

O-462-15

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3071062
IN THE NAME OF DOLI BEGUM
FOR REGISTRATION OF THE TRADE MARK



AND

OPPOSITION THERETO UNDER NO 403274
BY FOEZ AHMED

Background

1. On 3 September 2014, Doli Begum (“the applicant”) applied for registration, under no 3071062, of the trade mark shown on the cover page of this decision. Registration is sought in respect of:

Class 43:

Catering of food and drinks

2. Following publication of the application in *Trade Marks Journal* 2014/040 on 26 September 2014, notice of opposition was filed by Foez Ahmed (“the opponent”). There is a single ground of opposition brought under the provisions of section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opponent claims to have an earlier right used in relation to *catering services* since 15 December 2009.

3. The applicant filed a counterstatement in which she denies the claims made.

4. Only the opponent filed evidence which I will refer to later in this decision. The applicant filed written submissions which are extremely short and relate largely to a disputed domain name. Neither party sought to be heard. I therefore make this decision on the basis of all the papers before me.

Decision

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

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

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

6. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

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

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

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

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

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

7. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

"27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

8. I must also keep in mind that in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

"[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the

application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

9. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander Q.C. as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.’

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent’s goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs Q.C. sitting as the Appointed Person in *Croom’s TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schwepes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

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.' "

10. The applicant has not filed evidence and therefore cannot show that her mark was used before the date of filing of the application. As I indicated earlier, the application has a filing date of 3 September 2014. This is the relevant date at which I shall consider the opponent's claims.

11. The opponent relies on the following mark:



12. The opponent claims to have used this mark in Birmingham and "throughout the UK on website" since 15 December 2009 in respect of *catering services*. In his notice of opposition, he states:

"This is the same trading style. They have also copied our logo design. They have taken over our website Jolpai.co.uk which was used by my business. This was mistakenly not renewed by our IT company. However Google and all

other web searches show our business details and services but are linked to this domain.”

13. Any question regarding the ownership of domain names or the trading name of a company is not a matter for the Trade Marks Registrar. The only matter I have to consider is whether the trade mark applied for offends against section 5(4)(a) of the Act based on the opponent’s claimed use of his earlier mark.

14. The opponent’s evidence takes the form of a witness statement by Foez Ahmed who states he is the Director of the company known as Jolpai Ltd which trades as the Jolpai Bangladeshi and Indian Restaurant in Stechford, Birmingham. He states “[t]he business first traded under this name in 2009 and later the business was incorporated on 20th July 2011”.

15. Mr Ahmed gives no further details regarding any trade carried out but does exhibit a number of documents to his witness statement. They are:

Page 6: a copy of an invoice from G10 Design & Print dated 28 November 2009 addressed to “Jolpai” which seeks payment for printing work. Whilst it is not clear to me what each of the items might be, I can see references to menu covers and “in menu” but no details of what, specifically, might have been printed on any of the items are given in the evidence;

Page 7: a copy of an invoice from the same printers dated 15 October 2010, again addressed to “Jolpai”. It is not clear to me what the first item listed relates to but the second of the two items on the invoice is listed as a “leaflet”. Again, no details of what, specifically, might have been printed on these items are given in the evidence;

Page 8: a copy of an invoice from the same printers dated 8 December 2009, again addressed to “Jolpai” and in respect of “voucher”. Again, no details of what, specifically, might have been printed on them are given in the evidence;

Page 9: a copy of a letter dated 14 October 2014 on G10 Design & Print headed paper. Addressed “To whom it may Concern” it confirms that “the management of Jolpai restaurant have been trading with us since their opening of their restaurant in December 2009”. The letter, signed by a Mr Hoq, states “We have originally designed all their leaflets, menus and business stationery including their logo” and, at the bottom of the page a logo is shown however, no details of the specific trade have been given and no-one from the company has filed evidence;

Page 10: a copy of a letter dated 8 September 2010 on Birmingham City Council headed paper and addressed to Jolpai Bangladeshi And Indian Restaurant which confirms the “food business...is now registered” with the council;

Page 11: a copy of a gas statement from e-on dated 3 October 2012 and addressed to Jolpai Ltd;

Page 12: a copy of a letter dated 13 November 2014 from accountants and business advisors, SKN Services Ltd and addressed to the Intellectual Property Office. It includes the following; “We can further confirm that Mr Foez Ahmed has been our client since 15th December 2009 trading as Jolpai Bangladeshi and Indian Restaurant. This business was later incorporated at Companies House as Jolpai Ltd (company number 07712036) on 20 July 2011. This company is still trading as Jolpai with Mr Foez Ahmed as the sole Director and shareholder.” The letter is not signed in the name of any individual and no-one from the company has filed any evidence;

Pages 13-17: copies of bank statements showing the account name as Jolpai Ltd and dated 28 November 2011 (2 pages) and 26 January 2012 (3 pages). The statement at page 17 shows the account to have been opened on 27 September 2011. It is addressed to “The Director, Jolpai Ltd”.

16. The first hurdle for the opponent is for him to show that there is goodwill in the earlier mark claimed. The meaning of goodwill was set out in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

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

17. Whilst Mr Ahmed states his business began trading under the name Jolpai at an unspecified date in 2009, he provides no evidence to show any trade under the mark he relies on which is a highly stylised mark. There is no evidence of the extent of any use of the mark as claimed at any time and certainly not at the relevant date. The invoices from the printing company shows that various items were charged for and some of these items are suggestive of them being supplied to a restaurant business but there is no evidence of what, specifically, appeared on those items and no evidence of whether, and if so how and when, they were used or distributed. The copy letters from Birmingham City Council (dated a year after the earliest of the printer’s invoices) shows a “food” business had just been registered but does not assist in determining what sort of business that might have been. The utility bill and bank statements shows that the business was utilising gas and had a bank account, however, none of these documents show any business trading under the mark claimed nor do they show what specific goods or services that business may have supplied. The only other document within the evidence is the copy letter from Mr Hoq which indicates the opponent, his company’s client, is the sole director of Jolpai Ltd which trades as Jolpai Bangladeshi and Indian Restaurant, however, the information provided by Mr Hoq has not been put in evidential form e.g. in the form of a witness statement or statutory declaration and, in any event, provides no detail of the extent of any such business or the goods or services supplied under it at any particular time.

18. There is no evidence of e.g. turnover or advertising under the mark, no evidence from the trade or public and no evidence which goes to the extent of use of the mark relied on at any time and certainly not at the relevant date in relation to the services

claimed. The opponent claims to have used the mark on *catering services* but no evidence of any such trade has been referred to or shown in the evidence under any mark. In short, the opponent has failed to show he has the requisite goodwill in the earlier mark as claimed. That being the case, the objection under section 5(4)(a) of the Act fails.

Summary

19. The opposition fails.

Costs

20. The opposition having failed, the applicant is entitled to an award of costs in her favour. I make the award on the following basis:

For filing a Form TM8 and reviewing the opponent's Form TM7:	£300
For filing written submissions:	£100
Total:	£400

21. I order Foez Ahmed to pay Doli Begum the sum of £400 as a contribution towards her costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of October 2015

**Ann Corbett
For the Registrar
The Comptroller-General**