

O-231-15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3039266 BY
ZAMZAM DISTRIBUTORS LTD**

TO REGISTER:

The logo for 'Zam Zam' is written in a red, cursive script. Below the text is a horizontal underline consisting of a red line on top and a black line on the bottom, both slanted upwards from left to right.

**AS A TRADE MARK
IN CLASSES 29, 30 & 32**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 402299 BY
ABDUL BARAKAT MUHAMMAD MUHIB ULLAH,
MAHMUDUL HASAN, NAZMUL HASAN, BADRUL HASAN**

BACKGROUND & PLEADINGS

1. On 24 January 2014, ZamZam Distributors Ltd (“the applicant”) applied to register the trade mark shown on the cover of this decision for the following goods:

Class 29 - Meat, Poultry, Meat extracts, Preserved, frozen, dried and cooked vegetables, Sausages, Burgers, Frozen meat products, Frozen Chicken Kebabs, Frozen Meat Kebabs, Chicken Nuggets, Vegetable Samosas, Vegetable Pakora.

Class 30 - Samosas, Pies, Pasties, Spring rolls, curry, ice-cream.

Class 32 - Aerated juices; Cocktails, non-alcoholic; Energy drinks; Fruit beverages; Fruit beverages and fruit juices; Fruit juice; Fruit juice beverages (Non-alcoholic -); Fruit juice for use as a beverages; Fruit juices; Fruit nectars, non-alcoholic; Fruit-based beverages; Fruit flavoured beverages; Grape juice; Grape juice beverages; Juice (fruit); Juice (Fruit -); Non-alcoholic cocktail mixes; Non-alcoholic cocktails; Nonalcoholic fruit drinks; Non-alcoholic fruit extracts; Non-alcoholic fruit juice beverages; Orange juice; Orange squash; Pineapple juice beverages.

The application was published for opposition purposes on 14 March 2014.

2. The application is opposed by Abdul Barakat Muhammad Muhib Ullah, Mahmudul Hasan, Nazmul Hasan and Badrul Hasan (“the opponents”). The opposition, which is based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods in the application. The opponents rely upon the services shown below in trade mark registration no. 2334945 for the trade marks: **ZAMZAM** and **ZAM ZAM** (series of 2) applied for on 13 June 2003 and for which the registration procedure was completed on 9 January 2004:

Class 40 – Butchery, cooked foods (processing of-), cooked foods (treatment of-), food and drink preservation, food grinding, food milling, food preservation, food processing, food processing [other than cooking].

Class 43 - Provision of food and drink.

Having indicated that they have used these trade marks for the services shown above, the opponents state:

“The opposing marks are registered in block capitals and black lettering, therefore protecting all font/styles/types/stylised versions of the mark, and upper and lower case lettering. We submit that the registration also protects all colours and colour combinations of the word. The mark applied for clearly and solely comprises the identical words Zam Zam in red as the main and dominant element, underlined in black and red. The respective marks are therefore identical or similar.

It is submitted that, as the opposing registered marks cover

- (i) in addition to butchery, the preparation, processing, treatment and preservation of foods generally (in class 40), they cover the latter mentioned services in relation to and as part of the process of the provision of all the specific class 29 and 30 goods covered by the applicant's mark; and
- (ii) drink preservation (in class 40) they cover said services in relation to and for the purposes of the provision all of the specific class 32 goods covered by the applicant's mark; and
- (iii) provision of food and drink services (in class 43) they cover said services in relation to all of the specific class 29, 30 and 32 goods covered by the applicant's mark;

the respective services and goods are therefore identical and/or similar.

It is further submitted that, in view of all the above, the public and/or average consumers are likely to be confused into thinking that the mark applied for belongs to or is in some way connected with the opponent, and/or that the goods provided under the applicant mark are those of the opponent."

3. The applicant filed a counterstatement in which it asks the opponents to provide proof of use of the trade marks upon which they rely; a point to which I will return below. In its counterstatement, the applicant states:

"The opposition has been filed against the trade mark in classes 40 and 43 which are service related classes. It is therefore understood that the opposer was registering the trade mark for services related to the processes of preparation, processing, treatment and packaging of food. The applicant has applied to register for the trade mark on goods related classes 29, 30 and 32, which involve branding and selling of the already packaged goods. Furthermore we would like to object the opposition based on the rule 6A(3) of the Trade Marks Act for non-use of the trade mark (SI 2004/946) in particular to the products and classes were are registering for."

4. Neither party filed evidence, requested a hearing or filed written submission in lieu of attendance at a hearing.

DECISION

5. The opposition is based upon sections 5(1). 5(2)(a) and 5(2)(b) of the Act, which read as follows:

"5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

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

(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.”

6. 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.”

7. In these proceedings, the opponents are relying upon the registration shown in paragraph 2 above (which, although consisting of a series of two trade marks, I will refer to in the singular for the sake of convenience), and which qualifies as an earlier trade mark under the above provisions. As this trade mark completed its registration process more than 5 years before the publication date of the application in suit, it is, in principle, subject to proof of use, as per section 6A of the Act. In their Notice of opposition, the opponents state that their earlier trade mark has been used upon all the services upon which they rely and in its counterstatement the applicant indicated that it wanted the opponents to provide proof of use. Question 7 of the counterstatement is entitled “Request for proof of use”. Having indicated that it wanted the opponents to provide proof of use, there is a further question that the applicant needed to answer. This reads as follows:

“List of goods and/or services

List goods/services for which you require “proof of use”...

Note: If more than one trade mark is being relied upon by the opponent or cancellation applicant, please provide the number(s) of the trade mark(s) for which you would like the other party to provide proof of use”.

8. In the space allowed for the applicant to respond to the above, it entered the following “ZamZam”. In a letter to the applicant dated 19 August 2014, the Tribunal stated:

“At question 7 on the TM8 you need to list the trade mark *number* being relied on by the opponent, and you must also list the goods and services for which you require proof of use.

In light of the preliminary view expressed above, you are invited to file an amended counterstatement, on or before **9 September 2014**. If you choose not to amend the counterstatement the Registrar may move to strike out any grounds which are not adequately particularised.”

9. A reminder letter was sent to the applicant on 17 September 2014, following which, on 14 October 2014, the Tribunal issued a letter to the applicant in which it stated:

“**Please note**, you requested that the opponent provides proof of use. However, I received no response to my letters of 19 August 2014 and 17 September 2014 which requested that further information be provided for Question 7 of the TM8. Therefore, in order to progress the opposition, the opponent will not be expected to provide proof of use.”

10. Although the Tribunal’s reference to the applicant having to specify the trade mark number being relied upon by the opponents is clearly in error (the opponents are only relying on one earlier trade mark), the request for it to specify the services upon which it wanted the opponents to provide proof of use was not without merit. That is because in its counterstatement, the applicant only specifically mentions the opponents’ services in class 40 and, insofar as the proof of use regulations are concerned, it refers to the opponents providing proof of use in relation to “the products and classes [the applicant] is registering for.” Having sought clarification in the official letter of 19 August 2014 and having given the applicant a further opportunity to clarify its position in the official letter of 17 September 2014, it was not inappropriate in my view, given the need for the Tribunal to deal with cases in a timely manner, for the Tribunal to adopt the approach it did. As a consequence, the opponents are entitled to rely upon all of the services they claim.

Sections 5(1) and 5(2)(a) – case law

11. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

Section 5(2)(b) – case law

12. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98,

Matratzen Concord GmbH v OHIM, Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

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 be dominated by one or more of its components;

(f) however, it is also 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 great 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing process

13. As the case law above indicates, it is necessary for me to determine who is the average consumer for the respective parties' goods and services; I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

14. The opponents' services consist of butchery and a range of food processing, treatment, preservation, grinding and milling services in class 40 and services relating to the provision of food and drink in class 43, whereas the applicant's specifications consist of a range of food and drink products in classes 29, 30 and 32. The average consumer of all the applicant's goods and the opponents' services in class 43 is a member of the general public, whereas the opponents' services in class 40 are, in my view, more likely to be provided to businesses rather than the general public.

15. As to how these goods and services will be selected, my own experience tells me that as all of the applicant's goods are most likely to be the subject of self selection from the shelves of a retail establishment such as a supermarket or from the pages of a website, visual considerations are likely to dominate the selection process. Similar considerations will apply to the opponents' services in class 43 which will, for example, be selected from signage on the high street and from articles and advertisements in magazines and on websites. However, as the applicant's goods and (more frequently in my experience) the opponents' services in class 43 may be the subject of, for example, radio advertisements and oral recommendations, aural considerations must not be lost sight of. Although I have no experience of how the opponents' services in class 40 will be selected and no evidence or submissions to assist me, it is inevitable that both visual and aural considerations will play their part, although I am uncertain to what extent one may dominate the other.

16. In relation to the degree of care the average consumer will pay when selecting the various goods and services at issue, as all of the applicant's goods are inexpensive, everyday purchases, I would not expect the average consumer to pay more than a normal degree of attention to their selection. While the same may be true of the opponents' services in class 43, as the cost and importance of selecting, for example, a restaurant can vary widely, I would expect the average consumer to pay more attention when selecting a venue to hold, for example, a birthday meal, than they would to selecting a mobile caterer from which to purchase a burger or cup of coffee. Finally, insofar as the opponents' services in class 40 are concerned, in

view of the obvious importance to a business of selecting the most appropriate company to handle its food processing requirements, a process which may well include, for example, meetings, site visits, tendering arrangements etc., and in which not insignificant sums are likely to be involved, I would expect the average consumer to pay a fairly high degree of attention during the selection process.

Comparison of goods and services

17. The competing goods and services are as follows:

Opponents' services relied upon	Applicant's goods
<p>Class 40 – Butchery, cooked foods (processing of-), cooked foods (treatment of-), food and drink preservation, food grinding, food milling, food preservation, food processing, food processing [other than cooking].</p> <p>Class 43 - Provision of food and drink.</p>	<p>Class 29 - Meat, Poultry, Meat extracts, Preserved, frozen, dried and cooked vegetables, Sausages, Burgers, Frozen meat products, Frozen Chicken Kebabs, Frozen Meat Kebabs, Chicken Nuggets, Vegetable Samosas, Vegetable Pakora.</p> <p>Class 30 - Samosas, Pies, Pasties, Spring rolls, curry, ice-cream.</p> <p>Class 32 - Aerated juices; Cocktails, non- alcoholic; Energy drinks; Fruit beverages; Fruit beverages and fruit juices; Fruit juice; Fruit juice beverages (Non-alcoholic -); Fruit juice for use as a beverages; Fruit juices; Fruit nectars, non-alcoholic; Fruit-based beverages; Fruit flavoured beverages; Grape juice; Grape juice beverages; Juice (fruit); Juice (Fruit -); Non-alcoholic cocktail mixes; Non-alcoholic cocktails; Nonalcoholic fruit drinks; Non-alcoholic fruit extracts; Non-alcoholic fruit juice beverages; Orange juice; Orange squash; Pineapple juice beverages.</p>

The case law relating to similarity of goods and services

18. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

19. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] 11 R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

20. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

21. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

22. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of

activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

23. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

24. In trade mark decision BL O-198-12 (a link to which can be found at <https://www.ipo.gov.uk/t-challenge-decision-results/o19812.pdf>), the Hearing Officer had to consider whether there was any similarity between:

“Services for providing food and drink; restaurant, bar and catering services”,

in class 43 and a wide range of, inter alia, goods in classes 29 and 30. Having concluded that:

“17...The opponent’s term services for providing food and drink is a wide term which encompasses restaurants, cafés, takeaway services and the preparation of drink”,

the Hearing Officer stated:

“18. In comparing goods with services (the opponent only has cover for services), there is, of course, a difference between the nature of a good and the nature of a service, which also affects the method of use comparison. Goods and services can, however be complementary, share channels of trade

and they can be in competition with one another. This is particularly pertinent when considering services which provide food and drink, against food and drink goods which have been prepared. Takeaway services are within the scope of the opponent's services. A takeaway service is complementary to the takeaway, which is a prepared meal. The supply of the goods is essential to the supply of the services; the purpose of both the takeaway and the service is to satiate hunger or thirst; the channel of trade will be the same, and the users will be the same. In relation to restaurants and bars, consumers have a choice whether to visit an establishment where they can eat and/or drink, or they can buy a prepared meal and/or drink and take it home: the users are the same, the goods and services have the same purpose, but this time the goods and services are in competition. There is a high degree of similarity between the opponent's services and the following goods of the application which are either specified as prepared meals or drinks, or are in the nature of prepared meals or desserts for taking away (such as chips, soups, pasties, doughnuts and ice cream):"

25. Having identified a wide range of goods within classes 29 and 30 which she considered to be highly similar on the basis indicated above, the Hearing Officer went on to consider the following goods:

Meat, fish, seafood, poultry and game, all in prepared form; constituents for meals; meat extracts; fruits and vegetables, all being preserved, dried or cooked; cheese; jellies, jams; yoghurts; eggs; milk, milk preparations; sausages; edible oils and fats; olive oil; all being Halal products.

Bakery products including bread, pitta bread; burger buns; pasta; rice; noodles; spices, salt; corn chips, tortillas, tacos; custard; gravy mixes; puddings; coffee, tea, cocoa, sugar, tapioca, sago, artificial coffee; all being Halal products.

In relation to these goods, the Hearing Officer concluded:

20...Although the listed meat, fish, seafood, poultry and game is all in prepared form, I do not consider that this equates to prepared meals; more that it signifies goods in their raw form which have been (for example) filleted, de-scaled, or had the feathers removed. With the exception of corn chips which are more like crisps, all the goods which I have listed in this final category are in the nature of ingredients or goods to which other food goods are added; none of the listed goods are in the nature of prepared meals and so are not in competition or are complementary to takeaway, bar or restaurant services (as opposed to prepared meals and drinks). In relation to catering services, which would be understood by the average consumer as the provision of cooked or prepared meals and drink at a function or event, even then I think it unlikely that there is a complementary relationship in such a way that consumers may think that the same undertaking is responsible for both supplying the unfinished 'raw' food goods (e.g. milk, eggs, meat) and the service. There is no shared nature, purpose or channel of trade, nor meaningful level of complementary or competitive relationship with the goods

listed in this paragraph. There is no similarity between these goods and the opponent's services."

26. I also note that in trade mark decision BL O-299-14 (a link to which can be found at <https://www.ipo.gov.uk/t-challenge-decision-results/o29914.pdf>), a different Hearing Officer had a similar comparison of goods and services to perform to that in BL O-198-12 (to which he referred with approval). However, he also had to consider the degree of similarity between:

"Restaurant services; accomodation services; hotel, motel, bar, cafe, inn, public house and pub services; banqueting and catering services; provision of facilities for the consumption of alcoholic and non-alcoholic beverages; provision of facilities for meetings, seminars, conferences and banquets, and for exhibitions; hotel accomodation reservation services"

in class 43 and, inter alia,

"Beers; ales; mineral and aerated waters; non-alcoholic drinks; fruit drinks; fruit juice; syrups for making beverages; smoothies; non-alcoholic beers and wines",

in class 32. He stated:

"19) In respect of the applicant's beers; ales; mineral and aerated waters; non-alcoholic drinks; fruit drinks; fruit juice; ...; smoothies; non-alcoholic beers and wines, these are all similar to the opponent's bar, café [including licensed cafes], inn, public house and pub services. All these services involve the supply of alcoholic and non-alcoholic beverages, often as the primary purpose. In respect of both the goods and the services, the average consumer is likely to be the same. The purpose of both alcoholic and non-alcoholic beverages and the establishments providing the opponent's services are both to quench thirst and/or, in the case of alcoholic beverages, to seek the intoxication effect of alcohol. Consumers can chose to drink at home or on the premises of an establishment and consequently there is an element of competition between beverages and bar, café, inn, public house and pub services. As these establishments require beverages to ply their trade, the respective goods and services are also complementary."

27. As I agree with the approach the different Hearing Officers adopted and the conclusions they reached, I shall adopt the same approach here. I should begin by saying that as the applicant is seeking registration in relation to goods and as the opponents are only relying upon their trade mark in relation to the services mentioned, there is, in my view, no question of the goods/services being considered identical. As mentioned above, the phrase "provision of food and drink" in the opponents' specification in class 43 is a wide term which would include, for example, restaurants, cafés, bar, public house, catering and takeaway services. Applying the rationale in the decisions shown above to the goods in the applicant's specifications, I find that:

Burgers, Chicken Nuggets, Vegetable Samosas and Vegetable Pakora (in class 29)

Samosas, Pies, Pasties, Spring rolls, curry and ice-cream (in class 30) and;

Aerated juices; Cocktails, non-alcoholic; Energy drinks; Fruit beverages; Fruit beverages and fruit juices; Fruit juice; Fruit juice beverages (Non-alcoholic -); Fruit juice for use as a beverages; Fruit juices; Fruit nectars, non-alcoholic; Fruit-based beverages; Fruit flavoured beverages; Grape juice; Grape juice beverages; Juice (fruit); Juice (Fruit -); Non-alcoholic cocktail mixes; Non-alcoholic cocktails; Nonalcoholic fruit drinks; Non-alcoholic fruit extracts; Non-alcoholic fruit juice beverages; Orange juice; Orange squash; Pineapple juice beverages (in class 32),

are similar to a high degree to the opponents' services in class 43.

Also for the reasons indicated above, I find that:

Meat, Poultry, Meat extracts, Preserved, frozen, dried and cooked vegetables, Sausages, Frozen meat products, Frozen Chicken Kebabs, Frozen Meat Kebabs,

are not similar to the opponents' services in class 43.

28. Having reached those conclusions, it is now only necessary for me to compare those goods of the applicant I have found not to be similar to the opponents' services in class 43 with the opponents' services in class 40. For the sake of convenience, that comparison is as follows:


Opponents' services in class 40	Applicant's remaining goods in class 30
Butchery, cooked foods (processing of-), cooked foods (treatment of-), food and drink preservation, food grinding, food milling, food preservation, food processing, food processing [other than cooking]	Meat, Poultry, Meat extracts, Preserved, frozen, dried and cooked vegetables, Sausages, Frozen meat products, Frozen Chicken Kebabs, Frozen Meat Kebabs

29. The opponents' services in this class consist of butchery and a range of food processing, treatment, preservation, grinding and milling services which, as I indicated above, in my view, are more likely to be provided to businesses rather than the general public, who are the average consumer of the applicant's goods. Applying the guidance mentioned above, the nature, intended purpose and method of use of the competing goods and services are clearly different; equally, the goods and services are not in competition. However, it is inescapable that the remaining goods in the applicant's specification are (along with a range of other food products), either essential for or the result of the provision of the opponents' services. To that extent, there exists a symbiotic relationship between them. As the decision in *Sanco* indicates, goods and services may be considered to be complementary (and as a consequence similar to a degree) even where the nature and intended purpose may

be quite different. Although I have no evidence or submissions to assist me in assessing whether the relevant public are liable to believe that the responsibility for the competing goods and services lies with the same undertaking or with economically connected undertakings (my initial impression is that it is unlikely), in light of my comments above, I am not prepared to conclude that there is no similarity between the goods and services I have identified, and will proceed on the basis that there is (at least) a very low degree of similarity between the opponents' services in class 40 and the remaining goods in the applicant's specification in class 30.

Comparison of trade marks

30. The competing trade marks are as follows:

Opponents' trade marks	Applicant's trade mark
ZAMZAM ZAM ZAM (Series of 2)	

The opposition based upon sections 5(1) and 5(2)(a) of the Act

31. The provisions of section 5(1) are cumulative i.e. the competing trade marks and the competing goods and services must be identical. Having already concluded that none of the opponents' services are identical to the applicant's goods, the opposition based upon section 5(1) of the Act fails and is dismissed accordingly.

32. Insofar as section 5(2)(a) is concerned, the guidance in *Sadas* is relevant when determining if the competing trade marks are identical. In reaching a conclusion, I shall base my comparison on the second of the opponents' trade marks which, like the applicant's trade mark, is presented as two separate words; if the opponents do not succeed in relation this trade mark they will be in no better position in relation to their first trade mark which is presented as a single word. In *Specsavers International Healthcare Ltd & Others v Asda Stores Ltd* [2012] EWCA Civ 24 at [96] Kitchin LJ stated:

“A mark registered in black and white is, as this court explained in *Phones 4U* [2007] R.P.C. 5, registered in respect of all colours.”

33. Keeping in mind the above guidance as well as the opponents' comments in relation to the extent of protection it considers its earlier trade mark enjoys, I find that the competing trade marks are not identical. In reaching this conclusion, and while I agree that the opponents would be notionally entitled to present their ZAM ZAM trade mark in, for example, a range of colours, typefaces etc., this notional use would not, in my view, extend to the form in which the applicant's trade mark is presented, which also includes a device element (which although clearly subordinate to the words Zam Zam is certainly not negligible within the context of the trade mark as a whole). The same logic explains why these differences would not go unnoticed by the average consumer and, as a consequence, why the applicant's trade mark does

not fall foul of the test in *Sadas*. As the competing trade marks are not, in my view identical, the opposition based upon section 5(2)(a) of the Act must also fail.

The opposition based upon section 5(2)(b) of the Act

34. I must now compare the trade marks for the purposes of the opposition based upon section 5(2)(b) of the Act. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

35. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

36. Although I have found that the competing trade marks are not identical for the purposes of sections 5(1) and 5(2)(a) of the Act, the fact that both trade marks consist either exclusively of the words ZAM ZAM presented in upper case or contains these words presented in title case in red, inevitably leads to a very high degree of visual similarity and, as the device element in the applicant's trade mark will not be verbalised when its trade mark is referred to, aural identity. Although I am not aware that the words ZAM ZAM have any meaning; if they do, the competing trade marks are conceptually identical. Considered overall, although not identical, the competing trade marks are similar to a very high degree.

Distinctive character of the opponents' ZAM ZAM trade mark

37. The distinctive character of a trade mark can be appraised only, first, by reference to the services 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 services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In reaching a conclusion, I have only the inherent characteristics of the opponents' trade mark to consider. As I mentioned earlier, as far as I am aware, ZAM ZAM has no meaning in relation to the services upon which

the opponents rely in these proceedings. In my view, it will be treated by the average consumer as invented and, as a consequence, is possessed of a high degree of inherent distinctive character.

Likelihood of confusion

38. 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 services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponents' 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 and services, 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. Earlier in this decision I concluded that:

- the average consumer is either a member of the general public or a business user who will select the goods and services by a mixture of visual and aural means (with the visual component dominating in relation to the majority of the goods and services at issue) and who will (in the main) pay no more than a normal degree of attention whilst doing so;
- the majority of the competing goods and services are similar to a high degree, whilst some are only similar to (at least) a very low degree;
- whilst not identical, the competing trade marks are, when considered overall, similar to a very high degree;
- the opponents' earlier trade mark is possessed of a high degree of inherent distinctive character.

39. Having concluded that the majority of the applicant's goods are similar to the opponents' services to a high degree and that others are similar to (at least) a very low degree, I am satisfied that even in relation to those goods I have characterised as having (at least) a very low degree of similarity, the high degree of similarity in the competing trade marks and the highly distinctive nature of the opponents' earlier trade mark will lead to a likelihood of direct confusion i.e. where one trade mark is mistaken for the other. For the avoidance of doubt, I should also say that it matters not that I have reached these conclusions in relation to an average consumer who will (in the main) pay no more than a normal degree of attention during the selection process, as I would have reached the same conclusions had I characterised the degree of attention paid during the selection process in relation to all the goods and services at issue as high. Simply put, the competing trade marks are so similar that even in those circumstances, the average consumer would not, in my view, be able to distinguish between them.

Overall conclusion

40. The opposition succeeds and, subject to any successful appeal, the application will be refused.

Costs

41. The opponents have been successful and are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, but bearing in mind that neither party has been professionally represented, I award costs to the opponents on the following basis:

Preparing a statement and considering the applicant's statement:	£100
--	------

Opposition fee:	£100
-----------------	------

Total:	£200
---------------	-------------

42. I order ZamZam Distributors Ltd to pay to Abdul Barakat Muhammad Muhib Ullah, Mahmudul Hasan, Nazmul Hasan and Badrul Hasan (jointly) the sum of **£200**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of May 2015

C J BOWEN
For the Registrar
The Comptroller-General