

**O/782/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3522377  
IN THE NAME OF Qima Coffee Ltd  
TO REGISTER:**

**Yemenia**

**yemenia**

**YEMENIA**

**AS A SERIES OF 3 TRADE MARKS**

**IN CLASSES 30 & 43**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. OP000422573**

**BY**

**The Cooperative Union of Yemeni Coffee Producers  
Association**

## BACKGROUND AND PLEADINGS

1. On 13 August 2020, Qima Coffee Ltd (“the applicant”) applied to register the series of 3 trade marks shown on the cover of this decision, in the United Kingdom, for the following goods and services:

Class 30: *Coffee; Coffee (Unroasted -); Coffee [roasted, powdered, granulated, or in drinks]; Coffee; Coffee (Artificial -); Coffee (Unroasted -); Coffee [roasted, powdered, granulated, or in drinks]; Coffee bags; Coffee based beverages; Coffee based drinks; Coffee based fillings; Coffee beans; Coffee beverages; Coffee beverages with milk; Coffee capsules; Coffee capsules, filled; Coffee concentrates; Coffee drinks; Coffee essence; Coffee essences; Coffee essences for use as substitutes for coffee; Coffee extracts; Coffee extracts for use as substitutes for coffee; Coffee flavorings; Coffee flavorings [flavourings]; Coffee flavourings; Coffee in brewed form; Coffee in ground form; Coffee in whole-bean form; Coffee mixtures; Coffee oils; Coffee pods; Coffee substitutes; Coffee substitutes (Vegetal preparations for use as -); Coffee substitutes [artificial coffee or vegetable preparations for use as coffee]; Coffee substitutes [grain or chicory based]; Coffee, teas and cocoa and substitutes therefor; Coffee-based beverage containing milk; Coffee-based beverages; Coffee-based beverages containing ice cream (affogato); Aerated beverages [with coffee, cocoa or chocolate base]; Aerated drinks [with coffee, cocoa or chocolate base]; Artificial coffee; Barley for use as a coffee substitute; Beverages (Coffee-based -); Beverages based on coffee; Beverages based on coffee substitutes; Beverages consisting principally of coffee; Beverages made from coffee; Beverages made of coffee; Beverages with a coffee base; Beverages with coffee base; Caffeine-free coffee; Chicory [coffee substitute]; Chicory and chicory mixtures, all for use as substitutes for coffee; Chicory based coffee substitute; Chicory extracts for use as substitutes for coffee; Chicory for use as substitutes for coffee; Chicory mixtures for use as substitutes for coffee; Chicory mixtures, all for use as substitutes for coffee; Chocolate bark containing ground coffee beans; Chocolate coffee; Decaffeinated coffee; Drip bag coffee.*

Class 43: *Coffee shops; Coffee shops; Coffee bar services; Coffee shop services; Coffee supply services for offices [provision of beverages].*

2. The application was accepted and published for opposition purposes on 25 September 2020.

3. The application is opposed by The Cooperative Union of Yemeni Coffee Producers Association (“the opponent”). The opposition was filed on 29 December 2020 and is based upon Section 3(1)(b), Section 3(1)(c) and Section 3(1)(d) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods and services in the application.

4. Under Section 3(1)(b), the opponent claims that the mark is devoid of distinctive character as it contains the word Yemeni in its entirety, the meaning of which is “belonging to or relating to the Yemen, or to its people or culture”. It further asserts that the addition of the letter A at the end of the mark does not detract from the overall impression given to it by the meaning of the word Yemeni, and accordingly, the mark provides clear information that the goods are of Yemeni origin and the services provide for the sale and offering of goods of Yemeni origin.

5. In respect of Section 3(1)(c), the opponent claims that the mark YEMENIA designates a characteristic of the goods and services for which registration is sought, namely, products that are, or contain, coffee grown in Yemen and services relating to the sale and offering of products that are, or that contain, coffee grown in Yemen.

6. Under Section 3(1)(d), the opponent claims that given the nature of the goods and services at issue, the mark YEMENIA consists exclusively of a sign which is customary in the current language or in the *bona fide* and established practices of the relevant trade areas.

7. The applicant filed a counterstatement denying each and every claim made by the opponent and it puts the opponent to strict proof of each of its allegations. It claims that YEMENIA is an invented, distinctive word, without any customary meaning or

significance, and that registration of the series of marks will not prevent third parties from using the words Yemen or Yemeni descriptively in relation to their goods or services. It requests that the opposition is rejected, that the application is allowed to proceed to registration, and that an award of costs be made in favour of the applicant.

8. Both parties filed evidence, which will be summarised to the extent that it is considered necessary. Both parties filed written submissions, and I will refer to these, where appropriate, in my decision. Neither party requested a hearing, therefore this decision is taken following a careful perusal of the papers.

9. In these proceedings, the opponent is represented by Potter Clarkson LLP and the applicant is represented by Albright IP Limited.

## **EVIDENCE SUMMARY**

### **The opponent's evidence**

10. The opponent filed evidence in the form of a witness statement dated 26 April 2021, and adduces 5 exhibits labelled AAAM1 – AAAM5 in support of the opposition. The witness statement is in the name of Dr As'ad Abdullah Al Marri, being the President of the Cooperative Union of Yemeni Coffee Producers Association (“the Union”).

11. In paragraph 4 of the witness statement, Dr As'ad Abdullah Al Marri explains that the Union was set up to “become a leading regulatory platform in the Yemen coffee sector to work on enhancing sustainable production and solving problems and obstacles that stand in the way of increasing coffee production and quality”.

12. Exhibit AAAM1 comprises a scanned copy of a License to Practice Cooperative Activity for Cooperative Associations and Unions, together with an (uncertified) English translation, granted to the Union by the Yemen Ministry of Social and Labor Affairs on 11 February 2020.

13. Exhibit AAAM2 is copy of a letter, written in English, from the Union to the applicant explaining its concerns and reasons for its objection to the registration of the application. The letter is headed as REPUBLIC OF YEMEN, Ministry of Social Affairs & Labour, Cooperative Union of Yemeni Coffee Producers Association, and is dated 15/10/2020. The letter states that the applicant did not have permission to conduct research work in Yemen, that Yemeni items are considered to be the geographical antiquities of Yemen, and that no one has the right to register such a trade mark unless they adhere to Yemeni laws. Further, the applicant applied to register a trade mark in a foreign country before it was registered by the Yemeni state, and has violated all Yemeni laws and regulations.

14. Paragraph 9 of the witness statement explains that Exhibit AAAM3 shows a copy of a report on research undertaken in 2020 by the applicant and a third party in the form of an article for submission to a scientific journal. The opponent states that the research claims to have identified a new group of coffee genetics. However, as outlined in the previous exhibit, the opponent states that the applicant does not have a licence to practise research activities in Yemen; that Yemeni genetic material was used to carry out the study without coordinating with the Yemeni research authorities; and that the applicant did not mention that the new group of coffee genetics was Yemeni genetic material. Nevertheless, neither this document, nor the previous Exhibits AAAM1 and AAAM2, provide evidence of how the contested mark falls foul of Section 3(1) of the Act, *per se*.

15. Exhibit AAAM4 consists of a series of articles from various trade magazines, including, *inter alia*, “BARISTA MAGAZINE ONLINE” which was accessed on 16/03/2021, “DAILY COFFEE NEWS”, with an article dated 24 August 2020, and “FRESH CUP MAGAZINE”, with an article dated 26 August 2020. These articles report on the research project and refer to the newly discovered genetic group as YEMENIA, which according to several of the articles and paragraph 11 of the witness statement means “the Yemeni mother” in Arabic.

16. Exhibit AAAM5 comprises undated extracts from the US social news aggregation website Reddit, showing message boards discussing “Yemenia”, as well as posts on Instagram and YouTube, including a transcript of an Instagram video, and a transcript

of a YouTube video entitled “Willem Boot about “Yemenia” coffee variety”. Both clips are said to have been posted on 15 September 2020.<sup>1</sup> In his witness statement, Dr Al Marri asserts that these extracts echo the Union’s concerns that the applicant is not entitled to own, nor exclude others from using, a term that describes a resource of the Yemen state.

### **The applicant’s evidence**

17. The applicant filed evidence in the form of a witness statement dated 5 July 2021 by Katie A Oliver, Chartered Trade Mark Attorney and Director at Albright IP Limited. Alongside the witness statement, Ms Oliver adduces 4 exhibits, labelled KAO1 – KAO4, respectively, the contents of which are summarised in the witness statement from which the following is directly reproduced:

The Applicant is also the Proprietor of EUTM Application No. 18380160 YEMENIA in Class 30. An extract for this Trade Mark from the EUIPO website is attached at Exhibit KAO1.

On 10 May 2021, the Opponent filed third party observations against registration of the Applicant’s EUTM Application No. 18380160 YEMENIA. A copy of the observations filed is attached at Exhibit KAO2.

On 23 June 2021, the EUIPO notified the Applicant’s appointed EUTM Representative that the third party observations filed “*do not give rise to serious doubts concerning the eligibility of the trade mark for registration and the application will proceed accordingly*”. A copy of the letter issued by the EUIPO is attached at Exhibit KAO3.

On 22 June 2021, the Applicant’s EUTM Application No. 18380160 YEMENIA was granted registration. A copy of the Registration Certificate is attached at Exhibit KAO4.

### **PRELIMINARY ISSUE**

18. The applicant submits that the report of the research carried out by the applicant, a copy of which has been provided by the opponent as evidence by way of Exhibit AAAM3, is irrelevant to whether the contested marks should be registered in the UK.

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<sup>1</sup> See paragraph 15 of the opponent’s witness statement.

19. With regard to the research undertaken by the applicant, the issue of whether the applicant has a licence to practice research activities in Yemen is not a matter which I consider to be directly related to these proceedings on whether the contested series of marks fulfil the necessary criteria under sections 3(1)(b), (c) and (d) to be registered as trade marks in the UK.

## **DECISION**

20. Although the UK has left the European Union, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. Therefore, this decision contains references to the trade mark case-law of the European courts.

### **Section 3(1) –**

21. Section 3(1) of the Act provides as follows:

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

(a) [...]

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

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

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

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

22. I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c), but still be objectionable under Section 3(1)(b): *SAT.1 SatellitenFernsehen GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case C-329/02 P at [25].

23. The relevant date for determining whether the applicant’s mark is objectionable under sections (3)(1)(b), 3(1)(c) and 3(1)(d) is the date on which the application was made, being 13 August 2020.

24. The applicant submits that the grounds of opposition relied upon are without merit, and it notes that this was the conclusion reached by the European Union Intellectual Property Office (“EUIPO”) following their rejection of the third party observations based on the same grounds as the subject opposition.<sup>2</sup> While I acknowledge the findings of the EUIPO, this does not preclude a finding for the opponent under these grounds within the present opposition proceedings. I am not bound by the decisions of other intellectual property offices, rather, I must make my decision based on the evidence before me in relation to the relevant territory of the UK at the relevant date.

### **Section 3(1)(d)**

25. I will first consider the opposition under Section 3(1)(d) of the Act.

26. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court (“GC”) summarised the case law of the Court of Justice under the equivalent of s.3(1)(d) of the Act, as follows:

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<sup>2</sup> See Exhibit KAO3.

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40).”

27. In light of the above case law, the pertinent question is whether, on the relevant date (13 August 2020), the mark “YEMENIA” had, based on the perception of the average consumer of the goods and services in the UK, “become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark”.

28. In my view, the average consumer of the goods and services, being various forms of coffee and its derivatives, and the provision of coffee shop services and supply of coffee beverages, will be the general UK coffee drinking public, including those with a heightened interest in coffee. I acknowledge that the average UK consumer of the goods may also be a specialist in trade, such as a third party supplier of the goods to retail or wholesale outlets or directly to coffee shops, who is likely to have a broader knowledge of the goods at hand than a member of the general public.<sup>3</sup>

29. It is the opponent’s claim that the applicant seeks exclusivity in a trade mark that has clearly become customary and widely adopted by the trade to refer to the claimed new mother population of coffee genetics, marketed as YEMENIA. It further submits that the concerns as to the impact of granting such exclusivity are shared by several commentators in the trade, impacting the market in regards to pricing, to the legitimate importation and use by authorised distributors and re-sellers of Yemeni coffee to the UK, to the Yemeni farmers and to stakeholders, as the evidence demonstrates in Exhibit AAAM7.<sup>4</sup> However, only five exhibits, labelled AAAM1 – AAAM5, have been provided by the opponent. As paragraph 15 of the opponent’s witness statement specifically mentions the concerns of others are evidenced in Exhibit AAAM5, I will take the reference to Exhibit AAAM7 to be a typographical error.

30. The applicant submits that the articles and video transcripts contained within Exhibits AAAM4 and AAAM5 were published after the filing date of the opposed application.<sup>5</sup> I agree with the applicant that the evidence does not show that YEMENIA had become customary in the current language or in the bona fide and established practices of trade at the relevant date.

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<sup>3</sup> See *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, paragraph 24.

<sup>4</sup> See paragraphs 9 and 10 of the opponent’s written submissions, dated 6 September 2021.

<sup>5</sup> See pages 3 and 4 of the applicant’s written submissions, dated 6 September 2021.

31. The opposition based on Section 3(1)(d) fails.

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

32. I will now move to consider the opposition under Section 3(1)(c) of the Act.

33. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation ) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

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

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

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest

underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

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

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

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

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

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

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

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that

that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

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

34. With consideration to the above principles, in assessing the mark under Section 3(1)(c), I keep in mind that the objective of this section is to ensure that signs *exclusively* designating a characteristic of the goods and services remain free for use by other traders of those goods or services.

35. Earlier in this decision, I found that as exhibits AAAM4 and AAAM5 are either undated or were published after the relevant date they were of no help to the opponent in relation to the claim under Section 3(1)(d).<sup>6</sup> I note, however, that a trade mark does not need to be in use in a descriptive manner at the time of application for it to fall foul

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<sup>6</sup> See paragraph 30 of this decision.

of Section 3(1)(c): the possibility that a sign may be used descriptively in the future should also be considered.<sup>7</sup>

36. As I have already noted, the opponent states that the name “YEMENIA” translates in Arabic to “the Yemeni mother”, and it contends that this is a direct reference to the claimed new mother population of Arabica coffee. Accordingly, it submits that the contested marks designate a characteristic of the goods and services for which registration is sought, namely, products that are or that contain coffee grown in Yemen and services relating to the sale and offering of products that are or that contain coffee grown in Yemen.<sup>8</sup> It further submits that the evidence at Exhibit AAAM5 demonstrates that the average consumer and the relevant professional public now describe the claimed new mother population of coffee genetics from Yemen as “YEMENIA”.

37. The applicant submits that whilst the mark contains the letters Y, E, M, E, N and I, this is not the trade mark applied for. It further submits that the addition of the letter A affects the visual, aural and conceptual appearance and composition of the mark, which functions as an indication of commercial origin in the UK. It denies that registration of the mark, being the invented word “YEMENIA”, would block third parties from using the words “Yemen” and “Yemeni” in the course of trade. It submits that the newly discovered genetic coffee group is referred to as “New-Yemen” and that no reference is made in the research report to the trade mark YEMENIA.

38. I accept that the word “Yemeni” is descriptive of something which belongs or relates to the Yemen, or to its people or culture, however, it is the word “YEMENIA” not “YEMENI” which I must consider.

39. I take judicial notice that a proportion of the UK public will recognise the Yemen as a geographical location, however, I am less inclined to consider that a significant proportion of the same public will recognise the location as having a reputation for the production of coffee. Even given that a small proportion of the relevant UK consumer

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<sup>7</sup> See *Exalation v OHIM*, Case T-85/08, paragraphs 42 – 43.

<sup>8</sup> See paragraph 8 of the opponent’s Statement of Grounds dated 29 December 2020, filed alongside Form TM7.

would understand the meaning in Arabic to be “the Yemeni mother”, it is my view that an even smaller proportion of those consumers would understand the relevance in regard to a “mother population” of coffee, and would instead see the mark as merely alluding to the country of Yemen as the geographical origin of the goods, rather than exclusively describing it as such. There would also be a proportion of consumers who would view “YEMENIA” as an invented word with no conceptual identity.

40. I disagree that the evidence demonstrates that the relevant public view YEMENIA as a descriptor of the coffee. In relation to Exhibit AAAM3 and the research carried out by the applicant, the report makes no reference to the term YEMENIA. With regard to exhibits AAAM4 & AAAM5, I accept that the use of the word “Yemenia” in some of the articles and posts does appear to describe a new coffee group. However, this evidence appears to consist of North American sources and does not show descriptive use of the term specifically in the UK. Further, references to YEMENIA within the articles are in direct relation to the applicant and not descriptively as either the geographical location of the coffee or as a type of coffee bean such as Arabica or Robusta. Although mention is made that Yemenia belongs to a new genetic group of Arabica coffee, the articles refer to Yemenia as coffee discovered and named by the applicant. As such, I do not consider that the average UK consumer will recognise YEMENIA as being descriptive of a characteristic of coffee or coffee related services.

41. I consider that the adjective “YEMENI” would be the apt term to describe the kind and geographical origin of the goods, rather than the invented term “YEMENIA”. It is my view that whilst the relevant public may recognise “YEMENIA” to be a play on the descriptor “YEMENI”, this is not the same as finding the mark to be descriptive of a characteristic of the goods and services applied for. I find that insufficient evidence has been provided to demonstrate that “YEMENIA” would be recognised in the UK as designating a characteristic of the goods and services. Consequently, I have no basis on which to find that the mark should remain free for use by other traders.

42. The opposition under Section 3(1)(c) fails.

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

43. Section 3(1)(b) of the Act prevents registration of marks which are devoid of distinctive character. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per

se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

44. The applicant submits that the word YEMENIA is an invented and distinctive word without any meaning, usage or definition in the English language, and it is not understood or considered to have any meaning to consumers in the relevant trade in the United Kingdom. Accordingly, the applicant draws my attention to accepted practice as set out in the Manual of trade marks practice, thus:

*"There are no grounds for refusing registration of trade marks on the basis that they are descriptive or non-distinctive in a language which is unlikely to be understood by the relevant trade in the UK or by the relevant average UK consumer of the goods/services in question".<sup>9</sup>*

45. The opponent submits in its Statement of Grounds that when consumers are presented with the contested mark, it will be clear that those goods and services bearing the mark are of Yemeni origin and as such, the mark is devoid of distinctive character. Earlier in this decision, I found the series of marks to be unacceptable under sections 3(1)(c) and 3(1)(d). While I recognise that Section 3(1)(c) and Section 3(1)(b) are independent grounds, as the opponent has not provided any further evidence in relation to its claims under 3(1)(b), only that by dint of 3(1)(c), the mark

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<sup>9</sup> See page 3 of the applicant's written submissions dated 6 September 2021.

must be devoid of distinctive character, the claim under section 3(1)(b) has not been proven.

46. The opposition under Section 3(1)(b) fails.

## **Conclusion**

47. The opposition has failed on all grounds. Subject to any successful appeal, the application by Qima Coffee Ltd may proceed to registration.

## **Costs**

48. The applicant has been successful, and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice (“TPN”) 2/2016. Applying the guidance in that TPN, I award Qima Coffee Ltd the sum of £1500, which is calculated as follows:

Considering the notice of opposition and preparing a counterstatement: £400

Preparing evidence and considering and commenting on the opponent’s evidence: £600

Preparing written submissions in lieu of a hearing: £500

**Total: £1500**

49. I therefore order The Cooperative Union of Yemeni Coffee Producers Association to pay Qima Coffee Ltd the sum of £1500. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 19th day of October 2021**

**Suzanne Hitchings  
For the Registrar,  
the Comptroller-General**