

O-410-10

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2491756
IN THE NAME OF HALAL786 LTD

AND

OPPOSITION THERETO UNDER NO 98494
BY GHELANI'S SUPERSTORE AND CASH & CARRY LTD

TRADE MARKS ACT 1994

IN THE MATTER of application
no. 2491756 in the name of
HALAL786 Ltd and opposition
thereto under no. 98494 by
Ghelani's Superstore and
Cash & Carry Ltd

Background

1. Application No 2491756 is for the mark Halal786 and was filed on 3 July 2008. It stands in the name of Halal786 Ltd ("Halal") and registration is sought in respect of the following goods:

Food and meat products, all being halal food.

2. The goods are applied for in class 29 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

3. The application was published in the *Trade Marks Journal* on 3 October 2008. Following publication, Notice of Opposition was filed by Ghelani's Superstore and Cash & Carry Ltd ("Ghelani"). The grounds of opposition are founded on sections 5(2)(b), 5(3) and 56 of the Act. Ghelani relies on its earlier mark no 2228352 in respect of its objections brought under section 5 of the Act. The earlier mark was applied for on 5 April 2000 and completed its registration process on 22 September 2000 and is for the following mark:



The registration notes "The applicants claim the colours red and green as an element of the mark".

It is registered in respect of *Rice, salt, sauces, pickles, pastes, spices.*

4. Halal filed a counterstatement in which it denied each of the grounds of opposition. It also put Ghelani to proof of use of its mark.

5. Both parties filed evidence and the matter came before me for hearing on 4 November 2010. Halal indicated, through Serjeants, its legal representatives, that it would not be attending the hearing but did file written submissions in lieu of attendance. Ghelani was represented by Mr Tom Alkin of Counsel instructed by Marks & Clerk, its legal representative in these proceedings. Mr Alkin confirmed at the hearing that his client did not seek to pursue the objections founded on sections 5(3) and 56 of the Act. I therefore proceed to consider the matter on the basis of the objection founded on section 5(2)(b) only.

Decision

6. Section 5(2)(b) of the Act states:

(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. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,
- (b)
- (c)

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. In these proceedings, Ghelani is relying on trade mark no 2228352 which, as it has an application date of 5 April 2000 is prior to that of the application for registration, qualifies as an earlier trade mark under the above provisions. The application for registration was published for opposition purposes on 3 October 2008 and the earlier mark was registered on 22 September 2000. As the earlier mark was

registered more than five years before the publication date of the mark for which registration has been applied, the provisions of section 6A of The Trade Marks (Proof of Use, etc) Regulations 2004 are relevant. They state:

“6A (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)

(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)....”

9. Also of relevance is section 100 of the Act which states:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

10. I go on to consider whether genuine use has been shown of the mark relied on by Ghelani. In doing so, I take into account that the relevant period is the five year period ending with the date of publication of Halal’s application, i.e. 4 October 2003 to 3 October 2008.

11. Despite the claim made on the Notice of Opposition that the earlier mark has been used on all of the goods for which it is registered, Mr Ghelani’s evidence makes no claim to have used the earlier mark in relation to *salt, sauces, pickles, pastes or spices*. Mr Alkin conceded that in the absence of any evidence to support such a claim to use on these goods there can be no finding that there has been any genuine use of the mark in relation to them. I therefore go on to consider what use is made of the mark in relation to the remaining goods of the specification as registered: *rice*.

12. The guiding principles to be applied in determining whether there has been genuine use of a mark are set out in *Ansul BV v Ajax Brandbeveiliging BV* [2003]RPC 40 and *Laboratoire de la Mer Trade Mark* [2006] FSR 5. From these cases it is clear that:

- 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).

13. I must also keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, in relation to determining what constitutes a fair specification, namely:

“Pumfrey J in *Decon* suggested that the court’s task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view the task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use”.

14. In *Animal Trade Mark* [2004] FSR 19, Jacob J held:

“The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White’s brilliant and memorable example of a narrow specification) “three-holed razor blades imported from Venezuela” is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say “razor blades” or just “razors”. Thus the “fair description” is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection (“the umbra”) for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods (“the penumbra”). A lot depends on the nature of the goods—are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

15. Ghelani's evidence takes the form of a witness statement of Hitesh Ghelani, the managing director of that company since 1995. Mr Ghelani confirms that the statement he gives comes from his personal knowledge and the records of his company on whose behalf he is authorised to give evidence.

16. Mr Ghelani states that Ghelani has operated a cash and carry store in Leicester since 1995 selling a range of Asian foods to both the general public and as a wholesaler. It registered its earlier mark in 2000 and, in October 2004, began importing basmati rice under that mark. It has sold rice under the mark continuously since that time. Mr Ghelani estimates that between 2004 and 21 September 2009 sales of some £185,000 have been made with £121,000 of that amount being sold during the period between October 2004 and 1 July 2007 and £64,000's worth being sold between 1 July 2007 and 21 September 2009. On the basis of these figures, sales of rice within the relevant period would appear to be somewhere between £121,000 and £185,000.

17. Mr Ghelani exhibits, at HG1, what he calls "a selection of invoices and bills of lading relating to imports of 786 THE BRAND rice between 2004 and 2008". The exhibit consists of sixteen pages, five of which are invoices, the remainder being packing lists, bill of lading and fumigation certificates primarily relating to those invoices. The five invoices all date from within the relevant period. The first invoice (page 2) relates simply to "Basmati Rice": it does not indicate any trade mark under which the goods may have been supplied. The invoice at page 7 relates to both "Supreme 786" and "Raazi" brand rice but along with the remaining invoices, at pages 9, 12 and 14 show purchases by Ghelani of a total of some 3745 bags of "Supreme 786 brand" rice in a mix of 5, 10 and 20kg sizes.

18. At HG3 are exhibited invoices and payment receipts (some photocopied) for sales made between 2006 and 2009. This exhibit consists of 18 pages. Those shown on pages 1 to 8 all post date the relevant period as do one of the two shown on each of pages 17 and 18. The receipt at page 14 shows no date. The remaining pages show various sales of "786 basmati rice" or "786 rice" with the values of those individual sales being between £16.99 and £787.50 and totalling £1282.09.

19. At HG2, Mr Ghelani exhibits a photocopy of the packaging in which he says the rice is always sold. The photocopy is in black and white. Halal's evidence consists solely of the introduction of an exhibit comprising a colour photocopy of this packaging. Mr Ghelani himself also exhibits, as a second exhibit HG1 filed as evidence in reply, a colour photocopy of the packaging. Both exhibits show the front of the packet to bear the numerals 786 above the words The Brand. I digress briefly at this point to say that in its written submissions Halal allege that filing this material in black and white was "a deliberate attempt to deceive" in terms of the use made of the mark as registered. Mr Alkin on behalf of Ghelani took great exception to this. I will simply say that the allegation has not been supported by any evidence and thus appears to be completely without foundation. Such unsupported allegations are unhelpful in inter partes matters and are to be discouraged.

20. Both Halal's evidence and Mr Ghelani's second exhibit HG1 shows the mark not to have been used as registered but instead with the numerals presented in red with

a white border and the words THE BRAND presented in black, again with a white border. Halal submits:

“The red and green colour limitation is an inherent and significant part of the registration of the earlier Mark. It was volunteered by the Opponent as part of the application process ...and contributes significantly to the distinctive character of the earlier Mark”.

21. For his part, Mr Alkin submits that the earlier mark is not subject to a “limitation” as to colour and that “the distinctive character of the Earlier Mark is an entirely unrelated matter”. He submits that the mark has been used in a form which differs in elements which do not alter its distinctive character (Section 6A(4)(a) of the Act refers).

22. In *Able C & C Co Ltd v Mary Quant Cosmetics Japan Ltd*, (BL O-246-08) Geoffrey Hobbs Q.C. sitting as an appointed person considered the effect of colour. He said (with footnotes omitted):

“8. I take as my starting point the proposition that the registered representation of a trade mark is definitive as to the identity of the protected mark, with that being taken to consist only of the particular features which have actually been recorded in the register. The registration may show:

- (1) that the protected mark has been registered subject to a limitation or disclaimer making the use of particular colouring indispensable, in which case the absence of such colouring will prevent a finding of identity or similarity;
- (2) that the protected mark has been registered in colour without any limitation or disclaimer confining it to the particular colouring recorded in the register, in which case the use of other colouring will be sufficient to prevent a finding of identity but may not be sufficient to prevent a finding of similarity; or
- (3) that the protected trade mark has simply been registered in black-and-white, in which case colouring is optional hence inessential and therefore not a factor which permits or prevents a finding of identity of similarity relative to the mark as registered.

In effect, colouring is in the same degree (ir)relevant to a finding of identity or similarity as it is (im)material to the distinctiveness of the trade mark as registered.

9. The ECJ has recently confirmed that the protection of a trade mark proprietor’s right is more narrowly focused in infringement proceedings than it is in opposition and invalidity proceedings:

65. It is true that the notion of likelihood of confusion is the same in Articles 4(1)(b) and 5(1)(b) of Directive 89/104 (see, to that effect, Case C-425/98 *Marca Mode* [2000] ECR I-4861, paragraphs 25 to 28).

66. Article 4(1)(b) of Directive 89/104, however, concerns the application for registration of a mark. Once a mark has been registered its proprietor has the right to use it as he sees fit so that, for the purposes of assessing whether the application for registration falls within the ground for refusal laid down in that provision, it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier mark in all the circumstances in which the mark applied for might be used if it were to be registered.

67. By contrast, in the case provided for in Article 5(1)(b) of Directive 89/104, the third-party user of a sign identical with, or similar to, a registered mark does not assert any trade mark rights over that sign but is using it on an ad hoc basis. In those circumstances, in order to assess whether the proprietor of the registered mark is entitled to oppose that specific use, the assessment must be limited to the circumstances characterising that use, without there being any need to investigate whether another use of the same sign in different circumstances would also be likely to give rise to a likelihood of confusion.

So the question whether the proprietor of a trade mark registered for protection in colour can prevent registration of a later trademark recorded in black-and-white must be answered with due regard for '*all the circumstances in which the mark applied for might be used*' and therefore with due regard for the fact that the person applying for registration will (unless otherwise specified) have '*the right to use it as he sees fit*' in colour."

23. The earlier mark consists of a number of elements: the numerals 786 above the words THE BRAND and the colours red and green. The words THE BRAND are a synonym for 'trade mark' and are therefore non-distinctive. Whilst the earlier mark claims the colours red and green as an element of the mark, and the numeral element is in one colour and the word element in another, both with a very slight, contrasting border, there is nothing particularly remarkable in the presentation. In my view the distinctiveness in the earlier mark does not rely on those colours. The numerals are by far the dominant element of the mark given their position and size in relation to the words. Whilst I am aware that to some 786 is the numerical value of the letters forming the Bismillah, a type of invocation which forms the first verse of most suras of the Qur'an, and is therefore of relevance to some followers of the Islamic faith (who may be a sub-set of the relevant public), there is no evidence that 786 has any meaning in relation to the particular goods at issue. Thus I consider that 786 is also the distinctive element of the mark.

24. The mark as used shows use of the numerals 786 above, and very much larger than, the words THE BRAND. Again the word and numeral elements are in different colours and again they have a very slight, contrasting border. But again there is nothing particularly remarkable in the presentation. Taking all matters into account, I consider that the use made of the mark is use in a form which does not alter the distinctive character of the mark as registered and it is therefore use of the mark as registered as per the provisions of section 6A (4)(a) of the Act.

25. Whilst the evidence of use which has been filed is not extensive, there is evidence that Ghelani has imported and sold rice during the relevant period, albeit only from October 2004. The packaging, invoices and other documentary material support an ongoing trade under the mark. I have no evidence of the size of the relevant market (though I presume it is of quite some size) nor do I have any evidence which would allow me to establish Ghelani's place within that market. That said, there is evidence of continuing trade over a period of several years and I do not consider the volume of sales to be trivial or insignificant. Taking all matters into account, I consider the use of the mark as shown is sufficient to allow me to find that the earlier mark has been put to genuine use. That use has been shown primarily to be in relation to basmati rice however to reduce the specification in this way would in my view be pernicky: *rice* is how the goods would be perceived by the consumer and is a reasonable specification for the use shown. In summary I find that there is genuine use of the earlier mark in a form which does not alter the distinctive character of the mark as registered in relation to *rice* and it is this specification that I will use when considering the grounds of opposition further.

26. In determining the question under Section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [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* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (Limoncello). It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors: *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen B. V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel BV v Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki v Metro-Goldwyn-Mayer Inc*, paragraph 17;

- (f) 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; *Sabel BV v Puma Ag*, paragraph 24;
- (g) in determining whether similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer inc*; mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29;
- (j) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*;
- (k) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L Laudato & C. Sas v OHIM*.

27. In essence, the test under Section 5(2)(b) is whether there are similarities in marks and goods which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address factors such as the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed.

28. For ease of reference I set out below each of the respective marks:

Halal's application	Ghelani's earlier mark
Halal786	
Food and meat products, all being halal food	Rice

The average consumer and the nature of the purchasing act

29. The respective goods are all items of food and therefore the average consumer will be the general public though I do not discount the fact that some businesses (such as restaurants) will also purchase such goods. All of the respective goods are such that would be available in supermarkets and other food stores including, as shown in exhibit HG4, through specialist halal or ethnic suppliers. They are goods which will be bought on a regular basis and at relatively low cost and may be chosen or served from a shelf or refrigerator or ordered by telephone. Thus the purchase is likely to involve a combination of visual and aural considerations. The average consumer of such goods is reasonably observant and will pay a reasonable degree of attention to his purchase.

Comparison of marks

30. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). I have to consider the visual, aural and conceptual similarities of the respective marks with reference to the overall impressions created by the marks and bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG*). The average consumer, who rarely has the chance to make a direct comparison between marks but must instead rely upon the imperfect picture of them he has kept in his mind, is deemed to be reasonably well informed and reasonably circumspect and observant (*Lloyd Schuhfabrik Meyer & Co GmbH*).

31. Where a mark has a number of component features, the contribution of those individual elements to the marks as a whole and the impression conveyed to the average consumer of the goods in question are important factors in the consideration of whether two marks are similar.

32. I set out in paragraph 23 above my findings in relation to the dominant and distinctive elements of the earlier mark. As for the mark for which registration is

applied, whilst it is presented as a single entity, it naturally breaks down into two component parts: the word Halal and the numeral 786. Halal submit that “Halal foods are those which include meat or animal by-products, where the animals concerned are those permitted for consumption under Sharia law and which have been slaughtered under a strict Muslim code”. For its part Ghelani submit “the term Halal extends to more than just meat slaughtered in a particular manner. It refers to all food which Muslims are permitted to eat”.

33. The word Halal is well known to be of relevance to those of the Islamic faith and refers to any foodstuffs which believers are permitted to consume according to their faith either of themselves or due to the way they have been prepared (see e.g. exhibit HG4 pp 7 and 9 which refer not only to halal meat but also to other halal food such as biscuits, cakes, dates and sweets as well as drinks). The word Halal is therefore descriptive of not only meat but any foodstuffs including rice which are deemed permissible under the Islamic faith. In light of this, and in common with the earlier mark, it is the numeral 786 which I consider to be the dominant and distinctive element of the mark for which registration is applied.

34. The mark applied for begins with the word Halal. This is an element not present in the earlier mark, however, this does not mean that the marks cannot be considered similar. In *Spa Monopole compagnie fermière de Spa SA/NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-438/07* it was stated:

“23 Admittedly, the consumer normally attaches more importance to the first part of words (Joined Cases T-183/02 and T-184/02 *El Corte Inglés v OHIM-González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-965, paragraph 81). However, that argument cannot hold in all cases (see judgment of 16 May 2007 in Case T-158/05 *Trek Bicycle v OHIM –Audi, (ALL TREK)*, not published in the ECR, paragraph 70 and the case-law cited) and does not, in any event, cast doubt on the principle that the assessment of the similarity of marks must take account of the overall impression created by them.”

35. Given that the respective marks each contain words not present in the other, there are self-evidently some visual differences between them, however, due to the presence in both of the numeral 786 there is a reasonably high degree of similarity from a visual perspective. Aurally, the similarity is equally strong. The mark applied for will bring to mind halal food and, for those familiar with the Islamic faith the presence of the numeral 786 may bring to mind a further link to that faith. For those without such a familiarity, the numerals are unlikely to have any particular meaning other than being particular numbers and the mark is likely to be seen as referring to the halal version of 786 goods. As for the earlier mark, again the numerals may bring to mind a link to the Islamic faith or they may have no particular meaning depending on the consumer’s own knowledge. However they are seen, the commonality in the respective marks of the numerals 786 will lead to a high degree of conceptual similarity.

Comparison of goods

36. The goods to be compared are ‘*food and meat products, all being halal food*’ in class 29 and ‘*rice*’ in class 30.

37. The significance of classification and the relevance of class numbers have been considered by the courts in *Altecnic Ltd’s Trade Mark Application (CAREMIX)* [2002] RPC 639, by the Court of Appeal and in *Avnet Incorporated v Isoact Limited* [1998] FSR 16, by the High Court. In *Proctor & Gamble Company v Simon Grogan* O-176-08, Anna Carboni, sitting as the appointed person, referred to *Altecnic* and said:

“32. The International Classification system also applies to Community trade marks. Rule 294 of Commission Regulation 2868/95/EC implementing the Regulation on the Community trade mark (40/94) states as follows:

(4) The classification of goods and services shall serve exclusively administrative purposes. Therefore, goods and services may not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services may not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

33. It is thus made plain under the Community trade mark system that class numbers are irrelevant to the question of similarity of goods and services.

34. There is no similarly plain provision in the Act or the Directive. The Court of Appeal has held that, although the purpose of classifying goods and services is primarily administrative, that does not mean that the class numbers in an application have to be totally ignored in deciding, as a matter of construction, what is covered by the specification: *Altecnic Ltd’s trade Mark Application (CAREMIX)* [2001] EWCA Civ 1928, [2002] RPC 639. But neither the Court of Appeal, nor the ECJ, nor any other court or tribunal in the United Kingdom, has gone so far as to state that class numbers are determinative of the question of similarity of goods in the case of national trade marks. On the contrary, they are frequently ignored.

35. In *British Sugar PLC v James Robertson & Sons Ltd* [1996] RPC 280 (“*Treat*”), Jacob J said (at 289):

“When it comes to 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 trade. After all, a trade mark specification is concerned with use in trade.”

36. He went on (at 295) to set out the following factors as being relevant to the question of similarity (insofar as relevant to goods), without reference to the classes in which they fell:

- (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-service consumer items, where in practice they are respectively found or likely to be found in supermarkets;
- (f) the extent to which the respective goods are competitive. This enquiry may take into account how those in trade classify goods, for instance whether market research companies put the goods in the same or different sectors.

37. Subsequently, in *Canon Kabushiki Kaisha v MGM Inc.* (referred to above), the ECJ stated the following:

23. In assessing the similarity of the goods or services concerned,...all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

38. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks & Designs) (OHIM) Case T-325/06*, it was stated:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM –Sissi Rossi (Sissi Rossi)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR-I-7057; Case T-364/05 *Saint-GobainPam v OHIM-Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM-Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECRI-0000, paragraph 48).”

39. Food products and meat products are both relatively wide ranging terms (the former arguably more so than the latter) but, as registration is sought in class 29, the specification as applied for is limited to those goods within those terms proper to that class and which, given the limitation, are halal.

40. Mr Ghelani states that halal foods are commonly served with rice and that it is very common for rice and other halal foods such as meat to be sold through the same trading channels. He refers me to exhibit HG4 in support of this latter claim. HG4 consists of prints from the websites of five businesses. Four describe themselves as cash and carries, the remaining one is described as a supermarket.

For its part, Halal admit that some retail stores sell both rice and halal meat but submit:

“it is inevitable [...] that any food store offering halal foodstuffs has a separate halal meat counter and a separate halal stockroom or isolated stock area, to ensure that all the halal meat, meat products and other foodstuffs are kept completely isolated from any non-halal groceries on sale in the same store. It follows that under no circumstances would rice and halal meat and meat products be sold over the same counter or even in the same part of the store.”

41. The term *food products* includes any number of different goods made up of different components. Those components may be proper to more than one class and classified accordingly (as per *Vac-u-flex* [1965] FSR 176). Whilst *rice* is properly classified in class 30, *food products* in class 29 will include things such as soup and prepared meals and would therefore include such foodstuffs as rice soup or prepared meals in the form of e.g. curry and rice (where the curry may be meat, vegetable or fruit-based). The term *meat products* would also include e.g. prepared meals in the form of (meat-based) curry and rice. Given that a single prepared meal will contain e.g. both the curry (of whatever base ingredient) and the rice, it is clear that consumers will be used to the same undertaking supplying all of the respective goods. As I indicated above, halal refers to any foodstuffs which Muslims are permitted to eat and includes *rice*. *Rice* may be dried or in prepared form and is also sold as a ready meal and thus would be available from the same shelves as other prepared meals, which could include soups, in a supermarket. The goods are all intended to be eaten and they have the same users. I consider *food and meat products, all being halal food* to be similar to *rice*.

Likelihood of confusion

42. In reaching a decision on whether there is a likelihood of confusion, I must make a global assessment based on all relevant factors. The decision of the General Court in *New Look Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03, indicates that the circumstances in which the relevant goods and the marks are encountered by the consumer, particularly at the point at which the purchase is made, is an important consideration. But I also have to make an assessment of all relevant factors and take into account the fact that the consumer will rarely have an opportunity to compare marks side by side but will instead rely on the imperfect picture of them he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* paragraph 27).

43. Another factor to be taken into account is the distinctive character of the earlier trade mark having regard to its inherent characteristics and the reputation it enjoys with the public. I have already commented that the evidence of use of the earlier mark is not extensive. There is no evidence from the public or trade. Whilst I am unable to find the earlier mark has enhanced its distinctive character through the use made of it, I consider that it has a reasonably high level of inherent distinctive character.

44. I have found that the respective marks have a reasonably high degree of visual and aural similarity and a high degree of conceptual similarity. I have found *food and meat products, all being halal food* to be similar goods to *rice*. Taking all matters into account and applying the global approach as I am required to do, I find that the opposition succeeds in respect of *food and meat products, all being halal food*.

Supplementary consideration

45. In its written submissions Halal requests that if I find against it in relation to its published specification of goods, its application should be allowed to proceed for an amended specification. The amended specification Halal puts forward is: "*meat and meat products, all being halal food*".

46. I have already found that there is a likelihood of confusion as regards *meat products* and I say no more about this. As regards *meat all being halal*, I have to consider whether this is an amendment allowed under the provisions of section 39 of the Act. Section 39 states:

- "39.- (1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application.
- (2) In other respects, an application may be amended, at the request of the applicant, only by correcting-
- (a) the name or address of the applicant,
 - (b) errors of wording or of copying, or
 - (c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application."

47. It is not therefore permitted to amend a specification so as to widen its scope from that for which it was originally applied. The application as published sought registration in respect of *food and meat products, all being halal food*. I indicated above that the term *meat products* is wide ranging. In my view it would include not only products made of meat such as burgers and sausages but also cuts of meat such as lamb chops or steaks. On that basis, it seems to me that the term *meat* is included within the term *meat products*.

48. *Meat* is the flesh of an animal used by many as a foodstuff. Whilst *rice*, which is the grain of a grass, is also used as a foodstuff by some (who may or may not also be meat-eaters) the respective natures of the two differ markedly. Whilst, as I indicated above, there may be some overlap of trade channels as regards *meat products* and *rice*, the position is somewhat different as regards *meat per se*. *Meat* most often reaches the store via the farm/abattoir/meatpackers. These are very different trade channels to those for *rice*. Whilst both *meat* and *rice* may be sold in frozen form, and therefore both may appear in the freezer section of a supermarket, they would normally appear in very different parts of that section. 'Fresh' *meat* is sold direct from the butchery counter or prepacked from chiller cabinets. *Rice* whether dried or pre-cooked (for e.g. microwave reheating) will be displayed in packets on

shelves along with other dry goods but may also be found pre-cooked in chiller cabinets. But as with frozen goods, chilled meat and precooked rice are usually displayed in very separate areas of the chiller cabinets. Whilst *meat* is sometimes served with *rice*, one is not indispensable or important for the use of the other. I do not consider that *meat* is similar to *rice*.

49. Again I have to make an assessment of likelihood of confusion taking into account all relevant factors. In respect of the amended specification of proffered by Halal, I have found that the respective marks have a reasonably high degree of visual and aural similarity and a high degree of conceptual similarity. I have found *meat, all being halal food* not to be similar to *rice*. Taking all matters into account as I am required to do, I find there is not a likelihood of confusion in respect of these goods. The application is free to proceed for the limited specification of goods of *meat, all being halal food*.

Costs

50. Mr Alkin requested an award of costs in respect of an interlocutory hearing which had taken place earlier in the proceedings. In her letter advising the parties of her decision, the hearing officer indicated her intention not to determine the costs of that hearing at that stage but to carry it over for consideration as part of the substantive decision. The interlocutory hearing was convened at Halal's request following Ghelani's request for an extension of time for filing evidence. It is my view that an award of costs in the sum of £200 to Ghelani in relation to that hearing is appropriate.

51. Despite the fact that Halal indicated that the reduced specification they have offered was made at an earlier point in the proceedings, I do not think criticism can be directed at Ghelani for rejecting it given my findings. In my view Ghelani is also entitled to an award of costs in relation to the substantive proceedings, however, I take into account that the evidence filed was not extensive and would not have taken any significant effort to collect and that the hearing was not complicated or lengthy. As regards the substantive proceedings I make the award as follows:

For filing Notice of Opposition	£300
Fee	£200
For filing and reviewing evidence	£100
For preparation for and attendance at the hearing	£300
Total	£900

52. Taking all matters of costs into account, I order Halal786 Ltd to pay Ghelani's Superstore and Cash & Carry Ltd the sum of £1100 in these proceedings. This sum

is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of the case should any appeal against this decision be unsuccessful.

Dated this 29 day of November 2010

**Ann Corbett
For the Registrar
The Comptroller-General**