

**O/825/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION  
NO. 03641878 BY  
EVEREST DAIRIES LTD  
TO REGISTER THE TRADE MARK:**

**EVEREST**

**IN CLASSES 29 & 30**

**AND**

**OPPOSITION THERETO  
UNDER NO. 427568  
BY  
EVEREST FOOD PRODUCTS  
PRIVATE LIMITED**

## BACKGROUND & PLEADINGS

1. Everest Dairies Ltd (“**the applicant**”), applied to register the trade mark shown on the front page of this decision in the United Kingdom on 14 May 2021. It was accepted and published in the Trade Marks Journal on 16 July 2021. On 18 December 2021, the applicant filed a Form TM21B, which was published on 04 January 2022, amending its specification to read as follows:

**Class 29:** Yogurt; coffee whiteners consisting principally of dairy products; cream [dairy products]; creams containing dairy products; dairy desserts; dairy food being wholly or substantially wholly of fromage frais; dairy produce; dairy produce containing nuts; dairy products; dairy products being half cream and half milk; dairy products containing milk; dairy products containing or flavoured with custard; dairy products containing or flavoured with fruit; dairy products flavoured with cheese; dairy products for foods; dairy products for making milk shakes; dairy products having a soft consistency; dairy products in powder form; dairy products made from goats' milk; dairy puddings; dairy spreads; dairy substances for use as food or as ingredients for food; desserts made wholly or principally of dairy products; drinks made from dairy products; flavoured dairy desserts in the form of mousse layered onto flavoured sauce; food products made from a mixture of dairy products and of edible oils; food spreads consisting principally of dairy products; foodstuffs containing dairy products [as the main constituent]; fruit based dairy products; low fat dairy spreads; preparations for creaming coffee [dairy products]; preparations for use in creaming beverages [dairy based]; preparations for use in creaming coffee [dairy based]; preparations for use in creaming tea [dairy based]; preparations for use in whitening coffee [dairy based]; protein derived from soya beans for use as substitutes for dairy products; spreads consisting wholly or principally of dairy products; spreads made from dairy products; whiteners [dairy]

for beverages; blended cheese; butter cheeses; cheese; cheese products; cheese spreads; cheese sticks; cheese wedges; combinations of cheese and fruit; combinations of cheese and meat; combinations of cheese and vegetables; cottage cheese; cottage cheese preparations; cream cheese; curd cheese; dairy products flavoured with cheese; foodstuffs flavoured with cheese [cheese predominating]; fresh cheese; imitation cheese; imitation cheese made from soya and casein; low fat cheese; preparations of cottage cheese; prepared foods consisting principally of cheese; prepared meals made principally of cheese; processed cheese; processed cheese products; ready grated cheese; savouries consisting of cheese; soft cheese; soft cheese preparations; toppings (Cheese) for pizzas; snack food (fruit-based).

**Class 30:** Frozen yoghurt [confectionery ices]; frozen confectionery; frozen dairy confections; confectionery in frozen form.

2. EVEREST FOOD PRODUCTS PRIVATE LIMITED (“**the opponent**”) opposes the application on the basis of Sections 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The opponent is the proprietor of the following marks:

<b>Trade Mark no.</b>	UK00909247065 ('065) <sup>1</sup>
<b>Trade Mark</b>	
<b>Goods</b>	Classes 3, 29 & 30
<b>Relevant Dates</b>	Filing date: 14 July 2010
	Date of entry in register: 27 December 2010

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<sup>1</sup> The trade mark relied upon by the opponent is a ‘comparable’ trade mark. It is based on the opponent’s earlier EUTM, being registration number 09247065. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM.

<b>Trade Mark no.</b>	UK00002215357 ('357)
<b>Trade Mark</b>	EVEREST MASALA'S
<b>Goods</b>	Classes 29 & 30
<b>Relevant Dates</b>	Filing date: 22 December 1999
	Date of entry in register: 23 June 2000

3. For the purpose of this opposition, the opponent relies on some goods in Class 30 for the first and the second earlier mark, as follows:

**Class 30:** Spices.

4. In its notice of opposition, the opponent argues that the competing marks are identical under Section 5(2)(a) or highly similar under Section 5(2)(b). Further, it claims that the contested goods in Classes 29 and 30 “are complementary and highly similar” to the opponent’s goods “spices”.
5. In response, the applicant filed a counterstatement, denying all the grounds and any likelihood of confusion between the marks. Moreover, the applicant puts forward that “the Applicant submitted a TM21B to amend the specification to ensure that it only covers dairy related products. As such the goods are not similar and would not be confused by the end user.” Therefore, the applicant requests that the opponent provides proof of use of its earlier marks relied upon.
6. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that I consider necessary.
7. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.
8. In these proceedings, the opponent is represented by Withers & Rogers LLP and the applicant by Serjeants LLP.

9. 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 Trade Marks Act relied on 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.

### **Relevant Date/Period**

10. An “earlier trade mark” is defined in Section 6(1) of the Act:

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

- (a) a registered trade mark, international trade mark (UK) or European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

[...]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered. [...]

11. As the earlier marks relied upon had been registered for more than five years on the date on which the contested application was filed, Section 6A of the Act applies, which states:

“(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), (aa) 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)-(5A) [Repealed]

(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.”

12. As the earlier mark ‘065 is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union”.

13. In accordance with Section 6(1) of the Act, the opponent’s trade marks clearly qualify as earlier marks. The relevant period for proof of use of the opponent’s marks is **15 May 2016 to 14 May 2021**. I note that the opponent in its witness statement and submissions erroneously stated a slightly different period. In the present proceedings, the opponent also relies on the UK comparable mark ‘065, and, thus, it is possible for the opponent to rely on evidence of use in the EU as set out in Tribunal Practice Notice 2/2020.<sup>2</sup> In accordance with paragraph 7(3) of Part 1 of Schedule 2A of the Act, the assessment of use shall take into account any use of the corresponding EUTM prior to IP Completion Day, being 31 December 2020. Therefore, for the portion of the relevant five year period between **15 May 2016 and 31 December 2020**, evidence of use of the mark in the EU may be taken into account.
14. The relevant date for the assessment of likelihood of confusion as per Section 5(2)(b) is the date on which the contested application was filed, namely **14 May 2021**.

## **EVIDENCE**

### **Opponent’s Evidence**

15. The opponent’s evidence consists of witness statements by Sailesh Shah, who is the General Manager of Everest Food Products Private Limited, a position they have held since 1990. The main purpose of the evidence is to demonstrate that the earlier marks have been genuinely used in the UK for the relevant period.

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<sup>2</sup> See ‘Tribunal Practice Notice (2/2020) End of Transition Period – impact on tribunal proceedings’.



16. I have read and considered all of the evidence and will refer to the relevant parts at the appropriate points in the decision.

## DECISION

### Proof of Use

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

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

18. As the earlier mark ‘065 is a comparable mark, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11 are also relevant. The court noted that:

“36.It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all

consideration of whether a Community trade mark has been put to genuine use. [...]

50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark. [...]

55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

19. The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity."

20. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since *Leno* and concluded as follows:

"228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination,

however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]- [40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multifactorial one which includes the geographical extent of the use."

21. The General Court restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an

area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

22. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- i. The scale and frequency of the use shown
- ii. The nature of the use shown
- iii. The goods and services for which use has been shown
- iv. The nature of those goods/services and the market(s) for them
- v. The geographical extent of the use shown

23. The onus is on the proprietor of the earlier mark to show use. This is in accordance with Section 100 of the Act, which states:

“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.”

24. Proven use of a mark which fails to establish that “the commercial exploitation of the marks 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 Marks

25. In Case C-12/12 *Colloseum Holdings AG v Levi Strauss & Co.*, which concerned the use of one mark with, or as part of, another mark, 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 *Nestlé*, 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 by 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)

26. Where the issue is whether the use of a mark in a different form, rather than with, or as part of, another mark, constitutes genuine use of the mark as registered, the decision of Mr Richard Arnold QC (as he then was), sitting as the Appointed Person, in *Nirvana Trade Mark*, BL O/262/06, is relevant. He said:

"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."

27. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU\*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of

the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

28. There are examples of use of the earlier figurative mark ‘065 in the evidence, such as invoices and packaging of the goods, within the relevant period. It is claimed that there is use of the word mark ‘357 (“EVEREST MASALA’S”) in the following exemplified forms:



29. The distinctive character of the opponent’s word mark lies in the words “EVEREST MASALA’S” as a whole. As seen in ‘a’ above, the word element “EVEREST” appears at the top in a white upper-case font with a red background, whilst the rest of the word elements are in different colour and capitalised font. I note such variations in colour, case, and font are within the confines of fair and notional use. Also, there is additional matter in the marks, namely Tandoori Chicken or Egg Curry, as shown in ‘a-b’, preceding the word “MASALA”. I consider this matter is merely descriptive, qualifying the word “MASALA”. In addition, I note that the word “MASALA” is not presented in its possessive form, but its omission is not a material change that would alter the distinctive character of the mark. As per *Lactalis McLelland Limited*, I consider that use of the mark in ‘a-b’ forms shown above does not alter the distinctive character of the mark as registered and, as such, is an acceptable variant.

## Genuine Use

30. As indicated in the case law cited above, use does not need to be quantitatively significant to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded 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”.
31. The witness statement of Sailesh Shah provides screenshots of awards won throuout the years,<sup>3</sup> although it is not clear how known they are among UK consumers. Further, an unchallenged annual breakdown of the worldwide sales figures relating to goods sold under the earlier marks is provided with the witness statement. This is as follows:

<b>Financial Year</b>	<b>Approx. Sales Value (Rupees)</b>	<b>Approx. Sales Value (GBP)</b>
2010 - 2011	3,814,000,000	37,842,200
2011 - 2012	51,642,000,000	512,387,756
2012 - 2013	54,393,000,000	539,682,956
2013 - 2014	72,525,000,000	719,587,197
2014 - 2015	95,389,000,000	946,441,960
2015 - 2016	118,809,000,000	1,178,813,310
2016 - 2017	135,301,000,000	1,342,445,603
2017 - 2018	145,913,000,000	1,447,737,010
2018 - 2019	174,319,000,000	1,729,579,050
2019 - 2020	190,553,000,000	1,890,651,488
2020 - 2021	218,077,000,000	2,163,742,395

I note that the second table, as shown below, provides the sales figures from 2020-2022 covering the sales in the UK, which exceed £62,000 (converted from Rupees).

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<sup>3</sup> Exhibit SS01.

Financial Year	Approx. Sales Value (Rupees)	Approx. Sales Value (GBP)
2020 - 2021	3,106,115	31,428
2021 - 2022	3,050,585	30,866

Although the figures in the first table above do not differentiate between the first and the second earlier marks and the sales per country, they begin at over £1 billion in 2015-2016, steadily increasing over the years to over £2 billion in 2020-2021. Whilst the 2015-2016 and 2020-2021 figures include turnover falling outside (pre-dating or post-dating) the relevant timeframe, it is reasonable to assume from the previous annual figures that at least a portion of the turnover, and sales of the goods in that respect, will fall within the relevant time period.

32. In addition to the above figures, a set of invoices<sup>4</sup> addressed to London and Harlow, UK, shows sales of various quantities of a range of products, such as, Everest tandoori chicken masala, garam masala, rasam powder, curry powder, jaljira powder, etc., under the earlier marks. However, I identify that only two invoices, dated 15 April 2021 and 3 May 2021, fall within the relevant period, while the rest either pre- or post-date the relevant period. I note that these invoices demonstrate sales of a number of goods bearing the mark, with the total amount of both invoices exceeding the amount of \$84,000. Admittedly, the UK spices market is a considerable one, and even though the opponent did not provide any evidence as to the market share it possesses, I am satisfied that this evidence supports that the opponent has operated in a way aimed at real commercial exploitation and has done so for a number of years.
33. Further to the sales figures, as demonstrated below, screenshots of computer aided designs for packaging,<sup>5</sup> dated 13 and 15 June 2020, are

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<sup>4</sup> Exhibit SS02.

<sup>5</sup> Exhibit SS03.



34. In addition to the above, the opponent adduced undated photographs showing a wide range of its products on shelves in UK retail outlets with the forms I have already identified in the previous section targeting UK consumers.<sup>6</sup>

35. Whilst the opponent exhibited evidence of adverts,<sup>7</sup> namely screenshots from its YouTube channel, where the earlier marks were clearly referenced

<sup>6</sup> Exhibit SS04.

<sup>7</sup> Exhibit SS05.

in the thumbnails of the videos, I note that the screenshots are undated, and there is no indication that the content relates to customers based in the UK. Further, there are screenshots, with a print date of 9 April 2022, taken from the opponent's website *everestfoods.com/*, Facebook account, and the UK Amazon online store showing a range of goods (the majority of which are labelled as 'Blended Spices') and/or promotional posts. Likewise, screenshots with a print date of 24 March 2022 taken from the websites *agnifoods.co.uk* and *ahabazaar.co.uk* demonstrating a wide range of products. As shown below, a sample of promotional material is exhibited,<sup>8</sup> which is dated 6 February 2014.

**for best quality spices.**

ORDINARY Turmeric Powder	EVEREST Turmeric Powder
1 Pale colour	Rich golden yellow colour
2 Poor aroma	Fresh aroma
3 Bland flavour	Robust flavour
4 Purity?	100% purity

Everest maintains the high quality of its spices at every step - 1. Everest hand picks pure spices from the best sources. 2. They are ground in the latest technology. 3. They are scientifically packed to keep the goodness of nature fresh in every grain. So choose the best. Choose Everest.

MRP ₹ 20 for 100 gm Pouch

**EVEREST**  
**Turmeric**

Lastly, the opponent produced annual figures in relation to worldwide marketing expenditure for television and commercial advertisements as follows:

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<sup>8</sup> Exhibit SS07.

Financial Year	Approx. Expenditure (Rupees)	Approx. Expenditure (GBP)
2010 - 2011	1,077,000,000	10,695,078
2011 - 2012	2,005,000,000	19,910,522
2012 - 2013	2,069,000,000	20,546,070
2013 - 2014	2,472,000,000	24,548,035
2014 - 2015	2,941,000,000	29,205,409
2015 - 2016	2,848,000,000	28,281,878
2016 - 2017	3,924,000,000	38,967,026
2017 - 2018	5,080,000,000	50,446,609
2018 - 2019	6,184,000,000	61,409,810
2019 - 2020	6,820,000,000	67,725,566
2020 - 2021	3,032,000,000	30,109,078

36. Although the evidence could have been better and more comprehensive in parts, an assessment of genuine use is a global assessment, which requires looking at the evidential picture as a whole and not whether each individual piece of evidence shows use by itself.<sup>9</sup> Bearing in mind the two different marks and the forms of the marks I have said may be considered, I am satisfied that the evidence supports genuine use in the UK of the marks during the relevant period. As such, the opponent can rely upon the registered marks for the purpose of these proceedings.

#### Fair specification

37. The goods relied upon are “*spices*” in Class 30 for which the opponent made a statement of use. The applicant has not commented upon the specific goods they believe the earlier marks have, or have not, been used, nor what a fair specification should be. I recognise that the goods for which the marks have been used are different sorts of spices as described in the evidence. In addition, “EVEREST” is described in the opponent’s evidence and witness statement as “India’s largest selling brand for spices”. Given that the use shown covers a large number of different types of spices, for example, various types of masala, as well as chilly, ginger and rasam powder, I am content to conclude that when confronted with the wide range

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<sup>9</sup> See *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09.



of use shown, the average consumer would fairly categorise it as being for spices, and they would not seek to interpret it by using narrower terms.<sup>10</sup> Therefore, I accept that the opponent has shown use for its broad term “spices” in Class 30.

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

38. The relevant statutory provisions are as follows:

Section 5(2)(b) of the Act states:

“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.”

39. The principles, considered in this opposition, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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<sup>10</sup> *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch).

- 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 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**

40. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

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

41. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- “(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.”

42. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

43. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way

that customers may think that the responsibility for those goods lies with the same undertaking.”

44. The competing goods to be compared are shown in the following table:

Opponent's Goods Earlier Marks '357 & '065	Applicant's Goods
<p><b>Class 30:</b> spices.</p>	<p><b>Class 29:</b> Yogurt; coffee whiteners consisting principally of dairy products; cream [dairy products]; creams containing dairy products; dairy desserts; dairy food being wholly or substantially wholly of fromage frais; dairy produce; dairy produce containing nuts; dairy products; dairy products being half cream and half milk; dairy products containing milk; dairy products containing or flavoured with custard; dairy products containing or flavoured with fruit; dairy products flavoured with cheese; dairy products for foods; dairy products for making milk shakes; dairy products having a soft consistency; dairy products in powder form; dairy products made from goats' milk; dairy puddings; dairy spreads; dairy substances for use as food or as ingredients for food; desserts made wholly or principally of dairy products; drinks made from dairy products; flavoured dairy desserts in the form of mousse layered onto flavoured sauce; food products made from a mixture of dairy products and of edible oils; food spreads consisting principally of dairy products; foodstuffs containing dairy products [as the main constituent]; fruit based dairy products; low fat dairy spreads; preparations for creaming coffee [dairy products]; preparations for use in creaming beverages [dairy based]; preparations for use in creaming coffee [dairy based]; preparations for use in creaming tea [dairy based]; preparations for use in whitening coffee [dairy based]; protein derived from soya beans for use as substitutes for dairy products; spreads consisting wholly or principally of dairy products; spreads made from dairy</p>

	<p>products; whiteners [dairy] for beverages; blended cheese; butter cheeses; cheese; cheese products; cheese spreads; cheese sticks; cheese wedges; combinations of cheese and fruit; combinations of cheese and meat; combinations of cheese and vegetables; cottage cheese; cottage cheese preparations; cream cheese; curd cheese; dairy products flavoured with cheese; foodstuffs flavoured with cheese [cheese predominating]; fresh cheese; imitation cheese; imitation cheese made from soya and casein; low fat cheese; preparations of cottage cheese; prepared foods consisting principally of cheese; prepared meals made principally of cheese; processed cheese; processed cheese products; ready grated cheese; savouries consisting of cheese; soft cheese; soft cheese preparations; toppings (Cheese) for pizzas; snack food (fruit-based).</p> <p><b>Class 30:</b> Frozen yoghurt [confectionery ices]; frozen confectionery; frozen dairy confections; confectionery in frozen form.</p>
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45. In the notice of opposition, the opponent claims that “the goods listed in Classes 29 and 30 of the Application are complementary and highly similar to "spices" protected by the Opponent's Registration.” In addition, the opponent in its submissions asserts the following:

*“Nature*

The Applicant's Goods and the Registered Goods are all food products. The nature of the respective goods is thus identical.

*Intended purpose*

As food products, the Applicant's Goods and the Registered Goods are intended to be consumed. The intended purpose of the respective goods is thus identical.

### *Method of Use*

As foods products, the Applicant's Goods and the Registered Goods are consumed. The method of use of the respective goods is thus identical.

### *Relevant public*

Both the Applicant's Goods and the Registered Goods are aimed at the general public at large. The respective goods are aimed at a consumer intending to prepare and cook a meal.

### *Distribution channels*

As foods products, the Applicant's Goods and the Registered Goods will be sold to the general public via food stores including supermarkets and independent shops.”

46. The applicant in its notice of defence, denies any identity between the respective goods, stating that “the Applicant submitted a TM21B to amend the specification to ensure that it only covers dairy related products.” I note that the applicant in its submissions provided a comparison based on the whole earlier specification which is not applicable here as the opponent in its notice of opposition only relied on the term “*spices*” in Class 30 for the purposes of this opposition.
47. The applicant’s goods in Classes 29 and 30 can be largely identified as dairy foodstuffs. The opponent’s goods are plant/vegetable-based substances used to flavour food. The opponent has not provided an analysis specific to each of the contested terms in question. Although the competing goods are all considered to be foodstuffs and could be sold via similar channels, it would be superficial to find similarity. Most of the contested goods are chilled or frozen products placed/stored in chiller cabinets or freezers. Thus, the earlier goods, “*spices*”, would be sold in different areas/aisles of supermarkets or shops away from the contested goods. The same applies even for those contested goods that do not

require chilling, for example, “*snack food (fruit-based)*”, as they will still be found in different parts of a shop. In addition, the mere fact that the earlier goods may be used together with some of the contested goods, e.g., yoghurt mixed with spices, does not justify similarity, particularly when they do not share nature (physical properties), uses and users. In this respect, the respective goods are neither in competition nor complementary, where consumers are likely to believe that the same commercial undertaking could offer the respective goods. In the absence of specific submissions or evidence to assist me, I do not consider the contested goods in Classes 29 and 30 to be similar to the earlier Class 30 goods.

48. The application’s goods are dissimilar to the earlier mark’s goods and, thus, likelihood of confusion does not arise in such a case. The opposition cannot succeed against dissimilar goods and, therefore, is dismissed.

## **OUTCOME**

49. The opposition has failed, and, subject to an appeal against this decision, **the application may proceed to registration in its entirety.**

## **COSTS**

50. This opposition has failed in its entirety and the applicant is entitled to a contribution towards its costs of defending its application. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. I award costs to the applicant as a contribution towards the cost of the proceedings on the following basis:

Considering the other side’s statement and preparing a counterstatement	<b>£350</b>
Considering and commenting on the other side’s evidence	<b>£500</b>
Filing written submissions in lieu	<b>£350</b>
Total	<b>£1,200</b>



51. I, therefore, order EVEREST FOOD PRODUCTS PRIVATE LIMITED to pay Everest Dairies Ltd the sum of £1,200. 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 this 23<sup>rd</sup> day of September 2022**

**Dr Stylianos Alexandridis  
For the Registrar,  
The Comptroller General**