

O-515-18

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION  
BY ANIL GANDHI, YOGESH GANDHI AND KETAN GANDHI,  
PARTNERS IN AKY BROTHERS  
TO REGISTER TRADE MARK 3220388:

**Pride Spices**

IN CLASS 30:

AND AN OPPOSITION THERETO UNDER NO. 410146  
BY PRIDE OILS PLC

## BACKGROUND

1. On 22 March 2017, Anil Gandhi, Yogesh Gandhi and Ketan Gandhi, partners in AKY Brothers (the applicants) applied to register the above trade mark in class 30 for the following goods:<sup>1</sup>

### **Class 30**

Spices in the form of powders; Spiced salt; Spice mixes; Spice extracts; Spices; Spice rubs; Cinnamon powder [spice]; Curry spices; Curry powder [spice]; Mustard powder [spice]; Edible spices; Mixed spices; Cinnamon [spice]; Pepper powder [spice]; Curry spice mixes.

2. The application was published on 2 June 2017, following which Pride Oils Plc (the opponent) filed a notice of opposition against all of the goods in the application.

3. The opponent bases its case on sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (the Act). For the purposes of the first of these grounds it relies on the following marks and goods:

<b>Mark details:</b>	<b>Goods:</b>
<p><b>UKTM:</b> 1589406</p> <p><b>CONSUMER'S PRIDE</b></p> <p><b>Filed:</b> 28 October 1994</p> <p><b>Registered:</b> 10 May 1996</p> <p><b>Disclaimer:</b> Registration of this mark shall give no right to the exclusive use, separately, of the words "Consumer's" and "Pride".</p>	<p><b>Class 29:</b></p> <p>Vegetable oils; edible oils; corn oil, cotton seed oil, ground nut oil, maize oil, mustard oil; olive oil for food, palm kernel oil for food, palm oil for food, rape oil for food, sesame oil, sunflower oil for food; coconut oil, coconut fat, coconut butter, desiccated coconut; edible fats, butter, butter ghee, vegetable ghee, margarine; milk products; pickles; fruit pulp; tomato juice for cooking, tomato puree; all included in Class 29.</p>

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<sup>1</sup> *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

**UKTM:** 2338200

A series of eight marks:



**Filed:** 19 July 2003

**Registered:** 3 December 2004

**Description:** The applicant claims the following:- green, blue, yellow and white as elements of the 1st mark in the series, blue, yellow and white as elements of the 2nd mark in the series, purple, blue, yellow and white as elements of the 3rd mark in the series, orange, blue, yellow and white as elements of the 4th mark in the series, red, blue, yellow and white as elements of the 5th mark in the series, brown, blue, yellow and white as elements of the 6th mark in the series, white on black as elements of the 7th mark in the series, black on white as elements of the 8th mark in the series.

**Class 29**

Edible oils and fats; cooking oils; vegetable oils; edible oils; flavoured oils; corn oil, cotton seed oil, ground nut oil, maize oil, mustard oil; olive oil for food, palm kernel oil for food, palm oil for food, rape oil for food, sesame oil, sunflower oil for food; coconut oil, coconut fat, coconut butter, desiccated coconut; edible fats, butter, butter ghee, tomato juice for cooking; onion products; dried and preserved onions.

4. The opponent states:

*“4. The Earlier Trade Marks and the trade mark the subject of the Opposed Application are dominated by the distinctive element, PRIDE. The Earlier Trade Marks are both registered for goods identical or similar to the goods covered in the opposed application. Accordingly, the trade mark the subject of the opposed application is similar to the Earlier Trade Marks and is sought to be registered for goods identical with or similar to those for which The Earlier Trade Marks are registered, such that there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with The Earlier Trade Marks.”*

5. With regards to the s.5(4)(a) ground, the opponent relies on the sign PRIDE which it claims to have used in respect of cooking oils. Use is claimed throughout the UK since 1974. In addition, it relies on the sign CONSUMER'S PRIDE, for which use is claimed throughout the UK, for the same goods, since 'at least as early as 2004'. The opponent submits:

*“5. The trade marks PRIDE and CONSUMER'S PRIDE have been used in the United Kingdom on a significant scale since the 1970s and at least as early as 2004, respectively, by the Opponent. These trade marks have significant goodwill attached to them as the Opponent will prove in its evidence, and use in the course of trade by the Applicant of the trade mark the subject of the Opposed Application would amount to a misrepresentation which would likely lead to damage to the Opponent's goodwill.”*

6. The applicants filed a counterstatement in which they deny the opponent's claims.

7. The opponent filed evidence and both sides filed submissions in lieu of a hearing. Both sides seek an award of costs.

## EVIDENCE

### Opponent's evidence

Witness statement of Jonathan Willis, dated 6 April 2018, and exhibits JPW1 – JPW20

8. Mr Willis is the opponent's Finance and IT Director, a position he has held since September 2014. He is also the Finance and IT Director at Westmill Foods which is a subsidiary of ABF plc. Mr Willis describes the relationship between these companies in the following terms:

*"3. Pride Oils and ABF Grain Products Limited are sister companies, both being in common control of and wholly owned by a common parent company, A.B.F.Holdings Limited. Pride Oils, ABF Grain Products Limited and A.B.F.Holdings Limited are part of the Associated British Foods plc group of companies.*

*4. I am duly authorised to make this declaration on behalf of Pride Oils and Westmill Foods and the matters herein referred to are from my own knowledge, the public record, or from the records of Pride Oils and Westmill Foods, to which I have free access."*

9. With regard to the opponent's use of the earlier marks, Mr Willis states:

*"5. Pride Oils' business was established in east London, United Kingdom, in 1974. At that time the business specialised in cooking oils sold under the trade mark PRIDE..."*

*11. The Earlier Goods under the Earlier Marks are primarily sold to third party retailers, via wholesale. Our customer base is spread throughout the United Kingdom, covering, inter alia, parts of Scotland, Tyne and Wear, North and West Yorkshire, Merseyside, Greater Manchester, Nottinghamshire, West Midlands, Wales, South West England, Hampshire, Greater London and East Sussex.*

12. The Earlier Goods typically bear the mark CONSUMER'S PRIDE on their packaging. This mark also features in marketing and business materials produced in relation to the Earlier Goods.

13. The Earlier Goods are also sold by reference to the mark PRIDE. This mark features alongside the CONSUMER'S PRIDE mark in the same types of marketing and business materials as identified in paragraph 12. Our customers recognise both marks as referring to the Earlier Goods; for instance, when customers are placing orders for the Earlier Goods, which typically bear the mark CONSUMER'S PRIDE on their packaging, they will often make their request by reference to the mark PRIDE.”

10. Mr Willis states that during the period 2004 – 2017, gross sales in the UK under the earlier marks of the earlier goods were ‘in excess of £608,000,000’. He provides an approximate breakdown of ‘the value of sales’ during that period which, for ease of reference, I provide in the following table:

<b>Goods</b>	<b>Value sold each year 2004 - 2017</b>	<b>Total sales for the period 2004-2017</b>
Coconut products	£805,000 – £2,624,000	£22,000,000+
Prepared sauces	£231,000 – £449,000	£5,060,000+
Fruit	-	£6,000-
Butter ghee	£229,000 - £2,333,000	£13,490,000+
Oil based lemon juices and dressings	£491,000 - £920,000	£11,044,000+
Edible vegetable oils	£31,773,000 - £47,162,000	£542,682,000+

Onions	£113,000 - £237,000	£2,085,000+
Tomato paste	-	£1,112,000+
Canned vegetables (including canned tomatoes)	-	£10,986,000

11. At paragraph 16 of his statement Mr Willis provides a further breakdown of sales relating to 'certain edible oil products', during the same period:

<b>Oil product:</b>	<b>Sales between 2004-2017:</b>
Almond	£276,000+
Coconut	£261,000+
Corn	£17,371,000+
Cottonseed	£325,000+
Ghee	£13,490,000+
Groundnut	£2,193,000+
Mustard	£251,000+
Olive	£963,000+
Pomace	£2,416,000+
Rapeseed	£287,620,000+
Sesame	£841,000+
Soya	£178,725,000+
Sunflower	£47,239,000+

12. The first ten exhibits provided by Mr Willis<sup>2</sup> are prints taken from waybackmachine. Each exhibit is the same two pages taken from the opponent's website as it appeared on ten different dates. Mr Willis submits that the pages show essential information to consumers, relating to the goods under the earlier marks, such as unit sizes and the number of units available in packs. The pages are dated 12 October 2014, 13 December 2014, 3 March 2015, 3 May 2015, 17 September 2015, 22 November 2015,

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<sup>2</sup> See exhibits JPW1-JPW10

10 January 2016, 16 March 2016, 12 December 2016 and 8 July 2017. Each begins with the following:

*“Pride was established in 1974 in East London, specializing in cooking oils. Today, Pride continues to sell premium quality oils as well as an extensive range of food products for consumers, restaurants and takeaways.*

*Pride offers an extensive range of products across a wide range of food categories, including oil, canned goods and sauces all with high quality ingredients...”*

13. The following mark is shown at the top of the first page for each exhibit:



14. The goods are described as ‘Pride Sunflower Oil’, ‘Pride Vegetable Oil’, ‘Pride Rapeseed Oil’, ‘Pride Corn Oil’, ‘Pride Groundnut Oil’ and speciality oils which include, ‘Pride Pure Mustard Oil’ and ‘Pride Almond Oil’. Each of these is available in a range of container and pack sizes.

15. Each of the ten exhibits includes a link on the final page to what is described as a ‘trade sheet’. Mr Willis has provided a copy of that page which he describes as a document intended to give trade customers further details of the opponent’s range of oil products sold under the marks.<sup>3</sup> A mark appears in the top left corner of the page which is the same as that shown in the previous paragraph. Alongside it is the following:

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<sup>3</sup> See exhibit JPW11

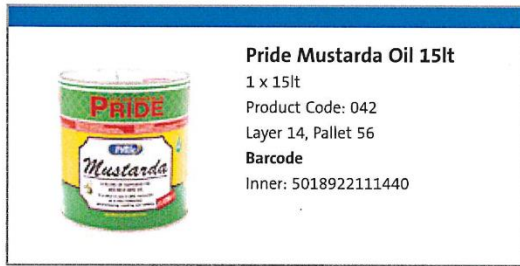


## Features

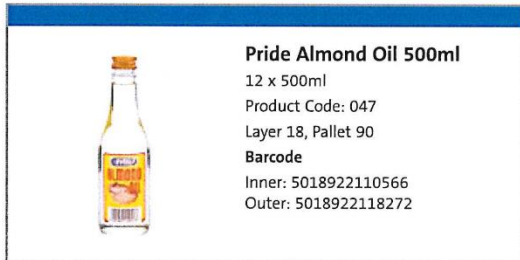
- ✓ A well known brand throughout the ethnic community
- ✓ Pride offers an extensive range of products across a wide range of food categories, including oil, canned goods and sauces
- ✓ High quality ingredients
- ✓ Great value for money

16. Each of the products available for sale is presented with an image of the product, its title, quantity, product code, barcode and so on. In each case the product is described as 'Pride', followed by a description of the type of oil. I provide nine examples as follows:

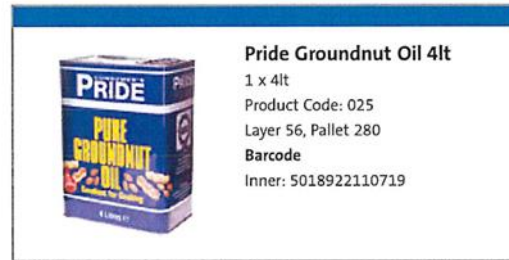
	<p><b>Pride Vegetable Oil 15lt</b>            1 x 15lt            Product Code: 003-A            Layer 14, Pallet 56  <b>Barcode</b>            Inner: 5018922110115</p>
	<p><b>Pride Vegetable Oil 20lt</b>            1 x 20lt            Product Code: 001-A            Layer 14, Pallet 42  <b>Barcode</b>            Inner: 5018922114823</p>
	<p><b>Pride Boxed Vegetable Oil 20lt</b>            1 x 20lt            Product Code: 272            Layer 16, Pallet 48  <b>Barcode</b>            Inner: 5018922117671</p>
	<p><b>Pride Rapeseed Oil 20lt</b>            1 x 20lt            Product Code: 001-C            Layer 14, Pallet 42  <b>Barcode</b>            Inner: 5018922110108</p>
	<p><b>Pride Corn Oil 2lt</b>            6 x 2lt            Product Code: 013            Layer 13, Pallet 78  <b>Barcode</b>            Inner: 5018922110276            Outer: 05015821152864</p>
	<p><b>Pride Corn Oil 4lt</b>            1 x 4lt            Product Code: 012            Layer 56, Pallet 280  <b>Barcode</b>            Inner: 5018922110153</p>



**Pride Mustarda Oil 15lt**  
 1 x 15lt  
 Product Code: 042  
 Layer 14, Pallet 56  
**Barcode**  
 Inner: 5018922111440



**Pride Almond Oil 500ml**  
 12 x 500ml  
 Product Code: 047  
 Layer 18, Pallet 90  
**Barcode**  
 Inner: 5018922110566  
 Outer: 5018922118272



**Pride Groundnut Oil 4lt**  
 1 x 4lt  
 Product Code: 025  
 Layer 56, Pallet 280  
**Barcode**  
 Inner: 5018922110719

17. Mr Willis provides two documents which he submits are available from the Westmill Foods website which list the allergen content of the earlier goods sold under the PRIDE mark. The second of these is after the relevant date but the first is dated 24 November 2014 and provides allergen information for a range of goods.<sup>4</sup> The first two pages are titled, 'Pride Accompaniments' and include a list of products described as 'Pride' goods. They are Pride Butter Ghee, Pride Lemon Juice, Pride Lemon Dressing, Pride Very Hot Chilli sauce, Pride Mint sauce, Pride Tomato Ketchup, Pride coconut flour, Pride creamed coconut, Pride coconut milk, Pride onions, Pride Distilled White Vinegar, Pride Malt Vinegar, Pride Egg Yellow Colour, Pride Red Colour, Pride Green Colour, Pride Orange Colour.

18. The next page is titled, 'Pride Canned Goods', and includes Peeled plum tomatoes, Chopped Tomatoes, Chick Peas, Red Kidney Beans, Black Eye Beans, Spinach puree and Kala Chana.

19. The next page is titled 'Pride Oils' and lists the same oils for which Mr Willis has provided sales figures and which I have reproduced at paragraph 11.

20. The final seven exhibits provided by Mr Willis are described as 'some representative invoices from the period 7 December 2006 to 22 June 2017'. Two of these make no reference to the earlier marks and the last invoice is dated after the

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<sup>4</sup> See exhibit JPW12

relevant dates for both the 5(2)(b) and 5(4) grounds relied on by the opponent. The remaining four invoices show the following:

<b>Date:</b>	<b>Location:</b>	<b>Goods description:</b>	<b>Value:</b>
7/12/06	Enfield	'Pride' Vegetable Oil Gold	£10920
4/12/06	Glasgow	Chinese R/Seed The invoice address is 'PRIDE OILS'.	£12285
23/9/16	Welwyn Garden City	'Pride' Corn Oil	£942.48
13/10/16	Essex	'Pride' Sunflower Oil	£8534.40

## **DECISION**

21. I will begin by considering the opposition under s. 5(4)(a) of the Act which states:

"5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

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

(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."

22. In *Discount Outlet v Feel Good UK*,<sup>5</sup> Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

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<sup>5</sup> [2017] EWHC 1400 IPEC

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

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

23. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

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

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

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

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

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

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

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

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

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

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

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

### **The relevant date**

24. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*,<sup>6</sup> Mr Daniel Alexander Q.C. as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act:

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<sup>6</sup> *BL O-410-11*

“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.’”

25. The filing date of the subject trade mark is 22 March 2017. There is no evidence or claim by the applicants that their mark has been used prior to this date. Accordingly, the matter need only be assessed as of 22 March 2017.

### **Goodwill**

26. The first hurdle for the opponent is to show that it had the required goodwill at the relevant date. In *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd*<sup>7</sup>, the Court stated:

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

27. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)*<sup>8</sup> Pumfrey J. stated:

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<sup>7</sup> [1901] AC 217 (HOL)

<sup>8</sup> [2002] RPC 19 (HC),

“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.”

28. However, 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.”

29. The applicants conclude in their written submissions that the opponent has failed to show the necessary goodwill. They submit:<sup>9</sup>

*“41....as regards the alleged goodwill attached to the word PRIDE, the Applicant contends that the Opponent has failed to establish goodwill in the word PRIDE alone...*

*44. Firstly, the webpage in the Opponent's Exhibits JPW1-10 reference 'Pride' in the opening paragraph as a shortened version of the company name - this is not an example of goodwill in the word PRIDE in relation to the specific goods for which goodwill is claimed.*

*45. Further, whilst the Opponent refers to various oils with 'PRIDE' written at the beginning of each item, such evidence does not substantiate the Opponent's claim to passing off rights in the word PRIDE or CONSUMER'S PRIDE because there is no evidence of how many consumers have viewed this page. As mentioned previously, the purchasing pattern of the average consumer of these goods is primarily visual, whether in the supermarket or online, and the goods bearing the Earlier Marks at the top of the webpage show the stylised version of the Opponent's Mark, which comprises the heavily stylised verbal elements CONSUMER'S PRIDE, and not PRIDE or CONSUMER'S PRIDE alone.*

*46. As regards the Opponent's other examples of evidence in the form of invoices, the number of sales and the 'trade sheet', whilst such examples may prove that the Opponent has made use of the Earlier Marks, they do not substantiate goodwill attached to the words PRIDE and CONSUMER'S PRIDE alone. As mentioned above at 44., the trade mark applied to the goods in question is the stylised version alone, which comprises the verbal elements CONSUMER'S PRIDE.*

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<sup>9</sup> See the applicant's written submissions in lieu of a hearing, dated 19 July 2018.



47. Overall, therefore, the Opponent's evidence does not substantiate the Opponent's assertion that it has accumulated substantial goodwill in the word *PRIDE* or *CONSUMER'S PRIDE* alone in relation to cooking oils.”

30. The opponent submits:<sup>10</sup>

“12. Within his Statement Mr Willis explains the nature of the use that has been made of the Earlier Marks (on product packaging and in marketing and business materials produced in relation to the Earlier Goods, per paragraph 12), their place of use (throughout the United Kingdom, per paragraph 11), the scale of their use (with gross sales in the period of 2004 to 2017 exceeding GBP 608,000,000, per paragraph 15), and the intensity of their use (by reference to the sustained levels of sales outlined in paragraph 15).

13. When Mr Willis' statements as to the use of the mark are considered in conjunction with Exhibits JPW1 to JPW20 it is clear that the Earlier Marks have been put to genuine use in relation to the Earlier Goods over the relevant period.

14. The Witness Statement and its Exhibits demonstrate how consumers have been exposed to the Earlier Marks over the many years of their use. This includes through use of the Earlier Marks in marketing and business materials issued by the Opponent and/or its related companies under authorisation from the Opponent, such as the consumer information materials referred to at paragraphs 17, 18 and 19 (and shown in Exhibits JPW1 to JPW13) and invoices referred to at paragraph 20 (and shown in Exhibits JPW14 to JPW20). It is clear that this use is consistent with the essential function of a trade mark, i.e. to guarantee the identity of the commercial origin of the Earlier Goods as sold under the Earlier Marks.

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<sup>10</sup> See the opponent's written submissions in lieu of a hearing, dated 19 July 2018.

15. Moreover, the Opponent has clearly made serious efforts to establish a share in the market for the Earlier Goods as sold under the Earlier Marks, and succeeding in doing so, with high levels of sales of the Earlier Goods sustained over a period of over a decade (see, in particular, the sales figures of paragraphs 15 and 16, which are supported by the invoices of Exhibits JPW14 to JPW20). These sales figures underline clearly external use of the Earlier Marks, which could in no way be perceived as token.”

31. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*<sup>11</sup>, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

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<sup>11</sup> *Case BL 0/404/13*

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

32. The evidence in its totality shows that the opponent’s business provides a range of food products, primarily focussed on edible oils but also including not insignificant sales of other food ingredients such as sauces. The opponent’s website states that ‘Pride Oils was established in 1974’. Mr Willis has provided sales figures for the period 2004-2017 in respect of edible oils sold under the opponent’s PRIDE and CONSUMER’S PRIDE marks with the first invoices exhibited being dated the 4 and 7 December 2006 to addresses in Glasgow and Enfield respectively.

33. The invoices provided by Mr Willis show the goods described as ‘Pride’, followed by a description, or in one case, just the oil description. The invoices do not show use of CONSUMER’S PRIDE. The prints from waybackmachine match the invoices in that they clearly show that between 12 October 2014 and 8 July 2017,<sup>12</sup> the opponent described its oil products as ‘Pride’, followed by the description of the type of oil. Evidence which shows the way in which the opponent has used its marks on the goods can be found in the opponent’s trade sheet. Some goods appear to have the word PRIDE in a plain typeface while others show the opponent’s earlier logo mark. In some of the examples a word or words can be seen above the word PRIDE, but they are illegible.

34. The figures amount to total sales in excess of £500 million pounds, with sales in each of the individual years being between £31.7 million and £47.1 million. Mr Willis

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<sup>12</sup> The last of the ten examples provided by Mr Willis is after the relevant date.

also provides a further breakdown of the sales by types of oil, for the same period. These figures have not been contested by the applicant and are not insignificant.

35. In its totality the evidence provided by the opponent is sufficient to show it had a protectable goodwill at the relevant date, namely 22 March 2017. A fair characterisation of its business is as a provider of a range products for use in preparing foods, with particular emphasis on edible oils. It is 'edible oils' on which the opponent relies for its opposition under section 5(4) of the Act and it is on that basis I will proceed.

36. The opponent states that it sells its goods throughout the UK, which is supported by the invoices provided by Mr Willis. In all the examples of use shown by the opponent, it is the word PRIDE which stands out and is supported by the accompanying text which describes each of the oils as 'Pride', followed by the type of oil. The word 'CONSUMER'S' is not visible on any of the prints provided in evidence, though it is likely that it is included in the earlier logo mark in the same position as it appears on the trade mark register. That said, the relevant public are likely to consider the opponent's goods as goods sold under the sign 'PRIDE' which is by far the most prominent word in the opponent's sign, in whichever form it is used, and is the word by which the goods are described online, in goods descriptions and on invoices.

### **Misrepresentation**

37. In *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, Morritt L.J. stated that:

"There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is:

'is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]?'

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

38. And later in the same judgment:

“... for my part, I think that references, in this context, to ‘more than *de minimis*’ and ‘above a trivial level’ are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

39. I have found the opponent to have goodwill in respect of edible oils. The opponent makes its passing off claim in respect of the applicant's goods, ‘Spices in the form of powders; Spiced salt; Spice mixes; Spice extracts; Spices; Spice rubs; Cinnamon powder [spice]; Curry spices; Curry powder [spice]; Mustard powder [spice]; Edible spices; Mixed spices; Cinnamon [spice]; Pepper powder [spice]; Curry spice mixes.’

40. The opponent draws the following conclusion with regard to the parties' respective goods:

*“41. The Earlier Goods consist of a variety of foodstuffs in classes 29 and 30. These are almost exclusively ingredients that can be combined with other foodstuffs in order to form a single edible product.*

*42. The Contested Goods, in turn, can all be characterised as types of spice, which (as set out in paragraph 20) are defined as ‘any of a variety of aromatic vegetable substances, such as ginger, cinnamon, nutmeg, used as flavourings’. Spices are accordingly not standalone food items; they, like*

*the Earlier Goods, are combined with other foodstuffs before they are consumed. For instance, the Contested Goods include the following terms: 'Curry spices; Curry powder [spice]; Curry spice mixes'. These items will be added to other foodstuffs in order to make a curry dish."*

41. The applicants submit:

*"35. If there is found to be goodwill in the word(s) PRIDE or CONSUMER'S PRIDE, the particular circumstances of the goodwill must be taken into account, namely the importance of a common field of activity and the specific way in which PRIDE and CONSUMER'S PRIDE are used by the Opponent.*

*36. The residual relevance of a common field of activity is summarised by Millett LJ in Harrods Limited v Harrodian School Limited [1996] RPC 697 (CA):*

*'Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In Stringfellow v. McCain Foods (G.B.) Ltd. [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that 'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'*

*In the same case Stephenson L.J. said at page 547:*

*‘...in a case such as the present the burden of satisfying Lord Diplock’s requirements in the Advocaat case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged “passer off” seeks and gets no benefit from using another trader’s name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents’ property in their goodwill, which must, as Lord Fraser said in the Advocaat case, be substantial.’*

*37. With this in mind, the Applicant submits that the Opponent’s Goods and the Applicant’s Goods are far removed from one another in the respective fields of activity and, in light of these circumstances, it is less likely that any member of the public could reasonably be deceived into thinking that the Applicant’s business is linked to the Opponent’s business.”*

42. I am required to consider normal and fair use of the contested application for all of the goods for which the application is made. The edible oils sold by the opponent include mustard oil, almond oil and coconut oil which are, along with groundnut and olive oil, used to add particular flavours to foods. The applicants’ goods, all being spices and curry powders are also used to flavour food. The natures of the products are different, the opponent’s being liquid and the applicants’ being dry goods, but their users and uses may be the same. They may be in competition, for example mustard powder or mustard oil, either of which will add a mustard flavour to food and they are likely to be sold in close proximity on shelves in bricks and mortar stores, or online. The fact that both parties’ goods are ‘ingredients’ does not lead to an automatic finding of similarity between them. However, in my experience, both parties’ goods at issue here are the types of goods which are used as base ingredients, in a range of different cuisines, by which I mean they are used in the initial stages of creating a meal and infusing it with a particular flavour and are often the foundation on which the rest of

the meal is based. To that extent, I find there to be some similarity between edible oils and spices.

43. The opponent's goodwill is associated with the sign PRIDE. The applicant's mark is 'Pride Spices'. Fair and notional use of the applicants' mark would include use in upper case. The second word 'Spices' is entirely descriptive of the applicants' goods for which registration of the mark is sought. I find these to be highly similar marks.

44. I come to the view that the use shown by the opponent is such that the word PRIDE will be seen as an indication of the commercial origin of the goods in relation to which it is used. The sign PRIDE is distinctive of the opponent.

45. Assuming use of the application in respect of goods which I have found to be similar, I find that a substantial number of the public would have been deceived at the relevant date. In conclusion, a normal and fair use of the applicant's mark at the relevant date would have constituted a misrepresentation to a substantial number of people.

## **Damage**

46. Having found that the goodwill and misrepresentation limbs of the test have been satisfied it follows that damage to the opponent's goodwill will arise, most obviously, by diverting trade from the opponent to the applicants.

47. Damage can also be wider than simply a loss of sales. In *Maslyukov v Diageo Distilling Ltd* Arnold J stated:

"85 Secondly, counsel submitted that the hearing officer had wrongly failed to recognise that damage resulting from Diegeo's loss of control over the marks, including erosion of distinctiveness of the marks, was sufficient damage to sustain a passing off action, as shown by the following passage from McAlpine at [20] which the hearing officer himself quoted at para.128 of the decision:



‘When it comes to considering damage, the law is not so naïve as to confine the damage to directly provable losses of sales, or ‘direct sale for sale substitution’. The law recognises that damage from wrongful association can be wider than that. Thus in *Ewing v Buttercup Margarine Ltd* (1917) 34 R.P.C. 232 Warrington L.J. said:

‘To induce the belief that my business is a branch of another man's business may do that other man damage in all kinds of ways. The quality of the goods I sell; the kind of business I do; the credit or otherwise which I might enjoy. All those things may immensely injure the other man, who is assumed wrongly to be associated with me.’

In so saying, he was not limiting the kinds of potential damage to those listed by him. Rather, he was indicating that the subtleties of the effect of passing off extend into effects that are more subtle than merely sales lost to a passing off competitor. In *Associated Newspapers Ltd v Express Newspapers* [2003] F.S.R. 909 at 929 Laddie J. cited this passage, referred to other cases and went on to say:

‘In all these cases [that is to say, the *Clock Ltd* case referred to above and *Harrods v Harrodian School* [1996] R.P.C. 679], direct sale for sale substitution is unlikely or impossible. Nevertheless the damage to the claimant can be substantial and invidious since the defendant's activities may remove from the claimant his ability to control and develop as he wishes the reputation in his mark. Thus, for a long time, the common law has protected a trader from the risk of false association as it has against the risk of more conventional goods for goods confusion.’

The same judge expressed himself more picturesquely, but equally helpfully, in *Irvine v Talksport Ltd* [2002] 1 W.L.R. 2355 at 2366. Having pointed out the more familiar, and easier, case of a defendant selling inferior

goods in substitution for the claimant's and the consequential damage, he went on to say:

‘But goodwill will be protected even if there is no immediate damage in the above sense. For example, it has long been recognised that a defendant cannot avoid a finding of passing off by showing that his goods or services are of as good or better quality than the claimant's. In such a case, although the defendant may not damage the goodwill as such, what he does is damage the value of the goodwill to the claimant because, instead of benefiting from exclusive rights to his property, the latter now finds that someone else is squatting on it. It is for the owner of goodwill to maintain, raise or lower the quality of his reputation or decide who, if anyone, can use it alongside him. The ability to do that is compromised if another can use the reputation or goodwill without his permission and as he likes. Thus Fortnum and Mason is no more entitled to use the name FW Woolworth than FW Woolworth is entitled to use the name Fortnum and Mason ...’ ‘The law will vindicate the claimant's exclusive right to the reputation or goodwill. It will not allow others so to use goodwill as to reduce, blur or diminish its exclusivity.’ (at 2368)

In *Taittinger SA v Allbev Ltd* [1994] 4 All ER 75 at 88, Peter Gibson L.J. acknowledged that:

‘Erosion of the distinctiveness of the name champagne in this country is a form of damage to the goodwill of the business of the champagne houses.’ The same view was expressed by Sir Thomas Bingham MR at 93.”

48. To illustrate the point further, I note that in *WS Foster & Son Limited v Brooks Brothers UK Limited*,<sup>13</sup> Mr Recorder Iain Purvis QC stated:

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<sup>13</sup> [2013] EWPC 18

## “Damage

55 Although proof of damage is an essential requirement of passing off cases, it will generally be presumed where a misrepresentation leading to a likelihood of deception has been established, since such deception will be likely to lead to loss of sales and/or more general damage to the exclusivity of the Claimant's unregistered mark. Mr Aikens accepted that if there was a misrepresentation in the present case, then he had no separate case on damage. I hold that damage is inevitable, at least in the sense recognised in *Sir Robert McAlpine v Alfred McAlpine* [2004] RPC 36 at 49 (the ‘blurring, diminishing or erosion’ of the distinctiveness of the mark).”

49. I therefore find that use of the applicant’s mark at the relevant date was liable to be restrained under the law of passing off in respect of the goods I have identified above.

50. The opposition succeeds under s. 5(4)(a) of the Act.

51. Having found the opposition to have succeeded under s.5(4)(a) in full, I do not intend to go on to consider the opponent’s case under section 5(2)(b) since it puts the opponent in no better position.

## **COSTS**

52. The opposition having succeeded; the opponent is entitled to a contribution towards its costs.

53. A case management conference (CMC) was held during these proceedings to determine an extension to the opponent’s deadline by which to file its evidence in chief. That request was granted despite the applicants’ objection to it. The CMC itself was brief and the issue was not a complex one and I do not propose to favour either party with an award of costs in respect of it.

54. In respect of the substantive proceedings, I award costs on the following basis:

Official fee:	£200
Preparing a statement and considering the other side's statement:	£200
Preparing evidence and submissions and considering submissions:	£800
Total:	£1200

55. I order Anil Gandhi, Yogesh Gandhi and Ketan Gandhi, partners in AKY Brothers to pay Pride Oils Plc. the sum of £1200. 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 should any appeal against this decision be unsuccessful.

**Dated this 21<sup>st</sup> day of August 2018**

**Ms AI Skilton  
For the Registrar,  
The Comptroller-General**