

# O-226-17

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATIONS Nos. 3059592, 3059567 & 3059563  
IN THE NAME OF GOURMET BAKERS & SWEETS LONDON LIMITED**

**AND IN THE MATTER OF OPPOSITIONS Nos. 402830, 402832 & 402833  
BY GOURMET FOODS**

**IN THE MATTER OF REGISTRATIONS Nos. 3002778, 2593103, 2646565, 2654078,  
3002769, 2643615 & 3035297  
IN THE NAME OF GOURMET BAKERS & SWEETS LONDON LIMITED**

**AND IN THE MATTER OF INVALIDATIONS Nos. 500611, 500612, 500613, 500614,  
500615, 500616 & 500781  
BY GOURMET FOODS**

**IN THE MATTER OF APPLICATION No. 3047645  
BY GOURMET PAKISTAN LIMITED**

**AND IN THE MATTER OF OPPOSITION No. 403760  
BY GOURMET BAKERS & SWEETS LONDON LIMITED**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON  
BY GOURMET FOODS  
AGAINST THE DECISION OF MRS J PIKE  
DATED 22 JUNE 2016**

---

## DECISION

---

1. These consolidated proceedings concern eleven actions.

**Applications nos. 3059592, 3059567 and 3059563**




2. On 12 June 2014, Gourmet Bakers & Sweets London Limited (“London”) applied under the above numbers to register the following designations for use as trade marks in the UK essentially in respect of food and drink related goods and services in Classes 29, 30, 32, 33 and 43:



3. Following publication on 11 July 2014, Gourmet Foods (an association of persons registered in Pakistan) (“GF”) on 11 September 2014 filed Notices of opposition and statements of grounds against the applications under Sections 5(4)(a) (use in the UK liable to be prevented by the law of passing off), 3(6) (applications made in bad faith), 5(4)(b) (use in the UK liable to be prevented by the law of copyright), and 5(3) and 56(1) (earlier well known trade mark). The oppositions were accorded numbers 402830, 402832 & 402833 respectively.
4. The grounds of opposition under Section 5(4)(a) were abandoned.
5. The Hearing Officer’s findings on the other grounds were:
  - (1) The case of pre-emption under Section 3(6) was not made out. There was no sufficiently public or concrete evidence that UK trade was imminent by GF at the applications date.
  - (2) Whilst it was accepted that UK copyright subsisted in GF’s stylised “g” and “gourmet” works created in Pakistan in 1987, none of the applications took these works (or substantial parts), and so the grounds of opposition under Section 5(4)(b) failed.
  - (3) The evidence fell some way short of establishing that GF’s stylised gourmet mark was well-known in the UK within the meaning of Section 56(1). There was no evidence relating to the other GF marks relevant to this ground.
  - (4) The oppositions failed.

**Registrations nos. 3002778, 2593103, 2646565, 2654078, 3002769, 2643615 and 3035297**

6. On 11 September 2014, GF also filed applications for invalidation under numbers 500611 – 500616 and 500781 respectively of the following UK registrations standing in the name of London, registered again essentially for food and drinks related goods and services:

Number	Mark	Filing date	Classes
3002778		19 April 2013	29, 43
2593103		29 August 2011	29, 30, 43
2646565		29 August 2011	29, 30, 43

2654078		23 February 2013	29, 30, 31, 32, 33, 43
3002769		19 April 2013	29, 30, 32, 43
2643615		27 November 2012	29, 30, 32, 33, 43
3035297		17 December 2013	29, 30, 32, 33, 35, 43

7. The grounds of invalidation under Section 47(1) and (2) of the Act were the same those in the oppositions, namely Sections 3(6), 5(4)(a) (abandoned), 5(4)(b), and 5(3) and 56(1).
8. On Section 3(6), the Hearing Officer noted that there was even less in GF's pre-emption case because the registrations in suit were applied for well before GF said it had taken its "first step" in expanding its trade into the UK through the incorporation of a UK subsidiary company in February 2014.
9. Generally speaking, GF's evidence relevant to Section 56(1) was unsupported and speculative. The Hearing Officer was unable to conclude what the degree of recognition of GF's stylised gourmet mark was amongst the UK relevant public at the relevant dates.
10. London's Registrations numbers 3002778, 2654078, 3002769 and 3035297 infringed GF's UK copyright in GF's stylised "g" and "gourmet" marks created in Pakistan. Those registrations contravened Sections 47(2) and 5(4)(b) and were deemed never to have been made.
11. London's Registrations numbers 2593103, 2646565 and 2643615 did not incorporate GF's copyright works or any part of them, and were not infringing.
12. The invalidations succeeded on the Sections 47(2)/5(4)(b) grounds against Registrations numbers 3002778, 2654078, 3002769 and 3035297, but failed on these and the other invalidity grounds against Registrations numbers 2593103, 2646565 and 2643615.

### **Application no. 3047645**

13. On 19 March 2014, GF<sup>1</sup> applied for registration of the following designation for use as a trade mark in the UK in relation to goods and services (including food and drinks related goods and services) in Classes 5, 29, 30, 32, 39 and 43:



14. Following publication on 7 November 2014, London opposed the application, opposition number 403760, under Sections 3(1)(c), 5(2)(b), 5(3) and 5(4)(a) of the Act.
15. The opposition under Section 5(2)(b) and 5(3) was based on London's Registrations numbers 2654078, 3002769 and 3002778. Since the Hearing Officer had declared the registrations invalid, the opposition on those grounds failed.
16. GF's mark did not consist exclusively of signs or indications which served in trade to designate characteristics of the goods/services applied for. Even if the word "gourmet" and its Arabic/Urdu equivalent below would be understood by the relevant UK consumer (to include Arabic/Urdu speakers) as laudatory, the Arabic/Urdu banner phrase "shines in every household" did not describe any characteristic of the goods/services. To non-Arabic/Urdu speakers the mark was not exclusively descriptive. The Section 3(1)(c) ground failed.
17. Since there had been no use of the mark by GF in the UK, the relevant date for assessing the Section 5(4)(a) ground was 19 March 2014. London had filed insufficient evidence to show that it had the necessary UK goodwill at that date. London could not rely on photographs of London's shop and packaging in GF's evidence for this purpose. The Section 5(4)(a) ground failed.
18. The opposition was unsuccessful.

### **The appeal**

19. On 20 July 2016, GF filed Notice of Appeal to the Appointed Person under Section 76 of the Act against the Hearing Officer's decision, BL O/298/16, dated 22 June 2016.
20. GF's appeal was limited to findings of the Hearing Officer in the London oppositions/invalidations concerning Section 3(6), and Sections 5(3) and 5(4)(a).

---

<sup>1</sup> The application was made in the name of GF's subsidiary, Gourmet Pakistan Limited.

21. GF accepted that the Hearing Officer had rightly dismissed GF's pre-emption allegations of bad faith pursuant to Section 3(6).
22. However, GF argued that the Hearing Officer wrongly interpreted GF's pleaded bad faith cases as resting solely on pre-emption.
23. Instead, GF contended that the Hearing Officer should have considered GF's allegations in the Statements of grounds that London intended through use of the words "ORIGINAL GOURMET"/"ORIGINAL GOURMET OF LAHORE" to signify that London's business was GF's business, which amounted to bad faith in the applications.
24. As to well-known status pursuant to Section 56(1) of the Act, GF alleged that the Hearing Officer wrongly required evidence showing prestige or notoriety in the mark. Further, she wrongly dismissed Yasmin Akhtar's evidence as to Ms. Akhtar's personal knowledge of GF. On a correct assessment of the evidence, the Hearing Officer should have concluded that GF's stylised gourmet mark was well-known in the UK.
25. There was no cross appeal in the London oppositions/invalidations, but London submitted a Respondent's notice on 21 September 2016. Subject to a preliminary point dealt with below, the Respondent's notice was confined to setting out arguments in favour of the Hearing Officer's reasoning.
26. There was no appeal in the opposition against GF's application.

### **Representation**

27. At the hearing of GF's appeal, GF was represented by Mr. Jeremy Heald of Counsel instructed by HGF Limited. Mr. Malcolm Chapple of Counsel instructed by London IP appeared on behalf of London. This was the same representation as before the Hearing Officer.

### **Standard of review**

28. Both parties agreed that this appeal was by way of review and not rehearing, and that I should be reluctant to interfere with the decision of the Hearing Officer in the absence of a distinct and material error on her part (*REEF Trade Mark* [2002] EWCA Civ 763, paras. 17 – 29).
29. Mr. Heald referred me to the observations of Mr. Geoffrey Hobbs QC sitting as the Appointed Person in *ALTI Trade Mark*, BL O/168/16 (paras. 19 – 20). Mr. Chapple cited *REEF* above, and the clarification of a "sufficient error of principle" given by Lindsay J. in *esure Insurance Limited v. Direct Line Insurance plc* [2007] EWHC 1557 (Ch) (para. 12).
30. The case law on the appellate function was reviewed, and the emerging principles summarised, by Mr. Daniel Alexander QC sitting as the Appointed Person in *TALK FOR WRITING Trade Mark*, BL O/017/17 (paras. 16 – 52). I have borne these principles in mind.

### **Preliminary points**

31. Two preliminary points need mention.
32. First, London criticised the Notice of appeal as failing to comply with Rule 71(1) of the Trade Marks Rules 2008 in that it failed properly and fully to explain the “case in support of the appeal”.
33. I agree that the Statement of grounds of appeal was short.
34. However, in my view the grounds under Sections 3(6) and 56(1) and respective cases in support were identified by GF with sufficient clarity, albeit economically (*COFFEEMIX Trade Mark* [1998] RPC 717 at 722).
35. Second, although these 11 actions were consolidated this was for procedural efficiency. It did not mean that the issues were amalgamated or unified in the sense that they did not, where necessary, need to be determined for each mark separately (see the comments of Mr. Geoffrey Hobbs QC sitting as the Appointed Person in *RENTRO Trade Mark*, BL O/143/17, pp. 6 – 7). Thus, *inter alia*, the relevant date for assessing the alleged grounds of opposition or invalidation in each action was the filing date of the particular application or registration in suit. On the other hand the appeal focussed on the marks in suit without differentiation, a point to which I return below.

### **Section 56(1) – well-known trade mark**

36. I deal with this ground first because: (a) it was abandoned by GF during the appeal hearing; and (b) it provides background to the Section 3(6) appeal.
37. The Hearing Officer accepted that GF’s stylised gourmet mark shown below was a household name in Pakistan in relation to soft drinks, and bakery and confectionery goods and services (para. 57):



- However, she concluded that there was no evidence that GF’s stylised gourmet mark was known internationally (para. 59).
38. GF contended that the degree of recognition in the UK would be high because many of the UK Pakistani community would have either lived in Pakistan, or been exposed to the mark in Pakistani media (including Pakistani media exported to the UK).
  39. The Hearing Officer reviewed GF’s evidence of UK recognition and concluded (footnotes omitted):

“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 259, 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.

[...]

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 [*Jang* newspaper], 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.”

40. With one exception, GF did not challenge the Hearing Officer’s above findings. That one exception was that the Hearing Officer’s statement that there was no evidence about the number of UK residents who visit Pakistan, failed to take into account the evidence of Ms. Akthar (a British national and resident, and independent restaurant business consultant) that many or most of the British Pakistani community would know of GF having seen them in Pakistan, where GF has a large high street presence (Witness Statement of Yasmin Akthar, dated 11 February 2015). The Hearing Officer rightly observed that this was the personal opinion of Ms. Akthar otherwise unsupported in the evidence.
41. The other criticism on appeal of the Hearing Officer’s findings in relation to Section 56(1) was that she wrongly imposed a requirement of prestige or notoriety for well-known status so ignoring GF’s sales figures in Pakistan in calculating the value of GF’s stylised gourmet mark. It seemed to me that this criticism was unjustified since following the lead of Arnold J. in *Hotel Cipriani Srl v. Cipriani Limited* [2008] EWHC 3032 (Ch), the Hearing Officer had commented (paras. 64 – 65):

“I am unconvinced that the value associated with a mark is only measured in pounds, shillings and pence. It seems to me that something more is required; in the sense of prestige or notoriety of some description.”

And

“These factors [for assessing well-known status] provide a useful framework, not a straightjacket.”

42. As I have said, GF abandoned its appeal against the Hearing Officer’s findings in relation to Section 56(1) during the hearing, in my view advisedly.

**Section 3(6)**

43. The sole remaining ground of appeal was, therefore, that the Hearing Officer wrongly considered only GF’s pre-emption cases under Section 3(6) whereas she should additionally have deliberated on GF’s allegations that London’s marks were applied for with the intent to mislead.

44. The Notices of opposition and Applications for invalidation in each case set out the following (near) identical statements in the appropriate boxes for Section 3(6) (emphasis supplied):

“As set out in the enclosed Statement of Grounds, in particular at Paragraph 4, the Applicant 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/Application to declare invalid a registration]. For the reasons set out in the enclosed Statement of Grounds, the application has been filed in bad faith because the [Applicant/Registered Proprietor] would have known or should have known at the time of the filing that the [Opponent/Applicant] was the proprietor of the GOURMET trade mark and the logo trade marks referred to in the enclosed Statement of Grounds. The [Applicant/registered proprietor] had knowledge of the [Opponent’s/Applicant’s] trade marks as a result of their reputation and well-known status. The [Applicant/Registered Proprietor] 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 Statement of Grounds.”

45. GF relied on the following paragraph appearing as either paragraph 13 or 14 in the respective accompanying Statements of grounds:

“The [trade mark applied for/Registered Proprietor’s registration] also includes the words “ORIGINAL GOURMET” which must be intended to signify that the [Applicant’s/Registered Proprietor’s] business (which is a new one) is the original business managed in Lahore, where the [Opponent/Applicant] originally started trading before its operation spread across Pakistan”.

46. The Hearing Officer cited the following observation by Mr. Iain Purvis QC sitting as the Appointed Person in *SAKURA/SAKURA/TEA Trade Mark*, BL O/131/16 (para. 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.”

47. The parties were, as I understood it, in agreement that the purpose of the pleadings was to identify the issues between the parties to be construed in each action from the relevant Notice of opposition and statement of grounds/Application to declare invalid a registration, as a whole<sup>2</sup>.

48. The Hearing Officer determined the extent of the pleaded Section 3(6) cases as follows:

“45. The pleading set out [in the boxes for Section 3(6) on the Notices of opposition/Applications for invalidation of a registration] 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) [abandoned], 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.”

49. I have some sympathy with that approach. On my reading of the documents, the first and second references in the Section 3(6) boxes to the Statements of grounds was to the descriptions of GF’s marks; the third and fourth references went to London’s presumed knowledge of GF’s marks; and the fifth reference related back to the bad faith claim of pre-emption.

50. Nevertheless, I have asked myself the question where would it take GF were the Hearing Officer to have undertaken the wider enquiry into the evidence for improper motive within the ambit of Section 3(6), indicated by Mr. Geoffrey Hobbs QC sitting as the Appointed Person in *IAN ADAM Trade Mark*, BL O/094/11 (paras. 33-34).

51. In his skeleton, Mr. Heald based his argument for this purpose on Article 4(4)(g) of Directive 2008/95/EC<sup>3</sup>, which provides that:

“4. Any Member State may, in addition, provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that:

---

<sup>2</sup> GF made clear in response to a suggestion in the Respondent’s notice that GF did not seek to rely on its skeleton at first instance.

<sup>3</sup> Article 5(4)(c) Directive (EU) 2015/2436.

[...]

(g) the trade mark is liable to be confused with a mark which was in use abroad on the filing date of the application and which is still in use there, provided that at the date of the application the applicant was acting in bad faith.”

52. However, the UK did not implement optional Article 4(4)(g) into UK trade marks law.

53. Moreover, although not yet subject to interpretation by the Court of Justice of the European Union<sup>4</sup>, the wording of Article 4(4)(g) suggests that the optional absolute ground for refusal/invalidity of registration of bad faith in the application in Article 3(2)(d) of Directive 2008/95/EC<sup>5</sup>, which was implemented by the UK in Section 3(6) of the Act, does not extend to liability of confusion with another mark otherwise than in a domestic context (*DAWAAT Trade Mark*, BL O/265/02, paras. 99 – 106).

54. Indeed, even in the context of the non-UK implemented Article 4(4)(g), the CJEU held in Case C-320/12, *Malaysia Dairy Industries Pte. Ltd v Ankenævnet for Patenter og Varemærker* EU:C:2013:435 (para. 44.2):

“... The fact that the person making that application knows or should know that a third party is using a mark abroad at the time of filing his application which is liable to be confused with the mark whose registration has been applied for is not sufficient, in itself, to permit the conclusion that the person making that application is acting in bad faith within the meaning of that provision.”

55. In the present case, there was no evidence that GF had any customers for its products in the UK under its stylised gourmet or other marks<sup>6</sup>, and there was insufficient evidence of the degree of recognition in the UK, if any, of those marks.

56. At the hearing, Mr. Heald informed me that he no longer pursued his argument concerning Article 4(4)(g) of Directive 2008/95/EC.

57. Instead, GF relied on the following statement by the Hearing Officer in connection with GF’s copyright claims under Sections 47(2)/5(4)(b) of the Act:

“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

---

<sup>4</sup> Beyond the meaning of “bad faith” in this context, *Malaysia Dairy* referred to above.

<sup>5</sup> Article 2 Directive (EU) 2015/2436, to be compulsory in the case of invalidity.

<sup>6</sup> I understood that this was the reason why GF abandoned its Section 5(4)(a) ground.

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."

58. As the Hearing Officer made clear, this statement only went to the opportunity by London to copy in the copyright claims, and concerned solely Registrations numbers 3002778, 2654078, 3002769 and 3035297, filed in 2013. It did not apply to London's other marks, numbers 2593103, 2646565, 2643615 and 3059592, 3059567 and 3059563 filed in 2011, 2012 and 2014 respectively, that did not incorporate GF's copyright works.
59. I have given this issue considerable thought in the light of the evidence.
60. In my judgment, the findings of the Hearing Officer in connection with the copyright claims could not be extrapolated safely to infer at the relevant times (or any of them) an intention to mislead UK consumers by London contrary to Section 3(6), in situations where GF had failed to establish on the evidence: (1) any customers in the UK for GF's products under its marks; (2) the degree of recognition, if any, amongst the UK public of GF's stylised gourmet mark (or any other of GF's marks relied on).<sup>7</sup>

### **Conclusion**

61. For the above reasons, in my judgment, the appeal fails and the Hearing Officer's decision is upheld (albeit, perhaps on wider grounds).
62. I will order GF to pay London the sum of £600 towards London's costs of this appeal to be paid within 21 days of the date of this decision<sup>8</sup>.

Professor Ruth Annand, 10 May 2017

Mr. Jeremy Heald of Counsel instructed by HGF Limited appeared on behalf of the Opponent/Applicant for invalidations/Appellant

Mr. Malcolm Chapple of Counsel instructed by London IP appeared on behalf of the Applicant/Registered Proprietor/Respondent

---

<sup>7</sup> Intention is just one factor in the global assessment of bad faith (Case C-529/07, *Chocoladefabriken Lindt & Sprüngli AG v. Franz Hauswirth GmbH* [2009] I-04893. Other factors include the degree of legal protection of the claimant's mark in the jurisdiction concerned.

<sup>8</sup> There was no order for costs below since the parties had enjoyed a roughly equal measure of success.