

BL-O-673-18

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF:

TRADE MARK APPLICATION 3207080

BY VIRUNDHU LIMITED

FOR THE MARK:

Royal Virundhu

AND OPPOSITION THERETO (No 409120)

BY VIRUNDHU RESTAURANT LIMITED

&

AN APPLICATION (No 501722) BY VIRUNDHU LIMITED

TO INVALIDATE TRADE MARK 3186761 OWNED BY

VIRUNDHU RESTAURANT LIMITED

IN RESPECT THE MARK:

VIRUNDHU

BACKGROUND AND PLEADINGS

1. This decision relates to two trade marks which either consist of, or contain, the word VIRUNDHU. The opposition proceedings relate to the following mark:

Application: 3207080

Mark: **Royal Virundhu**

Applicant: Virundhu Limited

Filing date: 17 January 2017

Publication: 27 January 2017

Class 29: Prepared meals containing meat and vegetables.

Class 30: Prepared meals; curry pastes; curry sauces; curry mixes; curry powders; curry seasonings; prepared curry dishes; prepared rice dishes; popadoms.

Class 35: Franchising consultancy and administration services relating to restaurants and other establishments or facilities engaged in providing food and drink; retail services connected with the sale of prepared meals containing meat and vegetables, prepared meals, curry pastes, curry sauces, curry mixes, curry powders, curry seasonings, prepared curry dishes, prepared rice dishes, popadoms; information and advice in relation to the aforesaid services.

Class 43: Services for providing food and drink; restaurant, bar and catering services; takeaway services; information and advice in relation to all the aforesaid services.

2. The opponent is Virundhu Restaurant Limited. It relies on a number of grounds under sections 5(1), 5(2)(a), 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). I will come back to the specifics of the grounds later. Under the first three grounds, the opponent relies on the following trade mark:

Registration: 3186761

Mark: **VIRUNDHU**

Filing date: 20 September 2016

Registration: 23 December 2016

Class 43: Restaurants; Catering services

3. After receiving the opposition to its mark, the applicant applied to invalidate the opponent’s earlier mark, relying on grounds under sections 5(4)(a) and 3(6) of the Act which, again, I will come back to¹.

4. The proceedings were consolidated. Both sides filed evidence. A hearing then took place before me on 28 June 2018 at which the opponent was represented by Mr Steven Langton, of counsel. The applicant was represented by its director, Mr Balasubramaniam, who was also cross-examined on the written evidence he had given. Although the applicant now represents itself, it was initially represented by Indra Sebastian Solicitors.

THE EVIDENCE

5. Evidence was filed by Mr Santosh Balasubramaniam on behalf of the applicant. He was cross-examined on certain parts of his testimony, upon which I will comment later. On behalf of the opponent, evidence was filed by Mr Ravithasan Thillainathar and Ms

¹ Both these grounds are relevant in invalidation proceedings by virtue of the provisions of section 47 of the Act.

Nirthiga Ravithasan, husband and wife, who are both directors of the opponent. However, the evidence of Mr Thillainathar merely attests to the truth of Ms Ravithasan's evidence, so I will focus on that.

6. Rather than provide a piece-meal evidence summary, I will, instead, refer to the content of the evidence as and when appropriate during this decision. I will not refer to all of the evidence, but confirm I have had sight of it and have taken it all into account.

REGISTRATION 3186761 - VALIDITY

7. Given that the opponent's earlier mark forms part of the basis of its opposition, it is sensible to firstly determine its validity. I begin with section 5(4)(a) which is based on the claimed use of the sign VIRUNDHU since May 2015.

Section 5(4)(a) of the Act

8. Section 5(4)(a) of the Act reads:

"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

(b)...

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

9. It is settled law that for a successful finding under the law of passing-off, three factors must be present: i) goodwill, ii) misrepresentation and, iii) damage. In *Discount*

Outlet v Feel Good UK, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court stated that:

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

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

10. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the matter of the relevant date in a passing off case. He said:

“43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”.

11. In view of the above, the applicant must, at the very least, establish that it had a protectable goodwill at the date when the contested trade mark application was filed (20 September 2016 “the relevant date”); even if this is satisfied, I may also need to consider the position at an earlier date if the opponent establishes any pre-filing use. The applicant’s pleading is based upon the use of the sign VIRUNDHU (not ROYAL VIRUNDHU).

Goodwill

12. Goodwill was described in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), where the Court stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

13. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not

acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

14. However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience.”

See also: Stannard v Reay [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC); *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590 (COA)

15. The applicant’s evidence comes from Mr Balasubramaniam. He explains that he and his wife (Revathi Mariappan) are joint directors in a number of companies, one being the applicant. The applicant holds leases for two properties from which a restaurant/takeaway is operated, one of which is called ROYAL VIRUNDHU. It is stated that the restaurant “business is traded under another company”, Virundhu Maidenhead. Virundhu was chosen as a name because it is a Tamil word meaning “feast”. Royal was added to signify a Royal Feast.

16. Various exhibits are provided showing the Royal Virundhu restaurant operating as such, including a TripAdvisor review, a Groupon offer, and examples of the restaurant’s menus, however, none of this can be placed before the relevant date. There is evidence showing payments for Facebook advertising (Exhibit RV22, page 110), but these are for periods of time in November 2016 which, again, is after the relevant date. There are also exhibits which relate to the planning stage of the restaurant. I accept that the evidence shows that plans were in place (before the relevant date) for a restaurant to be opened called VIRUNDHU, but this does not assist because goodwill relates to use which has generated custom.

17. Exhibit RV20 contains an image said to be a “Google website capture”. According to the date stamp, the image was captured in August 2016. The photograph depicts a restaurant outside of which a banner reads VIRUNDHU. There is no suggestion that the restaurant was open at this point, indeed, Mr Balasubramaniam confirmed that it was not.

18. The onus is on the applicant to establish that it had at the relevant date a protectable goodwill in the UK associated with the name VIRUNDHU. In terms of the restaurant business, I am far from satisfied that a protectable goodwill has been demonstrated. As far as I can see from the evidence, the only public facing use was of the banner placed outside the restaurant, which, if this was in August 2016, was for a minimum of 3 weeks (if it was erected at the end of August) and a maximum of 7 (if it was erected at the beginning of the month). Whilst this can barely be said to be pre-launch advertising, I nevertheless note that there is in any event significant doubt as to whether advertising campaigns without any actual sales to UK customers can create a protectable goodwill. In *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others*, [2015] UKSC 31, Lord Neuberger (with whom the rest of Supreme Court agreed) stated (at paragraph 66 of the judgment) that:

“Finally, a point which I would leave open is that discussed in the judgment of Sundaresh Menon CJ in *Staywell* (see para 46 above), namely whether a passing off claim can be brought by a claimant who has not yet attracted goodwill in the UK, but has launched a substantial advertising campaign within the UK making it clear that it will imminently be marketing its goods or services in the UK under the mark in question. It may be that such a conclusion would not so much be an exception, as an extension, to the “hard line”, in that public advertising with an actual and publicised imminent intention to market, coupled with a reputation thereby established may be sufficient to generate a protectable goodwill. On any view, the conclusion would involve overruling *Maxwell v Hogg*, and, if it would be an exception rather than an extension to the “hard line”, it would have to be justified by commercial fairness rather than principle. However, it is unnecessary to rule on the point, which, as explained in para 46, has some limited support in this jurisdiction and clear support in Singapore. Modern developments might seem

to argue against such an exception (see para 63 above), but it may be said that it would be cheap and easy, particularly for a large competitor, to “spike” a pre-marketing advertising campaign in the age of the internet. It would, I think, be better to decide the point in a case where it arises. Assuming that such an exception exists, I do not consider that the existence of such a limited, pragmatic exception to the “hard line” could begin to justify the major and fundamental departure from the clear, well-established and realistic principles which PCCM's case would involve. In this case, PCCM's plans for extending its service into the UK under the NOW TV mark were apparently pretty well advanced when Sky launched their NOW TV service, but the plans were still not in the public domain, and therefore, even if the exception to the “hard line” is accepted, it would not assist PCCM.”

19. It therefore appears to be clear that advertising under a mark is not sufficient to create an actionable goodwill where there was no imminent prospect of trade commencing at the time: *Bernadin (Alain) et Cie v Pavilion Properties Ltd* [1967] RPC 581. Although pre-launch publicity appears to have been accepted as sufficient to create an actionable goodwill in the cases of *Allen v Brown Watson* [1965] RPC 191 and *BBC v Talbot* [1981] FSR 228, as was explained in paragraph 3-071 of Wadlow's ‘The Law of Passing Off 5th Ed’, the plaintiffs in these cases had long established businesses and goodwill in the UK. I also note that in *Blink* BL O-606-18², Phillip Johnson, as the Appointed Person, reaffirmed the view that pre-launch publicity/trade would not be enough and that the position in *Maxwell v Hogg* (referred to above) remained the law, which was summarised by Sir Hugh Cairns in that case when he stated:

“It is admitted that the case is a new one, and that there is no authority precisely in point, but it must be admitted that the dicta in equity are opposed to the view that such a bill as this can be maintained; and the case of *Lawson v. Bank of London*, and all the definitions which have been given in this Court of the nature of the right to protection in the case of trade marks, seem to me to be opposed

² Although this decision was issued after the hearing in the subject case, I refer to it as merely reinforcing what I consider to be the state of the law.

to the idea that protection can be given where there has been no sale, or offering for sale, of the articles to which the name is to be attached.”

20. In any event, the nature of the pre-launch activity in the subject proceedings (the erection of a banner) is so lacking in significance, together with the short time period prior to the relevant date, together with the fact that there is no evidence demonstrating the imminence or otherwise of the opening of the restaurant and whether, for example, reservations could be made, there still would have been no actionable goodwill at the relevant date in relation to the restaurant business.

21. The applicant’s position is further complicated because the evidence shows that whilst the applicant had taken the lease to the property in which the VIRUNDHU restaurant was to be operated, the restaurant itself is operated by another company, Virundhu Maidenhead Ltd. Thus, it is not even obvious that the applicant itself would have owned any goodwill even if it had been generated.

22. The other aspect of the applicant’s passing-off case is the claim that it was additionally operating (before the relevant date) providing takeaway and catering services. At the hearing, Mr Langton made a number of submissions about inconsistencies in the applicant’s evidence of turnover in its Company House Annual Returns and information provided by its accountant. Whilst this is noted, there is a more fundamental problem. Put simply, the applicant has provided no evidence to show how it presented itself to the public in connection with this aspect of the business. I note that in its statement of case (and thus strictly not evidence) at Section C there is a list of payments made from late 2015 to the relevant date, but there is nothing to show the manner in which this business was attracted, such as menus, brochures, advertisements, leaflets etc, neither are there any invoices or sales invoices. To be relevant in a passing-off case the sign relied upon must be distinctive of the plaintiff³ (in this case the applicant), there is no evidence to test that proposition. My finding is

³ See, for example, *AG Spalding & Bros v AW Gamage Ltd* [1915] 32 RPC (HOL) and *T Oertli, AG v EJ Bowman (London) Ltd* (No.3) [1959] RPC 1 (HOL)

that the applicant has failed to clear the first hurdle of goodwill and, consequently, it has no claim under section 5(4)(a) of the Act; this ground is dismissed.

Section 3(6) of the Act

23. Section 3(6) of the Act provides for a refusal of a trade mark "...if or to the extent that the application is made in bad faith". The relevant law was summarised by Arnold J in the *Red Bull*⁴ case, as follows:

"130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C- 529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT*

⁴ *Red Bull GmbH v Sun Mark Ltd & Anr* [2013] ETMR 53

Trade Marks [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First

Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C- 456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)".

24. The basic claim is that the opponent must have known of the applicant's "established use" of VIRUNDHU and its plans to open a restaurant under that name

and, consequently, filing an application in such circumstances was conduct which fell short of the standards of acceptable commercial behaviour.

25. Mr Balasubramaniam's submissions at the hearing were based on the use that had been made by the applicant of VIRUNDHU, together with the timing of the opponent's application in September 2016 which was not long after the applicant's banner had been erected. He accepted that there was no direct evidence showing that the opponent had knowledge of the applicant's business at the relevant date, but a safe inference could nevertheless be drawn.

26. In respect of the opponent's evidence, Ms Ravithasan states that the opponent first became aware of the applicant in November 2016 when it came across the latter's Facebook page. Steps were then taken to have the applicant's Facebook page taken down. It is also explained (in a lot more detail than I give here) that Mr Thillainathar (her husband) has always had a passion for cooking and that since 2013 the VIRUNDHU mark has been used to promote authentic Sri Lankan cuisine. I note that there are various pages taken from Instagram and Facebook dating back to at least 2015 showing the use of the name VIRUNDHU in connection with various dishes. There is also evidence from 2015 showing the creation of a logo based upon the word VIRUNDHU. It is further stated that from "the early days" there was a plan to open a restaurant under the name, although, it is accepted that this did not happen until June 2017.

27. I can give my findings on the applicant's bad faith claim in a reasonably brief manner. I come to the view that the applicant has failed to establish even a *prima facie* case that the opponent knew about the applicant's business (and the planned restaurant opening) at the relevant date. It is not as though there has been any promotion from which it can be inferred that the opponent must have known of it and, indeed, there is no evidence to show how the applicant was presenting its takeaway/catering business to the public. The highpoint, from the applicant's perspective, is that the opponent must have seen the applicant's banner, but this is nothing more than speculation. Neither is the timing point sufficient to cast doubt on this, even on a *prima facie* basis.

28. Even if there was a question to answer, the opponent has answered it. They state that its knowledge came from a Facebook page in November 2016, which it subsequently asked Facebook to take down. I see no reason to question the probative value of the evidence that has been given, notwithstanding that the protagonists are located reasonably close (around 20 miles) to each other. Furthermore, the fact that the opponent itself was using VIRUNDHU from well before the relevant date (albeit in relation to cookery posts on Facebook and Instagram) supports the proposition that the application was just made in furtherance of its existing usage and plans to open its own restaurant.

29. In what I regard as the extremely unlikely event that the above findings are overturned on appeal, and that the opponent had knowledge of the applicant's plans to open a restaurant, I would not have considered the filing of the application by the opponent to be an act of bad faith. Even if prompted to protect the mark by having seen the applicant's banner, doing so was in furtherance of its existing use of VIRUNDHU and its plans to open a restaurant. Filing an application in such circumstances would, therefore, be viewed as a sensible commercial decision as opposed to an act of bad faith. The claim under section 3(6) of the Act is dismissed.

Outcome of the invalidation proceedings

30. Both grounds of invalidation have been dismissed. The opponent's registered mark may, therefore, remain registered. Consequently, the mark may be taken into account in respect of its opposition to the applicant's mark.

APPLICATION 3207080 - OPPOSITION

Sections 5(1) and 5(2)(a) of the Act

31. I will deal with these grounds briefly. Both provisions require the competing trade marks to be identical. The marks in question are:

VIRUNDHU and Royal Virundhu

32. It is self-evident that the marks are not identical, in the literal sense. However, whilst I accept that literal identity is not required on account of what the Court of Justice of the European Union (“CJEU”) said in *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA* [2003] FSR 34:

“54. In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the Directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

I take the view that the addition of the word ROYAL in the opposed mark, irrespective of Mr Langton’s submission that VIRUNDHU is its dominant element, is far from liable to go unnoticed. Consequently, the marks are not to be regarded as identical and the grounds of opposition under sections 5(1) and 5(2)(a) of the Act are dismissed.

Section 5(2)(b) of the Act

33. Section 5(2)(b) of the Act states that:

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

...

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

34. An “earlier trade mark” is defined in section 6 of the Act:

6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community 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.

35. The opponent’s mark was filed on 20 September 2016. The applicant’s mark was filed on 17 January 2017. Consequently, the opponent’s mark qualifies as an earlier trade mark under the above provisions. The opponent’s mark was only registered in December 2016, within (not before) the five year period ending on the date on which the applicant’s mark was published. Therefore, it is not subject to the use conditions set out in section 6A of the Act. The opponent is, therefore, entitled to rely upon its mark for all the services for which it is registered.

Relevant case-law

36. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*(Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v OHIM* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05P) and *Bimbo SA v OHIM* (Case C-591/12P):

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question. The average consumer 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/services

37. When making the comparison, all relevant factors relating to the goods/services in the specifications should be taken into account. In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*, the CJEU stated:

“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 are complementary.”⁵

38. Guidance on this issue has also come from Jacob J in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)*⁶ where the following factors were highlighted as being relevant when making the comparison:

- (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;

4 - C-397/97, para. 23

5 - [1996] RPC 281

- (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.

39. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

And I also note the further guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE*:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that

responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

40. The competing specifications are set out in the table below:

Applicant’s specification	Opponent’s specification
<p>Class 29: Prepared meals containing meat and vegetables.</p> <p>Class 30: Prepared meals; curry pastes; curry sauces; curry mixes; curry powders; curry seasonings; prepared curry dishes; prepared rice dishes; popadoms.</p> <p>Class 35: Franchising consultancy and administration services relating to restaurants and other establishments or facilities engaged in providing food and drink; retail services connected with the sale of prepared meals containing meat and vegetables, prepared meals, curry pastes, curry sauces, curry mixes, curry powders, curry seasonings, prepared curry dishes, prepared rice dishes, popadoms; information and advice in relation to the aforesaid services.</p> <p>Class 43: Services for providing food and drink; restaurant, bar and catering services; takeaway services; information and advice in relation to all the aforesaid services.</p>	<p>Class 43: Restaurants; Catering services</p>

Class 43

41. I deal first with the applicant's specification in class 43. Here there are some terms which are clearly identical given that the applicant seeks protection for restaurant and catering services, terms covered by the opponent's earlier mark. Further, the applied for services for providing food include within that term's ambit restaurants (covered by the opponent's specification) and are, therefore also deemed identical⁷.

42. That leaves: i) services for providing drink, ii) bar services, iii) takeaway services, and iv) information and advice in relation to everything else in the class 43 specification.

43. In relation to i) and ii), it is common knowledge that drinking establishments will typically serve food and eating establishments will typically service drink. This creates a similar trade channel. The physical nature of the service is similar with customers entering a premises, ordering what they like, and then consuming the offering, often at a table. Obviously, the end purpose differs and in that one is seeking drink on the one hand, food on the other, but often the consumer will want both. I also see a key complementary relationship where one is important to the use of the other, in a manner in which the consumer will assume the same undertaking is responsible for both. I consider there to be a medium degree of similarity.

44. In relation to iii), take-away services, these very often form an adjunct or ancillary service to a restaurant, with the consumer either sitting in, or taking away, the same food. This creates an overlap in trade channels. The inherent nature is not similar, but the purpose is highly so. There is a key aspect of competition. These services are highly similar.

⁷ As per the guidance in *Gérard Meric v OHIM* (Case T-133/05)

45. In my view, information and advisory services have a complementary role to the aforesaid services to which they relate and I would find the same degrees of similarity to the terms already assessed.

Class 29

46. The applied for goods constitute prepared meals. There is clearly a difference in nature because one is a physical product whereas the other is a service. However, in terms of purpose, the goods are purchased, or the service taken, in order to avail oneself of food. The same users are in play, although, this is a relatively superficial aspect of similarity in the present case because one is talking about the general public. The methods of use clearly differ given the difference in nature. The trade channels do not really overlap. However, there is in my view a clear competitive aspect to the goods/service because a consumer may make a choice between going to a restaurant for food, or purchasing a prepared meal for consumption at home. I consider there to be a medium degree of similarity.

Class 30

47. What I have said above applies in equal measure to the prepared meals, prepared curry dishes and prepared rice dishes in class 30. There is a medium degree of similarity.

48. That leaves, in this class: curry pastes; curry sauces; curry mixes; curry powders; curry seasonings; popadoms. There is less similarity here because the goods do not represent a take home meal per se, but they are still used in their preparation as a quick and easy contributor to a meal. There is some similarity in purpose (although to a lesser degree) still in play and still a degree of competition. Further, it is also common knowledge that restaurants may also sell specific items based on their area of specialism (which, given the broadness of the earlier mark's terms, would include restaurants which specialise in curry dishes) which the consumer could take home to create their own dishes. I consider there to be a low degree of similarity overall.

Class 35

49. In relation to the retail services (and associated information), and considering the retail of meals, then whilst the physical nature of the services differ, there is, again, a key similarity in purpose in the sense that they, and the earlier restaurant and catering services, both provide a consumer with food, and a key competitive relationship also exists. I consider there to be a medium degree of similarity. In relation to the retail of the other goods, the relationship is less, but there is at least a low degree of similarity.

50. That leaves:

Franchising consultancy and administration services relating to restaurants and other establishments or facilities engaged in providing food and drink.

51. Even though the services relate to restaurants (and other food/drink establishments), the purpose of the services in comparison to restaurant and catering services is very different. One is to provide food, whereas the other is to provide consultancy and administration to who I would assume to be a business person in the field of restaurant franchising. It follows from this that the inherent nature of the services differ as do the methods of use. The users are also different. The services do not compete. In terms of complementarity, no evidence has been filed to demonstrate the type of relationship which is in play and whether the consumer would expect the same undertaking to provide both. Absent such evidence, I am unable to reach a view in the opponent's favour as it is not obvious to me that the type of relationship is of the sort that would lead to complementarity in accordance with the case-law. I find these services not to be similar; as such, I make no further assessment in relation to these services as without some similarity, there can be no likelihood of confusion.

Average consumer and the nature of the purchasing act

52. In accordance with the case law cited in paragraph 36, I must determine who is the average consumer and the nature of the purchasing act. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that

the average consumer's level of attention is likely to vary according to the category of goods in question⁸.

53. The average consumer of the vast majority of goods and services is a member of the general public wishing to obtain food (and drink) via either food services, retail services or branded food goods. There will be a range of purchasing processes, but none which creates a degree of care and attention that is materially higher or lower than the norm. The selection process will involve a typical range of mechanisms from self-selection (for goods) in a high street or on the internet, pursuing websites, menus (for the class 43 services) etc. Largely, visual considerations predominate although I will not ignore aural considerations completely because they still have a role to play, particularly in relation to some of the class 43 services where bookings etc may be made by telephone.

Comparison of marks

54. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM* that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”⁹

⁸ *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*, C-342/97, para. 26

⁹ C-591/12P, para. 34

55. It would be wrong, therefore, to artificially dissect the marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

56. The respective marks are: **VIRUNDHU v Royal Virundhu**

57. The opponent's mark is the word VIRUNDHU solus and, consequently, that word is the only thing that contributes to its overall impression. The applicant's mark is Royal Virundhu, a two word mark, but one in which neither words takes on greater visual prominence. The structure of the mark will not give rise to an impression that the two words perform independent roles within the overall impression. Consequently, the overall impression is based on the two words combined, with neither materially dominating the other and both contributing to the mark's distinctive character.

58. Visually and aurally, that both marks contain the word VIRUNDHU means that there is an inevitable degree of similarity. However, there is also an aural and visual difference on account of the absence/presence of the word ROYAL. That the difference is at the beginning of the mark (ROYAL being the first word in the opponent's mark) does not in my view strengthen the difference in this case. I consider there to be a medium degree of visual and aural similarity.

59. In terms of concept, whilst evidence has been provided to show that the word VIRUNDHU is a Tamil word meaning feast, the vast majority of average consumers will have no knowledge of that. For them, the word VIRUNDHU will be regarded as either invented (thus having no meaning) or a foreign word the meaning of which they do not know. Thus, there is no conceptual similarity between the marks. Having said that, I do not consider that the inclusion of the word ROYAL in the applied for mark creates a strong difference either because, as a whole, the Royal Virundhu mark has no clear meaning. For people who know the meaning of the word VIRUNDHU then there is clearly a strong conceptual similarity, however, for reasons that will become apparent, this has little significance to my decision.

Distinctive character of the earlier trade mark

60. Having compared the marks, it is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

“In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”¹⁰

61. From an inherent perspective, the opponent’s earlier mark, VIRUNDHU, will, as I have already stated, have no meaning to the vast majority of average consumers. It will strike them as a very unusual word. The mark has a high degree of inherent distinctive character. There had been no use of the earlier mark in relation to the services for which it is registered (use of the word VIRUNDHU in relation to cookery posts on Facebook and Instagram are not considered to be use of the mark for

¹⁰ C-342/97, paras. 22-23

restaurant and catering services) at the point when the applicant's mark was filed, consequently, there can have been no enhancement of distinctive character.

62. For those people that know of the meaning of the word VIRUNDHU then, clearly, given that it means "feast", the degree of inherent distinctive character will be significantly less.

Conclusions on likelihood of confusion

63. I have so far considered the factors that need to be taken into account when assessing the likelihood of confusion and now come to a global assessment. As the CJEU stated:

"A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified."¹¹

64. There are two types of confusion that must be considered:

- direct confusion, where one mark is mistaken for another; and
- indirect confusion, where the similarities lead the consumer to believe that the goods or services come from the same, or a related, undertaking.

¹¹ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, C-39/97, para. 17

65. Before giving my views, I should say that I will approach the matter purely from the perspective of the average consumer who does not know the meaning of the word VIRUNDHU. This is not only because they represent the vast majority of average consumers, but also because they are in my view the most likely average consumers to be confused. Whilst I accept that those who know the meaning of the word, as “feast” (and will therefore regard it as less distinctive), are less likely to be confused (although I make no formal finding to that extent), it does not matter that there may be a small group of consumers who are not confused. The Tribunal is concerned with guarding against confusion. Therefore, those who could potentially be confused in the first category of consumer I have identified, which represents the majority, is more important in my assessment.

66. Considering first the identical services in class 43, I come to the view, notwithstanding the difference on a visual and aural basis created by the addition/omission of the word ROYAL, that there is a likelihood of direct confusion. This is, in my view, largely down to the high distinctiveness of the word VIRUNDHU coupled with the much lower level of distinctiveness inherent in the word ROYAL, which, although both these words have the same visual impact, means that the most memorable aspect (particularly bearing in mind that neither have a clear concept) will be VIRUNDHU, and which, in turn, increases the prospect of the marks being misremembered/misrecalled. I should add that Mr Balasubramaniam’s point that consumers would not be confused due to the different types of cuisine being offered is not pertinent because the specifications are not limited in scope in this way and, in any event, both provide Asian food so any distinguishing capacity is limited in the extreme.

67. However, even if I am wrong on my finding of direct confusion, I must also consider indirect confusion, in relation to which I note that in *L.A. Sugar Limited v By Back Beat Inc*; Case BL O/375/10 Mr. Iain Purvis Q.C., sitting as the Appointed Person, stated:

“..... Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious

but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

68. However, I also note that in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr. James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made simply because the two marks share a common element. Whilst guarding against finding indirect confusion simply because the marks share a common word, I come to the very clear view that the average consumer will put the common presence of the word VIRUNDHU in the respective marks down to the responsible undertakings being the same or being related. Put simply, that point of similarity is so distinctive that the average consumer would assume than no one else would likely make use of such a word. The position is strengthened by the fact that the point of difference (the word ROYAL) is not itself particularly distinctive (having

suggestions of a laudatory nature) and qualifies the word VIRUNDHU. To come to an opposite view would mean that the average consumer would put the point of similarity down to pure co-incidence – this is, in my view, highly improbable. There is a likelihood of indirect confusion in relation to the identical services in play.

69. I now turn to the other goods and services. In relation to the other services in class 43, I come to the view that my findings of confusion (both direct and indirect) apply here also. The relationship between the services in play and the overall assessment of confusion I have already made results in the average consumer also believing that the goods and services will have come from the same trade source. This also applies to the services in class 35 for the retail or meals, because that link between the services, together with the other factors will also lead to confusion.

70. I accept that there is greater room for argument in relation to the physical goods in classes 29 and 30, however, again, the level of distinctiveness of VIRUNDHU is such that the “no-one else” assumption will equally apply in relation to the goods/services even though the level of similarity is lower, and even though it is lower again in relation to curry, popadoms (and their retailing) etc. In summary, I consider that there is a likelihood of confusion in relation to all of the goods and services for which I have found some similarity.

71. Irrespective of the above, the ground must fail in relation to the franchising/administrative services in class 35 because, as stated earlier, some similarity between the respective services is a prerequisite for success.

Section 5(4)(a) of the Act

72. I have already set out the relevant legislation and case-law. It is only worth considering this ground of opposition in relation to the franchising/administrative services, for which the opposition has so far failed. Given that I have already found in favour of the opponent for all of the other goods and services, it is not in any better position under section 5(4)(a) in respect of them.

73. The relevant date is 17 January 2017 (the filing date of the contested trade mark). It will not be necessary to consider the position at any earlier date given the findings I have already made in relation to the applicant's evidence.

74. In terms of goodwill at the relevant date, the opponent cannot rely on its restaurant business because it is accepted that it had yet to open at that date. The evidence from before the relevant date comprises Facebook and Instagram posts and what is said to be the provision of catering services. In relation to the catering services, the opponent has failed to provide any sales figures either in terms of revenue or customers. All that is provided is a single invoice (for £510) dated 20 August 2016 for catering at a party. As this is all I can rely upon, I come to the clear view that this is trivial goodwill.

75. That leaves the social media posts. There are, though, a number of problems with this evidence in terms of establishing an actionable goodwill at the relevant date. My concerns are as follows:

- Although Ms Ravithasan gives the number of people who like/follow the pages (around 1600 for each platform), her evidence is given at the end of 2017 and the position at the earlier date (almost a year earlier) may well have been much lower. This is re-enforced by the fact that the opponent's restaurant opened in June 2017 which no doubt would have led to more likes/follows being received.
- Some of the posts before the relevant date do contain the number of views, the highest being just over 500. However, as the print was taken after the relevant date, it is not even clear what proportion of such views were made before the relevant date and what proportion after.
- Although the social media posts show pictures of food, they are little more than a picture together with a description of what the dish is. I raise this because goodwill is the attractive force that brings in custom. Whilst sales of goods/services for money is not a pre-requisite, it is difficult on the face of it to see what custom is actually being brought in. Reference is made by Ms Ravithasan to recipes, but none of the posts provided give a recipe and

reference is also made to promoting the catering services, a service which, on the face of it, is trivial. It is not as though any of the posts mentioned that catering services were available.

76. The net effect of the above is that, in my view, the opponent has failed to establish a non-trivial goodwill, in fact, the nature of the use is symptomatic of no goodwill (in the sense of the attractive force bringing in custom) at all. This means that the opponent's claim under section 5(4)(a) fails at the first hurdle.

77. Even if I am wrong on the above, any goodwill will have been of a very low level, in what would be characterised as some form of use promoting Sri Lankan foods, in a very general manner. It would in my view be a step too far, despite the inclusion of VIRUNDHU in the competing signs/marks, for that type of goodwill to be actionable in relation to the franchising and administrative services that I am now considering. I would therefore hold, in the alternative, that there would be no misrepresentation when all the relevant factors are considered¹².

Outcome of the opposition proceedings

78. The opposition succeeds under section 5(2)(b) save in relation to the franchising/administration services. The opposition under section 5(4)(a) fails.

¹² See, *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473 and *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA).

OVERALL OUTCOME

- i) Virundhu Restaurant Limited's registration no. 3186761 may, subject to appeal, remain registered for all of its services, the grounds for invalidity having failed.
- ii) Virundhu Limited's trade mark application is to be refused registration in part, the grounds of opposition having partially succeeded, but, subject to appeal, it may proceed to registration in respect of:

Class 35: Franchising consultancy and administration services relating to restaurants and other establishments or facilities engaged in providing food and drink; information and advice in relation to the aforesaid services.

OTHER ISSUES

Cross-examination of Mr Balasubramaniam

79. It is not lost on me that the cross-examination of Mr Balasubramaniam has not featured as part of any of my substantive findings or key points of evidence. The cross-examination was directed to deal, primarily, with a conflict of evidence relating to a meeting between Mr Balasubramaniam and Mr Ravithasan Thillainathar that took place (at the latter's home, or more accurately his driveway) after Facebook had contacted the former to take down his Facebook page.

80. The conflict of evidence related to whether Mr Ravithasan Thillainathar had invited Mr Balasubramaniam to his home to discuss the respective business names and that Mr Ravithasan Thillainathar had given consent to use the VIRUNDHU name which by that time had been filed by the opponent.

81. The reason none of this has featured in my substantive finding is because there was nothing in the testimony that got close to assisting on whether the opponent had in fact filed its application in bad faith. The only sense one got was of two businessmen

meeting to discuss a problem that had arisen. Therefore, whilst Mr Balasubramaniam came across as a generally reasonable witness (although I have reservations as to whether he was invited to the house or whether he went there with an acquaintance of his who knew Mr Thillainathar) I need say no more about his testimony. I should also add that Mr Langton did not refer to the cross-examination during his submissions on the substantive case.

Costs

82. The opponent has been largely successful and is, therefore, entitled to a contribution towards its costs. My costs assessment is as follows:

Official fee for opposition – £200

Preparing a statement of case and considering the counterstatement in the opposition and vice versa in the invalidity - £600

Filing and considering evidence - £1000

Preparing for and attending the hearing - £600

83. I therefore order Virundhu Limited to pay Virundhu Restaurant Limited the sum of £2400. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 23rd day of October 2018

Oliver Morris

For the Registrar,

the Comptroller-General