

**O-298-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NOS. 3059592, 3059567 AND 3059563  
BY GOURMET BAKERS & SWEETS LONDON LIMITED  
TO REGISTER THE TRADE MARKS**



**AND THE OPPOSITIONS THERETO UNDER NOS. 402830, 402832 AND 402833  
BY GOURMET FOODS**

**AND**

**IN THE MATTER OF REGISTRATION NOS. 3002778, 2593103, 2646565,  
2654078, 3002769, 2643615 AND 3035297  
OWNED BY GOURMET BAKERS & SWEETS LONDON LIMITED  
FOR THE TRADE MARKS**



**AND THE APPLICATIONS FOR DECLARATIONS OF INVALIDITY THERETO  
UNDER NOS. 500611, 500612, 500613, 500614, 500615, 500616 AND 500781  
BY GOURMET FOODS**

**AND**

**IN THE MATTER OF APPLICATION NO. 3047645 BY GOURMET PAKISTAN LTD  
TO REGISTER THE TRADE MARK**



**AND THE OPPOSITION THERETO UNDER NO. 403760  
BY GOURMET BAKERS & SWEETS LONDON LIMITED**

## Background and pleadings

1. Ten of the opposition and cancellation proceedings listed on the title page of this decision have been brought by Gourmet Foods (an association of persons, registered in Pakistan) against three trade mark applications and seven trade mark registrations owned by Gourmet Bakers and Sweets London Limited. Additionally, the latter has also opposed the trade mark application made by Gourmet Pakistan Ltd, which is a subsidiary of Gourmet Foods<sup>1</sup>. For simplicity, I will refer to Gourmet Foods and Gourmet Pakistan Ltd as 'GF' and to Gourmet Bakers and Sweets London Limited as 'London'. The various proceedings are consolidated.

2. The details of London's trade mark applications are as follows:

(i) 3059592 (opposition number 402830)



*Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals; soups and potato crisps.*

*Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.*

*Class 32: Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines.*

*Class 33: Alcoholic wines; spirits and liqueurs; alcopops; alcoholic cocktails.*

*Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.*

Filing date: 12 June 2014; date of publication in the *Trade Marks Journal*: 11 July 2014.

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<sup>1</sup> By way of an email to the Tribunal, dated 12 May 2015, these entities agreed to be jointly and severally liable for any adverse costs award.

(ii) 3059567 (opposition number 402832)



Goods, services, filing and publication dates as above.

(iii) 3059563 (opposition number 402833)



Goods, services, filing and publication dates as above.

3. The details of London's trade mark registrations are as follows:

(i) 3002778 (cancellation number 500611)



Class 29: *Jellies, jams, compotes; eggs, milk and milk products.*

Class 43: *Services for providing food and drinks; restaurant, bar and catering services, booking and reservation services for restaurants.*

Filing date: 19 April 2013; registration procedure completed: 25 August 2013

(ii) 2593103 (cancellation number 500612)



Class 29: *Dried and cooked fruits and vegetables, jellies, jams, milk and milk products, soups and potato crisps.*

Class 30: *Coffee and tea; flour and preparations made from bread, pastry and confectionery.*

Class 43: *Services for providing food and drink; restaurant and catering services.*

Filing date: 29 August 2011; registration procedure completed: 9 December 2011

(iii) 2646565 (cancellation number 500613)



Goods, services, filing and registration dates as for previous registration.

(iv) 2654078 (cancellation number 500614)



Goods and services as for the applications, with the addition of Class 31:

*Agricultural, horticultural and forestry products; fresh fruits and vegetables, seeds, natural plants and flowers.*

Filing date: 23 February 2013; registration procedure completed: 28 June 2013

(v) 3002769 (cancellation number 500615)



Class 29: *Jellies, jams, compotes; eggs, milk and milk products.*

Class 30: *Coffee, tea, cocoa, sugar, rice, tapioca, sago, pastry and confectionery, ices; sandwiches; prepared meals; pizzas, pies and pasta dishes.*

Class 32: *Non-alcoholic drinks; fruit drinks and fruit juices; non-alcoholic beers and wines.*

Class 43: *Services for providing food and drinks; restaurant, bar and catering services; booking and reservation services for restaurants.*

Filing date: 19 April 2013; registration procedure completed: 20 September 2013

(vi) 2643615 (cancellation number 500616)



Class 29: *Meat, fish, poultry and game; milk and milk products; prepared meals; soups.*

Class 30: *Coffee, tea, sauces (condiments); spices; prepared meals; pizzas, pies and pasta dishes.*

Class 32: *Beers, mineral and aerated water; non-alcoholic drinks, fruit drinks and fruit juices; syrups for making beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines.*

Class 33: *Alcoholic wines, spirits and liqueurs, alcopops, alcoholic cocktails.*

Class 43: *Services for providing food and drink, restaurant, bar and catering services; booking and reservation services for restaurants.*

Filing date: 27 November 2012; registration procedure completed: 1 March 2013

(vii) 3035297 (cancellation number 500781)



Class 29: *Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals; soups and potato crisps.*

Class 30: *Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, sweets, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.*

Class 32: *Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines.*

Class 33: *Alcoholic wines; spirits and liqueurs; alcopops; alcoholic cocktails.*

Class 35: *Advertising; business management; business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; opinion polling; data processing; provision of*

*business information; retail services connected with the sale of sweets, savouries and bakery products.*

*Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.*

Filing date: 17 December 2013; registration procedure completed: 31 October 2014.

4. The details for the single opposed application belonging to GF are:

3047645 (opposition number 403760)



*Class 5: Foods for babies, mineral food-supplements, dried milk being food for infants, infants' and invalids' foods; pharmaceutical preparations and substances; sanitary preparations; veterinary preparations; medicated hair oils and shampoos; medicated henna in all forms, all types of ayurvedic, homeopathic, medicinal and herbal preparations, natural hair colour revitalizers and restorers; medicated preparations for application to the skin; medicated soaps; medicated skin creams and lotions; talcum powder; skin lightening preparations; disinfectants; preparations for repelling insects and destroying vermin, insecticides, fungicides, herbicides, pesticides.*

*Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, edible oils and fats; fruits jellies, milk and milk products: milk, processed milk, preparations for making soups, soups fermented milks, powdered milk, soya bean milks, milk beverages, milk processed products, yogurt and dairy products (for food).*

*Class 30: Tea, coffee, cocoa, coffee essences and extracts, sugar, rice, foodstuff having a base of rice, tapioca, pasta, cereal and cereals preparations all food for human consumption, flour, bread, cakes, pastry; confectionery, chocolates, biscuits, wafers, ices, ice creams, puddings, honey, treacle, yeast, sauces, salad dressings, spices, syrups for food, snack food, mayonnaise, sauces (condiments).*

*Class 32: Mineral and aerated water, spring water, energy drinks, fruit drinks, juices, beers (non alcoholic); non-alcoholic drinks and syrups, and other preparations for making beverages.*

*Class 39: Packaging and storage of goods; distribution and delivery of meals for catering requirements; travel arrangement services; arranging of cruises, excursions, expeditions and tours; reservation services for travel; reservation services for transport; air transport services; tourist office and travel agency services; travel package holiday services; provision of tourist information.*

*Class 43: Services for providing food and drinks; catering services, cafe, restaurant, food courts and takeaway food services; restaurant services for the provision of fast food; restaurant, hotel and temporary accommodation services; reservations, booking and information services.*

Filing date: 19 March 2014; publication date 7 November 2014.

5. GF's oppositions and cancellations are based on sections 3(6) and 5(4)(b) of the Trade Marks Act 1994 ("the Act") and the protection afforded to well-known marks under the Paris Convention (section 56(1) of the Act). The claims are:

- Under section 3(6), GF has a number of 'Gourmet' marks incorporating the colour orange which it has used extensively in Pakistan (shown below) in relation to food, drink and associated services. London would have known about the marks at the time of filing because of their reputation and well-known status. London "has adopted the essential features of a mark being used abroad, with the intention of pre-empting the proprietor who intends to trade in the United Kingdom." The statement of case states that GF "intends to commence trading directly in the UK in the very near future."
- Under section 5(4)(b), GF claims that it created the graphic logos (shown below) in the 1980s and that the 'g' logo is a prominent feature of the marks numbered A, C and F. GF claims that it owns the copyright in marks A, C and F. GF claims that London's marks are reproductions of GF's logos, or a substantial part thereof, and because GF's marks are well-known, London would have known about their existence and use.
- Referring to section 56(1), GF claims that use of London's marks, being similar to GF's marks, in relation to various goods and services which are identical and similar to the goods and services for which GF's marks have been used, is likely to cause confusion.

6. GF's marks are<sup>2</sup>:

Gourmet (word-only)

A



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<sup>2</sup> These representations are taken from GF's evidence, as they are clearer than the representations in the statutory opposition and cancellation forms.

B



C



D



E



F





G



H



I



*gourmet*  
چمکے اور کھائیں

J



*gourmet*  
Foods

K



L



M



N



7. London filed counterstatements, denying the grounds of opposition and cancellation. In particular, London denies that GF's marks are known outside of

Lahore, the capital city of the Punjab province. Pakistan has four provinces. London denies that GF created the stylised 'g' and states that it is a standard font (examples of the letter g in various fonts are included in the counterstatement as Schedule A). Further, London claims that the colour orange is commonly associated with food in Pakistan. In relation to the ground under section 3(6), London states:

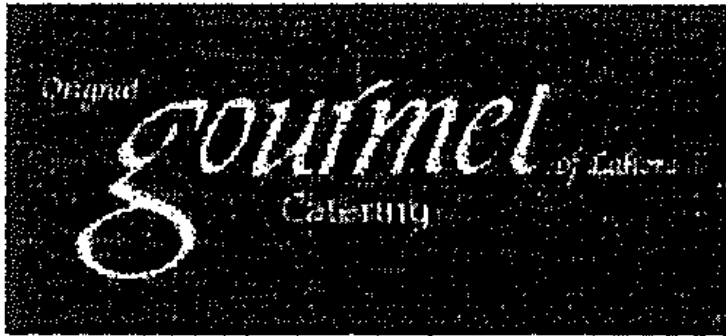
- London is a well-established UK business, operating since November 2010;
- There is no evidence that GF intends to trade in the UK and no reason why London should or could have known of any such intention.
- GF does not promote or advertise its business in the UK
- GF does not have any business located in the UK and no UK goodwill

8. London's opposition against GF's trade mark application is based upon sections 3(1)(c), 5(2)(b), 5(3) and 5(4)(a). The section 5(2)(b) and 5(3) grounds are founded upon London's registrations 2654078, 3002769 and 3002778. Different goods are opposed depending on which earlier right is relied upon for section 5(2)(b), and different goods are relied upon as having a reputation under section 5(3). Section 5(4)(a) relies upon the signs shown below<sup>3</sup>, in respect of use since 1 December 2010 (for various goods and services, depending on which sign is relied upon):



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<sup>3</sup> The representations in the statement of case are not of good quality.



9. London claims that the script below the word gourmet in GF's application is a representation of gourmet in Arabic and/or Urdu. Within the banner are the Arabic/Urdu words which translate into 'Shines in every household/home'. London claims that this element is laudatory and that 'gourmet' is laudatory and descriptive. It is claimed that the mark therefore consists exclusively of a sign or indication which may serve in trade to designate the kind, quality, value or intended purpose of some or all of the Class 5, 29<sup>4</sup>, 30, 32, 39 and 43 goods, contrary to section 3(1)(c) of the Act.

10. GF's counterstatement states that the reason the word gourmet in its mark is similar to the earlier marks is because London copied its trading style and its mark, which has been registered in Pakistan since 1991 and is a well-known mark. GF has applied to cancel London's earlier marks (see above). Although the counterstatement is silent in relation to the section 3(1)(c) ground, it is clear from the subsequent evidence rounds and the hearing that GF defends its application against this claim; certainly, London has not taken any points about its absence from the counterstatement, either during the evidence rounds or at the hearing.

11. The matter was heard by me at a hearing on 26 February 2016 by video conference. GF was represented by Mr Jeremy Heald, of Counsel (instructed by HGF Limited). London was represented by Mr Malcolm Chapple of Counsel (instructed by London IP Limited).

### **The evidence**

12. GF has filed evidence from seven individuals, one of whom has given evidence in reply. London has filed evidence from its trade mark attorney, Ms Frances Nwaegbe.

### **GF's evidence in support**

Yasmin Akhtar, witness statement dated 11 February 2015

13. Ms Akhtar has worked in the restaurant trade and now operates as a freelance business consultant to restaurant owners, but has never been employed by GF. She

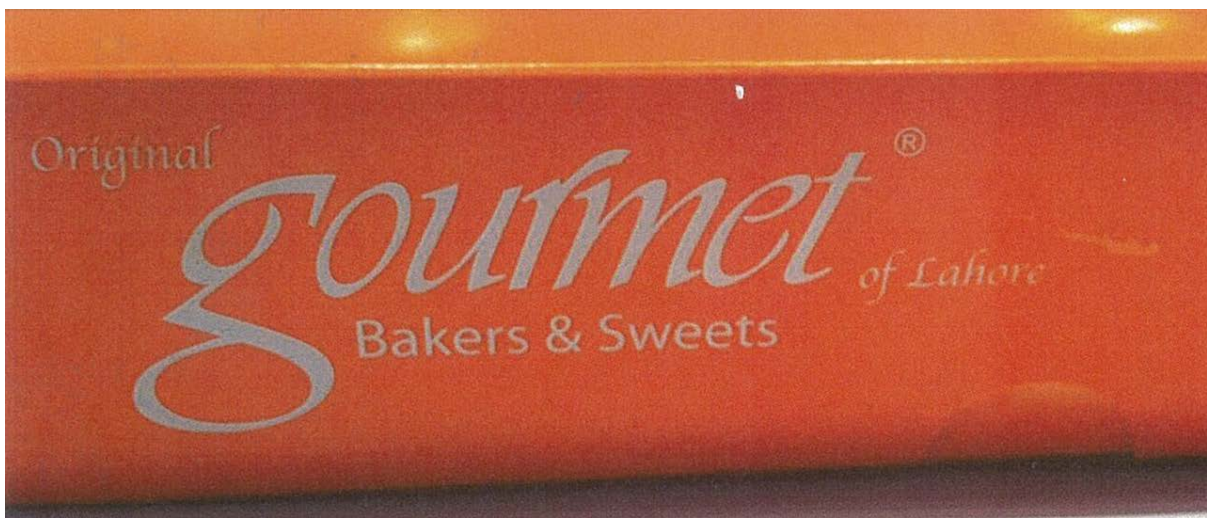
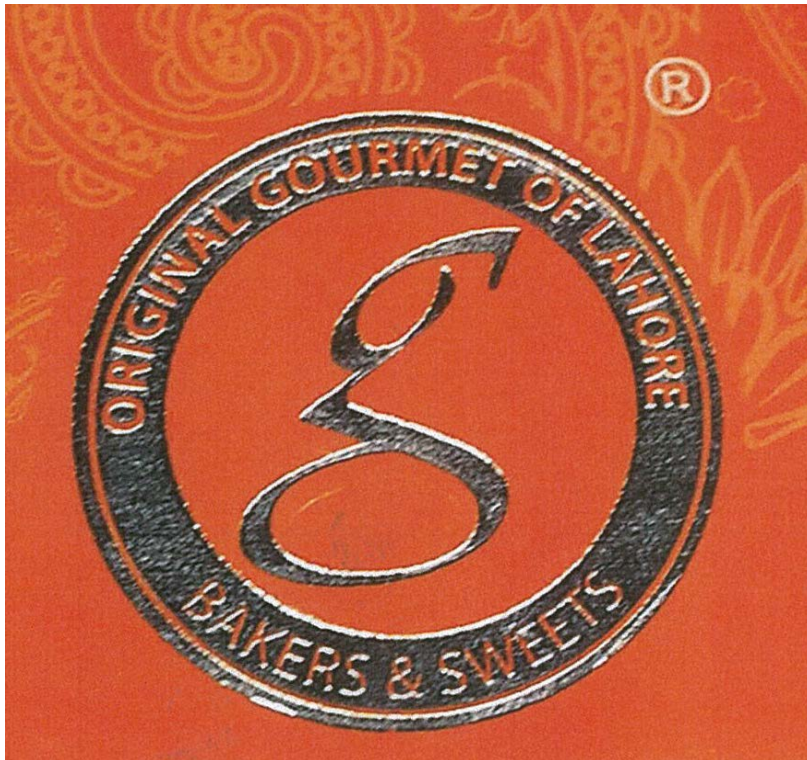
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<sup>4</sup> In the statement of case, class 9 is referred to instead of class 29. Since class 9 never formed part of the opposed application, this appears to have been a typographical error. The objection under section 3(1)(c) is taken against all the goods and services of the application, which would include class 29.

is British and lives in the UK, but is familiar with GF's shops and restaurants in Lahore. According to Ms Akhtar, GF is a household name in Pakistan and many of the British Pakistani community would know of GF, having seen their goods and premises in Pakistan where there is a large high street presence. This is unsupported assertion (or Ms Akhtar's personal opinion).

14. Ms Akhtar states that, upon seeing London's shop in Ilford (an area where there is a Pakistani community), she sent a text to a friend to ask if it was the same Gourmet that she had visited in Pakistan and was informed that GF had no shops in the UK. Her view was that the signage copied the trade dress of GF. She bought some sweets from the shop and was told by a staff member that the shop was the same company as GF. A photograph of the shop front and packaging for goods retailed therein is exhibited (YA1 and YA2):





Shaukat Ayaz, witness statement dated 11 February 2015

15. Mr Ayaz has been the General Manager of Gourmet Private Limited, in Lahore, a company wholly owned by GF, for five years. He states that GF started using the Gourmet family of marks in 1987, starting with a sweet shop in Lahore. Mr Ayaz states that Lahore is still GF's stronghold, but that it now operates throughout Pakistan. GF's businesses under the Gourmet trademarks includes bakeries, restaurants, pharmacies, furniture stores, shops selling sweets, cosmetics, publications and beverages, as well as manufacture of foodstuffs, beverages and packaging material. By May 2014, there were 138 retail outlets and 10 factories using the Gourmet mark(s). Mr Ayaz states that as well as having its own consumer-facing outlets, GF also sells its goods via 600 distributors throughout Pakistan.

16. Mr Ayaz gives the following sales figures for the Gourmet mark (not distinguishing between the various formats of the mark, or between goods and services):

2009	£5,994,883
2010	£9,742,223
2011	£17,482,077
2012	£30,297,344
2013	£34,937,991
2014	£57,758,127

17. Mr Ayaz states that GF promotes its trade marks and products on its website, gourmetpakistan.com, which he points out is accessible from the UK. He states that GF has always traded using the prominent, particular shade of orange<sup>5</sup> (as shown in the marks set out earlier in this decision), the particular script, and the stylised 'g'. Some examples of food packaging are given in Exhibit SA5. These are not dated. Undated photographs of GF's retail premises in Pakistan (137 in all) are exhibited in SA6, for example:



The majority of the retail and factory premises listed appear to be located in the Punjab (Lahore is the capital of the province and appears to be the primary location for GF's premises).

18. Mr Ayaz states that GF has been preparing to expand into the UK market. He states that "the first step was in February 2014 when we arranged for a subsidiary to be incorporated in England and Wales [Gourmet Pakistan Limited]. That company ("our UK subsidiary") has recently acquired three retail locations in London but has not yet started to trade here."

<sup>5</sup> Pantone Solid Coated 151C.

19. Exhibit SA9 is a copy of an article dated 4 May 2014, published in a newspaper, the Express Tribune of Pakistan. It reports that several Pakistani food businesses, including that of GF, have had their trade marks 'infringed' by unrelated parties setting up business in the UK. Mr Ayaz states that one of London's directors, Mr Rana Iftikar Ahmad established a company called Nirala Sweets London Limited in 2007. He opened a Nirala sweet shop in the UK and filed for Nirala as a trade mark in the UK and in the EU. Nirala is another well-established company in Pakistan, mentioned in the aforesaid newspaper article.

20. Mr Ayaz states that, according to the 2011 UK Census, 2% of the population of England and Wales is of Pakistani ethnicity. This figure is given in Exhibit SA11 which is the official census report of 11 December 2012, on the website of the Office for National Statistics. The report states that India, Pakistan and Bangladesh continue to rank highly within the most common non-UK countries of birth. Mr Ayaz states that London's food shops in London are specialist retailers of cakes and other foodstuffs for the Pakistani community. It is Mr Ayaz's opinion that residents and visitors of Pakistani descent will know of GF's business in Pakistan, especially if they have visited Pakistan.

21. Mr Ayaz also refers to evidence of copyright registrations, and that the duration of copyright protection in Pakistan is 50 years after the death of the author. He states that Muhammad Nawaz Chattha, the author/creator, is still alive. I will give details of the copyright registrations later in the evidence summary, as it is GF's trade mark attorney who exhibits the certificates (requests had been made for certified copies, but these had not arrived by the time Mr Ayaz had to file his evidence).

Yasir Siddiqi, witness statement 11 February 2015

22. Mr Siddiqi has been GF's Sales and Marketing Manager for four years. He states that GF advertises, for example, in the conventional press, on the TV, and via hoardings. He states that the scale of GF's advertising in Pakistan is great. As an example, he exhibits an advertisement (at YS1) which was published on a single day in seven newspapers, costing the equivalent of £2,000. The advertisement appeared on the back (outside) page on 8 November 2013; for example:





The publications appear to be Lahore editions.

23. Mr Siddiqui states that major Pakistani newspapers are available on commercial flights between the UK and Pakistan. Further, the papers have limited circulation within the UK through local distributors. Exhibit YS7 is a 'To whom it may concern' letter dated 11 February 2015 (unsigned) on headed notepaper from Total Media Solutions Jang Group Marketing. It 'certifies' that GF has advertised with them and that 'Jang' has a UK edition to cater for the UK audience. The letter says that "tentatively the circulation is 13,500 copies".

24. Exhibit YS2 contains prints of pages from GF's English language website, showing its trade marks in relation to foodstuffs, drinks, restaurants and shops. The pages were printed on 10 February 2015. In 2012-2013, GF spent a quarter of a million pounds on TV advertising and over £410,000 on advertising and publicity. Mr Siddiqui makes the point that money goes a lot further in Pakistan than it does in the UK. He states that GF has advertised in various media which have been "telecasted/viewed online/circulated to the United Kingdom". Mr Siddiqui attaches at Exhibit YS3 what he describes as summaries of annual media schedules. He says that UK Pakistanis will have had regular and frequent contact with some of these channels, which are the major channels in Pakistan. The advertisements took place between February and September 2013, several times a day.

25. Mr Siddiqui states that most of the TV channels are not terrestrial and are commonly viewed by Pakistani people around the world, "including particularly the UK". One of the channels listed in exhibit YS3 is 'Geo', owned by the Independent Media Corporation of Karachi. Exhibit YS4 consists of a letter from this broadcasting company which is headed "To whom it may concern" and says:

- 1) Geo TV is telecasted in the UK
- 2) Geo TV is free to air in UK and it has subscription of 150,000 in the UK
- 3) Gourmet is Geo's client & has advertised on Geo/Jang in past in Pakistan."

The letter is signed by Zaigham Abbas, Manager of Marketing Operations and is dated 10 February 2015.

26. Another channel in the list exhibited in YS3 is called APNA. Exhibit YS5 is a print from Wikipedia, dated 10 February 2015. It describes APNA Channel as a Punjabi language channel, with its target audience being Pakistan, but also Punjabi communities settled in Europe and elsewhere.

27. Mr Siddiqui states that part of the rationale for GF's advertising has been to reach people of Pakistani background residing in the UK "as we have been preparing the ground for the impending launch of Gourmet Foods retail operations in the UK." Mr Siddiqui estimates that the population of Pakistan which has been reached by GF's advertising is 180 million (almost the total population). He surmises that GF's advertising will have been seen in the UK by 1.1 million people, from the Pakistani community who come into contact with the media in which GF advertises.

Hassan Tariq, witness statement dated 11 February 2015

28. Mr Tariq is an investigator working for Cerberus Investigations Limited, in London, specialising in intellectual property investigations. His witness statement describes an investigation he undertook in the vicinity of London's shop on 30 January 2015. He filmed customers, having engaged them in conversations (in Urdu) about London's shop and goods. He exhibits his translations at exhibit HT3. The probative value of this evidence is zero. It is hearsay and none of the individuals are identified. No permission to adduce what is, effectively a street survey, was sought from the tribunal. Even if permission had been sought, the results are worthless, bearing in mind the standards set down for surveys in trade mark proceedings (see *Imperial Group plc & Another v. Philip Morris Limited & Another* [1984] RPC 293 and Tribunal Practice Notice 2/2012). It is unnecessary to describe this evidence.

Francesca Nwaegbe, witness statement dated 17 April 2015

29. Ms Nwaegbe is London's trade mark attorney. Her evidence comprises:

- Exhibit FIMN1: trade mark search results from the UK register of marks containing the word GOURMET, in the food and drink classes. Some are registered marks, others are withdrawn, refused or opposed.
- Exhibit FIMN2: a Wikipedia print and a Pakistani government website print which say that the national language of Pakistan is Urdu, whilst its official language is English.
- Exhibit FIMN3: Wikipedia and other reference source website prints showing the estimated current population of Pakistan to be close to 200 million. City dwellers make up over a third of the population.
- Exhibit FIMN4: a print from the website of the Office for National Statistics, showing the Pakistani ethnic group to be 2% of the population of England and Wales in 2011.
- Exhibit FIMN5: prints detailing four unrelated parties in Pakistan whose names include the word Gourmet (Gourmet Bakers, Gourmet Burger Company, Gourmet on Wheels and Roasters Gourmet Coffee House).
- Exhibit FIMN6: an extract from the 2013 report of the Asian Patent Attorneys' Association Copyright Committee which states that the register of copyright is prima facie evidence which only raises a presumption of the named person as the author, it is not conclusive.
- Exhibit FIMN7: domain name details for gourmetpakistan.com (belonging to GF) and an extract from the website, printed on 11 April 2015:



- Information about a GF European Trade Mark (EUTM) belonging to Zubair Chattha (for the stylised mark gourmet) which was partially refused in relation to food and drink goods and services on the grounds of descriptiveness.

Michael Varvill, witness statement dated 21 July 2015

30. Mr Varvill is a partner with HGF Limited, GF's trade mark attorneys. In addition to exhibiting certified copies of GF's Pakistani trade mark registrations, Mr Varvill exhibits (at MV2) certified copies of Pakistan Copyright registration numbers 28410, 23003 and 28400 (referred to in Mr Ayaz's statement, above). The certified copies come from the Intellectual Property Organisation of Pakistan, Copyright Office in Karachi. Registration 28410 is the orange stylised word 'gourmet'. Copyright is owned by GF, and it was created by Muhammad Nawaz Chattha in 1987, and published in Pakistan in the same year. Registration 23003 is for the stylised lower case 'g'. Copyright is owned by GF. The other details are the same. Registration 28400 is for the Arabic script which appears below the word gourmet in GF's trade mark application.

31. Exhibit MV3 is a copy of an article called 'Integrating Strategies of Entrepreneurship – Gourmet Pakistan: Case study from Pakistan' which appeared in International Journal of Academic Research and Reflection, Vol 2, No.2, 2014. There are references in the article to GF being the largest baking and confections chain in Pakistan; that GF was incorporated in 1987; and that it has over 150 outlets in Pakistan, three restaurants and five production units.

32. Mr Varvill states that, in Pakistan, GF's product range covers over 2,000 items, including beverages, breads, pastries, sweets, confectionery, milk, milk products, snacks, prepared meals, stationery and household goods. He exhibits, as examples at MV4, copies of the first and last pages of a 51-page list of GF's products.

33. Exhibit MV5 comprises a copy of a survey conducted by Neilson, a large consultancy which studies consumer trends and brands. The survey is dated 24 October 2014 and concerns the level of sales of mineral water and fizzy drinks in Pakistan. The report states that the top three producers of fizzy drinks in Pakistan (at the date of the survey) are PepsiCo, Coca-Cola and GF. GF sold 259 million litres of its Gourmet-branded soft drinks in 2012; 368 million litres in 2013; and 285 million litres in 2014.

Zubair Nawaz Chattha, witness statement dated 10 August 2015

34. Mr Chattha is a member of the Association of Persons which forms GF. He repeats information given by Messrs Ayaz and Varvill concerning copyright and trade mark registrations. Mr Chattha makes observations about the similarities between the parties' marks and speculates as to London's choices of marks and the motives of its directors. Mr Chattha questions why no one from London has filed evidence to explain the adoption of its UK branding and to refute "the obvious inferences that must be drawn" due to the similarities between the marks and the reference to Original Gourmet of Lahore in London's trade marks.

35. Mr Chattha has also filed a copy of a witness statement made by one of London's directors, Mr Nizakat Ali, in unconnected EUTM proceedings against a third party.

Second witness statement of Shaukat Ayaz, dated 10 August 2015

36. Mr Ayaz makes similar observations to Mr Chattha; it is unnecessary to repeat these.

Joanne Lowther, witness statement dated 23 November 2015

37. Ms Lowther is a Trade Mark Director at HGF Limited, GF's trade mark attorneys. The purpose of her evidence is to reply to Ms Nwaegbe's evidence. Ms Lowther makes observations about the status and composition of the marks from the trade mark register exhibited by Ms Nwaegbe. Some of the marks have been opposed by London.

Second witness statement of Frances Nwaegbe, dated 23 November 2015

38. Ms Nwaegbe adduces copies of Registry and Supreme Court decisions (the latter going to section 5(4)(a), which is no longer a pleaded ground). The Registry decision, BL O/409/15 MOCCIANI, is said to support London's defence against sections 3(6) and 5(4)(b). I will bear it in mind, but it is not appropriate to include it in this evidence summary.

39. Ms Nwaegbe also adduces the witness statement dated 18 August 2014 of Mr Nizakat Ali in the proceedings (referred to above in paragraph 35). She states that London relies upon this evidence as showing use of its marks/brand in the UK since 2010 (Exhibit FIMN13). Mr Ali states in his evidence<sup>6</sup>:

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<sup>6</sup> Opposition proceedings at the European Intellectual Property Office, number B2308784.

- He is London's Director (since 2012).
- Rana Iftikar Ahmad designed by hand in 2007 the trade mark which forms the basis of UK trade mark registration 2654078:



- The subject of UK trade mark registration number 2593103 was designed in 2010:



- The subject of UK trade mark registration number 2646565 was designed in 2012:



- The principal goods in relation to which the marks have been used are bakery products, savoury products, gateaux, cakes, wedding cakes, pastries, confectionery, patties, specialised Asian foods and non-alcoholic drinks. Exhibit NA2 comprises a selection of flyers, advertisements, shop window banners and other promotional material. These are undated. £2000 was spent on promotion in the UK over the three year period 2010 to 2013.
- The annual value of the products and services sold between 2010 and 2013 was:

2010-2011	£63,129
2011-2012	£373,254
2012-2013	£603,148

- Mr Ali states that he is not able to show any invoices as all products are sold to customers in London's shops, which issue till receipts. There are no till receipts exhibited.

## Decision

40. I will begin with GF's ground under section 3(6) of the Act, which is pleaded against London's applications and registrations. Section 3(6) states:

“3.— (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

41. This is relevant to the cancellation actions because section 47(1) of the Act states:

47.—(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).”

42. The law was summarised by Arnold J in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch):

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

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

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

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

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour

observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

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

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

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

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

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

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

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

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

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

139. There have been a series of cases in which courts and tribunals have had to consider whether a lack of intention to use the trade mark on the part of the applicant constitutes bad faith within section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation. It should be noted at the outset that there are a number of variants of this question, including the following:

(1) whether the making of a declaration of intention to use the mark as required by section 32(3) of the 1994 Act, which is false because in fact the applicant did not intend to use the mark, amounts to bad faith;

(2) whether an intention to use the mark in relation to some goods covered the application, but not others - and hence a statement of intention to use that is true in relation to the former goods, but not in relation to the latter – amounts to bad faith; and

(3) whether a lack of intention to use amounts to bad faith if there are exacerbating factors, such as (a) an attempt to obtain protection for an unregistrable mark or (b) an attempt to block others from registering the mark by repeated applications."

43. Mr Iain Purvis QC, sitting as the Appointed Person in *Mariage Frères, Société Anonyme v TWG Team Company* (Sakura! Sakura! Tea) BL O/131/16, observed:

"5. In any allegation of bad faith, the pleadings are of particular importance. The precise facts which are said to establish dishonesty or conduct falling short of the standards of acceptable commercial behaviour need to be identified."

44. GF's ground under section 3(6) (in all its actions) is worded as follows:

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As set out in the enclosed Statement of Grounds, in particular at Paragraph 4, the Opponent has extensively used and promoted a number of trade marks which include the GOURMET mark as well as a number of distinctive logos, details of which are referred to in the Statement of Grounds and are provided together with this Notice of Opposition. For the reasons set out in the enclosed Statement of Grounds, the application has been filed in bad faith because the Applicant would have known or should have known at the time of the filing that the Opponent was the proprietor of the GOURMET trade mark and the logo trade marks referred to in the enclosed Statement of Grounds. The Applicant had knowledge of the Opponent's trade marks as a result of their reputation and well-known status. The Applicant has adopted the essential features of a mark being used abroad, with the intention of pre-empting the proprietor who intends to trade in the United Kingdom. The application has therefore been filed in contravention of Section 3(6) of the Trade Marks Act 1994. This ground is further explained in the enclosed Statement of Grounds.



45. The pleading set out above is about pre-emption. GF states that the ground is further explained in the statement of grounds. The statement of grounds does not set out the position under separate grounds headings. It is a single narrative describing the opponent, its marks and its fame; that London has applied for very similar marks and must have known about GF's marks and intended therefore to signify that it was the original Lahore business. The statement of grounds includes the following:

“10. The Opponent intends to commence trading directly in the UK in the very near future.”

46. The statement of grounds covers sections 3(6), 5(4)(a)<sup>7</sup>, 5(4)(b) and section 56/5(3). It is not possible to say whether any part of the statement of grounds specifically supports the section 3(6) ground, except for paragraph 10, quoted above. I will assess this ground as it has been pleaded, i.e. pre-emption.

47. The relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date. The relevant dates for each of London's contested trade marks are:

2593103: 29 August 2011  
2646565: 29 August 2011  
2643615: 27 November 2012  
2654078: 23 February 2013  
3002769: 19 April 2013  
3002778: 19 April 2013  
3035297: 17 December 2013  
3059592: 12 June 2014  
3059567: 12 June 2014  
3059563: 12 June 2014

48. The evidence which relates to GF's claim that it intends to commence trading in the UK is as follows:

i) Mr Ayaz states that “the first step was in February 2014 when we arranged for a subsidiary to be incorporated in England and Wales (Gourmet Pakistan Limited). That company (“our UK subsidiary”) has recently acquired three retail locations in London but has not yet started to trade here.”

(ii) Mr Siddiqui states that part of the rationale for GF's advertising has been to reach people of Pakistani ethnicity living in the UK “as we have been preparing the ground for the impending launch of Gourmet Foods retail operations in the UK”.

(iii) London's evidence showing a screenshot from GF's website, printed on 11 April 2015:

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<sup>7</sup> Section 5(4)(a) is no longer pursued.



49. The first step taken was in February 2014, and was not a particularly public step: incorporation of a company. February 2014 was, at most, four months before London applied for trade marks 3059592, 3059567 and 3059563. There is no indication as to when exactly the retail locations were acquired (which are not trading). As of 11 April 2015, some 14 months after the 'first step' GF's website indicates that it had still not commenced UK trading. The first step was not sufficiently public or concrete that a third party should either have been aware of it or, if aware, have regarded that as an indication that UK trade was imminent by GF. Therefore, applications 3059592, 3059567 and 3059563 were not pre-emptive applications. *A fortiori*, London's registrations, which were all applied for before February 2014 (in two cases, well over two years before), were not pre-emptive applications either. The fact that GF's marks enjoy a significant reputation in Pakistan and that London, in selling goods aimed at the Pakistani community, would (for argument's sake) know that, does not mean that it had knowledge that GF intended to trade in the UK under a similar mark, or even that London should have anticipated that GF would expand to the UK, especially after GF had traded in Pakistan for nearly three decades before taking the 'first step' in the UK. Merely knowing that another party uses a mark abroad is not sufficient to justify a finding that a mark was registered in bad faith in the UK<sup>8</sup>. GF's own evidence specifically states that it is unaware of any of London's employees ever having had a business relationship with GF. This also weakens the pre-emption argument. Mr Heald submitted that London was only using its applications to oppose GF's application, which points to pre-emption. I disagree; proprietors have five years to use a mark and, in the meantime, an unused mark may be relied upon as an earlier mark.

<sup>8</sup> *Malaysia Dairy Industries Pte Ltd v Ankenævnet For Patenter og Varemærker* [2013] ETMR 36, Case C-320/12, CJEU. See also *DAAWAT Trade Mark* [2003] RPC 11: "107 The domestic perspective of the objection under s.3(6) was correctly recognised in para.17 of the principal hearing officer's decision: "In my view a vague suspicion that a foreign proprietor may wish to extend its trade to the UK is insufficient to found an objection under s.3(6)." (Mr Geoffrey Hobbs QC, sitting as the Appointed Person.)

Without a clear indication that GF would expand to the UK, or was already trading in the UK, this submission has little force. Pleaded as pre-emption, the section 3(6) ground fails.

## **50. The ground under section 3(6) of the Act fails.**

### **Section 56: well-known marks**

51. This ground is pleaded in the oppositions and in the cancellations. In relation to the latter, the relevant parts of Section 47(2) of the Act are as follows:

“(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.

(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.

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

52. The relevant part of section 6 of the Act states:

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

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.”

53. Section 56 of the Act provides:

“(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade

mark are to a mark which is well—known in the United Kingdom as being the mark of a person who—

(a) is a national of a Convention country, or

(b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in the United Kingdom. References to the proprietor of such a mark shall be construed accordingly.

(2) The proprietor of a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark which, or the essential part of which, is identical or similar in his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion. This right is subject to s.48 (effect of acquiescence by proprietor of earlier trade mark).

(3) Nothing in subsection (2) affects the continuation of any *bona fide* use of a trade mark begun before the commencement of this section.”

54. The dates of the applications to register the contested marks are the relevant dates for assessing GF’s claim to be the owner of earlier marks which are well known in the UK, as per section 56(1).

55. In *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2009] RPC 9, Arnold J stated:

“237 Counsel for the claimants and counsel for the defendants agreed that the approach to assessing whether a trade mark is well known was correctly stated in my decision sitting as the Appointed Person in *Le Mans Autoparts Ltd’s Trade Mark Application* (BL O/012/05):

“57. In reaching conclusion (b) Mr James referred to para.31 of the Opinion of Advocate General Jacobs in *Case C—375/97 General Motors Corp v Yplon SA* [1999] E.C.R. I—5421. Although it is primarily concerned with Arts.4(4)(a) and 5(2) of the Directive, I think it is worth quoting the relevant section of the Opinion in full:

“30. Both in the proceedings before the Court, and in general debate on the issue, attention has focused on the relationship between ‘marks with a reputation’ in Art.4(4)(a) and Art.5(2) of the Directive and well—known marks in the sense used in Art.6 *bis* of the Paris Convention for the Protection of Industrial Property. Well—known marks in that sense are referred to in Art.4(2)(d) of the Directive.

31. General Motors, the Belgian and Netherlands Governments and the Commission submit that the condition in the Directive that a mark should have a 'reputation' is a less stringent requirement than the requirement of being well known. That also appears to be the view taken in the 1995 WIPO Memorandum on well-known marks.

32. In order to understand the relationship between the two terms, it is useful to consider the terms and purpose of the protection afforded to well-known marks under the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). Art.6 *bis* of the Paris Convention provides that well-known marks are to be protected against the registration or use of a 'reproduction, an imitation, or a translation, liable to create confusion' in respect of identical or similar goods. That protection is extended by Art. 16(3) of TRIPs to goods or services which are not similar to those in respect of which the mark is registered, provided that use of the mark would 'indicate a connection between those goods or services and the owners of the registered trade mark and provided that the interests of the owner of the registered trade mark are likely to be damaged by such use'. The purpose of the protection afforded to well-known marks under those provisions appears to have been to provide special protection for well-known marks against exploitation in countries where they are not yet registered.

33. The protection of well-known marks under the Paris Convention and TRIPs is accordingly an exceptional type of protection afforded even to unregistered marks. It would not be surprising therefore if the requirement of being well-known imposed a relatively high standard for a mark to benefit from such exceptional protection. There is no such consideration in the case of marks with a reputation. Indeed as I shall suggest later, there is no need to impose such a high standard to satisfy the requirements of marks with a reputation in Art.5(2) of the Directive.

34. The view is supported by at least some language versions of the Directive. In the German text, for example, the marks referred to in Art.6 *bis* of the Paris are described as 'notorisch bekannt', whereas the marks referred to in Art.4(4)(a) and Art.5(2) are described simply as 'bekannt'. The two terms in Dutch are similarly 'algemeen bekend' and 'bekend' respectively.

35. The French, Spanish, and Italian texts, however, are slightly less clear since they employ respectively the terms 'notoirement connues', 'notoriamente conocidas', and 'notoriamente conosciuti' in relation to marks referred to in Art.6 *bis* of the Paris Convention, and the terms 'jouit d'une renommée', 'goce de renombre', and 'gode di notorietà' in Art.4(4)(a) and Art.5(2) of the Directive.

36. There is also ambiguity in the English version. The term 'well known' in Art.6 *bis* of the Paris Convention has a quantitative connotation (the Concise Oxford Dictionary defines 'well known' as 'known to many') whereas the term 'reputation' in Art.4(4)(a) and Art.5(2) might arguably involve qualitative criteria. The Concise Oxford Dictionary defines reputation as '(1) what is generally said or believed about a person's or thing's character or standing ...; (2) the state of being well thought of; distinction; respectability; ... (3) credit, fame, or notoriety'. Indeed it has been suggested that there is a discrepancy between the German text compared with the English and French texts on the grounds that the 'reputation' of a trade mark is not a quantitative concept but simply the independent attractiveness of a mark which gives it an advertising value.

37. Whether a mark with a reputation is a quantitative or qualitative concept, or both, it is possible to conclude in my view that, although the concept of a well-known mark is itself not clearly defines, a mark with a 'reputation' need not be as well known as a well-known mark."

58. The Advocate General refers in one of his footnotes to Mostert [*Famous and Well-Known Marks*]. Mostert at 8–17 suggests the following criteria derived from a number of sources for assessing whether a mark is well-known:

- (i) the degree of recognition of the mark;
- (ii) the extent to which the mark is used and the duration of the use;
- (iii) the extent and duration of advertising and publicity accorded to the mark;
- (iv) the extent to which the mark is recognised, used, advertised, registered and enforced geographically or, if applicable, other relevant factors that may determine the mark's geographical reach locally, regionally and worldwide;
- (v) the degree of inherent or acquired distinctiveness of the mark;
- (vi) the degree of exclusivity of the mark and the nature and extent of use of the same or a similar mark by third parties;
- (vii) the nature of the goods or services and the channels of trade for the goods or services which bear the mark;
- (viii) the degree to which the reputation of the mark symbolises quality goods;
- (ix) the extent of the commercial value attributed to the mark.

59. In September 1999 the Assembly of the Paris Union for the Protection of Intellectual Property and the General Assembly of the World Intellectual Property Organisation (WIPO) adopted a Joint Recommendation concerning Provision on the Protection of Well-Known Marks. Art.2 of the Joint Recommendation provides:

(a) In determining whether a mark is a well—known mark, the competent authority shall take into account any circumstances from which it may be inferred that the mark is well known.

(b) In particular, the competent authority shall consider information submitted to it with respect to factors from which it may be inferred that the mark is, or is not, well known, including, but not limited to, information concerning the following:

(1) the degree of knowledge or recognition of the mark in the relevant sector of the public;

(2) the duration, extent and geographical area of any use of the mark;

(3) the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;

(4) the duration and geographical area of any registration, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;

(5) the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities;

(6) the value associated with the mark.

(c) The above factors, which are guidelines to assist the competent authority to determine whether the mark is a well—known mark, are not pre—conditions for reaching the determination. Rather, the determination in each case will depend upon the particular circumstances of that case. In some cases all of the factors may be relevant. In other cases some of the factors may be relevant. In still other cases none of the factors may be relevant, and the decision may be based on additional factors that are not listed in subparagraph (b), above. Such additional factors may be relevant, alone, or in combination with one or more of the factor listed in subparagraph (b), above.

(a) Relevant sectors of the public shall include, but shall not necessarily be limited to:

(i) actual and/or potential consumers of the type of goods and/or services to which the mark applies;

(ii) persons involved in channels of distribution of the type of goods and/or services to which the mark applies;

(iii) business circles dealing with the type of goods and/or services to which the mark applies.

(b) Where a mark is determined to be well known in at least one relevant sector of the public in a Member State, the mark shall be considered by the Member State to be a well—known mark.

(c) Where a mark is determined to be known in at least one relevant sector of the public in a Member State, the mark may be considered by the Member State to be a well—known mark.

(d) A Member State may determine that a mark is a well—known mark, even if the mark is not well—known or, if the Member State applies subparagraph (c), known, in any relevant sector of the public of the Member State.

(a) A Member State shall not require, as a condition for determining whether a mark is a well—known mark:

(i) that the mark has been in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, the Member State;

(ii) that the mark is well known in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, any jurisdiction other than the Member State; or

(iii) that the mark is well known by the public at large in the Member State.

(b) Notwithstanding subparagraph (a)(ii), a Member State may, for the purpose of applying paragraph (2)(d), require that the mark be well known in one or more jurisdictions other than the Member State.

60. Two points of interest emerge from Art.2 of the Joint Recommendation. The first is that the list of six criteria contained in Art.2(1)(b) is not inflexible, but provides as it were a basic framework for assessment. The second is that *prima facie* the relevant sector of the public consists of consumers of and traders in the goods or services for which the mark is said to be well known.”

238 The relevant sector of the United Kingdom public in the present case comprises patrons of luxury international hotels and their restaurants. Considering the six criteria in the Joint Recommendation, the position is as follows:

(i) I consider that there was a high degree of recognition of the mark amongst



such persons: Hotel Cipriani was famous.

(ii) The mark had been used for approaching 50 years. The primary use was only in Venice, but many British consumers in the relevant sector had been exposed to it.

(iii) The mark had been widely promoted by HC and publicised by third parties.

(iv) The mark was registered as a Community trade mark.

(v) The mark had not been enforced.

(vi) The mark was a valuable one: Hotel Cipriani had a prestigious reputation.

239 Accordingly, I find that the mark CIPRIANI was a well-known trade mark for hotel and restaurant services among that sector of the public.”

56. The relevant sector of the UK public in these proceedings, for the purposes of section 56 of the Act, comprises both those who have a Pakistani ethnic background (which comes through the evidence) and the wider UK public.

57. GF’s evidence establishes that its stylised gourmet mark (i.e. the word gourmet in stylised script) is a household name in Pakistan in relation to soft drinks; behind only Pepsi and Coca Cola. The level of publicity in Pakistan also supports GF’s claim that this mark is a household name in Pakistan in relation to its bakery and confectionery goods and services, advertising having taken place in several Punjab/Lahore daily papers and Pakistan’s major TV channels. Mr Varvill’s evidence shows that GF is the largest baking and confections chain in Pakistan.

58. The first of the six criteria in the Joint Recommendation, listed in *Hotel Cipriani*, is the degree of knowledge or recognition of the marks in the relevant sector of the public. In *Le Mans*, it was observed that the fact that a mark is known internationally may assist its claim to being well known:

“70. As for the geographical area of use of the mark, while it is recognition of the mark in the country in question that is of primary importance, I consider it is relevant for a party claiming protection for a well-known mark to show that its mark is known internationally, because this increases the probability that its repute transcends national boundaries.”

59. There is no evidence which establishes that GF’s marks are known internationally. The question is if, and to what degree, GF’s stylised gourmet marks are known or recognised by the relevant public in the UK. Mr Heald submitted that the degree is high because many of the UK Pakistani community would know of the mark; either because they have lived in Pakistan; or because they have been exposed to Pakistani media, including Pakistani media exported to the UK.

GF’s evidence about UK recognition of its mark comprises:

- Yasmin Akhtar’s unsupported assertion that many of the UK Pakistani community would know of GF’s mark, having seen it in Pakistan where there is a large high street presence.

- Shaukat Ayaz’s opinion that residents and visitors of Pakistani descent will know of GF’s business in Pakistan, especially if they have visited Pakistan.
- Mr Siddiqui’s statement that major Pakistani newspapers are available on commercial flights between the UK and Pakistan.
- Mr Siddiqui’s Exhibit YS7, the unsigned ‘To whom it may concern’ letter dated 11 February 2015 from a media marketing company which says that GF has advertised with them and that ‘Jang’ has a UK edition: “tentatively the circulation is 13,500 copies.”
- Mr Siddiqui’s Exhibit YS3 about the Pakistani TV channel, Geo. This is also a ‘To whom it may concern letter’, signed and dated 10 February 2015, which says that Geo TV is free to air in the UK; has a UK subscription of 150,000; and that GF has advertised in the past on Geo TV.
- Mr Siddiqui’s statement that part of GF’s advertising rationale has been to reach people of Pakistani descent living in the UK “as we have been preparing the ground for the impending launch of Gourmet Foods retail operations in the UK”.
- Mr Siddiqui estimates that GF’s advertising will have been seen in the UK by 1.1 million people from the Pakistani community.

60. There is no evidence, only unsupported assertion or speculation, about the number of UK residents who visit Pakistan. There is no evidence about the number of Pakistan-born residents in the UK. In *Ajit Weekly Trade Mark* [2006] RPC 25<sup>9</sup>, the Hearing Officer (at first instance) observed that the proportion of the UK Pakistani community who would have emigrated from Pakistan to the UK was an ageing one. The relevant date in that case was 2001. In *Ajit Weekly*, 24 members of the UK Pakistani (Punjabi) community gave evidence of their knowledge of the Punjabi newspaper. There is no such evidence in this case. Further, the ‘To whom it may concern’ letters are hearsay and solicited for the proceedings. This affects their evidential weight<sup>10</sup>.

61. Hearsay evidence is admissible under rule 64(1)(b) of the Trade Mark Rules 2008, but its weight has to be assessed according to the various factors set out in section 4 of the Civil Evidence Act 1995:

**“4.— Considerations relevant to weighing of hearsay evidence.**

(1) In estimating the weight (if any) to be given to hearsay evidence in civil proceedings the court shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence.

(2) Regard may be had, in particular, to the following—

<sup>9</sup> Professor Ruth Annand, sitting as the Appointed Person.

<sup>10</sup> See Tribunal Practice Notice 5/2009.

- (a) whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;
- (b) whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;
- (c) whether the evidence involves multiple hearsay;
- (d) whether any person involved had any motive to conceal or misrepresent matters;
- (e) whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;
- (f) whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight."

62. The writers of the letters (one is not even identified) cannot be cross-examined as to the veracity, or otherwise, of the content of the letters. The filing of a hearsay statement inherently comes with the risk that the tribunal may assess its weight at a lower level than that which the party considers it should carry. Further, the unsigned letter only gives a tentative circulation figure, which is very likely after the various relevant dates. The letter giving the GeoTV UK subscriber figure of 150,000 is also written in the present tense, dated in February 2015, so does not give the position at the relevant dates. Mr Siddiqui estimates that 1.1 million UK residents of Pakistani descent will have seen GF's advertising. According to the UK 2011 census, the number of people of Pakistani descent living in England and Wales is 1,125,000. Mr Siddiqui's estimate is unsupported and appears speculative; he is effectively asserting that almost all of these people will have seen GF's advertising. This is unlikely and lacks credibility.

63. I am unable to conclude from the evidence what the degree of recognition of GF's mark was amongst the UK relevant public at the relevant dates.

64. In relation to the other factors, the mark has been used in Pakistan since 1987, widely promoted in Pakistan (or, at least the Punjab), and is registered as a trade mark in Pakistan (but nowhere else). There is no evidence about enforcement. Mr Heald submitted that the level of turnover in Pakistan means that the mark is valuable. In *Hotel Cipriani*, Arnold J found that the mark was valuable because Hotel Cipriani had a prestigious reputation. I am unconvinced that the value associated with a mark is only measured in pounds, shillings and pence. It seems that something more is required; in the sense of prestige or notoriety of some description.

65. These factors provide a useful framework, not a straightjacket. Nevertheless, taking all of the above into account, I find that GF's evidence falls some way short of meeting the burden necessary to establish that, at the relevant dates, its stylised gourmet mark was well-known in the UK under the terms of section 56 of the Act.

There is no evidence in relation to the other marks relevant to this ground. The section 56 ground is not made out.

**66. The ground under section 56 of the Act fails.**

**Section 5(4)(b): copyright**

67. This ground is pleaded in the oppositions and in the cancellations. In relation to the latter, section 47(2)(b) is relevant (see paragraph 51 above).

68. Section 5(4)(b) of the Trade Marks Act 1994 (“the Act”) states that:

(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) -

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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.”

69. GF has provided certificates of copyright registration in Pakistan under numbers 28410, 23003 and 28400. Registration 28410 is for the orange stylised word ‘gourmet’:



Copyright is owned by GF. The work was created by Muhammad Nawaz Chattha in 1987, and published in Pakistan in the same year.

70. Registration 23003 is for the stylised lower case ‘g’:



Copyright is owned by GF. The work was created by Muhammad Nawaz Chattha in 1987, and published in Pakistan in the same year. Registration 28400 is for the Arabic script which appears below the word gourmet in GF’s trade mark application.

This does not seem to be relevant to the copyright claim against London because it does not appear in any of London's marks, the subject of these proceedings.

71. The Pakistan trade marks are territorially limited to Pakistan. As they provide no rights in the UK, they are not therefore earlier rights for the purposes of section 5(4)(b) of the Act.

72. Original artistic works created in Pakistan are protected under UK copyright law (see the list of countries in which such protection is granted in the Copyright and Performances (Application to Other Countries) Order 2008, S.I. 2008/677). The 'g' is a graphic work and 'gourmet' includes the 'g', so is also a graphic work. They are thus capable of qualifying for protection as artistic works by virtue of sections 1(1) and (4)(1) of the Copyright, Designs and Patents Act 1988:

"(1) Copyright is a property right which subsists in accordance with this Part in the following descriptions of work –  
(a) original literary, dramatic, musical or artistic works,  
(b) sound recordings, films [or broadcasts], and  
(c) the typographical arrangement of published editions."

and

"4. Artistic works.

(1) In this Part "artistic work" means-  
(a) A graphic work, photograph, sculpture or collage, irrespective of artistic quality,  
(b) ...  
(c) A work of artistic craftsmanship."

73. The artistic work must also be original<sup>11</sup>, meaning that it must be the author's own intellectual creation. The CJEU stated in *Painer v Standard Verlags GmbH* Case C-145/10 [2012] ECDR 6:

"that is the case if the author was able to express his creative abilities in the production of the work by making free and creative choices".

74. A helpful summary of the main principles of copyright law and artistic works was given by District Judge Clark in *Suzy Taylor v Alison Maguire* [2013] EWHC 3804 (IPEC):

6. I will set out the law in greater detail than usual to assist the unrepresented Defendant, who did not attend the hearing, in understanding it. Section 1 of the CDPA provides for copyright to subsist in original artistic works. An "original artistic work" is a work in which the author/artist has made an original contribution in creating it – for example by applying intellectual effort in its creation.

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<sup>11</sup> *SAS Institute Inc. v World Programming Limited* [2013] EWCA Civ 1482.

7. Artistic works are listed in s.4(1) CDPA and include "a graphic work... irrespective of its artistic quality". Graphic work is defined in 4(2) as including "(a) any painting, drawing, diagram map, chart or plan and (b) any engraving, etching, lithograph, woodcut or similar work...".

8. For an artistic work to be original it must have been produced as the result of independent skill and labour by the artist. The greater the level of originality in the work the higher the effective level of protection is, because it is the originality which is the subject of copyright protection. If the work includes elements which are not original to the artist then copying only those elements will not breach that artist's copyright in the work. It is only where there is copying of the originality of the artist that there can be infringement.

9. Section 16 of the CDPA provides that the owner of the copyright in a work has exclusive rights to do various things in relation to the work as a whole or in relation to "any substantial part" of it. Again, when considering whether acts complained of relate to "any substantial part" of a work, it is that part of the work which is original which is relevant to substantiality. What is substantial is a question of fact and degree in the context of the originality of the author.

10. If something is an exact copy of the whole or a substantial part of an artistic work protected by copyright, it will be an infringement if there is no defence provided by one of the exceptions contained in the CDPA. If something is an inexact copy, for example if it merely resembles an artistic work protected by copyright, it may or may not be infringing. The issue is whether it is a mere idea which has been copied or whether it is the work itself – ie the expression of the author's idea – which has been copied. There is no copyright in an idea per se because a mere idea is not a "work" in which copyright can subsist.

...

13. [Lord Millett<sup>12</sup>] went on to set out the correct approach for a court concerned with determining an action for infringement of artistic copyright, which is the approach I shall follow:

*"The first step in an action for infringement of artistic copyright is to identify those features of the defendant's design which the plaintiff alleges to have been copied from the copyright work. The court undertakes a visual comparison of the two designs, noting the similarities and the differences. The purpose of the examination is not to see whether the overall appearance of the two designs is similar, but to judge whether the particular similarities relied on are sufficiently close, numerous or extensive to be more likely to be the result of copying than of coincidence. It is at this stage that similarities may be disregarded because they are too commonplace, unoriginal or consist of general ideas. If the plaintiff demonstrates sufficient similarity, not in*

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<sup>12</sup> *Designers Guild Ltd v Russell Williams (Textile) Ltd* [2001] FSR 11 HL.

*the works as a whole but in the features which he alleges have been copied, and establishes that the defendant had prior access to the copyright work, the burden passes to the defendant to satisfy the judge that, despite the similarities, they did not result from copying...*

*Once the judge has found that the defendant's design incorporates features taken from the copyright work, the question is whether what has been taken constitutes all or a substantial part of the copyright work. This is a matter of impression, for whether the part taken is substantial must be determined by its quality rather than its quantity. It [does not] depend[s] upon its importance to the defendant's work... The pirated part is considered on its own... and its importance to the copyright work assessed. There is no need to look at the infringing work for this purpose."*

75. The works relied upon, shown above, are the result of Mr Chattha's creativity and, unless copied from some other works, appear to qualify as original works. This is notwithstanding Mr Chapple's submissions about the 'g' being a standard font. A poorly photocopied page showing the letter 'g' in various fonts was attached to London's counterstatements, but was never formally filed as evidence. Further, it is virtually impossible to compare the font letters with GF's 'g' because they are so poorly reproduced.

76. Copyright in the two works therefore dates from 1987, when they were created by Mr Chattha, and they are owned by GF. Nizakat Ali's evidence about the dates that London's marks were designed shows that GF's copyrights predate the creation of London's marks, which Mr Ali states were designed in 2007 onwards. This makes GF's works earlier rights for the purposes of Section 5(4)(b) of the Act.

77. A single word may qualify as an "artistic work" if it is visually embellished in some way such as in its form of stylisation or additional matter. In this case, it is the 'g' and the 'g' within the word 'gourmet' of GF's works that allow them to be considered artistic works and therefore protectable under copyright law. However, this feature is not present in six of London's marks. There is nothing in the following of London's marks which conflicts with GF's rights:

3059592



3059567



3059563



3002769



2593103



2646565



78. I therefore find that London's marks shown in the previous paragraph do not infringe GF's copyrights. GF's opposition fails, insofar as it is based upon Section 5(4)(b) of the Act, in relation to these marks.



79. Since GF's grounds under sections 3(6) and 56(1) of the act have also failed, the outcome of the proceedings for the marks shown in paragraph 77 is as follows:

- (i) applications 3059592, 3059567 and 3059563 may proceed to registration;
- (ii) registrations 2593103, 2646565 and 2643615 may remain registered.

80. This leaves four other of London's marks to consider under section 5(4)(b) of the Act:

3002778



2654078



3002769



3035297



81. The copyright works are:



82. It is plain to see that the first three of London's marks all contain the 'gourmet' copyright work and that they all contain the 'g' copyright work. The fourth of London's marks contains the 'g' copyright work. There are similarities in terms of the colours used; particularly in the fourth mark, which has a white 'g', as does the 'g' copyright work. London's marks also contain non-distinctive or descriptive wording. I remind myself that the "purpose of the examination is not to see whether the overall appearance of the two designs is similar, but to judge whether the particular similarities relied upon are sufficiently close, numerous or extensive to be the result of copying than of coincidence". The copyright works are replicated in London's marks and thus a substantial part (i.e. all) of them has been taken. The overwhelming inference is that the inclusion in the marks of GF's works is more likely to be the result of copying than of coincidence.

83. Did London have prior access to the copyright works? Although I have found that GF's marks (which include the copyright works) do not qualify as well-known marks, this is a different question. The evidence shows that the copyright works enjoy a high level of exposure in Pakistan, and have done so for a number of years. All four of London's marks include 'Lahore', which is the capital of the Punjab and GF's stronghold. London's shop is located in Ilford, amongst a Pakistani community. Mr Ayaz states that London's food shops in London are specialist retailers of cakes and other foodstuffs for the Pakistani community; London has not denied this. These factors point strongly towards London having had access to GF's copyright works. The reference in the marks to the 'Original Gourmet of Lahore' reinforces my view that London was aware of GF's earlier rights and copied them; why else make reference to this being the 'original' Gourmet of Lahore? London has offered no evidence to prove that, despite the similarities, they did not result from copying. Its evidence states that the marks were created in 2007 onwards, which is twenty years or more after the creation of GF's copyright works.

84. The copied features have been incorporated into larger works/marks. London's marks infringe GF's copyright. At the date on which London's marks were filed as applications for trade mark registration, GF could have prevented use of them. **GF's section 47(2)/5(4)(b) ground succeeds against London's marks shown in paragraph 80. Accordingly, under section 47(6) of the Act, registrations 3002778, 2654078, 3002769 and 3035297 are deemed never to have been made.**

### **London's opposition to GF's application**

85. London's opposition under sections 5(2)(b) and 5(3) of the Act is based upon London's registrations 2654078, 3002769 and 3002778. I have found that they are invalid which means that they are not earlier rights upon which objections under sections 5(2)(b) and 5(3) may be founded. **The consequence is that London's opposition under sections 5(2)(b) and 5(3) of the Act fails.**

### **Section 3(1)(c)**

86. Section 3(1)(c) of the Act provides:

**"3.— (1) The following shall not be registered –**

- (a) ...
- (b) ...
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) ...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

87. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ( OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699, paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more

characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

88. GF's mark is



London claims that the script below the word gourmet is a representation of 'gourmet' in Arabic and/or Urdu. Within the banner are the Arabic/Urdu words which translate into 'Shines in every household/home'. London claims that the mark as a whole would be understood in the UK because of the number of Arabic and Urdu speakers in the UK, the high volume of Arabic and Urdu speakers who purchase these goods, the target obviously being those who speak these languages because of their presence in the mark.

89. London also submits that non-Arabic/Urdu speakers who will not understand the script beneath the word gourmet will either view the script as non-distinctive matter, or a translation of the non-distinctive matter above it (presumably, 'gourmet'). These arguments do not fit a ground raised under section 3(1)(c) because they do not claim that the average consumer will perceive the mark as exclusively designating one or more characteristics of the goods or services; rather, that part of the mark will not be understood and will be non-distinctive. London's submissions are appropriate to a section 3(1)(b) ground, but this ground has not been raised<sup>13</sup>.

90. In *Loutfi Management Propriété intellectuelle SARL v AMJ Meetproducts NV and Halalsupply NV*, Case C-147/14, the CJEU held as follows:

"Therefore, the answer to the question referred for preliminary ruling is that Article 9(1)(b) of Regulation No 207/2009 must be interpreted as meaning that, in order to assess the likelihood of confusion that may exist between a Community trade mark and a sign which cover the same or similar goods and which both contain a dominant Arabic word in Latin and Arabic script, those words being visually similar, in circumstances where the relevant public for the Community mark and for the sign at issue has a basic knowledge of written Arabic, the meaning and pronunciation of those words must be taken into account."

91. This was a relative grounds case, but account was taken of the relevant public as being consumers of Arabic origin who consume halal foods and who have at least a basic knowledge of written Arabic. Applying this to the present case, such consumers will be likely to understand that the Arabic/Urdu script means 'gourmet' and 'shines in every household'. Being UK residents, they are also likely to understand the meaning of gourmet in relation to food, drink and services for the provision thereof. Even if the word gourmet and its Arabic/Urdu equivalent are understood as denoting a laudatory characteristic of the goods and services, there remains the question as to the perception of the average consumer, assuming this consists of those described above who understand the meanings of the words in the banner: 'shines in every household'. This is not a phrase which describes or denotes any characteristic of the goods or services. Whilst not highly or even averagely distinctive, to say that goods or services shine in a household does not designate the quality or any characteristic of goods or services, unless they do actually shine (not a characteristic of the goods and services at issue). Further, if the average consumer is construed more widely, so as to comprise the general non-Arabic/Urdu-speaking UK public<sup>14</sup>, the mark does not consist exclusively of signs or indications which may serve, in trade, to designate characteristics of GF's goods or services. The section 3(1)(c) ground is not made out.

**92. The section 3(1)(c) ground fails.**

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<sup>13</sup> See section D, page 13 of London's form TM7.

<sup>14</sup> See Case T-503/15 *Aranynektar v EUIPO*, General Court.

## Section 5(4)(a): passing off

93. Section 5(4)(a) states:

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

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

(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.”

94. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

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

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

95. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation 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 feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court 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 plaintiff and the defendant carry on business;

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

(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 confusion or 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.”

96. In *Roger Maier and anor v. ASOS plc and anor* [2015] EWCA Civ 220, Kitchin LJ said, at paragraph 165:

“Under the English law of passing off, the relevant date for determining whether a claimant has established the necessary reputation or goodwill is the date of the commencement of the conduct complained of (see, for example, *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429). The jurisprudence of the General Court and that of OHIM is not entirely clear as to how this should be taken into consideration under Article 8(4) (compare, for example, T-114/07 and T-115/07 *Last Minute Network Ltd* and Case R 784/2010-2 *Sun Capital Partners Inc.*). In my judgment the matter should be



addressed in the following way. The party opposing the application or the registration must show that, as at the date of application (or the priority date, if earlier), a normal and fair use of the Community trade mark would have amounted to passing off. But if the Community trade mark has in fact been used from an earlier date then that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began.”

97. The position is no different in relation to a national trade mark application. As there has been no UK use by GF, the relevant date is the date of its trade mark application: 19 March 2014.

98. 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 than 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.”

99. 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.”

100. London's evidence in chief in these proceedings has been filed by its trade mark attorney, Ms Nwaegbe. There was no direct evidence in chief given by any employees of London itself. When it came to filing evidence in reply, Ms Nwaegbe filed a second witness statement, adducing as an exhibit a witness statement from London's director, Nizakat Ali, which had been filed in previous proceedings before the European Intellectual Property Office, involving an unconnected third party. This should have been filed as evidence in chief if it is meant to be relied upon to prove use of London's mark(s), so that GF had a proper opportunity to reply to it. As it is, the evidence seems to have slipped in by the back door.

101. What does Mr Ali's evidence show? He states that £2000 has been spent on promotion of the goods relied upon between 2010 to 2013, and that the annual 'value' of the goods for the years 2010 to 2013 was £63,129, £373,254, and £603,148. There are no invoices or other documents supporting a claim to have traded under the signs relied upon before the relevant date, or showing how the signs have been used. The flyers and banners are undated. Although I do not disbelieve the figures given, it is still necessary to examine what has been said for sufficiency. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander QC, sitting as the Appointed Person said, having referred to *Reef* and *Minimax* (as above):

"17. Key does not dispute the correctness of these principles or criticise the Hearing Officer for applying them. Instead, relying on the decision of Richard Arnold QC, Appointed Person, in *Pan World Brands v. Tripp (Pan World)* [2008] RPC 2, Key submits that if evidence is given about goodwill which is not obviously incredible and is unchallenged by countervailing evidence or by cross-examination, it is not open to the Hearing Officer to reject it. Key refers to Tribunal Practice Note TPN 5/2007 which is to similar effect. Key submits that this is the position here and that the Hearing Officer was therefore wrong to have concluded that Key's goodwill was insufficient to found a s.5(4)(a) attack. It is therefore necessary first to consider what *Pan World* was and was not saying.

18. In *Pan World*, the Appointed Person said that, although documentary records of use were not required, mere assertion of use of a mark by a witness did not constitute evidence sufficient to defeat an application for revocation for non-use (see [31]). He did not regard a tribunal evaluating the evidence as bound to accept everything said by a witness without analysing what it amounts to. He pointed out at [37] that Hearing Officers were entitled to assess evidence critically and referred to the observations of Wilberforce J in *NODOZ Trade Mark* [1962] RPC 1 at 7:

"...in a case where one single act is relied on it does seem to me that that single act ought to be established by, if not conclusive proof, at any rate overwhelmingly convincing proof. It seems to me that the fewer the acts relied on the more solidly ought they to be established."

19. *Pan World* and *NODOZ* were applications for revocation for non-use. The approach to use is not the same as in a s.5(4)(a) case. As Floyd J said in *Minimax*, it is possible for a party to have made no real use of a mark for a

period of five years but to retain goodwill sufficient to support a passing off action. Conversely, use sufficient to prevent revocation for non-use may be insufficient to found a case of passing off.

20. However, the approach to evaluation of evidence of use is similar: the less extensive the evidence of use relied on, the more solid it must be. The Registrar is not obliged to accept – and in some circumstances may be obliged to reject – a conclusory assertion by a witness that it has a given goodwill at the relevant date or that the use by a third party of a similar mark would amount to misrepresentation, when the material relied upon in support does not bear that out.

21. That point was also made by Laddie J in *DIXY FRIED CHICKEN TM* [2003] EWHC 2902 (Ch) and, more recently, in *Williams and Williams v. Canaries Seaschool SLU (CLUB SAIL)* [2010] RPC 32, Geoffrey Hobbs QC, Appointed Person, said at [38]:

“...it is not obligatory to regard the written evidence of any particular witness as sufficient, in the absence of cross-examination, to establish the fact or matter (s)he was seeking to establish.”

22. Overall, the adequacy of evidence falls to be assessed by reference to the Lord Mansfield’s aphorism from *Blatch v. Archer* (1774) 1 Cowp 63 at 65, cited, inter alia by Lord Bingham in *Fairchild v. Glenhaven Financial Services Ltd* [2002] UKHL 22 [2203] 1 AC 32 and in *CLUB SAIL*:

“...all evidence is to be weighed according to the proof which it was in the power of one side to have produced, and in the power of the other to have contradicted.”

102. Mr Alexander also said something similar in *Awareness Limited v Plymouth City Council*, Case BL O/230/13: 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”, because the nature and extent of use is likely to be well known to the proprietor.

103. Although GF’s evidence includes photographs of London’s shop and packaging, London cannot avail itself of GF’s own evidence because the photographs were taken after the relevant date. I find that London has not met the burden of proving goodwill sufficient to found a passing off claim at the relevant date. The section 5(4)(a) ground is not made out.

**104. The section 5(4)(a) ground fails. All grounds of opposition against GF’s application have failed.**

## **Overall outcomes**

105. The overall outcomes of these consolidated proceedings are:

(i) London's registrations 3002778, 2654078, 3002769 and 3035297 are invalid and are cancelled from the date on which they were applied for;

(ii) London's applications 3059592, 3059567 and 3059563 may proceed to registration;

(ii) London's registrations 2593103, 2646565 and 2643615 may remain registered.

(iv) GF's application 3047645 may proceed to registration.

## **Costs**

106. Each side has achieved a roughly equal measure of success. I direct that each side should bear its own costs.

**Dated this 22nd day of June 2016**

**Judi Pike  
For the Registrar,  
the Comptroller-General**