

O/591/20

TRADE MARKS ACT 1994

**IN THE MATTER OF THE APPLICATION FOR TRADE MARK NO. 3402074
IN THE NAME OF LONDON TRAVEL CENTRE LTD FOR THE TRADE MARK**

LONDON HAJJ AND UMRAH

IN CLASSES 39 AND 43

AND

THE OPPOSITION THERETO UNDER NUMBER 418201

BY

ALI JAFARI-FINI

Background

1. On 25 May 2019, London Travel Centre Ltd (“the applicant”) applied for the trade mark LONDON HAJJ AND UMRAH for the following services:

Class 39: Travel Agency services for arranging Airline Tickets, Visas, arranging holidays, arranging ground transportation.

Class 43: Arranging accommodation for pilgrims, for holidays, for business travellers.

2. The application was published for opposition purposes in the *Trade Marks Journal*, on 26 July 2019. Ali Jafari-Fini opposes the application under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The section 5(2)(b) ground is based upon the following earlier registered marks which Mr Jafari-Fini owns:

(i) 2398755 (filing date: 5 August 2005; registered 28 November 2008)

HAJ AND UMRA

HAJ & UMRA

(series of two marks)

Class 39: Travel arrangement services.

Class 43: Provision of temporary accommodation.

(ii) 2391203 (filing date: 6 May 2005; registered 4 November 2005.)

haj & umra
TRAVEL LIMITED

Haj & Umra
TRAVEL LIMITED

(series of 2 marks)

Class 39: Travel arrangement services.

Class 43: Provision of temporary accommodation.

(iii) 2391202 (filing date: 6 May 2005; registered 4 November 2005.)



Class 39: *Travel arrangement services.*

Class 43: *Provision of temporary accommodation.*

3. Mr Jafari-Fini claims that the parties' services are identical and the marks are highly similar, the combination of which will lead to a likelihood of confusion. The same three earlier registrations are relied upon for the section 5(3) ground. Mr Jafari-Fini claims that the reputation of the earlier marks would mean that use of the applicant's mark would cause the public to believe that the marks are used by the same or an economically linked undertaking; and, further, that the use would cause detriment to the distinctive character and repute of the earlier marks and give the applicant an unfair advantage.

4. Mr Jafari-Fini made a statement of use in respect of his earlier marks as they had been registered for five years or more on the date on which the contested application was filed (section 6A of the Act refers).

5. Mr Jafari-Fini's section 5(4)(a) ground is based upon his goodwill resulting from the use of signs corresponding to the earlier registrations, which he states have been used in the UK since 1993 in relation to *travel agency services; travel advice services; travel arrangement; provision of temporary accommodation; booking of hotels; booking flights; arranging visas; arranging hotels; arranging ground transportation; booking coaches; arranging pilgrimages; arranging holidays*. Mr Jafari-Fini claims that use of the application would be liable to be prevented under the law of passing off, as the similarity between the signs and the application would cause misrepresentation and damage to his business.

6. The applicant filed a notice of defence and counterstatement, denying the grounds and putting Mr Jafari-Fini to proof that he has made genuine use of the earlier marks in relation to the registered services. In particular, the applicant states that:

- HAJJ and UMRA in the applicant's mark is generic and non-distinctive. It states that Mr Jafari-Fini's unusual spelling of "haj" and "umra" would not go unnoticed by the average consumer for the services.
- The applicant has due cause to apply to register its mark.

7. Both sides filed evidence, and Mr Jafari-Fini filed submissions alongside his first set of evidence. Neither party requested a hearing and neither filed written submissions in lieu of a hearing. Mr Jafari-Fini is represented by Lewis Silkin LLP. The applicant is represented by Brand Protect Limited. I make this decision after a careful reading of all the papers filed by the parties.

Relevant dates

8. As the earlier marks relied upon for the grounds under section 5(2)(b) and 5(3) of the Act had been registered for more than five years on the date on which the contested application was filed, Section 6A of the Act applies, which states:

“6A (1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),
 (b) or (ba) in relation to which the conditions set out in section 5(1), (2)
 or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed
 before the start of the relevant period .

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

9. The relevant period for proof of use of the marks is 26 May 2014 to 25 May 2019. The relevant date for the assessment of the section 5(2)(b) and 5(3) grounds is the date on which the contested application was filed: 25 May 2019.

10. The applicant has not provided any evidence that it was trading prior to the date on which it filed its application. Therefore, the application date, 25 May 2019, is the relevant date at which Mr Jafari-Fini must demonstrate that he owned sufficient goodwill in the business identified by the three signs relied upon, in relation to the services relied upon, for the purposes of section 5(4)(a) of the Act.

Evidence

11. The opponent’s evidence comes from Mr Jafari-Fini. His two witness statements are dated 3 February 2020 and 13 August 2020. The first statement deals with the use of his earlier marks. The second witness statement deals with the allegations made by the applicant, in a witness statement from Mr Mohammad Jamshaid, dated 16 February 2020, regarding the use by Muslims of the words Hajj and Umrah as the names of holy pilgrimages in the Islamic faith.

12. Mr Jafari-Fini states that he has been the Managing Director and proprietor of Haj and Umra Travel Company Limited (“the company”) since 1997, having joined the company, a family business, the previous year. He states that he is the holder of the trade marks for the company. Mr Jafari-Fini explains that the aim of the business is to provide Islamic pilgrimage and travel services. It was the first such ATOL-protected business to offer pilgrimage packages from the UK (since 1993), including flights and accommodation.¹

¹ Copies of the company’s ATOL and IATA certificates are shown in Exhibits AJF7 and AJF8.

13. Mr Jafari-Fini states that, in 2005, he decided to protect the name Haj and Umra as no one was using the same name or had attempted to register the trade mark. Mr Jafari-Fini applied for the stylised and composite marks initially and states that, as these mark achieved registration relatively quickly, he also decided to apply for the word version (as a series of two marks). Mr Jafari-Fini states that the Intellectual Property Office raised a late objection against his word-only application (2398755), but that the application was later accepted on the basis of distinctiveness acquired through use.

14. The following turnover figures are provided:

Year	£
2014	2,466,383
2015	2,517,281
2016	1,217,467
2017	1,400,053
2018	1,314,523

15. There are no advertising figures because Mr Jafari-Fini states that the company relies upon customer satisfaction, recommendations, reviews, a website, brochures and social media presence. Figures for the number of travellers who have used the company's services are given as 1325 in 2014; 1219 in 2015; 905 in 2016; 778 in 2017; and 793 in 2018. There are over 8000 subscribers to the email mailing list and over 25,000 clients registered on the company database.

16. Mr Jafari-Fini states that the company prints 15,000 to 20,000 brochures every year which are distributed to mosques, Islamic centres and clients in all major cities across the UK. Some examples are provided at Exhibit AJF4, from 1994 to 2019. The content is all much the same, throughout the years. Details are given of the pilgrimage tour itineraries, with prices. For example, the 2017 Hajj brochure says:

HAJJ TOURS

Hajj is a Holy Pilgrimage. It is one of the pillars of Islam and must be performed by all Muslims, if physically and mentally fit and financially able to afford the journey.

HAJ & UMRA TRAVEL LIMITED

Has over 50 years experience in organising HAJJ & UMRAH Tours. Our tours are tailored to take care of all the planning associated with travelling abroad, so you the passenger can spend your time at ziyarat and prayers during your stay in Saudi Arabia. Our experienced staff will accompany you at each stage of the trip to make sure that everything runs as smoothly as possible.

AND WE WILL MOST CERTAINLY TRY YOU WITH SOMEWHAT OF FEAR AND HUNGER AND LOSS OF PROPERTY AND LIVES AND FRUITS; AND GIVE GOOD NEWS TO THE PATIENT.

Holy Qur'an, Sura II, 155

FOR HAJJ – ARE THE WELL KNOWN MONTHS, SO WHOEVER INTENDS TO PERFORM HAJJ, THERE SHALL BE NO OBSCENITY, NOR WICKEDNESS, NOR WRANGLING DURING HAJJ, AND WHATEVER YOU DO, ALLAH KNOWS IT; AND MAKE PROVISION, BUT THE BEST OF PROVISIONS IS RIGHT CONDUCT, SO FEAR ME, O MEN OF UNDERSTANDING.

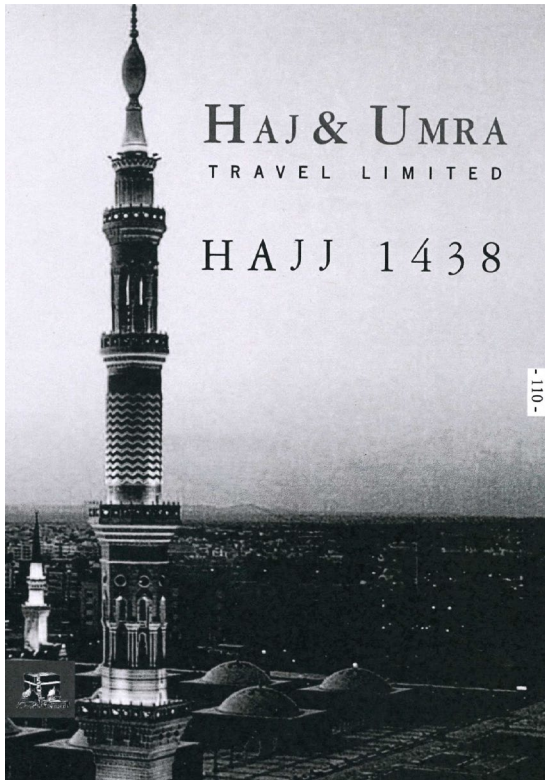
Holy Qur'an, Sura II, 197

ALL TOURS INCLUDE

Return air fares from London - All accommodation is fully air-conditioned - Round transfers by air-conditioned coaches, as per itinerary - Mina, Arafat, Mozdalifah and ziyarat in Madinah - Religious guides - Application for Visa - Meals in Mina and Arafat as per itinerary - Mattress, pillow and sleeping bags are provided in Mina - Pre Hajj reception - DVD and guide books.



17. During the relevant period for proof of use, the mark has appeared in the brochures as shown in the two examples below. There is no use of the composite mark in the brochures during this period.



Hajj 2017 brochure.

haj & umra
TRAVEL LIMITED

UMRAH 2016 / 2017



18. The company has owned the domain name haj.co.uk since 1998. Screenshots from its website from March 2000 to February 2019, obtained via the Internet Archive, the Wayback Machine, are shown at Exhibit AJF6. They are all largely the same. The composite mark appears in the screenshots from within the relevant period for proof of use, as in the example below, from 2017:

21 April 2017

INTERNET Explorer
Wayback Machine
http://www.hajj.co.uk/

200 connections
File: 2017-04-21 09:21:19

JAN APRIL MAY
2016 21 2018

Hajj & Umrah
TRAVEL LIMITED

Book Now On 020 7286 1111

HAJJ TOURS | UMRAH TOURS | ZIYARAT TOURS | ACCOMMODATION | TESTIMONIALS | GUIDES | CONTACT | GALLERY | BOOK NOW

Lured Packages

Hajj 5 Star Hotels
19th August - 5th September
Intercontinental (4 Nights HB)
and Movenpick (13 Nights HB)
Prices from: 45900

Join Our Mailing List

Email Address:

Powered by: EUP'SafeSubscribe™

Hajj & Umrah Tours and Packages

Specialist in all inclusive Hajj and Umrah packages.

Hajj & Umrah Travel is the first specialist tour operator to offer pilgrimage tours from the UK. For those of you privileged to have visited Makkah to perform the Hajj pilgrimage, you will know the immense and meticulous planning that is required to carefully arrange your trip. Makkah as you may or may not know is the most important holy meeting site in Islam.

Discovering this website means you can have more time preparing to demonstrate your solidarity with your fellow Muslim and your subsequent submission to Allah whilst attending Hajj. Attending the annual pilgrimage to Makkah, millions of Muslims from around the world will have spent many months preparing for their journey.

Here at hajj.co.uk we have spent time and energy in creating a network of affiliations and partnerships to cover all your travel needs and requirements, giving us the ability to offer fantastic Hajj tours and tailored Hajj services to suit the needs and requirements of any pilgrim visiting Saudi Arabia for the Hajj 2017.

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19. Mr Jafari-Fini states that the company has been at its current premises since 1993. Exhibit AJF9 comprises a picture and screenshot from Google Maps of the shop front, which dates from November 2018:



20. Finally, Mr Jafari-Fini states that his company regularly distributes merchandise which advertises the company's services. Exhibit AJF10 comprises images of drawstring bags, DVDs, pilgrimage guides, keyrings, puzzles, luggage labels, leaflet displays, pens, travel pouches, umbrellas and high visibility vests.

21. The applicant has filed evidence which addresses what it perceives to be the descriptiveness of the earlier marks. Mr Mohammad Jamshaid, who gives evidence for the applicant, is the religious cleric at the Jamia Noor Ul Quran Mosque, in Ilford, Essex. Mr Jamshaid states that he has been asked by Mr Muhammad Sulman, the

owner of the applicant, to give his opinion as to the meaning and usage of the words “HAJJ” and “UMRAH”.

22. Mr Jamshaid states that Hajj is an Arabic word meaning pilgrimage. In English, it is almost always written as “Hajj” with two ‘j’s. When used in the Islamic faith, Hajj refers to the annual pilgrimage during the twelfth month of the Islamic calendar.² The literal meaning of Hajj is “heading to a place for the sake of visiting”, but in Islamic terminology, Hajj is a pilgrimage made to the holy cities of Mecca and Medina (in the Kingdom of Saudi Arabia). Mr Jamshaid states that, for a Muslim, the word Hajj means “to attend a journey”, which connotes both the outward act of a journey and the inward act of intentions.

23. Mr Jamshaid states that Umrah is also an Islamic word which, when translated into English, literally means “to visit a populated place”. Like the Hajj pilgrimage, a Muslim undertaking the Umrah pilgrimage also visits the holy cities of Mecca and Medina. Mr Jamshaid explains that it is one of the central tenets of the Islamic faith that every Muslim must perform the holy pilgrimage of Hajj to the holy cities of Mecca and Medina at least once if they are physically and financially able to do so. The Umrah pilgrimage is not compulsory for Muslims. Hajj can only take place during the holy month of Ramadan, whilst Umrah can take place at any time of year.

24. Mr Jamshaid states that Hajj is usually spelt with two j’s, but he has sometimes seen it spelt “Hadj”, “Hadji” or even “Haj”, although the last spelling is a very unusual spelling in English. He has seen Umrah spelt as Umra, but such a spelling is very unusual.

25. Mr Jafari-Fini filed evidence to reply to the statement given by Mr Jamshaid. Mr Jafari-Fini agrees that the spelling of Haj and Umra is unusual and explains that this is what makes his earlier marks distinctive. He states that the applicant’s mark is entirely non-distinctive and descriptive and that it should be rejected on this basis. However, Mr Jafari-Fini has not opposed the application under the grounds of sections

² Dhul al Hijjah

3(1)(b) or 3(1)(c) of the Act. He has made no request to amend the pleadings, so it is not open to him to make these claims.

Proof of use

26. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) (28 June 2018), Arnold J. (as he then was) summarised the case law on genuine use of trade marks, referring to judgments from the Court of Justice of the European Union (“CJEU”):

“114. The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use:

Ansul at [38] and [39]; La Mer at [22]-[23]; Sunrider at [70]-[71], [76]; Leno at [29]-[30], [56]; Centrotherm at [72]-[76]; Reber at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: Ansul at [39]; La Mer at [21], [24] and [25]; Sunrider at [72] and [76]-[77]; Leno at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: Reber at [32].”

27. The onus is on Mr Jafari-Fini, as the proprietor of the earlier marks, to show use because Section 100 of the Act states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

28. The evidence about the meanings of Hajj and Umrah, and the spelling of Haj and Umra in the earlier marks, is relevant to the question as to whether the earlier marks have been put to genuine use, because use must be use in a trade mark sense, rather than descriptive use, for it to be deemed genuine.³ This is because if the use is descriptive, it cannot fulfil the essential function of a trade mark, as described by the CJEU in *Philips Electronics NV v Remington Consumer Products Limited* [2003] RPC 14:

³ See, for example, *Henkell & Co Sektkellerei KG v EUIPO*, Case T-20/15, General Court.

“30. [...] the essential function of a trade mark is to guarantee the identity of the origin of the marked product to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin, and for the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality”.

29. Mr Jafari-Fini points out that, after initial rejection by the Intellectual Property Office as being descriptive, his word-only trade mark was registered on the basis of acquired distinctiveness through use. It is clear in my mind that he has used, in a consistent manner, the stylised word mark (2391203) and the composite mark (2391202) which have appeared in the brochures and on the website, including the five year period which is relevant for proof of use. In the case of the composite mark, the use of this is on the website. The turnover and customer figures are commensurate with a small but consistently performing independent travel agency business. Mr Jafari-Fini does not say where his customers are based, and he appears to operate from a single shop in London, but his business has an online presence and it appears from the screenshots of the website homepage that it is possible to book through the website since there is a “Book now” tab at the top of the page. Mr Jafari-Fini also states that he prints 15,000 to 20,000 brochures every year and that these are distributed to mosques, Islamic centres and clients in all major cities in the UK. I am satisfied that the picture provided by the combination of facts and exhibits shows a UK-wide, not merely London-centric, business.

Fair specification

30. I will look next at the services in relation to which earlier marks 2391202 and 2391203 have been used, coming back to the word-only mark below (2398755). Use is claimed in relation to all the registered services:

Class 39: *Travel arrangement services.*

Class 43: *Provision of temporary accommodation.*

31. The registered services in class 39 cover all kinds of travel, from cruises to coach excursions. Mr Jafari-Fini's business has operated in a very niche area, organising pilgrimage packages; and, this is further narrowed to only two types of pilgrimage: the Hajj and the Umrah holy pilgrimages.

32. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

33. In relation to the class 39 services, it seems to me that the average consumer would fairly describe the services in relation to which the trade mark has been used as *Travel arrangement services for Islamic pilgrimages*. Mr Jafari-Fini’s business has provided no other type of travel arrangements.

34. The registered class 43 specification is *provision of temporary accommodation*. Such services cover accommodation businesses. The evidence does not indicate that Mr Jafari-Fini’s business provides accommodation; what it does is arrange hotel accommodation as part of the pilgrimage package, making reservations for whichever hotel the customer chooses. The hotels in Saudi Arabia which are highlighted in the brochure are all run by third-parties. I have considered whether, if a customer on one of Mr Jafari-Fini’s tours had a complaint about the hotel, that customer would view Mr Jafari-Fini’s business as responsible for the quality of the hotel. If so, it might tip the balance in favour of Mr Jafari-Fini having shown genuine use in relation to the provision of temporary accommodation.

35. In *Aegon UK Property Fund Limited v The Light Aparthotel LLP*, BL O/472/11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered whether use of a shopping centre name was use in relation to services provided by third parties within the shopping centre, such as hotels, restaurants and bars. Referring to the CJEU case *Celine*, C-17/06, to *Euromarket Designs Incorporated v Peters & Anor* [2000] EWHC 453 (Ch) and to *Premier Brands UK Ltd v Typhoon Europe Ltd & Anor* [2000] EWHC 1557 (Ch), Mr Alexander observed that:

“24. ...these cases demonstrate that in considering whether use is in relation to given goods or services, the tribunal may take into account a number of factors, including whether the goods were in fact obtained from the proprietor, the presence or absence of other branding on the goods, how the goods were sold and so on. An approach which entitles the tribunal to make an overall assessment of this aspect of use is similar to that of *Ansul*, which requires regard to all the facts and circumstances in evaluating whether use was genuine.

25. The effect of these authorities, both at EU and at national level, is therefore that this aspect of the non-use provisions requires the tribunal to consider whether, having regard to all the facts and circumstances, the mark has been used to identify to the average consumer the proprietor as the origin of, including having responsibility for, the particular goods or services in question.”

36. In my view, the facts in the present case point away from genuine use in relation to the provision of temporary accommodation. In the case of travel agents which use the same branding for the arranging of holidays as they do for their hotels, the customer would see the link between the travel agency and the hotel; they would consider the quality of the hotel to be the responsibility of the travel agency with whom they booked their holiday. The circumstances of the present case are different. Mr Jafari-Fini’s business arranges all the elements of the pilgrimage package, including booking airline tickets, arranging coach transfers and booking the hotel of the customer’s choosing, provided by third parties from the list provided in the brochure. The hotels all appear prestigious, of inter-continental style; it is inherently unlikely, given the size of Mr Jafari-Fini’s business, that they are part of his business. Mr Jafari-Fini’s business does not provide temporary accommodation: it provides accommodation reservation services, or accommodation arrangement services. These do not form part of the registered specification and the average consumer would not fairly describe provision of temporary accommodation as covering arrangement or reservation of accommodation, which are services provided by booking agents.

37. Consequently, I find that Mr Jafari-Fini may not rely upon the registered class 43 services and may only rely upon the following class 39 services for earlier marks 2391202 and 2391203:

Travel arrangement services for Islamic pilgrimages.

Earlier mark 2398755

38. I have found that there has been genuine use of 2391202 and 2391203 within the relevant period, in relation to restricted services.

39. The remaining earlier mark, 2398755, has not been used in the form in which it is registered. I need to assess whether it has been used in a way that constitutes an acceptable variant under section 6A(4)(a) of the Act. 2398755 is registered as follows:

HAJ AND UMRA

HAJ & UMRA

40. The use of HAJ & UMRA in the relevant period is with the words TRAVEL LIMITED, underneath, as in earlier mark 2391203, or with the device and the words TRAVEL LIMITED, as in earlier composite mark 2391202:

HAJ & UMRA
TRAVEL LIMITED



41. The mark, as registered, wholly appears, but with other matter: the additional words TRAVEL LIMITED, and the device. *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, concerned the use of one mark with, or as part of another mark. On the face of it, that is the case here: the words HAJ & UMRA are used as part of the other two earlier marks. The CJEU stated:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1). (emphasis added)

42. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold QC (as he then was), sitting as the Appointed Person, summarised the test under s.46(2) of the Act, the provisions of which are equivalent to those under section 6A(4)(a), as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

43. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered.

44. The applicant's evidence shows that Haj & Umra is a misspelling of Hajj and Umrah, words which are used descriptively in Mr Jafari-Fini's evidence about his company's services. The spelling being so close to the descriptive words, it appears that HAJ & UMRA are words low in distinctive character for services relating to the Hajj and Umrah holy pilgrimages. They differ only in the last letter of each word from the names of the holy pilgrimages. Therefore, the addition of other elements, in use, is likely to affect the distinctive character of the mark in the form in which it was registered. The addition of TRAVEL LIMITED creates the impression of a single business, which is absent from HAJ & UMRA. HAJ & UMRA has never been used *solus* and would not be perceived as indicative of the origin of the services without the additional words, which is how it has always been used, including on the shop signage since 1993, and certainly how it has been used in the relevant period. I find that the additional elements, in use, alter the distinctive character of the mark as registered.

As a consequence, the use is not of an acceptable variant, as provided for by section 6A(4)(a) of the Act. This earlier mark may not be relied upon in these proceedings.

Section 5(2)(b) of the Act

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

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

(a) ...

(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.”

46. The following principles are gleaned from the decisions of the CJEU 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

47. The services to be compared are as follows:

Earlier marks	Application
Class 39: <i>Travel arrangement services for Islamic pilgrimages.</i>	Class 39: <i>Travel Agency services for arranging Airline Tickets, Visas, arranging holidays, arranging ground transportation.</i> Class 43: <i>Arranging accommodation for pilgrims, for holidays, for business travellers.</i>

48. In determining which services are identical and which are highly similar, the law requires that goods/services be considered identical where one party's description of its goods/services encompasses the specific goods/services covered by the other party's description (and vice versa): see *Gérard Meric v OHIM*, Case T-33/05, GC. On this principle, the class 39 services of the application are identical to the (restricted) class 39 services of the earlier marks, since the earlier marks are registered for a term which is included in the applicant's services. If I am wrong about that because of the limitation to Islamic pilgrimages, the services are highly similar because the components of arranging Islamic pilgrimages include the services of the application in class 39, whilst being highly similar to the components of arranging holidays. The applicant's class 43 services are also similar to the services of the earlier marks. In particular, arranging accommodation for pilgrims would share the same trade channel, the same users, a similar nature and be complementary to arranging travel for Islamic pilgrimages. The services would be highly similar. The remainder of the class 43

services are also similar to a reasonably high degree, although not for a pilgrimage, they are part and parcel of a travel agency business arranging a package for travellers.

The average consumer and the purchasing process

49. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. 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.

50. The average consumers for the earlier marks are Muslims seeking to go on Islamic pilgrimages. These average consumers also apply to the applicant, but the application is not limited to travel and accommodation for Muslims attending the Hajj and Umrah holy pilgrimages. The services of the application cover a wider variety of services, and, therefore, in notional and fair use, a wider general public.

51. The services are most likely to be selected after visual inspection of brochures, websites and after having seen shop signage. I do not discount the potential for an aural aspect to the purchasing process; for example, Mr Jafari-Fini's evidence shows that his brochures are regularly distributed in mosques and Islamic community centres, where personal recommendation and group travel may come into play.

52. Mr Jafari-Fini's services are likely to be bought with some degree of care. This is because his evidence shows that undertaking the Hajj holy pilgrimage requires a lengthy period of planning. It could be a once-in-a-lifetime trip, according to the evidence. The evidence shows that there are components of the Hajj which pilgrims would want to ensure that the itinerary covered.

53. The applicant's services cover a wider range of travel services, not only pilgrimages. Holidays and business travel are specified. Depending on the nature of the trip, at least a reasonable degree of attention will be paid to the purchase of the applicant's services, to ensure the right travel arrangements are made, with the type

of accommodation required by the customer in the correct location, taking into account personal requirements.


Comparison of marks

54. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the 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.”

55. It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

56. The marks to be compared are:

Opponent's marks	Applicant's mark
	LONDON HAJJ AND UMRAH



57. The overall impression of the earlier series of two marks is dominated by haj & umra/HAJ & UMRA, which are larger in size than the words TRAVEL LIMITED, which are positioned beneath the dominant element. The overall impression of the earlier composite mark is of a device of buildings and the words HAJ & UMRA, with TRAVEL LIMITED again being smaller and less prominent in position. Although the device appears at the start of the mark, it shares dominance with the words HAJ & UMRA owing to their size in the mark as a whole.

58. The applicant's mark is composed of the name of the UK's capital city, London, together with the words HAJJ AND UMRAH which are the names of Islamic holy pilgrimages. None of these words are distinctive and none dominate the mark. The overall impression is comprised of the combination of all of the words.

59. The series of marks and the applicant's mark have a medium level of visual similarity. The common elements, whilst not identical, are visually similar, but there are other components which the marks do not share: TRAVEL LIMITED and LONDON. There is less visual similarity between the earlier composite mark and the applicant's mark because there is a further element which does not appear in the applicant's mark: the device. This is fairly prominent in the composite mark. I assess the visual similarity between these marks as low.

60. The device in the composite mark will not be articulated. Therefore, for the aural comparison, I will consider the earlier marks together. The first word which will be heard in the applicant's mark will be LONDON. This is absent from the earlier marks. The similar components in the parties' marks, HAJ & UMRA and HAJJ AND UMRAH are likely to be pronounced in the same way, or a highly similar way, with the double J sounding like a single J and the final H of UMRAH being silent. If TRAVEL LIMITED is also articulated, there is a low to medium degree of aural similarity. If TRAVEL LIMITED is not articulated, the aural similarity is medium.

61. There is more than one group of average UK consumer for the applicant's mark: those wishing to purchase travel arrangements to attend Hajj and Umrah holy pilgrimages, and the wider public in respect of other types of travel services. Both groups will know that LONDON is the name of the UK's capital city. Muslims will know that HAJJ AND UMRAH are the names of the Islamic holy pilgrimages. However, a significant proportion of UK average consumers who are not Muslim will also know, even if they are not entirely sure of the exact details, that Hajj is an event attended by Muslims, or at least meaningful in Islam, and will assume that Umrah also has a meaning in Islam since it appears in conjunction with Hajj. There will also be a proportion of UK average consumers for travel services who do not know of the words and will see them as invented.

62. As far as the earlier marks are concerned, the words TRAVEL LIMITED create the idea of a company providing travel services. HAJ & UMRA, to Muslims, will appear as misspellings of the descriptive words Hajj and Umrah, but the meaning will be immediately apparent. To non-Muslims who nevertheless know of Hajj, and therefore will make an assumption that Umrah also has an Islamic meaning, there will also be an Islamic connotation. This group may not know that Haj & Umra are not the usual spellings of Hajj and Umrah. The device in the composite mark is likely to be known to Muslims as comprising representations of the holy sites visited on the pilgrimages of Hajj and Umrah. To non-Muslims who have some understanding of the meaning of Hajj, and therefore Umrah, the conjunction of similar words with the device will cause them to understand the device as a representation of holy buildings, particularly mosques and a minaret. To those who do not know that Hajj and Umrah are meaningful, they will, likewise, attribute no meaning to HAJ & UMRA, but they are likely to understand that the device represents a collection of buildings with religious significance as a result of the domed roofs and the tower.

63. Putting all this together, I find that, for Muslims, the word marks are similar to a reasonably high degree conceptually, taking into account the different concepts of LONDON, in the later mark, and a travel company in the earlier mark. For non-Muslims who have an understanding that the words are significant to Muslims, but without knowing the exact meaning, the marks will be seen as Islamic words and will

also be conceptually similar to that extent, bearing in mind also the difference in meaning of LONDON and TRAVEL LIMITED. For those who have no understanding of the words, the parties' word marks are conceptually different, comprised of invented words but one mark also containing the name LONDON, and the other the idea of a travel company.

64. In relation to the earlier composite mark and the applicant's mark, for Muslims, there will be a reasonably high degree of conceptual similarity, taking into account the concept of LONDON, which is absent from the earlier mark. Although the device has no counterpart in the applicant's mark, Muslims will understand it to be a representation of the of the holy sites visited on the pilgrimages of Hajj and Umrah, words which appear in the applicant's mark. For non-Muslims who have an understanding that the words have Islamic meaning, they will perceive the device to be a collection of buildings which have the appearance of religious sites, some with domed roofs, and a tower. There will be a shared concept to the extent that the marks denote Islamic references, notwithstanding the conceptual differences of LONDON and TRAVEL LIMITED. For those who see the common elements as invented words, they are likely to see the buildings as reminiscent of religious sites. However, as for this group none of the words have a religious significance, the marks are conceptually different, with one having the meaning of a travel company, and the other the city, LONDON.

Distinctive character of the earlier marks

65. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* the CJEU stated that:⁴

“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-

⁴ Case C-342/97.

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).”

66. The assessment must be made on the basis of the restricted services upon which Mr Jafari-Fini may rely: *Travel arrangement services for Islamic pilgrimages*.

67. For travel services relating to Islamic pilgrimages, the assessment is from the perspective of the average consumer for such services; i.e. Muslims. The inherent distinctiveness of the marks is weak. It is weakest for travel services relating to the Hajj and Umrah pilgrimages since the spelling is so close and the average consumer for these services knows what Hajj and Umrah mean.⁵ It is only the elements which are common to both parties’ marks which are relevant in the assessment, so the device does not improve the position for Mr Jafari-Fini as there is no counterpart in the later mark.⁶ However, for completeness, the device does little to add to the distinctive character of the composite mark as it is comprised of representations of sites which are significant to Islamic holy pilgrimages, thereby also being low in distinctive character.

68. The evidence, although showing relatively long use of the earlier marks, does not persuade me that their weak distinctive character has been improved through use.

⁵ *Loutfi v AMJ Meatproducts NV and Another*, Case C-147/14, CJEU.

⁶ *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis QC, sitting as the Appointed Person.

Here, I am assessing the use to which the marks have been put, rather than a fair specification. The use made of the earlier marks is in relation to the holy pilgrimages of Hajj and Umrah. The level of turnover is relatively modest, as are the number of customers. The evidence shows the words Hajj and Umrah, used descriptively, in close proximity to the marks. For marks which are as close to the descriptive words as Haj and Umra are, the evidence does not support a claim to enhanced distinctive character.

Likelihood of confusion

69. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. I have found the services to be identical.

70. I have commented upon the level of distinctiveness of the earlier marks as being weak. I must assume that they have a minimum level of distinctiveness because they are registered and registration is *prima facie* evidence of validity.⁷ However, that weak level of distinctive character affects the level of protection of the earlier marks. This is often referred to as the ‘penumbra’ of protection.

71. Whether there is a likelihood of confusion must be assessed from the perspective of the average consumer. I found earlier that there is more than one group of average consumer because the application covers a wider set of services than those relating to Islamic pilgrimages. However, the only group that will encounter both parties’ marks will be the group seeking travel services for Islamic pilgrimages; i.e. Muslims.⁸ There would be no reason for the wider public to seek Mr Jafari-Fini’s services. These average consumers know what the words Hajj and Umrah mean.

⁷ Section 72 of the Act.

⁸ GC, T-126/03 *Reckitt Benckiser (España) v OHIM* at paragraph 81; T-202/16 *UAB Keturi kambariai EUIPO*, at paragraph 87.

72. The only similarity between the marks is a common element which in the applicant's mark is descriptive and, in the earlier marks, is of weak distinctive character. In *Whyte and MacKay Ltd v Origin Wine UK Ltd & Anor* ("ORIGIN") [2015] EWHC 1271 (Ch), Mr Justice Arnold (as he then was) observed:

"...what can be said with confidence is that, if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion."

This has particular force where, as in the present case, both parties' marks include other elements which provide points of difference.

73. In *Nicoventures Holdings Limited v The London Vape Company Ltd* [2017] EWHC 3393 (Ch), Mr Justice Birss stated:

"31. The nature of the common elements needs to be considered and in a case like this, in which the common elements are elements which themselves are descriptive and non-distinctive (as the Hearing Officer found in paragraph 34), it is necessary somewhere to focus on the impact of this aspect on the likelihood of confusion. As has been said already it does not preclude a likelihood of confusion but it does weigh against it. There may still be a likelihood of confusion having regard to the distinctiveness and visual impact of the other components and the overall impression but the matter needs to be addressed.

32. The Hearing Officer found that the element in the opponent's mark which is the common element (i.e. VAPE and CO) is itself more distinctive than other features of that mark (i.e. the stylised features). That is a decision he was entitled to reach but it does not mean that once that decision has been reached, the low distinctiveness of what is the common element ceases to be relevant to a likelihood of confusion. Far from it. That is not what the CJEU in *L'Oreal v OHIM* was saying at all.

33. Given that the Hearing Officer has erred in this way, the matter needs to be considered again bearing in mind the *White and Mackay's* principle. Given

the clarity of the Hearing Officer's decision there is no need to go over this at length.

34. Each mark includes as important elements the terms VAPE and CO. There is more to each mark than that because they each include stylised features which are unremarkable but are different from one another (decision paragraphs 27 and 28). The point is that the marks do have a high degree of visual, aural and conceptual similarity (paragraphs 29-31) but that similarity arises from the common elements of the terms VAPE and CO and the combination of those two words. Bearing in mind the goods and services for which these marks are registered or applied for respectively, those words individually are both descriptive and non-distinctive. Put together the combination is also descriptive and non-distinctive.

35. As the Hearing Officer held in paragraph 31 they connote an undertaking in the vaping market. The average consumer, who is a member of the general public over 18 years old, will pay a relatively high degree of attention to the selection of goods and a reasonable level of attention to the selection of services.

36. Bearing all this in mind but in particular having regard to the low degree of distinctiveness about the features these two marks have in common, even taking into account imperfect recollection the differences in the two marks will take on a greater significance for the average consumer than they might otherwise. Although the stylised aspects of each mark are not very remarkable, the fact remains that these aspects are entirely different. From the point of view of visual similarity, the likelihood of confusion is low. Considering conceptual similarity, the concept the two marks share is entirely down to their non-distinctive elements. It is the common concept which is non-distinctive. That does not lead to a likelihood of confusion. In some ways the respondent's best case could be thought to come from considering the aural similarity. From that point of view of course the visual stylised elements will not be present, and hearing "Vape dot co" or "THE Vape dot co" is not so far away from hearing "Vape and co" but the fact is again that they are not the same and what they

share is entirely non-distinctive when one bears in mind this is all in the context of electronic cigarettes.

37. Accordingly I do not consider that there is a likelihood of confusion in this case.

74. That is not to say that there will never be a likelihood of confusion where the common element is descriptive/low in distinctive character, but that caution is required before making a finding of a likelihood of confusion.⁹ Other factors in the global comparison may combine to point towards or away from a likelihood of confusion.

75. The only average consumers who will encounter both parties' marks, Muslims, will not be confused, even in relation to the applicant's services which go wider than Islamic pilgrimages, because they know what Hajj and Umrah mean. Furthermore, the other differences between the marks, although low in levels of distinctiveness, further differentiate between them. The average consumer will pay a relatively high level of attention to the selection of Mr Jafari-Fini's services and will be alive to those differences and to the descriptive words HAJJ AND UMRAH. They will not put the similarity between the marks down to the same or an economically linked undertaking, but will see the common element as describing a characteristic of the services in the applicant's mark and a misspelling of the descriptive words Hajj and Umrah in the earlier marks.

76. The higher level of aural similarity between the marks does not alter this outcome. The earlier marks will sound the same as HAJJ and UMRAH TRAVEL LIMITED, Hajj and Umrah being descriptive of the subject matter of the services. The only group of average consumers who will encounter both parties' marks will hear the earlier marks and perceive them in this way; i.e. travel services relating to the Hajj and Umrah holy pilgrimages. They will not confuse them because what they hear, as far as the similar elements are concerned, will be entirely descriptive.

⁹ *L'Oreal v OHIM*, Case C-235/05 P, CJEU

77. In the same vein, even if it considered that there is a high level of conceptual similarity, this will only be relevant to the group of average consumers which encounters both marks and, in that scenario, this group knows that the concept is descriptive of travel services relating to the Hajj and Umrah holy pilgrimages. The descriptiveness (in the applicant's mark) and the low distinctiveness (in the earlier marks) of the common elements has the effect of downgrading the significance of the level of conceptual similarity in the global assessment.¹⁰

78. Finally, if Mr Jafari-Fini had also been able to rely upon his word-only earlier mark HAJ AND UMRA/HAJ & UMRA, it a) have only been in relation to travel arrangements for Islamic pilgrimages; and b) would have made no difference to the outcome. Although this earlier mark is closer to the applicant's mark as it does not include the words TRAVEL LIMITED or the device, the findings I have made mean that the relevant group of average consumers, i.e. Muslims, the only consumers who will encounter both parties' marks, will not be confused by the common element which is descriptive in the later mark and a misspelling of the descriptive words in the earlier mark.

Section 5(2)(b) outcome

79. The section 5(2)(b) ground fails.

Section 5(3) of the Act

80. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international

¹⁰ *PLANETART LLC 7 Anor v. PHOTOBX LIMITED & Anor* [2020] EWHC 713 (Ch), Mr Daniel Alexander QC, sitting as a Deputy Judge of the Chancery Division, at paragraph 29.

trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

81. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph

68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

82. The conditions of section 5(3) are cumulative. Firstly, Mr Jafari-Fini must show that the earlier marks are similar to the applicant's mark. Secondly, that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the later mark. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

83. The first condition of similarity between the marks is satisfied: as found earlier in this decision, the two earlier marks are visually similar to the applicant's mark to a medium or low degree; aurally identical or similar to a medium degree; and conceptually similar to a reasonably high degree, or are different, depending on the perception of the marks.

84. The next condition is reputation. Although I decided that for the two earlier marks that could be relied upon that a fair specification is *Travel arrangement services for Islamic pilgrimages*, under this ground of opposition I must consider what that reputation is for, if there is one. In my view, if there was a reputation at the relevant date, it would only be for travel arrangement services in relation to the Hajj and Umrah holy pilgrimages.

85. Reliance upon this ground requires evidence of a reputation amongst a significant part of the relevant public. In *General Motors*, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

86. As the evidence shows that all Muslims are expected to attend the Hajj at least once in their lifetime (if they are financially able and well enough to do so) and there are many Muslims in the UK, it might be expected that there is a substantial market for such travel arrangement services . However, there are no details about the market share which Mr Jafari-Fini's business enjoys. Customer/traveller numbers declined in the years since 2014, when there were 1325. In 2018, the number was 793. There was also a comparable reduction in turnover, from £2,466,383 to £1,314,523. This level of business is not substantial, particularly as the business is located in London which has a large Muslim community. I find that the evidence does not support a qualifying reputation at the relevant date.

87. That being the case, there is strictly no need to go any further. However, in case of appeal and in case I am wrong about the level of reputation, I will go on to consider the next requirement, which is whether the relevant public will make a link between the earlier marks and applicant's mark. A link means that the earlier marks will be brought to mind by the application.

88. I have already found that the average consumers for travel arrangements for Islamic pilgrimages are Muslims. The same group is also the relevant public for the purposes of this section of the Act.

89. The factors involved in determining whether there is a link were identified in Intel as being:

- The degree of similarity between the conflicting marks
- The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- The strength of the earlier mark's reputation;
- The degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- Whether there is a likelihood of confusion.

90. In Mr Jafari-Fini's favour is the fact that the parties' services are identical. However, all the other factors point away from a link. If there is a qualifying reputation, it is not strong. The similarity between the marks resides in elements which are either descriptive (in the applicant's mark) or low in distinctive character (in the earlier marks). There is also no likelihood of confusion.

91. I find that, even there was a qualifying reputation, it is too weak, given the other factors, to cause a link. Even if the earlier marks are brought to mind, it will be fleeting and put down to a coincidence of terms describing or alluding to the Hajj and Umrah holy pilgrimages.

92. In case I am wrong about there being no link, I will go on to look at the types of damage claimed. In *PLANETART LLC 7 Anor v. PHOTOBX LIMITED & Anor*

[2020] EWHC 713 (Ch), Mr Daniel Alexander QC, sitting as a Deputy Judge of the Chancery Division, observed that:

“Just as in a case of infringement under section 10(2), so under section 10(3), descriptiveness of the respective marks is a key element. A trader has less right to complain that its brand is being diluted if it has chosen a mark which is of limited distinctiveness in the first place. Nor can a trader complain that precisely because its brand is so vulnerable to loss of distinctiveness and swamping by a newcomer using it descriptively that this gives rise to a claim for dilution. Nonetheless, these propositions must have regard to the precise marks in issue and the extent to which they only consist of descriptive terms.

93. In *Environmental Manufacturing*, the CJEU stated:

“34. According to the Court’s case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment).

35. Admittedly, paragraph 77 of the *Intel Corporation* judgment, which begins with the words ‘[i]t follows that’, immediately follows the assessment of the weakening of the ability to identify and the dispersion of the identity of the earlier mark; it could thus be considered to be merely an explanation of the previous paragraph. However, the same wording, reproduced in paragraph 81 and in the operative part of that judgment, is autonomous. The fact that it appears in the operative part of the judgment makes its importance clear.

36. The wording of the above case-law is explicit. It follows that, without adducing evidence that that condition is met, the detriment or the risk of detriment to the distinctive character of the earlier mark provided for in Article 8(5) of Regulation No 207/2009 cannot be established.

37. The concept of 'change in the economic behaviour of the average consumer' lays down an objective condition. That change cannot be deduced solely from subjective elements such as consumers' perceptions. The mere fact that consumers note the presence of a new sign similar to an earlier sign is not sufficient of itself to establish the existence of a detriment or a risk of detriment to the distinctive character of the earlier mark within the meaning of Article 8(5) of Regulation No 207/2009, in as much as that similarity does not cause any confusion in their minds.

38 The General Court, at paragraph 53 of the judgment under appeal, dismissed the assessment of the condition laid down by the *Intel Corporation* judgment, and, consequently, erred in law.

39. The General Court found, at paragraph 62 of the judgment under appeal, that 'the fact that competitors use somewhat similar signs for identical or similar goods compromises the immediate connection that the relevant public makes between the signs and the goods at issue, which is likely to undermine the earlier mark's ability to identify the goods for which it is registered as coming from the proprietor of that mark'.

40. However, in its judgment in *Intel Corporation*, the Court clearly indicated that it was necessary to demand a higher standard of proof in order to find detriment or the risk of detriment to the distinctive character of the earlier mark, within the meaning of Article 8(5) of Regulation No 207/2009.

41. Accepting the criterion put forward by the General Court could, in addition, lead to a situation in which economic operators improperly appropriate certain signs, which could damage competition.

42. Admittedly, Regulation No 207/2009 and the Court's case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on ‘an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case’.”

94. In my view, there is no “serious risk of such detriment” because the earlier marks are allusive of the services and the common element is, insofar as it appears in the later mark, descriptive of the services. To conclude that the later mark would cause the relevant public for the earlier marks – Muslims who wish to undertake the Hajj and Umrah holy pilgrimages – to be less likely to buy the services of the earlier marks would be the result of mere suppositions and not at all probable. There is no detriment to the distinctive character of the earlier marks.

95. The claim to a detriment to the repute of the earlier marks is poorly pleaded. The claim is a non-starter. Speculation about poor quality services harming the earlier marks, when there is no evidence that the later mark has been used, is not a basis for a claim to detriment to repute.¹¹ This claim fails.

96. In relation to unfair advantage, the claim is that the later mark would gain an unfair advantage from the reputation of the earlier marks, moving the relevant public to be more likely to buy the services of the applicant than it would otherwise have been. In *Claridges Hotel Limited v Claridge Candles Limited and Anor* [2019] EWHC 2003 (IPEC), Mr Recorder Douglas Campbell QC, sitting as a Judge of the Intellectual Property Enterprise Court, stated:

“30. What is also clear is that the advantage has to be unfair. The mere fact of gaining an economic (or commercial) advantage is not enough: see *Argos Limited v Argos Systems Inc* [2018] EWCA Civ 2211 at [108] per Floyd LJ, with whom Sir Colin Rimer and Lord Kitchin agreed at [115], [116].”

¹¹ *Champagne Louis Roederer v J Garcia Carrion S.A. & Others* [2015] EWHC 2760 (Ch) and *Unite The Union v The Unite Group Plc*, Case BL O/219/13, Ms Anna Carboni, sitting as the Appointed Person.

97. Not only do I think that there would be no unfair advantage, I do not think there would be any advantage at all. The applicant's customers will see the words HAJJ AND UMRAH in the applicant's mark as a description of the destination for the travel services. They will not import some favourable image associated with the earlier marks (not that the evidence shows there is one): they will simply see a description of the services they wish to procure. There is no unfair advantage.

Section 5(3) outcome

98. The ground of opposition under section 5(3) of the Act fails. There is, therefore, no need to look at the applicant's defence of due cause.

Section 5(4)(a) of the Act: passing off

99. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

100. The three elements which Mr Jafari-Fini must show are well known. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 (IPEC), Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

101. Guidance is given in paragraphs 184 to 188 of Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

102. As stated at the beginning of this decision, since there is no evidence in these proceedings that the applicant has used its mark, the date when the applicant applied to register its trade mark, 25 May 2019, is the relevant date for the purposes of section 5(4)(a) of the Act.

103. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margerine Ltd* [1901] AC 217 at 223:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing

which distinguishes an old-established business from a new business at its first start.”

104. I am satisfied that the evidence shows that, at the relevant date, there was sufficient goodwill in the business which used the signs corresponding to the two earlier trade marks upon which I have found Mr Jafari-Fini may rely. The goodwill extended only to the provision of travel arrangement services for the Hajj and Umrah holy pilgrimages. There has been no use of the word-only mark HAJ & UMRA. This is important because these words are low in distinctiveness for the services which have been provided. The only use of these words has been with the additional words Travel Limited. Although a small difference, it is a significant one given the low level of distinctiveness of HAJ & UMRA. The addition of TRAVEL LIMITED creates the impression of a single business. HAJ & UMRA has never been used alone and would not, without the additional words which have always been used, be distinctive of the business. This sign may not be relied upon for the purposes of the passing-off claim.

105. Although Mr Jafari-Fini is the registered proprietor of the registered earlier marks, it is not an automatic sequitur that he owns the unregistered rights. His evidence is that he is the Managing Director and proprietor of Haj and Umra Travel Company Limited. Mr Jafari-Fini describes the company as a family business. A crucial question, therefore, is who owns the goodwill.

106. Under The Trade Marks (Relative Grounds) Order 2007, only someone entitled to sue for passing off can bring a case under s.5(4)(a) in respect of a mark published after 30 September 2007.¹²

107. If a business is run by a company, the company usually owns the goodwill. Goodwill is owned by the undertaking which customers perceive as being responsible for the trade.¹³ The present case is not one where a sole trader who owns goodwill in their business then decides to incorporate, while still remaining the driving force and owner of the business. Mr Jafari-Fini is the managing director and proprietor of the

¹² S.I. 2007/1976

¹³ *Medigen v Passion For Life* [2001] FSR 30

business, but he joined it in 1997 and describes it as a family business. He specifically states that he holds the trade marks for the company. Mr Jafari-Fini is not named anywhere in the evidence. The evidence always refers to the company: HAJ & UMRA TRAVEL LIMITED.

108. I find that Mr Jafari-Fini is not entitled to bring the passing-off claim because he was not the owner of the goodwill at the date on which the proceedings were commenced. The company was the owner of the goodwill.

109. In *Tao Asian Bistro*, Mr Yam was the sole director of three companies which the Hearing Officer had found owned the goodwill in the earlier signs relied upon by Mr Yam in his opposition.¹⁴ Professor Ruth Annand, sitting as the Appointed Person, stated:

“34. If it proves necessary (that is, if Mr. Yam’s appeal under section 5(2)(b) is unsuccessful), I will order that Tao Restaurant Limited be joined as Co-Opponent to these proceedings for reasons that include:

(a) At least collectively, Mr. Yam and Tao Restaurant Limited are proprietors of any goodwill accruing to the restaurant premises at 5 London End, Beaconsfield from 2003 to the date of the Application.

(b) Mr. Yam could have called upon Tao Restaurant Limited to assign ownership of any such goodwill to him.

(c) The nature of the opposition under section 5(4)(a) (including the evidence) would remain unchanged.

(d) Any unnecessary duplication of proceedings with attendant expense in time and costs would be avoided. The alternative was for Mr. Yam/Tao Restaurant Limited to pursue the 5(4)(a) claim on invalidity.

¹⁴ BL O/004/11.

(e) There was nothing intentional about Mr. Yam bringing the opposition under 5(4)(a) in his name rather than Tao Restaurant Limited's (*CONSEAL Trade Mark*, BL O/197/00)."

110. However, since that decision, the Act has been amended by The Trade Mark Regulations 2018, which came into force on 14 January 2019.¹⁵ It was possible, in proceedings commenced prior to this date, for parties to be joined, as in *Tao Asian Bistro*. However, following the amendment to the Act, Section 38(2A) of the Act states:

"(2A) Where a notice of opposition is filed on the basis of one or more earlier trade marks or other earlier rights-

(a) the rights (if plural) must all belong to the same proprietor;"

111. These proceedings were commenced on 25 October 2019. It would only be possible to join the company as co-opponent if all the earlier rights, registered and unregistered, were jointly owned by Mr Jafari-Fini and the company, which is clearly not the case in relation to the registered rights.

112. It is also not possible for the company to be substituted as the sole opponent, for the same reason. All the earlier rights must be owned by the same proprietor, and Mr Jafari-Fini owns the earlier registered marks.

113. In the event, it does not matter because I find that the section 5(4)(a) ground fails. Mr Jafari-Fini has opposed a mark in which the only similar elements to his marks are the descriptive words Hajj and Umrah. An analogous example would be an opposition against a mark which contains the word 'pizza', for pizzas, based upon an earlier mark PIZA, which is a misspelling of the name of the goods. The penumbra of protection of PIZA, in relation to pizzas, would not extend to the word 'pizza'. In my view, Mr Jafari-Fini cannot complain about the application insofar as it relates to services for arranging Hajj and Umrah holy pilgrimages. The case under this ground is even narrower than under section 5(2)(b) because goodwill only resides in services

¹⁵ S.I. 2018/825

relating to travel arrangements for the Hajj and Umrah holy pilgrimages. The test for misrepresentation requires a substantial number of customers of the earlier signs to be deceived.¹⁶ Mr Jafari-Fini's company's customers are unlikely to be deceived even in relation to the wider travel services covered by the application because they are Muslims who know that the words Hajj and Umrah, the only similar element in the application, are descriptive of the services offered by the business HAJ & UMRA TRAVEL LIMITED.

114. The distinctiveness of the earlier signs lies in the precise form of words, i.e. HAJ & UMRA TRAVEL LIMITED (plus device, for the composite earlier sign). Mr Jafari-Fini's company's customers will not expect the common elements to mean that the entities are linked in some way. They will not be deceived because they will be able to distinguish between the marks on account of the differences between them, the only common elements being entirely descriptive as represented in the applicant's mark. There will be no misrepresentation and hence no damage. The section 5(4)(a) ground of opposition fails.

Overall outcome

115. The opposition has failed. The application may proceed to registration.

Costs

116. The applicant has been successful and is entitled to a contribution towards its costs, based upon the published scale.¹⁷ The breakdown is as follows:

Considering the notice of opposition and filing the defence and counterstatement	£450
Considering evidence and filing evidence	£800

¹⁶ *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473.

¹⁷ Tribunal Practice Notice 2/2016.

117. I order Ali Jafari-Fini to pay to London Travel Centre Ltd the sum of **£1250**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 25th day of November 2020

Judi Pike
For the Registrar,
the Comptroller-General