

**TRADE MARKS ACT 1994**

**IN THE MATTER OF OPPOSITION NO. 45681**

**IN THE NAME OF AL-MASARAAT INTERNATIONAL TRADING &  
CONTRACTING COMPANY LTD.**

**TO APPLICATION NO. 2055236**

**TO REGISTER A TRADE MARK IN CLASS 25**

**IN THE NAME OF AJLAN BIN ABDULLAZIZ AL-AJLAN & BROTHERS CO.**

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**DECISION**

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On 15 June 1999 Mr G W Salthouse acting as Hearing Officer for the Registrar of Trade Marks issued a decision rejecting an opposition by Al-Masaraat International Trading & Contracting Company Ltd (“**the Opponent**”) to an application by Ajlan Bin Abdullaziz Al-Ajlan & Brothers Co. (“**the Applicant**”) to register the following trade mark for use in relation to “clothing for men and children; headgear; footwear” in Class 25.



**عجلان واخوانه**  
**Ajlan & Bros.**

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شركة عجلان بن عبد العزيز العجلان واخوانه

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

In summary the pleaded grounds of objection to the application for registration were as follows:

- (i) The mark applied for “contains the device of a globe which is a common sight in Saudi Arabia and ought to be refused registration under the provisions of Section 1(1), Section 3(1)(a), and Section 3(1)(b) of the Trade Marks Act 1994, as being a sign which is not capable of distinguishing the Applicant’s goods from those of other undertakings and which is devoid of any distinctive character.”
- (ii) The mark applied for “consists of a sign which has become customary in the bona fide and established practices of the trade, and ought to be refused under the provisions of Section 3(1)(d) of the Trade Marks Act 1994. Attached are various representations showing the common use of ‘Globe’ signs in Saudi Arabia.”
- (iii) The mark applied for “is of such a nature that it is contrary to public policy and ought to be refused registration under the provisions of Section 3(3)(a) of the Trade Marks Act 1994.”

The evidence in support of the opposition consisted of two Affidavits of Mohammed Abdul Rahman Theneyan, Vice President of the Opponent, in which he sought to establish that the trade mark in suit was unregistrable in the United Kingdom under the Trade Marks Act 1994 on the basis of circumstances prevailing in the textile and clothing trade in Saudi Arabia.

Neither party wished to be heard and the Hearing Officer proceeded to determine the opposition on the basis of the papers before him. Having considered the decision and reasoning of the Court of Appeal in Al Bassam TM [1995] RPC 511 he concluded that

the pleaded objections to registration fell to be determined by reference to the position in the United Kingdom and not by reference to the position in Saudi Arabia. Looking at the matter from that perspective he decided that the opposition failed on all grounds. He ordered the Opponent to pay the Applicant £435 as a contribution to its costs of the unsuccessful opposition.

The Opponent appealed to an Appointed Person under Section 76 of the Trade Marks Act 1994. In the Grounds for Appeal it was asserted that the Hearing Officer had not given due weight to the Opponent's evidence and that the evidence was sufficient to demonstrate that the trade mark in suit was ineligible for registration under Sections 1(1), 3(1)(a), 3(1)(b) and 3(1)(d) of the 1994 Act. The appeal came on for hearing before me on 20 January 2000. No one attended on behalf of the Opponent. I determined that the appeal would be dismissed for reasons to be given in writing and I directed the Opponent to pay the Applicant £400 in respect of its costs of the unsuccessful appeal. I now give my reasons in writing for so deciding.

In the past it was considered possible that the foreign consequences of using a mark upon goods destined for foreign markets could render it unacceptable for registration in the United Kingdom. The high water mark of this approach may have been reached in The Jackson Co's Trade Mark (1889) 6 RPC 80. The Jackson Company, a firm carrying on business in the United States, applied to register two marks in the United Kingdom in respect of cotton goods in Class 24 of the prevailing Classification. One mark consisted of the device of an owl with the word KOKOKO underneath; the other consisted of the word KOKOKO alone. The device of an owl was common to the trade and unregistrable. It was accepted on behalf of the Jackson Company that this would preclude registration of

the English word “owl” for use in relation to cotton goods. The application for registration of the word KOKOKO was nevertheless pursued on the basis that it was a fancy word which was obviously meaningless to ordinary Englishmen and not in any way descriptive of cotton goods.

However, the application was rejected inter alia upon the basis that KOKOKO was an onomatopoeic word used by the Chippeway Indians to identify a particular kind of owl which cries at night. The name was apparently taken from the sound of its cry. The objection to registration was held to be sustainable despite the fact that there was affidavit evidence before the Court from which it appeared that the Chippeway Indians were dying out as a tribe and had no written language and that no English or American firm had any commercial dealings with them (see p.81 of the report). The cited foreign language was obscure, but the foreign meaning of the rejected word was not ignored because it was considered possible and therefore relevant that goods to which the word had been applied might circulate and cause confusion in an overseas territory where that language was spoken.

It is easy to agree with the comment of Romer J. in Densham’s T.M. [1895] 2 Ch. 176 at 185 where he said of the decision in the KOKOKO case:

“I should have been disposed to think that the chance of the Chippeway Indians getting these goods and being deceived was so remote that the Chippeway Indians might have been left to take care of themselves.”

Moreover, the approach indicated by the decision in the KOKOKO case was incompatible with later decisions emphasising the local nature of the interests to be

protected in connection with applications for registration in the United Kingdom. The need to focus on local interests was stated in plain terms by Earl Loreburn in Bagots Hutton & Co. Ltd's Application (1916) 33 RPC 357 at 370;

“In any case, there can be no ground for saying that a trade mark, otherwise appropriate for registration here, should be denied registration because it may be unfairly used somewhere else or because other nations would be deceived by some local experience into identifying the goods of one firm with the goods of another when no one would be deceived here.”

Matters peculiar to the circumstances of trade in overseas territories have consistently been regarded as irrelevant to questions of eligibility for registration in the United Kingdom on the authority of this statement: see Al Bassam T.M. [1995] RPC 511 (CA) at 525, 526.

Accordingly, under the Trade Marks Act 1938, marks were eligible for registration if they were capable of functioning satisfactorily as trade marks in relation to goods or services supplied or to be supplied (Sections 17 and 68) in or from within (Section 31) the United Kingdom. If a mark was capable of functioning satisfactorily as a trade mark within those limits it qualified for registration in the United Kingdom, whether or not it would also have qualified for protection elsewhere: De Cordova v. Vick Chemical Company (1951) 68 RPC 103 (PC) at p.107 per Lord Radcliffe.

The Trade Marks Act 1994 gives effect to Council Directive No. 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks. In the 12th recital to the Directive it is noted that all Member States of the Community are bound by the Paris Convention and that “it is necessary that the provisions of this Directive are entirely consistent with those of the Paris Convention” The recital further

confirms that "the obligations of the Member States resulting from this Convention are not affected by this Directive". There is nothing in the Directive which could be taken to have altered the established position that national trade mark rights are territorially limited and granted independently of each other in accordance with the principles stated in Article 6 of the Paris Convention: IHT Internationale Heiztechnik GmbH (Case C-9/93) [1994] ECR I-2789 paras. 21 to 25. I think it is clear that when a sign is presented for registration under the 1994 Act, the question for consideration is whether it is capable of functioning satisfactorily as a trade mark in relation to goods or services supplied or to be supplied in or from within the United Kingdom: Sections 9(1), 10(4)(c) and 46(2) of the Act.

Community law recognises that as a result of linguistic, cultural and social differences a sign may be unprotectable in one country and yet protectable in another (although circumspection may be required in order to ensure that traders engaging in trade between Member States are not unjustifiably prevented from using words which function generically or descriptively in substantial parts of the Community): Fratelli Graffione SNC v. Ditta Fransa (Case C-313/94) [1996] ECR I-6039 paras. 22 et seq; Deutsche Renault AG v. Audi AG (Case C-317/91) [1993] ECR I-6227 paras. 21 et seq; Pfeiffer Grosshandel GmbH v. Löwa Warenhandel GmbH (Case C-255/97) 11 May 1999 paras. 20 et seq; Estée Lauder Cosmetics GmbH v Lancaster Group GmbH (Case C-220/98) 13 January 2000 paras. 27 et seq.

The trade mark in suit in the present case is not said to have been ineligible for registration in the context of trade between Member States. It appears to me that the Hearing Officer was right to determine the opposition by reference to the position in the

United Kingdom and not by reference to the position in Saudi Arabia. I therefore think he was right to regard the Opponent's evidence as essentially irrelevant to the question whether the trade mark in suit was eligible for registration in the United Kingdom. I see no basis upon which his decision to reject the opposition and permit registration can be faulted. The appeal is therefore dismissed and the Opponent is directed to pay the Applicant £400 in respect of its costs of the unsuccessful appeal.

Geoffrey Hobbs QC

11 February 2000

Ms M A Marshall of Messrs J A Kemp & Co appeared on behalf of the Applicant

Mr M Knight, Principal Hearing Officer, appeared on behalf of the Registrar of Trade Marks.