

**TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NUMBER 1560705
IN THE NAME OF FOODS AND INNS LIMITED**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 44321 BY MADHUR JAFFREY**

**TRADE MARKS ACT 1938 (AS AMENDED)
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**IN THE MATTER OF application number 1560705
in the name of Foods and Inns Limited**

AND

**IN THE MATTER OF opposition thereto
under number 44321 by Madhur Jaffrey**

Background

On 29 January 1994, Foods and Inns Limited filed a trade mark application to register the trade mark MADHU in Class 29 in respect of the following goods:

Preserved and canned fruits and vegetables; all included in Class 29; but none containing honey.

The exclusion in relation to honey reflects the fact that the mark consists of the Hindi word meaning honey.

On 15 March 1996, Madhur Jaffrey filed notice of opposition to this application. The opponents say that the trade marks MADHUR JAFFREY and MADHUR'S have been used in the United Kingdom since at least 1976 in relation to cookery books, and from September 1982 in relation to a televised cookery series and video tapes of the series. From May 1995 (after the relevant date) they say that they have used MADHUR and MADHUR JAFFREY in relation to a range of foodstuffs. The grounds of opposition are in summary:

- 1. Under Section 12(1)** Because the mark applied for is similar, and is proposed to be registered for goods similar to the opponent's earlier trade mark and the goods for which it is registered.
- 2. Under Section 11** Because the opposed marks would be likely to deceive or cause confusion.
- 3. Under Section 12(3)** Having regard to the opponent's earlier trade mark and reputation, the opponent is entitled to protection under the Paris Convention as a well known mark.
- 4. Under Section 17** Because the applicant is not the bona fide proprietor of the trade mark and at the time of filing had no bona fide intention to use, and has not used the mark in relation to the services covered by the application.

The opponents further claim that the application was made in bad faith.

The marks relied upon by the opponents in the grounds of opposition is as follows:

	Number	Mark	Class	Specification
5	1365218	MADHUR'S	30	Spices, curry powder, seasonings, condiments, rice, noodles and tea.
10	2029066	MADHUR JAFFREY	29	Meat and meat extracts; eggs; milk and milk products, yoghurts, lasi; fish, poultry and game; pickles and vegetable pastes; preserved, dried and cooked fruits and vegetables; jellies, jams; salad dressings; preserves; edible oils and fats; lentils; prepared meals.
15			30	Rice and food products made from rice; cereals and cereal preparations; coffee, artificial coffee; tea, sugar, tapioca, sago; flour; yeast; baking powder; honey; treacle; vinegar, sauces, spices; salt; mustard; pickles and pastes; prepared meals, desserts, sweets, breads, pastry and confectionery.
20			31	Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.
25			32	Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; flavoured water; rose water; syrups and other preparations for making beverages.

The opponents ask that an award of costs be made in their favour.

The applicants filed a Counterstatement in which they deny the grounds of opposition. They ask that the opposition be rejected.

Both sides filed evidence in these proceedings. The matter came to be heard on 12 March 2001, the applicants being represented by Mr David Goldring of J E Evans Jackson, their trade mark agents, the opponents by Mr James Mellor of Counsel, instructed by Intelmark TSD, their trade mark agents.

By the time this matter came to be determined, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. These proceedings having begun under the provisions of the 1938 Trade Marks Act must continue to be dealt with under that Act, in accordance with the transitional provisions set out in Paragraph 17 of Schedule 3 of the 1994 Act. Accordingly, all references in this decision are references to the 1938 Trade Marks Act.

Opponent's evidence in Chief

This consists of a two Statutory Declarations. The first is dated 12 December 1996, and comes from Madhur Jaffrey, the opponent in these proceedings.

Ms Jaffrey gives details of her cinematographic, television, radio and stage credits, many in a leading role, starting in the 1950's through to, and after the relevant date in these proceedings. She refers to books, television series and magazine articles, including the following which appeared in the United Kingdom prior to the relevant date:

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Invitation to Indian Cooking published in 1973.

Eastern Vegetarian Cooking published in 1983.

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Madhur Jaffrey's Indian Cookery - an eight part television series for the BBC in 1982 which has been repeated on five occasions. A cookbook to accompany the series appeared on the best seller lists in the United Kingdom and continues to sell well.

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A taste of India published in 1985 - the book became a best seller and was serialised in London's Sunday Observer colour supplement

Madhur Jaffrey Cookbook published in 1989 - an extract appeared in Gourmet Magazine.

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Madhur Jaffrey's Far Easter Cookery - an eight part television series for the BBC in 1989. A cookbook and video accompanied the series, the book entered the best seller lists and was serialised by The Sunday Times Magazine.

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Listening to Volcanoes - a personal television documentary on colonialism in the Spice Islands of Indonesia, shown on BBC1 in 1992.

From Manna to Microwave - a six part series on the history of food written and presented on BBC radio 4 in 1990.

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A taste of the Far East published in 1993.

Quick and Easy Indian Cookery published in 1993.

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An Indian Spice Kitchen published in 1993.

Madhur Jaffrey's Flavours of India - a six part BBC television series on regional Indian food - with an average audience of 2.5 million for each episode. Accompanied by a book of the same title which reached the best seller lists.

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Ms Jaffrey relates the awards that she has received, although mostly from organisations outside of the United Kingdom, including the Glenfiddich 1982 award for best Radio/Television broadcaster, which Ms Jaffrey describes as the most prestigious food and wine award. She says that she has also written articles for various publications, inter alia, The London Times, Sunday Observer and Vogue, although does not give any specific details.

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Ms Jaffrey goes on to refer to an agreement entered into in 1995 with Tilda Rice Limited to assist in the creation of a range of food and beverages, including sauces, pastes and chutneys used in Asian cooking, and to be sold under the name “Tilda by Madhur Jaffrey”. Examples of the labels are shown as exhibit MJ1, and inter alia bear the name MADHUR JAFFREY. Ms Jaffrey refers to exhibits MJ2 and MJ3, which consist of a list of quotes attributed to her performances as an actress and author, and details of the trade marks relied upon in this opposition, respectively.

Ms Jaffrey ends her declaration by asserting that through her fame and reputation in relation to acting and cooking, that confusion would arise should the application the subject of these proceedings be registered.

The second Statutory Declaration is dated 18 December 1996, and comes from Paul Kavanaugh, a solicitor and head of Intelmark, the trade mark unit of Titmus Sainer Dechert, solicitors. Mr Kavanaugh refers to exhibit PK1 which consists of the results of a search to illustrate the fame and reputation of MADHUR JAFFREY, inter alia, in the field of cookery. The extracts include references to Ms Jaffrey as an actress and cookery writer.

Applicant’s evidence

This consists of a Statutory Declaration dated 26 August 1997, and comes from Anil Vasant Gokhale, an Indian citizen residing in Mulund (West) Mumbai, India. Mr Gokhale says that he is the Vice President (Legal) and Company Secretary of Foods and Inns Limited, and he confirms that he has full knowledge of the workings of his company and four years experience in the food industry.

Mr Gokhale says that his company has been involved in the manufacture and distribution of canned fruit, fruit pulp, vegetables, pickles, fruit juices and the like food and drinks since 1967. He refers to the filing, examination and opposition to his company’s application to register MADHU, saying that the mark has been in used in India by his company and its predecessors since 1939. He refers to exhibit 1 which consists of details of three trade mark registrations obtained in India for the mark MADHU, two dating from 1951 and covering the same goods as the application in suit.

Mr Gokhale gives the history of the ownership of the MADHU trade mark in India, and refers to exhibit 2 which consists of an advertisement for MADHU mangoes published in the Times of India in 1939 and again in 1997. He says that his company (or its predecessors) have used the trade mark in the United Kingdom since at least 1986 in relation to canned exotic fruits and vegetables, and refers to exhibit 3 which consists of an undated advertisement for MADHU tinned mangoes.

Mr Gokhale goes on to set out the approximate turnover for goods sold under the MADHU trade mark in the United Kingdom in the years 1986 to 1993, which ranges from £150,000 in 1986 rising to £210,000 in 1993. He says that approximately £5,000 has been spent in each year promoting and advertising the mark through leaflets, advertisements and direct mail to customers, and additionally, by the inclusion of MADHU products on retailer’s flyers, referring to exhibit 4 which consists of sample “Special Offer” flyers for a company called TRS Cash & Carry Limited. These include references to MADHU OKRA being available between 20 January 1992 and 9

February 1992, MADHU MANGO PULP between 10 February 1992 and 1 March 1992, and MADHU MANGO slices being on offer from 2 March, but no year given. Mr Gokhale says that sales of fruit and vegetables under the MADHU trade mark have been made throughout the United Kingdom, and to other European countries.

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Mr Gokhale recounts the events leading to, and subsequent to his company becoming aware of the opponent's objections to his company's application, and refers to exhibit 5 which consists of a letter dated 2 February 1996 from Titmus Sainer Dechert notifying them of Ms Jaffreys's reputation and the remedies available to her under the Trade Marks Act 1994.

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Mr Gokhale goes on to refer to the opponent's evidence, noting that it outlines her career as an actress, and as an author and broadcaster on cookery, much of it originating from outside of the United Kingdom. He highlights that the first use of her name in relation to foods was not until the agreement with Tilda Rice Limited in 1995, which is after the relevant date. He notes that despite his company's use of MADHU there is no evidence of any confusion, and he goes on to give his conclusions on why this should be, inter alia, because MADHU and MADHUR JAFFREY are not similar, that she has no reputation other than in her full name, there is no relevant use or reputation in relation to foods and any use is TILDA MADHUR JAFFREY.

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That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

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Turning first to the grounds under Sections 11 and Section 12(1) of the Act. These sections read as follows:-

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11 It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

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12(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

- a. the same goods
- b. the same description of goods, or
- c. services or a description of services which are associated with those goods or goods of that description.

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The reference in Section 12 to a near resemblance is clarified by Section 68(2)(b) of the Act which says that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

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The established tests for objections based on Sections 11 and Section 12 are set down in Smith Hayden and Company Ltd's application (Volume 1946 63 RPC 101) later adapted by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, the test may

be expressed as follows:-

- 5 (a) **(Under Section 11).** Having regard to the opponent's user of the mark MADHUR'S and/or MADHUR JAFFREY, is the tribunal satisfied that the mark applied for, MADHU, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?
- 10 (b) **(Under Section 12).** Assuming user by the opponents of their mark MADHUR'S and/or MADHUR JAFFREY in a normal and fair manner for any of the goods covered by the registration of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception among a number of persons if the applicants use their mark MADHU normally and fairly in respect of any goods covered by their proposed registration?
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The tests require me to consider the likelihood of deception or confusion by looking at what the applicants would notionally be entitled to do if they secured registration of the mark applied for (Section 12(1), or by having regard to the user, whether the opponents have established priority over the mark applied for (Section 11).

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Looking first at the respective marks. In a comparison I take account of Pianotist companies application ([VOL 1906] 23 RPC at page 777) in which Parker J said:

25 "You must take the two marks. You must judge of them both by their look and by their sound. You must consider the goods and services to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods or services. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods or services of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion -that is to say -not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods or services -then you may refuse the registration, or rather you must refuse the registration in that case."

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35 The opponents rely on two marks; a registration for MADHUR'S and an application to register MADHUR JAFFREY. Although the opponent's application to register MADHUR JAFFREY post dates the application under opposition, they have claimed use of the mark dating from 1976, earlier than the date of first use claimed by the applicants, and it is therefore appropriate to consider the matter as a "prior use" claim.

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Looking at the respective marks. Placed side by side it is plain to see that the applicant's mark MADHU is contained within MADHUR'S, creating a degree of visual similarity with both of the opponent's marks although much closer in respect of MADHUR'S alone. These words share the same hard syllable at the beginning and a softer syllable at the end. In my view the terminal letters "RS" in MADHUR'S makes no significant difference to the way the words would sound when spoken, particularly given the tendency to slur the endings of words. Consequently, there

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is also aural similarity but the addition of the word JAFFREY with the opponent's second mark makes a significant difference and moves the respective marks apart. However, marks are rarely viewed in this fashion and a consumer having come into contact with a mark will usually retain some recollection, often imperfect, and may recall it from memory at some later stage by reference to a particular feature or features.

The word MADHU is the Hindi word for HONEY although I consider that this meaning would be lost to all but to Hindi speaking persons which I accept may be a sizeable minority. To the majority of persons I would say that the mark will most probably be seen as nothing more than a word coined to capture the flavour of the subcontinent and in respect of goods other than honey or containing honey the word would be a distinctive trade mark. The word MADHUR'S may well be the possessive form of the forename of a well known person, and that it is the possessive form may lead one towards the conclusion that it is a name. But I am not convinced that anyone seeing MADHUR'S would necessarily make the link to MADHUR JAFFREY, particularly when used in an area which at best has some loose association with her fame, in this case food, rather than in connection with the activities for which she is said to be famous. It may well be that to most the word MADHUR'S will also be an invention.

There is no dispute that the opponent's MADHUR JAFFREY trade mark includes identical goods to those of the application. Their second mark MADHUR'S is registered in respect of "spices, curry powder, seasonings, condiments, rice and tea." all but one of which are capable of being regarded as preserved, dried or cooked fruits and vegetables, or in other words, identical goods to those covered by the application. The only item in the application that would I consider not to be identical to those covered by the opponent's MADHUR'S registration is noodles, but I would consider these to be of the same description to goods such as rice.

These goods are not high price items although are likely to be selected with a degree of care, but I would say with more attention likely to be paid to name of the foodstuff to ensure that the correct product is obtained rather than to the brand. That said, food products can attract brand loyalty with consumers choosing an item because they have previously bought and been satisfied with that specific product, or another product from that trader. The applicants make reference to their market being specialised, but their application is not limited in any way and notionally covers the same market and consumers. Even if the application were to be limited to reflect a trade in ethnic foodstuffs this would not change matters because the opponent's marks are not limited and would still cover the same goods.

The applicants have made long use of their mark, primarily in their home market in India and may well be known amongst emigre's to the United Kingdom from that region, but this would represent only a small proportion of the relevant consumers in this country. Sales and advertising in the United Kingdom have extended over a period of around 8 years, although I would say at what can only be described as a modest level. However, even accepting that this has been in relation to a limited range of exotic canned fruits and vegetables I do not consider that the evidence shows that through the use made of it their mark is likely to enjoy a strong reputation.

The name MADHUR JAFFREY is said by the opponents to be a name of long standing fame in this country, and is accepted as such by the applicants, albeit as an actress, and a writer and broadcaster primarily in relation to cookery. I do not dispute that the name MADHUR JAFFREY

is likely to be well known to a significant proportion of the public in this country, but this is where I consider the fame to subsist; in the name as a totality, and I would concur with the applicants on their assessment of the extent. The opponent's case relies upon the premise that a consumer on seeing MADHU will call to mind their marks, primarily because they will not have seen the word, or anything like it, that is other than in the forename of a well known personality. It may well be that some of the fame extends to the family name JAFFREY, it not being unusual for her to be referred to as MISS JAFFREY, for example in reviews of her books as shown in exhibit MJ2, but I see nothing in the evidence to establish that her forename has ever been used in the same way.

If MADHU were to be used in respect of the core activities in which her fame subsists there may well be some possibility of deception or confusion arising. However, to say that this would be the case if the mark were to be used in relation to goods that at best could be said to be loosely associated with her fame as an author and broadcaster in relation to cookery because they are foodstuffs and may be used or referred to in a book or broadcast on cooking seems an unlikely course of events. I accept that there has been some use of her name for foodstuffs in conjunction with Tilda, but this commenced after the relevant date, and in any event, there is scant detail on the extent of this use by which to gauge its impact.

Even making allowance for her long standing fame and that there is identity of goods, at least in part, and similarity in others, I do not consider that there is a likelihood of confusion in between the marks MADHU and MADHUR JAFFREY, and the ground founded under Section 11 and 12(1) in respect of application number 2029066 fails accordingly.

With regard to the mark MADHUR'S I believe the position to be somewhat different. There is no evidence that that mark has ever been used and I do not see how an attack under Section 11 can succeed, and is dismissed accordingly. However, taking into account the "global" test envisaged in the Pianotist case, for the reasons given above I come to the view that there is sufficient identity in respect of, inter alia, the marks, goods, customer and market base, for there to be a strong likelihood of confusion or deception, and the opposition succeeds under Section 12(1).

The opposition having been successful the opponents are entitled to a contribution towards their costs. I order the applicants to pay the opponents the sum of £835 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 05 day of July 2001

**Mike Foley
for the Registrar
The Comptroller General**