

O/186/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION
No. 2520407
BY HAJI BABA
TO REGISTER THE TRADE MARK**



IN CLASS 29

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 99930 BY
MOHAMMED DIN AND MAQBOOL AHMED**

BACKGROUND

1) On 7 July 2009 Haji Baba (hereinafter the applicant), applied to register the following trade mark:

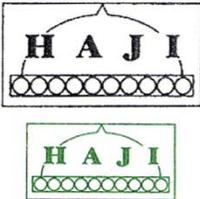


2) In respect of the following goods in Class 29: “Processed food, pre-packed frozen food, pre-packed chilled food, pre-packed cooked and uncooked ,meat and poultry.”

3) The application was examined and accepted, and subsequently published for opposition purposes on 25 September 2009 in Trade Marks Journal No.6804.

4) On 23 December 2009, Mohammed Din and Maqbool Ahmed, (hereinafter the opponents) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponents are the proprietors of the following trade marks:

Number	Mark	Filing and Registration Date	Class	Specification relied upon
2350467	HAJI	04.12.2003 / 21.05.2004	3	Detergents, cleaning preparations, bleach; detergents, cleaning preparations, bleach, all being for household use; detergents for dishwashing.
			29	Milk and milk products; cheese, eggs; dried lentils; frozen vegetables; frozen meat.
			30	Spices.
			31	Nuts.
2350764	 The applicant claims the colour green as an element of the second mark in the series.	05.12.2003 / 03.09.2004	3	Detergents, cleaning preparations, bleach; detergents, cleaning preparations, bleach, all being for household use; detergents for dishwashing.
			29	Milk and milk products; cheese, eggs; dried lentils; frozen vegetables; frozen meat.
			30	Spices.
			31	Nuts being fresh or unprocessed.

b) The opponents state that the marks of the two parties both have the word HAJI as their first word and both provide meat products. The opponents claim to have used their marks in the UK, starting in Rochdale but subsequently delivering throughout the UK, since 1958 in relation to meat and poultry. The opponents contend that the mark in suit therefore offends against Section 5(1), 5(1)(a), 5(2)(b) and 5(4)(a) of the Act.

5) On 10 May 2010, the applicant filed a counterstatement which denied the opponents' claims. The applicant claims to have been in business trading under the name HAJI BABA for over thirty five years and has never heard of the opponents. The applicant also put the opponents to strict proof of use.

6) Both sides filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 2 April 2012 when the applicant was represented by Mr Longstaff of Counsel instructed by Messrs Alexander Ramage Associates LLP; and the opponents by Mr Wilkes of Messrs Groom Wilkes & Wright LLP.

OPPONENTS' EVIDENCE

7) The opponents filed a witness statement, dated 13 April 2011, by Mohammed Din, one of the co-owners of the trade marks shown in paragraph 4 above. He states that he and his partner trade under the name HAJI and also use the stylised version of the mark as shown above. He states that the business has existed since 1955, something which is reflected in the partnerships' website, a copy of which is provided at exhibit MD2. This shows use of trade mark 2350764. It states that the company has a superstore and a cash and carry. It appears they also offer services such as money transfers and investments. The exhibit is dated 7 April 2011. It also shows the establishment date (1955), and a copyright date of 2010. At MD3 he provides a copy of a letterhead and business card. These refer to the cash and carry and catering supplies but show the same address in Rochdale as the superstore. Mr Din states that the store caters mostly for the Asian section of the town. He states that the partnership "have been the pioneers of Fresh Halal meat and poultry for over 50 years under the HAJI name". He states that in addition to being the name of the shop the name "HAJI" is used as an own brand on goods sold in the shop and via other outlets. He states: "HAJI is used in respect of, inter alia – fresh meat(1965), fresh poultry (1965), lentils(1979), nuts(1979), spices(1979), basmati rice(1980), cheese (1992), frozen meats(1993), pizza cheese(1994), eggs, chicken burgers, chicken nuggets, frozen foods, bleach, washing up liquid, frozen vegetables and flour". The dates shown in brackets are the approximate dates that Mr Din provides regarding when the first use of "HAJI" occurred on the relevant product. He states that detailed records are not available. He does confirm that in the five years prior to the advertisement of the mark in suit the name HAJI or the HAJI logo was used on all of the items listed.

8) At exhibit MD4 he provides labels and photographs of products which have the HAJI logo mark upon them. These show use on eggs, vegetable samosas, frozen lamb samosas, frozen chicken samosas, washing up liquid, mozzarella /cheese alternative,

mozzarella/cheddar, mozzarella, lamb chops, chicken, lamb leg, sheep leg, breaded steaks, breaded nuggets. These have best before dates ranging from 27 April 2011 to April 2012, outside any relevant period. There are also pictures of a small butchers department in a shop offering fresh meat, sacks of rice which are labelled “tolly boy” although they also state that they were packaged for “Haji Cash and Carry”. There are also photographs of carrier bags with the logo mark and the address of the shop in Rochdale. At exhibit MD5 Mr Din provides three invoices. The first, dated 8 June 2009, is to “Spice Fusion” in Rochdale for £367.61 and includes Haji brand tandoori chicken and fresh chicken fillets amounting to £90.48. The second invoice, dated 16 June 2008, is addressed to an individual living in Middlesex whose name cannot be read. The invoice states that cash was paid, and it relates to lamb mince, kebab keema, sheep chops and chicken wings. All are shown as own brand HAJI items, and the invoice totals £45.40. The third invoice, dated 2 June 2008, is addressed to a Mr Zaidi also of Middlesex. It also shows that cash was paid prior to the invoice being produced and relates to Chicken burgers, chicken nuggets, chicken breast, lamb leg and lamb mince, all being HAJI own brand and totalling £93.21. The second and third invoices also appear in exhibit MD6 but with somewhat different printing.

9) Mr Din provides the following estimates of turnover attributable to the retail of food and drink under the mark HAJI or HAJI logo.

Year	Approximate turnover £
2005	3.5 million
2006	3.8 million
2007	4 million
2008	4.5 million
2009	5 million

10) Mr Din estimates that approximately 25% of these figures relates to sales of products under the HAJI or HAJI logo own brands. He states that although based in Rochdale they sell throughout the UK. At exhibit MD6 he provides twenty five invoices. These date from 16 June 2008 – 12 December 2009, although most are from June 2009. Out of the twenty five invoices, seven post date the date of the application in suit. Four are to individuals in London and Middlesex where the bill was paid in cash prior to the invoice being typed, suggesting that these individuals collected their product at the shop. Interestingly, two of these invoices were also provided at exhibit MD5. However, the printing on these copies is in a totally different alignment despite being otherwise identical. There is only one invoice relating to anywhere other than Lancashire, Cheshire and North Wales, and that is for the provision of forty kilos of Basmati Rice to a business in London. It is clear from a number of the invoices that the businesses being supplied included a number of restaurant or takeaway outlets. All of the invoices in MD6 show use of the HAJI logo in relation to retail services. The following table relates to all the goods shown on the invoices in MD6 which are shown on the invoices as being branded “Haji”. I have included all of the invoices despite my reservations regarding at least two of them. I have also included the single unduplicated invoice from MD5.

PRODUCT	Prior to application date	After application date but prior to publication date
colour red	13.98	0
colour yellow	4.98	0
Bayleaf	4.24	3.49
almond powder	20.99	0
Elachi Green	0	99.80
Elachi Black	0	12.99
Saunf	0	9.77
Chana Dall	0	13.98
Dalchini	5.99	4.19
Panch Puran	0	3.99
chilli powder	12.99	0
Aniseed	0	37.82
Cloves	0	23.98
Mustard seed	0	5.98
coconut flour	11.49	0
Eggs	8.98	2.49
Mozzerela Cheese	0	289.86
Lentils	9.49	0
basmati rice	544.99	0
fresh mince	19.95	39.90
lamb mince	67.83	0
lamb leg	23.88	0
sheep chops	59.90	0
chicken wings	14.00	0
chicken breast	35.05	0
chicken fillet	169.02	147.70
kebab keema	20.93	0
Chicken burger	68.77	70.00
chicken nuggets	24.95	
tandoori chicken	87.56	22.49
Yoghurt	38.51	26.94

11) At exhibit MD7 Mr Din provides a letter from TRS Wholesale Co Ltd in London. This is a "to whom it may concern" letter and as such carries little weight (TPN 5/2009). It merely states that they have been dealing with "Mssrs Haji Cash and Carry Ltd" for 30 years. It does not state in what capacity or provide any other details. Mr Din states that the partnership advertises their business through their website, newspaper advertisements, business magazines, charity events and sponsoring a local football team. At exhibit MD8 he provides photographs of a football shirt for Rochdale Asia FC which has the HAJI logo mark upon it.

APPLICANT'S EVIDENCE

12) The applicant filed a witness statement, dated 9 September 2011, by Mr Nisar Malik a co-owner of the applicant. He states that they have been selling a wide range of halal meats and groceries under the HAJI BABA name since 1972 in the West London area. He states that in 2009 they opened six halal meat concessions in Asda stores in the London area. This is confirmed at the company website, pages from which were provided at exhibit HB2. He also provides the following exhibits:

- HB4: A copy of a letter, dated 2 September 2011, from Hounslow council confirming that since their present records system commenced in 1990 the business Haji Baba Food Store has been paying business rates. Also provided is a copy of the rates demand for 1.4.90-31.3.91, which is addressed to Haji Baba Food Store.
- HB5: A copy of a letter, dated 13 July 2011, from HSBC bank confirming that the business has had a bank account in the name Haji Baba Foodstore since November 1996.
- HB6: Copies of seven invoices from Mr Meats Wholesale Ltd to Haji Baba Food Store covering the period 7 October 2009 – 12 December 2009 showing purchases of £3,237.92.
- HB7: Copies of thirteen invoices from MCM Halal meat wholesaler to Haji Baba covering the period 28 December 2002 – 22 December 2007 showing purchases of £9,558.82.
- HB8: Copies of three invoices from Maxim Pharmaceutical & Marketing Co, to Haji Baba Food, although two are the same invoice simply amended due to the full order not being delivered. They are dated 29 November 2007 and 18 December 2007 and show a wide range of goods from biscuits to toothpaste totalling £872.21 being delivered.
- HB9: Copies of nine invoices from Medina Dairy Ltd to Haji Baba relating to eggs, milk and bread covering the period 1 March 2003 - 24 June 2008 and totalling £1,052.92.
- HB10: Copies of eight invoices from R & R Meat & Poultry to Haji Baba covering the period 11 November 2007 – 16 June 2008 totalling £9,950.16.
- HB11: Copies of three statements from Winterton Brothers Ltd, Bucks a major supplier of halal chicken to Haji Baba Food Store. Each statement shows numerous invoices and are dated 31 August 2002 (£1,000.82), 15 March 2003 (£425.50), 21 August 2004 (£959.00). Also included in this exhibit is a group of eight invoices dated between 6 January 2005 and 21 January 2005 totalling £968.29.

- HB12: Copies of two receipts from Bestway Cash & Carry Ltd to Haji Baba Food Store in relation to a range of goods from cigarettes to soap purchased on the same day 11 August 2005 and totalling £1,176.95
- HB13: A copy of an invoice dated 2 December 2002 from General Food Trading Co Ltd to Haji Baba in relation to drinks, cooking sauces and tinned fruit totalling £509.68.
- HB14: Copies of two invoices from Summers Poultry Products Ltd to Haji Baba Foodstore dated 14 & 28 March 2005 totalling £607.13.
- HB15: Copies of invoices for the period December 1997 – 13 June 2008. I have ignored those invoices which are dated after the application date. The invoices are all from TRS Cash & Carry Limited and are addressed to Haji Baba Food Store and total £21,526.24. They show purchases of all the items that one would expect to find in a small grocery or corner store.
- HB16: A letter dated 1 August 2011 from TRS Cash & Carry Limited “to whom it may concern” stating that they have dealt with Haji Baba Food Store for 30 years. Clearly this carries little weight (TPN 5/2009).
- HB17: This is a letter from the Chairman of the Pakistan Welfare Association Hounslow to the IPO dated 27 July 2011. The letter states:

“I write to support the application of Mr Nisar Malik for the registration of “Haji Baba” as a brand name.

Haji Baba is known to the West London community for the last 35 years, I have personally known the family and the business well for the past thirty years, it started as a small business from Staines Road and then moved to Kingsley Road in Hounslow. Mr Mohammed Younas, the founder of Haji Baba in Hounslow, recognised the need of the community and started a small business supplying asian groceries and halaal meat.

I understand you have already registered the name “Haji” for another organisation. I take this opportunity to clearly state that the registration of the of the name HAJI on its own for exclusive use can not be acceptable to the Muslim community at large, as it is a universal name used for anyone who has carried out the journey of pilgrimage to Makkah, Saudi Arab [sic] once in their lifetime, that cannot be owned or sold by any government department and as Chair of the Hounslow Muslim Forum and Pakistan Welfare Association Hounslow, demand that this registration must be cancelled/withdrawn with immediate effect.”

- HB18: A letter, dated 26 August 2011, from Imam M Hasmi, who writes:

“Please be advised and be clarified that the word HAJI is a universal Islamic title/name given to someone who performs “HAJ”, and he becomes HAJI. Word Haji cannot be owned or property of any one person or a company, it’s like someone having the right over the name “MOSES” or “ARCHBISHOP”.

- HB19: A letter, dated 27 August 2011, from Sheikh Khalifa Ezzat an Imam and Head of Religious affairs at the London Central Mosque Trust Limited and The Islamic Cultural Centre. He states:

“I hereby confirm that the word Hajj literally means visit to a sacred place. The word Hajji refers in Arabic to the person who performs pilgrimage [Hajj] in Makkah, Saudi Arabia which is one of the five pillars of Islam. This word is not limited to one person, it is a title for every one who does pilgrimage.”

- HB20: This consists of a number of pages from the internet which shows a number of shops trading with the name HAJI being the first or only part of the name. E.g Haji Foods, Haji & sons, Haji Food Store and Haji Yusuf sweets.

13) All the invoices provided in the above exhibits are said to be merely a representative sample. Mr Malik states:

“A person who has performed Hajj is known as “Haji”. Many businesses are named after the act of Hajj and it communicates instantly that you are Muslim and you have gone to the journey of Hajj and that, more importantly, you can be trusted. That is why a number of food suppliers use the word “Haji” as it provides confirmation that their food should be considered halal (permissible food for Muslims). The term “Haji” is already spiritually trade marked by the Islamic faith and by a billion Muslims, it is therefore an open sourced noun and should be kept free for all to use.”

14) Mr Malik makes a number of comments regarding the opponents’ evidence, pointing out that much of it is after the relevant date and that whilst the invoices show sales of various goods few if any are under the HAJI brand. He contends that the opponents’ evidence does not corroborate their claims.

15) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

16) Following the hearing the applicant amended its specification. This will be reflected in the goods comparison. At the hearing the opponents withdrew their grounds of opposition under Section 5(1) and 5(2)(a). I shall therefore firstly consider the ground of opposition under Section 5(2)(b) of the Act which reads:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.”

17) 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.”

18) The opponents are relying upon their trade marks 2350467 and 2350764 which are clearly earlier trade marks. They were registered on 21 May 2004 and 3 September 2004 respectively. Because of the interplay between the date the mark in suit was published (25 September 2009) and the registration dates of the opponents marks, the Trade Marks (Proof of Use, etc) Regulations 2004, come into play, paragraph six of which states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
 - (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (4) For these purposes-
- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
 - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.
- (7) Nothing in this section affects –
- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or
 - (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration)."

19) I must first consider whether the opponents have fulfilled the requirement to show that genuine use of the mark has been made. In the instant case the publication date of the application was 25 September 2009, therefore the relevant period for the proof of use is 26 September 2004-25 September 2009. The guiding principles to be applied in determining whether there has been genuine use of a mark are *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following main points:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);

- the use must be 'on the market' and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

20) The opponents' marks are registered for the following:

Number	Class	Specification
2350467	3	Detergents, cleaning preparations, bleach; detergents, cleaning preparations, bleach, all being for household use; detergents for dishwashing.
	29	Milk and milk products; cheese, eggs; dried lentils; frozen vegetables; frozen meat.
	30	Spices.
	31	Nuts.
2350764	3	Detergents, cleaning preparations, bleach; detergents, cleaning preparations, bleach, all being for household use; detergents for dishwashing.
	29	Milk and milk products; cheese, eggs; dried lentils; frozen vegetables; frozen meat.

	30	Spices.
	31	Nuts being fresh or unprocessed.

21) The opponents contended that exhibits MD4, MD5 and MD6 in addition to the witness statement of Mr Din was more than enough to meet the proof of use criteria. The applicant pointed out that the evidence of Mr Din was challenged in their evidence and it had been contended that it did not meet the standard required. To my mind I cannot accept evidence, challenged or not, uncritically. I look to the comments of Mr Alexander Q.C acting as the Appointed Person in BL O-410-11 when he concluded at paragraph 22:

“Overall the adequacy of evidence falls to be assessed in reference to the Lord Mansfield’s aphorism from *Blatch v. Archer* (1774) 1 Cowp 63 at 65, cited, inter alia by Lord Bingham in *Fairchild v. Glenhaven Financial Services Ltd* [2002] UKHL 22 [2203] 1 AC 32 and in *Club Sail*:

“...all evidence is to be weighed according to the proof which it was in the power of one side to have produced, and in the power of the other to have contradicted.”

22) Therefore, I must assess what has been claimed and also what has been corroborated by the applicant. Firstly, whilst the exhibits in MD4 show use of the mark on a number of items, the only discernible dates are those after the relevant period. Whilst the dates shown are “best before” dates, these are approximately 19-31 months after the relevant period to show use of the mark. Mr Wilkes contended that I should view the labels shown as being indicative of prior use which would be established by the invoices in MD5 & 6. He claimed that it was not possible to obtain evidence of labels used on meat so long after the relevant date. Firstly, even if I accept that the products are frozen, and this is not certain for all the products shown, in my experience these dates do not usually exceed a year other than for vegetables when they sometimes go up to 18 months. If the opponent contends that the best before date is a longer period which would have meant that the item could have been sold within the relevant period it should have provided evidence to back up this contention. Next I do not accept that it was not possible to show use of the marks in suit for the relevant period upon frozen meat. Surely a retail outlet with a turnover of up to £5 million at the end of the proof of use period would send out leaflets or advertise their products in some manner. Copies of such advertising would have sufficed. Failing that, can it really be contended that the opponents’ purchase in goods in the classes for which the mark is registered in bulk and then repackage and label the goods with the marks in suit on the shop premises. They claim to be selling over £1 million worth of own branded goods per annum. Surely they must purchase some goods which are produced for them with their own brand already upon the item, or at the very least purchase the labels. The question that must be asked is why did they not file such evidence?

23) At paragraph 10 above I have analysed the invoices provided at MD5 & 6 and show the total amount for each item listed on the invoices. The specifications for both marks

are effectively identical, and it was contended at the hearing that the logo mark is used upon the goods. Mr Wilkes contended that this amounted to use of the word only mark. He also contended that the invoices were merely a representative sample, although, as I pointed out at the hearing, the witness statement does not make this claim. Despite this, for the purpose of this decision I will accept the contention that the invoices are merely representative, and that the opponents could have filed further invoices which would have boosted the paltry amounts shown as being sold, although I cannot assume that it would have been able to file additional invoices where no use at all has thus far been shown.

Class	Specification	Corresponding goods shown on invoices	Value of goods sold £
3	Detergents, cleaning preparations, bleach; detergents, cleaning preparations, bleach, all being for household use; detergents for dishwashing.	None	0
29	Milk and milk products; cheese, eggs; dried lentils; frozen vegetables; frozen meat.	Yoghurt Cheese Eggs Lentils None None	65.45 289.86 11.47 9.49 0 0
30	Spices.	Colour red, colour yellow, bayleaf, almond powder, elachi green, elachi black, saunf, chana dall, dalchin, panch puran, chilli powder, aniseed, cloves, mustard seeds, coconut flour.	290.65
31	Nuts.	None	0

24) In addition there were sales under the HAJI (word only) brand of:

Basmati rice: £544.99.

Processed foods: (kebab keema, chicken burgers, chicken nuggets and tandoori chicken): £294.70.

Fresh Meat: (Fresh mince, lamb mince, lamb leg, sheep chops, chicken wings, chicken breast, chicken fillets): £577.23.

25) Clearly, basmati rice or any of the processed foods cannot be regarded as covering any of the goods for which the marks are registered. This leaves the items in paragraph 24 above under the heading “Fresh meat”. I have described them in this manner as the photographs of the butchers counter provided in the evidence shows only a sign for fresh meat. None of the invoices refers to any of the “haji” branded meat as being frozen. The onus is upon the opponents to show clearly use of their mark upon the goods for which that mark is registered when put to strict proof of use. The strongest case that the opponents had was under its registration for frozen meat and one would

have assumed that they would have concentrated upon this single item instead of putting in use on basmati rice for which it is not even registered. Whilst all of the invoices have the Haji logo mark upon them this is used in relation to the cash and carry retail aspect and not the branding of the goods.

26) The applicant also referred me to two decisions of the General Court: Firstly, *Centrotherm Systemtechnik GmbH v. OHIM* Case T-434/09 where the Court said:

“28. As to the extent of the use to which the trade mark at issue has been put, account must be taken, in particular, of the commercial volume of the overall use, as well as the length of the period during which the mark was used and the frequency of use (see *LA MER*, paragraph 56 and case-law cited). That assessment entails a degree of interdependence of the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or regular, and vice versa (see *LA MER*, paragraph 57, and case-law cited).

29. However, the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor of the mark to produce additional evidence to dispel any doubts as to the genuineness of its use (judgment of 18 January 2011 in Case T-382/08 *Advance Magazine Publishers v OHIM – Capela & Irmaos (VOGUE)*, not published in the ECR, paragraph 31).

30. Moreover, genuine use of a trade mark cannot be proven by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (see *LA MER*, paragraph 59, and case-law cited).”

27) Secondly, to *Volkl GmbH & Co KG v. OHIM* Case T-504/09 where the Court said:

“97. None the less, in order for these invoices to constitute material evidence as to the use of the earlier mark in relation to the goods referred to in paragraph 6 above, it is necessary to ascertain whether they did actually cover such goods and, if so, whether those goods bore the earlier mark or, at least, whether that mark was used, in accordance with its essential function, publicly and outwardly, in connection with the sale of those goods to consumers.”

28) Taking all the above into account I find that the opponents have shown use of its trade mark 2350467 HAJI only upon cheese, yoghurt, eggs, lentils and spices. As such its specification will be reduced to these items for the purposes of the comparison, as there is no overall category that adequately reflects such items. To my mind the opponents have not shown any use of its trade mark 2350764 upon any of the goods for which it is registered but only in regard to retail services. However, in case I am wrong I will include this logo mark in my comparison test on the basis that it has been used on the same goods as the word only mark.

29)) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union(CJEU) 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.

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

31) I now turn to compare the goods of the two parties which for ease of reference are shown below:

Applicant's Specification	Opponent's specification
In Class 29: Pre-packed frozen halal meat, halal poultry and fish; prepacked cooked and uncooked halal meat, halal poultry and fish.	In Class 29: Yoghurt; cheese; eggs; lentils. In Class 30: Spices

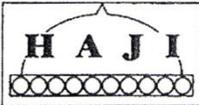
32) The accepted test for comparing goods is that set out by Jacob J. in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28 TREAT, which was effectively endorsed by the Advocate General in *Canon*; ETMR 1. The factors to be taken into account are:

- a) The respective uses of the respective goods;
- b) The respective 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.

33) Whilst the goods of both parties can be broadly said to be foodstuffs, they are significantly different in terms of use. Their users can also be very different e.g. vegetarians and vegans obviously not eating meat and in the case of the latter, neither cheese nor eggs. Even the average consumer who eats meat will not necessarily consume the opponents' products. The physical nature of the goods of the two parties are also different, although for the most part the trade channels will be similar. I do not accept that spices and meat are competitive and whilst they will all be found in supermarkets it will be in different places. I therefore conclude that the goods of the two parties are not similar. I must also determine the average consumer which, given that specifications of both parties merely cover, broadly speaking, foods must be assumed to be the average UK citizen.

34) I next turn to consider the marks which are reproduced below for ease of reference:

Applicant's mark	Opponents' marks
	2350467 HAJI
	2350764  

35) The opponents contend:

“In this instance the distinctive and dominant part of the opponent’s earlier marks is the word “Haji” – clearly that is the case for the word only mark, but also for the logo mark on the basis that “words speak louder than devices”; and for the applicant’s mark it is submitted that “Haji” is the dominant and distinctive part of that mark too, being the first element and bearing in mind that “Halal meats” is descriptive.”

36) The opponents were unable to provide an acceptable reason as to why the “BABA” element of the applicant’s mark would be overlooked by the average consumer. To my mind, a number of consumers, certainly any who are Muslim, will recognise the word HAJI as referring to a person who has been on a Hajj. It is a mark of respect and denotes that the individual is trustworthy. However, given that it is the duty of a Muslim

to undergo a Hajj at some point in their life that it is a “title” which is widely used and relatively common. The applicant equated it with the word “sir”, which I do not fully accept although it is not too far removed from what I take to be the case. The logo mark merely adds to the overall image of a semi-religious mark as it would appear to be the outline of the Temple Mount in Jerusalem, a holy shrine for Muslims, as well as Jews and Christians. In my view, even non-Muslims are likely to be aware of the Hajj and, particularly in the case of the logo mark, make the religious connection. Although it does not have any meaning as far as specifications of both parties are concerned, its common usage reduces its distinctiveness. There are very obvious visual, aural and conceptual similarities, however in my opinion these are outweighed by the differences.

37) When determining whether there is a likelihood of confusion I have to take a number of factors into consideration. There 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 vice versa. I must consider whether the opponents’ trade marks have a distinctive nature, the average consumer for the goods, the nature of the purchasing process and the issue of imperfect recollection. I must also take into account that these goods will be chosen with a degree of care. In the instant case the opponents’ marks do not have a high degree of inherent distinctiveness. To my mind, even if used on similar goods (which is not the case here), the clear differences in the trade marks mean that there is no likelihood of confusion on the part of the public, or a likelihood of association with the earlier trade mark. The ground of opposition under Section 5(2)(b) fails.

38) I now turn to consider the ground of opposition under Section 5(4)(a) which reads:

5. (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

39) In deciding whether the mark in question offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights

which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

'The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.'

40) Earlier in this decision I found that use of the mark in suit, actual or on a fair and notional basis would not result in confusion with the opponents' marks. Accordingly, it seems to me that the necessary misrepresentation required by the tort of passing off will not occur. The opposition under Section 5(4)(a) of the Act must fail.

CONCLUSION

41) The opponents have failed under both grounds of opposition.

42) The applicant's specification to be amended to: "Pre-packed frozen halal meat, halal poultry and fish; prepacked cooked and uncooked halal meat, halal poultry and fish."

COSTS

43) The applicant has been successful and it is therefore entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£200
Preparing evidence and considering and commenting on the other side's evidence	£800
Preparing for and attending a hearing	900
TOTAL	£1,900

44) I order Mohammed Din and Maqbool Ahmed. to pay Haji Baba the sum of £1,900. 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 4th day of May 2012

**George W Salthouse
For the Registrar,
the Comptroller-General**