(SZA) [...]

⁶ Exhibit IS4

⁷ Exhibit IS5

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
- (b) the registration procedure for the earlier trade mark was not completed before that date, or
- (c) the use conditions are met.

(2B) The use conditions are met if –

- (a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered—
 - (i) within the period of 5 years ending with the date of application for the declaration, and
 - (ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or
- (b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Union.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).

[...]

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

21. By virtue of this section, a registered trade mark may be declared invalid if there is an earlier trade mark which satisfies the conditions under section 5(1), (2) or (3) of

the Act and the owner of the earlier mark has not consented to the registration. In circumstances in which the earlier mark completed its registration process more than five years before (1) the date of the application for invalidity and (2) the date of filing of the application for registration of the later trade mark, the use conditions must be met.

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

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

(a) ...

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

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

23. Section 5(3) of the Act reads as follows:

“5(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

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

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

25. The applicant’s mark qualifies as an earlier mark under the above provisions.

Proof of use

26. As noted above, the proprietors have put the applicant to proof of use of its mark. The first issue, therefore, is whether, or to what extent, the applicant has shown genuine use of its mark. The relevant provisions for the invalidation are contained in section 47 of the Act, set out above.

27. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

28. Pursuant to Section 47 of the Act, which I have reproduced above, there are two relevant periods in these proceedings. They are 8 December 2013 to 9 December 2018 and 23 March 2014 to 22 March 2019.

29. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single

undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

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

Form of the Mark

31. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s.46(2) of the Act as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character

identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

32. Although this case was decided before the judgment of the CJEU in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

33. While I note the applicant's turnover figures and the fact that it has invested money in advertising, I also note that the applicant refers to the fact that it was trading as 'Nanna Biryani'. Further, the utility bill and invoice (although dated after the relevant date) are both addressed to 'Nanna Biryani'. There is no evidence that relates to the use of the applicant's mark as registered. Therefore, the proof of use relied on by the applicant hinges on whether the alternative uses of its mark are acceptable in accordance with the case of *Nirvana* (cited above).

34. Within its evidence, the proprietors set out that applicant's evidence shows use of a logo that is not contained within the mark as registered neither is it registered separately by the applicant. Throughout its evidence, I note the following marks have been used:

a) Nanna Biryani



d)



35. As per the case of *Nirvana* (cited above), I must consider what is the distinctive character of the applicant's mark as registered, what are the differences between marks a) to d) and the applicant's mark as registered and whether or not those differences alter the distinctive character of the applicant's mark.

36. The word 'BIRYANI' will be seen as a type of food and is, therefore, descriptive. The words 'Traditional foods of old Dhaka' will be seen simply as a strap line that is descriptive of the origin of the food provided by the applicant's services. As a result, these words will contribute little to the distinctive character of the applicant's mark. The words 'BABURCHI NANNA MIAH HAZI NANNA' will be seen as foreign language words that carry no obvious meaning and will, therefore, dominate the distinctiveness of the applicant's mark. The main difference between the uses shown and the mark as registered is that there are various words within the applicant's mark that are missing from marks a) to d), being 'BABURCHI', 'MIAH' and 'HAZI', while "NANNA" appears only once. I also note that marks a), b) and d) are also missing 'Traditional foods of old Dhaka' but mark c) is not. While I acknowledge that there are additional differences (such as use of foreign language words, stylisation differences and additional device elements), I do not consider it necessary to assess these in detail as the removal of the words "BABURCHI NANNA MIAH HAZI" from the applicant's mark as registered inevitably alters its distinctive character. This is because the missing words 'BABURCHI', 'MIAH' and 'HAZI' are highly distinctive and are prominent in the applicant's mark as registered. Consequently, it is my view that marks a) to d) have altered the applicant's mark's distinctive character meaning that they are not acceptable variant uses of the applicant's mark as registered.

37. As a result, the application must fail. However, even if the applicant was able to demonstrate proof of use of its mark, I would still have rejected the application. My reasons follow.

Section 5(2)(b)

38. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a

composite mark, without necessarily constituting a dominant element of that mark;

- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

39. The parties' services are as follows:

The applicant's services	The proprietors' services
<u>Class 43</u> Catering (Food and drink -);Catering for the provision of food and beverages; Catering of food and drinks; Catering services; Catering services for the provision of food; Fast food restaurant services; Fast-food restaurants; Food cooking services; Food preparation;	<u>Class 43</u> Restaurant services; the provision of food and drink to eat-in; take-away food and drink services; Catering; Cafés, Bars.

Food preparation services; Food service apparatus (rental of -);Preparation of meals; Salad bars; Self-service cafeteria services; Self-service restaurants; Services for providing food and drink.	
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40. The General Court confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

“29... In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

41. I note in the proprietors’ evidence, they have stated that:

“the Applicant and our services are fundamentally different. [...] Furthermore, we do not operate in the same industry, our services are different in the sense that the food are sold and prepared using different techniques and our unique recipe does not resemble the method used by the Applicant.”

42. While I note the proprietors’ position that they use different techniques and recipes to the applicant, they are not relevant to the comparison that I must now make. I must compare the services of both parties as they are registered.

43. “Catering” in the proprietors’ specification has a direct counterpart in the applicant’s specification, although expressed in a slightly different term (“Catering (Food and drink -)”). These services are identical.

44. “Restaurant services”, “the provision of food and drink to eat-in”, “take-away food and drink services” and “cafés, bars” in the proprietors’ specification all fall within the category of “services for providing food and drink” in the applicant’s specification. These services will, therefore, be identical under the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

45. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ services. I must then decide the manner in which these services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

46. I note that the applicant has stated that its business has become known in the Bengali community of the UK and that it has also advertised its services on local Bengali TV. While the applicant has not expressly pleaded that the average consumer of the services at issue would be a member of the Bengali community, I will consider this point for the sake of completeness.

47. I refer to the case of *Pooja Sweets & Savouries Ltd V Pooja Sweets Limited*, BL O-195-15, wherein Ms Anna Carboni, as the Appointed Person, held that where goods are targeted at the general public the mere fact that they might be of greater interest to a particular sub-set of the relevant public did not justify narrowing the

assessment of distinctiveness to just that sub-set of the relevant public. I make the same finding here. While the applicant's services may be of greater interest to the Bengali community within the UK, restaurant services are aimed at the public at large and I see no justification in narrowing the relevant public. Therefore, I find that the average consumer will be a member of the general public of the UK.

48. The services at issue can range significantly in price (from Michelin starred restaurants to fast food outlets) and in frequency of use. However, even where the costs are fairly low or purchases relatively frequent, such as in the case of the applicant's fast food services, a number of factors will still be taken into consideration (such as type of food or drink offered, dietary requirements and hygiene rating). I therefore conclude that a medium degree of attention will be paid during the purchasing process.

49. The services are likely to be selected following inspection of the premises' frontage, the website of the service provider or advertisements. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase of the services, given that word-of-mouth recommendations may also play a part.

Distinctive character of the applicant's mark

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

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

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

51. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

52. The applicant has not pleaded that its mark has enhanced distinctiveness through the use which has been made of it. However, for the sake of completeness, I note the following. The evidence provided by the applicant does not provide any information about the market share held by the applicant’s mark for the services for which it is registered. While it has provided sales figures, I do not consider those figures to be significant enough given the size of the relevant market. Further, the applicant has opened two restaurants in Manor Park, Stratford and in Whitechapel, London which means that the geographical spread of any use is limited. While the applicant has stated it has invested in promoting its mark, no information is provided about how much has been invested. I, therefore, do not consider that the evidence filed is sufficient to show that the applicant’s mark has an enhanced level of distinctive character. Consequently, I have only the inherent position to consider. The applicant’s mark is a word only mark that consists of the words ‘BABURCHI NANNA MIAH HAZI NANNA BIRYANI Traditional foods of old Dhaka’

53. I note that in the applicant’s notice of invalidity, it states:

“The Trade Mark ‘Baburchi Nanna Miah Hazi Nanna Biryani Traditional foods of old Dhaka’ is used so that any part or name or context can be protected.

The Trade Mark part ‘Baburchi Nannah Miah’ represent the name of chef who is famous for making food call Biryani or Biryiani.

‘HAZI’ or Haji is a title represent he done Islamic pilgrimage in mecca Saudi Arabia.

‘NANNA BIRYANI’ as chef Mr Nanna is famous for making Biryani, people recognise his special recipe used Biryani call Nanna Biryani or Nanna’s Biryani.

‘Traditional Foods of old Dhaka’ Biryani or Biryiani is traditional food from Dhaka which is capital of Bangladesh. As Mr Hazi Nanna Miah belongs from old Dhaka, and this food is been used in this region over 100 years, this special food become a tradition food of old Dhaka, Bangladesh.”

54. While the applicant’s comments regarding the individual meanings of the words contained within the mark are noted, they are not relevant to my assessment of distinctive character. This is because I must assess the meanings of the words from the perspective of the average consumer in the UK and assess the inherent distinctive character of the applicant’s mark as a whole.

55. The applicant’s mark is a word only mark that is made up of both English and foreign language words. While it is possible that some consumers who are more versed in the languages contained in the applicant’s mark would understand the meaning of those foreign words, I am unconvinced that this would be the case of the vast majority of consumers in the UK. Further, while I acknowledge that ‘NANNA’ may be known by the average consumer in the UK as an informal term for grandmother, I find that in conjunction with the other words in the mark, it will be seen as a foreign language word. I find that the word ‘BIRYANI’ will be understood by a majority of average consumers within the UK to be a type of food and is, therefore, descriptive. The English words in the mark are ‘Traditional foods

of old Dhaka'. While the average consumer is unlikely to be aware that Dhaka is the capital city of Bangladesh, they will still see it as a foreign location. As a result, 'Traditional foods of old Dhaka' will be seen as descriptive of the origin of the food provided by the applicant's services and will contribute little to the distinctive character of the mark. As a result, the words 'BABURCHI NANNA MIAH HAZI NANNA' will dominate the distinctiveness of the applicant's mark.

56. While 'BIRYANI' and 'Traditional foods of old Dhaka' will be seen as descriptive, I am of the view that the remaining words, being 'BABURCHI NANNA MIAH HAZI NANNA' will be highly distinctive. Given that these words dominate the distinctiveness of the mark, I find that, overall, the applicant's mark has a high degree of inherent distinctive character.

Comparison of marks

57. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

58. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

"... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

59. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the

marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

60. The respective trade marks are shown below:

The contested mark	The applicant's mark
	<p style="text-align: center;">BABURCHI NANNA MIAH HAZI NANNA BIRYANI Traditional foods of old Dhaka</p>

61. As set out in my evidence summary above, the proprietors' evidence discusses the similarities of the marks. The proprietors state:

"2. [...] On the other hand, my trademark UK:0003359409 which is described as "ORIGINAL HAJI NANNA'S BIRIYANI" has a logo of a plate of food. (**Exhibit IS2**) Therefore, any logo the Applicant has been using is not registered and therefore they do not have the lawful authority to use those logos.

3. The Applicant has further used the spelling "Hazi" whereas we have used the spelling "Haji" Furthermore, I have used the word "Biryani" whereas the Applicant uses the spelling as "Biryani". (**Exhibit-IS1**) and (**Exhibit IS2**)

4. Additionally, their [sic] the Applicant's choice of words is significantly different from my restaurant which therefore constitutes a difference in the number of words used by me and the Applicant.

5. The main difference in the spelling of words, different use of word and the difference in the number of words used is well visible and comprehensible by the targeted consumers of the businesses. Thus, there is no genuine and

properly substantiated likelihood of confusion on the part of a customer of our restaurant.”

62. While the comments within the evidence are noted, the contested mark does not contain the word ‘HAJI’. Further, despite the alternative spelling being present on the cover of the proprietors’ menu,⁸ the contested mark as registered has the spelling ‘BIRYANI’ not ‘BIRIYANI’.

63. The contested mark consists of an image of a rice dish that sits above the words ‘Nanna Biryani’ which are presented in a stylised white typeface. The word ‘Restaurant’ is presented in a stylised yellow typeface at the bottom of the mark. These elements sit on a green background. I also note that between the device element and the word ‘Nanna’ is the word ‘Original’ in a very small red typeface. However, due to its size I find that it will be overlooked and, therefore, has no trade mark significance.

64. The word ‘Restaurant’ is descriptive of the services offered by the proprietors and will, therefore, have little or no trade mark significance. Overall, I find that ‘Nanna Biryani’ will play the greater role in the overall impression of the contested mark, with the word ‘Restaurant’ and the device elements playing a lesser role.

65. The applicant’s mark is a word only mark that consists of the words ‘BABURCHI NANNA MIAH HAZI NANNA BIRYANI Traditional foods of old Dhaka’. Given their position at the end of the mark and their descriptive nature, I find that the words “Traditional foods of old Dhaka” will play a lesser role in the overall impression of the mark. Further, as the word ‘BIRYANI’ is descriptive, it will also play a lesser role. Overall, I find that the words ‘BABURCHI NANNA MIAH HAZI NANNA’ will play a greater role in the overall impression of the mark.

66. The only shared element between the marks is the words ‘Nanna Biryani’. Visually, this element sits at the centre of the contested mark and in the middle of the applicant’s mark. Taking into account all the other visual differences, being the

⁸ Exhibit 3 of the Witness Statement of Idris Shak

remaining word elements of both marks and the device elements within the contested mark, the marks are visually similar to a low degree. Aurally, the pronunciation of the shared element will be identical. Given its descriptive nature, I do not consider that the word 'RESTAURANT' in the contested mark will be pronounced. The aural similarities between the marks lies in the words 'NANNA BIRYANI' which, as a result of my finding that 'RESTAURANT' will not be pronounced, makes up the entire aural element of the contested mark. However, given the shared element's placement in amongst the other words in the applicant's mark and its remaining aural elements, I find that the marks are aurally similar to a low degree.

67. As for the conceptual comparison, I find that no concept will be attributed to the foreign language words in the applicant's mark. I have given further consideration to the concept of the word 'NANNA' in both marks. I acknowledge that, in the English language, the word 'NANNA' is commonly used as an informal term for 'grandmother'. However, I find it unlikely that 'NANNA' in either mark will be attributed any meaning by the average consumer in the UK. This is because the word 'NANNA' appears twice in an apparently meaningless string of words in the applicant's mark and, in both marks, the succeeding word, 'BIRYANI' will be recognised as a food, which, in my view, would take away any connection one may make to 'grandmother'. Therefore, I find that the only shared concept is the word 'BIRYANI' which will be seen as a type of food originating from the Indian subcontinent. This will be reinforced by the presence of the device element of the contested mark. There is also a conceptual point of difference in the presence of 'Traditional foods of old Dhaka' in the applicant's mark, though this is not a distinctive difference. As a result, any conceptual similarity will be low at best and derives from a non-distinctive shared concept.

Likelihood of confusion

68. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may

be offset by a greater degree of similarity between the trade marks, and vice versa. I have found the services to be identical and the marks to be visually and aurally similar to a low degree and conceptually similar to, at best, a low degree. The applicant's mark has a high level of distinctive character. The services will be selected with a medium degree of attention.

69. Taking all of the above factors into account, I consider that the visual, aural and conceptual differences between the marks are enough to offset the identity of the services. Therefore, the average consumer will not mistake one mark for another, even on identical services. Consequently, there will be no direct confusion. Further, it is my view that the average consumer will conclude that the differences between the marks are indicative of unconnected undertakings. The only shared element that will have any meaning to the average consumer will be the word 'BIRYANI', which is descriptive of a type of food. I see no reason why the average consumer would believe that only one undertaking would use the word 'BIRYANI' in relation to the type of services offered by the marks. Further, even if the average consumer was to notice the identical element in the marks, being the words 'NANNA BIRYANI', I consider that the presence of the remaining distinctive words in the applicant's mark and their relative prominence will offset any similarities produced by these words. As a result, the consumer is more likely to view the additional elements as indicating different undertakings specialising in the same type of services rather than indicating that the marks originate from the same or linked undertakings. I do not, therefore, consider there to be a likelihood of indirect confusion, even on services that are identical.

70. The application under the section 5(2)(b) grounds, therefore, fails. I will now proceed to consider the section 5(3) grounds of the application.

Section 5(3)

71. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v*

Interflora and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

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

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

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

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

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

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

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

Reputation

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

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

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

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

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

73. The applicant's mark must have a reputation among a significant part of the relevant public in the UK for which its services are registered. I have no evidence from the applicant as to the size of the UK market in relation to the services for which it is registered, being services relating to the restaurant industry. However, I would expect it to be a significant market amounting to hundreds of millions, if not billions of pounds per annum.

74. The applicant has not provided any evidence as to the market share achieved by its mark. While it has provided turnover figures, I note that in comparison to the likely size of the relevant market, they are low. Further, the applicant's services are only provided from two locations, which are situated close to one another in neighbouring areas of London, meaning that any geographical spread of its reputation will be limited. Additionally, the evidence states the applicant has spent money on advertising its brand via local Bengali TV, newspapers, leafletting and community festivals. In respect of the advertising aimed at local Bengali TV and community festivals, any reach of this will be limited to the local community only. As for the newspapers and leafletting, no further information is provided in respect of the extent of this advertising.

75. Taking the evidence as a whole, I am not satisfied that the applicant's mark had established a reputation in a significant part of the relevant UK public at the relevant date. The section 5(3) grounds of opposition fail accordingly.

CONCLUSION

76. The application for invalidity fails in its entirety and the contested mark will remain registered for all services.

COSTS

77. The proprietors have been successful and are entitled to a contribution towards their costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the proprietors the sum of £1,000 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparation of a counterstatement and considering the applicant's statement:	£200
Preparing evidence and considering the applicant's evidence:	£500
Filing written submissions in lieu of a hearing:	£300
Total:	£1,000

78. I therefore order Famous Food Ltd to pay Idris Shak, Kibria Ahmed, Muhammad Habibur Rahman, Abdul Jabbar Madbar and Shamima Begum Matin the sum of £1,000. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 10th day of December 2020

**A COOPER
For the Registrar**