

TRADE MARKS ACT 1994

IN THE CONSOLIDATED MATTERS OF:

(1) UK TRADE MARK REGISTRATION NO. 2401680 IN THE NAME OF POOJA SWEETS & SAVOURIES LTD AND INVALIDITY APPLICATION NO. 84010 THERETO BY POOJA SWEETS LIMITED; AND

(2) UK TRADE MARK APPLICATION NO. 2576986 IN THE NAME OF POOJA SWEETS & SAVOURIES LTD AND OPPOSITION NO. 102596 THERETO BY POOJA SWEETS LIMITED

APPEAL TO THE APPOINTED PERSON FROM THE DECISION OF DAVID LANDAU DATED 24 SEPTEMBER 2013

DECISION

INTRODUCTION

1. This case involves appeals by both sides against aspects of a lengthy decision issued by Mr David Landau, acting for the Registrar, on 24 September 2013 (O-384-13 – “**the Decision**”) made in consolidated proceedings comprising:

(1) an application for invalidity brought by Pooja Sweets Limited against UK trade mark registration no. 2401680, filed on 16 September 2005 and granted on 3 November 2006 in classes 29, 30, 35 and 43 in the name of Pooja Sweets & Savouries Ltd in respect of this series of two marks



(“**the Registration**”); and

(2) an opposition by Pooja Sweets Limited to UK trade mark application no. 2576986 in classes 29, 30, 35 and 43 by Pooja Sweets & Savouries Ltd in respect of this series of two marks

POOJA
SWEETS & SAVOURIES

POOJA
SWEETS & SAVOURIES (“the Application”).

For convenience, I adopt the Hearing Officer’s nomenclature for the parties: “**Tooting**” for Pooja Sweets & Savouries Ltd, which is based in Tooting, London; and “**Wolverhampton**” for Pooja Sweets Limited, based in Wolverhampton.

2. Underlying these proceedings is an objection by Wolverhampton to Tooting’s registration of marks containing the word POOJA. The objection has been put on several (sometimes inconsistent) bases, including: that “pooja” is generic for goods and services that are for use in Hindu ceremonies known as poojas (or pujas); that the use of “pooja” in a trade mark indicates that the goods and services have been prepared with only a certain purity of ingredients and with devotion in the manner of preparation, such that they are expected to be “holy or blessed” according to Hindu traditions and beliefs; that “pooja” cannot be used for meat products since Hinduism advocates vegetarianism; that, since Tooting is run by Muslims, the marks conflict with the notion of devoutly prepared food fit for Hindu pooja; that “pooja” is a key word in Hinduism and its registration and appropriation by anyone (whether Hindu, Muslim, or whatever) is offensive to Hinduism; that the marks infringe the copyright of Hindu religious scriptures; and that – notwithstanding the foregoing – Wolverhampton has prior passing off rights in relation to the mark POOJA SWEETS & SAVOURIES and a device that incorporates these words.
3. By way of brief introduction to the counter-arguments, Tooting asserts that “pooja” has many meanings and that, while it can be used to describe a form of ritual worship, it is not a sacred term as such and it is certainly not restricted or reserved for use by Hindus. Further, it is a name used for a variety of businesses (not limited to those involving Hindu rituals) in India, and is also used as a girl’s name and nickname (including that of an individual who is actually involved in Tooting’s business and that of the daughter of Mr Ram Joshi who runs Wolverhampton’s business). In any event, neither the Registration nor the Application are for the word “pooja” alone, and each of the marks as a whole is such as to be able to avoid the various objections raised.
4. Tooting has been using the name “Pooja” in association with its business since 1996, initially as “Pooja Sweets” and then, from 2001, “Pooja Sweets & Savouries”. The business was incorporated under its current name, “Pooja Sweets & Savouries Ltd”, on 18 October 2002. It is run by both Muslims and Hindus, and its primary trade is and always has been in making and selling vegetarian sweets and savouries to people of all religions (or no religion), including for a range of festivals (such as Eid, Diwali and

Christmas), celebrations, group meetings and special events. It has operated a website at www.poojasweets.com since 2003, and has been recognised as a successful business by local newspapers and in other media.

5. For its part, Wolverhampton was originally incorporated under the name “Pooja Sweets & Savouries Limited” on 10 September 2007. Tooting spotted this and complained to Companies House that it was too similar to its own name. Companies House agreed and directed Wolverhampton to change its name, which it did – to “Pooja Sweets Limited” – on 24 January 2008. Tooting has also in the past asked Wolverhampton to stop using a trade mark very similar to its own and has tried to have settlement discussions to resolve the dispute, but without success. It is not clear from the file whether the dispute about use on the market continues, but it does not matter for the purposes of my decision. I simply relate the outline facts above, in order to explain the background to the dispute, which is set out much more fully in the Decision.
6. Returning to the issues in the case, Wolverhampton based both the invalidity application and the opposition on multiple grounds of attack under the Trade Marks Act 1994 (“**the Act**”), including: absolute grounds objections under sections 3(1)(b), (c) and (d), 3(3)(a) and (b), and 3(4); a bad faith objection under section 3(6); and an objection under section 5(4)(a) based on alleged prior passing off rights. All of the goods and services covered by the Registration and the Application were attacked.
7. The hearing officer expressed some frustration at the scope and presentation of the grounds of invalidity and of opposition, describing the written grounds as “diffuse and rambling” and their presentation by counsel as having “no greater specificity or precision”. Nevertheless, he dealt with each ground in turn, with the outcome that he dismissed most of them, but:
 - (1) while he dismissed the invalidity application insofar as it was based on sections 3(1)(b) and (c) of the Act, he allowed the opposition under those provisions in respect of many of the goods and services, on the basis that they could be offered or used at poojas; and
 - (2) he allowed both the invalidity application and the opposition under section 3(3)(a) except in respect of goods suitable for vegetarians, for reasons that will be discussed below.
8. The combined effect of this on the Registration was that the hearing officer ruled that the specification should be amended by striking out certain goods from the list, and introducing limitations to goods and services “suitable for vegetarians”, as follows:

Class 29: ~~Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk~~

products; edible oils and fats; dried herbs; prepared meals and snacks included in this class; all being suitable for vegetarians.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; prepared meals and snacks included in this class; all being suitable for vegetarians.

Class 35: The bringing together, for the benefit of others, of a variety of foods and drinks and preparations for foods and drinks, enabling customers to conveniently view and purchase those goods; mail order retail services connected with foods and drinks and preparations for foods and drinks; the bringing together, for the benefit of others, of a variety of foods and drinks and preparations for foods and drinks, enabling customers to conveniently view and purchase those goods from a catalogue or by mail order or by means of telecommunications; electronic shopping retail services connected with foods and drinks and preparations for foods and drinks; all of the foods and drinks being suitable for vegetarians; information, consultancy and advisory services including helpline services relating to all the aforesaid services.

Class 43: Services for providing food and drink; restaurant, takeaway, cafe and bar services; catering services; sandwich and snack bar services; preparation and serving of food and beverages; all being suitable for vegetarians; information, consultancy and advisory services including helpline services relating to all the aforesaid services.

9. In relation to the Application, he ordered a more extensive narrowing down of the goods and services, as follows:

Class 29: ~~Preserved, frozen, dried and cooked fruits and vegetables; Asian fruit, vegetables and savouries; jellies, jams, compotes, fruit sauces, preserves; eggs; milk and milk products; edible oils and fats, being suitable for vegetarians; dried herbs; prepared, cooked and frozen meals and snacks included in this class; cold savoury snacks (chaat); prepared nuts; nut products; Bombay mix; potato snack products; pickles.~~

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour ~~and preparations made from cereals, bread;~~ pastry being suitable for vegetarians ~~and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; prepared, cooked and frozen meals and snacks included in this class; chutneys; cream cakes, fresh cream cakes, iced cakes; ice cream including kulfi; frozen cakes, confectionery, desserts, pastries and yoghurt; Asian sweets and confectionery; breads including buns, bread bases, biscuits, bread rolls, bread sticks, fruit breads, garlic bread, pita bread, naan bread, chapattis, poppadoms, parathas, unleavened bread, wholemeal bread, baguettes, croissants, sandwiches, bagels and wraps.~~

Class 35: Advertising; business management; business administration; office functions; ~~retail services connected with foods and drinks and preparations for foods and drinks; the bringing together, for the benefit of others, of a variety of foods and drinks and preparations for foods and drinks, enabling customers to~~

~~conveniently view and purchase those goods; mail order retail services connected with foods and drinks and preparations for foods and drinks; the bringing together, for the benefit of others, of a variety of foods and drinks and preparations for foods and drinks, enabling customers to conveniently view and purchase those goods from a catalogue or by mail order or by means of telecommunications; electronic shopping retail services connected with foods and drinks and preparations for foods and drinks; information, consultancy and advisory services relating to all the aforesaid services.~~

~~Class 43: Services for providing food and drink; restaurant, takeaway, cafe and bar services; eating services; sandwich and snack bar services; all being suitable for vegetarians preparation and serving of food and beverages; services for the provision of fast foods including Asian foods; information, consultancy and advisory services relating to all the aforesaid services.~~

10. The hearing officer's rationale for the different treatment of the two series of marks under sections 3(1)(b) and (c) was that the Registration included a distinctive graphical element which differentiated the marks in the series from the pure word mark POOJA SWEETS & SAVOURIES, whereas the stylisation of the same words in the Application was insufficient to give the marks in that series a distinctive character separate from the words alone – and in his assessment the words alone were not capable of registration in respect of the goods and services marked as being struck out in the above amended specification.
11. Both Tooting and Wolverhampton filed Notices of Appeal to the Appointed Person under section 76 of the Act on 22 October 2013. Tooting seeks to overturn the rulings under sections 3(1)(b)/(c) and 3(3)(a) which resulted in the limitation of the specifications for the Registration and Application, based on a number of alleged errors by the hearing officer. Wolverhampton's grounds of appeal complain that the hearing officer did not fully consider its allegation that religious offence would be caused to the UK Hindu population by the granting of the trade marks in issue, having misunderstood the background to certain email evidence. The aim of Wolverhampton's appeal, though not clearly stated, is apparently to overturn the Decision insofar as it allowed the Registration and Application under section 3(3)(a).

PROCEDURAL MATTERS

12. The hearing officer recorded at the end of the Decision that he intended to accede to Tooting's application for costs above the usual scale for Registry proceedings because not only had Wolverhampton lost on most of the grounds, but also Wolverhampton's pleadings were confused and unclear, a large part of its evidence was irrelevant to the proceedings, there was a lot of evidence about Wolverhampton's own business supposedly to show rights in passing off for which there was no basis, and the nature of the evidence and the manner in which Wolverhampton conducted the proceedings put an unnecessary and unacceptable burden on Tooting. He invited Tooting to file a breakdown

of costs and gave Wolverhampton the opportunity to respond within two weeks thereafter.

13. Having received Tooting's breakdown of costs (showing the total incurred to be £47,637.87 + VAT) but no submissions from Wolverhampton, the hearing officer issued a supplementary decision on costs on 7 November 2013 (BL O-447-13 – "**the Costs Decision**"), awarding Tooting half of its actual costs, ex-VAT, rounded down to £23,800, and payable within seven days of the expiry of the appeal period or within seven days of the final determination of the case if any appeal against the Costs Decision was unsuccessful.
14. No separate appeal was filed against the Costs Decision.
15. There has been one further decision in these proceedings, which was made by another Registry hearing officer, Mark Bryant, following a case management conference on 1 July 2014, and confirmed by letter to the parties dated 2 July 2014. This relates to an application for security for costs by Tooting against Wolverhampton pursuant to section 68 of the Act and rule 68 of the Trade Marks Rules 2008 ("**the Rules**"), based on evidence to the effect that:
 - (1) in January 2014 Tooting discovered that Companies House proposed to strike Wolverhampton off the Companies Register for failure to file its annual return by the due date in October 2013. Tooting wrote to Companies House and succeeded in preventing the proposed strike-off on the basis that Wolverhampton had debts arising from the Registry proceedings.
 - (2) Wolverhampton subsequently filed accounts for the year ending September 2013, which showed that its liabilities exceeded its assets by £16,685, that it had current assets of less than £13,000, and that it had recorded disposals to a value of nearly £40,000.
 - (3) Tooting attempted to obtain assurances from Wolverhampton as to its ability to meet a costs order, but such attempts were unanswered despite the relevant letters having reached their destination.
 - (4) a new company called Pooja Sweets (Wolverhampton) Limited had been incorporated at the same registered address as Wolverhampton in March 2014, albeit with different individuals named on the Companies House records. Tooting suspected that Wolverhampton may have transferred or be planning to transfer assets to this second company.
16. Mr Bryant was persuaded that as of September 2013 Wolverhampton's assets were insufficient to cover the original award of costs and that its financial position was not improving as assets were being disposed of. He therefore ordered Wolverhampton to pay

security for costs of £13,400, representing half of the amount awarded in the Costs Decision (£11,900), plus £500 as a contribution towards Tooting's costs of prosecuting the case since then, and £1,000 as a contribution towards Tooting's appeal costs. He ordered the security sum to be paid by 23 July 2014 into an account to be agreed between the parties' representatives.

17. Tooting's representatives, Bison Rivers, notified Wolverhampton's representatives, then Saunders & Dolleymore, of its client account where the security monies should be paid and would be kept pending a final order, but no sum was ever received.
18. In accordance with rule 68(2), Mr Bryant directed that the consequences of Wolverhampton failing to provide security for costs would fall to be determined by the Appointed Person when dealing with the appeals. Accordingly, Bison Rivers (for Tooting) wrote a letter on 4 August 2014, inviting me to refuse Wolverhampton's appeal and to treat Tooting's appeal as being successful, and to rule that the main costs award be immediately fixed and enforceable as a judgment debt.
19. While I considered that I had power to strike out Wolverhampton's appeal on the basis of the non-payment of the security for costs (which I discuss further below), I could not simply allow Tooting's appeal without consideration of its merits, and therefore I fixed the hearing of the appeals for 7 October 2014 and notified the parties that I would deal with Tooting's latest requests and all matters related to costs, including the failure to pay the security, at that hearing.
20. On 30 September 2014, Mr Andrew Marsden of Saunders & Dolleymore (for Wolverhampton) sent an email requesting that the hearing be adjourned, since he had only that day been instructed to represent Wolverhampton at the hearing and he would be away on holiday on the appointed date. I responded (via Treasury Solicitors, who look after the administration for Appointed Person appeals) that I was not inclined to permit an adjournment, unless (a) Wolverhampton had by then paid the £13,400 security for costs ordered by the Registrar, and (b) Wolverhampton had been provided with less than two weeks' notice of the hearing (the minimum notice required under rule 73(2) of the Rules); and only then would I consider the request to adjourn if I was given a full written explanation for the delay in both making the payment and requesting the adjournment, with reasons why I should accede to the request. The reply from Saunders & Dolleymore was that they did not know whether Wolverhampton had paid the security and that, in view of my response, they would not be attending the hearing.
21. Accordingly, the hearing went ahead before me on 7 October 2014 with Tooting represented by Tim Austen of Counsel, instructed by Bison Rivers, and in the absence of any representative of Wolverhampton. Wolverhampton did not file any written submissions before the hearing either. Apart from the brief exchange with Saunders &

Dolleymore concerning the hearing date, Wolverhampton has not taken any active step in the appeal process since defending the security for costs application in July 2014. It is plainly unwilling or unable to pay the security, despite being fully aware that it was necessary to do so in order to proceed further with its own appeal and to defend Tooting's appeal, and it has offered no explanation for the non-payment despite being given ample opportunity to do so.

WOLVERHAMPTON'S APPEAL

22. Rule 68 of the Rules provides as follows:

“68. (1) The registrar may require any person who is a party in any proceedings under the Act or these Rules to give security for costs in relation to those proceedings; and may also require security for the costs of any appeal from the registrar's decision.

(2) In default of such security being given, the registrar, in the case of the proceedings before the registrar, or in the case of an appeal, the person appointed under section 76 may treat the party in default as having withdrawn their application, opposition, objection or intervention, as the case may be.”

23. Wolverhampton is plainly in default of the hearing officer's order dated 2 July 2014. Having been given ample time and opportunity between then and the hearing to make payment or at least to explain the reasons for non-payment, and having received a clear message from me that the hearing would go ahead without them if the situation was not remedied, and in all the circumstances of the case, I see no reason why Wolverhampton should be permitted to continue with its appeal. Accordingly, I shall treat it as having been withdrawn. I will deal with the costs consequences at the end of this decision.

TOOTING'S APPEAL

24. For the reasons set out above, I also intend to treat Wolverhampton's defence of Tooting's appeal as having been withdrawn due to its failure to comply with the security for costs order. However, that is not the end of the matter, since Tooting's appeal relates to the Hearing Officer's determination of the absolute grounds objections raised against the Registration and the Application, which is final subject only to the appeal. Therefore, Mr Austen argued the appeal in front of me and I go on to consider its merits under the two separate groups of appeal grounds.

25. Notwithstanding Wolverhampton's non-participation in the appeal. I still have to deal with it by reviewing the Decision rather than rehearing the case. I should be reluctant to interfere with the Decision unless I find that the hearing officer has made an error of principle in reaching his conclusion: *REEF Trade Mark* [2003] RPC 5.

26. I bear in mind in this case that the first instance assessment was carried out by an experienced hearing officer, who not only had the benefit of oral argument by both sides'

representatives, but also listened to the oral evidence of witnesses, some of whom were cross-examined. However, the hearing officer himself stated (at paragraph 83) that the cross-examination of the witnesses had no material effect on the outcome of the proceedings, and so I do not need to be over-concerned about the impact of the oral evidence.

The appeal under sections 3(1)(b) and (c)

27. Section 3(1)(c) of the Act prohibits the registration of “*trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering services, or other characteristics of the goods or services*”.
28. Section 3(1)(b) prohibits the registration of “*trade marks which are devoid of distinctive character*”. It is clear from the case law that a mark which is held to be descriptive of characteristics of goods or services for the purposes of section 3(1)(c) will necessarily be devoid of distinctive character in respect of the same goods and services for the purposes of section 3(1)(b). In this case, the hearing officer’s conclusion under section 3(1)(b) was derived directly from his conclusion under section 3(1)(c), and so Tooting’s appeal against the latter would effectively ‘kill two birds with one stone’ if successful.
29. Tooting’s appeal under sections 3(1)(b)/(c) is directed at the hearing officer’s finding at paragraph 110 of the Decision that “*sweets and savouries are descriptive of food stuffs and services relating to such food stuffs and also are goods which are given as offerings at poojas*” and therefore, in view of the limited stylisation of the marks in the series, that the Application was subject to objection under section 3(1)(c) of the Act “*in relation to foods that could be offered at poojas and services relating to the offering of such foods*”.
30. The grounds of appeal are in summary as follows:
 - (1) this conclusion wrongly failed to take into account the perception of the trade marks from the point of view of the average consumer and in particular was inconsistent with (a) the hearing officer’s own finding at paragraph 117 that “*The average consumer for the goods and services of the application is the public at large and the public at large will have no knowledge of the word pooja, let alone its meaning. Consequently, pooja has no connotations for the average consumer.*”, and (b) the evidence of both sides showing that consumers (including those who understand the meaning of the word “pooja”) do not in fact perceive the marks of the Application as being descriptive in the way that was found;
 - (2) the hearing officer erred in construing certain of the goods and services in the specification as having the exclusive intended purpose of a pooja ceremony, whereas

a normal reading of the specification is that their purpose was simply for consumption as foodstuffs;

(3) alternatively, the hearing officer simply took one of the possible meanings of “POOJA SWEETS & SAVOURIES” and illegitimately conflated this with the goods and services for which the Application was made; and

(4) the hearing officer did not even consider whether there was any evidence that particular sweets and savouries were indeed offered at pooja ceremonies (which there was not).

31. Tooting also complains that the hearing officer’s implementation of his conclusion on descriptiveness to his proposed deletions of goods and services from the specification is arbitrary and without the benefit of any evidence.
32. Finally, Tooting complains that the hearing officer totally ignored its evidence of acquired distinctiveness through use of the trade marks, which might have saved the Application even if the conclusion on inherent lack of distinctiveness was correct.
33. It seems to me that Mr Austen was right to stress in argument the apparent discrepancy between the hearing officer’s conclusion on descriptiveness and his clear finding later in the Decision that the average consumer of the goods and services listed in the specification for the Application will not know the word “pooja” and consequently will not understand what it means. This discrepancy would not matter if the average consumer’s understanding of the meaning of a mark were irrelevant to the assessment of descriptiveness, and if the only question to consider was whether the mark in fact was or could be considered to be descriptive of the goods and services when assessed by a specific subset of potential consumers, however small, who happen to know the meaning of the word.
34. The hearing officer approached his assessment of the trade marks in issue without regard to the perceptions of the average consumer, as if the latter approach were correct. The key part of his reasoning was as follows:

“104) Tooting has argued that there are other meanings of Pooja eg a female forename. However, in relation to section 3(1)(c) of the Act this is not pertinent. In *Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr. Company Case C-191/01 P*, the CJEU outlined the basis for an objection under section 3(1)(c) of the Act:

“29. Article 7(1)(c) of Regulation No 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods or of rendering of the service, or other characteristics of the goods or service are not to be registered.

30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under Article 7(3) of Regulation No 40/94.

31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of Article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p.1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 73).

32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

Consequently, that Pooja is a female forename as well as being a religious ritual is not pertinent to the section 3(1)(c) objection. The purpose behind section 3(1)(c) is the public interest that signs or indications relating to the characteristics of goods or services should not be reserved to one undertaking. It is established that certain foods are offered for use in poojas as offerings to the gods and goddesses. Consequently, pooja in relation to such foods, or the services offering such foods, would relate to an intended purpose. The evidence shows that poojas are regularly conducted in the United Kingdom by Hindus. The Hindu population of England and Wales in 2001 was 1.2% (RJ43 page 93). The size of this population does not affect the issue as to whether the term is descriptive of a characteristic of the goods and services and, consequently, should not be reserved to one undertaking. The evidence of Tooting shows that it regularly supplies foodstuffs for poojas. Registration of pooja, therefore, would reserve to one undertaking a word that relates to an intended purpose and so would be contrary to section 3(1)(c) of the Act.”

35. While the hearing officer held that the device element of the marks in the Registration saved them from the descriptiveness attack, he went on to say the following in relation to the Application:

“109) The basis of the objection of Wolverhampton relates to foodstuffs that may be offered at poojas. However, its attack is against all of the goods and services from ‘baking-powder’ to ‘business management’. The submissions of Ms Heema brought no specificity to the attack. The objection will be considered within the parameters of the evidence.

110) In relation to the trade marks of the application, the trade marks consist of pooja and sweets and savouries. Sweets and savouries are descriptive of food stuffs and services relating to such food stuffs and also are goods which are given as offerings at poojas. The stylisation of the trade marks is so limited that it will not give the least modesty, unlike a fig leaf. Consequently, in relation to foods that could be offered at poojas and services relating to the offering of such foods, the trade marks are subject to objection under section 3(1)(c) of the Act.”

36. The reference here to “fig leaf” was to the judgment of Arnold J in *Starbucks (HK) Limited v British Sky Broadcasting Group PLC* [2012] EWHC 3074 (Ch), in which he warned trade mark registries against registering descriptive marks “under the cover of a figurative figleaf of distinctiveness”.
37. As the hearing officer indicated, the reason for refusing registration of descriptive marks is to satisfy the public interest in keeping such marks free for use by all traders, rather than allowing any one trader to reserve use to itself: 19.04.2007, C-273/05 P, *Celltech R&D/OHIM*, ECLI:EU:C:2007:224, §75.
38. The focus of *DOUBLEMINT*, to which the hearing officer referred, was to make clear that this provision applies even if the mark in question has more than one meaning, only one of which is descriptive. However, there is an additional question that must be considered, that was not under the microscope in *DOUBLEMINT*, which is whether the descriptive nature of the mark is a purely objective question that can be answered by looking up the meaning of words in a dictionary, or whether it is to be judged from the perspective of a particular group of people.
39. There is now a long line of case law on the assessment of trade marks under the ‘absolute grounds’ of objection set out in sections 3(1)(b) and (c) of the Act and their equivalent provisions in European legislation,¹ which stresses that the assessment has to be carried out by reference to the perception of the consumers of the goods and services covered by the mark, otherwise referred to in the cases as the “relevant public” (or sometimes the “target public”) and that, where the goods or services are intended for all consumers, the relevant public must be deemed to be composed of the “average consumer”, who is reasonably well-informed and reasonably observant and circumspect: 16.09.2004, C-329/02 P, *SAT.1/OHIM*, ECLI:EU:C:2004:532, §§24-25. Specifically in relation to descriptiveness objections, the General Court has held that descriptive marks are those

¹ Sections 3(1)(b) and (c) of the Act are the UK implemented versions of articles 3(1)(b) and (c) of the European Trade Marks Directive (2008/95/EC), and are matched by articles 7(1)(b) and (c) of the Community Trade Mark Regulation (207/2009/EC).

which may serve in normal usage from the point of view of the target public to designate, either directly or by reference to one of their essential characteristics, the goods or services in respect of which registration is sought: see, for example, 20.09.2001, C-383/99 P, *Procter & Gamble/OHIM (BABY-DRY)*, ECLI:EU:C:2001:461 and 25.10.2007, T-405/04, *Borco-Marken-Import Matthiesen/OHIM (CAIPI)*, ECLI:EU:C:2007:315, §30.

40. In referring only to the guidance set out in *DOUBLEMINT*, which involved a mark consisting of two ordinary words whose meaning would be understood by all the English-speaking public, it appears that the hearing officer lost sight of this aspect of European Court guidance when he was deciding on the section 3(1)(b) and (c) objections, since he only considered what the word “pooja” in fact meant, without doing so from the perspective of the relevant public who might be presented with goods and services sold and supplied by reference to the marks. This was a significant error that justifies a fresh look at those objections and the arguments raised.

41. It is helpful to start with the seminal *Windsurfing Chiemsee* case (04.05.1999, C-108/97 & C-109/97, ECLI:EU:C:1999:230) in which the CJEU considered the prohibition against registration of signs which may serve to designate the geographical origin of goods and services. The relevant guidance is found in the Court’s first ruling below:

“1. Article 3(1)(c) of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks is to be interpreted as meaning that:

- it does not prohibit the registration of geographical names as trade marks solely where the names designate places which are, in the mind of the relevant class of persons, currently associated with the category of goods in question; it also applies to geographical names which are liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods;
- where there is currently no association in the mind of the relevant class of persons between the geographical name and the category of goods in question, the competent authority must assess whether it is reasonable to assume that such a name is, in the mind of the relevant class of persons, capable of designating the geographical origin of that category of goods;
- in making that assessment, particular consideration should be given to the degree of familiarity amongst the relevant class of persons with the geographical name in question, with the characteristics of the place designated by that name, and with the category of goods concerned;
- it is not necessary for the goods to be manufactured in the geographical location in order for them to be associated with it.”

42. Applied to the descriptiveness objection raised by *Wolverhampton* in respect of the Application, this means that the marks in issue should not be registered if the relevant

public to whom the goods and services listed in the specification are targeted either currently associate the marks with such goods and services or are reasonably likely to do so in the future, particularly bearing in mind the degree of familiarity of the average consumer (i) with the marks, (ii) with the characteristics of the thing that the marks are said to describe, and (iii) with the category of goods and services concerned.

43. The CJEU has stressed that the prohibition on registering marks that designate characteristics of goods and services should not be applied to situations where one would have to stretch the imagination to discern the alleged characteristic. For example, in 10.03.2011, C-51/10 P, “1000” ECLI:EU:C:2011:139 at §50, the Court said:

“50. The fact that the legislature chose to use the word ‘characteristic’ highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

44. So the first step is to identify the relevant public. The specification for the Application in classes 29 and 30 lists a variety of mainstream foodstuffs, clearly aimed at the general public, as well as some which might be argued to be aimed at a more limited section of the public, in particular, “*Asian fruit, vegetables and savouries; ... cold savoury snacks (chaat); ... Bombay mix...*” in class 29 and “*spices; ... ice cream including kulfi; ...Asian sweets and confectionery; ... pita bread, naan bread, chapattis, poppadoms, parathas, unleavened bread, ...*” in class 30. There was no particular evidence in the case concerning this subset of the goods, and neither side argued for a different type of average consumer for such goods. Given the widespread availability of such foods in shops and restaurants in the United Kingdom, I think that it would be going too far to say that these foods are specifically targeted at the Asian population; and there is certainly no reason to find that they are aimed at a particular religious community, such as Hindus or Muslims.
45. As far as the services in classes 35 and 43 are concerned, these are all of a very general description (including, for example, “*retail services connected with food and drinks*” and “*restaurant, takeaway, café and bar services; catering services*”), save that the class 43 specification includes, “*services for the provision of fast foods including Asian foods*”. Once again, while one might expect that a higher proportion of people of Asian origin than those of non-Asian origin would be customers of outlets that sell fast Asian foods, there is no doubt that in this country such outlets are targeted at a wide range of non-Asians as well as Asians. Similarly, Asian fast food services cannot in general terms be

said to be targeted at any particular religious community, even if a particular outlet might be so targeted, for example, because of where it happens to be situated.

46. It therefore seems to me that, for all the goods and services in issue, the descriptiveness objections have to be assessed in this case from the perspective of the average consumer, based on the public at large.
47. As I have mentioned above, the hearing officer made a finding later in the Decision that the average consumer would have no knowledge of the word “pooja”, let alone its meaning. Having reviewed the evidence, I agree. On that basis, it could not be said that either of the two marks comprised in the Application would currently be understood by the average consumer to refer to food, drink and services associated with pooja ceremonies.
48. The hearing officer referred to evidence in the case suggesting that the Hindu population of England and Wales was 1.2%, that poojas are regularly conducted by Hindus in the UK, and that Tooting itself regularly supplies foodstuffs for poojas. The question thus arises whether the descriptiveness objections should be maintained if it is the case that a small subset of the target public, comprising Hindus in the UK who are aware of the meaning of the word “pooja” and also aware of the kind of food, drink and services supplied for poojas by Tooting, would perceive the marks of the Application to be descriptive in respect of some of the goods and services.
49. As I understand the authorities, these circumstances would not be enough to block registration of the marks under sections 3(1)(b)/(c), since they would not meet the relevant test, which is to assess the situation by reference to the average consumer. An analogy can be drawn with other cases where the goods concerned are aimed at a specialist consumer in addition to the general public. So, for example, in 12.03.2008, T-341/06, *Compagnie générale de diététique*, ECLI:EU:T:2008:70 at §34, the General Court held that, even if it were the case that the specialist and professional public of restaurateurs would be aware that the word “garum” meant a particular type of fish sauce, this did not mean that an application to register GARUM as a trade mark for “fish” and “fish preserves” should be rejected on the grounds of being descriptive, since the average consumer would not assign any particular meaning to it.
50. This outcome also accords with the guidance given by the CJEU in *MATRATZEN* (09.03.2006, C-421/04, *Matratzen Concord v Hukla*, ECLI:EU:C:2006:164) to the effect that articles 3(1)(b) and (c) of the Directive do not preclude the registration in a particular EU Member State, as a national trade mark, of a term borrowed from the language of another Member State in which it is devoid of distinctive character or descriptive of the goods or services in respect of which registration is sought, unless the relevant parties in

the Member State in which registration is sought are capable of identifying the meaning of the term.

51. I have considered the guidance given in the UK IPO Manual of trade mark practice as to the registrability of foreign words in the UK where the goods or services concerned are aimed at minority groups. In particular, the Manual states in the section on examination that, *“where the average consumer or end user of the goods in the application is far more likely than the average UK consumer to understand the language of the mark, this should be taken into account in determining whether the mark is caught by s3(1)(c) of the Act”*.
52. The Manual gives the example that the word “حِمار”, an Arabic word meaning YASHMAK, would not be registrable for yashmaks in class 25 because this would be a normal way for traders of these goods to market them because they are primarily used by the Arabic speaking community. It is then said that the same would apply if the application includes more general descriptions of the same goods such as “clothing”. However, the guidance does not go on to explain what would happen in that situation: would the specification, “clothing, except for yashmaks” be allowed, or would the mark be refused altogether? The Manual notes that this type of objection is most likely to arise for marks for foodstuffs and drinks in classes 29-32 and clothing in class 25, presumably on the basis that it is common for traders in such goods to target a specialist public, though this is not spelt out.
53. I find this guidance somewhat difficult to reconcile with that given by the Court of Justice referred to above, because it seems to require consideration of numerous possible specialist goods that might fall within the scope of a broader term, and it tends to suggest that the perception of specialist consumers is more important than has been indicated by the Court.
54. Nevertheless, I do not think that I need to resolve the issue in this case, since I am also persuaded by Tooting’s submission that the evidence did not in fact justify a finding that even those who know what poojas are and that pooja ceremonies can involve the offering up and consuming of foods, would perceive POOJA SWEETS AND SAVOURIES, used in the course of trade, as designating that any of the foods in the specification are sweets and savouries for offering up in pooja ceremonies. I reach that conclusion based on the following:
 - (1) Firstly, there was no cogent evidence of the term “pooja” being used as an adjective or description for food of any sort, e.g. “pooja food”.
 - (2) Secondly, it is apparent from the numerous witness statements and exhibits that discussed the offering up of food and other gifts during pooja ceremonies that it is not possible to identify particular types of foods as innately being “for pooja”. While there are certain foodstuffs that are considered suitable, such as leaves, rice, fruit,

clarified butter, sugar, betel nuts, pastries and sweets, while other foods, such as meat and fish, are considered unsuitable, one cannot sensibly describe any of the suitable foods as being “pooja foods” or “food for pooja”. Something more has to be done: the foods have to be prepared in a particular way and offered up in the course of pooja. This is too remote for it to be said that the term “pooja” itself designates a characteristic of the foods.

(3) Thirdly, the evidence showed that food offered in pooja ceremonies has its own descriptive term, which is “prashad” (or “prasad”), rather than “pooja”.

(4) Fourthly, there was no evidence of an established trade in the UK (beyond the outlets of Tooting and Wolverhampton) in providing food for pooja ceremonies, despite there having been a significant Hindu community in the UK for many years. (It is possible that such a trade exists, but it was not in evidence.)

(5) Fifthly, given that the Hindu community has been established in the UK for many years, and that this has not led to the general adoption by traders of the words “pooja sweets and savouries” as a descriptive term, I see no reason to believe that the situation might reasonably be expected to change in the foreseeable future. Wolverhampton did not suggest that there was likely to be a material change of circumstances and, having reviewed the evidence in the case, I do not see any reason to conclude that there would be such a change.

55. In these circumstances, it is perhaps not surprising that the hearing officer’s attempt to delete particular goods and services from the specification for the Application appeared to be rather arbitrary. The way in which the hearing officer applied his conclusion of descriptiveness to the specification for the Application is rightly criticised by Tooting for being unsupported by the evidence. Indeed, there was no explanation given in the Decision for the hearing officer’s jump, from his general conclusion that he should reject the Application for goods and services which were of such a nature that they could be offered or used at pujas, to the specific items deleted from the list of goods and services.

56. Mr Austen highlighted the stark example of the proposed deletion of “baguettes” in class 30, whereas there was absolutely no evidence of baguettes being offered up in pooja ceremonies, and they do not even fall within the general term “sweets and savouries” which the hearing officer wished to delete from the specification. Other obvious examples include “croissants” and “bagels”.

57. Furthermore, while I accept that registries should be careful not to register trade marks which consist of no more than descriptive terms ‘dressed up’ as brands by a very limited stylisation, I nevertheless bear in mind that it is the actual representation of the mark that is applied for that must be considered. In my assessment, both marks covered by the Application are in a logo form which is clearly intended to convey an origin function. If consumers – even those who know what a pooja is – were to come across goods and

services marketed by reference to these logos, I would expect them to understand that the person marketing them is making a statement that they come from a particular trader.

58. I therefore conclude that the hearing officer was wrong to hold that the Application should be refused in part under sections 3(1)(b) and (c) of the Act. As a consequence, I do not need to consider Tooting's complaint that its evidence of acquired distinctiveness was ignored. For the record, it is plain that it has made considerable use of the marks in issue across a wide range (albeit probably not all) of the goods and services that the hearing officer proposed to delete from the specification, and that this evidence could well have 'saved' a substantial portion of the Application that was proposed to be rejected.

Section 3(3)(a)

59. Section 3(3) of the Act provides that:

“S.3 (3) A trade mark shall not be registered if it is –

(a) contrary to public policy or to accepted principles of morality, ...”

60. The hearing officer summarised Wolverhampton's claim under this section at paragraph 14 of the Decision, as follows:

“14) Wolverhampton claims that pooja is a key word in Hinduism and its registration and appropriation is offensive to Hinduism. ...”

61. Having summarised the evidence and dealt with various of the other grounds of attack, he picked up this ground at paragraph 121 in the following way:

“121) The section 3(3)(a) case revolves around a religious issue. Both parties have adduced evidence in relation to this; evidence which gives conflicting views. It is not possible to ascertain how representative of Hindus the evidence of either party is.

122) Religions have many different bodies and some are more representative of the general view of those who hold the beliefs than others. In relation to the representative nature of the evidence of Wolverhampton a blind eye cannot be turned to certain of the evidence, which appears to be Islamophobic. ...”

62. The hearing officer continued by illustrating his concern about the Islamophobic nature of some of Wolverhampton's evidence with extracts from some of the witness statements and exhibits, about which he said there was nothing to suggest that the views expressed were representative of the Hindu community in the UK, and he also highlighted that some of the witnesses made inaccurate statements about Tooting's business and unsubstantiated claims about its motivation for choosing the trade marks under which it conducts business.

63. He then set out a series of lengthy extracts from some email correspondence between representatives of each of the parties on the one hand and representatives of the Hindu Council UK and the National Council of Hindu Priests UK on the other. This started with a request from Mr Shahid Salim of Tooting that the Hindu Council UK intervene to clarify whether there was anything wrong with using POOJA SWEETS as a name for a business run by a Hindu-Muslim partnership, and also appears to have involved an intervention by Mr Ram Joshi of Wolverhampton in which he claims that he was being asked to drop the name “Pooja” from his shop by Mr Salim who had registered the name as a trade mark.
64. These emails were referred to by both sides, each contending that their content supported their respective case. The hearing officer made the following points on the correspondence:
- (1) Both Tooting and Wolverhampton appeared to claim that the other was trying to prevent their trading use of the name POOJA SWEETS. According to the rest of the evidence, this was true in the case of Tooting, but not in the case of Wolverhampton.
 - (2) The National Council of Hindu Priests did not wish to be involved in a commercial dispute, but this did not gainsay its original response to Tooting that there was nothing wrong in their business being run by a Hindu Muslim partnership and supplying vegetarian food to Hindus, calling itself “Pooja Sweets and Savouries Ltd”.
 - (3) Mr Ravi Sharma, a Hindu priest, considered the issue concerning the name to be a commercial matter rather than a religious matter.
 - (4) While Mr Anil Bhanot, of the Hindu Council UK, expressed the view that a trade mark including the word “Pooja” would not be acceptable to the British Hindu Community, this was in response to a letter from Wolverhampton which – although not disclosed – appears to have suggested that Wolverhampton was the first user of the name POOJA SWEETS and that it was not trying to stop Tooting from using it, both of which were unsupported by the evidence.
 - (5) Mr Bhanot referred to all of the words, Pooja, Om and Yoga as being “auspicious words that Hindus use to connect to their God”. The hearing officer deduced from his emails that Mr Bhanot puts “pooja” on a par with “om” and “yoga”, and that these were not being used as “religious words”, but as “words used in relation to religion”.
65. As a final point on the facts, the hearing officer said at paragraph 133 that it was necessary to bear in mind that, despite Mr Joshi (of Wolverhampton)’s claims in relation to the importance of vegetarianism, the evidence showed that he associated his own shop with non-vegetarian foods.
66. He then went on to consider the tests that need to be satisfied for a mark to fall foul of section 3(3)(a). He referred to *Kerly’s Law of Trade Marks and Trade Names* (fifteenth

edition) and to guidance given in the following three previous Appointed Person decisions under this provision:

- (1) *Ghazilian's Application* (BL O/538/01), [2002] RPC 33 in which Simon Thorley QC upheld the Registrar's decision to refuse registration of the mark TINY PENIS in respect of clothing;
- (2) *Basic Trade Mark SA's Application* (BL O/021/05), [2005] RPC 25 in which Geoffrey Hobbs QC dealt with (and also refused) an application for protection in the UK of two International registrations for the mark JESUS in respect of a long list of goods including soaps, perfumery, sunglasses, jewellery and clothing; and
- (3) *French Connection Ltd's Application* (BL O/137/06), [2007] RPC 1 in which Richard Arnold QC dealt with (and upheld) the registrability of the mark FCUK for clothing.

67. From *Kerly* (at 8-195 et seq), derived from *Ghazilian/TINY PENIS*, he cited the following extract:

“The dividing line is to be drawn between offence which amounts only to distaste and offence which would justifiably cause outrage or would be the subject of justifiable censure as being likely significantly to undermine current religious, family or social values. The outrage or censure must be amongst an identifiable section of the public and a higher degree of outrage or censure amongst a small section of the community will no doubt suffice just as lesser outrage or censure amongst a more widespread section of the public will also suffice.

In that case it was also emphasised that s.3(3) was not concerned with political correctness but with principles of morality, a different and less readily invoked standard. The test is objective: using the concept of a right-thinking member of the public, it must be assessed whether the mark in question would cause outrage or censure amongst a relevant section of the public, if, for example, they saw the mark on an advertising poster. If the mark has actually been used, then the best barometer of public opinion is evidence resulting from actual use in the market.”

68. Following this quote, the hearing officer made the following remarks:

“135) Pooja is used as a female forename by Hindus and so can hardly be considered to be a word that usage outside of a religious context can be seen to be verboten. Although not direct analogies, it is noted that Jesús is a common forename in Hispanic countries and Christ is a Germanic surname; there is a chain of jewellers with the name Christ Schmuck (Schmuck meaning jewellery). That a word has a link to religion does not make it fall foul of section 3(3)(a); it will depend on the word, the context and the goods and/or services.

136) In his evidence Imran Salim refers to Puja being registered in the United Kingdom for class 3 goods and that there are several United States trade mark registrations that include the word puja. The registration of trade marks including the word puja cannot be determinative, or even indicative, in relation to these proceedings. It is necessary to consider the issue on the facts and evidence of this case. Imran Salim also refers to other businesses using pooja. All but one of these

appears to be outside the United Kingdom. However, taking into account the claims of Wolverhampton, it is of some interest that businesses in India use pooja: Pooja Exports International based in Kolkata sells clothing, Pooja Kennel based in Pune sells dogs and there is a Pooja Hospital in Mumbai. There is no indication of outrage in relation to such use in a predominantly Hindu society.”

69. He then went on to cite the following extract from *Basic Trade Mark/JESUS*:

“20. I agree with the proposition advanced on behalf of the Applicant to the effect that religious significance is not always or necessarily sufficient to render a mark unregistrable under Section 3(3)(a). However, branding which employs words or images of religious significance can quite easily have a seriously troubling effect on people whose religious beliefs it impinges upon and others who adhere to the view that religious beliefs should be treated with respect in a civilised society”

70. From *French Connection/FCUK*, the hearing officer quoted a long paragraph starting with:

“90 Furthermore, I agree with the hearing officer that the best barometer of public perception is evidence resulting from actual use in the market. In the present case, apart from the mysterious reference in the *Delete expletives?* report, the evidence resulting from actual use is really all one way. ...”;

continuing with a detailed summary of the evidence of sales of FCUK branded clothing and the following statement:

“... With exposure on this scale, if the mark FCUK was significantly offensive to a section of the public, there would be evidence of this. There is not. ...”;

and making the point that:

“A number of retailers expressly state that they have had no complaints from their customers.”

71. The hearing officer summed up the position in the following way (with emphasis as per the original):

“139) Tooting has used POOJA in relation to its business since 1996. It has used POOJA in a multi-cultural area. Its products have been bought by Hindus, they have been bought by Hindu religious groups. Tooting has been prominent in its local community. The evidence shows that it is well-known in its local community and is well respected in it. Ms Salim has met the then prime minister. Tooting’s profile has been high in relation to advertising before members of the Hindu community in print, radio and television. Despite the claims of Wolverhampton, no one has complained, no one has objected until Wolverhampton commenced these proceedings. None of these complaints was spontaneous. It has been clear to those who have purchased the goods of Tooting that the Salim family are from a Muslim background; again no one has objected to this. **The proof is in the pudding, as with BL O/137/06, registration of the trade marks neither is nor would be contrary to public policy or principles of morality, subject to one proviso.**

140) The evidence of Tooting shows that all of the goods that it has supplied in relation to its trade marks have been suitable for vegetarians. Many of those who have supported the case of Tooting have noted that the goods have been suitable for vegetarians. Consequently, on the empirical basis presented, this pudding must be suitable for vegetarians and the specifications of the application and registration appropriately limited. (Revised specifications, taking into account all objections, will be given at the end of the decision.)”

72. Tooting objects to the restriction of the Registration and the Application to vegetarian goods and services, arguing that:
- (1) the hearing officer was wrong to take a so-called “empirical approach” to the question of whether the trade marks in issue are contrary to public policy or principles of morality; and
 - (2) even if this was the correct approach, his conclusion was wrong since it was based only on the evidence relating to one business, Tooting, which did not constitute a fair assessment of the evidence.
73. Under the first ground, Mr Austen argued for Tooting that the hearing officer should have assessed the intrinsic qualities of the trade marks and not merely focused on the use made of them.
74. I do not agree with the suggestion that the hearing officer ignored the intrinsic qualities of the trade marks. He plainly made considerable efforts in the Decision to get to grips with the meaning and the public’s understanding of the word POOJA, both generally and in relation to the goods and services in issue. He also summarised his views in relation to the way in which the word would be understood when used in a commercial context when he considered the objection under section 3(3)(a) (at paragraphs 135-136, quoted above).
75. However, under the second ground, I agree that, in adopting his “empirical approach”, the hearing officer misapplied the guidance in relation to actual use. He appears to have relied on the fact that Tooting had only used the marks in issue in relation to goods suitable for vegetarians and that members of the trade and public who had been exposed to that use were not offended and did not object to it, to deduce that such people would be offended by and object to use in relation to non-vegetarian goods and related services. This involved a leap of logic that was not justified by either the authorities or the evidence and was unfair to Tooting.
76. In my opinion, this is a material error in approach that justifies a fresh consideration of this ground of objection.
77. The most comprehensive guidance in relation to the application of section 3(3)(a) was set out by Richard Arnold QC, then sitting as the Appointed Person, in *FCUK*, in a judgment

delivered on 17 May 2006. Having conducted a thorough review of the English cases and the small amount of case law developed up to that point under the equivalent provision under article 7(1)(f) CTMR, as well as the background to both provisions, he set out a series of propositions by reference to the cases from which they are derived. I reproduce these below, but without the case names, which can all be found in the *FCUK* decision:

- “(1) The applicability of section 3(3)(a) depends on the intrinsic qualities of the mark itself and not on circumstances relating to the conduct of the applicant.
- (2) As with any other absolute ground of objection, the applicability of section 3(3)(a) is to be assessed as at the date of application.
- (3) Section 3(3)(a) should be interpreted and applied consistently with Article 10 ECHR. It follows that registration should be refused only where this is justified by a pressing social need and is proportionate to the legitimate aim pursued. Furthermore, any real doubt as to the applicability of the objection should be resolved by upholding the right to freedom of expression and thus by permitting the registration.
- (4) Section 3(3)(a) must be objectively applied. The personal views of the tribunal are irrelevant.
- (5) While section 3(3)(a) may apply to a mark whose use would not be illegal, the legality or otherwise of use of the mark is a relevant consideration.
- (6) For section 3(3)(a) to apply, there must be a generally accepted moral principle which use of the mark would plainly contravene.
- (7) Mere offence to a section of the public, in the sense that that section of the public would consider the mark distasteful, is not enough for section 3(3)(a) to apply.
- (8) Section 3(3)(a) does apply if the use of the mark would justifiably cause outrage, or would be the subject of justifiable censure, amongst an identifiable section of the public as being likely significantly to undermine current religious, family or social values.
- (9) In the case of a word mark, it is necessary to consider the applicability of section 3(3)(a) on the basis of any usage that the public makes of the word or words of which the mark is comprised. Thus the slang meaning of a word may lead to an objection even if its normal meaning does not.
- (10) A mark which does not proclaim an opinion, or contain an incitement or convey an insult is less likely to be objectionable than one that does.
- (11) Different considerations apply to different categories of marks.”

78. Since this decision, further cases have been decided under article 7(1)(f) CTMR in appeals from OHIM first to the Boards of Appeal and then to the General Court. In Case R 495/2005-G *Jebaraj Kenneth t/a Screw You (SCREW YOU)* [2007] ETMR 7, the Grand Board of Appeal summarised the rationale behind Article 7(1)(f) as follows:

“13. The question whether a trade mark can be registered under Article 7(1)(f) is separate from the question whether it can be used. No provision of the CTMR (or of Community law in general) says that a trade mark which has been refused

registration under Article 7(1)(f) cannot be used; that is essentially a matter for national law. Conversely, when the Office decides to accept a trade mark that is in dubious taste, the mere fact that it has been registered as a CTM does not mean that its use cannot be prohibited in the Member States, for example under the laws on obscenity. Article 106(2) CTMR expressly safeguards the right to prohibit the use of a registered CTM under the civil, administrative or criminal law of a Member State. It follows that the purpose of Article 7(1)(f) is not to identify and filter out signs whose use in commerce must at all costs be prevented; rather the rationale of the provision is that the privileges of trade mark registration should not be granted in favour of signs that are contrary to public policy or the accepted principles of morality. In other words, the organs of government and public administration should not positively assist people who wish to further their business aims by means of trade marks that offend against certain basic values of civilised society.

14. The wording of Article 7(1)(f) CTMR is very broad and allows a great deal of room for interpretation. A judicious application of this provision necessarily entails balancing the right of traders to freely employ words and images in the signs they wish to register as trade marks against the right of the public not to be confronted with disturbing, abusive, insulting and even threatening trade marks.

15. If the provision is interpreted too widely, so as, for example, to include anything which a section of the relevant public is likely to find offensive, there is a risk that commercial freedom of expression in relation to trade marks would be unduly curtailed. While it is true to say that a refusal to register does not amount to a gross intrusion on the right of freedom of expression, since traders can still use trade marks without registering them, it does represent a restriction on freedom of expression in the sense that businesses may be unwilling to invest in large-scale promotional campaigns for trade marks which do not enjoy protection through registration because the Office regards them as immoral or offensive in the eyes of the public.

16. ... 17. ...

18. If the Office construed Article 7(1)(f) too narrowly, by for example refusing to register only those signs which violate the criminal law, the Office would effectively abrogate its responsibility to ensure that the privileges of trade mark registration are not extended to trade marks which are deeply offensive, disgusting and potentially capable of causing outrage, but whose use is not actually prohibited under national law. It would also amount to ignoring the spirit of the provision, which refers to ‘accepted principles of morality’. Article 7(1)(f) clearly imposes a duty on the Office to exercise a degree of moral judgment in assessing the suitability of signs to be granted trade mark protection.”

79. In relation to signs that may have religious connotations, the Grand Board said:

“20. Signs which severely offend the religious sensitivities of a substantial group of the population are also best kept off the register, if not for moral reasons, at least for reasons of public policy, namely the risk of causing public disorder.”

80. Then, with more of a focus on potentially obscene signs, but also applicable to those objected to on religious grounds, it added:

“21. In deciding whether a trade mark should be barred from registration on grounds of public policy or morality, the Office must apply the standards of a reasonable person with normal levels of sensitivity and tolerance. The Office should not refuse to register a trade mark which is only likely to offend a small minority of exceptionally puritanical citizens. Similarly, it should not allow a trade mark on the register simply because it would not offend the equally small minority at the other end of the spectrum who find even gross obscenity acceptable. Some people are easily offended; others are totally unshockable. The Office must assess the mark by reference to the standards and values of ordinary citizens who fall between those two extremes. It is also necessary to consider the context in which the mark is likely to be encountered, assuming normal use of the mark in connection with the goods and services covered by the application. ...”

81. This principle of not pandering to extremes was applied in *Dennis Nazir v George V Eatertainment (SA) (BUDDHA-BAR)*, 16 February 2011, in which the Cancellation Division held as follows:

“(14) A judicious application of Article 7(1)(f) CTMR necessarily entails balancing the right of traders to freely employ words and images in the signs they wish to register as trade marks against the right of the public not to be confronted with disturbing, abusive, insulting and even threatening trade marks. In deciding whether a trade mark should be barred from registration on grounds of public policy or morality, the Office must apply the standards of a reasonable person with normal levels of sensitivity and tolerance. The Office should not refuse to register a trade mark which is only likely to offend a small minority of exceptionally puritanical citizens. It is necessary to consider the context in which the mark is likely to be encountered, assuming normal use of the mark in connection with the goods covered by the registration (“*SCREW YOU*”, *loc. cit.*, paragraph 21).

(15) It is to be noted from the outset that in the context of the right of traders to freely employ words and images in the signs they wish to register as trade marks, it would be an unreasonably great restriction to exclude from registration all the words which have a connection with a religion, unless the mark is clearly blasphemous, i.e. expresses or involves impiousness or gross irreverence towards something sacred, including the profane use of divine names.”

82. The Cancellation Division went on to find that it was extremely unlikely that the expression “BUDDHA BAR” would severely offend the religious sensitivities of a substantial group of the population, even if used in respect of the allegedly frivolous activities of spas, aesthetic services, bars and restaurants.

83. The General Court has since confirmed the approach adopted within OHIM that a trade mark should not be refused under Article 7(1)(f) based on the perception of a part of the relevant public which is shocked by nothing or, alternatively, which easily takes offence, but must be based on the approach of a reasonable person with average levels of sensitivity and tolerance: 05.10.2011, T-526/09, *PAKI Logistics GmbH v OHIM*, ECLI:EU:T:2011:564, §12 and 09.03.2012, T-417/10, *Federico Cortés del Valle López v OHIM*, ECLI:EU:T:2012:120, §21.

84. Having considered the guidance given in the above line of cases, and in the light of all the evidence in this case, I have little doubt that the appearance of the word POOJA in the marks that are the subject of the Application and the Registration will not cause serious offence to reasonable people of normal levels of sensitivity and tolerance, including those people who are themselves observant Hindus, when used in the course of trade in relation to the various goods and services in the two specifications. I say this because *inter alia*:

- (1) Tooting has used the name POOJA as a business name since 1996, has used POOJA SWEETS and then POOJA SWEETS & SAVOURIES since 2001/2, and has also used these words within the marks shown in the Registration and the Application for many years, all in relation to a range of the goods and services listed, without any complaint or apparent offence being caused, until Wolverhampton raised its objections and encouraged others to comment adversely;
- (2) Wolverhampton has also used the term POOJA SWEETS in respect of relevant goods and services, apparently without any complaint from the public;
- (3) Such expressions of distaste or disgust as were put forward in Wolverhampton's evidence appeared to reflect one or more of the following:
 - a. minority views of individuals who were at the hyper-sensitive end of the spectrum;
 - b. bigoted objections to the idea of Muslims being involved in the preparation of foods suitable for poojas; or
 - c. objections based on misunderstandings (in some cases due to misinformation supplied by Wolverhampton) of what Tooting was trying to achieve by registering the marks in issue.

85. In relation to the hearing officer's conclusion that a distinction should be drawn between goods and services suitable for vegetarians and for non-vegetarians, I note firstly that this distinction was of the hearing officer's own making. It was not suggested in either the Application Notice (Form TM26(i)) or the first instance submissions made on behalf of Wolverhampton, which instead focused on the religious significance of the word "pooja" and the objection to a non-Hindu registering it for any goods and services. Furthermore, Wolverhampton's own grounds of appeal do not adopt the distinction, but simply ask for the refusal of the Registration and the Application across the board.

86. The only reasons given by the hearing officer for the vegetarian / non-vegetarian distinction are that, (1) Tooting's evidence showed that all of the goods that it had in fact supplied were suitable for vegetarians, and (2) many of those who supported Tooting's case noted that fact (see paragraph 140, set out earlier in this decision). As I indicated at the outset, there is a leap of logic here: just because the marks do not cause offence when

used in relation to vegetarian goods, it does not follow that they will cause offence if used in relation to non-vegetarian goods; and the fact that witnesses noted that Tooting supplied vegetarian food does not mean that they would have been offended by the use of the marks in relation to non-vegetarian food. There was simply no evidence that this would have been the case.

87. Further, as noted by Mr Austen for Tooting, Wolverhampton was shown to have used the name “Pooja Sweets & Savouries” with respect to non-vegetarian food, and there was no evidence of outrage or offence having been caused by that activity.
88. While it is possible that the supply of meat-based products for use at a pooja ceremony to be conducted by observant and vegetarian Hindus might well cause offence and upset, that is quite different from the general question here of whether the use of the composite marks set out in the Registration and the Application, in relation to non-vegetarian goods and related services, would in themselves cause outrage to reasonable people, including Hindus, with normal levels of sensitivity and tolerance. The evidence simply does not show that and I therefore overturn the hearing officer’s decision on that point.

OUTCOME OF THE APPEALS

89. In summary:

- (1) Wolverhampton’s appeal is deemed withdrawn in relation to both Invalidation Application no. 84010 and Opposition no. 102596 for failure to comply with the registrar’s order dated 2 July 2014 to pay security for costs; and
- (2) Tooting’s appeal succeeds in relation to both Invalidation Application no. 84010 and Opposition no. 102596.

COSTS

90. The first instance costs award of £23,800 was recognised by Mr Austen, for Tooting, to be an unusually high one for registry proceedings. Although Tooting did not win across the board, my impression from the Decision and Costs Decision is that the award was not significantly discounted to reflect the aspects of the case that it lost. Indeed, Mr Austen did not ask for any further uplift in the event of total success on appeal, but was content for the award to stand unaltered. I think that is a sensible approach, as it seems to me that the award in respect of the first instance proceedings is a fair one in the circumstances, even having regard to the final improved outcome for Tooting. I would, however, add a further seven days to the time for payment.
91. That leaves the costs of Tooting’s security for costs application and of the appeal to be dealt with. In the light of Wolverhampton’s challenge of the former, the circumstances in which it arose (discussed earlier in this decision), and the fact of its success and then subsequent breach by Wolverhampton, Mr Austen sought recovery of a significant

proportion of the costs incurred in relation to the security for costs application. In relation to the appeal, Mr Austen asked for a generous on-scale award.

92. Shortly after the hearing, Tooting provided me with a Statement of Costs, confirmed by Bison Rivers to be accurate, with a detailed breakdown of the work done, showing the actual costs incurred to be £13,260.62 plus VAT in relation to the security for costs application and £7,997.50 plus VAT in relation to the appeal and cross-appeal.
93. As at 2 July 2014, Mr Bryant for the registrar included the sum of £500 in his order for security for costs as a contribution towards Tooting's costs of prosecuting the case since the first instance decision. However, rather than representing a real assessment of the costs that might be claimed in respect of the application, this appears to have been simply intended to recognise that further work had been done and some sort of contributory element should be included in the security for costs. Therefore, I disregard that sum as indicative of an appropriate award.
94. The main activities covered by the summary of work done were:
 - (1) the investigation into the proposal to strike Wolverhampton off the Companies Register;
 - (2) the investigation of the link between Wolverhampton and the new similarly named company and analysing the accounts of both companies to see if monies were being siphoned off which might otherwise have been available to pay Tooting's costs;
 - (3) the preparation of a witness statement and exhibits in support of the application for security;
 - (4) liaising with Treasury Solicitors and the UK IPO;
 - (5) preparation for and attendance on the case management conference (represented by counsel); and
 - (6) considering and advising on the decision.
95. While one might be able to quibble with aspects of the work done, or the amount spent on individual items of work, it all appears to have been necessary in order to get to the position where the registrar would be sufficiently well informed to understand the case for a security for costs award. Further, Wolverhampton's opposition to the application (and thus full knowledge of the outcome) and subsequent non-compliance seem to me to justify a significant award of costs. On the other hand, the overall amount does seem rather high in the context of registry proceedings (albeit proceedings in which the other side had been found to have behaved unreasonably) and bearing in mind the amount of security that was being sought and was actually ordered.

96. Balancing all of these factors, I will award half of Tooting's actual costs in respect of the security for costs application, rounded down to £6,630.
97. Finally, in respect of the appeal and cross-appeal, and taking into account the exchanges of correspondence concerning the impact on Wolverhampton's appeal of its failure to comply with the security for costs order, and Tooting's success in the appeal, I will award scale costs of £2,300, made up of £600 for preparing the Notice of Appeal and skeleton argument, £200 for considering Wolverhampton's Notice of Appeal and working out the impact of its breach, and £1,500 for the hearing.

CONCLUSION

98. The final result is that:

- (1) the Registration should remain on the register without limitations to the list of goods and services;
- (2) the Application should proceed to the next stage in the registration process;
- (3) Wolverhampton must pay Tooting the sum of £32,730, inclusive of the first instance award of costs, within 14 days of this decision.

99. I appreciate that Tooting wishes to enforce the costs award against Wolverhampton, and I have set out the final outcome in a separate Order.

ANNA CARBONI

The Appointed Person

9 February 2015

The Appellant and cross-Respondent (Pooja Sweets & Savouries Limited) was represented by Tim Austen of Counsel, instructed by Bison River Limited.

The Respondent and cross-Appellant (Pooja Sweets Limited) did not attend and was not represented.