

O-170-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 1108972 IN THE  
NAME OF INFRA METAL ESTABLISHMENT OF THE TRADE MARK**

**HALAL 7**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 72421 BY CAN-DO CORPORATION LIMITED**

## BACKGROUND

1. On 13 January 2012 (claiming priority from a filing in Liechtenstein dated 18 July 2011), Infra Metal Establishment (the “applicant”) requested protection in the United Kingdom of the International Registration (IR) of the trade mark **HALAL 7**.

2. The United Kingdom Trade Marks Registry (“TMR”) considered the request satisfied the requirements for protection and particulars of the IR were published on 1 June 2012 for the following goods in class 32:

Beers; mineral and aerated waters and other non-alcoholic beverages; fruit juices and fruit drinks; syrups for making non-alcoholic beverages; energy drinks; isotonic drinks, stimulation drinks, beverages containing caffeine and/or plant extracts (all the aforementioned goods not for medical use); all being goods which conform to the Islamic (Muslim) standards and dietary laws known as Halal (or its variant Hallal).

3. On 19 July 2012, Can-Do Corporation Limited (the “opponent”) filed a notice of opposition which consisted of grounds based upon sections 3(3)(a), 3(3)(b) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The applicant subsequently amended its application by deleting “beers” from its specification. As this amendment met the opponent’s objections under sections 3(3) of the Act, I need say no more about these substantive grounds in this decision. The opposition under section 5(2)(b) of the Act, which is directed against all of the goods in the application, is based upon:

**UK trade mark no. 2574720 for a series of 2 trade marks i.e.**

**Hallal<sub>2</sub>0**

**Halal<sub>2</sub>0**

applied for on 9 March 2011 and registered on 19 August 2011 for a range of goods in classes 11 and 32. Although the opponent indicates that it is relying upon all the goods for which this trade mark is registered, I need only refer to those goods in class 32 i.e.:

Fruit juices; fruit drinks and fruit juices; additive free fruit juices; additive free vegetable juices; aerated fruit juices; aerated juices; beverages consisting of a blend of fruit and vegetable juices; beverages consisting of vegetable juices;

beverages consisting principally of fruit juices; beverages having a base of fruit juice; beverages having a base of vegetable juice; bottled fruit juices; concentrates for use in the preparation of fruit juice drinks; fresh fruit juices; fresh vegetable juices; frozen concentrated fruit juices; frozen fruit juices; frozen vegetable juices; fruit juice beverages; non-alcoholic fruit juice beverages; fruit juice concentrates; fruit juice extracts being beverages or for making beverages; fruit juice extracts for use as a beverage; fruit juice for use as a beverages; fruit juice nectar being beverages or for making beverages; fruit juices being beverages and being aseptic; fruit juices being beverages and being bottled; fruit juices being beverages and being canned; fruit juices being beverages and being in cartons; grape juice; vegetable juices for use as a beverage; lemon juice being a beverage or an ingredient for beverages; lime juice cordial; low calorie fruit juices; multi-vitamin enriched fruit juice beverages other than for medical use; multi-vitamin fruit juice beverages not for medical use; non-alcoholic beverage consisting of water, lemon juice and lemon pulp; non-alcoholic beverages consisting of mixtures of fruit juices; non-alcoholic beverages containing fruit juices; non-alcoholic beverages having a fruit juice base; non-alcoholic beverages made from fruit juices; carbonated water; non-alcoholic fruit juice beverages; non-alcoholic fruit juices; drinking water; non-fermented fruit juices; mineral and aerated waters; orange juice; preparations for making fruit juices; soft drinks consisting of non-fermented fruit juices; squash containing lemon and currant juice; tomato juice being beverages; unfermented apple juice; unfermented fruit juice; vegetable juice concentrates being beverages; vegetable juices being beverages; whey beverages containing fruit juice; drinks flavoured with fruit pastes and having a mineral water base; drinks flavoured with herbs and having a base of mineral water; drinks flavoured with spices and having a base of mineral water; lemon barley water; bottled water mineral and aerated waters; non-alcoholic drinks; syrups for making beverages; all of the aforesaid being goods which conform to the Islamic (Muslim) standards and dietary laws known as Halal (or its variant Hallal).

4. On 28 September 2012, the applicant filed a counterstatement which (following the deletion of beers) consists of a denial of the section 5(2)(b) ground which remains. In its counterstatement the applicant said:

“7. However it is admitted that the goods within class 32 of the application following its amendment are identical or similar to the goods in class 32 covered by the registration.”

5. Neither party filed evidence. The opponent filed written submissions during the evidence rounds and in lieu of attendance at a hearing. I will, if necessary, refer to these submissions below.

## DECISION

6. The surviving ground of opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

7. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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.”

8. In these proceedings the opponent is relying upon the trade marks shown in paragraph 3 above, which qualify as earlier trade marks under the above provisions. Given the interplay between the date on which the applicant requested protection in the UK and the date the opponent’s earlier trade marks completed their registration procedure, the earlier trade marks are not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

### **Section 5(2)(b) – case law**

9. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

## The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

## The principles

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

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

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

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

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

### **Comparison of goods**

10. As the applicant admits that its goods are either identical or similar to the opponent's goods in class 32, there is no need for me to deal with this issue in any great detail. However, bearing in mind the comments of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 i.e.

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42)”,

the competing goods are, in my view, identical (rather than similar) either because they are expressed in identical terms in both parties' specifications, for example, “fruit juices” and “fruit drinks”, or because the opponent's specification in class 32 includes a broad term such as “non-alcoholic drinks” which would include within it the goods in the applicant's specification.

### **The average consumer and the nature of the purchasing decision**

11. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods; I must then determine the manner in which the goods will be selected by the average consumer in the course of trade. The average consumer of non-alcoholic drinks is a member of the public who is most likely to buy the goods by self-selection in retail outlets such as convenience stores, garages and

supermarkets. Visual considerations will dominate the selection process and as the cost of the goods will be low so, in my view, will be the degree of care the average consumer devotes to their selection.

### **Comparison of trade marks**

12. Although the opponent's trade mark is registered as a series of 2, these marks are, with the exception of the spelling of the word Hallal/Halal, identical. For the purposes of comparison, I will compare the version of the opponent's trade mark which is spelt in the same way as the applicant's trade mark. If the opponent does not succeed in relation to this trade mark it will be in no better position in relation to the other version of its trade mark. The comparison is between:

**Halal<sub>2</sub>0**

and: **HALAL 7**

13. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

### **Distinctive and dominant components**

14. Both parties' trade marks contain the well known Arabic word HALAL (meaning permissible, lawful) presented in title and upper case. In the opponent's trade mark this word is accompanied by the numerals 2 and 0 which, in its notice of opposition, the opponent refers to as the numeral 20 but which in its submissions it refers to as "a letter and a number". Given its presentation in which the numeral 2 is presented in subscript, the second part of the opponent's trade mark is, in my view, likely to be seen as the numeral 2 and the letter O; however, I accept that both options are possible. No such ambiguity arises from the inclusion in the applicant's trade mark of the numeral 7. The fact that both parties' goods are limited to those which conform to Halal standards, indicates that although the word Halal/HALAL may be considered a dominant element of both parties' trade marks, it is not a distinctive element. It is, in my view, possible (I put it no higher) that the element which accompanies the word Halal in the opponent's trade mark may evoke the chemical symbol O<sub>2</sub> in the mind of the average consumer. Given its presentation, it is (arguably) a distinctive, even if it is a less dominant element, of the opponent's trade mark. However, if it is construed as the numeral 20, it would, like the numeral 7 in the applicant's trade mark, be neither a dominant element, nor as it

may be seen as, for example, a simple codifying number, a distinctive element. Considered overall, I think the distinctiveness of both parties' trade marks lie in the totalities they create rather than the elements of which they are made up.

### **Visual/aural similarity**

15. Although the numeral 7 and the numeral 20 or combination 2, O are visually and aurally quite different, the inclusion in both parties' trade marks of the words Halal/HALAL together with an element which either consists of or contains a numeral, results, in my view, in a reasonable degree of both visual and aural similarity.

### **Conceptual similarity**

16. If the opponent's trade mark is construed by the average consumer as the word Halal accompanied by the numeral 20, there would, in my view, be a high degree of conceptual similarity between the competing trade marks. However, even if the opponent's trade mark is construed as the numeral 2 and the letter O, the presence in both parties' trade marks of a numeral would still, in my view, result in a reasonable degree of conceptual similarity.

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

17. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. I have only the inherent characteristics of the earlier trade mark to consider. Although the word Halal is descriptive, the inclusion of what would be construed as either the numeral 20 or the numeral 2 and letter O, results, in my view, in the earlier trade mark being possessed of an average (i.e. no higher than normal) degree of inherent distinctive character.

### **Likelihood of confusion**

18. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's earlier trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the



opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

19. Earlier in this decision, I concluded that:

- the average consumer of the goods at issue is a member of the public who will select the goods by predominately visual means and who will pay a low degree of attention when doing so;
- the goods are identical;
- the distinctiveness of both parties' trade marks lies in the trade marks as a whole;
- there is a reasonable degree of visual and aural similarity and (at least) a reasonable degree of conceptual similarity;
- the opponent's earlier trade mark is possessed of an average degree of inherent distinctive character.

20. Given the identity in the goods, the similarities in the trade marks and the low degree of attention that will be paid by the average consumer to the selection of the goods (making him more susceptible to the effects of imperfect recollection), there is, in my view, a likelihood of confusion. Even if the differences in the competing trade marks is sufficient to avoid direct confusion i.e. where one trade mark is mistaken for the other (which in my view is arguable), the similarities I have identified are more than sufficient to lead to a likelihood of indirect confusion i.e. where the average consumer assumes the goods of the applicant come from an undertaking economically linked to the opponent.

## **Conclusion**

**21. The total opposition to the application succeeds in full.**

## **Costs**

22. As the opponent has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. In relation to the grounds based upon section 3(3) of the Act which were met when the applicant amended its specification by deleting beers, in its submissions dated 19 December 2012, the opponent said:

“We would maintain that the [grounds mentioned] have been successful and our client therefore should be awarded an award of costs on these grounds.”

In its submission in lieu of attendance at a hearing the opponent said:

“We request costs off the normal scale in favour of our client, all appropriate action was taken including writing to the attorneys of the international registration on 22 June 2012 and putting them on notice of our client’s earlier rights. It should be noted that no UK attorneys were instructed at this point. It should also be noted that contacting the other side prior to the opposition period resulted in no response beyond a short e-mail of 25 June 2013 (sic) confirming that our correspondence was “received with thanks”. We have only received no (sic) correspondence from the other party and the papers they have filed is the defence and deleting “beer” being goods which we opposed. Given the lack of all action on behalf of the proprietor of the international registration save filing a defence we would request costs off the normal scale on this matter.”

23. The application was published for opposition purposes on 1 June 2012; on 22 June the opponent sent a letter before action to the applicant; the applicant acknowledged this letter on 25 June; on 19 July the opponent filed its notice of opposition in which it relied upon grounds under sections 3(3) and 5(2) of the Act. On 28 September 2012, the TMR was advised that the applicant had appointed agents in the UK and a TM8 and counterstatement was filed in which the applicant denied the ground based upon section 5(2)(b) and indicated that “beer” would be deleted from its specification to overcome the objections based upon section 3(3) of the Act. The opponent filed two pages of submissions during the evidence rounds and a little over two pages of submissions in lieu of attendance at a hearing; the applicant chose to file no evidence or submissions.

24. Although the applicant has taken little part in these proceedings, it promptly acknowledged the letter before action and acted upon the form TM7 by appointing an agent in the UK who took the actions I have referred to above. Although the applicant appears to have accepted that the objections based upon section 3(3) of the Act had some merit, its approach to the objection based upon section 5 of the Act i.e. it denied the ground and chose not to file any evidence or submissions, indicates that it took quite a different view of that ground. Although the applicant has ultimately been unsuccessful, having considered the above chronology, I can see absolutely nothing in its approach to these proceedings which would justify an award of costs to the opponent off the normal scale. Having reached that conclusion, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant’s statement:	£300
Written submissions:	£300
Official fee:	£200
<b>Total:</b>	<b>£800</b>

25. I order Infra Metal Establishment to pay to Can-Do Corporation the sum of **£800**. 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 26th day of April 2013**

**C J BOWEN  
For the Registrar  
The Comptroller-General**