

O/690/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS. UK00003489841 AND UK00003489762
IN THE NAME OF MAYA'S CHILLI COMPANY LTD
TO REGISTER THE FOLLOWING TRADE MARKS:



AND



IN CLASSES 29 AND 30

AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO
UNDER NOS. 421412 AND 421413
BY SKKUDA HOLDINGS JERSEY LTD

BACKGROUND AND PLEADINGS

1. On 14 May 2020, Maya's Chilli Company Ltd ("the applicant") applied to register the trade marks shown on the cover page of this decision in the UK. The applications were published for opposition purposes on 31 July 2020 and registration is sought for the following goods:

Class 29 Chilli oils; chilli oils for food.

Class 30 Chilli oil for use as a seasoning or condiment; Chilli oils being condiments; Concentrated chilli sauce; Chilli Condiments; Chilli paste for use as a seasoning; Chilli sauce; Chilli seasonings.

2. On 10 September 2020, Skkuda Holdings Jersey Ltd ("the opponent") opposed the applications based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon the following trade mark:



UKTM no. 2546766

Filing date 6 May 2010; registration date 8 October 2010

Relying upon all goods for which the mark is registered, namely:

Class 29 Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, Jams, compotes; eggs, milk and milk products; edible oils and fats.

Class 30 Tea, sugar, rice, tapioca, sago; flour, bread; honey, treacle; salt, mustard; vinegar; spices.

3. The opponent claims that there is a likelihood of confusion because the marks are similar, and the goods are identical or similar.

4. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use.

5. Both parties filed evidence in chief. The opponent also filed further evidence following a successful application. A hearing took place before me, by video conference, on 24 August 2021. The opponent was represented by Ms Amandeep Rana of Sanderana Limited and the applicant was represented by Mr Chris McLeod of Elkington & Fife LLP. Both filed skeleton arguments in advance of the hearing.

EVIDENCE AND SUBMISSIONS

6. The opponent filed evidence in chief in the form of the witness statement of Devanand D Kalyani dated 1 March 2021, which is accompanied by 6 exhibits. Mr Kalyani is the General Manager of a company called Almaya International Limited. I will return to the connection between this company and the opponent below.

7. The applicant filed evidence in chief in the form of the witness statement of Mary Dole dated 27 April 2021. Ms Dole is the director of the applicant. The applicant's evidence was accompanied by written submissions dated 27 April 2021.

8. The opponent filed further evidence in the form of the witness statement of Deepak Lachmandas Pagrani dated 11 July 2021, which is accompanied by 4 exhibits. Mr Pagrani is a director of Almaya International Limited.

9. Prior to the hearing, Ms Rana filed further written submissions with her skeleton argument. The applicant took issue with the inclusion of these submissions, given that the opponent was due to have an opportunity to make oral submissions at a hearing. However, in the event, Ms Rana was content not to pursue the point and rely upon oral submissions only.

APPLICATION TO FILE FURTHER EVIDENCE

10. Prior to the hearing, the applicant made an application to cross-examine Mr Kalyani in relation to Exhibit DK-01. The part of Mr Kalyani's evidence which gave rise to the request for cross-examination is as follows:

“5. UK Trade Mark Registration No. UK00002546766 MAYA's is registered in the Name of Skudda Holdings Ltd a Limited Company incorporated in Jersey under Registration No. 69737. Almaya International Limited has always had the exclusive right to exploit and enforce UK Trade Mark Registration No. UK00002546766 MAYA'S, with the full consent of Skudda Holdings Limited. I now attach as Exhibit DK-01, a letter signed by the Director of Skudda Holdings Limited attesting to this fact.”

11. Exhibit DK-01 is a letter addressed to this Office from an unnamed Director of Skkuda Holdings (Jersey) Limited confirming the above. However, this document did not take the form of a witness statement (or other acceptable form of evidence) and was not accompanied by a statement of truth.

12. As a result of the applicant's request for cross-examination, the opponent sought leave to file further evidence addressing the nature of the relationship between the opponent and Almaya International Limited. This Tribunal responded as follows:

“It is the Registry's preliminary view to grant the opponent's request to file further evidence relating to the relationship between it and Almaya International Limited. The opponent has 1 month in which to file this evidence.

The applicant should confirm within 14 days of receipt of the opponent's evidence, as to whether they intend to pursue their request for cross-examination.

If either party disagrees with this preliminary view they should request to be heard [...]

13. The applicant requested to be heard and a Case Management Conference (“CMC”) took place before me by telephone conference on 24 June 2021. At the CMC, I confirmed the preliminary view to allow the opponent’s request to file further evidence. Following the CMC, I issued the following letter to the parties confirming my decision:

“I write further to the Case Management Conference (“CMC”) which took place before me today by telephone conference. The purpose of the CMC was to discuss the opponent’s request to file further evidence, as a result of the application for cross-examination made by the applicant in relation to Exhibit DK-01. A preliminary view had already been given to admit the further evidence.

The applicant was represented by Mr Chris McLeod of Elkington & Fife LLP and the opponent was represented by Ms Aman Rana of Sanderana.

Application for Further Evidence

I directed as follows:

1. The preliminary view stands and the opponent has until 12 July 2021 to file further evidence relating to the relationship between it and Almaya International Limited (“Almaya”); and
2. The applicant has 14 days following receipt of the opponent’s evidence to confirm whether it wishes to pursue the request for cross-examination.

I gave brief reasons for this decision at the CMC. However, for the sake of completeness, I will set my reasons out in detail below. In making my decision, I have borne in mind the factors set out in *Property Renaissance Ltd v Stanley Dock Hotel & Ors* (2016) EWHC 3103 (Ch).

It does not seem to be in dispute that the evidence in question is material. Mr McLeod argued that the lack of documentation going to the relationship between the opponent and Almaya was a “fatal flaw” in the opponent’s case.

In terms of the justice and fairness in subjecting the applicant to the burden of further evidence at this stage, it seems to me that this will be a lesser burden than the alternative i.e. the need for cross-examination, which is inevitably time consuming and costly. I note that Mr McLeod submitted that the cross-examination request in this case is targeted and, if allowed, will not take up any significant time at the hearing. However, the time and expense of legal advisors preparing to deal with cross-examination will inevitably be a factor for both parties.

Ms Rana submitted that the opponent’s deadline for confirming whether it wishes to file evidence in reply was 27 May 2021; had they taken the opportunity to do so, they would have had until 28 June 2021¹ to file their reply evidence. Consequently, any overall delay caused to these proceedings will be minimal.

In my view, there is a significant risk of unfairness to the opponent if the evidence is excluded. Mr McLeod noted that the applicant did reserve the right to cross-examine the opponent when she filed her evidence and submissions during the evidence rounds. However, he accepted that no explicit challenges were raised regarding the opponent’s evidence (specifically, Exhibit DK-01). As Ms Rana submitted at the CMC, had such challenges been raised at that time, the opponent would have elected to file evidence in reply. However, as matters stood it had nothing specific to reply to.

It seems to me that these criticisms of the opponent’s evidence should properly have been raised in the evidence rounds; had they been, the opponent would have had the opportunity to answer them. It would be manifestly unfair to allow such criticisms to be raised at this late stage, without giving the opponent the chance to answer them.

I sympathise that the applicant was, at the time of filing evidence and submissions, unrepresented. That does perhaps explain why the criticisms were not raised at the appropriate time. However, it is not, in my view, sufficient grounds for refusing the opponent the opportunity to answer the criticisms that have now been made.

It is for these reasons that I directed the evidence be admitted pursuant to rule 62(1) of the Trade Marks Rules 2008. [...]"

14. The opponent subsequently filed further evidence as outlined above. The applicant confirmed, upon receipt of that evidence, that it did not wish to pursue its request for cross-examination.

DECISION

15. Section 5(2)(b) of the Act reads as follows:

"5(2) A trade mark shall not be registered if because –

(a) [...]

(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."

16. Section 5A of the Act reads as follows:

"5A Where the grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

17. The trade mark upon which the opponent relies qualifies as an earlier trade mark because it was applied for at an earlier date than the applicant's marks pursuant to section 6 of the Act. The earlier mark had completed its registration process more than 5 years prior to the filing date of the applicant's marks and, consequently, it is subject to proof of use pursuant to section 6A of the Act.

18. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Proof of Use

19. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are 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 relevant period .

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes -

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

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

(5) 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.

(5A) [...]

(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.”

20. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

21. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the date of the applications in issue i.e. 15 May 2015 to 14 May 2020.

22. 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 Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [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].”

23. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

Form of the mark

24. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“the CJEU”) found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at

issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”. (emphasis added)

25. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act as follows:

“33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”

26. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

27. At the hearing, Mr McLeod took issue with the form in which the earlier mark has been used in the opponent’s evidence. I note that the opponent’s evidence contains the following examples of the earlier mark in use:



a)



b)

c) Maya's

d) Maya

28. Examples a) and b) appear throughout the evidence in various colour combinations. In my view, the background element of the mark as registered has very little impact on its distinctiveness. This is because it will be recognised for what it is; a background. Consequently, I do not consider that the use in these forms alters the distinctiveness of the registered mark and these are variants upon which the opponent can rely as per *Nirvana*.

29. With regard to example c), the same applies. The distinctiveness of the earlier mark lies predominantly in the word MAYA'S. Consequently, I do not consider that its presentation in text format alters the distinctive character of the mark and this is use upon which the opponent can rely as per *Nirvana*.

30. I recognise that the "s" is missing from variant d). In my view, this is still unlikely to alter the distinctive character of the mark as it remains the same name, but not in the possessive form. However, I will return to this point below.

Sufficient Use

31. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself¹.

32. With regard to any use of the earlier mark by Almaya International Limited, Mr Pagarani states as follows:

“4. I am the controlling mind behind both Skudda Holdings International Limited and Almaya International Limited. The MAYA’S trade mark has always been used by Almaya International Limited with the consent of Skudda Holdings Limited. In fact, on many of the MAYA’S branded products, the name and address of Skudda Holdings Limited also appears on the products as sold, despite these products being sold by Almaya International Limited. [...]”

33. Exhibits DLP-01 and DLP-03 confirm that Mr Pagarani is a Director of both companies. Taking all of this into account, I am satisfied that any use by Almaya International Limited is use with the consent of the opponent and, consequently, use upon which the opponent can rely.

34. Mr Kalyani gives evidence that the opponent’s products have been sold in the UK since 2011. Mr Kalyani states that the earlier mark has been used in relation to various goods including nuts, flour, citric acid, mango pulp, rice, nuts, seeds, pulses, lentils, noodles, herbs, tamarind, jaggery, sugar, pasta and spices (including dried and powdered chilli).

35. A number of photographs of products have been provided, only some of which are dated.² At the hearing, Mr McLeod noted that one of these photographs displays the price in AED (United Arab Emirates dirham) as opposed to GBP. However, as that photograph is undated it would not have assisted the opponent in any event. I note

¹ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

² Exhibit DK-02 and DK-06

that there are a number of photographs dated November 2015 and March 2016 which display goods including lentils and beans, basmati rice, jasmine rice, cumin seeds, coriander seeds, pistachios, cashew nuts, almonds, mango pulp, instant noodles, walnuts and tamarind. There are also a number of photographs which display chilli powder, curry powder, mustard seeds, fenugreek seeds, white pepper powder, black pepper (whole), citric acid, sesame seeds and whole chilli, but these are undated. There are some examples of products where the packaging date is visible including curry powder, cardamon powder, black pepper powder, cumin powder and crushed chilli. However, these are all dated after the relevant period.

36. The opponent's UK turnover figures are as follows:

2015	£8.5million	2016	£10.4million	2018	£12.2million
2019	£13million	2020	£13.4million		

37. Mr Kalyani notes that a significant proportion of these turnover figures relate to products sold under the earlier mark.

38. Mr Kalyani has provided a sample of invoices showing the sale of products sold under the earlier mark.³ The invoices are all dated between August 2016 and March 2020. They are all addressed to locations in the UK such as Southampton, Ilford, Coventry, Oxford, Sheffield, Manchester, Leicester and Bradford. I note that not all of the products referred to in the invoices make reference to the earlier mark. Of those that do, I note the following:

- a) There are various examples of goods being sold which are outside the scope of the opponent's specification, such as over 1000 units of dal and various varieties of nuts respectively and over 150 sales of instant noodles;
- b) There are sales of 168 units of chick peas, 133 units of kidney beans, 46 units of coco beans, 61 units of black eye beans, 127 units of mung beans and 25 units of lentils;

³ Exhibit DK-05

- c) There are sales of 7 units of peas and 1 unit of split peas;
- d) There are sales of 307 units of basmati rice and 50 units of jasmine rice;
- e) There are sales of various types of spices including over 200 units of cumin seeds, over 400 units of black peppercorns, 120 units of coriander powder, over 120 units of cumin powder, over 100 units of ginger powder, over 100 units of garam masala, over 100 units of ground chilli, over 50 units of tandoori masala, 120 units of fennel powder, over 70 units of fenugreek, over 120 units of dhanajeera spice mix, 190 units of ground turmeric, 120 units of madras curry powder, over 40 units of coriander seeds and over 140 units of fennel seeds;
- f) There are sales of over 30 units of mango pulp;
- g) There are sales of 2 units of sago seeds.

39. Clearly, the opponent has been using its mark in the UK for a number of years and its turnover figures are not insignificant. However, whilst I note Mr Kalyani's evidence that a significant proportion of these turnover figures relate to products sold under the earlier mark, without a detailed breakdown of the goods sold, it is difficult for me to assess the extent of any use made in relation to the goods covered by the specification relied upon. The same issue arises in relation to the photographs provided. Whilst these present a picture of the way in which the earlier mark is used on the goods, they do not give an idea of scale of the use. The most useful evidence I have in this regard is the invoices referred to above. I note Mr Kalyani's evidence that these are only a sample of the invoices for the relevant period and I will factor that into my assessment. Taking the evidence as a whole into account, I am satisfied that there has been genuine use in relation to dal, instant noodles, nuts, basmati rice, jasmine rice, various spices and various types of beans and lentils during the relevant period. For the avoidance of doubt, my findings would have been the same even if I had discounted those entries in the invoices which referred to MAYA as opposed to MAYA'S.

Fair Specification

40. I must now consider whether, or the extent to which, the evidence shows use of the earlier marks in relation to the goods and services relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

41. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

42. Whilst the opponent has shown genuine use in relation to various types of nuts, instant noodles and dal, these terms are not covered by the opponent's specification and do not assist the opponent for the purposes of this opposition. I recognise that noodles may be made from ingredients which are covered by the opponent's specification, but that is not sufficient for them to be able to rely upon that term. Similarly, I note that the key ingredient in dal is lentils. However, for the reasons set out below, I do not consider that lentils fall within the term 'vegetables'.

43. There is no evidence of use in relation to the terms "meat, fish, poultry and game", "meat extracts", "eggs, milk and milk products", "edible oils and fats", "tea", "sugar", "tapioca", "flour", "bread", "honey", "treacle", "salt", "mustard" or "vinegar". Consequently, the opponent is not able to rely upon these terms for the purposes of this opposition.

44. There is evidence of genuine use in relation to basmati rice and jasmine rice. Taking this evidence as a whole, I am satisfied that the opponent can retain the term “rice” for the purposes of this opposition.

45. I note that the opponent has shown genuine use in relation to various types of beans and pulses. However, these are legumes which are not types of vegetable such that they could be said to fall within the term “preserved, frozen, dried and cooked fruits and vegetables”. In my view, pulses and lentils are a different category of food to vegetables per se i.e. legumes. As noted above, there is some evidence of use in relation to peas, but this is not sufficient to amount to genuine use. Consequently, the opponent is not able to rely upon the term “preserved, frozen, dried and cooked fruits and vegetables”.

46. I do not consider that there has been genuine use in relation to any goods which may fall within the category of “jellies, jams, compotes”. I recognise that there has been some use in relation to mango pulp, which may be said to be a type of compote, but as noted above this is not sufficient to amount to genuine use. Consequently, the opponent cannot rely upon this term.

47. I note that the opponent’s specification includes the term “sago” and that the evidence shows sales of 2 units of sago seeds. However, as noted above, I do not consider this sufficient to amount to genuine use.

48. Finally, I am satisfied that the opponent has proved genuine use in relation to a broad range of spices. Given the range of spices in relation to which the opponent has used its mark, I am satisfied that it can retain the broader term “spices” for the purposes of this opposition.

49. Taking all of this into account, I consider a fair specification to be:

Class 30 Rice; spices.

Section 5(2)(b) – case law

50. 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:

(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 greater 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

51. In light of my findings above, the competing goods are as follows:

Opponent's goods	Applicant's goods
<u>Class 30</u> Rice; spices.	<u>Class 29</u> Chilli oils; chilli oils for food. <u>Class 30</u> Chilli oil for use as a seasoning or condiment; Chilli oils being condiments; Concentrated chilli sauce; Chilli Condiments; Chilli paste for use as a

	seasoning; Chilli sauce; Chilli seasonings.
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52. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

53. In the *Treat* case, [1996] R.P.C. 281, Jacob J. (as he then was) identified the following factors for assessing similarity:

- (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.

54. The applicant submits as follows:

“The distribution channels for my products compared to the Opponents products are completely dissimilar, targeting different target markets. My products are only sold online and do not appear in any Asian store. My marketing is only conducted via Instagram and Facebook by me, directly to my followers. If, for instance, my products were ever to make it to the big grocery stores like Tesco or Sainsbury’s, my products would appear alongside the sauces like other chilli condiments and oils and not on the spice racks. The Opponent’s customers will not be able to buy my jars, whilst shopping for the Opponent’s products, because our audience; distribution channels; marketing; target markets; as well as the product use, are all completely different.”

55. The parties may sell their products through different channels, with the opponent selling through physical retailers and the applicant selling through social media. However, this is not apparent from their specifications. It is important to assess the similarity of the goods by reference to the full breadth of the specifications, including how they may be used and sold in future. Similarly, the parties’ target markets in practice is not relevant to my assessment. I will return to the nature, purpose and user of the goods below.

Class 29

Chilli oils; chilli oils for food.

56. These terms in the applicant’s specification will overlap in purpose with the opponent’s “spices” to the extent that both are used to add heat and or/flavour to food. There will inevitably be overlap in user as both can be used by members of the general public. The nature of the goods is different, as spices typically take the form of seeds or ground mixtures whereas the applicant’s goods are oils. Consequently, there is likely to be some difference in method of use caused by this differing nature. There may be overlap in trade channels, as businesses specialising in spices or chilli may sell goods in both forms. There may be a degree of competition between the goods,

as the user may choose to add spices during the cooking process or use a chilli oil to add spice to a finished meal. Taking all of this into account, I consider the goods to be similar to a medium degree.

Class 30

Chilli oil for use as a seasoning or condiment; Chilli oils being condiments;

57. As these goods in the applicant's specification are also types of chilli oil, I consider the same comparison will apply as set out above. I consider these goods to be similar to a medium degree.

Concentrated chilli sauce; Chilli Condiments; Chilli paste for use as a seasoning; Chilli sauce;

58. I consider that the same comparison will apply as set out above in relation to method of use, user, trade channels and purpose. I recognise that the nature of these goods differ to the previously discussed oils. However, they will still differ in nature to the opponent's goods, with the applicant's being in liquid form and the opponent's typically taking the form of powders or seeds. I consider that there will still be a degree of competition between these goods for the same reasons set out above. Taking all of this into account, I consider the goods to be similar to a medium degree.

Chilli seasonings.

59. I consider this term to fall within the broader category of "spices" in the opponent's specification. These goods are, therefore, identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

60. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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.”

61. The average consumer for the goods will be a member of the general public. I recognise that the cost of the goods is likely to be relatively low and they are likely to be purchased reasonably frequently. However, various factors are still likely to be taken into consideration, such as heat and type of spice required for a particular recipe. Mr McLeod submitted that a moderate degree of attention is likely to be paid when purchasing the goods. Ms Rana submitted that the level of attention paid will be at the lower end of the scale. I agree. Consequently, I will proceed on the basis that between a low and medium degree of attention will be paid during the purchasing process.

62. The goods are likely to be self-selected from the shelves of a retail outlet or their online equivalent. Consequently, visual considerations are likely to dominate the selection process. However, given that advice may be sought from retail assistants, I do not discount an aural component to the purchase.

Comparison of trade marks

63. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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.”

64. 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.

65. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade marks
	<div style="display: flex; flex-direction: column; align-items: center;"> <div style="display: flex; align-items: center; justify-content: center;">  <div style="margin-left: 10px;"> <p>Maya's Chilli</p> <p>(“the First Application”)</p> </div> </div> <div style="display: flex; align-items: center; justify-content: center; margin-top: 20px;">  <div style="margin-left: 10px;"> <p>Maya's Nørrebro Chilli</p> <p>(“the Second Application”)</p> </div> </div> </div>

Overall Impression

66. The earlier mark consists of the word MAYA'S presented in lower case red font (with a black apostrophe) on a white outlined background. The applicant submits that the word MAYA's is "subordinate [in the mark] as this word or name could have been anything, whereas the font, the red colour, the white background and the lower-case letters are elements that makes it stand out as a trade mark, as registered". I disagree. In my view, it is the word MAYA'S that plays the greater role in the overall impression. The use of colour and stylisation plays a lesser role and the outlined background plays a much smaller role.

67. The First Application consists of the words MAYA'S CHILLI, presented in black title case font alongside a device of a Viking. Given the size of the device and the fact that the eye is naturally drawn to the element of the mark that can be read, I consider that the words and device play a roughly equal role in the overall impression. However, I note that the word CHILLI will be descriptive for all of the goods in the specification and, consequently, will be a non-distinctive element of the mark.

68. The Second Application consists of the words MAYA'S NØ RREBRO CHILLI in a black title case font, alongside the same device of a Viking. For the same reasons, I consider that the wording and the device play a roughly equal role in the overall impression and that the word CHILLI will be a non-distinctive element of the mark.

Visual Comparison

69. Visually, the earlier mark and the First Application overlap to the extent that they both contain the word MAYA'S. There are differences created by the presentation of that word and the presence of the device in the First Application which has no counterpart in the earlier mark. I recognise that the First Application contains the additional word CHILLI, but as this is a non-distinctive element of the mark I do not consider this to be of significant impact. Taking all of this into account, I consider the marks to be visually similar to a medium degree.

70. Visually, the same comparison will apply to the Second Application. However, there is the additional difference created by the presence of the word NØ RREBRO which has no counterpart in the earlier mark. Taking all of this into account, I consider the marks to be visually similar to between a low and medium degree.

Aural Comparison

71. Aurally, the word MAYA'S will be pronounced identically in both the First Application and the earlier mark. The word CHILLI will act as a point of aural difference, although I bear in mind that this is non-distinctive. The device element of the First Application will not be articulated. Taking all of this into account, I consider the marks to be aurally similar to a high degree.

72. Aurally, the same comparison will apply to the Second Application. However, there is an additional difference created by the presence of the word NØ RREBRO in the Second Application which has no counterpart in the earlier mark. Taking all of this into account, I consider the marks to be aurally similar to between a medium and high degree.

Conceptual Comparison

73. Conceptually, the word MAYA'S in all three marks is likely to be recognised as a female forename in possessive form. The word CHILLI in the First and Second Applications will be recognised as a type of spice, but will be recognised as non-distinctive in the context of the goods. I note Ms Dole's evidence that NØ RREBRO is a district of Copenhagen. However, I consider it unlikely that the UK average consumer will be familiar with that. Given the format of the text in the Second Application i.e. MAYA'S NØ RREBRO CHILLI it is may be that the word NØ RREBRO will be viewed as a type of chilli or a foreign language place name which is the origin of a particular type of chilli. However, I recognise that that may not be the case for all average consumers. The Viking device will act as a point of conceptual difference. Taking all of this into account, I consider all three marks to be conceptually similar to a medium degree.

Distinctive character of the earlier mark

74. 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-2779, 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).”

75. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

76. I note that the opponent has not pleaded that its mark has acquired enhanced distinctive character through use. However, as the opponent has filed evidence of use, as summarised above, I will make a finding in relation to enhanced distinctiveness for

the sake of completeness. Whilst the overall turnover figures provided are not insignificant, only a “significant proportion” of these relate to goods sold under the mark and no breakdown is given. In my view, neither these figures, nor the sales represented by the invoices provided, represent a particularly significant share of what is undoubtedly an extensive market. I recognise that the use shown has taken place over a number of years and that use has been reasonably geographically widespread across the UK. However, I have no evidence regarding advertising expenditure and no evidence of any marketing activities undertaken by the opponent. Taking all of this into account, I am not satisfied that the opponent has demonstrated that its mark has acquired enhanced distinctiveness through use.

77. I have, therefore, only the inherent position to consider. The earlier mark is likely to be recognised as the possessive form of the female forename Maya. In *Harman International Industries, Inc v OHIM*, Case C-51/09P, the CJEU found that:

“Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname ‘Becker’ which the Board of Appeal noted is common”.

78. I recognise that, as a general rule, forenames are considered to be less distinctive, although I also recognise that Maya is not a particularly common name in the UK. I bear in mind that the stylisation and use of colour is unremarkable and any contribution to the distinctiveness will be small. Taking all of this into account, I consider the earlier mark to be inherently distinctive to between a low and medium degree.

Likelihood of confusion

79. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being

the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

80. I have found the earlier mark and the First Application to be visually similar to a medium degree, aurally similar to a high degree and conceptually similar to a medium degree. I have found the earlier mark and the Second Application to be visually similar to between a low and medium degree, aurally similar to a medium degree and conceptually similar to at least between a medium and high degree. I have found the earlier mark to be inherently distinctive to between a low and medium degree. I have identified the average consumer to be a member of the general public who will purchase the goods predominantly through visual means (although I do not discount an aural component). I have found that between a low and medium degree of attention will be paid during the purchasing process. I have found the goods to be either similar to a medium degree or identical.

81. I do not consider that the device in the First and Second Applications will be overlooked by the average consumer. Consequently, I do not consider it likely that the marks will be mistakenly recalled or misremembered as each other. I do not consider there to be a likelihood of direct confusion.

82. I recognise that the earlier mark is distinctive to only between a low and medium degree. However, this does not preclude a likelihood of confusion.⁴ The common element MAYA'S, when used on such similar goods, is in my view likely to result in the average consumer concluding that the marks originate from the same or economically

⁴ *L'Oréal SA v OHIM*, Case C-235/05 P

linked undertakings. The differences in presentation and the addition of the device element in the applicant's marks may be viewed as a re-brand or, alternatively, as a different mark being used for a particular range of goods (such as a product range specifically focusing upon chilli as opposed to other spices). Taking all of this into account, I consider there to be a likelihood of indirect confusion. For the avoidance of doubt, my finding would have been the same even if a medium degree of attention was paid during the purchasing process.

CONCLUSION

83. The opposition is successful and the First and Second Applications are refused.

COSTS

84. As the opponent has been successful, it would ordinarily be entitled to a contribution towards its costs. However, I note that prior to the CMC referred to above, the applicant's representatives wrote to the Tribunal as follows:

“[...] we would note that when filing the oppositions, the opponent did not give the applicant notice of its intention to oppose the applications. As such, we would suggest that whatever the outcome of the hearing, and indeed the opposition, it would be inappropriate to award the opponent any costs in this matter.”

85. At the CMC, Ms Rana accepted the applicant's position in this regard.

86. Consequently, I direct that each party bear its own costs.

Dated this 22nd day of September 2021

S WILSON

For the Registrar