O/1027/24

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL
REGISTRATION NO. WO0000001689384 IN THE
NAME OF KIMBERLEY SPIRITS DISTILLERY PTY LTD
FOR THE FOLLOWING MARK:

WHITE PEARL GIN

AS A TRADE MARK IN CLASS 33

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 438758 BY
BESTWAY WHOLESALE LIMITED

BACKGROUND AND PLEADINGS

1. Kimberley Spirits Distillery Pty Ltd ("the holder") is the holder of the International Registration ("the IR") shown on the cover page of this decision.[1] The IR was registered on 19 September 2022 and, with effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 13 October 2022. The holder seeks protection in the UK for the following goods:

   Class 33: Gin.

2. On 23 January 2023, the IR was opposed by Bestway Wholesale Limited ("the opponent"). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Under the section 5(2)(b) and 5(3) grounds, the opponent relies on the following trade mark:

   WHITE PEARL
   UK registration no. 902469732[2]
   Filing date 13 November 2001; registration date 17 July 2003
   ("the opponent's mark").

3. Under the section 5(2)(b) ground, the opponent relies only on "beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices" in class 32 of its specification. In filing its opposition, the opponent made a statement of use in respect of "other non-alcoholic drinks; fruit drinks and fruit juices". The opponent claims that the marks are similar and that the holder's goods are similar to its own non-alcoholic beverage goods. As such, the opponent claims that there exists a likelihood of confusion between the marks.

[1] Despite the mark appearing as a figurative mark on the UK trade marks register, I note that the Madrid Protocol module for this mark confirms that it is intended to be a word only mark and I will treat it as such.
[2] The opponent's mark is a comparable mark based on an earlier EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs.

4. Under the section 5(3) ground, the opponent claims to enjoy a reputation in a wider range of goods, namely the following:

Class 30:	Curry sauces, curry paste, vindaloo paste, tandoori paste, tikka paste, curry powder, curry spices, turmeric, ground chillies, cumin, coriander, ginger, garam masala, minced spices; spice mixtures, five spice powder; condiments, chutneys, capers, pickles, relishes; spices; rice, lentils, pulses, beans, edible oils and fats, flour, flour mixes.
Class 32:	Non-alcoholic drinks, fruit drinks and fruit juices.

5. The opponent claims to have built up a reputation in its brand thanks to over 30 years of use. As such, the opponent argues that the relevant public would consider that the marks are either used by the same undertaking or that there is an economic connection between them. In respect of damage, the opponent argues that use of the IR would cause detriment to the opponent's brand as a result of any association with a hard liquor such as gin. In addition, the opponent argues that there is a risk of detriment to the distinctive character of the opponent's mark as the public may be swayed to buy a product that includes 'White Pearl' in its branding, having seen or heard of the opponent's 'White Pearl' brand previously.

6. Turning to the section 5(4)(a) ground, the opponent relies on the unregistered sign 'WHITE PEARL' that it claims to have used throughout the UK since 1992 in respect of the same goods listed at paragraph 4 above. Under this ground, the opponent claims that the use of its sign has resulted in its brand being well-known and popular with the public. The opponent argues that the holder's use of the IR would deceive the public into thinking that they were purchasing goods from the opponent. To be associated with hard liquor such as gin would be at odds with the opponent's reputation and would damage its goodwill and cause detriment to its brand.

7. The holder filed a counterstatement wherein it made a series of denials of the claims made against it. Further, the holder requests that the opponent provide proof of use of the mark relied upon.
8. The opponent is unrepresented and the holder is represented by Stobbs. Only the opponent filed evidence in chief and, in doing so, also filed accompanying written submissions. No hearing was requested and neither party filed written submissions in lieu. This decision is taken after a careful perusal of the papers.

9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

10. The opponent's evidence came in the form of the witness statement of Dawood Pervez dated 29 September 2023. Mr Pervez is the Director of the opponent, a position he has held since 1 July 2004. Mr Pervez's statement is accompanied by seven exhibits, being DP1 to DP7, and has been adduced to demonstrate the opponent's use of its mark in support of its claim to have genuinely used it mark and to prove that it enjoys a reputation in its mark and goodwill in its sign.

11. I do not intend to summarise the opponent's evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Proof of use

12. 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 or international trade mark (UK) 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,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[…]

(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."

13. Section 6A is also relevant. It reads:

"(1) This section applies where:

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

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

(5)-(5A) [Repealed]

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

14. Section 100 of the Act is also relevant. It 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."

15. As the opponent's mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

"7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union".

16. Given its filing date, the opponent's mark qualifies as an earlier trade mark under the above provisions. The opponent's mark had completed its registration processes over five years prior to the designation date of the IR. As set out above, the holder requested that the opponent provide proof of use in respect of the same. Therefore, the opponent's mark is subject to the proof of use assessment.

17. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, 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 Bundervsvereinigung 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], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], 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], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles 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]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(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]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(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]; *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]."

18. While section 6A of the Act (cited above) is silent on the issue of IRs, the Trade Marks (International Registration) Order 2008 sets out that this section of the Act extends to apply to IRs. As such, the relevant period for the present assessment is the five-year period prior to the designation date of the IR, being 19 September 2022. The relevant period is, therefore, 20 September 2017 to 19 September 2022 ("the relevant period").

19. As the opponent's first mark is a comparable mark based upon an earlier EUTM, use of the same in the EU prior to IP Completion Day (being 31 December 2020)

is relevant to the present assessment.[3] As a result, the relevant territory between 20 September 2017 and 31 December 2020 is the EU (which includes the UK as, at that time, it was a Member State) and between 1 January 2020 and 19 September 2022, the relevant territory is the UK only. On this point, I refer to the case of *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, wherein the Court of Justice of the European Union ("CJEU") noted that:

> "It should, however, be observed that … the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase 'in the Community' is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use."
>
> And
>
> "50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as 'genuine use', it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark."

20. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real"[4] 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.

---

[3] See paragraph 4 of Tribunal Practice Notice 2/2020
[4] *Jumpman* BL O/222/16

21. Before proceeding to discuss the evidence filed, I remind myself that the holder's proof of use request was not limited in any way. As a result, the issue of genuine use applies to all of the goods relied upon under both the section 5(2)(b) and 5(3) grounds. For ease, I will assess the evidence as a whole and then, if necessary, conclude any finding as to genuine use by dealing with these different sets of goods separately.

<u>Evidence of use</u>

22. The evidence confirms that use of the 'WHITE PEARL' brand is undertaken by a company called MAP Trading Limited, being a subsidiary of the opponent. On this point, I remind myself that as per section 6A(3)(a) of the Act, use conditions may be met if said use is by a third party so long as it is with the consent of the owner of the mark. I note that consent is not expressly confirmed in the present case, however, given the relationship between the companies, I am willing to accept that any use by MAP Trading Limited was with the appropriate consent of the opponent. Despite the use being by MAP Trading Limited, I will, for ease of reference, continue to refer to any use as being use by the opponent.

23. Use of the opponent's mark is claimed to have begun in 1992 when the opponent started selling a single variety of Basmati rice. The evidence then sets out that the opponent presently sells a wide range of 'WHITE PEARL' branded food and drink. This includes 300 curry ingredients such as spices, chutneys, curry paste, ghee, lentils and rice. I note that the opponent has provided a photograph of such goods, as well as four bottles of juice beverages, on a shelf.[5] The photograph shows goods all branded as 'WHITE PEARL', however, it is undated and no information is provided in relation to where this photograph was taken or whether it shows goods actually for sale. On the latter point I note that there are no prices shown and there only appears to be limited volumes of each product displayed on the shelf itself.

24. In addition to the above photograph, the opponent has provided approximately 30 pages of goods as they appear in the opponent's catalogue.[6] While the catalogue

[5] DP1
[6] DP2

shows a wide variety of goods (such as rices, oils, pulses, beans, spices, flours, pastes and juices) branded as 'WHITE PEARL', it is undated and no further information is provided as to where this catalogue was distributed or to whom. As such, I have no evidence in respect of the reach of this catalogue across the relevant consumer base of how it relates to the position during the relevant period.

25. The evidence sets out that the opponent's 'WHITE PEARL' brand is visible on the opponent's UK website but no printout of this is provided. At this stage, the opponent provides a series of images showing the labels used on the opponent's goods.[7] The labels include those used for various juices, beans and tomatoes and, to me, they appear to be design blueprints that are sent to printers in order for them to print the labels on the opponent's behalf. They are not images of finished labels on actual products. It is noted that the labels show a '.co.uk' email address, however, the images are all undated so it is not possible for me to determine when they were generated. While I note that the beans and tomatoes products do show best before dates, these are from long after the relevant period. On this point, there is nothing to suggest the shelf life for such products that could be said to reasonably point to the fact that these images were ultimately used on products that were sold during the relevant period.

26. In respect of advertising, I note that one printout is provided that shows the promotion of three different rice products.[8] This is undated but does make reference to the opponent's UK-based social media accounts. While on the topic of advertising, the opponent confirms that it has spent an average of £50,000 per year between 1 July 2018 and 30 June 2023. The evidence confirms that these costs are associated with advertising, promotional activity, point of sale costs, vehicle branding, website costs and packaging costs. While noted, I will say that there is nothing to suggest how point of sale costs, website costs or packaging costs can be said to relate to actual advertising efforts. For example, packaging costs are not ordinarily considered advertising costs but, instead, are likely to fall within the category of ordinary operational costs. Further, despite listing the spend in British pounds, there is nothing to suggest how it relates specifically to the UK

---

[7] DP3
[8] DP4

market (or the EU market, for the matter). I note that in support of the opponent's evidence as to promotional activity, it has provided a document which is titled 'Campaign Timing'.[9] I note that this is a list that shows the number of times (and when) a 'WHITE PEARL' rice advert ran on the channel 'New Vision'. The problem here is that there is nothing before me to suggest whether 'New Vision' is a UK or EU-based channel or not. If it were the case that these adverts ran on channels such as ITV, Channel 4 or Sky TV, it could be inferred that the adverts were seen by a wide range of the consumer base because these are, plainly, popular and well-known channels within the UK. However, insofar as it pertains to 'New Vision', I consider it reasonable to suggest that the opponent should have provided further information in respect of the channel and its viewership in the relevant territory. In addition to this, the opponent has provided a printout that shows the presence of adverts that ran during various cricket matches.[10] While this evidence is dated outside of the relevant period (meaning that it is of no assistance here), I do wish to discuss the fact that this advertising relates to cricket matches mostly involving Pakistan. Such an issue brings in to question whether the focus of the opponent's business is aimed at that territory, especially given the lack of evidence pointing directly to the UK or the EU.

27. In addition to the opponent's evidence on advertising, I note that it has provided an invoice dated 1 June 2022 regarding the order of television spots.[11] A lot of the information from this invoice has been redacted but I can see that it was sent to an address in London and that it relates to 155 adverts that seemingly ran in May of 2022. Also, I note that the total amount of the invoice is £3,255 (excluding VAT). While noted, the information as to the nature of the adverts has been redacted and there is nothing (either in the invoice itself or in the narrative evidence) to suggest how this advertising campaign was conducted, on what channel or in what territory. This creates a problem for the opponent as ultimately, even if they did run in the relevant territory, there is no supporting information available to me to assist in determining how widespread these adverts would have been.

[9] Pages 2 to 7 of DP5
[10] Pages 8 and 9 of DP5
[11] DP6

28. In respect of turnover, the opponent's evidence confirms that its turnover for 'WHITE PEARL' branded products between 1 January 2018 and 11 September 2023 was approximately £80,679,158. In support of this, the opponent has provided four invoices,[12] only one of which being from within the relevant period. This invoice is dated 8 September 2022 and shows the sale of 566 bags of 'WP' (presumably standing for 'White Pearl') rice and 36 'Lazzat' Bombay biryanis to a redacted recipient in Bradford. The invoice shows a total amount of £10,061.[13]

Assessment of evidence

29. Having considered the evidence as a whole, I have identified several issues. Before getting into these issues, I wish to remind myself of the case law regarding the need for clarity and precision in proof of use claims. The first case is that of *Awareness Limited v Plymouth City Council,* Case BL O/236/13 ("*Plymouth Life*"), wherein Mr Daniel Alexander Q.C. as the Appointed Person stated that:

> "22. The burden lies on the registered proprietor to prove use.......... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

[12] DP7
[13] While the invoice does cover goods not branded as 'White Pearl' ('Lazzat'), these have been attributed no value on the invoice so the total sales value of the invoice can be said to solely cover the 'White Pearl' goods.

30. And further at paragraph 28:

> "28. .... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as "tuition services", is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to "tuition services" even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted."

31. In addition, I refer to the case of *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL O/404/13, wherein Mr Geoffrey Hobbs Q.C. as the Appointed Person, stated that:

> "21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:
>
>> [24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in

the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not *'show'* (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

32. Turning back to the evidence before me, I appreciate that I am to take the evidence as a whole but I consider it necessary to discuss the issues with the individual items of evidence before making my holistic assessment.

33. Firstly, the supporting evidence showing the goods that the opponent sells is all undated and, as such, there is nothing sufficiently solid to suggest that the wide range of goods shown in evidence were available during the relevant period. I appreciate that there is a UK invoice but this is from the very end of the relevant period and does not extend to any goods other than rice. In addition, I appreciate that there are a few references in the evidence to '.co.uk' email addresses and UK social media accounts. However, this evidence is, again, undated meaning that it is not possible to determine whether or not it is reflective of the position during the relevant period. While the opponent may have had some focus on the UK market, the only sufficiently solid evidence on this point is the presence of one invoice just 11 days prior to the end of the relevant period. As such, there is nothing to suggest the opponent's level of focus on the UK market during the relevant period for any other goods.

34. The second issue comes in the advertising/promotional evidence. I have set out above that the supporting evidence regarding television advertisements relates to a channel called 'New Vision'. There is nothing before me to demonstrate whether this is a UK or EU-based television channel. If it was the case that the channel was available to the UK or EU consumer base, I consider it reasonable to suggest that it was for the opponent to confirm the same. In addition, the advertising invoice that is addressed to a UK customer shows nothing to suggest the nature of these adverts. In the present case, I consider that it would have been of great assistance to the opponent if it were to have confirmed the nature of these adverts, what channels they ran on and their potential reach across the UK consumer base. Instead, I have simply been left to determine genuine use based on very vague information.

35. The last issue I have relates to the turnover figures provided. Looking at the figure by itself, a turnover of over £80 million over almost six years (between 1 January 2018 to 11 September 2023) is significant. I wish to say at this point that I do not doubt that accuracy of the statement in regard to the overall value of the turnover obtained. However, the problem I have with the way in which this has been presented is that it is not confirmed how it can be broken down to the relevant territory or in respect of the relevant goods. Further, the relevant period expired on 19 September 2022 meaning that almost one year's worth of the turnover stems from outside of the relevant period. This leads to several questions, being how much of the turnover relates to the UK or EU markets, how much of it applies to the relevant goods and how much is attributable to the period that expired in September 2022. The only supporting evidence I have that can answer these questions is the invoice dated just 11 days prior to the conclusion of the relevant period which confirms 566 bags of rice were sold within the UK. The volume of the goods sold via this invoice suggests a wholesale invoice and given its proximity to the end of the relevant period, it is reasonable to suggest that the goods were ultimately sold to end consumers after the relevant period. Again, the vague nature of this evidence leaves me with great difficulty in trying to determine the level of use attributable to the relevant territory during the relevant period.

36. Taking all of the evidence into account, I am of the view that it is insufficiently solid in demonstrating exactly what it was that the opponent sold during the relevant period in the UK or the EU. Further, the evidence fails to demonstrate precisely how much of the turnover is attributable to the relevant goods. Given the wide-ranging goods at issue (being beverages and, in the opponent's own words, 300 curry ingredients), this latter point is a considerable issue for the opponent. In addition, the advertising evidence is also rife with its own issues as to target market and visibility to UK consumers.

37. In considering the issue of genuine use, I appreciate that even if the evidence filed does not, on the face of it, give rise to an obvious finding of genuine use, it is possible for Hearing Officers sitting in this Tribunal to make a series of inferences that may support a conclusion of use. However, said inferences are only possible if they are deemed to be reasonable. In the present case, I am of the view that to make any inferences in favour of the opponent would be unreasonable and to the detriment of the holder. Further, they would involve me unfairly building the opponent's case on its behalf. In addition, making inferences in the present case would be contrary the comments of Mr Alexander Q.C. in *Plymouth Life* and Mr Hobbs Q.C. in *Dosenbach* and to section 100 of the Act, all of which firmly place the burden of proving use on the owner of a trade mark. In short, the issues discussed above have, in my view, rendered the evidence (as a whole) insufficiently solid. Consequently, I am of the view that the evidence filed fails to support a finding that the opponent has genuinely used its mark in the UK.

38. My finding above means that the opponent's reliance on its section 5(2)(b) and 5(3) grounds fail at the first hurdle. Despite this, it is clear to me that the opponent's best case lies in its reliance upon the term "rice" and, on this point (and for the sake of completeness), I have given consideration as to whether the opposition would have yielded any success if I were to proceed on the basis that genuine use had been proven for "rice". In short, I do not consider that it would have and I will discuss why below by briefly assessing the section 5(3) ground.[14]

[14] I refer to the section 5(3) ground only on the basis that the opponent did not rely on "rice" for the purpose of its section 5(2)(b) ground of opposition meaning that it falls away in its entirety. As for the section 5(4)(a) ground, I will

Section 5(3)

39. Section 5(3) of the Act states:

> "5(3) A trade mark which –
>
> > 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."

40. 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, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure,* Case C-323/09, *Marks and Spencer v Interflora,* 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; G*eneral 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 Salomon, paragraph 29* and *Intel, paragraph 63.*

---

consider this in full below because, unlike the section 5(2) and 5(3) grounds, that ground is not reliant upon the opponent's registered mark and is, therefore, not subject to the genuine use assessment. It is, however, subject to an assessment as to goodwill which I will consider it in the ordinary way below.

(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).*

41. Before proceeding, it is necessary to point out that as the opponent's mark is a comparable mark based on an earlier EUTM, use of the same in the EU prior to IP Completion Day (being 31 December 2020) is relevant to the assessment of the existence of a reputation. That being said, I do not consider this to be of any real relevance here. This is because, as per the case of *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, an EU trade mark may be considered to have a reputation if it is known by a substantial part of the territory of the European Community and that the territory of a single Member State alone may be considered as satisfying that requirement. Further, I note the case of *Whirlpool Corporations and others v Kenwood Limited* [2009] ETMR 5 (HC), wherein Geoffrey Hobbs Q.C. confirmed that when assessing reputation in the EU, the UK is a substantial part of the same. While these cases were determined prior to the UK's departure from the EU, they remain relevant insofar as use in the EU is a relevant factor.

42. As set out above, the present ground proceeds solely in reliance upon the opponent's mark for "rice".

43. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks are similar.[15] Secondly, the opponent must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities

[15] Given the common use of 'WHITE PEARL' across both marks, I consider this is satisfied.

between the parties' marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the IR. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods at issue be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

44. I appreciate that I have proceeded to consider this ground in respect of the term "rice" in the opponent's first mark's specification. While my primary position was that the evidence before me is insufficient to demonstrate genuine use, I will proceed with this assessment on the basis that the evidence was just enough to satisfy the requirements for genuine use. On this point, I remind myself that the test for proving reputation under the section 5(3) ground is significantly more onerous than that for proof of use.[16] Given the criticisms I have levied at the evidence as a whole (being those at paragraphs 33 to 37 above), I am of the view that the opponent's use of "rice" is not sufficient to warrant a finding of a reputation. Put simply, while a turnover of over £80 million is noted, there is no way for me to determine (1) the position in respect of the turnover as at the relevant date (which for this assessment is the designation date of the IR, being 19 September 2022), (2) how it relates to the relevant territory and (3) how much of it can be said to cover rice. As a result, I have absolutely no way to accurately attribute the turnover to the goods at issue, the relevant territory or to the relevant date. Without any further evidence or information on this point, I am not willing to make inferences to the benefit of the opponent. Again, to do so would be unfair to the holder and would involve me having to formulate the opponent's case on its behalf. Such an approach would be entirely inappropriate in the circumstances. In addition, these same issues apply to the evidence outside of the turnover, such as the catalogues showing the opponent's goods and the evidence in respect of advertising.

[16] A finding of genuine use only requires a sufficient level of use (as per the case of *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, this need not be quantitively significant) whereas a finding of a reputation requires that the marks relied upon are known by a significant part of the relevant public in the relevant territory.

45. The only sufficiently solid evidence I can definitely point to in respect of use in the relevant territory prior to the relevant date stems from the wholesale of 516 bags of rice to an address in Bradford for a total cost of £10,061. Such use is far from sufficient to demonstrate that, at the relevant date, a significant part of the relevant public would have become aware of the opponent's 'WHITE PEARL' mark in respect of rice.

46. As a result of the above, I hereby find that the opponent's reliance upon its section 5(3) ground falls at the first hurdle for failure to prove the existence of a reputation.

Section 5(4)(a)

47. Section 5(4)(a) of the Act reads as follows:

> "(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, where the condition in subsection (4A) is met,
> >
> > (aa) …..
> >
> > (b) …..
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

48. Subsection (4A) of Section 5 states:

> "(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of

application for registration of the trade mark or date of the priority claimed for that application."

49. In *Discount Outlet v Feel Good UK,* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

50. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation[1] among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source[2] or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

Relevant Date

51. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander Q.C., as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

"43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

> 'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.' "

52. The IR does not have a priority date, and neither is there any evidence before me that could be said to be earlier use of the behaviour complained of. As a result, the relevant date for this assessment is the designation date of the IR, being 19 September 2022.

Goodwill

53. The first hurdle for the opponent is that it needs to show that, at the relevant date, it had the necessary goodwill in its business and that the sign 'WHITE PEARL' was distinctive and/or associated with that goodwill.

54. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

55. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

> "27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent that the enquiry under s.11 of the 1938 Act (see Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.
>
> 28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

56. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

> "[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the

application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

57. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

"62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by *s.2(2) of the Trade Marks Act 1994*. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in *BALI Trade Mark [1969] R.P.C. 472*. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used "but had not acquired any significant reputation" (the trial judge's finding). Again that shows one is looking for more than a minimal reputation."

58. Goodwill arises as a result of trading activities. I have assessed the evidence of the opponent in full at paragraphs 22 to 37 above. I do not intend to repeat that summary here but remind myself that I found the evidence as a whole to be insufficiently solid in that I am unable to accurately determine the level of use in the UK[17] prior to the relevant date and how said use relates to the actual goods relied upon. Again, the only sufficiently solid evidence demonstrating actual use in the UK prior to the relevant period is the sale of £10,061 worth of rice to an address in Bradford.

[17] the issue of the EU being a relevant territory is not at play here as an assessment of goodwill applies to the UK only.

59. In considering the issue of goodwill, I remind myself that even a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small.[18] While that may be the case, I do not consider that the evidence before me is sufficient to support a finding that goodwill exists in the opponent's business. In making this finding, I repeat the issues I have discussed throughout this decision in respect of the evidence as a whole.

60. Even if I was satisfied that the evidence was sufficient to warrant a finding of goodwill, it would apply to "rice" only (on the basis that is the only term for which actual sales have been proven) and I do not consider that it would be at a high enough level to support of finding of misrepresentation. In this scenario, the level of protectable goodwill would only be weak and, for the reasons set out below, I do not consider that this would result in any success in favour of the opponent.

Misrepresentation and damage

61. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

> "There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is
>
> > "is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]"
>
> The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville*

[18] See, for example, *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590

Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

And later in the same judgment:

> ".... for my part, I think that references, in this context, to "more than *de minimis*" and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

62. I have proceeded to this stage of my decision in case I am wrong in finding that the opponent does not have the requisite goodwill to support a claim under section 5(4)(a). Therefore, for completeness I proceed on the assumption that the opponent enjoys a protectable level of goodwill for the sign 'WHITE PEARL' in respect of "rice". The IR is 'WHITE PEARL GIN' and protection is sought for "gin". The opponent's sign and the IR are, clearly, highly similar with the only point of difference coming in the descriptive word 'GIN'. That being said, the goods for which the opponent is said to enjoy goodwill and the goods for which protection is sought are self-evidently different, one being an edible grain and the other being a distilled alcoholic beverage.

63. While the goods may be dissimilar, the question under the present ground is whether the parties carry on business in close (or otherwise) fields of activity. In considering this point, I appreciate that the parties operate in the very broad 'food and drink' sector, however, the actual activities of their businesses differ. I say this because, plainly, the activity of producing and selling gin, being an alcoholic spirit, is not the same as producing and selling rice. Further, I do not consider it common in the trade for a producer of rice to also produce gin. In my view, this emphasises the distinct fields of activity within which the parties operate. Taking these points into account, I am only willing to find that the overlap between the fields of activity

is tenuous. In such circumstances, I remind myself of the case of *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), wherein Millet LJ referred to the finding of Slade LJ in *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 which set out that the further removed the parties' respective fields of activity, the less likely it was that a member of the public would be deceived. This case law sets out that the burden in overcoming such a hurdle is a heavy one. In the present case, the evidence is just too insufficiently solid in order to even come close to discharging this burden.

64. In summary, while I appreciate that the sign and the mark at issue are highly similar, this is not sufficient to overcome the distance between the fields of activity, especially given the low level of goodwill enjoyed by the opponent's business. As a result, I do not consider that the IR would deceive the average consumer into believing that the holder's goods originated from or were endorsed by the opponent.

65. Without misrepresentation, there can be no damage. As a result, I find that even if the opponent did enjoy goodwill in its sign, its reliance upon the section 5(4)(a) ground fails at this stage.

CONCLUSION

66. The opposition fails in its entirety and, subject to any successful appeal against my decision, the IR may proceed to protection in the UK.

COSTS

67. The opposition has failed and, as a result, the holder is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. While the holder only sought to file a counterstatement and did not file any evidence, I note that it was still required to consider the evidence and submissions that were filed by the opponent. As such, I consider it appropriate to make an award in respect of this task, albeit for a sum lower than the recommendation set out in the scale.

68. In the circumstances, I award the holder the sum of £600 as a contribution towards its costs. The sum is calculated as follows:

Preparing a counterstatement:	£300
Considering the opponent's evidence:	£300
Total:	**£600**

69. I hereby order Bestway Wholesale Limited to pay Kimberley Spirits Distillery Pty Ltd the sum of £600. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of October 2024

A COOPER
For the Registrar