

O/737/19

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. 3263649 BY

IBRAHIM AL QURASHI

TO REGISTER THE FOLLOWING MARK



AND THE OPPOSITION THERETO UNDER NO. 600000773 BY

ZAHRAT ALQURASHI LTD

AND

IN THE MATTER OF REGISTRATION NO. 3240942 FOR THE MARK



AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO

UNDER NO. 502053

BY

IBRAHIM AL QURASHI

## Background and Pleadings

1. On 16 October 2017, Ibrahim Al Qurashi (“IA”) applied to register the following trade mark in the UK, for goods and services as outlined below. The application was published for opposition purposes on the 8 December 2017.

UKTM registration no. 3263649:



(“the 649 mark”)

Class 3: Aromatic essential oils; aromatic oils; body spray used as a personal deodorant and as fragrance; deodorants for body care; eau de perfume; eau de toilette; essential oils of cedar wood; ethereal oils; etheric oils; fragrances; fragrances and perfumery; incense; perfume; perfumeries; scented oils; scented wood; talcum powders.

Class 16: Adhesive labels; adhesive packing tape for stationery or household use; boxes of cardboard or paper; boxes, cartons, storage containers, and packaging containers made of paper or cardboard; cardboard boxes; cardboard packaging; cards, namely, greeting cards and note cards; gift boxes; gift boxes containing note cards; holiday cards; packaging boxes of cardboard; paper gift bags.

Class 35: Communication media (presentation of goods on), for retail purposes; demonstration of goods; organization of exhibitions for commercial or advertising purposes; retail services relating to perfumery and cosmetic products; business administration; The bringing together, for the benefit of

others, of a variety of goods being perfumery and cosmetic products enabling customers to conveniently view and purchase those goods which are presented on communication media.

2. The application was opposed by Zahrat Alqurashi Ltd (“ZA Ltd”). The opposition is only directed against some of the 649 mark’s goods, namely those in class 3. No opposition has been raised in relation to the 649 mark’s remaining goods and services in classes 16 and 35. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). For the purposes of the opposition, ZA Ltd relies upon the following earlier UK Trade Mark registration:

UKTM registration no. 3240942



(“the 942 mark”)

Filing date: 1 July 2017

Registration date: 29 September 2017

The 942 mark is registered for the following goods:

Class 3: Body cream; Body lotions; Perfume; Perfume oils; Perfume water; Perfumed creams; Perfumed oils for skin care; Perfumed potpourris; Perfumed powders; Perfumed soaps; Perfumeries; Perfumery and fragrances; Perfumes.

3. ZA Ltd submits that the marks are similar and the contested goods are identical or similar leading to a likelihood of confusion.

4. IA filed a defence and counterstatement denying the claims made.

5. On 26 April 2018, IA applied to have the 942 mark declared invalid under section 47 of the Act basing the application for invalidation upon section 5(2)(b) of the Act. The application is directed against all of the goods for which the 942 mark is registered relying upon the following EU trade mark registration no. 016220642:



("the EUTM")

Colour claimed: gold and black

Filed: 2 January 2017

Published: 10 February 2017

Registered: 22 May 2017

Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.<sup>1</sup>

6. IA claim that there is a likelihood of confusion because the marks are similar and the contested goods are identical or similar.

---

<sup>1</sup> Whilst the EUTM is registered for goods and services in classes 3, 16 and 35 for the purposes of its application for invalidation, IA relies upon its goods in class 3 only.

7. ZA Ltd filed a defence and counterstatement denying that there is any similarity between the marks.

8. Whilst the opposition originally commenced by way of the fast track procedure it was converted into a standard opposition and was subsequently consolidated with the application for invalidity.

9. ZA Ltd was originally represented by Crater Law Solicitors LLP but is now unrepresented. IA is represented by Beck Greener LLP. IA filed evidence in the form of a witness statement of Kashif Syed dated 5 February 2019. Neither party requested a hearing nor did they file written submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.

#### **Preliminary Issue regarding the evidence filed by ZA Ltd**

10. Following the consolidation of the proceedings, the Registry set a time table for the filing of evidence. Both parties were given until 5 February 2019 to file evidence in chief. There were a number of issues associated with the filing of ZA Ltd's evidence. Initially it filed documents that were not in the correct format to be considered as evidence. A further opportunity was given therefore for it to rectify the matter. Furthermore, whilst this evidence was purported to have been filed within the time frame it was not initially linked with the Registry's file and although initially admitted at this stage, it subsequently transpired, following an objection from IA, that this evidence had not been copied to IA. A preliminary view was taken by the Registry for ZA Ltd to serve the evidence on IA and under cover of its letter dated the 23 July 2019 the consequences of failing to do so was set out, namely that it would result in the evidence not being admitted. ZA Ltd failed to serve the evidence as directed and therefore by letter dated the 11 September 2019 the evidence was deemed inadmissible. ZA Ltd was given an opportunity to challenge this preliminary view but

failed to do so. I am satisfied that ZA Ltd was notified of the consequences of failing to comply with the directions set by the Registry. In light of this, the evidence submitted by ZA Ltd has not been taken into account in my assessment.

## **Evidence**

11. IA's evidence consists of the witness statement of Kashif Syed dated 5 February 2019 with 7 exhibits. Mr Syed is IA's legal representative and states that the facts and matters in his statement are taken from his personal knowledge and are true to the best of his information and belief, based on the documents and information relating to the matter. I summarise this evidence below, to the extent that I consider it necessary:

- Mr Syed produces a print out taken from Wikipedia setting out the variations in the spelling of the name "Qureshi" to include the spelling Qurashi and setting out the origins and historical background of the name.<sup>2</sup>
- Mr Syed states that Qurashi is a common Muslim family name derived from the Arabic language and refers to being a member of the 'Quraish tribe'.<sup>3</sup>
- In Britain Qureshi is the 31<sup>st</sup> most common Muslim surname with many famous people around the world, including the UK, having the surname Qureshi.<sup>4</sup>
- The word Al in AlQurashi is used as a definitive article in the same way as "the" is used in English and is commonly used in Arabic names or used to designate a family or tribal name.<sup>5</sup>

## **Decision**

12. The outcome of IA's application to invalidate the registration owned by ZA Ltd may be determinative of the opposition brought by it because if successful it will remove

---

<sup>2</sup> Para 3 of statement and Exhibit KS1

<sup>3</sup> Para 4 of statement and KS3

<sup>4</sup> KS5

<sup>5</sup> Para 7 Exhibit KS6

from the register those goods upon which ZA Ltd rely as their earlier mark in the opposition. I will therefore deal with the application for invalidation first.

## **The Invalidation Application**

13. Section 5(2)(b) of the Act is relevant to the application for invalidation because section 47 of the Act states:

“47(2) The registration of a trade mark may be declared invalid on the ground-

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
- (b) the registration procedure for the earlier trade mark was not completed before that date, or
- (c) the use conditions are met.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Union.

14. Section 5(2)(b) of the Act reads as follows:

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

(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”.

15. An earlier trade mark is defined in section 6 of the Act which gives priority to the mark which has a date of application for registration earlier than that of the trade mark in question. Given its filing date the EUTM qualifies as an earlier mark under section 6 of the Act. In addition, given the date of registration of the EUTM and the date of application the EUTM is not subject to the proof of use requirements as it has not been registered for more than five years at the date the application for invalidity was made.

16. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG, Case C-251/95*, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc, Case C-39/97*, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. Case C-342/97*, *Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98*, *Matratzen Concord GmbH v OHIM, Case C-3/03*, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04*, *Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P* and *Bimbo SA v OHIM, Case C-591/12P*.

The principles:

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



(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of the goods**

17. When conducting a goods comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union (CJEU) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

18. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

19. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T-133/05, the General Court (GC) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

20. The competing goods in respect of the application for invalidation are as follows:

IA's goods for the EUTM (the Invalidation Applicant)	ZA Ltd's goods for the 942 Mark (the Registered Proprietor)
Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.	Class 3: Body cream; Body lotions; Perfume; Perfume oils; Perfume water; Perfumed creams; Perfumed oils for skin care; Perfumed potpourris; Perfumed powders; Perfumed soaps; Perfumeries; Perfumery and fragrances; Perfumes.

21. Whilst ZA Ltd concedes that the goods may be the same or similar it remains for me to assess whether there is identity between the respective goods or, if not, the extent and degree of any similarity.

22. Taking into account the caselaw, I consider that ZA Ltd's "*perfumed soaps*" are identical to IA's "*soaps*" on the principle outlined in *Meric*.

23. In relation to ZA Ltd's "*perfume oils; perfumed oils for skin care;*" I consider that they are identical to IA's "*essential oils*".

24. With regards ZA Ltd's "*perfumeries; perfumery and fragrances; perfumes; perfume; perfume water;*" I consider that they are identical to IA's "*perfumery*", either self evidently or on the basis of the principles outlined in *Meric*.

25. Although "*perfumed potpourris*" may not be considered as perfumery in the true sense of the word, the ordinary meaning of perfumery would not only be a scent applied to the body but also include a scent applied to enhance the fragrance of a room; they would therefore share purpose. On this basis I consider that IA's *perfumery* would include the contested *perfumed potpourris* and therefore be identical. If I am wrong in this assessment then the contested goods would be similar to at least a medium degree, sharing use, users and trade channels.

26. ZA Ltd's "*body cream; body lotions; perfumed creams; perfumed powders*" share similarity with IA's "*cosmetics*" or in the alternative "*perfumery*". Cosmetics are defined in the Cambridge dictionary as "substances put on the face or body that are intended to improve its appearance or quality"<sup>6</sup> and therefore would include such things as body creams, lotions and powders. ZA Ltd's contested goods are therefore if not identical then highly similar to IA's cosmetics in so far as the goods will overlap in users, uses and trade channels. I am also aware that perfume houses not only produce perfumes

---

<sup>6</sup> <https://dictionary.cambridge.org/dictionary/english/cosmetics>

but a whole range of products infused with their own fragrance (to include creams, lotions and powders). Therefore, if I am wrong in assessing that ZA Ltd's perfumed creams and perfumed powders are similar to cosmetics then they are similar to IA's perfumery to at least a medium degree; their nature would differ but they would share use, users and trade channels.

### **The Average Consumer**

27. The average consumer is deemed to be reasonable well informed and reasonably observant and circumspect. When considering the opposing trade marks, I must consider the level of attention paid during the purchasing process and how they are selected taking into account that the level of attention may vary according to the category of goods in question.<sup>7</sup>

28. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch)*, Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

29. Neither party has made submissions regarding the average consumer or the purchasing process and therefore my assessment is a notional one based on the

---

<sup>7</sup> Lloyd Schuhfabrik Meyer, case c- 342/97.

goods as they appear on the register. In my view the average consumer for the goods at issue is a member of the general public selecting the goods from a shop or supermarket or from an online equivalent. Relatively speaking I do not consider that the goods are particularly costly and are likely to be purchased on a fairly frequent basis. Due to the nature of the goods, sales are heavily influenced by magazine/television advertisements and celebrity endorsements via social media. The purchasing process is, therefore, predominantly visual. I do not discount aural considerations however as goods at the higher range of the market may be kept behind a counter or in a locked cabinet and would therefore involve a request to supply from a sales representative. I accept that perfume is purchased according to personal taste and consumers are on the whole loyal to a particular scent. If this is the case then perhaps less consideration will be taken on repeat purchases as consumers will select the product without a high degree of scrutiny relying on their familiarity with the mark. A greater degree of care may be undertaken, however, in the purchase of a new perfume as certainly most consumers will try the perfume first. On the other hand, for goods such as ordinary day to day soap I do not consider that the level of attention will be necessarily low since factors such as suitability to the skin and allergens will be taken into account. Factoring in these variations, I consider that an average level of attention will be paid during the purchasing process.



### **Comparison of the Marks**

30. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

31. IA submits that the respective marks contain both a device and word element and that they are identical or highly similar. Both parties accept that the element “Al Qurashi” in the respective marks are identical and a reference to an Arabic/Muslim name. However, neither mark exclusively contains this element alone and both are complex marks including a number of elements. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to consider the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

32. The respective trade marks are shown below:

IA's Trade Mark (the Invalidation Applicant)	KA Ltd's Trade Mark (the Registered Proprietor)
	

## **The Overall Impression of the marks**

33. IA's mark consists of an ornate art deco device, the words IBRAHEEM AL QURASHI and an embellishment, each presented in gold on a black square that acts as a background. A proportion of the public will recognise the embellishment as Arabic writing, however, due to its stylisation I do not consider that the general UK populous will recognise it as such and will merely perceive it as a fairly ornate scroll. I note that a full stop separates the words AL and QURASHI however I consider that this will go unnoticed by the average consumer and therefore it contributes very little to the mark. Due to the position and relative size of the words and the device, the overall impression of the mark lies in the combination of these two elements although the words have a greater impact since, as a general rule, words speak louder than devices; the eye being naturally drawn to verbal elements. The embellishment contributes to the mark but it will play a lesser role and be considered as decorative for the reasons I have already set out. Despite the colour claim, the black square and colour combination whilst contributing do not play a significant role.

34. ZA Ltd's mark is a complex mark consisting of several elements. The mark is dominated by the letters Q and G presented in orange with the letter G sitting within the significantly larger letter Q. Included within the mark are the words ZHRAT AL QURASHI presented in capitals in considerably smaller font. Directly beneath and to either side of the letter Q are images of two trees in red and what appears to be Arabic writing. No explanation has been given as to the meaning of these words. Due to their relative size and position the mark is dominated by the letters Q and G. The words ZHRAT AL QURASHI contribute to the mark but not significantly so due to their size. Similarly, less weight will be attributed to the trees, colour and Arabic writing as their contribution is aesthetic and therefore these elements will play a lesser role in the overall impression.



## **Visual comparison**

35. Other than the identical words Al Qurashi there are no other visual similarities between the marks. The differences lie with the respective devices, the additional wording, the embellishments and letters Q and G. Bearing in mind my assessment of the overall impression of each mark I consider that the visual similarities between the marks are low.

## **Aural comparison**

36. The only overlap in the marks is the pronunciation of the words AL QURASHI. The average English speaking UK consumer, however, will have no understanding of the pronunciation of the Arabic names and are therefore more likely to pronounce them phonetically which will be identical in both marks. UK Consumers will, however, have an understanding of the pronunciation of the letters Q and G. Bearing in mind my assessment regarding the dominant features of the respective marks IA's mark will be pronounced as "IBRA-HEEM-AL-KOO-RASHI" as neither the device nor the embellishment will be articulated. Due to the dominance of the central letters, ZA Ltd's mark will be pronounced as QG or GQ; it is unlikely that the words ZAH RAT AL QURASHI will be articulated due to their size. If only the letters Q and G are articulated in ZA Ltd's mark then there will be no aural similarity between them. If, however, all the words and letters are articulated then the aural similarity would be low due to the shared presence of only the words AL QURASHI.

## **Conceptual comparison**

37. Both parties are in agreement that the element AL QURASHI is a Muslim surname/Arabic name. In addition, ZA Ltd submits that AL QURASHI is often used in

relation to perfume and such goods. To my knowledge neither mark appears to be descriptive of the goods nor do I consider that the average UK consumer will be aware of the origins of the verbal elements or link them to perfume. It is reasonable to conclude, however, that the verbal elements will be regarded as Middle Eastern names, following the conventional name structure of IBRAHEEM and ZAHRAT as first names and AL QURASHI as a surname. Neither party has provided evidence attributing any meaning to the additional elements although the letters Q and G may be considered as initials. To the average UK consumer, the verbal elements of the marks will be seen as a reference to a person's name, neither conveying a general and abstract idea or possessing a clear semantic content thus rendering a conceptual comparison impossible.<sup>8</sup> On this basis the position in terms of assessing the conceptual similarity of the marks is neutral.

### **Distinctive character of the earlier mark**

38. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

---

<sup>8</sup> Luciano Sandrone v EUIPO Case T-268/18

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

39. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion.

40. In *Becker v Harman International Industries*, Case C-51/09 P, the distinctive character of a surname was considered and the CJEU stated as follows:

“Although it is possible that, in part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate to take account of factors specific to the case and, in particular, to the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character.”

41. The earlier mark consists of words, a device and an embellishment which has no apparent link to the goods. Whilst I recognise that some of the elements in this mark may have more meaning for members of the UK Arabic speaking community, there is no evidence that these goods are targeted at that section of the public rather than the public generally. Consequently, I must not narrow my assessment of the mark's distinctiveness to that section of the public alone.<sup>9</sup>

42. To the average UK consumer, the mark will be seen as a reference to a name. Names are commonly used as trade marks and thus not considered as greatly distinctive. In *El Corte Inglés, SA v OHIM*, Case T-39/10, the GC found that:

“54. As the applicant asserted in its pleadings, according to the case-law, the Italian consumer will generally attribute greater distinctiveness to the surname than to the forename in the marks at issue (Case T-185/03 Fusco v OHIM – Fusco International (ENZO FUSCO) [2005] ECR II-715, paragraph 54). The General Court applied a similar conclusion concerning Spanish consumers, having established that the first name that appeared in the mark in question was relatively common and, therefore, not very distinctive (Case T-40/03 Murúa Entrena v OHIM – Bodegas Murúa (Julián Murúa Entrena) [2005] ECR II-2831, paragraphs 66 to 68).

55. Nevertheless, it is also clear from the case-law that that rule, drawn from experience, cannot be applied automatically without taking account of the specific features of each case (judgment of 12 July 2006 in Case T-97/05 Rossi v OHIM – Marcorossi (MARCOROSSO), not published in the ECR, paragraph 45). In that regard, the Court of Justice has held that account had to be taken, in particular, of the fact that the surname concerned was unusual or, on the contrary, very common, which is likely to have an effect on its distinctive

---

<sup>9</sup> *Pooja Sweets & Savouries Ltd V Pooja Sweets Limited*, BL O-195-15

character. Account also had to be taken of whether the person who requests that his first name and surname, taken together, be registered as a trade mark is well known (Case C-51/09 P Becker v Harman International Industries [2010] ECR I-5805, paragraphs 36 and 37). Likewise, according to the case-law cited in the previous paragraph, the distinctive character of the first name is a fact that should play a role in the implementation of that rule based on experience.”

43. When comparing full names and surnames account must be taken of whether the surname is unusual or on the contrary very common or whether the names, taken together, are of a particularly well known person so that the distinctive character of the mark would be affected. Even though the element AL QURASHI will be perceived as a surname it is not a name which is particularly common or well known to the English speaking consumer, whereas IBRAHEEM will be recognised as a fairly common Middle Eastern first name. Taking account of the other elements present in the mark and my conclusions regarding the overall impression, the commonality of the first name IBRAHEEM will offset the more unusual surname AL QURASHI in terms of distinctive character. Whilst ordinarily a more unusual name/surname would elevate the distinctive character of the mark, taking its position within the mark and the additional elements of the mark as a whole and weighing one up against the other, I consider that the mark will possess an average degree of distinctive character.

### **Likelihood of confusion**

44. A likelihood of confusion may arise in a form that may be direct or indirect. Before I set out my own global assessment of likelihood of confusion, I note the following relevant points from case law. Indirect confusion (and its distinction from direct confusion), was considered by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*<sup>10</sup>, where he noted that:

---

<sup>10</sup> Case BL-O/375/10

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark, I conclude that it is another brand of the owner of the earlier mark.”

45. In determining whether there is a likelihood of confusion there are a number of factors to bear in mind. The first 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 or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of IA’s trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must consider that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

46. I have identified the average consumer to be a member of the general public, who would primarily select the goods via visual means but with aural considerations not being discounted. I have found an average level of attention will be paid during the purchasing process.

47. In making my assessment of a likelihood of confusion, I bear in mind the purpose of a trade mark namely to distinguish the goods and services of one undertaking from

another. In so doing, I bear in mind that the respective parties' goods are identical or similar to at least a medium degree. I also bear in mind that I have found the respective trade marks to be visually and aurally similar to a low degree. I have found the conceptual position to be neutral. I have also found the earlier mark to have an average degree of inherent distinctive character. I must also take account of the overall impression of each mark and consider the distinctiveness of the common element within the marks as a whole. I cannot base my assessment solely on a comparison between one part of a composite mark and comparing that with another.

48. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it."

49. When comparing the two marks I take into account the obvious visual and aural differences between them; the different first names and the surname AL QUASHI

being less noticeable in ZA Ltd's mark which is dominated by other elements in particular the letters Q and G. Due to the complexity of the respective marks each including a combination of devices and words it is unlikely that the marks will be mistaken one for the other. Even with the shared presence of the identical element AL QURASHI I do not consider that this is sufficient to create confusion in the minds of the public.

50. I consider that it is reasonable to conclude that average consumers will focus on the dominant and distinctive features of ZA Ltd's mark namely the letters "Q" and "G" and dismiss the additional elements entirely or see the name ZAHRAAT AL QURASHI as the name of the founder of the business and attach little weight to it. Consumers would not confuse the two marks as a result of the differing forenames, even if they note the shared surname. It is the letters "Q" and "G" which will be retained in the mind of the average consumer and by which ZA Ltd's mark will be referred. Taking into account the nature of the respective goods, the purchasing process being dominated by visual considerations and the fact that consumers will pay an average level of attention, the differences between the marks both visually and aurally are so pronounced that it is highly unlikely that consumers will consider that the respective goods are provided by the same undertaking. The differences between the marks are such that the average consumer will easily distinguish between them. I do not consider there to be a likelihood of direct confusion.

51. Even if there were a link made between the element AL QURASHI, taking into account the decision in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, a finding of indirect confusion should not be made merely because two marks share a common element. It is not sufficient that a mark merely calls to mind another mark; this is association not indirect confusion. I would suggest that the dominant and distinctive elements present in the respective marks are sufficient to distinguish between them and no consumer will consider that there is an economical link between them even for identical or highly similar goods. Consumers may call to mind the other party's mark but they would not think that the goods came from the same source. Consumers will not consider that ZA Ltd's mark is a sub brand or brand extension of



IA's mark. It is not a natural brand variant or brand extension for trade marks to use a different forename where the trade mark consists of a forename/surname combination. There is nothing to suggest that the two are connected; consumers will merely conclude that the use of the same surname is coincidental. I do not consider there to be a likelihood of indirect confusion.

**52. On this basis the application for invalidation against the 942 mark fails and it remains available for the purposes of the opposition to the 649 mark.**

### **THE OPPOSITION**

53. ZA Ltd's claim is also based on section 5(2)(b) of the Act. Given the filing date of the 942 mark it qualifies as an earlier trade mark under section 6 of the Act. Since it had not been registered for more than five years before IA's 649 mark was published ZA Ltd's 942 mark is not subject to the proof of use provisions under section 6A of the Act.

54. For the purposes of the opposition under section 5(2)(b), I must take into account the same case law, principles and considerations as outlined earlier in my decision when the invalidation application was considered. My assessment regarding the visual, aural and conceptual similarities and the overall impressions of the respective marks therefore will not differ. I, therefore, consider the marks to be visually and aurally similar to a low degree and conceptually neutral. However, since IA's application for its 649 mark is sought for slightly different goods, a goods comparison is still necessary.

55. The comparison of the goods is therefore as follows:

IA's 649 Mark (The Applicant's mark )	Za Ltd's 942 mark (The Opponent's mark)
Class 3: Aromatic essential oils; aromatic oils; body spray used as a personal deodorant and as fragrance; deodorants for body care; eau de perfume; eau de toilette; essential oils of cedar wood; ethereal oils; etheric oils; fragrances; fragrances and perfumery; incense; perfume; perfumeries; scented oils; scented wood; talcum powders.	Class 3: Body cream; Body lotions; Perfume; Perfume oils; Perfume water; Perfumed creams; Perfumed oils for skin care; Perfumed potpourris; Perfumed powders; Perfumed soaps; Perfumeries; Perfumery and fragrances; Perfumes.

56. On the basis of my earlier assessment IA's "*eau de perfume, eau de toilette, fragrances, fragrances and perfumery; perfume; perfumeries*" are identical to ZA Ltd's "*perfume, perfume water; perfumeries; perfumery and fragrances; perfumes*" either self evidently or identical according to the principles as set out in *Meric*. I will therefore proceed on the basis that the goods are identical as this represents ZA Ltd's best case. If the opposition does not succeed in relation to goods that are identical it will not succeed for goods that are only similar or dissimilar.

57. In relation to the distinctive character of ZA Ltd's mark again the assessment will be based on the inherent qualities of the mark as no evidence has been filed to suggest that the mark's distinctive character has been enhanced through use. Bearing in mind my earlier assessment regarding the overall impression of the mark and the conceptual characteristics, the dominant and distinctive element will be seen as the letters Q and G which have no allusive or apparent connection to the goods. The text ZHRAT AL QURASHI will be seen as a name, although again not common to the average UK consumer. Even to the Arabic speaking community, I have no evidence as to how widespread and common this name would be. The common element AL QURASHI is not a particularly common surname to the English speaking UK consumer however the distinctiveness of the mark does not lie with this element alone. The device, Arabic writing and use of colour adds some distinctiveness to the mark,

however it is the letters Q and G which are the elements retained in the mind of the consumer and by which the mark will be referred. Names or surnames are commonly used as trade marks and are therefore not considered as greatly distinctive. The more common the name/surname, the less distinctive the character of the mark. The name ZHRAT AL QURASHI will not be considered as particularly common within the UK, however given its position within the mark I do not consider that it enhances the mark's level of distinctive character to a high degree. Overall, I place the level of distinctive character of the mark at no higher than average.

58. My assessment regarding the likelihood of confusion will be the same therefore even where the parties' roles are reversed. The average consumer is no more likely to confuse IA's mark for ZA Ltd's mark as it would in my earlier assessment based on the same analysis and considerations. The differences between the dominant and distinctive elements of the marks are such that no consumer would mistake one mark for the other and directly confuse the two marks or believe that the goods were provided by one and the same undertaking or that the respective undertakings were linked in any way. I find that there is no likelihood of confusion for similar reasons to those given in paragraphs 44-52 above. **The opposition therefore also fails and IA's mark may proceed to registration.**

59. For completeness since I have found no confusion in respect of those goods assessed as being identical, applying the same reasoning, the position would be the same for any goods that are only similar to those of ZA Ltd.

60. Finally, for clarity my findings would not have differed even if I had taken account of ZA Ltd's evidence. This material consisted of one statement from Gamal Al-Esaei which included details of other marks on the market containing the word QURASHI, a certificate of registration, certificate of incorporation and details regarding the origins of the name Quraishi with its spelling variation. The certificate of incorporation, and registration certificate would have been of little relevance to the decision before me and as to whether a likelihood of confusion exists. In addition, the fact that others are

including the word AL QURSHI within their mark is rarely significant because this information does not confirm whether average consumers would be aware of these marks on the market and even if they were it does not follow that the mark's inherent capacity to distinguish is altered.

## **Outcome**

61. On the basis of my conclusions both the invalidation and the opposition fail. **Subject to any successful appeal mark registration no. 3263649 may proceed to registration for the following goods:**<sup>11</sup>

Class 3: Aromatic essential oils; aromatic oils; body spray used as a personal deodorant and as fragrance; deodorants for body care; eau de perfume; eau de toilette; essential oils of cedar wood; ethereal oils; etheric oils; fragrances; fragrances and perfumery; incense; perfume; perfumeries; scented oils; scented wood; talcum powders.

Class 16: Adhesive labels; adhesive packing tape for stationery or household use; boxes of cardboard or paper; boxes, cartons, storage containers, and packaging containers made of paper or cardboard; cardboard boxes; cardboard packaging; cards, namely, greeting cards and note cards; gift boxes; gift boxes containing note cards; holiday cards; packaging boxes of cardboard; paper gift bags.

Class 35: Communication media (presentation of goods on), for retail purposes; demonstration of goods; organization of exhibitions for commercial or advertising purposes; retail services relating to perfumery and cosmetic products; business administration; The bringing together, for the benefit of

---

<sup>11</sup> No opposition was raised in relation to its goods and services in classes 16 and 35 in any event.

others, of a variety of goods being perfumery and cosmetic products enabling customers to conveniently view and purchase those goods which are presented on communication media.

**62. The application for invalidation having failed, mark registration no. 3240942 may remain on the register.**

### **Costs**

63. As both parties have been successful and unsuccessful in equal measure I make no award for costs.

Dated this 3<sup>rd</sup> December 2019

Leisa Davies

For the Registrar