O-278-03

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 2139070
BY MOHAMMED S AL AJLAN SONS COMPANY
TO REGISTER A TRADE MARK IN CLASSES 24 & 25

AND

IN THE MATTER OF OPPOSITION THERETO UNDER No. 48096
BY AJLAN BIN ABDULAZIZ AL-AJLAN & BROTHERS CO.

AND

IN THE MATTER OF APPLICATION No. 2139074
BY MOHAMMED S AL AJLAN SONS COMPANY
TO REGISTER A TRADE MARK IN CLASSES 24 & 25

AND

IN THE MATTER OF OPPOSITION THERETO UNDER No. 49676
BY AJLAN BIN ABDULAZIZ AL-AJLAN & BROTHERS CO.

AND

IN THE MATTER OF APPLICATION No. 2139078
BY MOHAMMED S AL AJLAN SONS COMPANY
TO REGISTER A TRADE MARK IN CLASSES 24 & 25

AND

IN THE MATTER OF OPPOSITION THERETO UNDER No. 49679
BY AJLAN BIN ABDULAZIZ AL-AJLAN & BROTHERS CO.

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 2139070
by Mohammed S Al Ajlan Sons Company
to register a Trade Mark in Classes 24 & 25

and

IN THE MATTER OF Opposition thereto under No. 48096
by Ajlan Bin Abdulaziz Al-Ajlan & Brothers Co.

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by Mohammed S Al Ajlan Sons Company
to register a Trade Mark in Classes 24 & 25

and

IN THE MATTER OF Opposition thereto under No. 49679
by Ajlan Bin Abdulaziz Al-Ajlan & Brothers Co.

Background

1. On 15 July 1997, Mohammed S Al Ajlan Sons Company of Riyadh, Saudi Arabia, applied for registration of three trade marks in Classes 24 and 25. A representation of each of the trade marks applied for is shown below:

No. 2139070

العجلان

The application included the following clause:

> AThe transliteration of the Arabic characters which comprise the mark is >Al-Ajlan= which means >The Swift One=.@

No. 2139074

شركة أبناء محمد السعد العجلان

I note that the application included the following clause:

> AThe transliteration of the Arabic characters appearing in the mark is ASharikat Abna Mohammed Al-Saad Al-Ajlan@ which mean AMohammed Al-Saad Al-Ajlan Sons Company@.@

No. 2139078 (an application for a series of two trade marks):

AL-AJLAN

Al-Ajlan

2. The applications were examined, accepted and subsequently published for the following specifications of goods:

2139070

Class 24: Textiles and textile goods not included in other classes; textiles piece goods for making headshawls; bed and table covers.

Class 25: Clothing and footwear and headgear.

2139074 and 2139078

Class 24: Textile piece goods, all for making up into headshawls and yashmagls; all for export to the Middle East.

Class 25: Headshawls and yashmagls; all for export to the Middle East.

3. On 20 April 1999, Ajlan Bin Abdulaziz Al-Ajlan & Brothers Co. filed notices of opposition to all the applications. The grounds of opposition in each case were, in summary:

i) that the trade mark is contrary to the provisions of Section 3(3)(b) of the Act so as to deceive the public who would associate the applicants= trade marks with those of the opponents;

ii) 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;

iii) on the basis of the opponents= earlier protected trade marks, as defined in Section 6, the opponents believe that the registration of the trade mark in suit is likely to cause confusion on the part of the public. Therefore, the application should be refused on the basis of Section 5(2) of the Act.

iv) under the provisions of Section 5(3) because the trade mark is similar to the opponents= trade marks which have a reputation in the United Kingdom and use by the applicants would take unfair advantage of, or be detrimental to, the distinctive character or repute of the opponents= marks;

v) that the trade mark would be contrary to Section 5(4) of the Act because the opponents are the proprietors of an earlier right in the United Kingdom protectable by the law of passing off.

4. The opponents further request that the Registrar refuses the applications 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 requirements of the Act and Rules in one or more respects.

5. The applicants filed counterstatements which, in essence, deny the grounds of opposition. I note that in paragraph 10 of the Counter Statement the applicants make the following statement >... the application in suit should be registrable under the provisions, if necessary, of Section 7 of the Trade Marks Act 1994'.

6. Both parties filed similar evidence in each of the cases involved in these proceedings and both sides ask for an award of costs. The matter came to be heard on 10 April 2003. At the hearing the applicants were represented by Ms Mary Vitoria of Her Majesty=s Counsel instructed by Eric Potter Clarkson; the opponents were represented by Mr Simon Malynicz of Counsel instructed by J A Kemp & Co. As all cases were heard at the same time, a composite decision is appropriate.

7. Just before the hearing, in his skeleton argument, Mr Malynicz narrowed the opposition in each case to one based upon Section 5(2)(b) of the Act; though he also maintained the ground based upon Section 5(4)(a) he acknowledged it Adoes not add very much to the Section 5(2)(b) objection@. I agree. I proceed therefore to consider the cases on the 5(2)(b) ground.

Opponents= Evidence

8. This consists of a statutory declaration dated 2 August 1999 by Mr Fahad Bin Abdul-Aziz Ajlan Al-Ajlan (hereafter Mr Ajlan Al-Ajlan). Mr Ajlan Al-Ajlan explains that he is Administrative Affairs Manager of Ajlan Bin Abdulaziz Al-Ajlan & Brothers Co. and has been employed by this company for 4 years. He states that he is authorised by his company to make his statutory declaration and that he is fully conversant with the English language.

9. He states that his company are the owners of United Kingdom trade mark application numbers 2015208, 2022252 & 2055236, as represented in Exhibit FBAAA1, details of these trade marks can be found in the Annex to this decision. However, I note that his company has abandoned application numbers 2015208 and 2022252. Details of Application No. 2055236 are shown below:

 App. Date: 01.02.1996
Class 25: Clothing for men and children; headgear; footwear
Transliteration clause: The Arabic characters appearing in the mark mean >Ajlan and Brothers= and >Ajlan bin Abdulaziz Al-Ajlan & Brothers Co.=

10. Mr Ajlan Al-Ajlan states that his company has made substantial use of it=s trade marks between the period of 1995 and 1998. He states that 518, 500 yashmaghs have been sold in this period with a total value of ,6,507,715. Exhibit FBAAA2 comprise copies of invoices rendered for the shipments of the goods made in the United Kingdom by E & M Manufacturing Limited and the Original Manufacturing Company. I note that all of these

invoices pre-date the applications, 15 July 1997, and have reference to Mr Ajlan Al-Ajlan=s company.

11. Exhibit FBAAA3 consists of a sample of a yashmagh on the packaging upon which appears a representation of the opponents= mark the subject of application 2055236.

12. Mr Ajlan Al-Ajlan states that advertising expenses have been substantial to promote the company=s trade mark but this is not done within the United Kingdom because this is the place of manufacture of the products, and the products themselves are marketed and sold in Saudi Arabia.

13. Exhibit FBAAA4 comprise copies of advertisement contracts relating to the promotion of the mark. These contracts are all in Arabic with no translations, therefore they can have no bearing on this matter. However, they do have the occasional English word, mainly in the title, for example, >Media= or >Press, Printing and Publishing= which would suggest advertising. But as stated, as there are no translations provided I give no weight to this exhibit.

14. Exhibit FBAAA5 are copies of advertising materials relating to Mr Ajlan Al-Ajlan=s company, all bearing the opponents= trade mark, but this Exhibit too is in Arabic and there seems to be no clear indication of where they are from and of what date.

Applicants= Evidence

15. This consists of a witness statement of Robert John Quick dated 21 August 2000. Mr Quick is Managing Director of Lappet Manufacturing Company Limited and has held this position since March 1989. He states that his company has at all times exclusively manufactured Arab head shawls. Mr Quick confirms that he is authorised to make this statement on behalf of the applicants adding that the facts given in his declaration are from his personal knowledge or the books and records of his company or has been told it by Abdul-Aziz Al-Ajlan, who is one of the directors of Mohammed S Al-Ajlan Sons Company (the applicant).

16. Mr Quick states that Mohammed S Al-Ajlan, founder of the applicant=s company, first imported head shawls into Saudi Arabia around 1954/1955. He goes on to say that the company is now called Mohammed S Al Ajlan Sons Company, of which his five sons are all partners.

17. Mr Quick states that Lappet Manufacturing Company Limited manufacture all of the shawls, the packaging of which bears the trade marks the subject of the present applications.

18. Commenting on Mr Ajlan Al-Ajlan=s statutory declaration and evidence Mr Quick questions, firstly, the sales figures given, stating that it is impossible to tell if any of these sales took place before the date of application, that is 15 July 1997. Secondly, Mr Quick questions the authenticity of the opponents= invoices (applicant=s exhibit RJQ2 - Opponents= exhibit FBAAA2).

19. Mr Quick goes on to provide information provided by various sources on the capacity and ability of the various suppliers of the opponent to supply the stated number of yashmaghs. He thus challenges the veracity of the opponents= evidence as to the extent of the use of their trade marks.

Applicants= Additional Evidence

20. Because the applicants had no objection, I admitted at the hearing statutory declarations dated 15 May 1998 by Mr Quick filed at the ex parte stage in support of applications Nos. 2139074 and 2139078 and another two dated 5 January 2000 filed similarly in support of the applications.

Decision

21. Section 5(2)(b) states:

> A5.(2) 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,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.@

22. An earlier trade mark is defined in Section 6, the relevant parts state:

> A6.-(1) (a) In this Act an Aearlier 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,
>
> (2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.@

23. Mr Malynicz submitted that despite their withdrawal, the opponents= two applications, Nos. 2015208 and 2022252, were earlier trade marks extant at the relevant date and must therefore be taken into account in determining matters under Section 5(2)(b).

24. In his view the Directive (Article 4) provided for applications for registration (whether subsequently registered or not) to be earlier trade marks if filed in relation to later filed

applications, taking into account as appropriate any priority. In his view the wording of the Directive at Article 4(2)(a), the term >subject to their registration= in Article 4(2)(c) was almost otoise, because it was only the fact that there was an earlier application that mattered. He considered that *Transpay* [2001] RPC 191 was wrongly decided. I took the view at the hearing that a purposeful construction had to be applied to Article 4(2)(c) as a whole and the Trade Marks Act 1994 at Section 6(2).

25. The term Asubject to its being so registered@ had the effect of applying the effect of an earlier right only when it became protected ie. it had been accepted and placed upon a register. This is clearly a practical provision so that only when the scope of the protected right is known (given that the application can be amended at all stages and may require to be so amended by a narrowing down of the specification of goods and services to overcome an opposition) is the conflict between a later filed application and earlier right fully determined. For this reason I noted the United Kingdom Trade Marks Registry and the Office for Harmonization in the Internal Market suspended opposition proceedings, or withhold issuing a final decision in opposition proceedings, until the earlier trade mark is accepted and registered. For an example of the United Kingdom practice see the Hearing Officer=s decision in BL 0/191/03.

26. For the reasons I gave at length in *Transpay* which in any event dealt with post registration issues, I consider that the United Kingdom Trade Marks Registry must sensibly, and for the benefit of the applicants for registration have the ability to take account of events which post date an application date.

27. Thus, because applications, Nos. 2015208 and 2022252 have been withdrawn and will not therefore be registered they have no bearing on the issues before me and I do not take them into account in determining, under the provisions of Section 5(2)(b), whether the trade marks the subject of the applications for registration in suit should be registered because they are no longer earlier trade marks. That said I consider that the opponents= application No. 2055236 is an earlier right as defined by Section 6 of the Act.

28. In her skeleton argument Ms Vitoria said:

> AThe proper approach to Section 5(2) is that set out in *Sabel BV v Puma AG* [1998] RPC 199 at page 223 line 50 to 224 line 36; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] F.S.R. 77 at 83-85, [1999] ETMR 690 at 698 and *Marca Mode CV v. Adidas AG* [2000] ETMR 723. In particular:
>
> (i) the likelihood of confusion must be appreciated globally taking into account all factors relevant to the circumstances of the case;
> (ii) the matter must be judged through the eyes of the average consumer, of the goods 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;
> (iii) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(iv) the global appreciation of visual, aural or conceptual similarity must be based on the overall impression given by the marks, bearing in mind their distinctive and dominant components;

(v) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(vi) the more distinctive the earlier mark (either *per se* or because of the use that has been made of it), the greater will be the likelihood of confusion;

(vii) mere association, in the strict sense that the later mark simply brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2);

(viii) but if the association between the marks results in a likelihood that the average consumer will wrongly believe the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the Section.@

29. Mr Malynicz concurred.

30. The first point to consider is whether the goods covered by the respective applications are the same or similar. There can be no question that the applicants= goods in Class 25 Aclothing and footwear and headgear (No. 2139070) and Aheadshawls and yashmaghs; all for export to the Middle East@(Nos. 2139074 and 2139078) are the same goods as covered by the opponents= application for registration in Class 25 for Aclothing for men and children; headgear; footwear.@

31. Ms Vitoria submitted that none of the applicants= goods covered by Class 24 ie. Atextiles and textile goods not included in other Classes; textile piece goods for making headshawls; bed and table covers@ (2139070) and Atextile piece goods all for making up into headshawls and yashmags; all for export to the Middle East@ (2139074 and 2139078) Awere similar to the opponents Class 25 goods@. Mr Malynicz submitted otherwise. Both parties were, he argued, in the business of selling headshawls and one had to take that into account in making the comparison. In his view, textile piece goods for making headshawls were similar goods to headshawls themselves. I agree. The fact that the Trade Marks Registry does not as a matter of routine search from Class 24 into Class 25, and vice versa, does not determine matters. From a common sense point of view, the textile piece goods for making headshawls in Class 24 are to a large extent going to be indistinguishable from the finished article in Class 25. Therefore, we have identicality in respect of the Class 25 goods and similarity of goods as between headgear in Class 25 in the opponents= specification and the applicants= textile piece goods for making headshawls in Class 24.

32. With that in mind I proceed to consider the respective trade marks themselves, taking into account the criteria set out above. I should note that both sides agreed that matters surrounding trade in overseas territories were not relevant to the consideration of registrability in the United Kingdom (*Al Bassam* [1995] RPC 511) but that for the principal goods at issue here headshawls, the reasonably circumspect consumer would be Arab speaking.

33. Mr Malynicz did not pursue any claim that the opponents= trade mark had a highly distinctive character through the use made of it. He relied upon what he termed his clients =distinctiveness per se=. I therefore need not dwell on the evidence of use filed by the opponents except to say that I feel that it falls some way short of establishing either goodwill or reputation. Exhibits are in Arabic and no translations have been provided. The veracity of invoices is challenged by the applicants but without a detailed response by the opponents. The precise trade mark which it is claimed to have been used is not clear. Thus, I think that Mr Malynicz was right to leave aside the evidence and rely upon the prima facie case.

34. The respective trade marks are compared as follows:

Applicants= trade mark No. 2139070

العجلان

Opponents= trade mark

عجلان واخوانه
Ajlan & Bros.
شركة عجلان بن عبد العزيز العجلان واخوانه

35. The applicants= trade mark is in Arabic script which comprises the mark Al-Ajlan which means =the swift one=. Even to an Arab speaker there are significant differences between the trade marks. There is much additional matter in the opponents= trade mark - more script and the device of a globe. Also, there is the possibility that the trade mark would be seen as =the swift one= by an Arabic speaker rather than having any surnominal significance which the opponents= trade mark, by the addition of the term & Brothers, does have. The differences between the applicants= and the opponents= trade marks, despite the identicality and similarity between the respective goods means that even in the specialised field of headgear the relevant public are not going to be confused as to the origin of the goods. Thus, I do not consider that the opponents= trade mark constitutes a barrier to the registration of the applicants= trade mark No. 2139070 under the provisions of Section 5(2)(b). The opposition under that head in respect of that application is therefore dismissed.

Applicants= trade mark No. 2139074

شركة أبناء محمد السعد العجلان

Opponents= trade mark

عجلان واخوانه
Ajlan & Bros.
شركة عجلان بن عبد العزيز العجلان واخوانه

36. In the applicants= trade mark, the translation of the Arabic characters mean AMohamed Al Said Al Ajlan Sons Company@. Thus it contains a significant element of the opponents= trade mark, the word Ajlan. Because of the way in which they are presented there is clearly a surnominal significance. Though how significant I know not. There is no evidence before me as to the prevalence of Ajlan as a surname in Arab speaking countries and therefore its significance as such to an Arab speaker in the United Kingdom. Making the best I can of the criteria to be applied looking at the trade marks as wholes, and taking into account imperfect recollection, I reach the view that there are differences between the opponents= and applicants= trade marks - the reference to sons rather than brothers, the addition of the forename Mohammed, together with a device of a circle containing additional matter, would enable the relevant public to differentiate one trade mark from the other, even in a case such as this where identical and specialised goods are involved. The opposition to this application on the basis of Section 5(2)(b) is therefore dismissed.

Applicants= trade mark No. 2139078

Al-Ajlan

AL-AJLAN

Opponents= trade mark

عجلان واخوانه

Ajlan & Bros.

شركة عجلان بن عبد العزيز العجلان واخوانه

37. In this case the applicants= trade mark consists solely of the term Al Ajlan. It is the same term which features predominantly in the opponents= trade mark. Whereas in the other cases before me, in the applicants= trade mark the term Ajlan has appeared along with other matter, which has overwhelmed the term. In this case it is not so. There can be no doubt that the respective trade marks, in my view, taking account of all of the guidance set out above are similar. Sufficiently so, taking account of the identicality and similarity of the respective goods for the public to be confused. For these reasons I believe the application No. 2139078 falls foul of Section 5(2)(b) because of the opponents= earlier trade mark and the application for registration must be refused registration under that head.

38. I go on to deal with the ground of opposition based upon Section 5(4)(a), albeit briefly.

Section 5(4)(a)

39. This states:

> A5.(4)(a) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> (a) by virtue of any rule of law (in particular, the law of passing off)

protecting an unregistered trade mark or other sign used in the course of trade, or@

40. Because Mr Malynicz accepted that this ground did not add much I do not intend to deal with his client=s case in detail, except to say that, as indicated earlier, the evidence of use/reputation/goodwill, leaves a lot to be desired. In *Wild Child* Trade Mark [1998] RPC 455 & *South Cone Incorporated v Jack Bessant & Others* [2002] RPC 19 comments were made about the evidence needed to support a claim to passing off. Where a party claiming a protectable goodwill derived from suppliers rather than their own direct trade in the United Kingdom (*Home Box Office v Chanel 5* [1982] FSR 499 and *J C Penney v Punjabi Nick* [1979] FSR 27) then the evidence should be clear and robust. This is not the case here. The challenge to the opponents= evidence by the applicants has not been answered **other than in terms?** Also, the applicants themselves have a claim to use of the >Ajlan= trade marks covering the same period but no confusion seems to have come to light. For these, albeit brief, reasons I do not consider the Section 5(4)(a) ground has merit and is dismissed.

Costs

41. The opponents have been successful in one case and the applicants in two. There was only one hearing and to a large extent the evidence in each case was the same. Taking those facts into account I consider that the net result is that the opponents should pay to the applicants the sum of **,** 500 and I so order. 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.

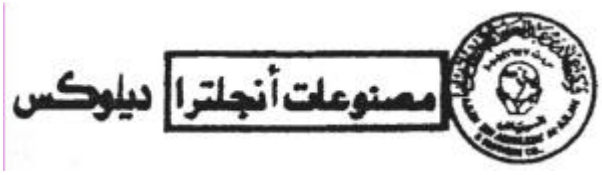
Dated this 11th day of September 2003

M KNIGHT
For the Registrar
the Comptroller-General

ANNEX

Application No 2015208

App. Date 15.03.1995



Class 24:
Textiles and textile goods; blankets, linen, towels; bed and table covers.

Class 25:
Articles of clothing for men and boys; footwear; headgear.

Transliteration clause: The Arabic characters in the mark mean "Ajlan Abdulaziz Al-Ajlan Co., C.R. 1010121627, Riyadh, manufactured goods from England, Deluxe".

Application No 2022252

App. Date 30.05.1995

Class 25:
Article of clothing for men; footwear; headgear.

Transliteration clause: The Arabic characters appearing in the mark is "Malaki" and "Ajlan Wa Ikhwanuhu" meaning "Royal and "Ajlan and Brothers".