

O/126/12

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION 2534117
IN THE NAME OF DAIRY FARM PRODUCTS LIMITED
IN RESPECT OF A SERIES OF TWO TRADE MARKS:**

RANI



RANI



AND

**AN APPLICATION (NO 83945) FOR INVALIDATION BY
AUJAN INDUSTRIES CO (S.J.C.)**

THE BACKGROUND AND THE PLEADINGS

1) The series of two registered trade marks the subject of these proceedings stands in the name of Dairy Farm Products Limited (the “Registered Proprietor”). It applied for the trade marks on 11 December 2009 and the registration procedure was completed on 24 September 2010. The trade marks and the goods for which they are registered are shown below:

RANI



RANI



Class 29: Milk and dairy products; yogurt; yogurt products, including yogurt-based beverages; milk-based beverages.

2) On 20 December 2010 Aujun Industries Co (S.J.C.) (the “Applicant”) applied for a declaration of invalidity in respect of the Registered Proprietor’s registration. Invalidity is sought under section 5(2)(b) of the Trade Marks Act 1994 (the “Act”) in relation to all the goods covered by the registration. The Applicant relies on earlier Community Trade Mark No. 4005211, as shown below. Blue and white were claimed as colours for the mark, and the description of the mark asserts: “The Arabic word is the vocal pronunciation of the Latin word “RANI” written in Arabic Script. “RANI” is an invented word that has no meaning”. The earlier mark covers goods in classes 29 and 30, but in the present proceedings only goods in class 29 (as shown below) are relied on:



Class 29: Milk and milk products; edible oils and fats.

The earlier mark is not subject to the requirement of proof of use under section 47(2A) of the Act as the registration procedure for the earlier trade mark was completed within (not before) the period of five years ending with the date of the application for the declaration of invalidity.

3) As part of its statement of case the Applicant claimed that:

“Whilst it is recognized that Community Trade Mark Registration No. 4005211 RANI (and Arabic equivalent) and UK Trade Mark Registration No. 2534117 RANI (and Device) are made up of two different aspects, the most memorable and recognizable of each is the word RANI”.

“In view of the fact that the respective trade marks are similar, and the goods in respect of which UK Trade Mark Registration No. 2534117 has been registered are either the same as, or similar to those within Class 29 for which registration has been obtained as a Community Trade Mark by Aujan Industries Co (S.J.C.), there exists likelihood of confusion on the part of the public. UK Trade Mark Registration No. 2534117 therefore falls foul of Section 5(2)(b) of the 1994 Trade Marks Act and should be removed from the UK Trade Marks Register”

4) The Registered Proprietor filed a counterstatement denying the grounds of invalidation. It claimed that differences resulting from the stylisation of the word RANI and the device element of the Applicant’s mark meant there was no visual similarity between them; that, regarding aural comparison, the element RANI could not be said to be so distinctive or dominant within the marks that this word should be considered in isolation from other elements of the marks when assessing likelihood of confusion; that the inclusion of the image of a cow in the Registered Proprietor’s mark gave rise to a strong conceptual difference from the Applicant’s earlier mark; that RANI would be understood by a significant proportion of the UK population as a word meaning “queen” or “lady” which, not being a made up word, had no particular distinctiveness; that several other

registrations on the UK Trade Marks Register included the word RANI, which, thus, did not possess any special degree of distinctiveness; and that the visual, aural and conceptual differences meant the marks were neither identical nor similar, so there could be no likelihood of confusion in the minds of the relevant public.

5) Neither side filed evidence. Neither side requested a hearing or filed written submissions in lieu of attending a hearing. I therefore give this decision after a careful review of all the papers before me.

SECTION 5(2)(b) OF THE ACT

6) This section reads:

“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.”

7) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead

rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) 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 of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks 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."

The average consumer

8) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer takes

when selecting goods or services can, however, vary depending on what is involved (see, for example, the judgment of the General Court (“GC”) in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

9) The goods concerned are not specialist ones. They are not highly considered purchases but routine, everyday ones. No more than an average degree of consideration will be deployed by the average consumer when selecting the goods. The goods are not such as would tend to be purchased only by a particular cultural or ethnic group. The average consumer I need to consider will therefore be a member of the general UK public at large.

Comparison of goods

10) In terms of the comparison to be made, all relevant factors relating to the goods in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment: “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.”

11) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services 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 or services 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 or services in the same or different sectors.”

12) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter,

regarded for the purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². Finally, when comparing the respective goods, if a term clearly falls within the ambit of a term in the competing specification then identical goods must be considered to be in play³ even if there may be other goods within the broader term that are not identical.

13) I consider that the terms “*milk products*” and “*dairy products*” are synonymous, both covering products made from milk. I consider all the goods covered by the Registered Proprietor’s registration – “*milk and dairy products; yogurt; yogurt products, including yogurt-based beverages; milk-based beverages*” – to fall within the ambit of “*milk and milk products*” in the specification of the Applicant’s earlier mark. The goods are therefore identical. Even if it could be argued that “*yoghurt products*” and “*yogurt-based beverages*” are not covered by “*milk products*”, their nature, purpose and method of use are closely aligned to those of milk products and their channels of trade are the same. The consumer expects to find them sold alongside other milk products, whether on the refrigerated or “long-life” shelves. They are certainly at least highly similar to milk products.

The distinctiveness of the Applicant’s earlier mark

14) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). No use of the earlier mark has been put forward so I have only its inherent characteristics to consider.

15) The earlier mark consists of what both sides agree to be a word in Arabic script, and beneath it the word RANI, written in white on a blue background, both words being presented with a slight upward slant from left to right. It is the word RANI which will be readable (and very easily) by the average consumer. It is the word RANI on which the attention of the average consumer will focus, and which forms the dominant component of the mark. The Registered Proprietor claims that the word RANI translates from many Indo-Aryan languages as “queen” or “lady”; that Indo-Aryan languages are understood by, and may be the mother tongue of, a significant proportion of the UK population; that RANI would be understood by a significant proportion of the UK population as a word meaning

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

³ See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM) Case T-133/05 (“Gérard Meric”)*.

“queen” or “lady”; and that, not being a made up word, it has no particular distinctiveness. I do not think that the word “queen” or “lady” necessarily lacks distinctiveness in relation to milk products. However, the average consumer I need to bear in mind for the purposes of my assessment will be a member of the general UK public at large. There is no evidence whatsoever to support the Registered Proprietor’s claims. In my view the average consumer will perceive RANI either as a made up word or as a foreign word or name with whose meaning or significance s/he is unfamiliar. As such I consider the word to have a reasonably high degree of distinctiveness and, through its dominance, to lend the mark overall a reasonably high degree of distinctiveness.

16) The Registered Proprietor also claims that numerous registrations on the UK Trade Marks Register include the word RANI, and that this means that it does not possess any special degree of distinctiveness. However, the comments in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 suggest that evidence on the state of the Register is in principle not helpful and, as I have pointed out above, no evidence on how the word will actually be perceived in the market was submitted. My finding that the word RANI will have a reasonably high degree of distinctiveness therefore remains unaffected.

Comparison of the marks

17) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

The registered marks	The earlier mark
	

18) I have explained above why I consider the word RANI to form the dominant and distinctive feature of the Applicant’s earlier mark. Similarly, I think it is the

word RANI on which the attention of the average consumer will focus in the Registered Proprietor's mark, and which forms the dominant and distinctive component of that mark. There is nothing particularly distinctive about the presentation of the cow's head in the mark. It is a straightforward – seemingly photographic – image. The average consumer is used to seeing images of cows in a rural setting used in the marketing of milk products. Having said that, when I make my assessment I will, of course, undertake a whole mark comparison as the elements beyond RANI in both marks cannot be regarded as negligible.

19) From a visual perspective, the presence of the Arabic word in the earlier mark and the device in the Registered Proprietor's mark certainly establish differences; but, given that these are the less dominant elements, they do not outweigh the similarity created by the presence of the word RANI. Nor do I think the different stylisation of the word RANI in the marks or the differing colours provide significant distinguishing features. The overall impression created by the prominent use of the word RANI therefore lends the marks, viewed as a whole, a reasonable degree of visual similarity.

20) I do not think that the average consumer would normally ask for the goods by describing the appearance of the trade marks. I think s/he would most naturally use the word prominent in both marks: RANI. The same word will be pronounced in the same way. As regards aural similarity the marks are, therefore, identical.

21) As regards conceptual similarity, for a conceptual meaning to be relevant, it must be one capable of immediate grasp. This is highlighted in numerous judgments of the GC and the CJEU, including *Ruiz Picasso v OHIM* [2006] ECR. –I-643; [2006] E.T.M.R. 29. I have found that the visually and orally dominant and distinctive element of both marks is the word RANI. I consider that the average consumer will perceive RANI either as a made up word, or as a foreign word or name with whose meaning or significance s/he is unfamiliar.

22) The Registered Proprietor claims that the image of a cow in its mark is likely to bring farming or the countryside to the mind of the average consumer, that neither of these things is suggested by the earlier trade mark, and that there is therefore a strong conceptual difference between the two marks. However, this is not the dominant element of the mark and, given its relationship with the goods, is not something the average consumer is likely to conceptualise as part of his/her conceptual hook. I therefore doubt that a straightforward image of a cow is, as such, apt to impart any conceptual message in the mind of the average consumer for the goods at issue. Even if it did form part of the mental hook, its significance should not be overplayed given the nature of the image in relation to the goods. Viewing the marks as a whole, I find no great conceptual similarity or dissimilarity between them.

Likelihood of confusion

23) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), and a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

24) I have found the goods specified in the Registered Proprietor's registration to be identical or highly similar to those covered by the Applicant's earlier mark. I have found the marks to have a reasonable degree of visual similarity and to be aurally identical, with a neutral conceptual content. I have found the earlier mark to possess a reasonably high degree of inherent distinctive character. The consumer is used to seeing businesses use variations of their mark in trade. Bearing in mind the interdependency principle, together with my assessment of the nature of the average consumer and their purchasing process, I have little hesitation in concluding that the average consumer will consider the relevant goods provided under the respective marks to be the responsibility of the same or an economically linked undertaking. Accordingly, there is a likelihood of confusion in respect of all the goods specified in the Registered Proprietor's registration. **The application for invalidation succeeds. The Registration is declared invalid under the provisions of section 47(6) of the Act and deemed never to have been made.**

COSTS

25) The Applicant has been successful and is entitled to a contribution towards its costs. I hereby order Dairy Farm Products Limited to pay Aujun Industries Co (S.J.C.) the sum of £400. This sum is calculated as follows:

Preparing a statement and considering the other side's statement – £200
Official fee – £200

26) The above sum should 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 22nd day of March 2012

Martin Boyle
For the Registrar,
The Comptroller-General