

O/714/22

TRADE MARKS ACT 1994

TRADE MARK REGISTRATION 3541410

AND TRADE MARK APPLICATION 3612136

IN THE NAME OF ANGLO ASIAN CASH & CARRY LIMITED

AND

APPLICATION 504073 FOR THE INVALIDATION OF TRADE MARK 3541410

AND

OPPOSITION 426191 TO TRADE MARK APPLICATION 3612136

BY KINGS FOODS (PVT) LIMITED

Background and pleadings

1. These are consolidated invalidation and opposition proceedings brought by Kings Foods (Pvt) Limited of Sri Lanka (“Kings”) against trade mark registration 3541410 and trade mark application 3612136, both of which are in the name of a UK company called Anglo Asian Cash & Carry Limited (“Anglo Asian”).
2. The contested marks are shown below:

3541410



3612136



3. The application to register trade mark 3541410 was filed on 7th October 2020 (“the first relevant date”) and the mark was registered on 5th February 2021 in relation to

Curry powder; Curry spices in class 30. The application to register trade mark 3612136 was filed on 18th March 2021 (“the second relevant date”) and covers the same goods.

4. On 13th August 2021, Kings filed an application under section 47(2) of the Trade Marks Act 1994 (“the Act”) to invalidate trade mark registration 3541410. On 16th August, Kings filed a notice of opposition to application 3612136.

5. The grounds for invalidation/opposition are the same. Kings is the owner of the three earlier trade marks shown below:

Trade mark	Filing date	Goods
910364198 	24 th October 2011	Class 30: Spices and curry powder
918243297 	25 th May 2020	As above
918243305 	22 nd May 2020	As above

6. Kings claims that the contested marks are similar to the earlier trade marks and the respective goods are identical. According to Kings, there is a likelihood of confusion

on the part of the public. Therefore, registration of the contested marks was/would be contrary to section 5(2)(b) of the Act.

7. Kings claims that trade mark 910364198 has been used and has a reputation in the UK. According to Kings, use of the contested marks would, without due cause, take unfair advantage of, or be detrimental to, the reputation or distinctive character of the earlier mark. Therefore, registration of the contested marks was/would be contrary to section 5(3) of the Act.

8. Kings claims to have used trade mark 910364198 in the UK since 1992 and to have acquired goodwill under that mark (and the word 'KINGS' so far as contested trade mark registration 3541410 is concerned) in relation to *spices* and *curry powder*. According to Kings, use of the contested marks by Anglo Asian constitutes passing off. Therefore, registration of the contested marks was/would also be contrary to section 5(4)(a) of the Act.

9. Kings further claims that the applications to register the contested marks were filed in bad faith contrary to section 3(6) of the Act. The pleading in invalidation 504073 is as follows:¹

"The Registered Owner of the contested mark is a wholesaler and retailer of Asian groceries. The Applicant is a well known supplier of spices and curry powder to wholesalers and retailers in the UK. Moreover, the registered owner of the contested mark has in the past itself offered for sale the goods of the Applicant bearing the trade marks which are now relied on to object to this registration. It is therefore submitted that the registered owner had the Applicant's trade marks in mind and was targeting the Applicant's "trade mark and business space" when it filed the application to register its mark.

The bad faith of the Registered Owner is also apparent in the way that the registered owner has combined elements from all three of the registered trade marks of the Applicant, in ways which cannot reasonably be attributed to coincidence, to create a label which will confuse consumers into thinking that its goods are the goods of the Applicant. The Registered Owner has moreover

¹ The bad faith pleading in invalidation 426191 is very similar

applied for a further mark (No. 3612136) which is clearly closely derived from the Applicant's trade mark registered under number 910364198. This is a pattern of behaviour which shows that the registered owner has acted in bad faith and in full knowledge of the Applicant's earlier rights."

10. On the basis of these pleadings, Kings asks for trade mark registration registered under 3541410 to be declared invalid, and for trade mark application 3612136 to be refused.

11. Anglo Asian filed counterstatements denying the grounds advanced by Kings, including the claim that the applications were filed in bad faith. It also put Kings to proof of the use and reputation claimed for earlier trade mark 910364198.

12. Both sides seek an award of costs.

Representation and evidence

13. Anglo Asian is represented by Revomark, Trade Mark Attorneys. Kings is represented by Branded, also Trade Mark Attorneys.

14. Kings filed evidence in the form of witness statements by Candavanam Ranjan (with 6 exhibits), Erin Hyde and Alexander Thompson (each with 1 exhibit). Candavanam Ranjan is the Managing Director of Kings. He gives evidence about the use of the earlier marks relied on in these proceedings. Ms Hyde and Mr Alexander are Trade Mark Attorneys working for Branded. The purpose of their evidence is to show that Anglo Asian is a retailer of Kings' products.

15. Anglo Asian filed written submissions, but no evidence.

16. A hearing took place on 23rd June 2022 at which Kings was represented by Carin Burchell and Alexander Thompson of Branded. Anglo Asian decided not to appear or to be represented at the hearing.

The Section 5(2)(b) grounds

17. It is convenient to start by examining the grounds based on section 5(2)(b) of the Act, which 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”.

18. Earlier trade mark 910364198 had been registered for more than 5 years at the dates the applications to register the contested marks were filed, and at the date the application to invalidate trade mark 3541410 was filed. In accordance with sections 6A and 47(2A) – (2E) of the Act, Kings can only rely on this mark in these proceedings if it can show the mark was put to genuine use in the periods ending:

Opposition 426191: 5 years ending 18th March 2021;

Invalidation 504073: 5 years ending on 7th October 2020 and on 13th August 2021.

19. According to Candavanam Ranjan, Kings has exported curry powder to the UK since 1992 under the label mark registered as 910364198. Between 2016 and 2020, Kings sold its product to three UK importers. This claim is corroborated by copies of invoices Kings sent to its UK distributors in relation to supplies of curry powder.² Pictures of a flyer distributed in the UK in 2015/16 promoting curry powders under the mark are also in evidence.³ Total sales in 2016 were around £270k. In 2017, UK sales were around £340k. Sales declined to around £220k in 2018, before rising to around £265k in 2019, and further to £320k in 2020.

20. Candavanam Ranjan says that goods bearing the trade mark are sold in many Asian and Indian stores throughout England, Scotland and Wales. This is confirmed by letters from two of Kings’ UK distributors.⁴ Advertising is usually done by the distributors or by the stores selling the product. However, from March 2021 products bearing the mark were advertised in the UK on a private broadcast TV network called

² See exhibit CR1

³ See exhibit CR4

⁴ See exhibits CR2 and 3

Vijay TV. Candavanam Ranjan says this is the second most watched Tamil-language TV channel and very popular amongst communities of Asian and Indian origin.⁵

21. 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. That is why this decision continues to refer to retained EU trade mark law.

22. In *Walton International Ltd & Anor v Verweij Fashion BV*⁶ Arnold J (as he then was) 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 Kameradschaft ‘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].

⁵ See exhibit CR6

⁶ [2018] EWHC 1608 (Ch)

(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. In my view, Kings has shown that it made genuine use of the mark registered as 910364198 in relation to curry powder during each of the 5 year periods specified above. Having regard to sections 6A(6) and 47(2E) of the Act, I consider that the earlier mark is entitled to protection in relation to *curry powder and curry spices*. This is because that is how an average consumer would characterise the goods shown in the evidence.⁷

Global assessment of the likelihood of confusion

24. 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,

⁷ Per *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

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.

Identity of goods

24. The contested marks are applied-for, or registered, in relation to *curry powder*; *curry spices*. These are plainly the same goods for which I have found that earlier trade mark 910364198 (‘the ‘198 mark’) is entitled to protection. They are a sub-set of the goods for which the other two earlier marks are registered (Spices and curry powder). Consequently, these goods must also be considered to be identical to the goods covered by the contested marks on the so-called ‘inclusion’ principle.⁸

Average consumer and the selection process

25. In general, the goods at issue will be bought by ordinary members of the general public. Kings submits that a large number of such consumers will only speak English as a second language. It is suggested this means that they will pay more attention to the way the marks look rather than to the meaning of English word elements. I accept that a significant proportion of consumers of curry powder may have a first language which is other than English. I do not accept this means that such consumers will pay

⁸ See *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05

less attention to English words in trade marks used for such products compared to consumers whose first language is English.

26. Kings further submits that the goods at issue will be bought casually and quickly 'over the counter' or from an Asian foods website. In this respect, Kings suggests that curry powder can be likened to a bag of sweets, which is often cited as an example of the kind of products typically selected with a low degree of attention.

27. The evidence shows that the wholesale price of a 500g jar of curry powder is around £1.40. The retail price is therefore likely to be at least £2, and probably £3 or more. Further, curry powder is not an impulse purchase like sweets. Consequently, I do not accept that the level of attention typically given to the selection of curry powder can be likened to selecting a bag of sweets at (say) a check out. However, I accept that whilst being reasonably observant etc. the average consumer is unlikely to give the selection of curry powder a great deal of thought because these are routine purchases of relatively cheap consumable products. Therefore, in my view, average consumers are likely to pay a below-average degree of attention when selecting these goods. I accept that the goods are likely to be selected from shelves in a shop or from a food retailer's website. Either way, the selection process is likely to be mainly visual, with word-of-mouth orders/recommendations forming only a small part of the process.

28. Further, given that most average consumers tend to use curry powder in relatively small quantities, I consider it likely that most repeat purchases will take place weeks, if not months, apart.

Distinctive character of the earlier trade marks

29. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* 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).”

30. The ‘198 mark is a complex label-type trade mark. The descriptive words CURRY POWDER in red letters on a blue background with brown underlining are visually dominant. This is because of their relative size and central position. Although much less dominant in terms of size, the KFL logo and the word KINGS are also visible, and they are not descriptive. They are the most inherently distinctive elements of the ‘198 mark. The background comprised of pictures of spices and pepper pods in the colours dark red, browns and yellows also makes a more-than-negligible contribution to the overall visual impression created by the ‘198 mark. However, in the context of curry powders, such representations are (at least by themselves) inherently non-distinctive. This is because they represent the ingredients used to make curry powders and, as such, do not usually serve the purpose of identifying the trade source of such products. In my judgment, the ‘198 mark as a whole has a medium degree of inherent distinctiveness. The visual distinctiveness resides in the KFL logo, the word KINGS, and the graphic elements of the mark, including the prominent coloured ‘CURRY POWDER’ banner, and the colours and arrangement of powders, spices and pepper pods depicted in the pictorial background.

31. The KFL logo and the word KINGS are dominant and distinctive elements of trade mark 918243297 (“the ‘297 mark”). The red letters in foreign characters above these elements of the mark are also visually dominant. The yellow fan-like

background is not distinctive or dominant. In my view, the '297 mark has a medium degree of inherent distinctiveness.

32. The same applies to trade mark 918243305 ("the '305 mark").

33. The '198 mark appears on the front label applied to Kings' curry powder products. The '297 mark appears above it on the 'neck' of the jar. I was told that the '305 mark appears across the lid of the jar. Candavanam Ranjan's evidence is that a flyer depicting the product at issue was distributed to almost all Asian and Indian stores in the UK in 2015 and 2016. A copy of the flyer is in evidence.⁹ I can see the '297 mark on the neck of the jar depicted in this advertisement. The top of the jar is not clearly visible. Consequently, I cannot see the '305 mark in use. In any event, the '297 and '305 marks are plainly secondary marks to the '198 mark. They do not catch the eye as much as the '198 mark. In my view, the evidence does not establish that the '297 and '305 marks had acquired an enhanced degree of distinctiveness through use prior to the first or second relevant dates.

34. The evidence indicates that products bearing the '198 mark had been on the UK market for around 18/19 years prior to the relevant dates. Wholesale sales appear to have been steady at around £250k - £350k per annum. At around £1.40 for a typical jar, that represents roughly 180k – 250k unit sales per annum. There is no evidence as to the size of the UK market for curry powder, but I would expect this accounts for a small-but-not-insignificant share of the market. There is no evidence as to the amounts spent promoting the mark. I note that the TV advertising relied on by Kings only started around the second relevant date. Consequently, I attach no weight to that. Taking all these matters into account, I conclude that the distinctive character of the '198 mark had been modestly enhanced through the longstanding use made of it in the UK prior to the relevant dates. In my view, the '198 mark possessed an above average (although not the highest) degree of distinctive character at those dates. Further, I find that, by the relevant dates, the distinctive character of the earlier '198 mark was unlikely to have resided solely in the KFL and/or KINGS word elements of the mark. Rather, it resided in the mark as a whole, including the blue, red and brown

⁹ See exhibit CR4

banner carrying the words CURRY POWDER, and the coloured pictorial background depicting curry powders, spices and pods.

Comparison of marks

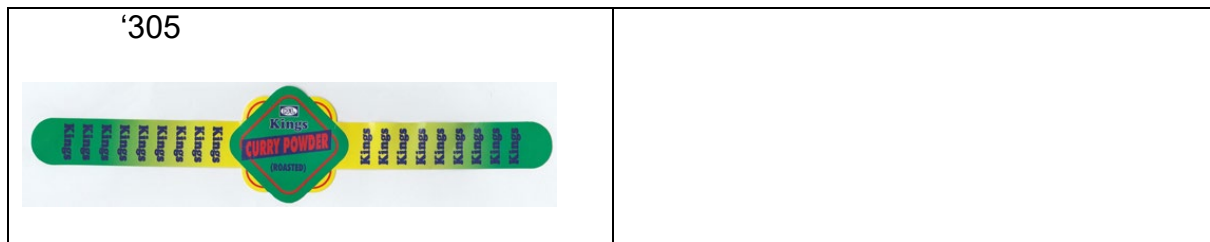
35. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM* that:

“.....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.”

36. It would be wrong, therefore, to dissect the trade marks artificially, 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.

37. Contested trade mark 3541414 and Kings’ earlier marks are show below:

Earlier trade marks	Contested trade mark
 <p>'297</p> 	



38. Kings submits that its best case is based on the earlier '198 mark. I agree. If Kings cannot succeed on the basis of the '198 mark it will be no better off basing its case on the '297 or '305 marks (individually). Therefore, I will limit my comparison to the '198 mark.

39. Anglo Asian submits that:

- (i) The contested mark consists of the words RISHANA KITCHEN KING CURRY POWDER ROASTED, the last three of which are descriptive;
- (ii) The distinctive element of contested mark 3541414 is therefore RISHANA KITCHEN KING, which is different to the distinctive element of the '198 mark, being KFL KINGS;
- (iii) The colours and get-up of the respective marks are also very different.

40. In my view, the word 'Rishana' is a minor element of contested mark 3541414. This is because it is a small and difficult to read element of a complex label-type mark, the most eye-catching features of which are the words KITCHEN KING, CURRY POWDER in red letters on a prominent yellow and brown banner, with a pictorial background of curry spices and powders in the colours dark red, browns, yellows with some green. I consider it likely that many average consumers would overlook the word Rishana altogether. Even if they notice and make out that word, it will play only a small part in the impression created by the contested mark as a whole.

41. The KFL logo in the '198 mark has no counterpart in contested mark 3541414. This will help to visually distinguish the marks, but not by much because the KFL logo is quite a small element of the '198 mark.

42. The words KITCHEN KING is similar to the word KINGS in the '198 mark, being the plural form of the second word in KITCHEN KING. The degree of similarity between

these elements is increased by the fact that the common word – KING(S) - appears in larger letters than the word KITCHEN in contested mark 3541414.

43. The banners bearing the words CURRY POWDER are also visually similar to the extent that (a) the words appear in red letters, (b) the banners slope upwards from left to right, (c) the word ‘roasted’ appears in yellow letters beneath the words CURRY POWDER, and (d) the banners have a brown section beneath the blue/yellow part. The banners differ in that (e) the main background colour is blue in the ‘198 mark, but yellow in the contested mark, and (f) the banner in the ‘198 mark does not extend across the whole mark, whereas the banner in the contested mark does.





44. I accept that the pictorial backgrounds depicting curry spices, powders and peppers are different, but the depiction of similar subjects and use of similar colours adds a certain degree of visual similarity between the marks as wholes.

45. Overall, I find contested mark 3541414 to be visually similar to a medium to high degree to the ‘198 mark.

46. I find that contested mark 3541414 is likely to be verbalised by average consumers as KITCHEN KING CURRY POWDER. This is because the word Rishana is such a minor (and difficult to read) part of the mark it is unlikely to be given oral expression. The ‘198 mark is likely to be verbalised as KFL KINGS CURRY POWDER. In my view, the common words KING(S) CURRY POWDER as the second to fourth words in these marks creates a medium degree of aural similarity between them, despite the clear difference in the (admittedly important) first element, i.e. KITCHEN v KFL.

47. Conceptually, the words KITCHEN KING create the idea of the ‘king of the kitchen’. The KFL element of the ‘198 mark has no concept. The words KINGS creates the idea of multiple kings. The general idea of a king or kings is common to both marks, but the specific meaning of a ‘king of the kitchen’ is conveyed only by the contested mark. I conclude that there is no immediately recognisable conceptual similarity between the marks, but neither is there a sharp conceptual difference.

48. Contested trade mark 3612136 and Kings' earlier marks are show below:

Earlier trade marks	Contested trade mark
<p>'198</p> 	
<p>'297</p> 	
<p>'305</p> 	

49. Kings again submits that its best case is based on the earlier '198 mark. I agree. If Kings cannot succeed on the basis of the '198 mark it will be no better off with the '297 or '305 marks (individually). Therefore, I will limit my comparison to the '198 mark.

50. Anglo Asian submits that 'Rishana' is the dominant and distinctive element of contested mark 3612136. According to Anglo Asian, this word is dissimilar to all the distinctive elements of the '198 mark, being the KFL logo and the word KINGS.

51. I accept that the word 'Rishana' is clearly visible in contested mark 3612136. I also accept that it is the most distinctive element of that mark. I agree that there is no similarity between Rishana and the KFL logo or the word KINGS. However, the most visually dominant element of the contested mark is the banner bearing the words CURRY POWDER in red letters on a mainly blue background. This banner bears a

striking resemblance to the one in the '198 mark: both have the same words in red and blue. In both cases there is a thinner brown section running below the blue section. Both banners slope upwards from left to right. Neither banner quite extends across the whole mark, both being inset into the background consisting of pictorial representations of curry spices and powders in the colours dark red, browns, yellows with some green. In my view, these striking similarities create a medium to high degree of overall visual similarity between the marks, despite the different word elements.

52. The contested mark is likely to be verbalised as RISHANA CURRY POWDER, whereas the '198 mark is likely to be verbalised as KFL KINGS CURRY POWDER. Therefore, the only aural similarity arises from the common use of the name of the product at issue, which by itself cannot be an important factor in my assessment of the likelihood of confusion.

53. I accept there is no conceptual similarity between these marks.

Likelihood of confusion

54. I will first assess the likelihood of confusion between contested trade mark 3541414 and Kings' earlier '198 mark.

55. In *New Look Limited v OHIM*,¹⁰ the General Court stated that:

“If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important.”

56. As noted earlier, the goods at issue are selected mainly by eye. The degree of visual similarity between the marks is therefore more important than the lower degree of aural (or conceptual) similarity between them.

¹⁰ Joined cases T-117/03 to T-119/03 and T-171/03, at paragraph 49 of the judgment. See also *Quelle AG v OHIM*, Case T-88/05.

57. Given the:

- (i) medium to high degree of visual similarity between the marks;
- (ii) above average degree of distinctive character of the earlier mark;
- (iii) identity of the goods;
- (iv) below average degree of attention paid by average consumers when selecting curry powders;
- (v) likely gap of weeks or months between repeat purchases of curry powders;

- I have no hesitation in finding that there is a likelihood of direct confusion as a result average consumers imperfectly recollecting earlier mark '198 and confusing it with the contested mark (or vice versa).

58. I turn next to the assessment of the likelihood of confusion between contested mark 3612136 and Kings' earlier '198 mark.

59. Anglo Asian relies on the difference between the distinctive letters and word elements of the respective marks, and the lack of distinctiveness of the dominant common words CURRY POWDER (for curry powders).

60. As regard the different distinctive letters/word elements, it is often said that, in general, words tend to make more impact on consumers than figurative elements in composite marks. However, this is a general observation, not a rigid rule. In *L&D SA v OHIM*¹¹ the CJEU dealt with an appeal on this ground alleging an error of law on the part of the EU's Court of First Instance.¹² The CJEU rejected this ground of appeal stating that:

"55. Furthermore, inasmuch as L & D further submits that the assessment of the Court of First Instance, according to which the silhouette of a fir tree plays a predominant role in the ARBRE MAGIQUE mark, diverges from the case-law of the Court of Justice, it need only be stated that, contrary to what the appellant

¹¹ [2008] E.T.M.R. 62

¹² Now called the General Court

61. In *Aceites del Sur-Coosur SA v OHIM*,¹³ the CJEU dealt with another appeal on similar grounds. The contested EU trade mark looked like this:



62. The earlier Spanish trade mark looked like this:



63. The applicant for the EU trade mark appealed the Court of First Instance's finding that the similar figurative elements were sufficient to find a likelihood of confusion, notwithstanding the different word elements. Part of the court's reasoning was that the average Spanish consumer of the goods at issue (olive oil) selected the goods mainly by eye and without paying a high degree of attention. The CJEU rejected the appeal, stating that:

¹³ Case C-498/07 P

“59. As regards the appellant’s arguments concerning the errors committed by the Court of First Instance in its investigation of the existence of a risk of confusion between the marks at issue, it must first be recalled that, as the Court of Justice has consistently held, the existence of such a likelihood of confusion on the part of the public must be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, to that effect, *SABEL*, paragraph 22; Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 18; order of 28 April 2004 in Case C-3/03 *P Matratzen Concord v OHIM* [2004] ECR I-3657, paragraph 28; Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 27; and Case C-334/05 *P OHIM v Shaker* [2007] ECR I-4529, paragraph 34).

60. According to further settled case-law, the global assessment of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (see *OHIM v Shaker*, paragraph 35 and the case-law cited).

61. In particular, the Court has held that in the context of examination of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29; and *OHIM v Shaker*, paragraph 41).

62. In that regard, the Court has also held that, according to established case-law, the overall impression created in the mind of the relevant public by a complex trade mark may, in certain circumstances, be dominated by one or more of its components. However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (*OHIM v Shaker*, paragraphs 41 and 42, and Case C-193/06 *P Nestlé v OHIM* [2007] ECR I-114, paragraphs 42 and 43 and the case-law cited).

63. *It is therefore in the light of those principles that the second part of the second ground put forward by the appellant in support of its appeal should be examined.*

64. *In that regard, it must be observed that, in the judgment under appeal, the Court of First Instance first held, at paragraphs 88 to 90 of that judgment, that the Board of Appeal was wrong to state that the word element of the marks at issue was of overriding importance in the light of the weak distinctive character of the figurative elements of those marks.*

65. *By contrast, the Court of First Instance afforded overriding importance to the figurative element by stating clearly at paragraph 91 of the judgment under appeal that that element held a more important position, in terms of surface, than the word element, thus making it subsidiary in relation to the figurative element. According to paragraph 109 of that judgment, it was that figurative element which, in the particular circumstances in which the goods at issue were sold, acquired greater importance.*

66. *The Court of First Instance thus attributed to the figurative element of the marks at issue the character of a dominant element in relation to the other elements comprising those marks, in particular the word element. That enabled it correctly to base its assessment on the similarity of the signs and on the existence of a likelihood of confusion between the marks La Española and Carbonell by giving the visual comparison of those signs an essential character.*

67. *Contrary to what the appellant contends, such an approach did not, however, mean that the Court of First Instance took no account of the impact of the word element.*

68. *Thus, having made a detailed comparative assessment of the marks at issue from a visual point of view at paragraph 100 of the judgment under appeal, the Court then held, at paragraphs 103 and 104 of that judgment, that the elements common to the two marks, seen as a whole, produced an overall visual impression of great similarity, since the La Española mark reproduced very precisely the essence of the message and the visual impression given by*

the Carbonell mark, thus inescapably giving rise to a likelihood of confusion on the part of the consumer between those marks.

69. The Court of First Instance lastly held, at paragraphs 105 and 111 of the judgment under appeal, that such a likelihood of confusion is not diminished by the existence of the different word element, in view of the latter's very weak distinctive character in relation to the mark in respect of which registration was sought, which refers to the geographical origin of the goods.

70. In other words, whilst considering the figurative element of those marks as a dominant element in relation to the other elements of which they are comprised, the Court of First Instance did not fail to take the word element into account. On the contrary, it is precisely in the context of the assessment of that element that the Court of First Instance described it essentially as negligible, on the ground, in particular, that the differences between the word signs of the marks at issue do not invalidate the conclusion it reached after the comparative examination of those marks from the visual point of view.

71. The conclusion must therefore be drawn that in this case, contrary to what the appellant claims, the Court of First Instance correctly applied the rule that a global assessment should be undertaken, as laid down in the Community case-law referred to in paragraphs 59 to 62 above, when determining whether a likelihood of confusion exists between the marks at issue.

72. Consequently, it cannot be claimed, as the appellant does, that the Court of First Instance, far from complying with that case-law, distorted the facts and evidence in the file.

73. Also, with regard to the appellant's argument challenging the description of the Spanish consumer of olive oil given by the Court of First Instance, it must be stated first of all that the latter's assessment in that regard complies with the settled case-law of the Court of Justice on that subject.

74. Thus, as the Court of First Instance rightly noted at paragraph 107 of the judgment under appeal, the perception of marks in the mind of the average

consumer of the goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion (SABEL, paragraph 23, and Lloyd Schuhfabrik Meyer, paragraph 25) and, for the purposes of that global appreciation, the average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect, but his level of attention is likely to vary according to the category of goods or services in question (Lloyd Schuhfabrik Meyer, paragraph 26).

75. In the light of those principles, the Court of First Instance held in particular, at paragraphs 108 and 109 of the judgment under that appeal, that olive oil is a consumer product which is very common in Spain, that it is most commonly purchased in supermarkets or establishments where goods are arranged on shelves and that the consumer is guided more by the visual impact of the mark he is looking for.

76. The Court of First Instance was therefore right to conclude from this, at paragraphs 109 and 110 of the judgment under appeal, that in those circumstances the figurative element of the marks at issue acquires greater importance, which increases the likelihood of confusion between them, and the differences between the signs at issue are more difficult to distinguish since, as the Court of Justice has moreover had occasion to observe (see, to that effect, OHIM v Shaker, paragraph 35, and Nestlé v OHIM, paragraph 34 and the case-law cited), the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.”

64. It is clear from these cases that in appropriate circumstances, the inclusion of wholly different word or letter elements in composite marks is not necessarily sufficient to rule out a likelihood of confusion. Admittedly, the fact that the word element of one of the marks at issue in the second case cited above (La Espanola) was likely to be regarded as descriptive by Spanish speakers does not apply here. However, that point does not undermine the CJEU's general reiteration of its case-law to the effect that, unless negligible, all the elements of the respective marks must be considered and given appropriate weight in the global assessment of the likelihood of confusion.

65. As regards Anglo Asian's argument that the common (and dominant) words CURRY POWDER are purely descriptive, I would have no hesitation in accepting that argument if the common element in the marks was limited to the mere presence of those words. However, for the reasons given in paragraph 51 above, the similarities between the presentation of those words on a banner set against a similar figurative background go well beyond the common use of the words CURRY POWDER. The similarities include distinctive elements of the earlier mark as described in paragraph 34 above.

66. Comparing contested mark 3612136 and Kings' earlier '198 marks as wholes, I find that, for the same reasons given in paragraph 57 above, there is a likelihood of direct confusion through imperfect recollection.

67. It follows that the section 5(2)(b) based grounds of invalidation/opposition succeed in full against trade mark registration 3541414 and application 3612136. The invalidation application and the opposition therefore succeed.

Approach to the other section 5 grounds of invalidation/opposition

68. The success of the section 5(2)(b) based grounds means there is no absolute need to address Kings' further grounds for invalidation/opposition. However, in case I am wrong about the success of the section 5(2)(b) grounds, I will examine the other section 5 based grounds briefly to see if any of them would succeed independently of the section 5(2)(b) grounds.

69. In keeping with this purpose, I will approach the remaining section 5 grounds on the footing that (contrary to my primary findings) there is no likelihood of confusion between the 3541414 and 3612136 marks and any of the earlier trade marks relied on by Kings.

The Section 5(4)(a) grounds

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

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

71. Section 5(4A) states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

72. In *Discount Outlet v Feel Good UK*,¹⁴ Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per Interflora Inc v Marks and Spencer Plc [2012] EWCA Civ 1501, [2013] FSR 21).”

¹⁴ [2017] EWHC 1400 IPEC

73. At the hearing, I asked Kings' representatives how the section 5(4)(a) grounds improved Kings' case compared to the grounds based on section 5(2) of the Act. The goods at issue are identical. If my primary findings are correct, it is likely that use of the contested marks amounts to a damaging misrepresentation, i.e. to passing off. If, on the other hand, there is no likelihood of confusion, it seems very unlikely that use of the contested marks could deceive a substantial number of Kings' customers or potential customers. In that case there would be no misrepresentation and, therefore, no passing off right.

74. I was told that Kings' case may be stronger under section 5(4)(a) of the Act because under the law of passing off, Kings can rely on the similarities between the contested marks and (collectively) all three of the signs which Kings' says are distinctive of its goodwill; being the '198, '297 and '305 registered marks. By contrast, Kings accepts that for the purposes of section 5(2), the comparison with the earlier marks must be based on a one-at-a-time mark to mark comparison.

75. In my view, the comparison of marks required under section 5(2) may not be limited in the way Kings believes. In *Il Ponte Finanziaria SpA v OHIM*,¹⁵ the CJEU accepted that a likelihood of confusion may be established on the basis of a comparison between the contested trade mark and a 'family' of (used) earlier marks in the same ownership with a common distinctive element. It is true that the situation here is different. Kings accuses Anglo Asian of copying different colours from the get-up of each of the three of the signs it uses in order to add to the likelihood of confusion. Given that (a) the EU Trade Marks Directive on which section 5(2) of the Act is based was intended to harmonise trade mark law in the EU, (b) the conditions for establishing a likelihood of confusion are an important part of trade mark law, and (c) the CJEU has already accepted that, in at least one circumstance, it is appropriate to compare the contested mark with a number of earlier marks together, I do not think it can be ruled out that section 5(2) may allow for the sort of comparison with multiple earlier marks that Kings asked me to conduct for the purposes of its section 5(4)(a) grounds.

76. I accept that a comparison between the contested marks and several earlier distinctive signs together is permissible to establish misrepresentation for the

¹⁵ Case C-234/06

purposes of passing off law. However, it is not possible for Kings to ask for such a comparison on this occasion. This is because Kings' pleadings under section 5(4)(a) are based (only) on the use of sign registered as the '198 mark and, so far as contested trade mark registration 3541410 is concerned, the word 'KINGS' alone. Kings' pleadings under section 5(4)(a) do not cover the marks registered as '297 or '305. Consequently, it was not open to Kings to ask me at the hearing to make my assessment of the likelihood of deception and misrepresentation partly based on the similarities of colour between the contested marks and the '297 and '305 marks.

77. I conclude that Kings' case under section 5(4)(a) adds nothing to the case it has made out under section 5(2)(b). Therefore, if I am wrong about there being a likelihood of confusion between the contested marks and the earlier '198 mark, the passing off right case would also fail.

The Section 5(3) grounds

78. At the second relevant date, section 5(3) was as follows:¹⁶

“(3) A trade mark which-

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 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.”

79. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

¹⁶ At the first relevant date, the section referred to earlier EU marks (as 910364198 was at that time) having a reputation in the EU. However, nothing turns on this difference because, according to the case law of the CJEU, a reputation in the EU can be based on a reputation in a single Member State (as the UK was being treated at the time)

- (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

Reputation

80. Based on the facts set out in paragraph 34 above, I am prepared to accept that the '198 mark had a qualifying reputation in the UK at the relevant dates.

Link

81. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

82. I earlier found that there is a medium to high degree of visual similarity between the contested marks and the '198 mark, and a medium degree of aural similarity between the '198 mark and contested mark 3541410. There is no strong conceptual similarity (or sharp difference) between the '198 mark and the contested marks.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

83. The goods are identical. They are relatively low cost consumable products. The relevant public is comprised mostly of the general public who are likely to pay a below average level of attention when selecting the products through mainly visual means.

The strength of the earlier mark's reputation

84. On the evidence provided, I find that the earlier '198 mark had a modest reputation in the UK/EU at the relevant dates in relation to curry powders. The reputation was likely to have been concentrated amongst users of Indian and Asian food shops and associated websites.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

85. The earlier mark is inherently distinctive to a medium or average degree, but had acquired an above-average degree of distinctiveness by the relevant dates. This enhanced distinctive character resided in the word KINGS, the KFL logo, and the graphic elements of the mark, including the prominent red/blue/brown coloured 'CURRY POWDER' banner, as well as the colours and arrangement of powders and spices depicted in the pictorial background.

Whether there is a likelihood of confusion

86. My primary findings are that there is a likelihood of confusion with both the contested marks. However, in keeping with my limited purpose of examining Kings'

other section 5 grounds only to see if they provide an alternative basis for refusal, I shall approach this comparison on the footing that there is no likelihood of confusion.

Conclusion – link

87. In my view, the degree of similarity between the marks is sufficient to cause a significant proportion of average consumers of goods marketed under the contested marks to (at least) bring the ‘198 mark to mind. This is sufficient to establish the required link.

Unfair advantage

88. Confusion aside, Kings’ case is that:

“[Anglo Asian] stands to gain consumer trust by applying a label to packaging which mimics that of [Kings], who has built up a considerable reputation in its trade mark in the UK.”

89. In my view, using a look-alike label-type trade mark to convey the message that a competitor’s new product has the same characteristics as an established product with which consumers are familiar and have learned to trust, may constitute taking advantage of the reputation or distinctive character of the earlier trade mark. This is because the use of the look-alike mark is liable to transfer the image of the earlier mark to the new mark and thus make it easier for the competitor to sell its products. The look-alike mark thereby takes a ‘free ride’ on the reputation and distinctive character of the senior mark.

90. In *Jack Wills Limited v House of Fraser (Stores) Limited*¹⁷ Arnold J. (as he then was) considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant’s intention. It is clear both from the wording of Article 5(2) of the Directive and

¹⁷ [2014] EWHC 110 (Ch)

Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

91. Therefore, although not necessary, an intention to take advantage of the earlier mark is a relevant factor in the assessment of whether the advantage gained by Anglo Asian should be regarded as unfair. Kings submits that Anglo Asian adopted the contested marks with the intention of taking advantage of the reputation and distinctive character of the '198 mark. In this connection, Kings points to:

- (i) the prominent use of the word KING in contested mark 3541410;
- (ii) the use of a central banner for the words CURRY POWDER in both the contested marks;
- (iii) the use of almost identical colours and arrangement for that element of contested mark 3612136;
- (iv) the use of a similar arrangement and colours drawn from the '198, and '297 marks for the banner in contested mark 3541410;
- (v) the use of colours drawn from the '305 mark for the KITCHEN KING logo in contested mark 3541410;
- (vi) the use a pictorial background in both contested marks showing curry spices and powders in similar colours dark red, browns, yellows with some green;

(vii) evidence showing that (albeit in June 2021, i.e. after the relevant dates) Anglo Asian marketed Kings' curry powder product, indicating that it was familiar with the earlier mark.

92. Some of these points depend on Anglo Asian having copied aspects of the '297 and '305 marks, whereas Kings' section 5(3) case is based on the '198 mark. It is therefore necessary to consider whether Kings can ask for matters extraneous to the '198 mark to be taken into account in my assessment of whether Anglo Asian intended to take advantage of the reputation of the '198 mark.

93. In *The Coca Cola Company v OHIM and Another*¹⁸ the General Court held that:

“.....a finding of a risk of free-riding made on the basis of Article 8(5) of Regulation No 207/2009 may be established, in particular, on the basis of logical deductions resulting from an analysis of the probabilities and by taking account of the usual practices in the relevant commercial sector as well as all the other circumstances of the case, including the use, by the proprietor of the mark applied for, of packaging similar to that of the goods of the proprietor of the earlier trade marks. That case-law therefore in no way limits to the mark applied for the relevant evidence to be taken into consideration for the purposes of establishing a risk of free-riding (the risk that unfair advantage will be taken of the distinctive character or the repute of the earlier trade marks), but allows account also to be taken of any evidence intended to facilitate that analysis of the probabilities as regards the intentions of the proprietor of the trade mark applied for, and — a fortiori — any evidence relating to the actual commercial use of the mark applied for.” (emphasis added)

94. Therefore, in my view, Kings is entitled to ask me to take account of all the surrounding circumstances in making my assessment as to whether Anglo Asian adopted the contested marks with the intention of taking advantage of the reputation of, inter alia, the '198 mark.

¹⁸ Case T-480/12. See also the later judgment of the General court in the same case, T-61/16

95. In my judgement, the matters set out in paragraph 91 above are sufficient to raise a *prima facie* case that Anglo Asian adopted the contested marks with the intention of taking advantage of the reputation or distinctive character of the '198 mark.

96. Anglo Asian denies Kings' pleaded case, but it has chosen to file no evidence. Consequently, there is no evidence setting out who, or why, Anglo Asian adopted the contested marks. It follows that Anglo Asian has not rebutted Kings' *prima facie* case of intent, or shown that it has 'due cause' to use the marks. In these circumstances, I find that (a) use of the contested marks would take advantage of the reputation and distinctive character of the '198 mark, (b) this is likely to be Anglo Asian's intention, and (c) use of the contested marks would, therefore, take unfair advantage of the reputation and distinctive character of the '198 mark.

97. The section 5(3) grounds therefore succeed, even if the section 5(2)(b) grounds fail.

98. Having decided that the section 5(3) grounds succeed on the basis of unfair advantage, I see no need to address Kings' alternative section 5(3) grounds based on detriment to reputation and distinctive character.

Bad faith

99. Section 3(6) of the Act states:

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

100. Kings' pleaded case is set out in paragraph 9 above.

101. Anglo Asian filed a blanket denial of all the grounds of invalidation/opposition, but it did not specifically deny that it knew about the earlier trade marks relied on by Kings when it filed applications to register the contested marks. Kings' evidence shows that Anglo Asian was marketing curry powders bearing the earlier marks in June 2021, just three months after the second relevant date. Kings' product had been present on the UK market for nearly 20 years by this time. In these circumstances, I am prepared to

infer that Anglo Asian was familiar with the Kings earlier marks when it applied to register the contested marks.

102. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*,¹⁹ the Court of Appeal summarised the relevant CJEU case law as follows:

1. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin.
2. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices.
3. The date for assessment of bad faith is the time of filing the application.
4. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved.
5. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application.
6. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case.

¹⁹ [2021] EWCA Civ 1121

7. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

103. On the basis of my findings above, there is a *prima facie* case that Anglo Asian's intention was to adopt similar marks to those established by Kings. This was either to confuse consumers into thinking that the products sold under those marks were Kings' products, or to represent its goods as equivalent to Kings' products so as to feed off the reputation of the earlier marks.

104. This is enough to raise a rebuttable presumption of a lack of good faith. It was for Anglo Asian to file evidence to answer this *prima facie* case, which it has not done. Consequently, if I am correct about the section 5(2) or 5(3) grounds, the bad faith grounds would also have succeeded. However, if I am wrong about those grounds succeeding, the bad faith ground would fail. This is because there would then be no basis for presuming a lack of good faith, and therefore no *prima facie* case of bad faith for Anglo Asian to rebut.

Overall outcome

105. The application to invalidate trade mark 3541410 succeeds. The opposition to trade mark application 3612136 also succeeds.

Costs

106. Kings has been successful and is entitled to a contribution towards its costs. I assess these as follows:

£500 for filing an application for invalidation and a notice of opposition;

£400 official fees for forms TM26(I) and TM7;

£1200 for filing evidence;

£800 for attending a hearing and preparing a skeleton argument.

107. I therefore order Anglo Asian Cash & Carry Limited to pay Kings Foods (Pvt) Limited the sum of £2900. The above sum should be paid within twenty-one days of

the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated 23rd day of August 2022

**Allan James
For the Registrar**