

O-268-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2461431
BY IMRAN AYUB TO REGISTER A
TRADE MARK IN CLASSES 16 & 35**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 95752 BY ASIAN TRADE PUBLICATIONS LIMITED**

BACKGROUND

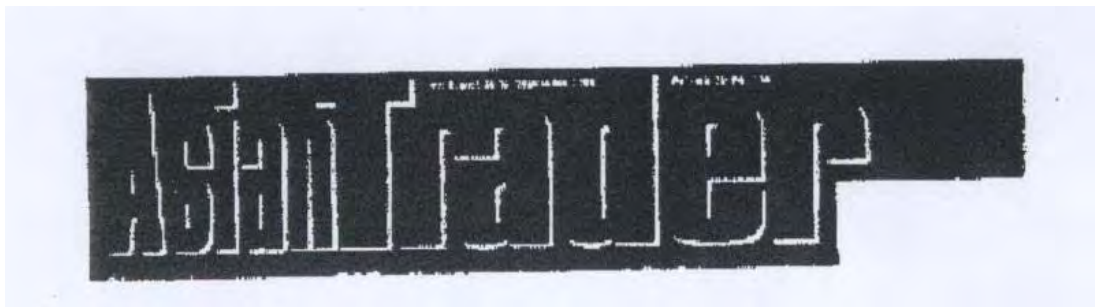
1) On 16 July 2007 Imran Ayub applied to register a series of two trade marks. After examination, one of the trade marks was deleted. The remaining trade mark (shown below) was accepted and subsequently published for opposition purposes on 14 September 2007 in Trade Marks Journal No.6701 for the following goods and services:



Class 16: Printed matter; directories; advertising material.

Class 35: Internet and website advertising services.

2) On 12 December 2007 Asian Trade Publications Limited (the opponent) filed a notice of opposition. This consists of a single ground based upon section 5(4)(a) of the Trade Marks Act 1994 (as amended) (the Act), which is directed against all of the goods and services in the application. On the Form TM7 the opponents say that the following sign:



has been used:

“..for the title of a magazine available in both paper and electronic form and an award service for successful business. Subscribers are based throughout the United Kingdom. The magazine specialises in business-to-business and carries a classified section that advertises businesses. Links on the web page are directed to a Business Directory operated by a sister company.”

3) They add that the magazine was launched in the United Kingdom in November 1985.

4) On 27 February 2008 Mr Ayub filed a counterstatement which was accompanied by a copy of both his own publication from 2007/2008, and a copy of the opponents' publication from July 2007. Mr Ayub's counterstatement contains his views on many of the issues in play in these proceedings. He says, inter alia:

“Asian Trader the directory” (the directory) was set up in March 2006 as a directory and website listing Asian businesses in the North West. The directory is purely for customers/consumers to search for addresses and detail about Asian businesses trading in the North West. As a result the directory is marketed for businesses promoting themselves to customers for retail sales. It is not aimed at other businesses searching for products to buy for the whole purpose of selling in their business (i.e. business to business retail sales). Because of this the target audience/market level that the directory is aimed at differs to that of the opposing party.

In the small time the business has been set up it has earned its own goodwill and reputation. This is not because of the similarity between the names of “Asian Trader the directory” and “Asian Trader the voice of Asian business”, but because of the marketing; reputation; and advertising carried out by the accused.”

5. Having explained what, in his view, is required for the opponents to make good their claim to passing off, Mr Ayub goes on to say:

“At no time during the course of business and trading has “Asian Trade the directory” purported or claimed to be part of “Asian Trader the voice of Asian business.

The existence of “Asian Trader the directory” is purely a coincidence and an honest mistake, and up until the date of the opposing party's opposition the accused was not aware that such a similar business existed.

“Asian Trader the directory” has established itself without the aid of “Asian Trader the voice of Asian business”, especially since the latter is not well known to the clients who have purchased a page to place their advertisement in “the directory”. Because of this the sales and reputation of “the directory” is independent to that of “Asian Trader the voice of Asian business.

Because “Asian Trader the voice of Asian business” is based at a different market audience they can not suffer damage either to their purported reputation or goodwill, especially since there was no misrepresentation on behalf of the accused, and all the clients and customers of the accused recognise “the directory” as a separate entity to “Asian Trader the voice of Asian business”. This is especially since “the directory” is based in the North West, while “Asian Trader the voice of Asian business” is based in London, America and India. It is not well known in the North West compared to “the directory” and its main trading and operating areas.

“The directory” is clearly distinguished from “Asian Trader the voice of Asian business” especially since there is a significant difference between the logos of the two businesses and the business format.

“The directory” is published in an A5 book listing Asian businesses in Lancashire and Bolton from A to Z. The website is similar, and both goods and services are available to the general public. However, “Asian Trader the voice of Asian business” is published as an A4 magazine providing short articles, in no specific order, about different products which are available on the market. In addition to this the magazine contains short articles regarding current issues and news. The website is similar and is restricted, as a condition of entry, to owners/managers/tobacco buyers of a retail outlet.

“The directory” is of exceedingly high quality and because of this the name attached to it has earned its own goodwill and a reputation.”

6) In view of the factors mentioned above, Mr Ayub concludes:

“Due to the lack of common field of activity there is no danger of confusion as to the origins and quality of the goods and services in question. Because of there “the directory” is not likely to cause harm to “Asian Trader the voice of Asian business.”

The accused is simply making honest use of his own business name, and the actual use is careful to ensure that passing-off does not occur. There is a minimum chance of confusion occurring, especially due to the difference between each business target audience and location of trade...”

7) Both parties filed evidence in these proceedings which to the extent that I consider it necessary I have summarised below. The matter came to be heard on 23 July 2009. At the hearing, the opponents were represented by Mr Steven Jennings of Lewis Silkin LLP; Mr Ayub represented himself and also provided written submissions which I will take into account when reaching my decision.

OPPONENT’S EVIDENCE

8) This consists of a witness statement, dated 17 October 2008, by Paul Gray who is the Associate Publisher of Asian Trade Publications Ltd, the opponent in these proceedings; Mr Gray has held this position for six years having been with the opponent since 1993. He confirms that the information in his statement comes from his own knowledge and from company records.

9) Mr Gray explains that the Asian Trader publication was launched in 1985 to fill a gap in the market resulting from what the opponent considered to be the relatively narrow appeal and focus of The Grocer magazine. He adds that the publication which is published every fortnight now has more readers than The Grocer magazine. Exhibit 1 consists of a Standard Certificate of Circulation for The Grocer magazine issued by ABC Limited for the period 1 July 2006 to 30 June 2007.

10) Mr Gray states that while the style in which the Asian Trader trade mark has been used has changed over the years, the current format has been in place since November 1995. He adds that the Asian Trader trade mark has also been used in various brand extension such as the Asian Trader Awards and Asian Trader seminars. Exhibit 2 consists of copies of the Asian Trader publication from: November 1986, February 1988, October 1991, December 1993, November 2003, October 2006, November and December 2007, and June and August 2008. I note that in 1986 and 1988 the words appeared in the following format:



In 1991 and 1993 the words appeared in the following format:



And in the subsequent years the words appeared in the following format:



11) Mr Gray goes on to say that the Asian Trader publication is mailed to its registered users and other VIP patrons across the UK, the majority consisting of independent retailers. Exhibit 3

consists of circulation figures provided by ABC for the publication for the last five years. These are as follows:

Date	Amount
July 2006 – June 2007	50,602
July 2005 – June 2006	55,039
July 2004 – June 2005	50,232
July 2003 – June 2004	53,895
July 2002 – June 2003	57,128
July 2001 – June 2002	53,745

12) Having said:

“..The magazine has gained significant popularity with retailers of all backgrounds and therefore the reputation of The ASIANTRADER Trade Mark extends far beyond the Asian community”,

Mr Gray goes on to provide details of the subscribers to the publication by comparison with the regions covered by particular television stations. These are as follows:

Television Region	No. of subscribers
Anglia Television	2565
Border Television	1972
Carlton/LWT	14887
Central Independent Television	10007
Grampian Television	689
Granada Independent Television	6986
HTV	287
Meridian Television	3579
STV	2504
TTTV Tees	3598
UTV	362
West Country Television	1548
Yorkshire Television	3987

13) Mr Gray explains that to promote good business practices and to encourage new generations of businessmen, in 1988 the opponent created an annual awards event called the Asian Trader Awards. He adds that this event is promoted throughout the UK and is attended by politicians, government officials and individuals from the retail and FMCG sector, such as Pepsi Cola, Nestle, Coca Cola, Mars, Bestway and Londis. Exhibit 4 consists of a copy of a speech given by the Rt. Hon Alistair Darling MP at the Asian Trader Awards held in London on 14 November 2006. I note that this speech began:

“I am pleased to be here for this double celebration – marking 21 years since the launch of Asian Trader Magazine in 1985, and the 18th anniversary of the Asian Trader awards. Both have come of age.

Asian Trader has been a very important voice. Valued and respected....

..With a circulation of 53,000 copies published in English, Gujarati and Urdu the magazine provides a vital link between manufacturers, wholesalers and retailers...”

14) Mr Gray adds that the Asian Trader trade mark is used as the main logo for the awards night and also appears on the entry and nomination forms. Copies of documentation from 2008 (which show the Asian Trader trade mark in the third of the variations listed above) is provided as exhibit 5.

15) Exhibit 6 consists of two promotional leaflets (which appear to be undated) in which the third version of the Asian Trader trade mark can be seen, together with a copy of an entry form for the 1992 Asian Trader Awards, in which the trade mark appears in the second of the variations listed above.

16) Mr Gray states that retailers, shops and companies advertise themselves as winners of the Asian Trader Awards. Exhibit 7 consists of an extract from www.londis.co.uk which refers to the Asian Trader Awards of 2005.

17) Mr Gray explains that while the opponent does not traditionally have any large expenditure on advertising, it does widely promote the Asian Trader brand prior to and during the Asian Trader Awards. He adds that the opponent regularly participates in trade and industry exhibitions, having over the years exhibited at many national and regional exhibitions including the Neighbourhood Retailing Exhibition and the Convenience Retailing Show.

18) Mr Gray states that: “the sales turnover for my company” (but not turnover under the Asian Trader trade mark) has been as follows in the last three years:

Date	Amount (£)
April 2007- March 2008	1, 475, 142
April 2006 – March 2007	1,474,594
April 2005 – March 2006	1,551,045
Total	4,500, 781

19) Mr Gray explains that the opponent’s website at www.asiantrader.biz has been in operation since November 2002. Exhibit 8 consists of data obtained using the internet archive tool WaybackMachine in support. Exhibit 9 consists of extracts from a range of publications which refer to the Asian Trader publication and/or the Asian Trader Awards obtained using the Westlaw online database of newspapers. All of the articles appear to date from before the date of the application for registration and are from a range of publications including, inter alia: The Evening Standard, The Scunthorpe Telegraph, The Daily Mail, Media Week and The Independent.

20) Mr Gray then turns his attention to the Form TM8 and counterstatement filed by Mr Ayub. This part of his statement consists of a mixture of submissions and evidence. While I do not

propose to summarise those submissions here, I will of course keep them in mind when reaching a decision. In response to comments made by Mr Ayub in his counterstatement, Mr Gray provides, inter alia, the following evidence:

- Exhibit 10 – consists of the results of a Whois search conducted in relation to the domain name asiantradersuk.com which indicates that the domain was not registered until 12 May 2007;
- Exhibit 11 – consists of an extract from the WaybackMachine which indicates that the website www.asiantradersuk.com was not activated until 20 October 2007, together with a copy of how the website would have appeared on that date;
- Exhibit 12 – consists of the results of a Whois search together with an extract from the WaybackMachine in relation to the domain name asiantraders.co.uk which Mr Gray notes was registered on 19 April 2007. Mr Gray states that this site simply forwards to the domain name asiantradersuk.com;
- Exhibit 13 – consists of a screen print from www.asiantradersuk.com from which Mr Gray notes that the drop down box covers all cities in the UK, and is not, as Mr Ayub suggests, limited to businesses in the North West.

APPLICANT'S EVIDENCE

21) This consists of a witness statement, dated 3 February 2009, from the applicant, Mr Imran Ayub, accompanied by a range of documents; I shall return to these documents below. A good deal of Mr Ayub's statement consists of submissions rather than evidence. Where this is the case, I propose to deal with it on the basis indicated in paragraph 20 above.

22) Mr Ayub explains that he is the owner of "Asian Traders. The Directory", which he "set up" in March 2006. He confirms that the information in his statement are facts which he knows to be true and which come from either his own knowledge or from company records. The following quotations from Mr Ayub's statement will, I hope, convey a flavour of his defence to the opposition. He says, inter alia:

"[The opponent] is based in London whilst my business is based in Preston..

.or secondly as its aimed purely at the grocery trader, then ordinary consumers like me or owners of any other Asian business would not have reason to come across "Asian Trade Publications Ltd.

Our Asian traders the directory is aimed at every single Asian business from plumbers, mechanics, hairdressers and kebab shops, oh and not forgetting the Asian retailers..I would compare our business to that of Yellow Pages or Yell.com...

Our print run and distribution is reflective of the number of people living in a particular area, and our channels of distribution are carefully targeted to ensure that every Asian

household in that area has access to at least one copy of the directory. Our directories are distributed in places of worship, mosques, Hindu temples, and Gudwaras..retail outlets of every description....basically anywhere where Asian people shop or visit frequently...

This again highlights the fact that they are targeting specifically the retail outlets..

The name Asian trader or Asian traders is used by a number of different registered businesses as shown below:

Domain names taken with the name “Asian traders”

Asiantraders.com
Asiantraders.net
Asiantraders.eu
Asiantraders.biz

The three domain names below are registered to me.

Asiantradersuk.com
Asiantraders.co.uk
Asiantradersuk.co.uk

Domain names taken with the name “Asian trader.”

Asiantrader.com
Asiantrader.net
Asiantrader.org
Asiantrader.biz – owned by the opponent
Asiantrader.eu
Asiantrader.co.uk

As you can see for the above the name Asian trader/traders is used by other organisations...

Our businesses both in the print and website are completely different. Our target markets are different. Our readership is different. Our logos are different. Our areas of distribution on the whole are different.

There is a forwarding link to asiantradersuk.com from asiantraders.co.uk which was registered on 19-04-2007. This was the first time Asian Traders was used online.

In response to Paul Gray’s statement that the asiantradersuk.com website was not registered until May 2007, although technically correct, it doesn’t show the full picture, as the first website was commissioned in March 2006. However the initial website developers were based in Pakistan, and the whole project was a complete disaster...”

23) In relation to exhibit 11 Mr Ayub says, inter alia:

“..The information on the way back records also clearly states that material typically becomes available 6 months after collection. This would clearly be in line with what I have said, the new site was uploaded in May 2007, and six months later, in October 2007, our details appeared on the wayback machine records..

In my initial letter sent to Paul Gray beginning of 2008, it did mention ...that the directory and website was for the North West. This information was written by a friend who made the mistake in assuming that the recipient would understand that the website will target customers throughout the UK...

Finally let's be honest about it, the name Asian trader/traders is hardly a unique name. It simply describes a particular sector of the community, which is why I believed it perfectly suited the purposes of our directory.”

24) I note that under the heading “Additional Comments” (at points 9 and 11) Mr Ayub says:

“Please see the attached witness statements from a handful of my clients that I contacted to gain evidence, to confirm what I have said.

The attached pdf also shows an enquiry from a client who found our details on Google”

25) As I mentioned above, Mr Ayub's statement was accompanied by a range of documents. I say documents rather than exhibits because none are marked as exhibits in the conventional manner. These documents are (using their page numbers for ease of identification) as follows:

- Page 15 – an e-mail dated 21 January 2009 sent to info@asiantraders.uk.com by sarah.cartwright@futurehomecare.co.uk in which Ms Cartwright enquires of the applicant:


“How much does it cost to advertise a job please without being member?”

- Pages 16, 17, 18, 19 and 20 – consist of, and despite some being marked as Witness Statements, what amount to a number of: “To whom it may concern” letters dated 27, 21, 20, 8 and 20 January 2009 from Scheme Designs of Blackburn, Primo Photos of Stockport, Kashmir Watan Foodstores of Preston, Northern Studios of Preston and the Islamic Book Centre & Frame House of Blackburn. Given Mr Ayub's comments at paragraph 24 above and the contents of the first paragraph of each letter which reads:

“Further to a Request by Mr Imran Ayub of Asian Traders the directory, I have prepared the following statement”,

it is clear that these letters were solicited by him for the purposes of these proceedings.

26) The Trade Marks Registry's approach to letters of this type was outlined in Tribunal Practice Notice (TPN) 1 of 2008 where it says:

"1. . The Registrar has noted an increasing trend for evidence to be filed in the form of letters from third parties solicited by the parties to the proceedings. Typically, it is the Registrar's experience that such letters are headed "To whom it may concern", or even addressed to the Registrar, whilst others are less obvious in format. The procedures for filing evidence in trade mark proceedings before the registrar is governed by rule 55 of the [Trade Marks Rules \(2000\) as amended](#)  (365Kb). The rule states:

[Rules omitted]

2. Letters of the kind described above are not therefore a suitable means of introducing statements made by the person signing such a letter as his or her evidence in the proceedings. This is because such letters do not comply with the requirements of Rule 55(1) or (3).

3. Where such a letter is relied upon by a witness and attached as an exhibit to his or her affidavit, statutory declaration or witness statement, the statements of the person signing the letter are normally admissible as part of the evidence of the person making the affidavit, statutory declaration or witness statement. However, in these circumstances statements made by the person signing the letter are hearsay evidence.

4. Hearing Officers will give hearsay evidence of this kind such weight as it deserves. Statements made in letters which have been sent to a party for a purpose unconnected with the proceedings are, in general, likely to be given more weight than statements made in letters solicited for the purpose of the proceedings. However, each case will be assessed on its own merits."

27) I intend to approach these letters on the basis indicated above. I note that the writers of the letters at pages 16, 17, 18 and 20 indicate that Mr Ayub approached them in 2006 and 2007 (16), 2007 (17), 2006 (18) and 2006 and 2007 (20). The four letters which all share similar phraseology all end with an identical final paragraph which reads:

"I would like to confirm that Mr Ayub has never said or implied that his business was part of any other company. Mr Ayub did explain that it was a new venture and I agreed to advertise on the basis of benefits received and value for money, and I firmly believe that I have not been misled in to advertising in anything other than what was agreed. I also cannot recall having come across any other publication with a similar name, therefore as far as I am aware this is the first publication that I have come across bearing the name Asian Traders the directory."

28) The letter at page 19 indicates that Mr Ayub approached Northern Studios in February 2006 to have a logo designed for his advertising business which he advised was a new venture. This letter concludes in the following terms:

“I have worked closely with Mr Ayub since 2006 creating the artwork for all the advertisers in the directory and never have Mr Ayub, any of the advertisers or the sales persons working at Asian Traders said that they had come across another business called Asian Traders. The whole team has always been of the opinion that this was both a unique advertising concept and that the name was also original.”

29) Pages 25 and 26 consist of a witness statement, dated 26 January 2009, by Martin O’Reilly. Briefly, Mr O’ Reilly explains that he was a colleague of My Ayub’s in 2005 when they worked together in advertising for a publishing business. Mr O’ Reilly recalls the discussions he had with Mr Ayub regarding the development of Mr Ayub’s business under the applied for trade mark, including the current opposition. Mr O’Reilly recalls how he sent Mr Ayub a copy of the opponent’s publication in (it would appear) early 2008. Mr O’Reilly states Mr Ayub first became aware of the opponents in December 2007, and that he (Mr Ayub) had not had sight of the opponents’ publication until Mr O’ Reilly sent him the copy mentioned. Mr O’Reilly concludes his statement in the following terms:

“I would therefore ask you to dismiss their claim that Imran has attempted to trade on their name as utter rubbish. Considering that they produce a tabloid newspaper as opposed to the high quality annual Business Directory of Asian Traders.

Secondly despite Imran calling on numerous businesses and related outlets promoting his directory never once was the opposition mentioned. In fact it was only when opposition presented themselves to Imran, that their name was made known to him....

Again I would say that by looking at both publications it is blatantly obvious that there is no connection between the two parties.”

30) That concludes my summary of the evidence filed.

DECISION

31) The opposition is based solely upon section 5(4)(a) of the Act which reads as follows:

“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

(b)....

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.”

32) 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.’

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

‘To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

33) The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts first complained of commenced – as per the comments in *Cadbury Schweppes Pty Limited v. The Pub Squash Co Pty Ltd* [1981] RPC 429. In his counterstatement the applicant’s claim to have first used his mark in March 2006, this is prior to the application

date 16 July 2007 and so the relevant date for this decision must be March 2006. This was accepted by both parties at the hearing.

34) With these considerations in mind I turn to assess the evidence filed on behalf of the parties in the present proceedings as set out earlier in this decision. The opponent has used three slightly different type faces and stylisations. However, since November 1995 it has used a very straight forward typeface. In all of the marks the dominant characteristic has been the name “Asian Trader”. This has been the name used in its awards ceremonies which have also attracted significant publicity in the national press and indeed on television news programmes. These awards ceremonies have been attended by major political figures. The opponent has provided circulation figures which have been broken down into regions. These show that the magazine enjoys significant UK wide coverage with its subscribers being throughout the UK. The opponent’s magazine is aimed at the traditional corner shop grocer and advertises other businesses and their products and services to these grocery businesses. Although, because many of the corner grocery shops are owned and operated by Asians, the title of the magazine can be seen as somewhat descriptive it has had substantial use over a lengthy period. Therefore, even if, as the applicant contends, it has only a small amount of inherent distinctiveness, it has a considerable reputation amongst grocery businesses. The opponent therefore passes the first hurdle of showing that, at the relevant date it had goodwill.

35) The applicant is using his mark on a directory of Asian businesses in the North West which is produced annually and is aimed at the average Asian consumer in this area. Its purpose is to promote Asian businesses to the Asian community. To this end it is distributed via mosques, and Sikh and Hindu temples and other places where Asian consumers might congregate. Inevitably, it will be seen in these places by the Asian grocers that the opponent’s magazine is aimed at.

36) The applicant contends that the nature of his directory, a sort of Thompson’s or Yellow Pages directory is different to the opponent’s magazine. Clearly, there are differences between this and the opponent’s product, but there are also similarities. The opponent’s magazine advertises businesses to business consumers, albeit in the narrow field of the grocery sector. However, these end consumers would also feature in the applicant’s target consumer group.

37) I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

Applicant’s Mark	Opponent’s Mark
	

38) The applicant's mark has a large device element and the words "ASIANTRADERS THE DIRECTORY". Given that the mark is used upon a directory the last two words are purely descriptive of the product. Given that it is intended to be a directory of Asian traders the term "ASIANTRADERS" could also be said to be descriptive, although the specification is not restricted in this manner and any such restriction might be thought, by the average consumer to be unlikely given the various laws governing discrimination. It might be considered to be businesses trading in Asian goods, although this is a somewhat nebulous concept.

39) The opponent's mark consists of the words "Asian" and "Trader" in plain text. Visually there are differences between the marks of the two parties but also considerable similarities. Aurally the marks are identical except for the letter "s" on the end of the word "trader" turning it into the plural form and the words "The Directory" which will be viewed as descriptive. I do not believe that many consumers will note the change from the singular to the plural form of the word "trader" and even if it is noted, given imperfect recollection, they will not take heed of it. I do not believe that the device element in the applicant's mark can be oralised. Conceptually, the marks share the same concept of "Asian traders" whether these are the intended consumers or whether they are the sole advertisers both marks conjure an image of an Asian businessman or trader. Overall, the similarities far outweigh any differences.

40) Turning to the goods and services of the two parties, clearly the opponent has shown only use on a trade magazine, on an associated website and on its business awards. The applicant has sought registration for the following; in Class 16 "Printed matter; directories; advertising material" and in Class 35 "Internet and website advertising services". There is a clear overlap between the goods and services of the two parties.

41) In reaching my decision I take into account the comments of Morritt L J in the Court of Appeal decision in *Neutrogena Corporation and Another. v Golden Limited and Another* [1996] RPC 473, when he said that the correct test on the issue of deception or confusion was whether, on the balance of probabilities, a substantial number of members of the public would be misled into purchasing the applicant's products in the belief that it was the opponent's.

42) Taking all of the above into account it is clear that the opponent enjoys a considerable reputation for its publication. The average consumers for each parties products overlap, as do the goods and services of the two parties. The similarities in the marks far outweigh any differences and so there would be, in my view, misrepresentation. I stated at the hearing and for the avoidance of doubt restate here, that this in no way reflects upon the integrity of the applicant. I fully accept, as did the opponent, that Mr Ayub came upon his mark independently with no knowledge of the opponent's mark or business and so there can be no question of impropriety on his part.

43) I must now consider if the opponent has suffered, or is likely to suffer, damage as a result of this misrepresentation. In *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 HL Lord Fraser stated that the opponent must show that "he has suffered, or is likely to suffer, substantial damage to his property in the goodwill". In the instant case both marks have the words "Asian" and "Trader/s" and both deal in printed publications which promote businesses. The only difference being that the applicant is promoting all businesses to all consumers

including businesses whereas the opponent is promoting grocery companies to other grocery businesses. In my opinion, the average consumer will view the applicant's directory as merely an extension of the opponent's business. If the applicant's goods and services are unsatisfactory in any way it will result in damage to the opponent's goodwill. The ground of opposition under Section 5(4)(a) is successful against the entire specification sought to be registered.

COSTS

44) As the opponent has been successful it is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £1,200. 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 7th day of September 2009

**G W Salthouse
For the Registrar
The Comptroller-General**