

O-277-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2055236
BY AJLAN BIN ABDULAZIZ AL-AJLAN & BROTHERS CO.
TO REGISTER A TRADE MARK
IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No. 45743 BY LAPPET MANUFACTURING CO LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2055236
By Ajlan Bin Abdulaziz Al-Ajlan & Brothers Co.
to register a trade mark in Class 25**

and

**IN THE MATTER OF Opposition thereto under
No. 45743 by Lappet Manufacturing Co Ltd**

BACKGROUND

1. On 1 February 1996, Ajlan bin Abdulaziz Al-Ajlan & Brothers Co. of Riyadh, Saudi Arabia, applied for the registration of a trade mark in Class 25. A representation of the trade mark applied for is shown below:



2. The application was examined, accepted and subsequently published for the following specification of goods: “Clothing for men and children; headgear; footwear”. I note that the publication included the following clause:

“The Arabic characters appearing in the mark mean “Ajlan and Brothers” and “Ajlan bin Abdulaziz Al-Ajlan & Brothers Co.”

3. On 22 October 1996, Lappet Manufacturing Co Limited filed notice of opposition to the application. The grounds of opposition were in summary:

- (i) that the trade mark applied for is not registrable because it does not consist of a sign which satisfies the requirements of Section 1(1) of the Act;

- (ii) that the trade mark applied for is devoid of any distinctive character and therefore fails to meet the requirements of Section 3(1)(b) of the Act, and/or consists of words consisting exclusively of indications of origin and therefore fails to meet the requirements of Section 3(1)(c) and/or consists of words which have become customary in the current practices of the trade and is therefore unregistrable under the provisions of Section 3(1)(d) of the Act;
- (iii) that the trade mark should be refused under the provisions of Section 3 of the Act because it would prevent others with the same name, which is common in Saudi Arabia and the Middle East, manufacturing and selling products in the United Kingdom in these classes under their name;
- (iv) that the trade mark applied for has been filed in bad faith and ought to be refused under the provisions of Section 3(6) of the Act;
- (v) that the trade mark applied for should be refused under the provisions of Section 5 of the Act. In particular the application should be refused under the provisions of Section 5(4) because third parties have used trademarks in the United Kingdom for many years which incorporate the words "Ajlan" and "Al-Ajlan" in relation to goods which are covered by the present application and have therefore acquired a significant reputation in those trademarks, protectable by the law of passing off;
- (vi) that the applicants are not the true proprietors of the trade mark and therefore registration should be refused under the provisions of Section 32 of the Act;
- (vii) that the trade mark should be refused under the provisions of Section 5 of the Act because it conflicts with prior registration No. 1243842 (full details of which are provided later in this decision).

4. The opponents further request that the Registrar refuse the application in the exercise of her discretion. However, under the Trade Marks Act 1994 the Registrar does not have a discretion to refuse an application as she did under the old law. An application can only be refused if it fails to comply with the requirements of the Act and Rules in one or more respects.

5. The applicants filed a counterstatement in which the grounds of opposition were either not admitted or denied.

6. Both parties filed evidence in these proceedings and both sides ask for an award of costs. The matter came to be heard on 9 December 2002. At the Hearing, the applicants were represented by Mr Simon Malynicz of Counsel instructed by J.A. Kemp & Co; the opponents were represented by Ms Mary Vitoria of Her Majesty's Counsel instructed by Eric Potter Clarkson.

Opponents' Evidence

7. This consists of two statutory declarations. The first dated 6 May 1997 is by Robert John Quick who is the Managing Director of Lappet Manufacturing Company Limited. Mr Quick confirms that he is authorised to make his declaration on his company's behalf adding that the facts given in his declaration are from his personal knowledge of the opponents' business and from the opponents' company records.

8. Mr Quick states that the opponents are a wholly owned subsidiary of United Manufacturing & Trading Company Limited, which in turn is partly owned by the proprietors of Abdul Aziz and Abdulla Al-Ajlan Co; he notes that Abdul Aziz and Abdulla Al-Ajlan Co own United Kingdom trade mark registration No. 1243842 a copy of which is provided as exhibit RJQ1.

9. Mr Quick explains that he is advised by his trade mark attorneys Eric Potter Clarkson, that the applicants have applied to register trade mark No. 2015208 in Classes 24 and 25; this trade mark application incorporates the Arabic words which have been transliterated to read "Ajlan Abdulaziz Al Ajlan & Co manufactured goods from England, Deluxe".

10. Mr Quick states that his company and their predecessors in title have manufactured head shawls and textile piece goods for the manufacture of head shawls for at least 60 years. These head shawls are, he says, sold primarily to the Middle East and the major customer of these head shawls has been Mohammed S Al Ajlan Sons Co. of which Abdul Aziz and Abdulla Al-Ajlan Co. is a trading division. He adds that since at least 1965 his company and its predecessors in title have sold head shawls and textile piece goods for making head shawls to this company. Exhibit RJQ3 comprises a copy of packaging used since 1991 for these head shawls which shows an ALAJLAN stylised trade mark. The trade marks Mohammed S Al-Ajlan Sons Co. and Arabic script above it, is, he is advised, a transliteration of the term Mohammed S Al-Ajlan Sons Co. which also appears on the packaging.

11. Exhibit RJQ4 contains details of sales over the past 5 years both in value and volume terms of products being head shawls, yashmaks and textile piece goods for making head shawls sold in and from the United Kingdom under the trade marks shown on the packaging exhibited at RJQ3. In relation to this exhibit a direction was sought by the opponents under the provisions of rule 45 that the contents be kept confidential to the Registrar and to the applicants' legal advisers J.A. Kemp & Co; a request to which the Registrar acceded and a direction to this effect was issued on 1 December 1997.

12. The second (undated) statutory declaration is by Sayed Hassan Amin. Mr Amin states that he is a member of the Faculty of Advocates a position he has held for four years. He explains that he has a degree in Law and a Doctorate in Public International Law and is fluent in Arabic and English. His statement comes from his own personal knowledge.

13. Exhibit SHA1 consists of copies of United Kingdom trademark applications 2015208 and 2055236. Exhibit SHA2 consists of copies of packaging for head shawls which Mr Amin is advised by Eric Potter Clarkson are manufactured and sold in the United Kingdom by a company associated with Lappet Manufacturing Company Limited. Mr Amin confirms that the Arabic

wording on the packaging in exhibit SHA2 is a transliteration of the words Mohammed Al-Sa'd Al-Ajlan Sons Co, adding that there is a slight difference between the Arabic and English versions in that the English version of the name Al-Sa'd has been abbreviated to S.

Applicants' Evidence

14. This consists of an affidavit by Ajlan Abdul-Aziz Ajlan Al-Ajlan (hereafter Mr Ajlan Al-Ajlan) dated 25 April 1998. Mr Al-Ajlan explains that he is the General Manager of Ajlan bin Abdulaziz Al-Ajlan & Brothers Co who are a Saudi Collective Partnership carrying on business as a manufacturer and merchant; he was appointed to his present position four years ago. He states that the information in his affidavit comes either from his personal knowledge or from the files and records of his company; he confirms that he is fully conversant with the English language.

15. Mr Ajlan Al-Ajlan states that the applicants are an established and respected Saudi Arabian clothing merchant who have manufactured head shawls or yashmaks for many decades and sells many hundreds of thousands of dozens of head shawls worth millions of pounds of turnover each year. He explains that the applicants owns 50% of a company in England called Sutton Vale Limited which manufactures its head shawls, yashmaks and associated textile piece goods for export to Saudi Arabia.

16. Exhibit MAL-A1 consists of a representation of the application in suite (which Mr Ajlan Al-Ajlan explains is an original mark of the applicants), together with a translation and transliteration of the Arabic words appearing in the Mark. The trade mark is, says Mr Ajlan Al-Ajlan, a composite mark, a distinctive "globe and hands" device with the applicants' full business name and the shortened version "Ajlan & Bros" below.

17. Mr Ajlan Al-Ajlan states that the trade mark they are seeking to register is an established mark of the applicants and is known as such throughout the Middle East. He states that the mark has been used for a number of years and it has been registered by the applicants since 1991 (the country of registration is not specified). He adds that the trade mark has been used in the United Kingdom since 1995 in relation to yashmaks for export. He explains that yashmaks bearing or packaged under the trade mark in question are manufactured in England and exported to Saudi Arabia from where they are distributed to other Middle Eastern Countries. The number of yashmaks to which the trade mark has been applied in the United Kingdom is in the order of hundreds of thousands and the value of these goods runs into millions of pounds each year. Exhibit MAL-A2 consists of details of the applicants' turnover and sales in Middle Eastern countries of goods manufactured in the United Kingdom and sold under or by reference to the trade mark. As in the opponents' exhibit RJQ4 above, a direction was sought by the applicants under the provisions of rule 45 that the contents of exhibit MAL-A2 be kept confidential to the Registrar and to the opponents' legal advisers Eric Potter Clarkson; a request to which the Registrar also acceded and a direction to this effect was issued on 27 July 1998.

18. The trade mark has, says Mr Ajlan Al-Ajlan, been substantially promoted and advertised in Saudi Arabia. Exhibit MAL-A3 consists of copies of typical promotional material bearing the trade mark. He explains that no advertising has been carried out in the UK market, "as goods

bearing the mark are not intended for sale in the United Kingdom". However, the goods have, he says, been advertised on MBC TV and MBC Radio, both of which are said to broadcast from London to the Middle East.

19. In Mr Ajlan Al-Ajlan's view the opponents have no mark similar to the applicants' trade mark. He states that the opponents say that they manufacture yashmaks for Mohammed S Al-Ajlan Sons Co who are a traditional competitor of the applicants and, like the applicants, are owned by members of the Al-Ajlan family. The opponents' yashmaks are, he says, put into packaging that contains the opponents' business name and a stylised mark that contains the name ALAJLAN. He comments again that this mark is not similar to the applicants' mark, of which the name AL-AJLAN forms only a part. He believes that this same comment applies to registered United Kingdom trade mark No. 1243842, as this mark only contains the letters A, J, L and N, not the name ALAJLAN.

20. Mr Ajlan Al-Ajlan comments again that the opponents have not provided any registered or unregistered marks that are similar to the applicants' mark. He states that the opposition is only founded on the fact that the opponents manufacture yashmaks for Mohammed S. Al-Ajlan Sons Co which are put into packaging bearing a trade mark that incorporates the name ALAJLAN, and that ALAJLAN forms part of the applicants' mark. He believes that this is not a sound and sufficient ground for opposition and also that there is no scope for confusion. Mr Al-Ajlan states that the applicants' trade mark is used on yashmaks manufactured in England by Sutton Vale Limited for export to Saudi Arabia. He also claims that the applicants' have several trade mark registrations in Saudi Arabia and other Middle Eastern countries including UAE and Yemen that bear its business name AJLAN BIN ABDUL-AZIZ AL-AJLAN & BROTHERS CO in Arabic and Latin characters and/or the trading style AJLAN & BROTHERS, again in Arabic and Latin characters. He adds that the applicants' business name is entered in the Commercial Register of Companies in Saudi Arabia.

Opponents' Evidence in Reply

21. This consists of a statutory declaration dated 14 March 1999 by Abdul Aziz Al Ajlan (hereafter Mr Abdul Al Ajlan) who is the Managing Director of Mohammed S Al-Ajlan Sons Company; he confirms that he is authorised to speak on his company's behalf adding that he is conversant with the English language. He explains that for the past 30 years his company has been involved in the importation and sale in Saudi Arabia of head shawls (also known as yashmaks or shemaghs) and believes that his company purchases head shawls from Lappet Manufacturing Company Limited who are the opponents in these proceedings.

22. Commenting on the evidence filed by the applicants in these proceedings, he notes that in paragraph 3 of the statutory declaration of Ajlan Abdul Aziz Ajlan Al-Ajlan he states that his company owns 50% of an English company called Sutton Vale Limited who manufacture his company's head shawls. Mr Abdul Al Ajlan points out that the date Ajlan Abdul Aziz Ajlan Al-Ajlan signed his statutory declaration is 25 April 1998. In October 1998, Mr Abdul Al Ajlan's trademark attorneys obtained a Dunn & Bradstreet report on Sutton Vale Limited. Exhibit AL1 comprises a copy of this report together with a copy of the complete company records of Sutton Vale Limited obtained in October 1998 from Companies House.

23. In Mr Abdul Al Ajlan's view it is apparent from the report that Sutton Vale Limited was put into receivership on 16 February 1998 and that on 3 February 1998 Ajlan Abdul Aziz Al-Ajlan resigned as Director of the above company. Mr Abdul Ajlan explains that it is clear from the receiver's report that Ajlan Abdul Aziz Ajlan Al-Ajlan had on 3 February 1998 decided to source from elsewhere the yashmaks that were being produced by Sutton Vale Limited and consequently yashmak production ceased on this date. He says that it is also clear from this report that the yashmaks that had previously been shipped from Sutton Vale Limited to Ajlan Abdul Aziz Ajlan Al-Ajlan had been rejected by him and were in Saudi Arabia pending disposal.

24. Mr Ajlan says that in his opinion the statements made on oath in Mr Ajlan Al-Ajlan's affidavit are contradictory. He explains that for some months prior to the date of signing his affidavit Abdulaziz Al-Ajlan & Brothers Co did not own 50% of Sutton Vale Limited and that furthermore Sutton Vale Limited had not, for a number of months prior to the execution of the affidavit manufactured head shawls for export to Saudi Arabia for sale by Ajlan Abdul Aziz Ajlan Al-Ajlan.

25. Insofar as exhibit MAL-A3 to Mr Ajlan Al-Ajlan's affidavit is concerned, Mr Abdul Al Ajlan states that his company monitors the head shawl market place in Saudi Arabia very closely and has no recollection of ever having seen any of the promotional material mentioned being used by the applicants in the Saudi Arabian market. Mr Abdul Al Ajlan adds that insofar as Saudi Arabia is concerned, his company consistently objects to other companies registering or using trademarks which incorporate the word Ajlan in relation to the manufacture and/or sale of head shawls. He adds that insofar as Saudi Arabia is concerned, his company has opposed third party trade mark applications for head shawls which incorporate the words Al Ajlan in Arabic or Latin characters. In this regard, he states that in Saudi Arabia his company has successfully opposed applications by the present applicants for head shawls for trade marks which incorporate the words Al Ajlan.

Opponents' Additional Evidence

26. This comprises a further statutory declaration dated 5 January 2000 and a witness statement dated 27 September 2001 by the same Robert John Quick mentioned above. The purpose of this additional evidence is to correct errors in his earlier declaration. Firstly, he explains that he wishes to correct an error he made in paragraph 4 of his first statutory declaration and exhibits. He states that whilst preparing a statutory declaration in connection with opposition No. 48096, he rechecked his company's internal records regarding the first date on which his company made use of the trade marks incorporating the words Al Ajlan in the United Kingdom in relation to the manufacture and sale of head shawls; it appears that it was in fact in 1994 and not 1991 that it had been first used on packaging for head shawls.

27. Secondly insofar as paragraph 3 of his declaration was concerned, he incorrectly identified trademark No. 2055236, which was correctly shown in exhibit RJQ2 to that statutory declaration, as trademark No. 2015208. He wishes to correct that error and confirms the trademark to which he was referring in paragraph 3 of his declaration as 2055236. Finally he wishes to further clarify evidence contained in his previous statutory declaration and exhibits. He explains that in

his original declaration he incorrectly included sales figures for products sold under the trade mark appearing on head shawls manufactured by the opponents from 1991 to 1994. He had, he explains, obtained these figures from counting the number of bags used to enclose the head shawls purchased each year having assumed that those bags always bore the trade marks. Subsequent checks revealed that 1991 was the first year that his company purchased plastic bags in which to supply head shawls sold under the trade mark. However it was not until 1994 when a new supplier was appointed that the design of the plastic bags were changed to incorporate the trade marks on which this opposition is based. Mr Quick confirms that he has rechecked the sales figures given in his evidence for the years 1994 and 1995 and confirms that they are accurate.

Decision

28. In her skeleton argument submitted prior to the hearing, Ms Vitoria narrowed down the grounds of opposition to those based upon Sections 3(1)(b), 3(6) and 5(2)(b). I deal with each of these in turn below. The remainder, are dismissed.

29. Section 3(1)(b) of the Act states:

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

(a)

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

30. The opponents’ submissions on this ground were centred upon the fact that they manufactured goods to be sold under the trade mark for another branch of the Al Ajlan family who sold those goods also under an Ajlan trade mark. I was asked in that regard to have regard to the judgment of Jacob J in *Nichols PLC’s* trade mark application [2002] EWHC 1424 and in particular paragraph 10 where he said:

“It is important in my view in all trade mark matters to take a realistic approach to the way the registered trade mark system actually operates and is likely to operate rather than to look at the purely theoretical position.”

31. In this case there was a small and very specialist market (for yashmaks) and there were a few people misled in their supply. This case involved two of them, branches of the same family trading under the same name. In such circumstances the trade mark in suit could not distinguish goods of the applicant from those supplied by the opponent to the other branch of the family and therefore the trade mark lacked distinctive character.

32. For his part Mr Malynicz, for the applicants, submitted that though the trade mark contained a surname it was a distinctive one, as he rightly pointed out there was no evidence that it was common either here in the United Kingdom or in the Arab world. He also drew my attention to *Al Bassam* [1995] RPC 511, *Tonalite Henne* trade mark [20001] RPC 36 and *El Canal De Las*

Estrellas trade mark [2000] RPC 291 all of which deal either with ‘foreign’ surnames or the use of words in a language other than English appearing in trade marks.

33. Having regard to all of the submissions made to me and the earlier jurisprudence, I am unable to hold that the trade mark in suit is objectionable under the provisions of Section 3(1)(b).

34. This trade mark in suit consists of what to the average consumer in the United Kingdom would appear to be a globe held by a pair of hands above Arabic script together with the word ‘Ajlan’ used with the term ‘& Bros.’ which would imply in my view that the word Ajlan was in fact a surname. There is also some further Arabic script.

35. No evidence has been submitted as to the frequency of occasions of the word Ajlan in any telephone directory. Nor has any evidence been submitted as to how an Arabic speaker might view the trade mark. I have no doubt that the trade mark examiner looked at the relevant telephone directories and as far as I am aware did not raise any objections as a result of that research. I assume therefore the word Ajlan does not have surnominal connotations in the United Kingdom.

36. The Arabia script used in the trade mark would, to the average consumer in the United Kingdom add to the trade marks distinctive character. This is because it would appear to add device elements to the word Ajlan and I do not ignore the globe and hands device itself which appears above all the other matter in the trade mark which is itself distinctive in relation to the goods covered by the application. Thus the trade mark in suit does not lack a distinctive character.

37. Insofar as the submissions made by Ms Vitoria directed to the point that her clients may have had first use in the United Kingdom of the word Ajlan those were, in my view, directed to a relative ground of opposition under Section 5(4)(a) which was withdrawn. The fact is that Section 3 deals with objections to registrations based upon an inherent flaw in the trade mark sought to be registered. No such flaw has been identified under Section 3(1)(b) and the opposition based upon that ground is dismissed.

38. I turn to Section 3(6) which states:

“3-(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

39. As noted above, this ground of opposition was accompanied by the bald statement that ‘the trade mark which is the subject of the present application has been filed in bad faith and therefore the application should be refused under the provisions of 3(6) of the Trade Marks Act 1994.’”

40. In the evidence rounds information was provided by each side as to their alleged use of their respective trade marks but no evidence which I can see which, went to the fact that the applicant was, at the date of applying for the registration of the trade mark in suit, acting in bad faith.

However in her skeleton argument submitted just prior to the hearing Ms Vitoria set out the ground as one based upon the following allegations:

- (1) the applicant had no intention to use the trade mark on all of the goods claimed in the specification (their only trade has been in yashmaks);
- (2) there was never any intention on the part of the applicant to use the trade mark in the United Kingdom (the goods to which the trade mark is applied are exported from the United Kingdom).

41. Mr Malynicz objected to what he considered to be new grounds of opposition. There had been nothing in the statement of grounds about his clients' intention to use nor anything alleging that use of the trade mark on goods exported from the United Kingdom was not use for the purposes of the Act.

42. I was quoted various authorities on the subject of bad faith *Gromax Plasticulture v Don & Low Nonwovens Ltd* [1999] RPC 367, *Demon Ale* trade mark [2000] RPC 349 and *Royal Enfield* [2002] RPC 24. In essence, though bad faith can occur when someone acts in a way which they themselves do not regard as reprehensible, there must be a clear allegation that someone has behaved in a manner which falls below commercial standards. That clearly did not happen in this case. The allegations were opaque at the start of the proceedings and there was nothing in the evidence rounds which brought them into focus. They were therefore sprung on the applicants in Ms Vitoria's skeleton argument – there was no request to amend pleadings accordingly.

43. On the first allegation, Mr Malynicz argued that the evidence submitted by the applicants on their use of the trade mark was not germane to the new allegation. They had, so far, only traded in yashmaghs under the trade mark but the Act gave them five years within which to put the trade mark to use on other goods. It was not sufficient for an opponent simply to allege no intention to use, there must be some substance to the claim.

44. In response to Ms Vitoria's claim that claims made in the applicants evidence (in 1998) were, to say the least, inaccurate (because there were no sales of goods by the applicants despite their claims to such), Mr Malynicz, submitted that bad faith must be established at the date of the application and not by reference to events subsequently.

45. On the question of intention to use the trade mark on the goods set out in the specification, I do not regard the applicants' evidence as tantamount to an admission that they intend only to use the trade mark on yashmaghs. This evidence of use was not put in in response to the specific allegation now made and can not therefore be used to support a finding that there is no intention to use on any of the remaining items. As far as the veracity of the opponents evidence is concerned, the allegation that Mr Abdul Al Ajlan may have misled those reading his affidavit of 25 April 1998 was not denied by the applicants. However, that in my view, is not sufficient upon which to base a finding that the application made some 15 months earlier itself was made in bad faith.

46. The final allegation was that the trade mark in question was never going to be used in the United Kingdom and therefore registration would be contrary to Section 3(6).

47. Ms Vitoria citing *Glenforrest Glenlivet Distillery Co's* application (Whiteleys) [1934] 51 RPC 325 *Marcos Bale y Hnos' Application (SOLIBRISA)* [1948] 65 RPC 17 and *Geoffrey Inc v Felia Tena Comadran (IMAGINARIUM)* [BL O/479/02] argued that in this case the goods in question were not being exported under the trade mark but merely outsourced in the United Kingdom. The transactions between the applicant and Sutton Vale Ltd was intra company trade, between a parent and subsidiary, and therefore there was no export trade between them. Mr Malynicz simply argued that Ms Vitoria was wrong in her submissions and that the evidence that was submitted by the applicants was simply evidence of use of the trade mark in suit. The applicant had been given no opportunity to file evidence in their defence against this new allegation.

48. For my part I believe the Registrar's position on use was set out clearly by her Hearing Officer in the *Imaginarium* trade mark case. In this case the applicant has a stated intention to use the trade mark on goods the subject of the specification contained in the application and which are to be exported from the United Kingdom. The precise relationship between the applicants and their suppliers has not been the subject, until now of allegations that their relationship is such as to negate the protection afforded to use for exports within the Act (see Section 46). Thus they have had no opportunity to file evidence or make informal submissions in the matter. I thus decline to find for the opponents because:

- (i) their allegation was made late;
- (ii) the registrar has ruled in the matter of export use;
- (iii) I have no evidence that the applicants can not fall within the protection of the Act which provides for export use.

49. The grounds of opposition based upon Section 3(6) are dismissed.

50. I turn finally to the ground of opposition based upon Section 5(2)(b) which states:

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

- (a)
- (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,”

51. An earlier trade mark is defined insofar as this case is concerned in Section 6(1)(a) which states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

52. Ms Vitoria’s skeleton stated:

14. It is well established that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, [1998] RPC 199, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co GmbH v. Klijsseti Handel BV* [2000] FSR 77, paragraph 26 et seq;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details-, *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Meyer Inc*, [1999] RPC 117, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section- *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

53. Mr Malynicz agreed that these were the facts I need to take into account in deciding matters under this head.

54. The respective trade marks and their specifications of goods are set out below:

2055236 **Class 25:** Clothing for men and children; headgear, footwear.



1243842 **Class 25:** Head coverings, being articles of clothing.



55. The opponents' trade mark is an earlier trade mark. The goods of the respective trade marks are identical and similar – neither side dissented from that. Therefore I only need to consider the trade marks themselves.

56. Applying all of the above factors, in particular, allowing for the identity of the goods, imperfect recollection, and the fact that some of the goods, yashmaks, constitute a small but specialised market, I reach the view that the trade marks are not similar. Whilst each does contain some Arabic script and the letters AJL there is scant visual or oral similarity and the fact that the opponents' trade mark is contained within a circle and the applicants contains a globe reduces considerably the likelihood that anyone would even associate one with the other. The trade marks differ significantly one from the other such that the provisions of Section 5(2)(b) can not apply. The ground of opposition based on that Section of the Act is dismissed.

Costs

57. The applicants have been successful and are therefore entitled to an award of costs. I order the opponents to pay to the applicants the sum of £1700. This sum is to be paid within seven

days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

58. This decision is issued in parallel with another dealing with a further three disputes between the parties. In delaying the issue of the decision I have had in mind the opportunity for all the issues between the parties to go forward on appeal together, if that is their wish. Thus time and effort will be saved by all concerned.

Dated this 11th day of September 2003

**M KNIGHT
for the Registrar
the Comptroller-General**