

O-788-21

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003460807

BY UK MALAYALEE MATRIMONY LTD

TO REGISTER:

**UK Malayalee Matrimony**

AND THE OPPOSITION THERETO UNDER NO. 420200

BY UKMALAYALIMATRIMONY.COM LIMITED

AND

IN THE MATTER OF APPLICATION NO. UK00003494075

BY UKMALAYALIMATRIMONY.COM LIMITED

TO REGISTER:



AND THE OPPOSITION THERETO UNDER NO. 422347

BY UK MALAYALEE MATRIMONY LTD

## BACKGROUND AND PLEADINGS

1. On 24 January 2020, UK Malayalee Matrimony Ltd (“Malayalee”) applied to register the trade mark **UK Malayalee Matrimony** (“the Malayalee mark”) in the UK. The application was published for opposition purposes on 31 January 2020, in respect of the following services:

Class 45      Dating services; Internet dating services.

2. On 28 April 2020, ukmalayalimatrimony.com limited (“Malayali”) filed an opposition against the application in full under sections 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994 (“the Act”). Malayali argues that the Malayalee mark consists exclusively of a sign which may serve in trade to designate the kind and purpose of the services e.g. a marriage agency service or matchmaking service for the British Malayali community.

3. Malayalee filed a counterstatement denying the claims made and stating that the Malayalee mark is imaginative, fanciful and allusive.

4. On 27 May 2020, Malayali applied to register, in the UK, the following mark (“the Malayali mark”):



5. The application for the Malayali mark was published for opposition purposes on 13 November 2020, in respect of the following services:

Class 45      Matrimonial agencies.

6. On 4 December 2020, Malayalee filed an opposition against the application in full under section 5(2)(b) of the Act, relying on the Malayalee mark and its class 45 services. Malayalee claims that the marks at issue and their respective services are highly similar, resulting in a likelihood of confusion.

7. Malayali filed a counterstatement denying the claims made and referred to its opposition under sections 3(1)(b) and (c) against the Malayalee mark.

8. The two oppositions were subsequently consolidated.

9. During the evidence rounds, Malayali filed evidence in chief and Malayalee filed written submissions. Neither party requested a hearing and only Malayalee filed written submissions in lieu. Malayalee is represented by Wilson Gunn; Malayali represents itself.

10. 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**

11. Malayali's evidence is in the form of the witness statement of Prince Joseph, director of Malayali. Mr Joseph's witness statement is accompanied by 11 exhibits (PJ1-PJ11). I have read the evidence in its entirety and summarise it below only to the extent that I consider it necessary.

12. Copies of webpages from Oxford English Dictionary and Wikipedia define the word "Malayali" (also written as "Malayalee") as "[a] member of a Malayalam-speaking people chiefly inhabiting the state of Kerala in south-west India" and "a Dravidian ethnolinguistic group originating from the present-day state of Kerala in India".<sup>1</sup>

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<sup>1</sup> Exhibit PJ3.

13. Malayali has filed a letter sent from the UK IPO refusing the mark 'UK Malayali Matrimony' under sections 3(1)(b) and (c).<sup>2</sup>

## **PRELIMINARY ISSUE**

14. As stated in my evidence summary, Malayali filed a letter from the UK IPO refusing its mark. Malayali submits that the same reasoning as provided in that letter should apply to the Malayalee mark. Malayalee, in its written submissions in lieu, submits as follows:

“5. Party B’s application was examined and accepted without any distinctiveness or descriptiveness issues being raised.”

15. I must point out that I am not bound by the previous decision of an examiner. The individual circumstances surrounding each application are paramount and so ‘precedents’ cannot be decisive. For this reason, the parties’ submissions on this point are not relevant to the decision I am required to make.

## **DECISION**

16. Given its impact upon the 422347 opposition, I will begin by assessing the opposition against the Malayalee mark.

## **THE OPPOSITION AGAINST THE MALAYALEE MARK**

17. Sections 3(1)(b) and 3(1)(c) read as follows:

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

(a) [...]

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<sup>2</sup> Exhibit PJ4.

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

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) [...]

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

18. The relevant date under sections 3(1)(b) and (c) is the date of filing of the contested mark i.e. 24 January 2020.

19. I bear in mind 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): *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P at [25].

20. The position under the above grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect: *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04. The average consumer varies depending on the particular goods and services concerned. In this case, the average consumer is likely to be a member of the general public interested in dating (online or otherwise).

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

21. I will begin with the opposition under section 3(1)(c). Section 3(1)(c) prevents the registration of marks which are descriptive of the services, or a characteristic of them.

22. 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. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

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

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ( OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

[...]

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

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

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

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for

the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland* , paragraph 86, and *Campina Melkunie*, paragraph 19).

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

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

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

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily



recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

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

23. The mark against which this opposition is directed is **UK Malayalee Matrimony**.

24. “UK” simply suggests that the services are provided in the UK: it serves to designate the geographical scope of the services and it is, therefore, descriptive.

25. “Malayalee” has been shown, in Malayali’s evidence, to be an alternative spelling of the word “Malayali”, which refers to Malayalam-speaking people inhabiting Kerala, India. I recognise that “Malayalee” is a non-English word and that there are no grounds for refusing registration of trade marks on the basis that they are descriptive in a language which is unlikely to be understood by the relevant average UK consumer of the services. However, non-English word marks which are likely to be recognised as descriptive will be objectionable.

26. At this point, I consider it relevant to refer to the trade marks manual, which provides some guidance on services aimed at minority groups. The manual reads:

“Where the goods or services are aimed at a specific consumer who is far more likely to understand the language of the mark rather than the average UK

consumer as a whole, this should be taken into account in determining whether the mark is objectionable under section 3(1)(c).

For example, the Arabic word [for 'Niqab'] would not be registrable for niqabs in class 25 because this would be a normal way for traders of these goods to market them as they are primarily used by the Arabic speaking community. The same would apply if the application includes more general descriptions of the same goods, such as 'clothing'."

27. I also bear in mind the judgment of the Court of Justice of the European Union ("CJEU") in *Louffi v AMJ Meatproducts NV and Another*, Case C-147/14, where it was held that where average consumers have a basic understanding of the meaning of foreign words, this must be taken into account.

28. The fact that the services in the application are not limited to, or specifically directed at, a minority group, is not a determinative factor, since Malayalam-speaking people are still likely to form a group of consumers, who would know, without thought, what "Malayalee" means. Average UK consumers also include those who are not Malayalam speaking themselves, but who know (or will understand from the mark when read as a whole) that Malayalam describes a people originating from abroad. I consider, therefore, that the non-English word "Malayalee" is likely to be recognised as descriptive by at least some average consumers of the services.

29. "Matrimony" is a common word in the English language, which will be immediately understood by UK consumers as "the state of being married".<sup>3</sup> As a result, in the context of dating services and online dating services, "matrimony" is indicative of the intended purpose of those services i.e. dating with the aim of getting married. In my view, "matrimony" is descriptive of the services.

30. It follows that each word element of the Malayalee mark is descriptive of the services in the application. In *Campina Melkunie BV and Benelux-Merkenbureau*, Case C-265/00, the CJEU stated that:

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<sup>3</sup> [www.dictionary.cambridge.org/dictionary/english/matrimony](http://www.dictionary.cambridge.org/dictionary/english/matrimony)

“39. As a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive even if the combination creates a neologism. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

40. However, such a combination may not be descriptive within the meaning of Art.3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition will have to be satisfied as regards both the aural and the visual impression produced by the mark.

41. Thus, a mark consisting of a neologism composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics within the meaning of Art.3(1)(c) of the Directive, unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts.”

31. I do not consider that the three words comprising “UK Malayalee Matrimony” create such an unusual combination in relation to the services that its meaning is so far removed from the meanings of the individual elements that it ceases to be descriptive. The combination of the descriptive words is not odd or unusual for the services and

so, in this case, I am satisfied that the three descriptive words combine to create a descriptive mark.

32. The opposition under section 3(1)(c) is successful.

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

33. I now turn to the opposition under section 3(1)(b) of the Act. Section 3(1)(b) prevents registration of marks which are devoid of distinctive character. 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)."

34. As stated in *Starbucks (HK) Ltd v British Sky Broadcasting Group plc* at [46] descriptive signs are also devoid of distinctive character. It therefore follows that since Malayali has succeeded under its section 3(1)(c) ground, it must also succeed under its 3(1)(b) ground. In addition, Malayali's pleadings do not present any alternative reason (other than descriptiveness) as to why the Malayalee mark would be non-distinctive. Consequently, the opposition based upon section 3(1)(b) also succeeds in its entirety.

35. The opposition (no. 420200) against the Malayalee mark is successful and the application (no. 3460807) will be refused.

## **THE OPPOSITION AGAINST THE MALAYALI MARK**

36. Since the Malayalee mark is to be refused registration, it follows that there is no earlier mark to be relied upon in the opposition against the Malayali mark. The

opposition (no. 422347) under section 5(2)(b) is dismissed and the Malayali mark (no. 3494075) will proceed to registration for the services applied for.

## **COSTS**

37. ukmalayalimatrimony.com limited has been successful and would ordinarily be entitled to a contribution towards its costs. As ukmalayalimatrimony.com limited is unrepresented, at the conclusion of the evidence rounds the tribunal invited it to indicate whether it wished to make a request for an award of costs and, if so, to complete a pro-forma including a breakdown of its actual costs. No pro-forma was returned and so, no costs, other than the official fee of £200, will be awarded.

38. I order UK Malayalee Matrimony Ltd to pay ukmalayalimatrimony.com limited the sum of £200. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

**Dated this 20th day of October 2021**

**E VENABLES**

**For the Registrar**