

O-586-20

TRADE MARKS ACT 1994

**IN THE MATTER OF
UK TRADE MARK REGISTRATION NO. 3320388
IN THE NAMES OF MANINDER SINGH KHANEJA AND SUKHWANT SINGH
KHANEJA:**



**AND
AN APPLICATION FOR A DECLARATION OF INVALIDITY UNDER NO. 502650
BY RESHAM SINGH BHANGRA**

Background and pleadings

1. Trade mark registration number 3320388 stands in the names of Maninder Singh Khaneja and Sukhwant Singh Khaneja (“the proprietors”). The application for the trade mark was filed on 25 June 2018 and the mark was registered on 21 September 2018 in respect of “restaurant and bar services” in class 43.

2. On 21 June 2019, Resham Singh Bhangra (“the applicant”) filed an application for a declaration of invalidity. The application is made under the provisions of s. 47 and ss. 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).¹ Under ss. 5(2)(b) and 5(4)(a), the application is directed against all of the services in the contested mark. The application under s. 5(3) lists, at the questions concerning the scope of the attack, the specifications of the applicant’s marks rather than the services in relation to which invalidation is sought. The proprietors did not seek clarification of this issue. For reasons which will become apparent, it is unnecessary to dwell on this. I will proceed on the basis that the s. 5(3) ground is directed against all of the services in the specification.

3. Under both ss. 5(2)(b) and 5(3), the applicant relies upon the following two trade marks, to the extent shown below:

(i) UK trade mark registration number 2180906 (series of two) (“UK906”):



Filing date: 30 October 1998; registration date: 11 June 1999

¹ Claims under ss. 3(1)(b), (c) and 3(6) were dropped during proceedings.

Class 42: Restaurant services; cafeteria and bar services; food cooking services; catering services for the provision of food and drink.²

(ii) UK trade mark registration number 2438529 (series of three) (“UK529”):

HAANDI
Haandi
Haandi

Filing date: 15 November 2006; registration date: 28 March 2008

Class 43: Café, restaurant and bar services; catering services; provision of food and drink to eat-in and takeaway; advisory services relating to café, restaurant, bar and catering services; advisory and information services relating to the selection, preparation and serving of food and beverages.

4. The applicant claims under s. 5(2)(b) that the contested mark is similar to the earlier marks because of the identical element “Haandi”, the similarity of the fonts and flame device above the letter “i” and, in respect of UK906, the depiction of “a haandi cooking pot” and the colours of the marks. The services are said to be similar “as both trade marks are used in relation to restaurant services provided in the London area which specialise in upmarket Indian cuisine”. This will lead to a likelihood of confusion, including the likelihood of association.

5. Under s. 5(3), the applicant’s claim is that the relevant public will believe that the respective trade marks are used by the same undertaking, or that there is an economic connection between the users of the trade marks. It is asserted that the applicant operates a number of restaurants which use the earlier marks and that he has been notified by customers that they have confused the trade marks and, in some cases, visited the

² At the time of filing, the 7th edition of the Nice classification was in force and these services were properly classified in class 42.

proprietors' restaurant in error. It is further alleged that the proprietors' website is very similar to the website for the applicant's restaurant, the latter publicising the fact that it is part of a chain.

6. Under s. 5(4)(a), the applicant relies upon two signs, both of which are said to have been used in London since 2000. The first is:



It is said that this sign has been used in relation to “restaurant services; cafeteria and bar services; food cooking services; catering services for the provision of food and drink”.

7. The second sign relied upon under this ground is:



This sign is asserted to have been used in respect of the following goods and services:

Café, restaurant and bar services; catering services; provision of food and drink to eat-in and takeaway; advisory services relating to café, restaurant, bar and

catering services; advisory and information services relating to the selection, preparation and serving of food and beverages.

Packaging and delivery of food and drink products.

Prepared meals and snack foods including chutneys; sauces and spice mixes.

8. The applicant claims that there is a significant goodwill attached to the goods and services provided under the signs and that use of the contested mark would amount to a misrepresentation to the relevant public. It is alleged that the public has been led to believe that the services offered under the contested mark are the services of the owner of the signs. It is alleged that there have been instances of confusion. It is said that there is significant similarity between the mark and the signs and that the services are identical. It is also said that “the confusion is causing damage to the registered owner of the first mark by way, but not limited to, of dilution of the reputation of his business and loss of custom/profit”.

9. The proprietors filed a counterstatement denying the grounds of invalidation. They highlight a number of differences between the trade marks, which they say result in the trade marks being “clearly not similar”. There are also various allegations about the applicant’s conduct, which are not relevant to the grounds at issue and which I do not repeat. In addition, the proprietors point to the registration by the applicant of more than one trade mark containing the word “Haandi”. This latter point appears to reflect a misunderstanding of the trade mark system. There is nothing unusual in a trade mark owner registering variations of their trade mark, nor is there anything improper in the Registry allowing the registration of subsequent trade marks which include an identical word: the trade mark system in the UK is no longer one in which the Registry raises relative grounds objections (i.e. those arising from other trade marks present on the Register, or indeed in use). If an owner wishes to challenge a later trade mark, they must oppose it or apply for a declaration of invalidity, as has happened here. For obvious

reasons, when the same party owns both trade marks it would be most unusual for it to instigate such a challenge. I will, therefore, say no more about this issue.

10. Given their dates of filing, the applicant's trade marks qualify as earlier marks in accordance with s. 6 of the Act. In the application for invalidation, the applicant indicated that the marks have been used for all of the services relied upon. This statement is made because, as the marks had completed their registration procedure more than 5 years before the date of the application for invalidation, they are in principle subject to the proof of use provisions contained in s. 47(2A) – (2E) of the Act. However, the proprietors indicated in their counterstatement that they did not require proof of use. That being the case, the applicant may rely upon all of the services identified without showing that his trade marks have been used.

11. Both parties filed evidence. Neither party requested a hearing. Only the applicant filed written submissions in lieu, through his professional advisors, which I will bear in mind and refer to as appropriate in the course of this decision. This decision is taken following a careful reading of all of the papers. The applicant is represented by Blaser Mills Law; the proprietors are litigants in person.

Evidence

12. The applicant's evidence consists of the witness statements of Resham Singh Bhangra, the applicant and owner of "the 'Haandi' chain of restaurants", and Aaron Wood, a trade mark attorney at the applicant's professional representatives. The proprietors' evidence is provided by Maninder Singh Khaneja. I have read all of the evidence. I do not intend to summarise it here but will return to it as appropriate later in this decision.

Section 5(2)(b)

13. Section 5(2)(b) of the Act reads as follows:

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

[...]

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

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

14. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

15. The written submissions filed on behalf of the applicant make it clear that the strongest case under s. 5(2)(b) is considered to be that based upon the first mark in UK529's series. I will, therefore, start with that mark and return to the others only if necessary.

Comparison of services

16. The contested specification is "restaurant and bar services". The same term is in the earlier mark's specification, as relied upon. These services are self-evidently identical.

The average consumer and the nature of the purchasing act

17. It is necessary for me to determine who the average consumer is for the respective parties' services. I must then decide the manner in which these services are likely to be selected by the average consumer in the course of trade. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch) at [60]. For the purposes 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/services in question: *Lloyd Schuhfabrik*.


18. The average consumer of the identical services at issue is a member of the general public. The services are likely to be chosen reasonably frequently, with some attention to the type of cuisine offered, the cost of the services and the nature of the establishment. The level of attention is, therefore, likely to be medium. The selection is likely to be predominantly visual, as the average consumer will see the marks on websites, advertising matter both in print and online, and on the premises themselves. I do not discount that there may be an aural element to the selection of the services, arising primarily from oral recommendations.

Comparison of trade marks

19. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel* (particularly paragraph 23). *Sabel* 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 Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in *Bimbo*, 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”.

20. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

Earlier mark	Contested mark
<p>HAANDI</p>	

21. The earlier mark consists of the word “HAANDI” presented in capital letters. It is unclear from the register whether the mark is a word mark or is figurative. Proceeding on the basis that it is the latter, the typeface is minimally stylised and unlikely to be noticed by the average consumer. The overall impression of the mark is dominated by the word “HAANDI”.

22. The contested mark has a number of elements, all presented in shades of copper on a black background. Starting at the top of the mark, there is a letter “C” boxed in by four straight lines forming a diamond shape. Within the curve of the “C” is a flourish device; it may be intended to resemble an “H” but its level of stylisation is such that, in my view, it is unlikely to be perceived in that way. Beneath the “C” device are the words “Copper Haandi”. The typeface is somewhat stylised, including straight lines over the lower-case

letters and small diamond shapes positioned in the “C” and above the vowels. The words “FINE INDIAN DINING & BAR” appear in a much smaller, plain typeface below. The final element is a stylised device of a steaming pot, in outline. The words “Copper Haandi” have the most impact in the overall impression, given their central position and size, along with the general tendency of words to speak louder than devices, which I consider applies here. The “C” device has slightly less force than the words “Copper Haandi” but still plays a reasonable role. The pot device has a weaker impact, given that it has limited distinctiveness for restaurant services, whilst the words “FINE INDIAN DINING & BAR” are non-distinctive and play only a very minor role.

23. As regards the visual comparison, the only element which is shared by the respective trade marks is the word “Haandi”. There are differences because of the additional verbal and device elements in the contested mark. However, with my assessment of the overall impression in mind, there is a medium degree of visual similarity overall.

24. In the contested mark, only the words “Copper Haandi” are likely to be articulated: the devices will not be verbalised and the descriptiveness of “FINE INDIAN DINING & BAR” renders it unlikely to be spoken. The word “HAANDI” is likely to be articulated as “HANDY” by the average UK consumer, in both the earlier and the contested mark. I accept that there may be other pronunciations but, even if that is the case, the same word in the respective marks will be pronounced in an identical fashion. There is a medium degree of aural similarity.

25. It appears to be acknowledged by both parties that a “haandi” is a type of cooking pot, though I did not understand either to be asserting that the average consumer would know that to be the meaning of the word. Whilst there may be a group of consumers who do understand the actual meaning of “haandi”, the services at issue are restaurant and bar services at large. These are mainstream services for which the average consumer is, as I have already held, the general public. The vast majority of the general public will not attribute any particular meaning to the word “haandi”, though some may speculate as to its meaning in the contested mark, given the context in which it is presented. Therefore,

for the average consumer, who is the public at large, the earlier mark is without meaning. The contested mark also contains the word “Copper”, which will be taken to mean either a colour or the metal. This introduces a conceptual difference between the respective trade marks. Although the words “FINE INDIAN DINING & BAR” introduce a conceptual difference, it is not a distinctive difference.

Distinctive character of the earlier trade mark

26. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

27. I have indicated that the average consumer is unlikely to perceive “haandi” as having any meaning. It will be perceived as an invented or unknown foreign word and it is, as a consequence, inherently distinctive to a high degree.

28. The applicant has filed some evidence concerning the use of his trade mark. There were, at the date of his statement in December 2019, four restaurants trading under the “Haandi” name.³ One of these is in Knightsbridge, where it opened in 2000; the remainder are in Africa. A second UK restaurant closed in 2013. Undated images of the London premises, menus and the website are in evidence.⁴ The UK branch won a number of awards in 2004/2005.⁵ It also won two prizes at the London Curry Awards in May 2018.⁶ A print from the TripAdvisor website dated 27 September 2019 shows the restaurant had received 300 reviews and was ranked 2,397 of over 19,000 restaurants in London. Five press reviews including discussion of the UK restaurant are provided but, save for two which are from 2001, these are not dated.

29. The evidence falls a long way short of establishing that the earlier mark was known to a significant proportion of average consumers at the relevant date (i.e. 25 June 2018). The reviews are either undated or almost twenty years old. Most of the awards are also many years old. The mere fact that the applicant won two awards in London in 2018 does not demonstrate that the earlier mark was known to any significant extent in the UK, or even in London, at the relevant date. Three hundred votes on TripAdvisor (the evidence of which is from after the relevant date) are far from sufficient to establish enhanced distinctiveness in a market which has many thousands of restaurants in London, let alone nationwide, and even greater customer numbers. The existence of restaurants in Africa is of no relevance, as the evidence goes no distance to establishing that the UK consumer would have any knowledge of them. The UK presence itself is limited to one restaurant, as to which there is no evidence of turnover or advertising spend, or any significant presence in the media. There has been no enhancement of the mark’s distinctiveness.

³ Bhangra, §3.

⁴ Exhibit RB1.

⁵ RB1, pp. 11-13. One further award (at RB1 p. 14) is not dated.

⁶ Bhangra, §10.

Likelihood of confusion

30. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]). Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, whilst indirect confusion involves the consumer recognising that the marks are different but nevertheless concluding that the later mark is another brand of the earlier mark owner. The difference between these two types of confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, where Iain Purvis Q.C. explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized 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”).

31. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls another mark to mind. That is mere association not indirect confusion.

32. Although the services are identical and the earlier mark inherently highly distinctive, my view is that there is no likelihood of one trade mark being mistaken for the other, because of the additional verbal and figurative elements in the contested mark. The differences arising from these elements are sufficient to neutralise the risk of direct confusion, even allowing for a medium degree of attention and imperfect recollection on the part of the consumer.

33. The position is different concerning indirect confusion. The shared element “Haandi” is highly distinctive. I accept that the phrase “Copper Haandi” does not suggest an ordinary brand extension in the way envisaged by Mr Purvis at (b) and (c) above. However, the distinctiveness of “Haandi” is such that, when used on identical services,

the average consumer who has encountered one mark is likely to think that the other mark is a different mark used by the same or a connected undertaking, as envisaged in Mr Purvis's category (a). The visual and conceptual differences introduced by the additional verbal and figurative elements in the contested mark are insufficient to dispel the likelihood of confusion on this basis. There is a likelihood of indirect confusion. The application for a declaration of invalidity succeeds under s. 5(2)(b).

34. For the avoidance of doubt, the position on confusion would not have been different had I found that the average consumer will know that a "haandi" is a cooking pot. That is because there would, in those circumstances, have been conceptual similarity to a medium degree (because both marks would share the concept of a cooking pot but there would be the same differences as elaborated at paragraph 25, above). In those circumstances, the addition of "Copper" would be seen as qualifying "Haandi" and would make it more, not less, likely that the contested mark would be seen as a brand extension.

35. I have assessed the action on the basis of the best case put forward by the applicant, which has been successful. I see no need to consider the remaining marks, which cannot, as the applicant accepts, improve its position.

Final remarks under s. 5(2)(b)

36. I have made this decision without reference to the applicant's claim of actual confusion. The implication in Mr Bhangra's statement is that such confusion has been relatively recent, given that he says consumers have been confused "by the 2018 Trade Mark". However, it is unclear how many occasions of actual confusion there have been or the exact nature of the confusion on any given occasion. The allegation appears to be that at least some customers have dined at the proprietors' restaurant in the belief it was part of the applicant's chain but the applicant's evidence on this matter amounts to no more than an assertion and is too imprecise to make good the claim. Internet searches for a particular term are of no assistance in showing actual confusion in the marketplace: it is unsurprising that a search for "haandi" shows results for both parties' restaurants but

such results do not show that the consumer was confused in any resulting purchasing decision.

37. I have also not addressed the proprietors' claims concerning the locations of the parties' premises or the assertion that the applicant's customers are (East African) tourists. That is because the assessment of the likelihood of confusion under s. 5(2)(b) is a notional comparison between the trade marks and their respective specifications.⁷ The physical distance between the restaurants is not a relevant factor in this assessment, nor are the alleged differences between the parties' customers, because such differences are not evident from the specifications at issue. For the sake of completeness, I would also add that, insofar as the proprietors' comments are intended to present a defence of honest concurrent use, there is very limited evidence of trading on both sides (the applicant's evidence I have discussed above; the only evidence of the proprietors' trading activities are undated photographs of a restaurant frontage, appearance in Google search results and a two TripAdvisor pages, one of which is undated and the other bears only a printing date of March 2020).⁸ This is not sufficient to show that there has been a long period of concurrent trade in which the average consumer has become accustomed to distinguishing between the respective parties' trade marks.⁹

Section 5(3)

38. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United

⁷ See *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41) at [22], *Roger Maier v ASOS* [2015] EWCA Civ 220 at [78] and [84] and *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 (CJEU).

⁸ Exhibits CH-3, CH-8 and RSB1, pp. 15, 19.

⁹ The leading case on honest concurrent use is *Budejovicky Budvar NP v Anheuser-Busch Inc*, Case C-482/09. See also *Budejovicky Budvar NP v Anheuser-Busch Inc*, [2012] EWHC Civ 880.

Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

39. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, EU:C:1999:408, *General Motors* [1999] ETMR 950; Case 252/07, EU:C:2008:655 *Intel*, [2009] ETMR 13; Case C-408/01, EU:C:2003:582, *Adidas-Salomon*, [2004] ETMR 10; and C-487/07, EU:C:2009:378, *L’Oreal v Bellure* [2009] ETMR 55; and Case C-323/09, EU:C:2011:604, *Marks and Spencer v Interflora*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there

is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

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

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

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

coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

Reputation

40. In *General Motors*, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it”.

41. The evidence filed to support the assertion of the earlier mark's reputation is not at all compelling. On the contrary, there is a total absence of sales figures, turnover, market share information, advertising or any recent media interest in the mark. For essentially the same reasons as given at paragraph 29, above, the evidence does not come near to

supporting the claim to a reputation under s. 5(3). The application for invalidation under this ground is dismissed.

Section 5(4)(a)

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

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

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

(aa)

(b)

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

[...]

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

43. Whether there has been passing off must be assessed at a particular point or points in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11 at [43], Daniel Alexander QC, as the Appointed Person, 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.’”.

44. 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, conveniently summarised the essential requirements of the law of passing off as follows:

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

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

45. It has long been held that the law of passing off does not protect a goodwill of trivial extent: *Hart v Relentless Records* [2002] EWHC 1984 (Ch) at [62]. In *Smart Planet*

Technologies, Inc. v Rajinda Sharm, BL O/304/20, Mr Thomas Mitcheson QC, as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

“[...] a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon”.

46. Notwithstanding such cautions, it is possible for a business with a small goodwill, provided that it is more than a trivial goodwill, to protect a sign which is distinctive of that business under the law of passing off.¹⁰

47. The pleaded case under s. 5(4)(a) is that the two signs shown at paragraphs 6 and 7, above, are relied upon. In the applicant’s written submissions, it is said that “we believe it will be commonly understood between the parties that this was intended to identify 5 different marks and that you should treat that part of the invalidation as such”. I am doubtful that it would be safe to proceed in that way, especially as the proprietors are not represented and it is the responsibility of a party pleading a point to make it clear. However, it is unnecessary for me express a concluded view on this issue.

48. There is before me no evidence of the level of sales enjoyed by the applicant’s business, either in the UK or elsewhere. Although some of the reviews in evidence refer to the other restaurants in the chain, these are no more than passing references and are insufficient to establish that any reputation associated with the African restaurants would

¹⁰ See, for example, *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, *Stannard v Reay* [1967] FSR 140 (HC) and *Teleworks v Telework Group* [2002] RPC 27 (HC).

have been known to the relevant public in the UK. The reviews themselves are not of particular assistance, since they do not on their own show that the applicant's business had any particular presence on the market at the date of application or earlier, particularly as only two are dated. There is some evidence that the restaurant won awards, one of which is explicit that it is awarded on merit. However, in the absence of more cogent evidence of the scale of the restaurant business, this limited evidence does not assist in determining the extent to which the applicant's business was known to the relevant public or whether there was a goodwill of more than trivial extent. I note that there are undated prints in both the applicant's and the proprietors' evidence showing "HAANDI BITES" on the applicant's website, which appear to relate to food goods. However, there is no indication of the level of sales achieved for these goods. The evidence overall is insufficient to establish that the applicant's business had a protectable goodwill at any time. The opposition based upon s. 5(4)(a) is dismissed.

Conclusion

49. Although the application for a declaration of invalidity has failed under ss. 5(3) and 5(4)(a), it has been successful under s. 5(2)(b). The trade mark is hereby declared invalid with effect from 25 June 2018.

Costs

50. The applicant has been successful and is entitled to an award of costs. I see no reason to depart from the normal Registry scale, contained in Tribunal Practice Notice 2/2016, in this case. Bearing in mind the very thin evidence, in all respects, filed by both parties, I award costs to the applicant as follows:

Official fee:	£200
Filing the application and considering the counterstatement:	£200
Filing evidence and considering the other party's evidence	£500
Written submissions in lieu of a hearing:	£300
Total:	£1,200

51. I order Maninder Singh Khaneja and Sukhwant Singh Khaneja jointly and severally to pay Resham Singh Bhangra the sum of **£1,200**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20th day of November 2020

**Heather Harrison
For the Registrar
The Comptroller-General**