

O-057-11

TRADE MARKS ACT 1994

**IN THE MATTER OF
REGISTRATION OF TRADE MARK No. 2500053
STANDING IN THE NAME OF
IMRAN KHAN**

AND

**IN THE MATTER OF THE REQUEST FOR A DECLARATION
OF INVALIDITY THERETO UNDER No. 83547
BY GARLBSONS (PVT) LIMITED**

BACKGROUND

1) On 13 October 2008 Imran Khan (hereinafter the registered proprietor) applied to register the trade mark MUGAL in respect of the following goods:

Class 29: Cooking oils (including vegetable oil, sunflower oil and other cooking oils), tinned vegetables, tinned fruits, pulses, tinned pulses; puddings.

Class 30: Rice.

2) The application was examined and accepted. The trade mark was published for opposition purposes on 28 November 2008. No opposition was filed, and registration granted on 6 February 2009.

3) On 7 December 2009 Garlbsons (PVT) Limited (the applicant) applied for invalidity under section 5(2)(b) of the Trade Marks Act 1994 (the Act). The grounds are, in summary:

- a) The applicant is the registered proprietor of CTM No.3425766 MUGHAL registered in respect of “Rice” in Class 30.
- b) As the marks are similar and the class 30 goods identical there is a likelihood of confusion amongst the public and so the mark in suit should be declared invalid under Section 47(2)(b) of the Trade Marks Act 1994. I note that the invalidity request is limited to the goods in Class 30 and does not include the class 29 goods.

4) On 28 September 2009 the registered proprietor filed a counterstatement denying the ground of invalidity. The registered proprietor claims to have businesses in Pakistan registered under the name Mugal and that the registered proprietor is by caste a mugal. There is also a history of dispute between the two parties in Pakistan. It is also claimed that the applicant does not trade in the UK. Proof of use is also requested.

5) Only the registered proprietor filed evidence. Both parties ask for an award of costs. The matter came to be heard on 8 February 2011 when the applicant was represented by Mr Krause of Haseltine Lake LLP. The registered proprietor did not attend or provide written submissions.

REGISTERED PROPRIETOR’S EVIDENCE

6) The registered proprietor filed a witness statement, dated 25 May 2010, by Mr Imran Khan. He states that the mark in suit was first used in the UK in 2005/06. He provides at exhibit FJB4 copies of two invoices from Phoenix Distributors (UK) Ltd. The first is said to be dated in 2006, however, the only date that can be read is “15 Jan 200”. The second invoice is dated 2 July 2009. He also provides examples of packaging and advertising and states that the annual sales prior to registration were £125,000. He also states that the mark has been used throughout the UK.

7) That concludes my review of the submissions filed in these proceedings insofar as I consider it necessary.

DECISION

8) The invalidity is based upon Section 47(2) and Section 5(2)(b) of the Trade Marks Act 1994 which read as follows:

“47.-(2) The registration of a trade mark may be declared invalid on the ground -

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

And:

“5.-(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.”

9) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

10) In these proceedings the applicant is relying upon an earlier mark which has a registration date of 22 April 2005 and, therefore, is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

11) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown

below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

- (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/ 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; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
- (e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 in that mark;
- (f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;
- (g) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it;
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;
- (i) 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;
- (j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

12) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the

registered proprietor's mark and the mark relied upon by the applicant on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods in their specifications.

13) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act is a factor to be considered. However, in the instant case the applicant for invalidity has not shown use of its mark and so cannot benefit from enhanced protection from use. However, I do consider that the applicant's mark is inherently very distinctive for "Rice".

14) I must now determine the average consumer for the goods of the parties, rice. It is clear that the average consumer must be both the general public and the restaurant trade. Also I must take into account the concept of imperfect recollection.

15) I now turn to consider the goods of the two parties. The invalidity action is restricted to the Class 30 goods of the registered proprietor and so the goods of both parties are "rice". It is clear that the goods of the two parties are identical. They are everyday goods of low cost which would be purchased with relatively little care.

16) I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

Applicant's Trade Mark	Registered Proprietor's Trade Mark
MUGHAL	MUGAL

19) Clearly, there is very little visual and no aural difference in the two marks. The letter "h" in the applicant's mark is silent. The words would normally be pronounced "MOO- GULL" although it is just possible that some might pronounce it "MUG-ALL".

20) Conceptually, the average consumer would see both as referring to the rulers of India from approximately the fourteenth to the eighteenth century. The word is more commonly spelt Mogul in English. Given the levels of literacy in the UK some may believe it to refer to the invented word Muggle used in Harry Potter stories to describe a non-witch, although these would, hopefully, be a minority.

21) Considering the marks as wholes and acknowledging the minor differences I consider the registered proprietor's mark to be very similar if not quite identical to the applicant's mark.

22) I take all of the above into account when considering the marks globally. I also take into account the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa. In the instant case the goods are identical and the marks are very similar. I believe that there is a likelihood of consumers being confused into believing that the goods provided by the registered proprietor are those of the applicant or provided by some undertaking linked to them, such as by way of a license. The invalidity action under Section 5(2) (b) therefore succeeds in relation to the Class 30 goods. As such the registration is deemed never to have been made in respect of the Class 30 goods although it will remain upon the Register in relation to the goods in Class 29.

COSTS

Preparing a statement and considering the other side's statement	£200
Preparing evidence and considering and commenting on the other side's evidence	£0
Preparing for and attending a hearing	£600
Expenses	£200
TOTAL	£1,000

23) As the applicant has been successful it is entitled to a contribution towards its costs. I order the registered proprietor to pay the applicant the sum of £1,000. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18 day of February 2011

**G W Salthouse
For the Registrar
the Comptroller-General**