

TRADE MARKS ACT 1994
IN THE MATTTTER OF APPLICATION No 2055236
BY AJLAN BIN ABDULAZIZ AL-AJLAN & BROTHERS CO.
TO REGISTER TRADE MARKS
AJLAN & BROS and device
IN CLASS 25

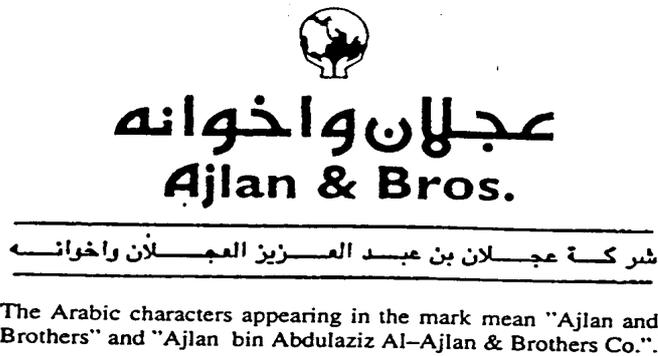
AND IN THE MATTER OF OPPOSITION THERETO
by AL-MASARAAT INTERNATIONAL TRADING & CONTRACTING
COMPANY LIMITED

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2055236
By AJLAN BIN ABDULAZIZ AL-AJLAN & BROTHERS CO.
TO REGISTER A TRADE MARK IN CLASS 25

AND IN THE MATTER OF OPPOSITION THERETO UNDER No 45681 BY
AL-MASARAAT INTERNATIONAL TRADING & CONTRACTING COMPANY LIMITED

DECISION

On 1 February 1996, Ajlan bin Abdulaziz Al-Ajlan & Brothers Co. of P.O. Box 42468, Riyadh 11541, Saudi Arabia applied under the Trade Marks Act 1994 for registration of the following Trade Mark in respect of "Clothing for men and children; headgear; footwear." in Class 25:



On the 10 October 1996 Al-Masaraat International Trading & Contracting Company Limited of P.O. Box 58965, Riyadh 11515, Saudi Arabia filed notice of opposition to the application. The grounds of opposition are in summary:

i) The mark applied for "contains the device of a globe which is a common sight in Saudi Arabia and ought to be refused registration under the provisions of Section 1(1), Section 3(1)(a), and Section 3(1)(b) of the Trade Marks Act 1994, as being a sign which is not capable of distinguishing the Applicants' goods from those of other undertakings and which is devoid of any distinctive character."

ii) The mark applied for "consists of a sign which has become customary in the bona fide and established practices of the trade, and ought to be refused under the provisions of Section 3(1)(d) of the Trade Marks Act 1994. Attached are various representations showing the common use of 'Globe' signs in Saudi Arabia."

iii) The mark applied for "is of such a nature that it is contrary to public policy and ought to be refused registration under the provisions of Section 3(3)(a) of the Trade Marks Act 1994."

The opponents further requested that the Registrar refuse application number 2055236 in the exercise of his discretion. However, under the Trade Marks Act 1994 the Registrar does not have a discretion to refuse an application as he did under the old law. An application can only be

refused if it fails to comply with the requirements of the Act and Rules in one or more respects.

5 The opponents also requested Security of Costs under Section 68 of the Trade Marks Act 1994 and Rule 55(1) of the Trade Marks Act 1994, and in the event of this not being given that the Registrar consider that the applicants as having withdrawn their application as provided for under Rule 55(2).

10 The applicants filed a counterstatement denying all the grounds of opposition, pointing out that whether a globe device is common in Saudi Arabia is irrelevant to the opposition of a registration in the UK. It was also claimed that the globe device used in the mark in suit is the subject of a trade mark registration in Classes 24 & 25 in Saudi Arabia. They asked for the Registrar to exercise discretion in their favour and also asked for Security of Costs. The issue of security of costs was not dealt with at the time, but remains an issue to be considered in the event of an appeal. Neither party wished to be heard in this matter. My decision will therefore be based on
15 the pleadings and the evidence filed.

OPPONENTS' EVIDENCE

20 This consists of a statutory declaration, dated 5 October 1997, by Mr Mohammed Abdul Rahman Theneyan the Vice President of Al-Masaraat International Trading and Contracting Company Limited (the opponents).

25 The opponents' business is stated to be that of merchants. Mr Theneyan states that the applicants' mark is not capable of distinguishing the applicants' goods from those of other undertakings in Saudi Arabia. He claims that although the applicants are seeking registration in the UK, it is his belief that the goods bearing the applicants' mark are for export to Saudi Arabia. It is his contention therefore that the distinctiveness of the mark has to be considered in Saudi Arabia.

30 Mr Theneyan contends that the applicants' mark fundamentally consists of two non distinctive elements. These are a "globe" device and the surname "Ajlan". It is claimed that globe devices are common to many fields including the textile industry in Saudi Arabia. At exhibit MART1 are examples of yashmaghs from different suppliers which show the use of a globe device on the
35 packaging and also on the yashmaghs themselves. In addition a number of photographs of signs on buildings in Saudi Arabia are provided and all have a globe device incorporated in them.

40 Mr Theneyan also exhibits a search relating to globe devices carried out in Saudi Arabia which shows a number of devices registered. He comments that only one mark consists solely of a globe held in a pair of hands (said to be another common device in Saudi Arabia), that belonging to the applicants. Mr Theneyan comments that he believes that the mark should not have been allowed onto the register in Saudi Arabia.

45 With regard to the name "Al Ajlan", Mr Theneyan comments that it is a common name in Saudi Arabia and backs up this assertion with the relevant pages from the Saudi Arabian telephone directory (these show 299 entries for the surname Al Ajlan). He asks that this evidence be taken into account as although the applicants' goods are to be manufactured in the UK, he claims that

they are strictly for export to Saudi Arabia and the Gulf States.

Mr Theneyan also comments on the claims of the applicants to have registered the marks in Saudi Arabia stating that the mark applied for in the UK differs from that registered in Saudi Arabia, and also the proprietor's name is different. Further he claims that the applicants are using the opponents registered brand name MALAKI. Examples of both the applicants and opponents goods are exhibited and the name MALAKI appears. There are a number of detailed comments on the similarity of the opponents' and applicants' marks and the repute of the opponents in Saudi Arabia, but these do not appear to be relevant to the grounds of opposition filed.

APPLICANTS' EVIDENCE

This consists of a statutory declaration by Mr Ajlan Abdul-Aziz Ajlan Al-Ajlan the general manager of Ajlan bin Abdulaziz Al-Ajlan, the applicants. Mr Al-Ajlan has held this position for four years. He states that the applicants are manufacturers of head shawls or yashmaks and clothing merchants, and that the opponents are "one of its traditional competitors".

Mr Al-Ajlan claims that the mark they are seeking to register is an established mark of the applicant and is known throughout the Middle East. He states that the mark has been used for a number of years and that the applicants have held a registration of it since 1991 (the country of registration is not specified). He also claims that they have used the mark in the UK "since 1995 in relation to yashmaks for export". He elaborates that all yashmaks bearing the mark in question are exported to Saudi Arabia from where they are distributed throughout the Middle East.

Mr Al-Ajlan states that "since 1995, the turnover in Middle Eastern countries in goods sold under the mark and exported from the United Kingdom has amounted to not less than £4,378,665." He explains that no advertising has been carried out in the UK market "as goods bearing the mark are not intended for sale in the United Kingdom". They have been advertised in Saudi Arabia, sometimes via TV and radio stations broadcasting to the Middle East from London.

Mr Al-Ajlan questions the relevance of the opponents' evidence relating to practice in Saudi Arabia when it is registration in the UK that is sought. In any event he disputes the claims that the applicants' globe device is not distinctive, and also states that the other devices exhibited by the opponents are "in no way similar or comparable".

Mr Al-Ajlan also makes a number of comments regarding the registration and ownership of marks in Saudi Arabia and the commonality of the name Al-Ajlan, none of which are relevant to these proceedings.

Regarding the use of the name MALAKI, Mr Al-Ajlan explains that the word means "royal" which he claims is traditionally connected with yashmaks. He also comments that the opponents' UK registrations do not give exclusive rights in the term MALAKI, whether in Roman or Arabic text.

OPPONENTS' EVIDENCE IN REPLY

This consists of another statutory declaration by Mr Theneyan, dated 22 September 1998.

Firstly Mr Theneyan comments that in a previous opposition case (number 45289) Mr Al-Ajlan claimed to have been the general manager for 18 years whereas in this case he claims to have been in the same position for only four years.

5 Mr Theneyan questions whether the applicants have held a registration in the mark since 1991, and whether they are manufacturing yashmaghs in the UK bearing the mark applied for. He also states his doubts as to whether the mark is used as a trade mark, and whether they are sold in the Middle East and also the turnover figures provided.

10 Mr Theneyan reiterates his belief that the “globe devices are not registrable per se due to their ubiquitous nature.” He provides further examples of yashmaghs with globe type devices on them to back up this view. Mr Theneyan states his contention that “globe devices within Saudi Arabian commerce, and to whatever field they relate, cannot be afforded distinctiveness, and the only meaning which may be attributed to such devices is the universal nature of the business they represent.”

15 With regard to the name “Al-Ajlan”, Mr Theneyan restates that the name is a common one, and that anyone born with the names Ajlan or Al-Ajlan has rights in the name and that one particular Al-Ajlan cannot claim trade mark rights in the name. He exhibits the details of three other companies in the textile field who trade under the name of Al-Ajlan. Examples of the packaging complete with translations are provided to back up this statement.

20 Mr Theneyan makes additional comments regarding the use of the word MALAKI, but these are not relevant to this action.

25 That concludes my review of the evidence. I now turn to the decision.

SECTION 1(1) & SECTION 3(1)(a) OF THE ACT

30 Section 1(1) of the Act is in the following terms:

35 *“1 (1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings”.*

“A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

40 Section 3(1) of the Act is in the following terms:

3 (1) The following shall not be registered -

(a) signs which do not satisfy the requirements of section 1(1),

45 The opponents have offered no evidence as to why the mark cannot function as a trade mark. I do not think that the mark AJLAN & BROS and DEVICE is so descriptive that I can say now that the applicants will never be able to educate the public to regard the words as a trade mark

denoting only their goods or services. The opposition under Sections 1(1) & 3(1)(a) therefore fails.

SECTION 3(1)(b)

5

3 (1) The following shall not be registered -

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

10

The mark in question is AJLAN & BROS and DEVICE. The opponents contend that surname Al-Ajlan is common in Saudi Arabia and therefore not distinctive. They also comment that the globe device used in the application is a common device in Saudi Arabia and is non distinctive. A similar point was considered by the Court of Appeal in the AL BASSAM case [1995] RPC 511 at page 525 where Morritt L.J. said:

15

“The Registrar concluded that notwithstanding the surnominal significance of the word Bassam

20

‘Considering the mark as a whole I find that it is capable of distinguishing the applicants goods so as to qualify it for registration in Part B subject to disclaimer of descriptive material’

25

In doing so he had adopted the practice of the Registry at the examination stage of considering how often the surname appeared in certain telephone directories. Aldous J. held such practice to be inappropriate for dealing with an objection after advertisement as to compliance with Section 10.

30

Before the judge, who reached the same conclusion as the Registrar, it was submitted by the Opponents that in the case of goods for export it was right to take account of the position in such countries as Saudi Arabia as that is where the mark had been and would be seen and that in such places the surnominal significance was substantially greater. The judge declined to do so. He said:

35

‘The Trade Marks Act 1938 provides for registration of marks that are used and to be used or deemed to be used in the United Kingdom. The exclusive rights given by the Act are confined to the United Kingdom. Thus there is no reason why a mark which would be registrable when the position in the United Kingdom is considered should be refused registration under section 10 because of events or matter particular to another country.

40

45

The evidence establishes that the name Al Bassam is fairly common in Saudi Arabia as appears from the number of entries in telephone directories. However, that is not the position in this country. Even so, I believe it right to conclude that Arabic speakers in this country would recognise the name as having a surnominal significance, but I see no reason to conclude that it would not be capable of distinguishing as the name is so little known in this country. There is no evidence

which leads me to think that registration of the mark in Part B would impinge upon the needs of any honest trader in this country.”

5 The Opponents accept that the test there formulated is wholly consistent with the formulations established in *W & G du Cros Ltd.’s Applications* (1913) 30 RPC 660 at page 672; *Bagots Hutton & Co. Ltd.’s Applications* (1916) 33 RPC 357 at page 369; *Reddaway’s Application* (1927) 44 RPC 27 at page 37 and *Impex Electrical Ltd v Weinbaum* (1927) 44 RPC 27 at page 410. But they contend that section 31 Trade Marks Act 1938 has changed the law in this respect. They rely on a passage in the judgement of
10 Sir Raymond Evershed M.R. in *Hassan-el-Madi’s Application* (1954) 71 RPC 348 at page 357 which left for future consideration whether section 31 had any effect on *Bagots Hutton*. I confess that I do not see how section 31 can have any effect on the principle of *Bagots Hutton* and *Reddaway*. All section 31 does is to treat the application of the trade mark and any other act done in the United Kingdom in relation to goods to be exported
15 from the United Kingdom as done in the United Kingdom in relation to goods to be traded in the United Kingdom. If, in accordance with *Bagots Hutton* deception or confusion abroad is a matter for the courts of that jurisdiction and not a ground for refusing registration in the United Kingdom section 31 by, in effect, removing the foreign element cannot affect the matter.

20 In my view the judge was right to consider the ability of the mark to distinguish the goods of Courtaulds by reference to the position in the United Kingdom only and the appeal on this point also fails.”

25 Although these comments related to a trade mark being registered under the 1938 Trade Marks Act, the comments are relevant to the 1994 Act. The opponents have filed no evidence to show why the mark applied for is devoid of distinctive character so far as market in the United Kingdom is concerned.

30 The opposition under Section 3(1)(b) therefore fails.

SECTION 3(1)(d)

35 3.- (1) *The following shall not be registered*
(d) *trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:*

40 Again the opponents have filed no evidence which proves that the mark applied for offends against this Section of the Act. The opposition under Section 3(1)(d) therefore fails.

SECTION 3(3)(a)

45 (3) *A trade mark shall not be registered if it is -*
(a) *contrary to public policy or to accepted principles of morality,*

The opponents' evidence does not contain any arguments to explain why the acceptance of the applicants' trade mark would be contrary to public policy or to accepted principles of morality. The ground of opposition under Section 3(3)(a) therefore fails.

5

The opposition having been unsuccessful the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £435

10

Dated this 15 day of June 1999

15

George W Salthouse
For the Registrar
The Comptroller General