

**O-006-21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3373650  
BY ARK INTERNATIONAL (UK) LTD IN RESPECT OF THE TRADE MARK**

**GODAVARI**

**IN CLASSES 29, 30 AND 31**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 417090 BY  
BOKHARY FOODS INC (DBA) EKTA FOODS**

**AND**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3387567  
BY BOKHARY FOODS INC (DBA) EKTA FOODS IN RESPECT OF THE TRADE  
MARK**



**IN CLASSES 29, 30 AND 31**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 417583 BY ARK  
INTERNATIONAL (UK) LTD**

## Background and pleadings

1. Ark International (UK) Limited (hereafter “Ark”) applied to register the trade mark no. 3373650 in respect of GODAVARI in the UK on 7 February 2019. It was accepted and published in the Trade Marks Journal on 28 June 2019 in respect of the following services:

**Class 29:** *Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.*

**Class 30:** *Coffee, tea, cocoa, sugar, 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.*

**Class 31:** *Raw and unprocessed agricultural, aquacultural, horticultural and forestry products; raw and unprocessed grains and seeds; fresh fruits and vegetables, fresh herbs; natural plants and flowers; bulbs, seedlings and seeds for planting; live animals; foodstuffs and beverages for animals; malt.*

2. Bokhary Foods Inc (DBA) Ekta Foods (hereafter “Ekta”) opposes the application on the basis of sections 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994 (“the Act”). The opposition is on the basis that the mark consists exclusively of a sign that may serve in trade to designate the geographical origin of the goods and this also renders the mark devoid of any distinctive character. It asserts that the word “Godavari” designates that the goods concerned are from the districts of Godavari in India or from other areas adjacent to the Godavari river. It relies upon the Registry’s refusal of trade mark no. 3104167 for the same reasons.

3. Ark filed a counterstatement denying the claims made asserting that the Registry is not bound by its previous decisions and noting that its mark was assessed for its registrability by the Registry during the examination process. It puts Ekta to proof of its claims. It further points to the difference in the list of goods of its application

compared to the goods of the refused application no. 3104167 asserting that the Registry was correct to refuse 3104167 and to accept its application.

4. On 28 March 2019, Ekta applied to register the following trade mark:



5. It was published on 7 June 2019 in respect of the following list of goods:

**Class 29:** *Pickles; lentils; vegetables (prepared, frozen); frozen meals consisting primarily of fish or meat; frozen meals consisting primarily of vegetables; fruit snacks; potato snacks; coconut based snacks; milk based snacks; legume based snacks.*

**Class 30:** *Rice; Sona Masoori rice; brown rice; sweet and savoury snacks; seasonings, flavouring and condiments; spices; mixed spices; marinades containing spices; flour; flour mixes; frozen meals consisting primarily of rice; cereal based savoury snacks; cereal based sweet snacks; rice snacks; cake based snacks; extruded corn snacks; rice cake snacks; extruded wheat snacks.*

6. Ark subsequently filed an opposition to Ekta's application on the basis of grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Act, directed in each instance against all of the applied-for goods. For the purposes of its sections 5(2)(b) and 5(3) grounds it relies upon its application no. 3373650, the details of which are provided in paragraph 1 above. It has a filing date of 7 February 2019. This is earlier than the filing date of Ekta's application (28 March 2019) and, therefore, if it progresses to registration it will be an "earlier mark" under section 6 of the Act.

7. Ark asserts that Ekta's mark is aurally identical or, in the alternative, highly similar to its earlier mark and both contain the distinctive and dominant element GODAVARI. Further, it asserts that they are visually highly similar. It acknowledges the additional words present in the mark but asserts that the words "CRYSTAL QUALITY" are purely descriptive. It asserts that because the respective goods are identical or similar there exists a real risk of confusion and the mark should be refused under section 5(2)(b) of the Act.

8. In respect of the ground based upon section 5(3), Ark asserts that use of Ekta's mark in respect of all of the listed goods would, because of its similarity to its mark, lead to the relevant public believing that the respective marks are used by the same undertaking or believe that there is an economic connection. It claims to have spent considerable sums and resources building its brand and that given the similarity between the marks and goods it is inevitable that the association made between the two marks will result in detriment to its mark's reputation.

9. The section 5(4)(a) ground is based upon Ark having goodwill identified by the sign GODAVARI and the following sign:



10. It claims these two signs have been used throughout the UK since February 2019 in respect of a list of goods that corresponds to the specifications of goods set out in its application no. 3373650 and shown in paragraph 1, above. It asserts that use of Ekta's mark will amount to misrepresentation and Ark is highly likely to suffer damage. It asserts this all amounts to passing off under section 5(4)(a) of the Act.

11. Ekta filed a counterstatement denying the claims made. It contends that the only shared element is the word “GODAVARI” and that this is purely descriptive. In this respect it refers to its cross-opposition based upon sections 3(1)(b) and 3(1)(c) of the Act. It asserts that the other elements present in its mark create substantial differences between the marks. Consequently, it denies that the marks are similar. It also requests that Ark proves that it has the claimed reputation.

12. The two oppositions were subsequently consolidated.

13. The parties have both filed evidence in these proceedings. This will be referred to the extent that it is considered necessary. A hearing took place before me on 17 November 2020 where Ekta was represented by Jamie Muir Wood of counsel, instructed by WP Thompson. Ark is represented in these proceedings by Sheridans but it was not represented at the hearing. It did file written submissions in lieu of attendance. I keep these submissions in mind and I will refer to them where they assist me.

## **DECISION**

### **Ekta’s Evidence**

14. This takes the form of a witness statement from Francesco Simone, Trade Mark Attorney at WP Thompson who is representing Ekta in these proceedings. Mr Simone’s evidence is in support of the claim that the Godavari River is well known and that Indian cuisine is particularly popular in the UK.

### **Ark’s Evidence**

15. This takes the form of two witness statements from Chandrasekhar Korla, the founder and 100% shareholder of Ark. His evidence relates to the Registry’s previous refusal of the mark GODAVARI in respect of rice and evidence of the cultural and agricultural significance of the Godavari River.

## **Approach**

16. Ekta's opposition to Ark's mark, based upon section 3 of the Act, has the potential to impact upon Ark's opposition. I, therefore, intend to consider Ekta's opposition first.

## **Ekta's Opposition to Ark's application**

17. The relevant parts of section 3(1) state as follows:

"3(1) The following shall not be registered –

(a) ...,

(b) trade marks which are devoid of any distinctive character,

(c) 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 of services, or other characteristics of goods or services,

(d) ...:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

## **Section 3(1)(b) and (c) – General:**

18. In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the CJEU stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

### **Section 3(1)(c)**

19. I find it convenient to begin by considering the ground based upon section 3(1)(c).

20. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 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), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of

Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of

no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

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)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

21. The mark at issue is the name of a large river in India and Ekta submits that, consequently, it indicates geographical origin of all the goods of Ark's application. I keep in mind the following additional guidance relating to geographical names from the CJEU in *Windsurfing Chiemsee v Boots Attenberger* ("*Chiemsee*"), C-108/97 and C-109/97:

"31 Thus, under Article 3(1)(c) of the Directive [equivalent to section 3(1)(c) of the UK Trade Marks Act 1994 or 'UKTMA'], the competent authority must assess whether a geographical name in respect of which an application for registration as a trade mark is made designates a place which is currently associated in the mind of the relevant class of persons with the category of goods concerned, or whether it is reasonable to assume that such an association may be established in the future.

32 In the latter case, when assessing whether the geographical name is capable, in the mind of the relevant class of persons, of designating the origin of the category of goods in question, regards must be had more particularly to the degree of familiarity amongst such persons with that name, with the characteristics of the place designated by the name, and with the category of goods concerned.

33 In that connection, Article 3(1)(c) of the Directive [section 3(1)(c) UKTMA] does not in principle preclude the registration of geographical names which are unknown to the relevant class of persons or at least unknown as the designation of a geographical location or of names in respect of which, because of the type of place they designate (say, a mountain or lake), such persons are unlikely to believe that the category of goods concerned originates there.

34 However, it cannot be ruled out that the name may serve to designate geographical origin within the meaning of Article 3(1)(c) [section 3(1)(c) UKTMA], even for goods such as those in the main proceedings [being, in that particular case, items of sports clothing], provided that the name could be understood by the relevant class of persons [to include the shores of the lake or the surrounding area].

35 It follows from the foregoing that the application of Article 3(1)(c) [section 3(1)(c) UKTMA] does not depend on there being a real, current or serious need to leave a sign or indication free.

36 Finally, it is important to note that, whilst an indication of the geographical origin of goods to which Article 3(1)(c) [section 3(1)(c) UKTMA] applies usually indicates the place where the goods were or could be manufactured, the connection between a category of goods and a geographical location might depend on other ties, such as the fact that the goods were conceived and designed in the geographical location concerned.

22. Whilst not bound by the guidance in the Registry's Work Manual, I also keep in mind the following comments contained therein:

“the ‘association’ between place name and product, which the Court has confirmed is central to the assessment, need not be limited to a consideration of whether the word designates the ‘place of manufacture’ (or, in the case of services, the ‘place of rendering’).

Beyond the more conventional forms of geographical place names (being countries, cities, and towns), section 3(1)(c) can equally apply to any other designation of geographical area be it inter alia a district, a mountain, a lake (see Chiemsee, for example), a commercial district, see Canary Wharf [2015] EWHC 1588 (Ch) a natural spring, a resort, or a place of natural beauty.

Wherever it is considered that the relevant consumer will make an association between the place name and the product(s) intended for protection, then an objection will be likely. Equally, where it is considered that other traders may genuinely seek to use the geographical place-name in their future course of trade (most likely, again, because of the existence of an association between the place and the product) then an objection will apply.

Where the geographical place name intended for protection has no obvious reputation, it must still be considered how the mark will be perceived in trade. In order to do so, consideration will be given to all facts related to the place

name including, but not limited to, the size of the location, and the extent and nature of commercial activity that goes on within its boundaries.

Whilst every town, regardless of size, would likely offer library services, not every town would produce tea bags, and so the consideration of reputation becomes more prevalent. For example, Oxford Leisure Centre would face an objection under 3(1)(c), however, Oxford Tea Bags would not.

The names of places which are likely to be the source of natural produce are unlikely to be registrable as trade marks for such goods even if the place identified by the mark has no specific reputation. A place will have to be obscure before its name can be registered as a trade mark for unprocessed products of the kind frequently sold from roadsides and farm shops, such as fruit and vegetables, flowers, potatoes, water, eggs and milk. This may not be the case in respect of processed foodstuffs, which are less likely to be associated with local producers and providers. In the case of such products, the names of a larger, more populous areas may be objectionable if the examiner considers them likely to be perceived as a reference to where the foodstuff was processed.”

23. At the hearing, Mr Muir Wood pointed out that the Godavari river is the second longest river in India running across the country. He submitted that, consequently, it is reasonable to assume that the majority of the population of India will be aware of it. Ekta’s relevant evidence can be summarised as follows:

- The Godavari river is the second longest river in India and is about 910 miles long. It runs into the Bay of Bengal where it forms the largest river basin in the Indian subcontinent<sup>1</sup>;
- The following evidence is provided<sup>2</sup>, sourced from the Internet, to support the claim that the British Indian Community forms a considerable part of the UK population:

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<sup>1</sup> See extracts from Wikipedia and Encyclopaedia Britannica at Exhibit FS1

<sup>2</sup> At Exhibit FS2

- British Indians are UK citizens whose ancestral roots lie in India. They comprise about 1.4 million people in the UK and are the “single largest visible ethnic minority population in the country”. 45% of these are of Punjabi origin<sup>3</sup>;
- Over 2 million Britons eat at Indian restaurants in the UK every week with a further 3 million cooking at least one Indian based meal at home each week<sup>4</sup>;
- In support of the claim that GODAVARI is known as a geographical indication for a variety of foods, the following Internet extracts are provided<sup>5</sup>:
  - From the website [www.southreport.com](http://www.southreport.com): A list of “10 Must Try Dishes of Andhra Pradesh” includes a dish called “Pulasa Pulusu” that is described as “[a] famous and expensive fish found in the back waters of River godavari. It is a sea fish which enters the river godavari and known for its amazing taste”. A second dish called “Bongulo Chicken” is described as “... a tribal dish found in the East Godavari ...districts of Andhra Pradesh”;
  - From the website [www.crazymasalafood.com](http://www.crazymasalafood.com): an article entitled “Best 20 Spicy Pickles in Godavari Region. Recipes are provided for these pickles.
  - An article appearing on the Indian website <http://sandrp.in> is entitled “Godavari’s Story” and Ekta highlights the following statements contained within this lengthy article:
    - “About 60% of the [Godavari] basin is covered with agricultural land.”
    - “Godavari Basin is rich in fish species”
  - A Wikipedia entry for the fish called “ilish” includes the statement “In India, [various rivers] and Godavari rivers ... are famous for their fish yields”;
  - An extract from the website [www.quora.com](http://www.quora.com) relates to the question “What are the famous godavari cuisines?”. One answer is shown that states “The entire Godavari delta ... developed a cuisine, that has

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<sup>3</sup> Wikipedia extract in the same exhibit

<sup>4</sup> ditto

<sup>5</sup> At Exhibit FS3

been heavily rice and coconut based. The cuisine of this region, is based solely on the local food produce ..., has ensured that fish, prawns and crabs are a staple of the region too.”

24. In undertaking my considerations, I keep in mind the following principles from those above:

- It is not necessary that the sign in question is actually in use at the time of the application. It is sufficient that the sign could be used for descriptive purposes;
- The sign is caught by the provision if it is capable of designating a “characteristic” of the goods, in this case that characteristic is geographical origin;
- The sign does not need to be currently associated with a specific place. It is sufficient if it is reasonable that such an association may be established in the future.

25. Ark, in its evidence<sup>6</sup>, admits that the Andhra Pradesh region that part of the Godavari river runs through is known for its rice production, that the moniker “rice bowl” is used to describe the area and that the area is ripe for farming paddy fields and coconut groves. Consequently, it admits that GODAVARI would typically be understood as a geographic indicator of the origin for rice or rice goods<sup>7</sup>.

26. Ark also provides evidence in support of its claimed reputation among the relevant public in the UK<sup>8</sup>. It states that its GODAVARI mark was used “as early as February 2019”. Insofar as this can be interpreted as a claim that its mark has acquired distinctive character in the UK, I dismiss it. The relevant date in these proceedings is the filing date of Ark’s application, namely, 7 February 2019. This coincides with the first claimed use and it is clear to me that there was not sufficient time to acquire distinctive character by the relevant date. Consequently, my considerations are limited to the inherent qualities of the mark.

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<sup>6</sup> Mr Korla’s witness statement, paras 10 and 11

<sup>7</sup> Ditto, para 13

<sup>8</sup> Ditto, para 18 - 28

27. Ark states that GODAVARI is not clearly associated with the goods covered by its specifications and that, consequently, it is distinctive and acts as a trade mark for its listed goods<sup>9</sup>. In this respect, the evidence illustrates that about 60% of the Godavari basin is covered by agricultural land. However, the basin is located in the south east part of the river that is in Andhra Pradesh and, therefore, appears to be a reference to the Godavari “rice bowl”.

28. Ark has acknowledged that GODAVARI would typically be understood as a geographic indicator of the origin for rice or rice goods. Rice is not listed in its specifications, however, the following general terms, covered by Ark’s Class 31 specification can all, self-evidently, include rice:

*Raw and unprocessed agricultural ...products; raw and unprocessed grain*

29. In light of this, I find that the word GODAVARI will be understood as designating the geographical origin of these goods at least insofar as they are in the form of rice.

30. It is Ekta’s submission that the GODAVARI is a place currently associated in the minds of the relevant consumer with the goods concerned. It points to:

- the existence of 1.4 million British Indians whose ancestral roots and will therefore be aware of the Godavari river;
- over 2 million Britons eat in Indian restaurants in the UK every week.

31. Ark makes a number of criticisms of Ekta’s reliance upon the number of British Indians. I particularly note and agree with the claim that many of these are not first generation Indians and a large proportion will have been brought up in the UK and may have a lesser level of knowledge of Indian geography than first generation Indians. It is more likely the British Indians whose families originate from parts of India that are close to the Godavari river will be aware of it, but I note that the evidence also states that 45% of British Indians are of Punjabi origin. As Ark have submitted, this is in the North West of India and not near the course of the Godavari

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<sup>9</sup> Ditto, paras 14 - 16

river. Consequently, I find the fact that there are 1.4 million British Indians is not a significant factor and I cannot conclude that the UK relevant public will know that GODAVARI is a geographical location or the name of a river in India.

32. I am unpersuaded by Ekta's reliance upon the fact that 2 million Britons eat at Indian restaurants each week. It is not obvious to me how the number of Britons that eat in Indian restaurants translates to the UK relevant public knowing that GODAVARI indicates a geographical place. Whilst there is some evidence of several dishes being described as Godavari cuisine, there is no evidence that the dishes are widely available in UK Indian restaurants or that, even if they are, that they are promoted as being Godavari cuisine. Therefore, I dismiss this submission.

33. This is not end of matter because, as stated by the CJEU in *Chiemsee* (para 31), a sign may not be refused registration unless the geographical name in respect of which registration as a trade mark is sought designates a place which is associated in the mind of the relevant class of persons with the category of goods concerned, or it is reasonable to assume that such an association may be established in the future. Further, at paragraph 33 of the same judgment, the CJEU also stated that, in principle, the registration is not precluded of geographical names which are unknown to the relevant class of persons, or at least unknown as the designation of a geographical location, or of names in respect of which, because of the type of place they designate, such persons are unlikely to believe that the category of goods concerned originates there.

34. It is relevant that the GODAVARI name appears to be associated with the name of a river rather than any other geographical area. With the exception of the goods identified in paragraph 28, above, there is nothing before me to suggest that river names are generally used as a geographical description of the origin of goods of the kind in issue here. As a consumer of many of the goods listed, my experience is that where geographical origin is considered a desirable characteristic this is communicated by the use of a geographical place name whether that be a country, a region, or a smaller place. It is not normal to use the name of a river that may flow through a particular geographical place. There may be some exceptions where locally caught fish are promoted by reference to the river they were caught in, but

there is nothing before me that illustrates that a river name is used in relation to fish caught on one continent and marketed on another.

35. Whilst the Godavari river undoubtedly passes through a number of areas/regions where natural produce may be produced, or even through area/regions that may have a specific reputation for the goods produced there, it does not mean that the river's name will become associated with that produce or reputation. This is particularly so where, as here, I am considering the name of a river on a distant continent and what it means to the average UK consumer. There is an absence of persuasive evidence that this consumer is even aware of the GODAVARI river, let alone a level of knowledge that would result in a perception that goods sold under the name GODAVARI originate from or around the river.

36. Taking all of the above into account, I conclude that, in respect of all the goods other than those identified in paragraph 28, the geographical name GODAVARI is not currently associated in the mind of the UK consumer with the goods listed. Further, there is no basis to reasonably assume that such an association may be established in the future. Consequently, the ground based upon section 3(1)(c) fails.

37. In summary, the opposition based upon section 3(1)(c) succeeds in respect of the following goods:

**Class 31:** *Raw and unprocessed agricultural, ... products; raw and unprocessed grains*

38. The ground fails in respect of the following goods:

**Class 29:** *Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.*

**Class 30:** *Coffee, tea, cocoa, sugar, 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.*

**Class 31:** *Raw and unprocessed ..., aquacultural, horticultural and forestry products; raw and unprocessed ... seeds; fresh fruits and vegetables, fresh herbs; natural plants and flowers; bulbs, seedlings and seeds for planting; live animals; foodstuffs and beverages for animals; malt.*

### **Section 3(1)(b)**

39. As stated in *Starbucks (HK) Ltd v British Sky Broadcasting Group plc* (at para 46) descriptive signs are also devoid of any distinctive character. It, therefore, follows that to the extent that the opponent has succeeded, it must also succeed based upon its section 3(1)(b) grounds.

40. In addition, Ekta makes no independent claim as to why the mark is non-distinctive other than because it is claimed to be a geographical name. This also points to there being no need to consider the section 3(1)(b) ground separately to the section 3(1)(c) ground (see the comments of Anna Carboni, sitting as the Appointed Person in O-363-09 *COMBI STEAM Trade Mark*).

41. Therefore, whilst recognising that section 3(1)(b) and section 3(1)(c) are independent of each other, the circumstances in this case are such that it is not necessary for me to consider separately the ground based upon section 3(1)(b)

42. I conclude that the ground based upon section 3(1)(b) succeeds partially and to the same extent as the ground based upon section 3(1)(c).

### **Ark's Opposition to Ekta's application**

43. Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

44. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

### ***Comparison of goods***

45. In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

46. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

47. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“the GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

#### *Class 29*

48. The respective goods are:

<b>Ark's goods</b>	<b>Ekta's goods</b>
<i>Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.</i>	<i>Pickles; lentils; vegetables (prepared, frozen); frozen meals consisting primarily of fish or meat; frozen meals consisting primarily of vegetables; fruit snacks; potato snacks; coconut based</i>

	<i>snacks; milk based snacks; legume based snacks.</i>
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49. The term *pickles* in Ekta's specification describes one form of *preserved ...vegetables* and is, therefore, identical to Ark's goods when keeping in mind the guidance from *Meric*. Similarly, Ekta's *lentils* are covered by Ark's broad term *preserved, dried and cooked ... vegetables* and are also identical. Further, Ark's *milk products*, in Class 29, is a broad term that covers Ekta's *milk based snacks* and they are identical.

50. Ark's *vegetables (prepared, frozen)* having the same nature, purpose, method of use and are in competition to Ekta's *preserved, dried and cooked ... vegetables*. They differ only that one is frozen and the other is not. They are highly similar.

51. I note that Ekta's *frozen meals consisting primarily of fish or meat* have, as their primary ingredient food covered by Ark's *Meat, fish, poultry and game*. I recognise that this, in itself, is not sufficient to show that the respective goods are similar<sup>10</sup> but in this case they share a similar nature, being meat-based food, they have the same intended purpose, namely, to be consumed to satisfy hunger. Further they are likely to share an essentially overlapping average consumer and will be in competition where the consumer may choose between buying meat for use as an ingredient for a meal or the meal ready-prepared. Taking all of this into account, I find that they share a medium level of similarity.

52. Similarly, Ekta's *frozen meals consisting primarily of vegetables* also share a medium level of similarity to Ark's *preserved, dried and cooked ... vegetables*.

53. Ark's *fruit snacks; potato snacks; coconut based snacks; ...; legume based snacks* overlap with Ekta's *preserved, dried and cooked fruits and vegetables* that can also be snacks and I find that these respective goods are identical.

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<sup>10</sup> *Les Éditions Albert René v OHIM*, Case T-336/03, para 61

54. The respective goods are:

Ark's goods	Ekta's goods
<p><i>Coffee, tea, cocoa, sugar, 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.</i></p>	<p><b>Class 30:</b> <i>Rice; Sona Masoori rice; brown rice; sweet and savoury snacks; seasonings, flavouring and condiments; spices; mixed spices; marinades containing spices; flour; flour mixes; frozen meals consisting primarily of rice; cereal based savoury snacks; cereal based sweet snacks; rice snacks; cake based snacks; extruded corn snacks; rice cake snacks; extruded wheat snacks.</i></p>

55. Ekta's *Rice; Sona Masoori rice; brown rice* is not covered by Ark's specification. However, it is a starchy carbohydrate source of nutrition as is Ark's *sago* and *tapioca* and is, therefore, likely to have overlapping uses in cooking and preparing food/meals. Consequently, they are similar in nature and intended purpose and may be in competition. I conclude that they share a medium level of similarity.

56. The following of Ekta's goods are self-evidently identical to Ark's goods because the same or very similar term appears in both specifications : *seasonings, flavouring* [both include spices]; *spices; mixed spices; flour, flour mixes*.

57. In respect of *condiments* overlap with Ark's *salt, mustard; sauces (condiments)* and are also self-evidently identical.

58. In respect of Ekta's various snack products i.e. *sweet and savoury snacks;*, *cereal based savoury snacks; cereal based sweet snacks; rice snacks; cake based snacks; extruded corn snacks; rice cake snacks; extruded wheat snacks*, they have

no direct equivalent in Ark's specification. Ark's *bread* and *confectionery* are food products that may be consumed as a snack and, therefore, these goods may share the same purpose and be similar in nature to Ekta's goods. Further, because the consumer may choose between one or the other when purchasing a snack, they may be in competition. I conclude that these goods share a medium level of similarity.

59. Ekta's *marinades containing spices* is used to soak food before cooking and is not identical to any of Ark's goods. However, it has a complementary relationship with those goods (such as *meat* and *fish* in Ark's Class 29 specification). Further, these goods are all foodstuffs that may be cooked together and ready-made marinades may appear on adjacent shelves to the food products that the marinade is intended to be used with. However, they are different in nature, methods of use and they are not in competition. Taking account of this, I find there is similarity but I would put it at no more than low.

60. Ark's specification does not include any meals, nor rice and, therefore, its goods are not identical to Ekta's *frozen meals consisting primarily of rice*. Ark's specification does include the term *preparations made from cereals*. These cereals may include rice. Therefore, the respective goods may be similar in nature, intended purpose and may also be in competition. Taking all of this into account, I find they share a low to medium level of similarity.

### **Comparison of marks**

61. It is clear from *Sabel BV v. Puma AG*, Case C-251/95 (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*, Case C-591/12P, that:

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

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

63. The respective trade marks are shown below:

Ark's earlier mark	Ekta's mark
<p>GODAVARI</p>	

64. Ark's mark consists of a single word and is, obviously, the dominant and distinctive element. Ekta's mark consists of the word GODAVARI appearing in large red letters at the centre of the mark. The letter "V" in the word appears slightly larger than the rest of the word. The word "EKTA'S" appears directly above the word GODAVARI in white letters within a blue background and the words "CRYSTAL QUALITY" appear below the word and in the same font, colour and background as "EKTA's" but in a slightly larger font. There is also a device in the form of a forearm and hand held upwards and holding what appears to be a coconut. The arm appears through the "O" of GODAVARI. Finally there is a line border. The word "GODAVARI", because of its size and position within the mark, is its dominant distinctive element. The word "EKTA'S" contributes to the distinctive character of the mark as does, to a lesser degree, the device element and the get-up of the mark. The words "CRYSTAL

QUALITY” is likely to be perceived as a laudatory message and does not add to the distinctive character and neither does the line border as it only has a negligible impact upon the overall impression created by the mark.

65. Visually, there is some similarity between the marks because the word GODAVARI appears in both. All the additional elements present in Ekta’s mark create visual differences, but because of the dominance and position of the GODAVARI element within its mark and conclude that there is still a medium degree of visual similarity.

66. Aurally, Ark’s mark will be expressed as the four syllables GOD-AH-VAR-EE. In respect of Ekta’s mark, I do not consider that CRYSTAL QUALITY will be expressed when referring to the mark. The mark is likely to be expressed either in an identical way to Ark’s mark or, equally likely, by reference to the “EKTA’S” element also. In the latter case it will be expressed as the six syllables EK-TAAS-GOD-AH-VAR-EE. In the first case, the marks are aurally identical and, in the second case, they share similarity that is somewhere between medium and high.

67. Conceptually, whilst some average consumers in the UK will recognise the word GODAVARI as the name of an Indian river, the majority will not. Other than the claim that the 1.4 million British Indians will have knowledge of the Godavari river (something I have already dismissed) there is nothing before me to suggest that the average UK consumer has a knowledge of Indian geography that would extend to the name of this river. In the minds of these consumers, the mark is likely to be perceived as an invented word or a foreign word of unknown meaning. Ekta’s mark carries a number of conceptual messages, namely, the concept of “crystal quality”, the possessive of the word “EKTA” applying to the word GODAVARI giving the impression of ownership of “GODAVARI”. However, because the word “GODAVARI” is not likely to have a conceptual meaning in the minds of the average UK consumer, it’s occurrence in both marks does not create any conceptual similarity.

### ***Average consumer and the purchasing act***

68. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

69. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

70. All of the parties' Class 29 and 30 goods are ordinary food products where the average consumer is the grocery purchasing general public. The purchasing process will be primarily visual in nature with goods being selected from a shop shelf or online equivalent and the level of care and attention will be no more than average in respect to such goods.

### ***Distinctive character of the earlier trade mark***

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the

goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

72. There is no claim that the earlier mark benefits from an enhanced level of distinctive character because of the use made of it in the UK. Consequently, I need only consider its inherent distinctive character and, at paragraph 26 above, I have anyway dismissed the notion that there is evidence of use of mark that could affect its distinctiveness.. The earlier mark consists of the word GODAVARI. I found earlier that whilst some will recognise it as being the name of a river in India, the majority of consumers in the UK will not. Rather it will be perceived as either an invented word or a foreign word of unknown meaning. Consequently, it is endowed with a good level of inherent distinctive character.

#### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

73. The following principles are obtained from the decisions of the CJEU in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson*

*Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P:*

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

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

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

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

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

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

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

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

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

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

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

74. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). These factors must be assessed from the viewpoint of the average consumer who rarely has the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods down to the responsible undertakings being the same or related).

75. I have found that:

- some of the respective goods are identical and the others range between a low to high level of similarity;
- the word GODAVARI is the dominant and distinctive element of Ekta's mark but I also recognised that the EKTA'S element contributes to the distinctive character;

- the respective marks share a medium degree of visual similarity, somewhere between medium and high aural similarity and that there is no conceptual similarity for the majority of UK consumers;
- the average consumer of the respective goods is the grocery buying general public and the purchasing process is primarily visual in nature with no more than an average degree of care and attention being paid;
- Ark's earlier mark GODAVARI is endowed with a good level of inherent distinctive character.

76. Ekta's submissions regarding likelihood of confusion are premised upon its position that GODAVARI is a non-distinctive element of its mark and that Ark's mark is descriptive and non-distinctive. I have dismissed this position and I have found that, from the perspective of the UK consumer, the word GODAVARI is likely to be perceived as an invented word or an unknown foreign word and with a good level of distinctive character. This word is the dominant and distinctive element of Ekta's mark. With all of this in mind, I find that, in respect of all of Ekta's goods, there is a likelihood of confusion. Even if the average consumer recalls the visual differences between the marks, the prominence of GODAVARI in Ekta's mark will lead the consumer to assume that its mark is used by the same or linked undertaking as Ark's mark and, consequently, there would be indirect confusion.

77. In reaching this finding, I have kept in mind that some factors lean in favour of a finding of no likelihood of confusion, such as the visual differences between the marks and the fact that I have found that some of the respective goods are only similar to no more than a low degree. However, these factors are out-weighed by the similarities between the marks created by the common occurrence of the word GODAVARI.

78. In summary, I find that the ground based upon section 5(2)(b) succeeds in its entirety.

#### **Section 5(4)(a)**

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

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

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

(aa) .....

(b) .....

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

80. Subsection (4A) of Section 5 states:

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

81. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

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

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

82. 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.”

83. In *SWORDERS TM* O-212-06, Mr Allan James acting for the Registrar summarised the position regarding the relevant date for the purposes of section 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.’ ”

84. In the current case, the Ekta’s mark was applied for on 28 March 2019. No claim has been made by the proprietor to an earlier date and, consequently, I only need to consider the position as of the filing date of Ekta’s mark.

85. Ark must, therefore, demonstrate that it had the requisite goodwill at the relevant date. It relies upon the evidence of Mr Korla and, in particular, the evidence of

company turnover and its investment in promoting its signs amongst the relevant public. Mr Korla states<sup>11</sup> that:

“The ‘GODAVARI’ mark has been available on the UK market from the end of April and early May 2019 as evidence [sic] by the orders placed by distributors in Edinburgh and Leeds ...”

86. This statement illustrates that any goodwill associated with Ark and its signs could not have existed at the relevant date. The absence of use before 28 March 2019 and the resultant absence of goodwill at the same date is fatal to its case based upon section 5(4)(a).

87. In summary, the grounds based upon section 5(4)(a) fail in their entirety.

### **Section 5(3)**

88. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

89. Section 5(3A) states:

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<sup>11</sup> At para 20 of his witness statement of 5 December 2019

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

90. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

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

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

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

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

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

## *Reputation*

91. The evidence referred to in paragraph 85, above, illustrates that Ark did not commence trading in the UK until after the relevant date. I recognise that reputation in the UK can be shown if the UK relevant consumer has been exposed to the use of the mark outside the UK. However, there is no such claim that this is so and, consequently, the ground based upon section 5(3) must fail because of the absence of the requisite reputation.

## **Summary**

92. Ekta's opposition to Ark's mark, based upon section 3(1)(b) and section 3(1)(c) has failed in its entirety. As a consequence, Ark is able to rely upon its mark as an earlier mark in its opposition to Ekta's mark, and Ark's opposition based upon section 5(2)(b) has succeeded in its entirety.

94. The grounds based upon section 5(3) and section 5(4)(a) of the Act fail in their entirety.

93. As a consequence, Ark's mark may proceed to registration and Ekta's application is refused in its entirety.

## **COSTS**

94. Ark has successfully defended the opposition against its mark and has been successful in respect of its opposition to the registration of Ekta's application. Therefore, it is entitled to a contribution towards its costs. I take into account that these are consolidated proceedings, that both sides filed evidence and written submissions and that whilst Ark did not attend the hearing it did file further written submissions in lieu of attendance.

95. Ark succeeded in its opposition only in respect of its grounds based upon section 5(2)(b). The filing fee for bringing an opposition based only on section 5(2) carries an official fee of £100. Therefore, despite Ark paying a £200 fee to file its opposition, it

is appropriate that only £100 is reflected in the costs. I award the following sum as a contribution towards the costs of the proceedings, in accordance with TPN 2/2016:

Official filing fee in respect of Ark's opposition	£100
Preparing statements in both cases and considering Ekta's statements	£700
Preparing and considering evidence	£1000
<b>TOTAL</b>	<b>£1800</b>

95. I, therefore, order Bokhary Foods Inc (DBA) Ekta Foods to pay Ark International (UK) Limited the sum of £1800. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 6th day of January 2021**

**Mark Bryant**  
**For the Registrar**  
**The Comptroller-General**