

O-074-04

IN THE MATTER OF APPLICATIONS NOS. 2139070 AND 2139074 IN THE
NAME OF MOHAMMED S AL AJLAN SONS COMPANY

AND IN THE MATTER OF OPPOSITIONS NOS. 48096 AND 49676 THERETO
BY AJLAN BIN ABDULAZIZ AL-AJLAN & BROTHERS CO

DECISION

Introduction

1. Ajlan bin Abdulaziz Al-Ajlan & Brothers Co. appeals against a decision of Mr Knight acting for the Registrar dated 11 September 2003 in which he dismissed its oppositions to Applications Nos. 2139070 (“‘070’”) and 2139074 (“‘074’”) in the name of Mohammed S Al Ajlan Sons Company. In the same decision he upheld the appellant’s opposition to the respondent’s Application No. 2139078 (“‘078’”). Although the three oppositions were not formally consolidated, they were heard together and the hearing officer issued a single decision dealing with all three. There is no appeal by the respondent against the decision in respect of ‘078.
2. On the appeal the only ground of opposition still pursued by the appellant is that registration of ‘070 and ‘074 would be contrary to section 5(2)(b) of the Trade Marks Act 1994, which provides:

A trade mark shall not be registered if because ... 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 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.
3. The earlier trade mark relied upon is the appellant’s own registration No. 2055236 (“‘236’”). Although the appellant filed evidence of use of this mark, it did not rely upon that evidence before the hearing officer. Accordingly the

hearing officer only had to consider the section 5(2)(b) objection upon the basis of the inherent qualities of the '236 mark when notionally used in a normal and fair manner.

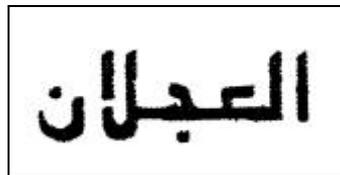
The appellant's mark and the respondent's applications

4. '236 is registered as of 1 February 1996 in respect of "clothing for men and children; headgear; footwear" in Class 25. The mark is as follows:



The Arabic characters appearing in the mark mean "Ajlan and Brothers" and "Ajlan bin Abdulaziz Al-Ajlan & Brothers Co."

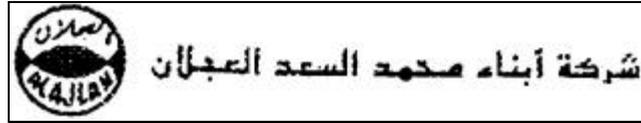
5. '070 is sought to be registered as of 15 July 1997 in respect of "textiles and textile goods not included in other classes; textiles piece goods for making headshawls; bed and table covers" in Class 24 and "clothing and footwear and headgear" in Class 25. The mark is as follows:



The Arabic characters which comprise the mark are transliterated as "Al-Ajlan", which means "The Swift One".

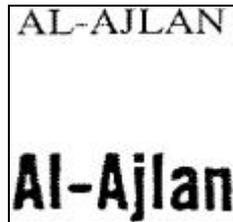
6. '074 is sought to be registered as of 15 July 1997 in respect of "textile piece goods, all for making up into headshawls and yashmagls; all for export to the

Middle East” in Class 24 and “headshawls and yashmagls; all for export to the Middle East” in Class 25. The mark is as follows:



The Arabic characters appearing in the mark mean “Mohammed Al-Saad Al Ajlan Sons Company”.

7. ‘078 was sought to be registered as of the same date and in respect of the same goods as ‘074. It comprises a series of two marks as follows:



The hearing officer’s decision

8. The hearing officer summarised the jurisprudence of the European Court of Justice regarding the proper approach to section 5(2)(b) in terms taken from the skeleton argument of counsel for the respondent and accepted by counsel for the appellant as follows:
- (i) the likelihood of confusion must be appreciated globally taking into account all factors relevant to the circumstances of the case;
 - (ii) the matter must be judged through the eyes of the average consumer of the goods in question, who is deemed to be reasonably 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;
 - (iii) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
 - (iv) the global appreciation of visual, aural or conceptual similarity must be based on the overall impression given by the marks, bearing in mind their distinctive and dominant components;

- (v) a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the goods, and vice versa;
- (vi) the more distinctive the earlier mark (either per se or because of the use that has been made of it) the greater will be the likelihood of confusion;
- (vii) mere association, in the strict sense that the later mark simply brings the earlier mark to mind, is not sufficient for the purposes of section 5(2);
- (viii) but if the association between the marks results in a likelihood that the average consumer will wrongly believe the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section.

9. The hearing officer also recorded that both parties were agreed that:

...matters surrounding trade in overseas territories were not relevant to the consideration of registrability in the United Kingdom (*Al Bassam* [1995] RPC 511) but that for the principal goods at issue here, headshaws, the reasonably circumspect consumer would be Arab speaking.

AL BASSAM Trade Mark was a decision of the Court of Appeal under the Trade Marks Act 1938, but before me both counsel confirmed that they agreed that there was no reason to think that the position was any different in this respect under the 1994 Act.

10. The hearing officer found that textile piece goods for making headshaws were very similar goods to headshaws themselves, and that accordingly the goods covered by the respondent's applications were either identical to or similar to the goods covered by the appellant's mark. The respondent did not challenge those findings.
11. The hearing officer's reasons for rejecting the oppositions to '070 and '074 but upholding the opposition to '078 are set out in paragraphs 35, 36 and 37 of his decision:

Applicants' trade mark No. 2139070

35. The applicants' trade mark is in Arabic script which comprises the mark Al-Ajlan which means 'the swift one'. Even to an Arab speaker

there are significant differences between the trade marks. There is much additional matter in the opponents' trade mark – more script and the device of a globe. Also, there is the possibility that the trade mark would be seen as 'the swift one' by an Arabic speaker rather than having any surnominal significance which the opponents' trade mark, by the addition of the term & Brothers, does have. The differences between the applicants' and the opponents' trade marks, despite the identity and similarity of the respective goods, means that even in the specialised field of headgear the relevant public are not going to be confused as to the origin of the goods. Thus, I do not consider that the opponents' trade mark constitutes a barrier to the registration of the applicants' trade mark No. 2139070 under the provisions of Section 5(2)(b). The opposition under that head in respect of that application is therefore dismissed.

Applicants' trade mark No. 2139074

36. In the applicants' trade mark, the translation of the Arabic characters mean "Mohamed Al Said Al Ajlan Sons Company". Thus it contains a significant element of the opponents' trade mark, the word Ajlan. Because of the way in which they are presented there is clearly a surnominal significance. Though how significant I know not. There is no evidence before me as to the prevalence of Ajlan as a surname in Arab speaking counties and therefore its significance as such to an Arab speaker in the United Kingdom. Making the best I can of the criteria to be applied looking at the trade marks as wholes, and taking into account imperfect recollection, I reach the view that the differences between the opponents' and applicants' trade marks – the reference to sons rather than brothers, the addition of the forename Mohammed, together with a device of a circle containing additional matter, would enable the relevant public to differentiate one trade mark from the other, even in a case such as this where identical and specialised goods are involved. The opposition to this application on the basis of Section 5(2)(b) is therefore dismissed.

Applicants' trade mark No. 2139078

37. In this case the applicants' trade mark consists solely of the term Al Ajlan. It is the same term which features predominantly in the opponents' trade mark. Whereas in the other cases before me, in the applicants' trade mark the term Ajlan has appeared along with other matter, which has overwhelmed the term. In this case it is not so. There can be no doubt that the respective trade marks, in my view, taking account of all of the guidance set out above are similar. Sufficiently so, taking account of the identity and similarity of the respective goods for the public to be confused. For these reasons I believe the application No 2139078 falls foul of Section 5(2)(b) because of the opponents' earlier trade mark and the application for registration must be refused registration under that head.

Standard of review

12. This appeal is a review of the hearing officer's decision. Counsel for the appellant accepted that the hearing officer's decision with regard to section 5(2)(b) involved a multi-factorial assessment of the kind to which the approach set out by Robert Walker LJ in *REEF TM* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applied:

In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.

Counsel for the respondent reminded me of the point made by Robert Walker LJ in *REEF TM* at [29] that a decision does not contain an error of principle merely because it is infelicitously expressed.

First appeal: '070

13. The appellant contends that the hearing officer erred in principle in two respects. The first is that the hearing officer's conclusion in respect of '070 is inconsistent with his conclusion in respect of '078 since there is no material difference between the two marks. The second is that when considering '070 the hearing officer failed to consider what was the dominant feature of '236, even though he concluded that the expression AL AJLAN was the dominant feature of '236 when considering '078. The appellant argues that he should have reached the same conclusion when considering '078 and, further, that the significance of this expression is primarily surnominal.
14. Counsel for the respondent accepted that the third sentence of paragraph 37 of the hearing officer's decision dealing with '078 is wrong, since in '070 the term AJLAN does not appear with other matter which overwhelms it. Nevertheless, she argued that the two conclusions are not inconsistent with each other on the basis that '078 is in Roman script whereas '070 is in Arabic script, and that this could affect the average consumer's perception to such an extent as to lead to confusion in one case and not the other. The obvious

problem with this argument is that this difference did not form part of the hearing officer's reasoning. Moreover, it is difficult to see why the difference in script should have the effect postulated. As counsel for the respondent accepted, the average consumer of these goods must be taken to be able to read Roman script as well as Arabic script. In substance, therefore, the '070 and '078 marks are the same so far as the relevant average consumer is concerned. Accordingly, I consider that the hearing officer's conclusions in respect of '070 and '078 are inconsistent. This is an error of principle because cases which are materially alike should be treated alike. It follows that it is necessary for me to consider the section 5(2)(b) objection afresh.

15. In these circumstances it is unnecessary to consider whether the hearing officer erred in principle in the second respect contended for by the appellant. Nevertheless this aspect of the matter remains important, and I therefore turn to consider it next.
16. In my judgment the hearing officer's assessment in the second sentence of paragraph 37 of his decision is correct: the dominant component of '236 is AJLAN. The prefix AL, which appears in the cursive Arabic script but not in the stylized Arabic script or the Roman script, does not appear to be significant, since it appears that it means "the". Although the mark contains other matter, I consider that it is AJLAN that would be likely to lodge most strongly in the average consumer's memory.
17. The evidence establishes that by 15 July 1997 the expression AL-AJLAN (or AL AJLAN - the presence or absence of the hyphen does not appear to be material) had been used as a surname by a number of persons in Saudi Arabia, not all of were directly related to each other. As the hearing officer rightly found in paragraph 36 of his decision, the evidence does not establish how prevalent that surname was in Saudi Arabia, let alone how well known it was to Arabic speakers in the United Kingdom.
18. Accordingly, I consider that the hearing officer was right to conclude in paragraph 35 of his decision that an Arabic speaker might read the expression

AL-AJLAN in '070 in its literal sense or might read it as being a surname, in the same way as the English word SWIFT may be read in its dictionary sense or as a surname according to context.

19. In my view, however, that the possibility that the average consumer might read AL-AJLAN in the context of '070 in its literal sense, whereas he would certainly read it in the context of '236 as being a surname, does not mean that there is no likelihood of confusion. Even if the average consumer would read '070 in its literal sense, the two marks still have a considerable degree of phonetic (on the basis that '236 would become simply AJLAN & BROTHERS or its Arabic equivalent in oral use) and conceptual similarity. In English terms, the comparison is effectively between THE SWIFT ONE and SWIFT ONE & BROTHERS. Although '236 is a more visually complicated mark than '070, even visually there is a significant common factor. Given the identity and close similarity of the goods and making allowance for imperfect recollection, I conclude that there is a likelihood of confusion.
20. In reaching this conclusion I have not overlooked the respondent's unchallenged evidence that it has not encountered any confusion in practice. That may be explained by a variety of factors, in particular the fact that both parties have so far only used their respective marks for export to the Middle East. Since the specifications of '070 and '236 are not restricted to goods for export to the Middle East, the likelihood of confusion has to be assessed on the basis of notional normal and fair use of the marks in the United Kingdom.
21. In short, I consider that the hearing officer reached the correct conclusion in relation to '078 and that he should have reached the same conclusion in relation to '070.

Second appeal: '074

22. The appellant contends that when dealing with the '074 mark the hearing officer erred in principle in that he had failed to consider the likelihood of "indirect" confusion, that is to say, the likelihood that the average consumer

would think that the respondent's goods emanated from an undertaking which was economically-linked with the undertaking responsible for the appellant's goods. It argues that the hearing officer should have concluded that this was likely because the average consumer would believe the two undertakings to be branches of the same family tree.

23. In my judgment the hearing officer made no such error of principle. On the contrary, in paragraph 36 of his decision he expressly referred back to the criteria to be applied which he had set out earlier in the decision, which included consideration of this very point. Moreover, he expressly considered the effect of the inclusion in '074 of the words "Mohammed" and "Sons" as opposed to the inclusion in '236 of the references to "Brothers". While the phrasing of the penultimate sentence of paragraph 36 is not particularly felicitous, in that it could be read as indicating that the question was merely whether the average consumer was able to differentiate the marks, I am not persuaded that this shows that the hearing officer applied the wrong test. In reality, the appellant's arguments simply amount to saying that the hearing officer should have reached a different conclusion. In my view no sufficient ground has been shown for interfering with that conclusion.
24. A separate point which I should mention is that the appellant sought to rely upon evidence as to the likelihood of confusion given by a Mr Amin in opposition proceedings brought by the respondent against the appellant's '236 application. This evidence was not adduced by the appellant in the '074 opposition, however, nor was any formal application made to adduce it on this appeal. Indeed, I was not even shown the actual declaration relied upon. In any event, the evidence in question is opinion evidence from a person without any relevant expertise and therefore inadmissible.
25. Finally, I would add that I see no inconsistency between the hearing officer's conclusion with respect to '074 and the conclusion which I consider he ought to have reached with regard to '070 and which he did reach with regard to '078. In the case of '070 and '078 the mark applied for consists just of an expression, (AL) AJLAN, which is also a significant feature of '236; whereas

in the case of '074 the mark applied for contains other distinguishing elements. To adapt an analogy made by Counsel for the appellant in argument, the difference is between comparing SWIFT & BROTHERS with (in the case of '070 and '078) SWIFT and (in the case of '074) JOHN SWIFT & SONS. In my view it is clear that confusion would be more likely in the former case than in the latter.

Conclusion

26. The first appeal is allowed. The second appeal is dismissed.

Costs

27. The hearing officer ordered the appellant to pay the respondent £500 in respect of costs on the basis that the respondent had been successful in two cases and the appellant in one. The result of my decision is that the proportion of success has been reversed. Accordingly, I will substitute for the hearing officer's order an order that the respondent pay the appellant £500 in respect of the proceedings below. Before me each party has succeeded in respect of one case, and therefore I will make no order as to the costs of the appeal.

22 March 2004

RICHARD ARNOLD QC

Simon Malynicz, instructed by J.A. Kemp & Co, appeared for the appellant.

Mary Vitoria QC, instructed by Eric Potter Clarkson, appeared for the respondent.