

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2029066
IN THE NAME OF MADHUR JAFFREY**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 45413 BY FOODS AND INNS LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF application number 2029066
in the name of Madhur Jaffrey**

5

AND

**IN THE MATTER OF opposition thereto
under number 45413 by Foods and Inns Limited**

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15 **Background**

On 2 August 1995, Madhur Jaffrey filed a trade mark application to register the trade mark MADHUR JAFFREY in Classes 29, 30, 31 and 32 in respect of the following goods:

- 20 **Class 29** Meat and meat extracts; eggs; milk and milk products, yoghurts, lasi; fish, poultry and game; pickles and vegetable pastes; preserved, dried and cooked fruits and vegetables; jellies, jams; salad dressings; preserves; edible oils and fats; lentils; prepared meals.
- 25 **Class 30** Rice and food products made from rice; cereals and cereal preparations; coffee, artificial coffee; tea, sugar, tapioca, sago; flour; yeast; baking powder; honey; treacle; vinegar, sauces, spices; salt; mustard; pickles and pastes; prepared meals, desserts, sweets, breads, pastry and confectionery.
- 30 **Class 31** Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.
- 35 **Class 32** Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; flavoured water; rose water; syrups and other preparations for making beverages.

On 18 September 1996, Foods and Inns Limited filed notice of opposition to this application. The grounds of opposition are in summary:

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1. **Under Section 5** because the mark applied for contains the word MADHUR which is confusingly similar to the opponents trade mark MADHU and is likely to deceive or cause confusion if used in relation to the goods applied for, which are the same goods or of similar description to the goods covered by the opponent's trade mark.

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The trade mark relied upon by the opponents in the grounds of opposition is as follows:

Number	Mark	Class	Specification	
5	1560705	Madhu	29	Preserved and canned fruits and vegetables; all included in Class 29; but none containing honey

10 The opponents ask that the Registrar exercise her judgement and refuse to register the mark. But as has been said on a number of occasions, there is no discretion to be exercised and I therefore disregard the request. They also ask that an award of costs be made in their favour.

15 The applicants filed a Counterstatement in which they deny the grounds of opposition. They ask that the opposition be rejected and that they be awarded costs.

Both sides filed evidence in these proceedings. The matter came to be heard on 12 March 2001, the applicants being represented by Mr David Goldring of J E Evans Jackson, their trade mark agents, the opponents by Mr James Mellor of Counsel, instructed by Intelmark TSD, their trade mark agents.

20 **Opponents' evidence in Chief**

This consists of a Statutory Declaration dated 26 August 1997, and comes from Anil Vasant Gokhale, an Indian citizen residing in Mulund (West) Mumbai, India. He says that he is the Vice President (Legal) and Company Secretary of Foods and Inns Limited. Mr Gokhale says that he has full knowledge of the workings of his company and four years experience in the food industry.

30 Mr Gokhale says that his company has been involved in the manufacture and distribution of canned fruit, fruit pulp, vegetables, pickles, fruit juices and the like food and drinks since 1967. He refers to the filing and examination his company's application to register MADHU, and to the opposition to that application filed by the applicants in this case. He says that the mark MADHU has been in used in India by his company and its predecessors since 1939, and refers to exhibit 1 which consists of details of three trade mark registrations obtained in India for the mark MADHU, two dating from 1951 and covering the same goods as the application in suit.

35 Mr Gokhale gives the history of the ownership of the MADHU trade mark in India, and refers to exhibit 2 which consists of an advertisement for MADHU mangoes published in the Times of India in 1939, and again in 1997. He says that his company (or its predecessors) have used the trade mark in the United Kingdom since at least 1986 in relation to canned exotic fruits and vegetables, and refers to exhibit 3 which consists of an undated advertisement for MADHU tinned mangoes.

45 Mr Gokhale goes on to set out the approximate turnover for goods sold under the MADHU trade mark in the United Kingdom in the years 1986 to 1993, which ranges from £150,000 in 1986 rising to £210,000 in 1993. He says that approximately £5,000 has been spent in each year promoting and advertising the mark through leaflets, advertisements and direct mail to customers, and additionally, by the inclusion of MADHU products on retailer's flyers, referring to exhibit 4

5 which consists of sample “Special Offer” flyers for a company called TRS Cash & Carry Limited. These include references to MADHU OKRA being available between 20 January 1992 and 9 February 1992, MADHU MANGO PULP between 10 February 1992 and 1 March 1992, and MADHU MANGO slices being on offer from 2 March, but no year given. Mr Gokhale says that sales of fruit and vegetables under the MADHU trade mark have been made throughout the United Kingdom, and to other European countries.

10 Mr Gokhale refers to the trade mark application cited in the grounds of opposition, saying that by virtue of the use they have made of MADHU they have priority over the opposed application, which he notes was filed well after the date that his company first used MADHU and later than his company’s application to register that mark.

15 Mr Gokhale gives his views on the similarity of MADHU and MADHUR JAFFREY concluding that they show sufficient similarity and cover similar goods so that there is a likelihood that the marks may be confused. He concludes his Declaration by referring to another set of proceedings in which the applicants in this case have opposed the registration of his company’s application to register the mark MADHU.

20 **Applicant’s evidence**

This consists of a two Statutory Declarations. The first is dated 27 April 1999, and comes from Madhur Jaffrey, the applicant in these proceedings.

25 Ms Jaffrey gives details of her cinematographic, television, radio and stage credits, many in a leading role, starting in the 1950's through to, and after the relevant date in these proceedings. She refers to books, television series and magazine articles, the following appearing in the United Kingdom prior to the relevant date:

30 Invitation to Indian Cooking published in 1973.

Eastern Vegetarian Cooking published in 1983.

35 Madhur Jaffrey’s Indian Cookery - an eight part television series for the BBC in 1982 which has been repeated on five occasions. A cookbook to accompany the series appeared on the best seller lists in the United Kingdom and continues to sell well.

40 A taste of India published in 1985 - the book became a best seller and was serialised in London’s Sunday Observer colour supplement.

Madhur Jaffrey Cookbook published in 1989 - an extract appeared in Gourmet Magazine.

45 Madhur Jaffrey’s Far Eastern Cookery - an eight part television series for the BBC in 1989. A cookbook and video accompanied the series, the book entered the best seller lists and was serialised by The Sunday Times Magazine.

Listening to Volcanoes - a personal television documentary on colonialism in the Spice Islands of Indonesia, shown on BBC1 in 1992.

5 From Manna to Microwave - a six part series on the history of food written and presented on BBC radio 4 in 1990.

A taste of the Far East published in 1993.

10 Quick and Easy Indian Cookery published in 1993.

An Indian Spice Kitchen published in 1993.

15 Madhur Jaffrey's Flavours of India - a six part BBC television series on regional Indian food - with an average audience of 2.5 million for each episode. Accompanied by a book of the same title which reached the best seller lists.

20 Ms Jaffrey relates the awards that she has received, although mostly from organisations outside of the United Kingdom, including the Glenfiddich 1982 award for best Radio/Television broadcaster, which Ms Jaffrey describes as the most prestigious food and wine award. She says that she has also written articles for various publications, inter alia, The London Times, Sunday Observer and Vogue, although does not give any specific details.

25 Ms Jaffrey goes on to refer to an agreement entered into in 1995 with Tilda Rice Limited to assist in the creation of a range of food and beverages, including sauces, pastes and chutneys used in Asian cooking, and to be sold under the name "Tilda by Madhur Jaffrey". Examples of the labels are shown as exhibit MJ1, and inter alia bear the name MADHUR JAFFREY. Ms Jaffrey refers to exhibits MJ2 and MJ3, which consists of a list of quotes attributed to her performances as an actress and author/broadcaster, and details of the trade mark registration for MADHUR'S and application to register MADHUR JAFFREY, respectively.

35 Ms Jaffrey ends her declaration by asserting that through her fame and reputation in relation to acting and cooking, that confusion would arise should the application the subject of these proceedings be registered.

The second Statutory Declaration is dated 4 November 1998, and comes from Charles Alan Pridmore, Managing Director and Company Secretary of Vegetarian World Limited, a position he has held since 1993.

40 Mr Pridmore refers to the trade mark MADHUR'S saying that this was first used in the United Kingdom in 1987 by Quintessential Catering Limited, a company which was acquired by Speciality Foods in 1989, that company subsequently changing its name to Vegetarian World Limited. He says that on 12 October 1995, his company assigned all rights to the trade mark MADHUR'S to Madhur Jaffrey.

45 Mr Pridmore says that over the years the mark had been used on a range of food products including curry sauce, chick peas, whole moong, whole urid, dhal and vegetable curry. He lists

the turnover in respect of goods sold under the MADHUR'S trade mark for the years 1991 to 1995, which are as follows:

5	1991	£7,000
	1992	£7,461
	1993	£26,504
	1994	£18,094
	1995	£5,602

10 He refers to exhibit AP1 which consists of:

invoice dated 3 October 1995 (after the relevant date) relating to sales of £1,841.40.

15 Vegetarian World Limited price list for 1994 showing MADHUR'S curry sauces, chick peas, whole moong, whole urid, dhal and vegetable curry. The list is noted as being effective on all deliveries after 1 January 1994.

20 Sample labels for MADHUR's curry sauces, chick peas, whole moong, whole urid, dhal and vegetable curry

That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

25 At the hearing Mr Goldring confirmed that the opposition was based upon Section 5(2)(b) and Section 5(3). I turn first to the grounds under Section 5(2)(b). That section reads as follows:

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

30 (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

35 (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.

The term 'earlier trade mark' is itself defined in Section 6 as follows:

40 **6 (1)** In this Act an earlier trade mark means -

45 (a) a registered trade mark, international trade mark (United Kingdom) or Community trade mark 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,

In my determination of whether there is a likelihood of confusion I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 2, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:-

a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, paragraph 23, 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 10 his mind; *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel B.V.* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*, paragraph 23; 15 (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to 30 mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the 35 strict sense; *Marca Mode CV v Adidas AG*, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29;

The mark applied for consists of the words MADHUR JAFFREY which the opponents contend is similar to their earlier trade mark MADHU. Placed side by side it is plain to see that the first word in the applicant's mark contains the opponent's mark and to that extent there must be a degree of visual identity, and with the same hard syllable at the beginning and a softer syllable at the end, aural similarity, particularly so when allowance is made for the tendency to slur the endings of words.

Whilst it is well established that the beginnings of marks are of most significance, and I would say particularly so where the marks consist of one word or the first word is the dominant or sole distinctive component, marks must be compared as a whole, albeit with regard to the dominance of the distinctive components. The word MADHU is said to be the Hindi word meaning HONEY (which accounts for the qualification to the specification) although I would say that other than to Hindi speaking persons the mark will most likely be seen as an eastern sounding word of unknown origin or meaning, or simply as a word invented to capture the flavour of the subcontinent. As such I would say that it is a mark with a strong distinctive character.

If, as the applicants say, the name Madhur Jaffrey is famous, and I have not heard the opponents dispute the claim that she is, the fame in my view rests in the name as a whole and is where I would say the real distinctiveness of the applicant's mark exists. I do not see why MADHUR should be considered any more dominant or distinctive than JAFFREY.

The opponents have made long use of their mark in their home market in India. Sales and advertising in the United Kingdom have extended over a period of around 8 years, although at what I would describe as a modest level, although I do accept that this has been in relation to a limited range of exotic canned fruits and vegetables, but even so, I do not consider that the evidence shows that through the use made of it their mark is likely to enjoy a strong reputation. The respective marks notionally cover the same market and consumers.

The entirety of the opponent's mark is contained within the mark tendered for registration, but I would not say that it follows that it captures its identity. The opponent's case relies upon the premise that their mark MADHU is going to be picked out from MADHUR JAFFREY, a name which it is accepted the public are familiar with, and that through imperfect recollection the opponent's mark will be called to mind and confusion will arise. This seems an unlikely course of events. Even making allowance for the fact that there is identity of goods, at least in part, and similarity in others, when considered "globally" I do not consider that there is a likelihood of confusion, and the ground founded under Section 5(2)(b) fails accordingly.

Turning next to the ground under Section 5(3). That section reads as follows:

5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a

reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) 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.”

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The opponent’s registration cited in the notice of opposition is an earlier trade mark within the meaning of Section 6(1) of the Act (set out earlier). Although some of the goods included in the application are the same or similar to those within the registration, the application also covers a range of goods which I would say are clearly different. However, I have already determined the

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respective marks to be neither the same nor similar, the consequence of which is that the earlier mark relied upon fails to meet the criteria for an objection under Section 5(3). Even if the respective marks had been similar I do not consider that the ground under Section 5(3) would have succeeded. In *Pfizer Ltd v Euro Food-Link (UK) Ltd* ((ChD) [1999] 22(4) IPD 22039) Mr Simon Thorley QC sitting as a Deputy High Court Judge said:

“What is necessary is that the trade mark proprietor should prove the required reputation and should then satisfy the Court that the defendants use of the sign is:

- (a) without due cause; and
- (b) takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.”

The opponents have used their mark over a reasonably long period of time, although only in respect of a limited range of what can be termed exotic fruits and vegetables. Given the overall size of the potential market, sales have not been significant, and would not be so even if the market were considered to be specialist ethnic food stores. Setting aside the question of “due cause” I do not consider that at the relevant date the opponents had proved that they had established a reputation within the United Kingdom such that if the applicants were to use MADHUR JAFFREY in respect of identical, let alone dissimilar goods, that the distinctive character or repute of their mark would suffer, or that any benefit will be derived by the applicants, and the ground under Section 5(3) fails accordingly.

The opposition having failed on all grounds I order the opponents to pay the applicants the sum of £635 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3 day of July 2001

**Mike Foley
for the Registrar
The Comptroller General**