

**O/459/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3510504  
IN THE NAME OF KARAK(C) LIMITED  
IN RESPECT OF THE TRADE MARK**

**KARAK CHAAI**

**IN CLASSES 29, 30 & 43**

**AND**

**OPPOSITION THERETO UNDER NO. 421959**

**BY YASER SALEEM**

## Background and pleadings

1. Karak(C) Limited (“the applicant”) applied to register the trade mark no. 3510504 for the mark KARAK CHAAI in the UK on 10 July 2020. It was accepted and published in the Trade Marks Journal on 7 August 2020 in respect of the following goods and services:

*Class 29: Snacks; prepared meals; prepared meat dishes; prepared dishes consisting principally of meat; prepared meals consisting substantially of seafood; prepared meals consisting substantially of vegetables; cheese based snacks; cheeses; chilled dairy desserts; dairy based beverages; flavoured milk beverages; dairy products.*

*Class 30: Coffee; beverages based on coffee; beverages based on coffee; pies; wraps [sandwiches]; baked goods; batter mixes; pastry dough; frozen confectionery; frozen yoghurts; honeys; sweet glazes and fillings; syrups and treacles; pastries; savoury pastries; pastries containing cream; pastries containing fruits; buns; filled buns; breads; fresh bread; naan bread; prepared foodstuffs in the form of sauces; prepared foodstuffs in the form of rices; snack food products made from cereals; snack foods consisting principally of grains.*

*Class 43: Bar and restaurant services; café services; food preparation; food and drink preparation services; coffee bar services; snack bar services; take away food services; provision of food and drink; catering for the provision of food and drink; restaurant information services.*

2. Yaser Saleem (“the opponent”) opposes the trade mark on the basis of section 3(1)(b) and (c) of the Trade Marks Act 1994 (the Act). The opponent argues that ‘Karak Chai’ translates to ‘Strong Tea’ and it is a commonly known name for a type of hot beverage. On this basis the opponent argues the mark is devoid of distinctive character under section 3(1)(b). The opponent also argues that due to the translation of ‘Karak Chai’ as being a type of hot beverage “commonly known and served in India, Pakistan and UEA”, the mark is descriptive of the “goods served”. The opponent further argues that allowing this mark to proceed

would “open the flood gates” for other applicants to register descriptive and generic marks, which would in turn prevent others from making use of the descriptive terms, and that as such the mark should remain free for other traders to use.

3. The applicant filed a counterstatement denying the claims made. In its counterstatement, the applicant noted the difference in spelling between the mark KARAK CHAAI and ‘KARAK CHAI’ as defined by the opponent and highlighted that no distinctiveness objection was raised by the Office when the mark was examined. The applicant put the opponent to proof that ‘Karak Chai’ translates to strong tea, and that it is understood by the average consumer in the UK to mean a type of hot beverage served in India, Pakistan and the UAE. Further, the applicant states that even if it is accepted as meaning strong tea by the UK consumer, the application does not cover any tea product, and it will therefore be capable of distinguishing its goods and services from those of other traders. The applicant also denied the claims under section 3(1)(c) of the Act, and stated that no descriptiveness objection was raised by the Office. The applicant submitted that as no tea or tea related products are covered by the application, it follows that the mark is not descriptive.
4. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Neither party filed written submissions in these proceedings.
5. No hearing was requested and so this decision is taken following a careful perusal of the papers. The applicant is professionally represented in these proceedings by Eversheds Sutherland (International) LLP. The opponent represents itself.
6. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

## Evidence

7. The opponent's evidence comprises a witness statement in the name of the opponent, Yaser Saleem, and six exhibits, namely Exhibit YS1 to Exhibit YS6. In the witness statement, Mr Saleem is described as a business man. The witness statement includes some submission and opinion from Mr Saleem on matters that I am to decide, such as regarding the understanding of the average consumer. Where this is the case, these statements will not be taken as evidence of fact. The witness statement provided is dated 16 February 2021. None of the exhibits provided are dated, other than by way of the date provided in the footer of all pages of evidence which reads "Yasar Saleem 16<sup>th</sup> February 2021".
8. Exhibit YS1 includes an extract from the applicant's website, in which the word 'Chaai' is defined as a noun and a type of tea "made famous on the Indian sub-continent". The final sentence states "The Karak Chaai perfects the art of tea".
9. Exhibit YS2 is a document showing passages of text along with web addresses that define 'Karak Chai' as well as offer alternative spellings and names including 'Kadak Chai', 'Chai Karak' and others. Mr Saleem explains in his witness statement that the passages were extracted by him from the various websites stated.<sup>1</sup> The extracts translate and define 'Karak Chai' as meaning strong tea, and explain it is a type of tea enjoyed in countries and areas such as Qatar, UAE, Iran, India and Pakistan. One passage describes it as a "hot beverage", and another as "Qatar's famous tea". One passage states the tea is "hugely popular" in India and Pakistan, and another describes the "Chai Karak" as "an integral part of local culture, even popular among young people" in Qatar and the UAE. All of the extracts appear to be from '.com' domains.
10. Exhibit YS3 includes screenshots of four webpages selling tea. The first of these is sold under 'KADAK CHAI', which is listed as an alternative name for Karak Chai within Exhibit YS2. The second screenshot shows a box of instant tea for sale under 'Karak Chai' on 'shopatregal.com', available for purchase in GBP. The third shows a further box of tea under the sign 'Karak Chai' available

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<sup>1</sup> See paragraph 6

on the site royaltea.uk and stating the origin of the goods as the United Kingdom. The fourth screenshot shows a tub of instant tea available on amazon.co.uk in GBP also under the sign Karak Chai, with the flavour name on the site listed as “Karak”.

11. Exhibit YS4 is described by Mr Saleem in the witness statement as “a list of outlets serving Karak Chai just in my local area of Bradford and the applicant’s local area of Manchester...”, and Mr Saleem describes Karak Chai as a growing trend, with an increasing number of establishments serving the same.<sup>2</sup> It consists of a typed list of names and addresses, with 12 locations in Bradford and 14 locations in Manchester.
12. Exhibit YS5 is described by Mr Saleem as a screenshot from the applicant’s website. Mr Saleem explains in his witness statement that the image shown is of a man preparing Karak Chai using the long pouring method used to aerate the drink.
13. Exhibit YS6 is described by Mr Saleem as a copy of the applicant’s menu taken from its website, which lists ‘Karak Chaii’ as the first option under its hot drinks section, offering either original or sugar free. It is followed on the menu by drinks including ‘karak coffee’, ‘mint chaii’, ‘cinnamon chaii’, ‘english tea’, ‘green tea’ and others. Mr Saleem submits in the witness statement that the image shown next to this is “unmistakable” as Karak Chai as it served in the correct manner and surrounded by the ingredients of the drink.<sup>3</sup>

### **Preliminary issues**

14. Before I proceed with this decision, I note that the applicant states in its counterstatement that no objection under section 3(1)(b) or section 3(1)(c) was raised during the examination of its application carried out by the UK Intellectual Property Office, prior to the publication of its mark. I highlight at this stage that the fact that an objection was not raised by the examiner does not preclude a finding for the opponent under these grounds within the opposition proceedings,

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<sup>2</sup> See paragraph 8

<sup>3</sup> See paragraph 10

and I am not bound by the results of the examination. I will therefore consider this opposition objectively based on the information and evidence I have before me.

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

15. Before I begin my assessment under section 3(1)(b) and 3(1)(c) of the Act, I remind myself that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c), but still be objectionable under section 3(1)(b) of the Act: *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P at [25].

## **Legislation**

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

16. Section 3(1) states as follows:

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

- (a) signs which do not satisfy the requirements of section 1(1),
- (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) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

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.”

17. The position under 3(1)(b) and 3(1)(c) must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect: *Matratzen Concord AG v HuklaGermany SA*, Case C-421/04.

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

18. I will begin with the examination of the trade mark under section 3(1)(c) of the Act. The relevant date for determining whether the marks are objectionable under section 3(1)(c) is the filing date of the contested application, namely 10 July 2020.

### **General principles of section 3(1)(c)**

19. 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).

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].”

20. With consideration to the principles above, in assessing the mark under section 3(1)(c), I keep in mind that the objective of this section is to ensure that signs designating a characteristic of the goods or services remain free for use by traders of those goods or services.

21. The evidence filed by the opponent is minimal, and the statements and assertions made in the witness statement are often not particularly well supported by the documentation filed. I note the applicant has not challenged any of the evidence filed by the opponent, however this does not mean I must assign high probative value to statements made in the witness statement where I find they are poorly supported in the documentation filed.<sup>4</sup> However, I consider that what has been provided, including the copied and pasted extracts from websites, and I see no reason to believe these are not genuine, despite not being provided in the best format. With this in mind, I consider therefore what the evidence shows. I find from the sum of the evidence that Karak Chai translates roughly as ‘strong tea’, although it is not clear what language this translates from or how commonly spoken that language is in the UK, and so I am unable to make any further finding on the basis of the translation of the mark alone. I also gather from the sum of the evidence that ‘Karak Chai’ is a type of tea commonly served in India, Pakistan, Qatar, the UAE and the Middle East in particular, and that in these territories at least it

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<sup>4</sup> See the comments made by Mr Geoffrey Hobbs Q.C. in paragraphs 21 of *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13

appears to be popular. The evidence also shows that the tea was, to at least to a limited extent, on sale in the UK, seemingly around the date of 16 February 2021 when the witness statement was prepared. At the time the opponent's evidence was gathered, it seems it was shown on three different websites that appear, either due to the .co.uk domain, or due to the price being shown in GBP, to be targeted at the UK consumer.

22. I note the opponent has provided what is described by Mr Saleem as a list of outlets serving the tea in both Bradford and Manchester. However, I do not find a list of names and addresses alone to be of much evidential weight value. Whilst I do not disbelieve Mr Saleem in his statement that these are names and addresses of outlets serving the tea, I find I would require additional evidence of how this was being sold to rely on this. I gather from Exhibit YS2, that there are a number of alternative names for the tea, and so I am not inclined to rely on what has been provided in this instance as evidence that there are 26 outlets in the UK serving tea under the sign Karak Chai.

23. In consideration of my findings above, I accept that Karak Chai is used to describe a type of tea, that is to at least a limited extent available for purchase online by the UK consumer. Where it is understood as such, I do not find the misspelling of the mark will prevent it from immediately being perceived as referring to 'Karak Chai', and so I do not find this to be particularly relevant to my assessment in this instance.<sup>5</sup> However, I consider that in order to reject the application under section 3(1)(c) of the Act, it is not enough for the mark to simply have a meaning, and this is simply the first step in my assessment. In order to be objectionable on this ground, this meaning must be known by the average consumer of the goods, at the relevant date, and it must be understood by the average consumer at that date to be descriptive of a characteristic of the goods and services as filed.

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<sup>5</sup> See *EC Brand Comércio, Importação e Exportação de Vestuário em Geral Ltda v EUIPO*, Case T-532/19, EU:T:2020:103

24. When identifying the average consumer of the goods, this consideration must be made in the context of the territory in which the registration is sought,<sup>6</sup> as well as in respect of the goods and services filed. In this instance the goods and services applied for under the application include broad and/or general categories of goods and services, and they are clearly aimed at the UK general public at large, rather than a particular sub-set of consumers only. However, I note that the UK general public will include within it groups which either are part of, or who will have a greater understanding of the culture in India, Pakistan, the UAE, Qatar and the Middle East, within which this tea appears, from the limited evidence provided, to be particularly prevalent. This will also include consumers with a heightened interest in tea. In this respect, I refer to the comments of Daniel Alexander QC sitting as the appointed person in the appeal of the refusal of the application for BEST MANGAL by Elite Ocakbasi Restaurants Ltd<sup>7</sup> as below:

*“The applicant suggests that it is the public in this country that should be considered and not the public in a country far removed from the UK. That is correct in principle but does not assist the argument. The Registrar was entitled to take account of the fact that there is a significant Turkish and Middle Eastern community in the UK to whom the term is likely to be wholly descriptive and of the fact that members of this community and others are likely to want to use the term to describe cuisine of this kind in future, regardless of where they may come from.”*

25. I consider therefore, that I may take into account the group of consumers I have identified above, and their understanding of the mark. However, it is also true that I must also consider the understanding of these consumers at the relevant date. I note particularly that I have been provided with no evidence dated prior to, or on the relevant date of 10 July 2020, nor do I have any

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<sup>6</sup> In *Matratzen* in the context of the assessment of distinctiveness for the purposes of registration, the CJEU held that the distinctive character of a trade mark must be assessed from the perspective of the relevant public in the territory in which registration is sought.

<sup>7</sup> BL O-224-16

evidence making reference to the presence of Karak Chai as a type of tea (in the UK or otherwise) prior to the relevant date. I also note the following comments made by Mr Saleem within his witness statement:

“The UK Trade Mark Application 3510504 consists of a word mark “KARAK CHAAI” which is descriptive of a type of hot tea beverage consisting of strong black tea, cardamom and evaporated milk. It is traditionally served in India, Pakistan, Middle East and is now widely available in the United Kingdom.”<sup>8</sup>

“...Karak Chai is a growing trend and a rapidly increasing number of establishments are starting to serve Karak Chai.”<sup>9</sup>

“As Karak Chai is a fast growing product in the United Kingdom and by allowing the applicant’s Trade Mark registration of a simple word mark ‘KARAK CHAAI’ with no distinctive characteristics to proceed for full registration in classes 29, 30 and 43 it would create an unfair monopoly in the market.”<sup>10</sup>

26. Whilst I note that Mr Saleem makes reference to the tea being “traditional” in his witness statement, this does not assist me in identifying when the tea became popular or known in the UK or overseas. In addition, Mr Saleem’s comments that the availability of the tea in the UK was growing rapidly in February 2021 when the witness statement was signed, do not in any way indicate whether the tea was popular, available, or known to any group of consumers in the UK (or elsewhere) at the relevant date. Whilst it is therefore possible that a group of consumers in the UK would have known the meaning of ‘Karak Chai’ (and as such would understand KARAK CHAAI as a reference to this) in the UK on 10 July 2020, this has clearly not been established by the evidence filed in this case.

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<sup>8</sup> See paragraph 3

<sup>9</sup> See paragraph 8

<sup>10</sup> See paragraph 13

27. As I am unable to establish whether any meaning would be attributed to the mark KARAK CHAAI at the relevant date, I have no basis on which to consider if the meaning of the mark would be viewed as descriptive of a characteristic of the goods as filed. Further, I have no basis on which to find that the mark must remain free for use for other traders.
28. For completeness, I note that the mark does not need to actually be in use in a descriptive manner at the time of the application in order for it to be objectionable under section 3(1)(c), and that the possibility that the mark *may* be used descriptively in future should also be considered. I refer back to the comments made by Daniel Alexander QC regarding *BEST MANGAL* above, in which it was stated that consumers may wish to use the term MANGAL in future to describe Mangal cuisine. I note there are some parallels with that case and the matter in hand. However, a key difference in that case was that it was accepted by the applicant that the term Mangal would be known by the Turkish consumer in the UK, and that as such it would be “extremely descriptive if you apply it to food”.<sup>11</sup> That case does not therefore share the same lack of agreement and lack of evidence that the mark was descriptive at the relevant date. It is established in the case law that where a mark would be understood as descriptive at the relevant date by the average consumer, it is not important whether it is in use in a descriptive manner at the time, instead what is important is that it may be used descriptively. However, where I have been unable to establish from the evidence that a meaning would have been attributed to the mark at the relevant date, I am unable to apply the same logic that the mark may be used descriptively in future. If the mark is found to be descriptive at the relevant date, with consideration to the objective under section 3(1)(c), it will need to remain free for use by traders both for now and in future. Where the mark has not been evidenced to have any meaning at the relevant date, it cannot be said that it must remain free for future use by traders in future. A situation where the mark had no meaning at the relevant date but has since become descriptive is not a matter for consideration under this ground.

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<sup>11</sup> See paragraph 16 of BL O-224-16

29. On the basis of the evidence filed I cannot find that the mark is descriptive under Section 3(1)(c).

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

30. I will now consider the opposition in relation to section 3(1)(b) of the Act.

### **General principles of section 3(1)(b)**

31. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).



32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

32. The objective of section 3(1)(b) is to prevent marks that are incapable of serving to identify that goods derive from a single origin from being registered as trade marks. In respect of the opposition filed under section 3(1)(b), the opponent has submitted as follows:

"Karak Chai translates to Strong Tea and is the commonly known name for a type of hot tea beverage. The proposed application does not have any distinctive characteristics to base the trademark application on".

33. I have already established that I have no evidence on which I am able to base a finding that the mark KARAK CHAAI would be understood as translating as

'strong tea' by consumers in the UK, or that it would be understood to be a type of beverage at the relevant date. In addition, the opponent has not provided me with any separate basis to consider that the mark lacks distinctive character. 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).

### **Final remarks**

34. The opposition has failed. Subject to appeal, the application will proceed to registration in respect of all of the goods and services filed.

### **COSTS**

35. The applicant has been successful in this opposition and is entitled to an award of costs. Whilst the applicant has not filed its own evidence, it will have incurred costs for considering the evidence filed by the opponent. In the circumstances I award the applicant the sum of £450 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the TM7 filed and preparing the	
TM8 and counterstatement:	£250
Considering the opponent's evidence:	£200
<b>Total</b>	<b>£450</b>

36. I therefore order Yaser Saleem to pay Karak(C) Limited the sum of £450. The above sum should be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 17<sup>th</sup> day of June 2021**

**Rosie Le Breton**

**For the Registrar**