

O-356-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2404933
BY KENMERE LTD TO REGISTER
THE TRADE MARK WANIS IN CLASS 30**

AND

**IN THE MATTER OF OPPOSITION No. 94412
BY WANIS LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2404933
by Kenmere Ltd to register the Trade Mark WANIS
in Class 30**

and

**IN THE MATTER OF Opposition No. 94412
by Wanis Limited**

BACKGROUND

1. On 26 October 2005 Kenmere Ltd applied to register the mark WANIS for “rice; flour; tinned, fresh and frozen products”.

2. On 12 June 2006 Wanis Limited filed notice of opposition against this application citing grounds under Sections 3(6) and 5(4)(a). The basis for these claims is said to be as follows:

1. All of the directors of the Applicant are the same as the directors of Flying Trade Ltd. which trades under the name Golden Foods. At the time of the registration of WANIS, Golden Foods had been a customer of Wanis and acted as a sub-distributor of Wanis for many years. Consequently, the Applicant is fully aware that Wanis uses the mark WANIS and their goodwill under the mark WANIS. The Applicant is fully aware that consumers will automatically assume that the WANIS products that will be supplied and/or distributed by the Applicant are part of the same portfolio of the products that Wanis distributes.

It is clear that the Applicant is acting in bad faith and registration of the Application WANIS should therefore be rejected in accordance with Section 3(6) of the Trade Marks Act 1994.

2. Wanis is a cash and carry and distribution business. Wanis has generated substantial goodwill in the United Kingdom for over 42 years through the supply and sale of food, drink, toiletry and cosmetic products. The use of the WANIS mark by the Applicant is likely to cause public confusion. The use of the WANIS mark is a clear and deliberate misrepresentation of Wanis’ goodwill under the mark and threat[en]s to cause Wanis, damage.

Use of WANIS by the Applicant constitutes passing off at common law and registration of the Application WANIS should therefore be rejected in accordance with Section 5(4)(a) of the Trade Marks Act 1994.”

3. The applicant filed a counterstatement which must be taken to amount to a denial of the claims. Specifically the applicant puts its position as follows:

1. Kenmere Ltd has never been a customer of Wanis Ltd.
2. The opponent has not demonstrated any goodwill associated to the brand WANIS.
3. It appears that Wanis Ltd has never marketed the brand WANIS. It does not sell any products under the brand of WANIS.
4. Wanis Ltd is not using and has not used the trade mark WANIS. The brand is not being marketed.
5. Kenmere Ltd is keen to develop the brand in a wide variety of markets.
6. There is no intent to pass off in this application and hence the objection should be removed.
7. There is no goodwill associated to the brand WANIS.

4. Both sides subsequently filed evidence. The Registry invited the parties to say whether they wished to be heard or, in the alternative, to file written submissions. Neither side has requested a hearing. Written submissions have been received from the opponent under cover of a letter dated 2 July 2007. Acting on behalf of the Registrar and with the above material in mind I give this decision.

Opponent's evidence

5. This consists of a witness statement by Mr T Sanjay Wadhvani a director of Wanis Ltd, a position he has held for over fifteen years.

6. The first part of his witness statement deals with the company and its business. Mr Wadhvani then goes on to deal with the applicant company, the group of which it is part, the directors of these companies and past dealings between Wanis and the group of which the applicant is a member.

7. Wanis has been in business for over 42 years and has built up a substantial reputation since its inception as the leading Afro-Caribbean food and drink distributor in the UK. Wanis supplies Tesco, the largest supermarket multiple in the UK, major cash and carries such as Dhamecha, Bestways, TRS and Hyperama, and wholesalers, retailers and caterers. Customers can either shop at the Wanis cash and carry or have their goods delivered to them from the company's warehouse by Wanis' fleet of delivery vehicles.

8. The generality of this claim is supported by the following exhibits:

- A - a website printout
- B - a domain name registration certificate
- C - examples of promotional offers advertising the name (carrying dates in April, May and June 2005)
- D - photographs showing the name WANIS on transport vehicles
- E - photographs showing the name on the company's building

- F - photographs of signage at the company's premises
- G - a letterhead and a compliment slip showing the name WANIS
- H1 - current sales invoice displaying the name
- H2 - invoices from the 1970s displaying the name
- I - posters from the company's 7 September 2004 trade day.

9. Mr Wadhvani goes on to deal with the applicant's status:

- "2. The Applicant itself has not been a customer of Wanis. However, the Applicant's affiliate, Flying Trade Ltd ("Flying Trade") has been a customer of Wanis for many years. I refer to Exhibit J, a copy of Harry Dulai's business card, which demonstrates that he is known in the trade as Harry Dulai, though his legal name is Harjit Singh Dulai, and demonstrates that Surya, the company stated on his business card, is part of Flying Trade and Flying Trade Group plc. I refer to Exhibit K, business information for the Flying Trade from creditsafe.com, which shows that Harjit Dulai is a director of Flying Trade. I refer to Exhibit L, director details from creditsafe.com, which shows that Harjit Dulai and Sukhjit Dulai are directors of the Flying Trade, Flying Trade Group plc and the Applicant and shows that Flying Trade Group plc wholly owns Flying Trade. I refer to Exhibit M, company information for Flying Trade Group plc from creditsafe.com, which shows that Kewal Dulai is a significant shareholder of Flying Trade Group plc which owns Flying Trade. I refer to Exhibit K and Exhibit N, company details of the Applicant, which shows that the directors of the Applicant are also directors of Flying Trade, and shows that the sole shareholder of the Applicant is Kewal Dulai who is also a significant shareholder of Flying Trade Group plc which wholly owns Flying Trade."

10. Exhibit O contains Trade Marks Registry case details for the application in suit showing that Harry (Harjit) Dulai of Golden Foods is the address for service.

11. The application was filed in the name of Golden Foods but Registry records show that a change of name was recorded to Kenmere Ltd at the same address in Wembley. Mr Wadhvani shows at Exhibit P an invoice from Golden Foods to Wanis Ltd dated 26 July 2005. A footnote to this invoice records that Golden Foods is a trade name of Flying Trade Ltd.

12. He also introduces at Exhibit Q two lever arch files containing reprints of all Wanis' invoices to Golden Foods/Flying Trade dating back to 2001. I note that most of these relate to food and drink items. He says that all of these reprints would have appeared on Wanis headed stationery as shown in a small selection of invoices at Exhibit R. A sales report at Exhibit S shows the value of this trade to have been £1,779,595.18.

13. Mr Wadhvani goes on to describe his dealings with Harry (Harjit) Dulai – see Exhibits T and V, the latter being a selection of e-mail exchanges. He says he met with Mr Dulai on 7 August 2006 to remind him of the fact that WANIS is the opponent's name.

14. Next, Mr Wadhvani exhibits (Exhibit V) a purchase order for goods to be supplied by Golden Foods to Wanis. The purchasing history of Wanis from Golden Foods is shown at Exhibit W covering the period 30 June 2002 to 30 June 2006. Wanis purchased goods to the value of £815,471.23. Wanis has also dealt with Surya, another trading name of Flying Trade Ltd. A Surya sales invoice is shown at Exhibit X and a fax to 'Harry' at Surya at Exhibit Y.

15. Wanis and the applicant through its affiliates also sell and deal with similar customers. At Exhibit Z is a list of stores that both sides are said to have had dealings with.

16. The remaining exhibits are "To whom it may concern letters" that do not comply with the evidential requirements of Rule 55 of the Trade Marks Rules 2000 (as amended). I do not intend to give weight to these exhibits.

Applicant's evidence

17. Harjit Dulai, a director of Kenmere Ltd has filed a witness statement. He is also a director of Flying Trade Ltd which trades under the names of Surya and Golden Foods. He says that the companies which he represents form part of an established food import and distribution network throughout Europe.

18. As part of its activities it has its own rice milling operations within the UK, India and Pakistan. Rice represents over 70% of its activities. The remainder involves a range of other products.

19. Mr Dulai says that Flying Trade and its associated companies own and operate "almost 15 brands of products". Different brands are used to differentiate between the varied ethnic communities within Europe. An example is shown at Exhibit HD1, a table showing brand and ethnic groupings. Exhibit HD2 is said to show a similar practice of product differentiation employed by two competitors that is to say different brands targetted at different ethnic groups. In fact HD2 shows trade mark registrations belonging to Tilda and Veetee Rice but yields no information on the target market for the goods.

20. Exhibit HD3 is a listing of various trade mark registrations owned by Wanis Ltd and is intended to show that the opponent has not itself applied to register the mark WANIS.

21. Mr Dulai says that the mark WANIS was selected for the purpose of marketing a rice brand towards the Sindhi (Asian) community within Europe. He goes on to say:

"12. The reason for selecting the mark Wanis was because the Sindhi community is recognised for having their surname ending in WANI and ANI.

This is demonstrated by Exhibit HD5 which shows the research undertaken to select the name. This research includes a list of Sindhi surnames downloaded from the internet (www.dalsabzi.com – a website dedicated towards the Sindhi community)

13. There is wide awareness of the general name WANIS is popular and this can be demonstrated by the name producing 1,430,000 results on the search engine www.google.com. (Exhibit HD6)”

22. Mr Dulai concedes that Wanis Ltd has traded with Flying Trade Ltd for many years but says “... they have never marketed the brand Wanis. They have never sold Flying Trade Ltd any products under the brand of Wanis”.

23. Finally Mr Dulai observes that the opponent is a specialist in African and Caribbean foods. Hence they serve a niche market whereas the applicant’s interest is in serving the Sindhi community.

Opponent’s evidence in reply

24. Mr Wadhvani has filed a further witness statement. Picking up on Mr Dulai’s stated interest in serving the Sindhi community with rice and other products, he says that his family belongs to the Sindhi community and is well known within that community. He says that most people in the Sindhi community and many Indians would, if they saw a product under the WANIS name, assume it originated from Wanis Ltd. In support of this he exhibits witness statements as follows:

- TSW1 - Murli Mukhey, President of the Sindhi Association of UK
- TSW2 - Kamla Roopchand of Holy Mission of Guru Nanak that serves the Sindhi community
- TSW3 - Krishin Ralleigh, General Secretary of Indialink Business and Travel Club that serves the Indian community
- TSW4 - Ashwin Majithia of Tilda Ltd, a company that has been doing business with Wanis for almost 35 years
- TSW5 - John Rispin of S & B Herba Foods Ltd
- TSW6 - M G Mulchandani, a Director of Imperial Cash & Carry
- TSW7 - Dr Rami Ranger, Managing Director of Sun Oil Ltd

25. The witnesses confirm that it is widely known in the Sindhi community that WANIS is the trade name of the Wadhvani family who own a food and drink wholesaling and distribution business called Wanis. They all say that, if another company or person was to use WANIS in connection with food and drink, it would be assumed that the products came from the Wadhvani family business, Wanis.

26. Mr Wadhvani notes Mr Dulai's claim that the name WANIS is popular by reference to a Google search but points out that the search was based on Wani and not WANIS. A further search of his own in relation to WANIS shows that five of the first ten hits (and the first three) refer to his company. The remainder of his witness statement is submission and/or a reiteration of points made in his evidence in chief.

27. That completes my review of the evidence.

DECISION

Section 5(4)(a)

28. The relevant part of the statute reads:

“5. (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, or

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.”

29. I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not

intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.'

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

'To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

30. The Act is silent on the matter of the relevant date but Article 4.4(b) of First Council Directive 89/104 makes the position clear:

“(b) rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark and that non-registered trade mark or other sign confers on its proprietor the right to prohibit the use of a subsequent mark;”

In the event that an applicant has not used his mark in advance of the filing of his trade mark application the relevant date will be that filing date. However, it is well established (see *Pub Squash* case [1981] R.P.C. 429) that in a passing off action a plaintiff must have established this right at the date the defendant started to use his mark, the so-called date of the act first complained of. I am not aware that the position is any different when the passing off issue arises, as it does here, under the umbrella of a trade mark opposition action. In the absence of evidence as to when the applicant began using the mark in suit I will base my consideration on the position that pertained at the application filing date of 26 October 2005.

31. It will be apparent from the terms in which the counterstatement is couched (see above) that the applicant does not concede that the opponent has any goodwill in the name WANIS. The claim is repeated in Mr Dulai’s evidence. This time it is conceded that Wanis Ltd has traded with Flying Trade Ltd (an associated company of the applicant) but it is said “... they have never marketed the brand WANIS. They have never sold Flying Trade Ltd any products under the brand of WANIS”.

32. The essence of the applicant’s case is, therefore, that products are not branded WANIS. In this I consider that Mr Dulai is broadly-speaking correct. The thrust of the evidence is that Wanis Ltd is a trade intermediary that in the main sells third party branded products. The evidence is almost wholly one way in supporting that position. Thus, the transport signage (Exhibit D) and the building signage (Exhibit E) indicate the nature of Wanis’ business. Exhibit E is particularly telling. It shows signage at the opponent’s premises indicating that Wanis Ltd are “Food Importers/Exporters, Food Wholesalers and Distributors, Specialists in Afro-Caribbean Foods”. The promotional offers (Exhibit C) and the voluminous invoice evidence at Exhibit Q reinforces the view that the trade mainly involves third party branded goods.

33. There is, of course, no reason in principle why a business intermediary (importer, wholesaler, distributor, retailer etc) should not also use its name on or in relation to goods. One only has to think of the practice of the large supermarket chains in offering a mixture of own brand goods and third party brands. What the position is in any particular case is a matter to be determined on the facts of the case. If the sign in question is being used both as a retail service sign and a goods brand then that will be a factor to take into account in determining the nature and extent of the resulting goodwill.

34. But to return to the matter in hand the overwhelming impression is that the name WANIS or WANIS LTD is being used as the sign of an importing, wholesaling and distribution business specialising in but not necessarily limited to, ethnic foodstuffs. I hesitate to say that this is exclusively the position because I note from one of the promotional offers in Exhibit C (specifically the one sub-headed “selling out 13/6/05 – 25/06/05”) contains an example of WANIS being used on a bag of gari. I also note from Mr Dulai’s Exhibit HD3 that Wanis Ltd has a number of trade mark registrations for goods in Classes 29, 30, 31 and 32. The promotional offers and invoice evidence in Exhibits C and Q to Mr Wadhvani’s evidence show at least two of these registrations (TROPICAL SUN and JAMAICA SUN) in use. It is not, therefore, that Wanis Ltd does not sell branded goods of its own at all but on my reading of the material before me there is negligible evidence that the name WANIS is itself used as a goods brand. Nevertheless, there is abundant evidence that Wanis is used in trade as the sign under which the opponent conducts its wholesale/distribution business in ethnic and other foodstuffs.

35. Once the matter is understood in those terms I do not think that the applicant could credibly deny that the opponent has goodwill in the name WANIS. The applicant’s own purchases from Wanis are shown to have amounted to over £1.7 million pounds. Some of that figure needs to be discounted because the sales would have occurred after the relevant date but the invoice evidence at Exhibit Q confirms a consistent pattern of trade from Wanis to Flying Trade in the years preceding the filing of this application by Kenmere Ltd. It is also to be borne in mind that this trade, though substantial, is only part of Wanis Ltd’s business. Mr Wadhvani’s uncontroverted evidence is that Wanis has been in business for 42 years and supplies major cash and carries, wholesalers, retailers and caterers. The first leg of the passing off test has, therefore, been made out.

36. The next issue is whether, having regard to the goodwill I have described above, use of WANIS by the applicant in relation to the goods of the application (rice; flour; tinned, fresh and frozen products) would constitute a misrepresentation.

37. It is well established in the law of passing off that there is no requirement for a common field of activity in the sense that the parties need to be trading in the same or related goods and services. The Court of Appeal so held in *Harrods v Harrodian School* [1996] R.P.C. 697. An example of circumstances where a passing off case succeeded in circumstances where there was some distance between the goods was *Lego System Aktieselskab and another v Lego Mr Lemelstrich Ltd*, [1983] F.S.R. 155. In that case the well known manufacturer of toy construction kits succeeded against an identical mark for garden sprinklers and other irrigation equipment. It was

nevertheless held in the *Lego* case that the proximity of the defendant's (applicant's) field of activity to that of the plaintiff (opponent) would be relevant as to whether the acts complained of in a particular case amounted to a misrepresentation.

38. There can only be one answer to that question. Here are two traders specialising in the provision of goods to the ethnic foodstuffs market. The closeness of their trading activity is readily apparent from the fact that they buy and sell to one another (or group companies). It does not matter that Wanis Ltd may not brand its own goods under the name WANIS. The plain fact is that other traders, retailers and consumers encountering the mark WANIS would automatically associate it with the long established wholesaling/distribution business conducted under that name and would be erroneously led to believe that the goods in question had been placed on the market by the opponent.

39. The applicant for its part suggests that different brands are targeted at different ethnic communities as certain communities respond better to some brands than others.

40. Given my above finding that WANIS is employed as a service brand and an overarching brand for the opponent's ethnic food business that argument has little weight. The opponent offers a wide variety of goods suitable for a wide variety of customers. The same is true of the applicant's goods. Exhibit HD1 shows that it targets a whole range of ethnic communities under the umbrella of its overall business. I note too that a number of its brands are directed at a number of different ethnic groupings (up to 4 in the case of the Surya brand).

41. More importantly, despite the claim that the mark WANIS was chosen for the purpose of marketing a rice brand towards the Sindhi community, the specification applied for is neither restricted to rice nor the Sindhi community. If the mark were to achieve registration, Kenmere would be free to sell all or any of the goods to any market or ethnic grouping of its choice.

42. If any further proof was necessary in relation to the misrepresentation point (and in my view it is not) it can be found in the witness statements exhibited to Mr Wadhvani's reply evidence. The evidence of other traders is of particular relevance and significance in this respect – that is to say Exhibits TSW4 to TSW7. All are long standing members of their trade and confirm, to take Mr Majithia of Tilda Ltd's comment as being typical:

“5. If another company or person were to use the WANIS name in conjunction with a food or drink product, it would be automatically assumed that these products belong to the Wadhvani family business, Wanis. Thus, if another company were to bring out a rice product under the name WANIS, consumers would undoubtedly associate this product with Wanis, the company owned by the Wadhvani family.”

43. There is an element of uniformity in the statements made (as to which see *Re Christiansen's Trade Mark* [1886] 3 R.P.C. 54 at 60) but there is no reason to suppose that the views expressed are not honestly held. Nor are the views in any way incredible. On the contrary they come from long established traders in the relevant area of trade and confirm the view that I would have reached independently.

44. I need to say very little about the third leg of the test, damage. The applicant has chosen a sign that is identical to that used by the opponent. It is true that it is proposed for use in relation to goods rather than services. But the closeness of the respective trades is such that it is inconceivable that there would not be damage to the opponent's business if WANIS brand products (unless emanating from the opponent) were circulating in the market. This could take many forms including loss of sales/diversion of trade because customers ordered goods in the mistaken belief that it was an own brand range developed by the opponent and damage to the opponent's reputation in the trade where it is a long-standing player. It would also place the opponent's reputation in the defendant's hands and generally restrict any expansion of trade by Wanis into own brand goods.

45. In summary, the opponent is successful under Section 5(4)(a).

Section 3(6)

46. Section 3(6) provides that a trade mark shall not be registered if or to the extent that the application is made in bad faith. In *China White* [2005] FSR 10, the Court of Appeal decided that the 'combined test' they understood to have been laid down by the House of Lords in *Twinsectra v Yardley* [2002] 2 AC 164, should be applied in deciding cases under Section 3(6) of the Act. In *Barlow Clowes International Ltd v Eurotrust International Ltd* [2006] 1 Lloyd's Rep 225, the Privy Council clarified that the House of Lords' judgment in *Twinsectra* required only that a defendant's state of knowledge was such as to render his action contrary to normally accepted standards of honest conduct. There is no additional requirement that a defendant (or applicant in trade mark proceedings) must also have reflected on what the normally accepted standards were. The applicability of these principles to trade mark cases has since been confirmed in *Ajit Weekly Trade Mark* [2006] R.P.C. 25. The standard itself is that set down in *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] R.P.C. 367. It includes dishonesty but also includes some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined.

47. The position must be decided at the date of filing of the application in suit.

48. As described in the evidence there have been regular business dealings between Wanis Ltd and Flying Trade Ltd. Mr Dulai accepts that that is the position. The applicant is not, however, Flying Trade Ltd but a company called Kenmere Ltd. The statement of grounds clearly signposted the opponent's view that Flying Trade Ltd and Kenmere Ltd had common directors such that the applicant company must also have been aware of Wanis Ltd and its business.

49. In the counterstatement the applicant merely noted that "Kenmere Ltd has never been a customer of Wanis Ltd". That seems to me to have been a somewhat disingenuous response and fell a long way short of denying that Kenmere Ltd and its controlling minds (which included Mr Dulai) had any knowledge of Wanis and its business.

50. I have recorded above Mr Wadhvani's evidence in relation to the Flying Trade group of companies, the relationship between them, their common directorships and shareholdings and the trading names used. None of this material or the conclusions to be drawn has been disputed. Purely as a pleadings matter I find that the applicant did not deny awareness of the WANIS name at the time it was adopted. Furthermore, on the basis of Mr Wadhvani's evidence (again unchallenged) I find that this to be the case.

51. On the plain facts of the matter the applicant has applied to register the name of a long-established fellow trader in the ethnic foodstuffs business. For the reasons given in relation to the Section 5(4)(a) ground it is no defence to say that the application is for goods rather than services.

52. The only other point that the applicant raises in mitigation is that the reason for selecting the mark was because the Sindhi community is recognised for having surnames ending in WANI and ANI. Exhibit HD5, taken from a Sindhi community website, is advanced as evidence of this position. The website does indeed show surnames ending in –ANI. A variety of permutations of letters precede this common element. The first 5 names on the list illustrate the point – Amarnani, Israni, Bhaharani, Bhaherwani and Balani. WANI or WANIS is not shown as being a surname in its own right though I accept that WANI appears as the suffix element of longer names of which Mr Wadhvani's is an example.

53. Mr Dulai does not go on to explain why the applicant chose to adopt as its mark the ending of a typical Sindhi surname. It is not said that WANI is a surname in its own right. Furthermore, the mark applied for is not WANI but WANIS. Given the opponent's position as a long standing trader in ethnic and other foodstuffs and the undoubted knowledge that the applicant had of that fact, any defence based on innocent independent adoption of the mark WANIS must fail. I find that the mark was adopted in bad faith and the opposition also succeeds under Section 3(6).

54. The opponent has been successful and is entitled to a contribution towards its costs.

55. The applicant has not been professionally represented in these proceedings and is in effect in the position of a litigant in person. It is appropriate to reflect this in the costs award on the basis of Simon Thorley QC's observations in *Adrenalin Trade Mark*, BL O/040/02 at paragraph 8:

“It is correct to point out that the Registrar's practice on costs does not specifically relate to litigants in person but in my judgment it could not be that a litigant in person before the Trade Mark Registry could be placed in any more favourable position than a litigant in person before the High Court as governed by the CPR. The correct approach to making an award of costs in the case of a litigant in person is considered in CPR Part 48.6”.

56. Part 48 of the Civil Procedure Rules referred to in the above passage provides as follows:

“48.6(1) This rule applies where the court orders (whether by summary

assessment or detailed assessment) that costs of a litigant in person are to be paid by any other person.

(2) The costs allowed under this Rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative”.

57. I order the applicant to pay the opponent the sum of £1800. This sum is 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 6th day of December 2007

**M REYNOLDS
For the Registrar
The Comptroller General**