O/0078/26

TRADE MARKS ACT 1994

IN THE MATTER OF UK TRADE MARK APPLICATION NUMBER 4060091

BY

KHAIRAT AL MANAFIE CO FOR TRANSPORT AND GENERAL TRADING LTD
TO REGISTER THE FOLLOWING TRADE MARK:

Al KASS TOBACCO

IN CLASS 34

AND

IN THE OPPOSITION THERETO

UNDER NUMBER 449700

BY "INTERNATIONAL MASIS TABAK" LLC

BACKGROUND & PLEADINGS

1. On 5 June 2024, Khairat Al Manafie Co for Transport and General Trading Ltd ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK ("the contested mark"). The contested mark was published for opposition purposes in the Trade Marks Journal on 14 June 2024 in respect of the following goods:

   Class 34: Cigarettes; Cigarettes containing tobacco substitutes, not for medical purposes; Flavourings, other than essential oils, for tobacco; Cigarillos; Cigars; Herbs for smoking; Tobacco.

2. On 16 September 2024, the contested mark was opposed by "International Masis Tabak" LLC ("the opponent"). The opposition was initially brought under sections 3(6) and 5(2)(b) of the Trade Marks Act 1994 ("the Act"). However, by way of official letter dated 26 March 2025 the Tribunal struck out the section 3(6), as a result of the opponent's failure to file evidence within the specified timeframe and confirmed that the opposition would proceed in respect of section 5(2)(b) only.

3. The opponent relies upon the following International Registration designating the UK ("the earlier mark"):

   Alkasar

   القصر

   International Registration number: WO0000001349556

4. The opponent relies upon all of the goods for which its earlier mark is protected, namely:

   Class 34: Tobacco, smokers' articles, matches; gas containers for lighters; absorbent paper for tobacco pipes, cigarette papers; lighters for smokers;

tobacco pouches; books of cigarette papers; humidors; match boxes, firestones; cigar cutters; tobacco pipes, pipe racks for tobacco pipes, tips of yellow amber for cigar and cigarette holders; ashtrays; spittoons for tobacco; tobacco holders; pipe cleaners for tobacco pipes, cigarettes; cigarillos; cigars; tobacco jars, match boxes, not from precious metals; chewing tobacco; snuff; tobacco cases; pipes, pocket machines for rolling cigarettes, cigarette filters; cigar cases, cigarette cases for tobacco.

5. The earlier mark was registered on 27 December 2016 and, with effect from the same date, the opponent designated the UK as a territory in which it sought to protect its mark under the terms of the Protocol of the Madrid Agreement. Protection was granted on 24 August 2017

6. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

"(6)(1) In this Act an "earlier trade mark" means –
(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

7. The mark identified in paragraph 3 qualifies as an earlier trade mark under the above provisions. It is noted that the earlier mark has been protected for more than five years at the date of the application for the contested mark and so, in accordance with section 6A of the Act, the applicant could have requested proof of use of the earlier mark from the opponent. However, no such request has been made by the applicant. I am not therefore required to consider this issue and, consequently, the opponent may rely on all of the goods highlighted in paragraph 4 of this decision for the purposes of this opposition.

8. The opponent submits that the contested mark is "visually, phonetically and conceptually highly similar" to the earlier mark and that the goods that the marks are applied/registered for are "identical" or "highly similar". Consequently, the

opponent submits that “there is a resultant likelihood of confusion” between the marks.

9. The applicant filed a counterstatement denying the claims made against it. Specifically, the applicant submits that the marks are not similar and there is therefore no likelihood of confusion between the marks. Consequently, the applicant submits that the opposition should be “dismissed in its entirety”.

10. The opponent is represented by Williams Powell, and the applicant is self-represented. In this case, neither party filed evidence. No hearing was requested, and neither party filed written submissions in lieu of a hearing. This decision is therefore taken following a careful consideration of the papers that have been filed by the parties, which will not be summarised but will be referred to as and where appropriate during this decision.

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

PRELIMINARY ISSUES

12. I note the applicant’s submissions that there is “no basis” for consumers to confuse the marks in issue because of the opponents “lack of use” and consequential failure to acquire “any reputation or recognition among UK consumers in connection with the relevant goods”, and because the respective marks “operate in different circumstances and target distinct consumer perceptions”. As a preliminary point, I have no evidence before me to substantiate the parties’ alleged “different circumstances” and “distinct consumer perceptions”. However, even if I did, I must compare the goods in the parties’ specifications on the basis of the ‘notional’ coverage of the goods listed in the specifications, not the goods currently provided. Any differences between the

actual goods offered by the parties or the parties' trading styles will, as a matter of law, have no bearing on the outcome of this opposition, unless those perceived differences are apparent from the specifications. This is because a trade mark registration is essentially a claim to a piece of legal property (the trade mark). Every registered mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods/services if there is a likelihood of confusion, and the level of protection afforded to that mark will be identified in its specifications. Once a trade mark has been registered for five years, section 6A of the Act is engaged and the opponent can be required to provide evidence of use of its mark. However, as discussed above, that has not been requested in this instance; the earlier mark is therefore entitled to protection in respect of the full range of goods for which it is registered.

13. Further, whilst evidence of a lack of confusion by consumers over an extended period of time may point towards there being no likelihood of confusion,[1] in this instance, both parties have acknowledged that the earlier mark has not been used. Consequently, the alleged lack of actual confusion in this instance does not evidence that there is no likelihood of confusion on the part of the public.

DECISION

Section 5(2)(b)

14. This opposition is based upon section 5(2)(b) of the Act which stipulates the following:

"5(2) A trade mark shall not be registered if because-

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

[1] Paragraphs 34 and 35 of the decision of Dr Brian Whitehead in *Azumi Limited v Nick Robinson*, BL O/078/22

protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

15. Section 5A of the Act stipulates that where "grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

16. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*,[2] *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc ("Canon")*,[3] *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*,[4] *Marca Mode CV v Adidas AG & Adidas Benelux BV*,[5] *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM")*,[6] *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*,[7] *Shaker di L. Laudato & C. Sas v OHIM*[8] and *Bimbo SA v OHIM*[9]:

    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 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;

[2] Case C-251/95
[3] Case C-39/97
[4] Case C-342/97
[5] Case C425/98
[6] Case C-3/03
[7] Case C-120/04
[8] Case C-334/05P
[9] Case C-591/12P

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 greater 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 services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of Goods

17. The competing goods are as follows:

The opponent's goods	The applicant's goods
Class 34 Tobacco, smokers' articles, matches; gas containers for lighters; absorbent paper for tobacco pipes, cigarette papers; lighters for smokers; tobacco pouches; books of cigarette papers; humidors; match boxes, firestones; cigar cutters; tobacco pipes, pipe racks for tobacco pipes, tips of yellow amber for cigar and cigarette holders; ashtrays; spittoons for tobacco; tobacco holders; pipe cleaners for tobacco pipes, cigarettes; cigarillos; cigars; tobacco jars, match boxes, not from precious metals; chewing tobacco; snuff; tobacco cases; pipes, pocket machines for rolling cigarettes, cigarette filters; cigar cases, cigarette cases for tobacco.	Class 34: Cigarettes; Cigarettes containing tobacco substitutes, not for medical purposes; Flavourings, other than essential oils, for tobacco; Cigarillos; Cigars; Herbs for smoking; Tobacco.

18. As a preliminary point, it should be noted that section 60A of the Act provides that goods and services are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification[10], or

[10] "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957.

dissimilar on the ground that they appear in different classes under the Nice Classification."

19. In *Canon*, the Court of Justice of the European Union ("CJEU") stated (at paragraph 23) that, when making the comparison, "all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

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

    a. The uses of the respective goods;

    b. The users of the respective goods;

    c. The physical nature of the goods;

    d. The respective trade channels through which the goods reach the market;

    e. In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

    f. The extent to which the respective goods are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods in the same or different sectors.

[11] [1996] R.P.C. 281

21. In *Gérard Meric v OHIM*, the General Court ("GC") confirmed that even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa)[12]:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

22. As per the case of *Separode,*[13] I also bear in mind that it is permissible to group the goods together, for the purpose of comparison, where they are sufficiently comparable to be assessable in essentially the same way for the same reasons.

23. The opponent submits that the goods in issue are identical or highly similar as they are all either "tobacco, or tobacco related products, for the purpose of smoking", or "accessories or products related to the smoking of tobacco". Specifically, the opponent submits that the goods in issue overlap in user, nature and trade channels.

24. The applicant's submissions on the similarity, or lack thereof, of the goods in issue are limited. The applicant appears to me to be submitting that the applicant's goods can be distinguished from the opponent's goods on the basis that the opponent's goods cover a "broader scope of Class 34 goods". However, the applicant fails to confirm whether it accepts or denies whether any of the specific goods within its specification are identical or similar to that of the opponent's, and it is important to note that identity or similarity only needs to be established between the applicant's goods and some of the opponent's goods.

[12] Case T-133/05
[13] BL O/399/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person

25. As discussed above, the opponent has submitted that the applicant's goods are either identical or similar to all of its goods. In the interest of brevity, whilst I have given due consideration to all of the opponent's submissions, I have only outlined what I consider to be the opponent's best case for the purposes of my comparison of the goods in issue.

Tobacco; Cigarettes; Cigarillos; Cigars

26. It is noted that all of the above referenced terms appear in both the applicant's and opponent's specifications and that these goods are, therefore, self-evidently identical.

Cigarettes containing tobacco substitutes, not for medical purposes

27. The opponent's term "cigarettes" is not limited in any way, so can cover any type of cigarette including those containing tobacco substitutes. As such, I find that the above term of the applicant falls within the opponent's wider term (cigarettes), and that they are therefore identical in accordance with the principle outlined in *Meric*.

Herbs for smoking;

28. I compare the above referenced goods with the opponent's "tobacco". I consider there to be an overlap in purpose and method of use between these goods as they are both to be added to, for example, a cigarette for the purpose of being smoked. I also consider there to be an overlap in users, being smoking adult members of the general public, and trade channels, as both goods would be available to purchase from tobacconists. I also consider there to be an overlap in the physical nature of these goods on the basis that they are all natural products, often in loose leaf form, which have been shredded/cut and dried. However, I note that tobacco will contain nicotine, whereas herbs for smoking will not. I also consider there to be a level of competition between these goods as consumers may opt to smoke herbs in the place of tobacco, or vice versa. However, I do not consider these goods to be complementary as they are neither

important nor indispensable to one another.[14] Overall, I consider these goods to have a high degree of similarity.

Flavourings, other than essential oils, for tobacco;

29. I compare the applicant's above referenced goods with the opponent's "tobacco". The goods themselves will differ in nature, as the flavourings may be either natural or artificial and would likely come in the form of liquids or powders, while tobacco is a natural product often in loose leaf form, which has been shredded/cut and dried. The primary purpose of the compared goods will also differ as the primary purpose of "tobacco" is to be smoked, whereas the primary purpose of the applicant's above referenced goods is to add flavour to tobacco. Given their differing purpose, I do not consider there to be any competition between the compared goods. Whilst the opponent's goods are essential for the use of the applicant's goods, I do not consider that the average consumer would assume that responsibility for the compared goods derives from the same undertaking. I do not therefore consider that the goods are complementary.

30. Having said that, I do accept that there is an overlap in method of use between the compared goods as both goods would be inhaled in the same way, at the same time, through devices such as pipes or rolled cigarettes. There will also be an overlap in user of these goods, being adult members of the general public who are smokers. There is also an overlap in trade channels whereby both parties' goods would be obtainable from tobacconists. Overall, I find that there is a medium degree of similarity between these goods.

Average consumer and the purchasing act

31. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected

[14] *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

by the average consumer. 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 and services in question (see *Lloyd Schuhfabrik Meyer*[15]).

32. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,*[16] Birss J. held:

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

33. The goods at issue are goods associated with smoking. As such, I find that the average consumer will be a member of the general public over 18 years old, who smokes. For the most part, the goods are likely to be available via general retailers, tobacconists or their online equivalents. In respect of the tobacco related products, they are not permitted to be displayed on shelves and will, therefore, be selected aurally. Having said that, a visual component will still play a part as the consumer will view the goods at the point of purchase. Tobacco goods can also be purchased online from, for example, supermarkets, where visual inspection will be possible. I note that where tobacco goods are concerned this will be restricted to the brand name as the packaging is otherwise blank or carries health messages, not related to the particular undertaking offering the goods for sale.

[15] Case C-342/97
[16] [2014] EWHC 439 (Ch)

34. As for the other goods at issue, these are not subject to any ban or limitation and, therefore, will be selected by the consumer after a visual inspection of the same. In my view, the selection of the goods that are not directly tobacco products will be dominated by the visual component (though I do not discount aural considerations in the form of word-of-mouth recommendations or advice from sales staff) whereas the selection of tobacco products will be done primarily based on the aural component (though as above, the visual component will still play a role).

35. Most of the goods at issue are likely to be purchased at a relatively low cost and on a frequent basis, albeit I note that some of the cigar goods can vary quite considerably in price. In any event, I consider that consumers are likely to consider factors such as the price, type, taste or strength of the product, and that, despite the relatively low cost and high frequency of purchase, I consider that a medium degree of attention would be paid during the purchasing process due to the potential consequential impact on the consumers' health as a result of the goods being inhaled into the body.

Comparison of marks

36. 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 proceed to 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 *Bimbo SA v OHIM*,[17] 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

[17] Case C-591/12P

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

37. It would be wrong, therefore, to dissect the trade marks artificially, although 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.

38. The respective trade marks are shown below:

Earlier mark	Contested mark
Alkasar القصر	**Al KASS TOBACCO**

39. As discussed above, the opponent submits that the marks in issue are visually "highly similar", aurally "almost identical" and conceptually "similar and to some extent identical".

40. By contrast, the applicant submits that the marks differ in "visual impression" and in "semantic feature".

Overall Impression

41. The contested mark is a word only mark. There are no other elements in the mark which contribute to its overall impression, so the overall impression lies in the words themselves. I consider the word "tobacco" to be descriptive of the opponent's goods, which are all smoking related goods. I am also conscious that

the GC noted in *El Corte Inglés, SA v OHIM*,[18] that the beginnings of words tend to have more visual and aural impact. Consequently, I find that the word "tobacco" plays a lesser role in the overall impression of the earlier mark, with the words "Al KASS" being the dominant element.

42. The earlier mark is a figurative mark consisting of the word "Alkasar", above, what appears to be, some form of middle eastern language script ("the script"). However, I do not consider that the average UK consumer would be able to identify the meaning of the script. I also consider that the average consumer's attention will be drawn to the element of the mark that they are able to read (i.e., the word "Alkasar"), as such, I find this to be the dominant element of the earlier mark, with the script playing a lesser role in the mark's overall impression.

Visual Comparison

43. Visually, the marks overlap in their first 5 letters ("ALKAS"). However, the earlier mark also has an additional "AR" at the end, which is not present in the contested mark, and the contested mark has an additional "s" and "tobacco" at the end, which is not present in the earlier mark. There is also a space between the "Al" and the "KAS" in the contested mark, which is not present in the contested mark, and this results in the earlier mark forming one word and the contested mark being broken into three separate words. The earlier mark also has the additional middle eastern language script, which is not present in the contested mark.

44. Whilst I acknowledge my finding that the word "tobacco" in the contested mark, and the script in the earlier mark play a lesser role in the marks' overall impressions, I do note that there are still a number of additional differences in the elements of the marks that I have found to be dominant. Consequently, I find the marks to be visually similar to between a low and medium degree.

[18] Cases T-183/02 and T-184/02

Aural Comparison

45. I consider that the entirety of the contested mark will be pronounced, but that only the "Alkasar" element of the earlier mark will be pronounced. This is because, as discussed above, I do not consider that the average UK consumer will be able to understand and therefore pronounce the script in the earlier mark.

46. I do consider that the "ALKAS" element of the earlier mark and the "AL KASS" element of the contested mark will be pronounced identically. However, the additional "AR" at the end of the earlier mark and the "tobacco" at the end of the contested mark amount to clear phonetic differences.

47. Weighing up all of the above and noting my finding that the "tobacco" element of the contested mark plays a lesser role, I am of the view that the marks are aurally similar to a medium degree.

Conceptual Comparison

48. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU, including *Ruiz Picasso v OHIM*.[19] The assessment must, therefore, be made from the point of view of the average consumer.

49. I am also conscious of the findings of the GC in *Usinor SA v OHIM,*[20] *that "*as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him".

[19] [2006] ECR I-643; [2006] E.T.M.R
[2020] Case T-189/05

50. It is noted that both parties appear to be asserting that the elements of the marks I have found to be dominant (i.e., the word “AL KASS” in the contested mark and “Alkasar” in the earlier mark) derive from Arabic words. Specifically, the opponent submits that “the trade marks translates from Arabic as “a castle” and that the marks are therefore conceptually “similar and to some extent identical”. The applicant submits that the word “kasar” in the earlier mark in Arabic means “palace” or “ruin”, “which gives the brand the opportunity to be associated with luxury or historical motifs”, and that the word “AL KASS” “may” be Arabic. Regardless, of the meaning identified by the parties, neither “AL KASS” nor “Alkasar” are standard English dictionary words. In respect of the earlier mark, I consider that the average consumer may identify the word “Alkasar” as a foreign language word (particularly given its presence above what appears to me to be some form of middle eastern script), or an invented word. However, even if it is viewed as a foreign language word by the average UK consumer, I do not consider that they would be able to identify its meaning.

51. Further, as discussed above, I also do not consider that the average UK consumer would be able to identify the meaning of the script in the earlier mark. Consequently, I do not consider that the average UK consumer would identify any conceptual meaning from the earlier mark, beyond perhaps identifying that it contains either a foreign language word, or a foreign language script.

52. In respect of the contested mark, I consider that the average consumer would identify the words “AL KASS” as invented words, with no clear conceptual meaning. However, the word “TOBACCO” is a standard English dictionary word, which would be identified by the average consumer as indicative of the type of goods being sold by the applicant. Given this point of conceptual difference (albeit not a particularly distinctive one), insofar as the marks as wholes convey any concept, I find them to be conceptually dissimilar.

Distinctive character of the earlier trade mark

53. In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR I-0000, paragraph 49)
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> 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)."

54. Whilst the distinctiveness of a mark may be enhanced as a result of it being used in the market, in this instance the opponent has admitted that there has been no use of the mark to date. Consequently, I have only the inherent position to consider.

55. Distinctiveness is a scale along which marks of various types sit. A mark which is allusive of the goods/services will have less distinctive character than one that is not; dictionary words will also be less distinctive than words which are entirely fanciful. However, all will turn on the particular facts. For example, there are "invented" words which are really just composites of two allusive words and only distinctive as a result, and dictionary words which are more or less common than others.

56. In this instance, the earlier mark is made up of the word “Alkasar”. As outlined above, my primary finding is that the average consumer would not attribute any meaning to the word “Alkasar” beyond identifying it as either an invented word or a foreign language word. I have also found that the average UK consumer would not identify the meaning of the script underneath the word “Alkasar” beyond identifying it as some form of middle eastern script. Consequently, I do not consider the earlier mark to have any relevance to the opponent’s services, and I therefore consider it to have a high level of distinctive character.

Likelihood Of Confusion

57. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, whilst indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods/services down to the responsible undertakings being the same or related.

58. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*[21]). The first is the interdependency principle i.e., a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (see *Canon*[22]). It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods, and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

59. I have found the applicant’s goods to be identical or similar to a medium or high degree to the opponent’s goods. I have also found that the marks are visually

[21] C-251/95, para 22
[22] C-39/97, para 17

similar to between a low and medium degree, aurally similar to a medium degree, conceptually dissimilar, and that the earlier mark has a high degree of inherent distinctive character.

60. I have identified that the average consumers are adult members of the general public who smoke, who will demonstrate at least a medium level of attention during the purchasing process depending on the goods concerned. I have also identified that the purchasing process for the tobacco goods will be primarily aural in nature, though visual considerations have not been excluded. However, for other goods, the purchasing process will be primarily visual, though aural considerations have not been excluded.

61. Weighing up all of the above and notwithstanding the principle of imperfect recollection, I consider that there are sufficient visual differences between the marks to avoid them from being mistakenly recalled as each other, particularly given that I have determined that a medium level of attention will be paid by the average consumer during the purchasing process. In my view, these differences are sufficient to counteract the high degree of distinctive character of the earlier marks.

62. I make this decision with due consideration of my findings on the level of similarity/identity between the goods in issue, that I have found the highest level of similarity between the marks in my aural comparison (albeit, I only found the goods to be aurally similar to a medium degree), that I have found that the purchasing process for the tobacco goods will be primarily aural in nature, and that I cannot discount aural considerations during the purchasing process of the other goods in issue. However, with that in mind, I still consider there to be sufficient phonetic differences between the marks (namely, the additional “AR” at the end of the earlier mark, which is not present in the contested mark, and the additional word “tobacco” at the end of the contested, which may play a lesser role in the overall impression, but will still be pronounced). It is also important to note that I have found that visual considerations will also play a part in the purchasing process for all of the goods in issue, and I consider there to be sufficient visual differences between the marks which I consider will preclude the

public from confusing the two marks. Consequently, I do not consider there to be a likelihood of direct confusion between the marks.

63. I now turn to consider whether there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis KC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:[23]

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).
>
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand

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or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI”, etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

64. As outlined above, I have found the earlier mark to have a high level of distinctive character. However, I do not consider the common element of the marks in issue (namely the letters “ALKAS”) to be “so strikingly distinctive” that the average consumer would assume that no-one, but the opponent, would be using it in a trade mark, and, in any event, the average consumer would have no reason to dissect the string “ALKAS”/”AL KAS” from part of the longer/words in the marks (“ALKASAR”/”AL KASS”) in order to come to such a conclusion. Having recognised the differences between the marks, I can see no reason why the average consumer would conclude that they originate from the same or economically linked undertakings. I do not consider the marks to be natural variants or brand extensions of each other. Whilst I accept that the adding/removing of the word “tobacco” alone might be seen as a natural variant/band extension, I can foresee no real reason why the dominant elements (namely the word “Alkasar” and “AL KASS”) within the marks in issue could be interpreted as natural variants or brand extensions of one another. Consequently, I do not consider there to be a likelihood of indirect confusion between the marks in issue.

CONCLUSION

65. The opposition fails in its entirety, and the contested mark may, subject to any successful appeal of my decision, proceed to registration for all of the goods it has been applied for.

COSTS

66. As the applicant has been successful it is entitled to a contribution towards its costs. However, as the applicant is not legally represented, in its letter to the applicant of 11 June 2025, the Tribunal said:

> "If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party. Please send these by e-mail to tribunalhearings@ipo.gov.uk.
>
> If there is to be a "decision from the papers" this should be provided on or before 9 July 2025.
>
> If a hearing is taking place you will be advised of the deadline to do so when the Hearing is appointed.
>
> If the proforma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded. You must include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed and any travel costs. Please note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour."

67. No cost pro forma has been received to date. Since the applicant did not file a cost pro forma by the deadline given in the Tribunal's letter of 9 July 2025, and has paid no statutory fees in these proceedings, I will make no costs order against the opponent in this matter.

Dated this 30th day of January 2026

B Hartland
For the Registrar