

O-527-18

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3210287

BY EMIRATES DELIGHTS MARKETING CO.

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 29:

AL AQSA DATES

تمور الاقصى

AND

OPPOSITION THERETO UNDER NO. 409163

BY GOODIES FOODS LTD

Background and pleadings

1. The above trade mark was filed by Emirates Delights Marketing Co. (“the applicant”) on 02 February 2017. It was published for opposition purposes on 14 April 2017. Registration of the mark is opposed by Goodies Foods Ltd (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on UK Trade mark (“UKTM”) registration 3088554, which was filed on 08 January 2015 and registered on 17 April 2015. This case therefore involves a conflict between the following marks and goods:

Applied for mark	Earlier mark
<p>AL AQSA DATES تمور الاقصى</p> <p>Class 29: Dates</p>	<p>AL AQSA الأقصى</p> <p>Class 29: Dates; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; potato crisps.</p> <p>Class 31: Horticultural and forestry products; fresh fruits and vegetables, seeds, natural plants and flowers; foodstuffs for animals; malt; food and beverages for animals; Raw dates, fresh dates, unprocessed dates.</p>

2. In its notice of opposition, the opponent contends that the applied for mark is similar to the earlier mark and that the goods for which the applied for mark is seeking protection are either identical and/or similar to the goods and services covered by the

earlier mark. The opponent further contends that there exists a likelihood of confusion on the part of the public including a likelihood of association.

3. The applicant filed a counterstatement in which it admits that the marks are similar and that the goods are identical or similar, but denies that a likelihood of confusion exists.

4. The applicant is represented by Beck Greener. The opponent is not represented. Neither party filed evidence or written submissions, nor did they ask to be heard.

Section 5(2)(b)

5. Section 5(2)(b) of the Act states that:

“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.”

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 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 opponent is relying upon the trade mark referred to in paragraph 1 above, which qualifies as an earlier trade mark under section 6 of the Act outlined above. As the opponent’s earlier mark had not completed its registration process more than five years before the publication date of the applied for mark, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods for which its earlier mark is registered.

8. The following principles are gleaned from the judgment 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 C3/03, *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.

(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 the 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.

Comparison of goods

9. It is self-evident that “dates” in the applicant’s specification are identical to “dates” in the opponent’s specification. The parties’ goods are identical.

The average consumer and the nature of the purchasing act

10. As principle (b) in paragraph 8 above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. 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.”

11. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

12. The only goods at issue in this case are dates. The average consumer for these goods is a member of the general public. The goods are inexpensive and purchased fairly frequently, for example during a weekly shop. The purchase is likely to be primarily visual: the goods are likely to be selected from physical stores or websites. However, I do not discount that there may be an aural element. I bear in mind that the average consumer is likely to consider, for example, the quality and origin of the goods in question and whether they are organic or not. I find that, taking all of these factors into account, the level of care and consideration that will be adopted during the purchasing process will be average.

Comparison of marks

13. It is clear from *Sabel BV v Puma AG* 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 their overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

14. It would be wrong, therefore, to artificially 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.

15. The trade marks to be compared are as follows:

Applied for mark	Earlier mark
<p data-bbox="272 757 707 808">AL AQSA DATES</p> <p data-bbox="344 842 639 909">تمور الاقصى</p>	<p data-bbox="946 752 1262 815">AL AQSA</p> <p data-bbox="963 837 1235 913">الأقصى</p>

16. The opponent made submissions regarding the comparison of the marks, which I will refer to where relevant. The applicant did not make reference to the overall impression or the components of the marks within its counterstatement but did submit that the marks are similar.

Overall impression

17. The applicant's mark consists of the words "AL AQSA DATES", presented in capital letters in a standard typeface. Underneath are what appear to be Arabic script elements. "DATES" is purely descriptive of the only goods for which this mark seeks protection and consequently, does not play a significant role in the overall impression. I consider that the words "AL AQSA" have the greatest impact in the overall impression, given their size and position and the fact that they are the only non-descriptive part of the mark which the average consumer will be able to identify. The average consumer in the UK is unlikely to be familiar with the meaning of the words presented in Arabic script. However, they are not negligible and do contribute to the overall impression, but to a lesser extent than the words "AL AQSA".

18. The opponent's mark consists of the words "AL AQSA", presented in capital letters in a standard typeface. Underneath are what appear to be Arabic script elements. The opponent has submitted that the words "AL AQSA" are the "key distinctive and dominant element". I agree with this submission. The words "AL AQSA" have the greatest impact in the overall impression, given their size and position. Again, a lesser role is played by the Arabic script elements which are positioned in a subservient position and are unlikely to be understood by the average UK consumer, but will be noticed within the mark as a whole.

Visual comparison

19. Visually, both marks begin with the words "AL AQSA", which in both cases is presented above Arabic script. The first element of the script is the same in each mark, differing only in its typeface. The only differences in the marks are the addition of the word "DATES" in the application and a second word in Arabic script below the words "AL AQSA DATES". I consider the two marks in question to be visually similar to a very high degree.

Aural comparison

20. In terms of aural similarity, I believe that both marks will be referred to simply as "AL AQSA". When spoken aloud, the average consumer is likely to pronounce the same words, "AL AQSA", in both marks as "al-ak-sah". Even if I am wrong in this pronunciation, the average consumer will pronounce both marks in the same way. The average consumer may or may not pronounce the word 'dates' in the applicant's mark, although the latter is more likely. The average UK consumer will be unlikely to speak Arabic and will therefore not attempt to pronounce the Arabic script elements of either mark.

21. There are two conclusions I could reach in respect of the aural similarity. The most likely scenario is that both marks would be referred to as "AL AQSA", rendering them aurally identical. Alternatively, if the word 'dates' is pronounced in the applicant's mark, I would consider the marks to be aurally similar to a high degree.

Conceptual comparison

22. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the General Court (“GC”) and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29. The assessment must be made from the point of view of the average consumer.

23. The opponent submits that the words “AL AQSA” relate to “the great mosque in Jerusalem”. The average consumer cannot be assumed to know the meaning of everything. In the *Chorkee* case (BL O-048-08), Anna Carboni, sitting as the Appointed Person, stated in relation to the word CHEROKEE:

“36. ...By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one’s own personal experience, knowledge and assumptions are more widespread than they are.

24. The opponent has not filed evidence in support of its submissions that AL AQSA refers to a specific mosque and I cannot conclude that the average consumer in the UK would be familiar with such a meaning. In my view, the “AL AQSA” part of both marks will be seen as invented words or possibly words from another language with which the average consumer is not familiar. The “DATES” element in the application will simply be seen as a description of the goods and not part of the mark which gives any indication of the undertaking responsible for those goods. I therefore conclude that the marks are conceptually neutral.

Distinctive character of the earlier trade mark

25. The degree of distinctiveness of the earlier mark must be assessed. This is because, as per principle (h) in paragraph 8 above, the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph

24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

26. As no evidence has been filed by the opponent, I have only the inherent distinctiveness of the earlier mark to consider.

27. In relation to the words in another language, I refer to *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04. In the context of the assessment of distinctiveness for the purposes of registration, the CJEU held that the distinctive character of a trade mark must be assessed from the perspective of the relevant public in the territory in which registration is sought. The same must apply to the assessment of the distinctive character of trade marks for the purposes of assessing whether there is a likelihood of confusion between them: see *Matratzen Concord AG v OHIM*, Case T-6/01.

28. Whilst that decision made a finding in respect of an EUTM, the same principle applies to UK registrations for marks which include words in another language. I must make an assessment based on the average consumer, who, for these purposes, is the average consumer in the UK. I am of the view that “AL AQSA” has no meaning in the English language. No evidence has been provided to show that the relevant public in the UK will be aware that the words relate to a mosque in Jerusalem. Therefore, I find that the average consumer will either perceive “AL AQSA” as an invented word, or they will consider it to be a word of another language, with which they are not familiar. As a result, I am of the view that the earlier mark is inherently highly distinctive.

Likelihood of confusion

29. 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 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.

30. Earlier in this decision I found that:

- The average consumer is a member of the general public, who will select the goods primarily by visual means (though I do not discount an aural component) and who will pay, in the main, an average degree of attention to their selection;
- The goods are identical;

- The marks are visually similar to a very high degree, aurally identical (or aurally similar to a high degree where the average consumer articulates the word ‘dates’) and conceptually neutral;
- The opponent’s mark is inherently highly distinctive.

31. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C., sitting as the Appointed Person, pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

32. As I have found above, the most distinctive element of both marks at issue here is ‘AL AQSA’. The same element is found at the beginning of both marks and is the part by which the average consumer will refer to and remember the parties’ goods. Taking these factors into account, I find that the average consumer having encountered either one of the parties’ marks will, on encountering the other, be directly confused, simply believing them to be the same undertaking.

Conclusion

33. There is a likelihood of direct confusion. **The opposition succeeds.**

Costs

34. As the opponent has been successful, it would, ordinarily, be entitled to an award of costs in its favour. As the opponent is unrepresented, at the conclusion of the evidence rounds the tribunal invited it to indicate whether it intended to make a request for an award of costs and, if so, to complete a pro-forma indicating a breakdown of its actual costs. It was made clear to the opponent that if the pro-forma was not completed “no costs, other than official fees arising from the action and paid by the successful party...will be awarded”. Since the opponent did not respond to that invitation within the timescale allowed (nor has any response been received from the opponent prior to the date of the issuing of this decision), each party will bear its own costs, save for the official fee of £100.

35. I order Emirates Delights Marketing Co. to pay Goodies Foods Ltd the sum of **£100**. 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 23rd day of August 2018

Emily Venables

For the Registrar,

The Comptroller-General