

**O-311-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**TRADE MARK APPLICATION No. 3274292  
BY SALAM FOODS LTD.  
TO REGISTER THE FOLLOWING TRADE MARK  
IN CLASSES 29, 30 AND 35**

**SALAM FOODS**

**AND**

**OPPOSITION THERETO (NO. 412091)  
BY FLYING TRADE LIMITED**

## **Background and pleadings**

1) On 30 November 2017 Salam Foods Ltd (“the applicant”) applied to register the trade mark **SALAM FOODS** in the UK. It was accepted and published in the Trade Marks Journal on 16 February 2018 in respect of the following goods:

Class 29: Processed potatoes; frozen vegetables; preserved, frozen, dried and cooked fruits and vegetables; frozen chips; frozen fruits; dairy products; milk and milk products; butter; yoghurt; cheese.

Class 30: Confectionary; halva; halwa shaar; chocolate based confectionary; pistachio based confectionary; almond and sultana kibbeh.

Class 35: Retail services and online retail services connected with the sale of processed potatoes, frozen vegetables, preserved, frozen, dried and cooked fruits and vegetables, frozen chips, frozen fruits, dairy products, milk and milk products, butter, yoghurt, cheese, confectionary, halva, halwa shaar, chocolate based confectionary, pistachio based confectionary, almond and sultana kibbeh, dates; flour, herbs and spices, honey, jam, nuts, seeds, oils, olives, pickles, ready meals, rice, pasta, pulses, sauces, pastes, sweets, tea, coffee, fruit drinks, cola drinks, carbonated drinks, almond drinks, honey drinks, air fresheners.

2) Flying Trade Limited (“the opponent”) opposes the trade mark on the basis of Sections 5(2)(b) and 5(3)<sup>1</sup> of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier UK and European Union Trade Mark (“EUTM”) registrations. Pertinent details of these registrations are below:

**UK 2416763**

**Mark: SALAAM**

**Goods:** Class 30 Rice and rice products

**Filing date:** 16 March 2006

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<sup>1</sup> The Section 5(3) claim was added following a request to add this ground of attack filed by the opponent.

**Registration date:** 2 November 2007

**EUTM 11830122**

**Mark:** salaam

**Goods:** Class 30 Coffee, tea, cocoa and artificial coffee; Rice; Tapioca and sago; Flour and preparations made from cereals; Bread, pastry and confectionery; Ices; Sugar, honey, treacle; Yeast, baking-powder; Salt; Mustard; Vinegar, sauces (condiments); Spices; Ice.

**Filing date:** 21 May 2013

**Registration date:** 25 September 2013

3) The opponent argues that the respective goods are similar and that the marks are highly similar and therefore a likelihood of confusion exists, and the application should be refused under section 5(2)(b) of the Act. In respect of its section 5(3) claim, the opponent only relies upon its earlier UK registration. The opponent argues that by virtue of the reputation that its mark enjoys in the UK, an “advantage would be gained by the Applicant by more readily getting an initial response from retailers and consumers”. Further, it claims that “the uniqueness of the earlier mark in the field of South Asian specialist foods would be undermined by the presence of the mark in the market”.

4) The applicant filed a counterstatement denying the claims made and requesting that the opponent provides proof of use of its earlier UK<sup>2</sup> trade mark relied upon.

5) Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary.

6) Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful consideration of the papers. The applicant has been represented by Baron Warren Redfern whereas the opponent was not represented.

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<sup>2</sup> The EUTM is not old enough to be the subject of proof of use.

## PRELIMINARY ISSUES

7) In the applicant's submissions of 21 January 2019, it requests that the opposition be dismissed on two technical grounds. In essence, it claims that 1) the amended Form TM7 (the third attempt dated 19 November 2018) was filed in the name of "Adosh Chatrath" who is not "the owner of the two earlier trade marks upon which the Opposition is based", and 2) the "third" Form TM7 no longer contains the original section 5(2)(b) ground.

8) The submissions include a number of other issues and a request for costs off the scale which I shall address at the end of this decision. All of the matters raised in the submissions were addressed and dismissed in the Registry's letter of 28 February 2019 and I duplicate a copy in full at Annex A. No response to the aforementioned letter was received from the applicant.

9) In respect of the first claim for dismissal (the opposition not being in the correct name), the applicant refers to the amended Form TM7 of 19 November 2018 which had the name of the opponent as being "Adosh Chatrath" rather than the proprietor of the earlier mark, Flying Trade Limited. This went unnoticed by the Registry and was served on the applicant. It is useful to put this in context. When the initial Form TM7 'notice of opposition' was filed it was also in the name of Adosh Chatrath. This was identified by the Registry and the opponent was invited to file an amended version to include the correct opponent<sup>3</sup>. The opponent duly complied and submitted the amended Form confirming that the opponent is Flying Trade Limited. They were subsequently recorded as the opponent for this opposition and this was not changed upon filing an amended version.

10) The amended form would not have been taken to "substitute" the existing one because, 1) they are not the proprietor of the earlier marks and could not rely upon them (as argued by the applicant) and, 2) the Registrar would have applied the "substitution" criteria as set out at section 4.17 "Substitution of parties" in the Tribunal

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<sup>3</sup> Under the legislative changes that came into force on 1 October 2007, the oppositions based on Section 5 of the Act can only be made by the proprietor of an earlier mark or other earlier right.

Section of the Trade Marks Work Manual. Therefore, for these reasons and those given in the Registry's letter of 28 February 2019, the applicant's claim that the opposition should be dismissed is rejected.

11) Turning to the second claim for dismissal, the applicant argues that since the "third" Form TM7 no longer contains that original section 5(2)(b) ground it is no longer entitled to rely upon it. The letter serving the Form TM7 included the following:

"At the Case Management Conference (CMC) held on 16 October 2018, the Hearing Officer allowed the addition of a Section 5(3) ground of opposition along with a further addition of an earlier right under section 5(2)(b)."

12) It is clear from the above that the additional earlier mark was to be relied upon as well as the existing earlier mark. If there was any doubt about this, then the applicant had ample opportunity to clarify the position with the Registry. Therefore, for these reasons and those given in the Registry's letter of 28 February 2019 I dismiss the request for the opposition to be rejected.

13) The applicant also takes issue with the Registry not requesting the applicant to file an amended counterstatement following the acceptance of the section 5(3) ground being added and that the opponent may rely upon its earlier EUTM 11830122. I accept this criticism and agree that the applicant should have been given the opportunity to file an amended Form TM8. However, in the applicant's email of 28 February 2019 it confirmed that it will not be filing an amended Form TM8 and counterstatement and instead relies upon its original form and its submissions of 21 January 2019 collectively.

## **EVIDENCE**

### *Opponent's evidence*

14) The opponent's evidence consists of a witness statement from Mr Adosh Chatrath who is a director and Group Legal Counsel of the sole parent company to the opponent.

15) Mr Chatrath states that the opponent's primary customers are wholesalers and cash and carry stores, "although we do also distribute through larger chains such as Tesco, Sainsburys, Asda, Morrisons and Amazon"<sup>4</sup>. He states that these customers predominantly sell to independent supermarkets and mini-markets with a particular focus on such stores catering for the Asian community.

16) Exhibit AC1 to the witness statement consists of a "presentation document"<sup>5</sup>, which Mr Chatrath attests to being factually correct. The document states that between 1 January 2009 to 31 December 2017 Salaam total revenue sales were £59,582,762. The revenue is not broken down into annual sales figures. Mr Chatrath estimates that 70% of these sales were in the UK. Mr Chatrath estimates that 70% of the sales are for rice and the rest are poppadums.

17) Exhibit AC2 consists of examples of Salaam Basmati rice products being offered for sale on the Asda website, the Eastern Eye brochure, Amazon and Morrisons. Mr Chatrath acknowledges that all of the examples post-date the application filing date but he claims that the evidence reflects the position prior to the application filing date. Mr Chatrath also claims that these demonstrate that the respective marks will be in direct competition with one another, however the evidence does not appear to include references to the applicant.

18) Exhibit AC3 includes two tables headed Top 10 Rice which appear to be from an article in The Grocer publication of 14 January 2015 for "Top Products Survey, 2014". The full article has not been provided and even if I were to try to access the website page via the link provided<sup>6</sup> I would not have been able to have done so because my understanding is that articles from The Grocer can only be accessed by paid subscribers. I reproduce the tables at Annex B to this decision.

19) The exhibit includes further links to websites, but again the details within the links have not been provided. The rest of the exhibit includes pictures of the packets of

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<sup>4</sup> Paragraph 4.3 of the witness statement

<sup>5</sup> Paragraph 2 of the witness statement

<sup>6</sup> The Registrar does not actively review links provided in evidence since the onus is on the filer to provide the relevant information it seeks to rely upon.

rice bearing the mark salaam. The exhibits state that the goods are for 2009 and 2015. Mr Chatrath also states the following:

“A further point is that we focus on the Muslim community with our “SALAAM” brand. As explained in Exhibit AC1, the Muslim and non-Muslim South Asian communities do not buy the same brands and the brand “SALAAM” would be unlikely to appeal to the non-Muslim market. The same point applies to the Mark applied for: it is a mark which is much more likely to be used, and to appeal to, members of the South Asian Muslim community.”

20) Finally, exhibit AC4 comprises of a presentation which appears to amount to submissions relating to there being a likelihood of confusion. One point of note is the statement “Salaam is relatable to Asian Muslim Consumer – It is a common greeting in many Arabic speaking Muslim countries”.

21) This completes my summary of the evidence to the extent that I deem necessary.

## **DECISION**

### **Section 5(2)(b)**

22) Since the opponent’s earlier EUTM is not the subject of proof of use and covers broader goods, I shall assess the section 5(2)(b) claim based on this earlier mark. Section 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

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

### *The principles*

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive



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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

24) In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

25) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

26) The respective goods and services are as follows:

<b>Application</b>	<b>Earlier goods</b>
<p>Class 29: Processed potatoes; frozen vegetables; preserved, frozen, dried and cooked fruits and vegetables; frozen chips; frozen fruits; dairy products; milk and milk products; butter; yoghurt; cheese.</p>	<p>Class 30 Coffee, tea, cocoa and artificial coffee; Rice; Tapioca and sago; Flour and preparations made from cereals; Bread, pastry and confectionery; Ices; Sugar, honey, treacle; Yeast, baking-powder; Salt; Mustard; Vinegar, sauces (condiments); Spices; Ice.</p>
<p>Class 30: Confectionary; halva; halwa shaar; chocolate based confectionary; pistachio based confectionary; almond and sultana kibbeh.</p>	
<p>Class 35: Retail services and online retail services connected with the sale of processed potatoes, frozen vegetables, preserved, frozen, dried and cooked fruits and vegetables, frozen chips, frozen fruits, dairy products, milk and milk products, butter, yoghurt, cheese, confectionary, halva, halwa shaar, chocolate based confectionary, pistachio based confectionary, almond and sultana kibbeh, dates;</p>	

flour, herbs and spices, honey, jam, nuts, seeds, oils, olives, pickles, ready meals, rice, pasta, pulses, sauces, pastes, sweets, tea, coffee, fruit drinks, cola drinks, carbonated drinks, almond drinks, honey drinks, air fresheners.	
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27) The goods and services sought by the applicant are generally foodstuffs and the retailing thereof. I will go through the terms in turn but shall group them when it is reasonable to do so. I will compare each term (or group of terms) with the opponent's goods as above. I will focus on what I consider to be the opponent's most similar goods but I have, of course, borne all the opponent's goods in mind.

#### *Class 29*

28) The opponent argues that the contested class 29 goods are similar to a low degree since they are all foodstuffs sold in supermarkets and other retail outlets. They have not provided an analysis specific to the goods in question. Whilst it is true that they are foodstuffs and may be sold via similar channels, this is too far a generalisation to find similarity. Many of the applied for goods are chilled or frozen items and with the exception of ice, the earlier goods would be sold in different areas of supermarkets or shops. Further, the goods are not in competition nor are they complementary in the sense that there is not a close connection between them in the sense that one is indispensable or important for the use of the other<sup>7</sup>. In the absence of specific submissions or evidence to assist me, I do not consider the contested class 29 goods to be similar to the earlier class 30 goods.

29) For the avoidance of doubt, I do not consider *ice* to be similar to any of the applied for class 29 goods. Ice is frozen water which is typically added to drinks to keep them cool. They are not foodstuffs like the applied for goods. They are not in competition or complementary. They are dissimilar.

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<sup>7</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

### Class 30

30) Both lists contain the identical goods *confectionery*. Applying the *Meric* principle, the applied for *halva; halwa shaar; chocolate based confectionery; pistachio based confectionery* are included in the broader term, and are therefore identical to the earlier *confectionery*.

31) With regard to the contested *almond and sultana kibbeh*, I understand these to be a Levantine dish consisting of frying together bulgur, minced onions, finely ground meat and Middle Eastern spices which are typically rolled into balls or croquettes. They are a finished prepared snack or meal which may be eaten as a first course. Whilst they include spice, being an ingredient does not result in the goods being similar. None of the earlier goods are finished products, snacks or meals (apart from bread which may be eaten by itself). Therefore, they are different in nature. Whilst they may all be sold in supermarkets and shops, they would be in a different area and/or aisle. They are not in competition with one another since one is the finished articles and the others are ingredients to make other foodstuffs (not to make almond and sultana kibbehs). Accordingly, I do not consider the goods to be similar.

### Class 35

32) In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

33) In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are

four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut."

34) However, on the basis of the European courts' judgments in *Sanco SA v OHIM*<sup>8</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>9</sup>, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*<sup>10</sup>, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

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<sup>8</sup> Case C-411/13P

<sup>9</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>10</sup> Case C-398/07P

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

35) In *Frag Comercio Internacional, SL, v OHIM*, Case T-162/08, the General Court held that a registration for 'retail services', which did not identify the kinds of goods covered by the services, was too vague to permit a proper comparison to be made between those services and the goods covered by the later mark. It was not therefore possible to determine that the respective services and goods were similar.

36) In *Major League Baseball Properties, Inc v Giant UK Limited ("Giant")*, BL 0/264/14, Ms Anna Carboni, sitting as the Appointed Person, considered *Oakley* in the context of a case involving the comparison of the retailing of bicycles against clothes. She said:

"44. I reject Mr Onslow's suggestion that complementarity can only be found where there is identity of goods with the subject goods of retail services, and only in those circumstances can the relevant goods and retail services be found to be similar. In my view, it must be a question of fact to be assessed in each case, as the Courts have done in countless cases, including the General Court in *Oakley* itself.

...

54. So far as complementarity is concerned, the hearing officer did not find this to exist between clothing and retail services for bicycles and bicycle accessories. So the only feature of similarity that he found was "the potentially common retail environment". Here, I go back to my earlier comments about the need for care when considering overlaps in distribution channels and sales outlets, due to the possibility of finding all sorts of otherwise quite different products and services being provided in one place. When it is possible to find products and services together, it is worth delving a bit deeper and considering, for example, whether they are usually purchased together or whether one is needed for the use of the other. In this case, as Mr Onslow submitted, the purchase of cycle clothing is not indispensable or important to

the purchase of a bicycle; their purchase is optional. While of course clothing is generally necessary to be worn when bicycling, it is not necessary to buy clothes at the same time or through the same outlets as the bicycle, and in any event the same could be said for virtually any other activity. The connection between the two is therefore at a very general level.

55. In my assessment, the fact that cycle clothing covered by the Earlier Mark might be offered through the same outlet as retail services for bicycles and bicycle accessories, whether specialist or more general outlets, cannot be enough to reach an overall finding of similarity in circumstances where the other Canon factors point quite strongly in the other direction (in the case of nature, purpose and method of use) or are absent (in the case of competitiveness or complementarity). While the requirement of similarity of goods/services - just like that of similarity of marks - is not a high one, the bar must not be set at an unduly low level.”

37) I take from the authorities above that, in comparing retail services against goods, there may be some similarity based upon complementarity and shared trade channels; the goods do not have to be identical to the subject goods of the retail service; and that the level of similarity may be weak depending on the presence or absence of the other *Canon* factors.

38) Services and goods *per se* differ in nature since services are intangible whereas goods are tangible items which serve different needs. *Retail services* consist in bringing together, and offering for sale, a wide variety of different goods, thus allowing consumers to conveniently satisfy different shopping needs at one stop. This is not the purpose of goods. However, there is a complementary relationship since the services are generally offered in the same places where the goods are offered for sale. Further, they target the same public and share distribution channels.

39) Taking the guidance set out above into account, I consider the contested “*Retail services and online retail services connected with the sale of confectionery, halva, halwa shaar, chocolate based confectionary, pistachio based confectionary, sauces, herbs and spices, ready meals, sweets, tea, coffee, rice, pasta, pulses, pastes, flour*

*and honey*” to be similar to a medium degree to the identical goods covered by the opponent’s earlier mark, namely “*confectionery; sauces (condiments); spices; tea, coffee, rice, flour and honey*”.

40) The earlier goods specification does not specifically identify some of the contested retiled foodstuffs. However, it is considered that a retailer of a wide range of food and drink (as is the case here) is likely to be linked with other specific items. Further, the distribution channels will coincide. Therefore, I find that there is a low degree of similarity.

### **Comparison of marks**

41) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

42) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

43) The respective trade marks are shown below:



Earlier mark	Application
salaam	SALAM FOODS

44) In terms of the overall impression of the earlier mark, since ‘salaam’ is the only element within the mark its distinctive character rests in its whole. With regard to the application, the word FOODS is descriptive of the characteristic of the applied for goods and whilst it is not disregarded, the distinctive character in the mark resides in the word “SALAM”.

45) Visually, the opponent argues that the marks are visually highly similar due to the dominant distinctive component in each mark (salaam and SALAM) being very similar. The applicant argues that the additional letter “a” in the earlier mark “sets it clearly apart from the shorter word of the Applicant’s sign”<sup>11</sup>. The respective marks coincide with the letters “SALA\*M” being in the same order and only differ insofar that the earlier mark has an additional “a” and the application includes the word “FOODS”. Since “salaam” and “SALAM” are the distinctive elements of each mark, I consider the respective marks to be visually similar to a high degree.

46) Aurally, the applicant argues that “the sign SALAM has a different and clearly discernible pronunciation to the sign SALAAM. The sign SALAM has a distinctive short “a” sound to its second syllable, while the sign SALAAM has a longer drawn out “ar” sound to its second syllable. In addition, the extra word FOODS in the Applicant’s sign helps to differentiate it...phonetically from the Opponent’s sign.<sup>12</sup>” The opponent merely states that the marks are aurally highly similar.

47) Whilst I acknowledge the applicant’s comments, in particular that the double-a in the earlier mark results in a more drawn out sound, I certainly do not agree that this differentiates the marks to any significant degree. Therefore, taking this into account, together with the non-distinctive word “FOODS” in the application, I consider the marks to be aurally similar to a high degree.

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<sup>11</sup> Applicant’s written submissions of 21 January 2019

<sup>12</sup> As above

48) The applicant has not made any submissions on the conceptual comparison. The opponent argues as follows:

“To those members of the public who speak Arabic, Urdu or Farsi, and more generally the Muslim and South Asian communities, the word “salam”/“salaam” would be instantly recognisable as the well-known Islamic greeting. To such members of the public the conceptual effect of the two marks would be very similar.”

49) The opponent’s evidence<sup>13</sup> included a statement about the word Salaam is “a common greeting in many Arabic speaking Muslim countries”<sup>14</sup>. Accordingly, for Arabic speaking members of the relevant public the earlier mark will have a meaning. Whilst the application does not have the double-A in SALAM, since this may go unnoticed or considered to be an alternative or misspelling, it would still be viewed as the common greeting together with the descriptive word “FOODS”. Accordingly, to those that understand the meaning of SALAAM they are conceptually identical.

50) Notwithstanding the above, neither list of goods or services are limited to the Arabic speaking community and I must therefore consider the position for the general non-Arabic speaking public. For these consumers, neither “salaam” or “SALAM” will have any meaning and will be viewed as invented or foreign word. This does not create a conceptual hook and since “FOODS” is descriptive, a conceptual comparison is not possible.

### **Average consumer and the purchasing act**

51) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

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<sup>13</sup> Exhibit AC4 to the witness statement of Mr Chatrath

<sup>14</sup> As above

52) In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

53) The average consumer of the goods and services at issue is a member of the general public. The goods will generally be purchased following a visual inspection of the goods on shelves in shops, websites for home delivery or in some cases menus. However, I do not discount that some goods may be purchased following aural recommendations and so I do not discount the aural aspect of the purchasing process. The degree of care the average consumer will display when selecting such goods and service is likely to vary considerably, ranging from a quick purchase of confectionary in a corner shop to a slightly more considered purchase for more expensive items but even then, the level of attention is (at best) medium.

### **Distinctive character of the earlier trade mark**

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined

Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

55) From an inherent perspective, the earlier mark consists of the word salaam. For those that do not speak Arabic it will be considered to be an invented word. Therefore, it has a high degree of inherent distinctive character. For Arabic speakers who would perceive the marks to be an alternative or misspelling of “Salam”, a common form of greeting someone, it would be understood and have a meaning which is not descriptive or allusive of a characteristic of the goods that it covers. Therefore, to these members of the relevant public it will have a medium degree of distinctive character.

56) The opponent also claims that it has an enhanced degree of distinctive character by virtue of the use made of it. The applicant is critical of the evidence. For example, it highlights that the opponent has not provided any invoices or distribution documents to support its claim that its turnover is in the region of £2m per annum. Further, the applicant argues that the opponent’s claim that its total turnover is nearly £60million is “outlandishly large and the Applicant questions its veracity given the paucity of supporting documentary evidence”<sup>15</sup>. It also states that: “It should be noted that no third party evidence at all has been provided to attest to any reputation in the Opponent’s Sign in the UK, such as reviews, articles or news reports. Exhibit

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<sup>15</sup> Paragraph 6.11 of the applicant’s written submissions of 21 January 2019

AC3 contains three internet links allegedly to articles in The Grocer magazine, but it is denied that URL addresses written out in text form in an exhibit to a witness statement are anything more than meaningless text.<sup>16</sup> The applicant points out that the opponent has not provided any marketing or advertising activity conducted by the opponent which might have educated the public as to the reputation of the opponent's sign. I agree that the evidence is poorly presented and not comprehensive. However, the applicant has not challenged the veracity of the evidence by providing contradictory evidence or cross examining the witness.

57) Taking all of the above into account, the evidence indicates that in 2015 the opponent had a UK turnover of around £2m per annum and independent tables list them as being the 9<sup>th</sup> largest rice manufacturer in the UK for 2014. All of this evidence is at least 3 years prior to the date that the application was filed (30 November 2017), which is the date I must determine whether the earlier mark had an enhanced degree of distinctive character. As the applicant states, there is no indication of advertising spend. Taking all of these factors into account, I do not consider the earlier mark's use was such to enhance its distinctive character. Therefore, even if the mark was not already inherently distinctive to a high degree, it would not have been enhanced by virtue of the use made of it. For Arabic speakers who understand the mark to be a common greeting, then the mark is not descriptive or allusive of the goods and so the inherent distinctive character is medium.

#### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

58) Confusion can be direct (when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). To determine whether there is a likelihood of confusion I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the factors I set out in paragraph 23.

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<sup>16</sup> Ditto paragraph 6.12

59) Since similarity between goods or services is a prerequisite for there being a likelihood of confusion, where I have found the contested goods to be dissimilar to those of the earlier mark, the opposition fails. Therefore, the rest of this assessment relates to the remaining goods and services

60) I have found that the remaining applied for goods and services are either identical or similar to a low degree. I have found that the marks are visually and aurally similar to a high degree. For Arabic speakers it is likely that the marks are conceptually identical. For those that do not speak Arabic, neither has a meaning and so the position is neutral.

61) I have also found that the goods will predominantly be purchased following a visual inspection of the goods, though I do not discount aural recommendations. The level of attention is, at best, medium. Taking all of these factors into account, I find that the level of similarity between the marks is such that there is an inevitable risk of direct confusion, even for the services I have found to be similar to a low degree.

62) Whilst I acknowledge that the majority of the evidence and submissions relate to the Arabic speaking community, the goods and services have not been limited to this section of the relevant public. To this end, the non-Arabic speaking average consumer, which make up a significant proportion of the consumer of the applied for goods will view the marks as invented or foreign words, followed by the non-distinctive “foods”, which results in there being a likelihood of direct confusion. In other words, even if Arabic speakers would not be confused (though I find that they would), the non-Arabic speakers would be confused which is sufficient for the section 5(2)(b) claim to succeed.

### **Section 5(2)(b) outcome**

63) The section 5(2)(b) succeeds against the following goods and services:

Class 30: Confectionery; halva; halwa shaar; chocolate based confectionary; pistachio based confectionary.

Class 35 in its entirety.

64) The section 5(2)(b) fails against the following goods and services:

Class 29: Processed potatoes; frozen vegetables; preserved, frozen, dried and cooked fruits and vegetables; frozen chips; frozen fruits; dairy products; milk and milk products; butter; yoghurt; cheese.

Class 30: Almond and sultana kibbeh.

### **SECTION 5(3)**

65) Since the opposition under section 5(2)(b) has succeeded only in part, I shall now consider the opposition under section 5(3) against the remaining goods and services (as listed in paragraph 63 above).

66) The section 5(3) claim is based on its earlier UK registration for the mark SALAAM for class 30 "Rice and rice products".

67) Section 5(3) states:

"(3) A trade mark which-

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

68) The opponent's Form TM7 statement of case relies upon section 5(3) based solely on its earlier UK trade mark registration for the mark SALAAM which is registered for class 30 *rice and rice products*. Since the UK mark has been registered for more than 5 years prior to the publication of the subject application (16 February 2018), the applicant has exercised its discretion under section 6A of the

Act and requested the opponent to demonstrate that the mark has been genuinely used for the goods that it seeks to rely upon.

## **Proof of use**

69) The proof of use provisions are set out in section 6A of the Act as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

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

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

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.



(4) For these purposes -

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

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

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

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

*Proof of use case law*

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

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm*

*Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor

does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de*

*minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

### *The relevant period*

71) The relevant period for which the opponent must demonstrate use is the five-year period ending on the date of publication of the application. Therefore, the relevant period is 17 February 2013 - 16 February 2018.

72) The opponent has provided examples of how the mark has been on packets of rice, turnover figures which are in the millions and that the opponent is considered to be 9<sup>th</sup> in the Top 10 products by The Grocer magazine in 2014. Therefore, I find that it sufficiently demonstrates use of the mark for rice. Whilst there are examples of evidence of use for poppadums, since these goods are not covered by the registration it may not rely upon them.

73) Now that it has been established that the opponent may rely upon its UK trade mark registration for *rice*, I must now determine whether the cumulative conditions of section 5(3) are met. Firstly, the opponent must show that its earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, the opponent must establish that the public will make a link between the marks, in the sense of the earlier marks being brought to mind by the later marks. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

## REPUTATION

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

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

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

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

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

75) In determining whether the opponent has demonstrated a reputation for rice, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with rice. In reaching this decision, I must take all of the evidence into account including "the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it”.

76) When I assessed the distinctive character of the earlier mark under section 5(2)(b) of the Act, I said that the evidence was insufficient to find that the mark's inherent distinctive character was enhanced by virtue of the use made of it. For the

reasons I gave earlier, I find that the evidence is insufficient to support a claim to a *General Motors* standard of reputation.

### **Section 5(3) outcome**

77) The section 5(3) claim fails.

### **OVERALL OUTCOME**

78) Subject to appeal, the opposition succeeds, and the application shall be refused registration for the following goods and services:

Class 30: Confectionery; halva; halwa shaar; chocolate based confectionary; pistachio based confectionary.

Class 35 in its entirety.

79) Subject to appeal, the opposition fails, and the application shall proceed to registration for the following goods and services:

Class 29: Processed potatoes; frozen vegetables; preserved, frozen, dried and cooked fruits and vegetables; frozen chips; frozen fruits; dairy products; milk and milk products; butter; yoghurt; cheese.

Class 30: Almond and sultana kibbeh.

### **COSTS AND OTHER ISSUES**

80) The opponent seeks an award of costs in accordance with the Registry's published scale. The applicant, on the other hand, claims that it is entitled to an off-the-scale costs award based on the conduct of the opponent. More specifically, the applicant's claim is based on the opponent's repeated attempts to get the Form TM7 in an acceptable format, the late request to add the section 5(3) claim and the opponent's repeated failure to copy material to the applicant. Further, the opponent's

Form TM7G (Request to add a ground) submitted to the office on 12 October 2018 and the evidence filed on 12 December 2018. To summarise, the applicant claims that the opponent's actions (or lack of) have resulted in long delays and put the applicant to additional unnecessary expense.

81) Costs off the scale requests are covered in the Trade Marks Work Manual 5.6 headed "Costs off the scale" and states as follows:

"It is vital that the Tribunal has the ability to award costs off the scale, approaching full compensation, to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour. In Rizla Ltd's application [1993] RPC 365 (a patent case) it was held that the jurisdiction to award costs, derived from section 107 of the Patents Act 1977, conferred a very wide discretion on the Comptroller with no fetter other than to act judicially. It is considered that the principles outlined in Rizla's application apply also to Tribunal proceedings. Thus, if the Tribunal felt that a case had been brought without any bona fide belief that it was soundly based or, if, in any other way, its jurisdiction was being used for anything other than resolving genuine disputes; it has the power to award compensatory costs. It would be impossible to outline all of the situations which may give rise to such an award; however, Hearing Officers have stated that the amount should be commensurate with the extra expenditure a party has incurred as the result of unreasonable behaviour on the part of the other side. This "extra costs" principle is one which Hearing Officers will take into account in assessing costs in the face of unreasonable behaviour. Hearing Officers should act judicially in all the facts of a case. It is worth clarifying that just because a party has lost, this is not indicative, in itself, of unreasonable behaviour.

Any claim for costs approaching full compensation or for "extra costs" will need to be supported by a bill itemising the actual costs incurred.

Depending on the circumstances, the Tribunal may also award costs below the minimum indicated by the standard scale. For example, the Tribunal will

not normally award costs which appear to exceed the reasonable costs incurred by a party.”

82) Taking the guidance set out above into account, I do not agree that costs off the published scale are justified. It is unfortunate that some of the forms were not filed in the correct format in the first instance, but I bear in mind that the opponent was not professionally represented. It therefore seems unjustified to award costs against a private litigant for not being particularly *au fait* with opposition proceedings. There was clearly an intention to oppose and efforts were made to rectify any irregularities. On the other hand, the opponent is expected to copy correspondence to the other party (notice that this should be done was included in the links provided in the Registry letters to the opponent of 9 April and 5 July 2018). Further, there was no reason why the section 5(3) ground could not have been raised earlier which would have negated the need for a CMC.

83) Taking all of the above into consideration, I award the applicant the sum of £300 to reflect 1) the late request to add an additional ground and the attendance of the applicant at the subsequent CMC and 2) for not copying certain correspondence to the other party.

84) I therefore order Flying Trade Limited to pay Salam Foods Ltd the sum of £300. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated 3 June 2019**

**Mark King**

**For the Registrar,**

**The Comptroller-General**



## ANNEX A

### NEWS EDITORIALS covering Salaam in the news/media

27<sup>th</sup> May 2015.

<http://www.thegrocer.co.uk/stores/ranging-and-merchandising/dragons-den-rejection-doesnt-stop-asda-snapping-up-the-wild-peanut/519102.article>

20<sup>th</sup> December 2012. Feature in the Grocer.

<http://www.thegrocer.co.uk/buying-and-supplying/categories/ambient/grocery/rice-pasta-and-noodles-pot-snacks-give-brands-instant-win/235028.article>

14<sup>th</sup> of January 2015. Top products Survey, 2014

<http://www.thegrocer.co.uk/reports/rankings/top-products-survey-2014/511971.article?sm=511971>

19/11/2018

TOP10 Rice			SALES			
Total volume change: 3.2%			TOTAL CATEGORY	£ million	change (m)	change (%)
			TOTAL OWN LABEL	177.5	2.7	3.3
1	1	Uncle Ben's	Mars	134.0	-0.9	-0.7
2	2	Tilda	Tilda	58.2	6.1	11.7
3	3	Veetee	Veetee	18.2	-0.1	-0.4
4	4	Batchelors	Premier Foods	9.3	0.8	8.8
5	5	Kohinoor	Kohinoor Foods	5.9	0.7	14.1
6	6	Riso Gallo	Gallo	3.4	-0.9	-20.1
7	9	Lella	Surya Rice	3.3	1.1	52.8
8	7	Badshah	Veetee	2.9	-0.8	-21.7
9	16	Salaam	Surya Rice	2.1	1.1	109.0
10	10	Trophy Basmati Rice	Satnam Overseas	1.9	-0.1	-6.4

TOP10 Rice			SALES			
Total volume change: -0.9%			TOTAL CATEGORY	£m	change (m)	change (%)
			TOTAL OWN LABEL	120.8	2.3	2.0
1	1	Uncle Ben's	Mars	136.6	1.4	1.0
2	2	Tilda	Tilda	68.2	6.1	9.8
3	3	Veetee	Veetee	20.5	3.2	18.1
4	4	Batchelors	Premier Foods	8.8	-0.9	-9.0
5	5	Lella	Surya Rice	6.1	0.5	9.1
6	6	Kohinoor	Kohinoor Foods	4.7	-0.4	-7.3
7	7	Riso Gallo	Gallo	2.9	-0.1	-4.8
8	8	Badshah	Veetee	2.7	0.4	15.1
9	14	Salaam	Surya Rice	2.3	1.1	94.3
10	12	Apna	Surya Rice	1.9	0.5	37.3

## ANNEX B



Intellectual  
Property  
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Flying Trade Limited  
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Essex  
CO12 4PT

Your Reference: FTG/AC/sll/Salaam v  
Salam Food  
**Opposition No: OP000412091**  
Examiner: Chris Benney  
Direct Telephone: +44(0)1633814598  
Date: 28 February 2019

**Trade Mark No: UK00003274292**

**Applicant: Salam Foods Ltd**

**Opposition No: OP000412091**

**Opponent: Flying Trade Limited**

*Please quote your Opposition ID Number in all correspondence*

If you wish to correspond by email please reply to [tribunalsection@ipo.gov.uk](mailto:tribunalsection@ipo.gov.uk) and ensure your email is copied to the other party

Dear Sirs,

**For complete clarification of the matters raised in recent correspondence, this letter is being sent to both parties in the above proceedings.**

Following the filing of the written submissions on behalf of the applicant, the Registry has received emails from the representative of the applicant dated 28 January 2019 and 8 February 2019 and an email from the opponent dated 7 February 2019.

The correspondence from the applicant has queried the earlier rights in support of this opposition, the name of the opponent in these proceedings and the amended notice of opposition which was sent to the applicant on 28 January 2019 and subsequent amended notice of opposition filed by the opponent on 7 February 2019.

Following the filing of the Form TM7G, requesting the addition of a further ground of opposition under Section 5(3), at the Case Management Conference (CMC) dated 16 October 2019, the Hearing Officer agreed to the addition of the extra ground, directions of this were given in the letter from the Hearing Officer dated 19 October 2018.

As no challenge was made, the decision to add a Section 5(3) claim to add to the originally filed Section 5(2)(b) claim for UKTM00002416763, as well as the addition of a further Section 5(2)(b) ground for EUTM11830122, was implemented.

The letter from the Hearing Officer concluded with a deadline being given for the opponent to file an amended Form TM7, and evidence in support of the opposition on or before 19 November 2018.

An amended notice of opposition, containing only the added earlier rights, was filed on 19 November 2018. It is noted that, in recent correspondence, the applicant has queried the existence of the originally filed Section 5(2)(b) claim for UKTM00002416763. However, reference to that earlier right under Section 5(2)(b) is clearly included in the continuation sheets filed with the amended notice of opposition and have remained included in other correspondence from the opponent.

Those amended pages, therefore, have been added to the originally filed earlier right and included in the notice of opposition sent to the applicant on 1 December 2019.

The applicant has also queried the name of the opponent in the proceedings, the email dated 28 January 2019 saying even though the above name of the opponent is the likely position of the opponent, *'but this must be something for the Opponent to establish, not the Office'*.

The matter of the name of the opponent was queried when the notice of opposition was originally filed. When requested for clarification by the Registry, in the email dated 13 April 2018 (a copy is enclosed), the name of the opponent was sufficiently clarified.

Unfortunately, there has been an issue with the identification of the EUTM earlier right added to the proceedings after the CMC dated 16 October 2019. The email from the applicant dated 8 February 2019 states, despite the correct number now being provided, some of the answers given for the remainder of that part the notice of opposition, were incorrect.

Please note, as the details of the earlier right were corrected to the satisfaction of the Registry, that solitary page has replaced the respective page of the notice of opposition.

Please note, such action to correct a typographical/numerical error contained in a notice of opposition is done in this manner. When a solitary page of the notice of opposition is to be corrected for the opposition to proceed, the Registry can and will accept the filing of the relevant page(s) rather than expect the parties to continually file a full version of the Form TM7.

The Registry strongly refutes the point made by the applicant that *'this appears to be the Office acting of its own volition in a manner which is prejudicial to the applicant'*.

A copy of the notice of opposition is now included with this letter and a period of one month is now given for the applicant to file an amended Form TM8 and counterstatement.

The Form TM8 and counterstatement, therefore, must be filed on or before **28 March 2019**.

As written submissions on behalf of the applicant were filed on 21 January 2019, upon receipt of the form, the parties will then be asked whether they wish to be heard on the matter.

Yours faithfully,

*Chris Benney*  
**Trade Marks Registry**