

**O/0938/24**

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
APPLICATION NO. 3729009  
IN THE NAME OF ESSENCES DU MAROC  
TO REGISTER**

**ATTAR BABOHANDA**

**AS A TRADE MARK IN CLASS 3  
AND  
OPPOSITION THERETO UNDER NO. 432992  
BY  
TAREK KUDSI ALATTAR**

## **Background and pleadings**

1. On 3 December 2021, ESSENCES DU MAROC (“***the Applicant***”) applied to register the trade mark ‘ATTAR BABOHANDA’ in the UK, under number 3729009 (“***the Contested Mark***”). Details of the application were published for opposition purposes on 28 January 2022. Registration is sought for the following goods:

Class 3: Soaps; perfumes; eaux de toilette; perfumery products and beauty products; cosmetics products and toiletries products; beauty serums; face and body cream for cosmetic purposes; face and body milk for cosmetic purposes; oils for cosmetic purposes; essential oils; oils for massage purposes; cosmetic preparations for hair care; hair lotions; shampoos; hair masks; dentifrices; make-up preparations; make-up removing preparations.

2. On 27 April 2022 Tarek Kudsi Alattar (“***the Opponent***”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“***the Act***”). The Opponent relies upon the following trade mark registrations (“***the Earlier Marks***”):

**Mark 1:** Alattar

**UK registration no.** 00915608011

**Filing date:** 03/07/2016

**Registration date:** 03/11/2016

**Relying on some goods, namely:**

- Class 3      Bleaching preparations; other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery; essential oils; cosmetics; hair lotions; dentifrices.
- Class 31      Grains; agricultural, horticultural and forestry products; live animals; fresh fruits; fresh vegetables; seeds; natural plants; flowers; foodstuffs for animals; malt.



**Mark 2:**

**UK registration no.** 00908283806

**Filing date:** 06/05/2009

**Registration date:** 03/12/2009

**Relying on some goods, namely:**

Class 3 All goods in class (3) namely, bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

العطار  
Alattar

**Mark 3:**

**UK registration no.** 00915575061

**Filing date:** 24/06/2016

**Registration date:** 12/12/2017

**Relying on some goods, namely:**

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

3. The Opponent is represented by Robin Forsythe Browne. The Applicant is represented by Mitchiners.

4. In its notice of opposition, the Opponent essentially contends that the competing marks are similar (especially aurally identical), and that the parties' goods are identical

or similar, giving rise to a likelihood of confusion, including the likelihood of association. While the Opponent also argues that such misrepresentation would be detrimental to the reputation and goodwill of the Opponent's Earlier Marks, such an issue is not relevant here because those arguments are reserved for section 5(3) oppositions, which is not at issue in these proceedings.

5. The Applicant filed a counterstatement, denying the ground of opposition. In its counterstatements, the Applicant indicated that it would require the Opponent to provide proof of use of the earlier Mark 1 and Mark 2.
6. The Opponent's registrations are comparable marks based on earlier EU trade marks<sup>1</sup>. Given the respective filing dates, the Earlier Marks qualify as earlier trade marks under the above provisions. The Opponent's Mark 1 and Mark 2 completed their registration process over five years prior to the filing date of the Applicant's mark. As such, they are subject to the proof of use requirements specified within section 6A of the Act.
7. In its notices of opposition, the Opponent made statements of use in relation to Mark 1 and Mark 2 and given that the applicant requested proof of use such marks, it is subject to the proof of use requirements.
8. Mark 3 was registered on 12 December 2017 and, as such, it had not completed its registration process more than five years before the filing date of the application in issue. Thus, it is not subject to proof of use pursuant to section 6A of the Act. The Opponent can, therefore, rely upon all of the goods it has identified without having to demonstrate use.

### **Relevance of EU law**

9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated

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<sup>1</sup> Following the end of the transition period of the UK's withdrawal from the EU, all EUTMs registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). Comparable trade marks retain the same filing date, priority date (if applicable) and registration date of the EUTMs from which they derive.

law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

### **Evidence and submissions**

10. The Opponent filed evidence of use in the form of the Witness Statement of Emad Nicola Saleh dated 30 March 2023. Mr. Saleh states he is the “trademark portfolio personnel for AL Attar”, a position which he has held since 2001. He confirms that he is authorised to give evidence on behalf of the Opponent. The Opponent’s evidence consists of one Exhibit containing certificates of origin, invoices, and health certificates showing the export of products, bearing Mark 1 and Mark 2, from Jordan to the United Kingdom between the years 2020 and 2022.

11. Neither party requested a hearing. Only the Applicant filed written submissions in lieu<sup>2</sup> which I will not summarise here, but I will refer to them as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

### **Decision**

#### **Proof of use**

12. I will begin by assessing whether there has been genuine use of the earlier Mark 1 and Mark 2.

#### **The law**

“(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,

(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,

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<sup>2</sup> Dated 08 September 2023.

would be an earlier trade mark by virtue of subsection (1)(a), subject to its being so registered.”

“Section 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 of a kind falling within section 6(1)(a), (aa) or (ba) 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 relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(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 relevant period 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether

or not the trade mark in the variant form is also registered in the name of the proprietor), 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)-(5A) [Repealed]

(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.”

13. As the Earlier Marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

14. Section 100 of the Act is also relevant, which reads:

“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.”

15. Consequently, the onus is upon the opponent to prove that genuine use of the registered trade marks was made in the relevant period.

### **Case law**

16. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including:

- (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question;
- (b) the nature of the goods or services;
- (c) the characteristics of the market concerned;
- (d) the scale and frequency of use of the mark;
- (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them;
- (f) the evidence that the proprietor is able to provide;
- and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23];

*Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

17. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

18. The relevant period in which genuine use must be established is the five-year period ending on the date of filing of the contested mark. In the case before me, that period is **4 December 2016 to 3 December 2021**. By virtue of paragraph 7 of Part 1, Schedule 2A of the Act, use within the EU is relevant for the first four years of the relevant period which falls prior to IP Completion Day (31 December 2020).

### **Mark 1 and Mark 2**

19. I will consider whether proof of use has been shown for both Mark 1 and Mark 2. The presence of the word ‘namely’ in the specification of Mark 2 has the effect of limiting the goods covered by this registration to same specification as Mark 1. As such, the goods covered by Mark 1 and Mark 2 are the same, being as follows:

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

20. The Opponent provides evidence in the Witness Statement of Mr. Emad Nicola Saleh dated 30 March 2023, which has one accompanying exhibit labelled Exhibit 1.

21. The Opponent submits export invoices from Jordan to the UK regarding herbal tea from flowers and plants with medicinal effect. The Opponent's evidence is comprised of:

- Commercial Invoice, Packing List, and Health Certificate for Export relating to bill No. S21PK964 for 47,172 pieces of herbal tea for a value of \$44,925 dated 21/05/2022. The goods were shipped to a company in London (UK).
- Commercial Invoice, Packing List, and Health Certificate for Export relating to bill No. S21PK905 for 21,840 pieces of herbal tea bags for a value of \$15,700 dated 01/09/2021. The goods were shipped to a company in London (UK) (same company as for invoice No. S21PK964).
- Commercial Invoice relating to bill No. S21PK905 for 21,840 pieces of herbal tea bags for a value of \$15,700 dated 01/09/2021. The goods were shipped to a customer in Dubai (UAE).

22. While the above invoices are noted, one relates to sales in Dubai (UAE), being outside of the relevant territory for the present assessment, and another is dated 21 May 2022, being outside of the relevant period. Therefore, the only invoice relevant to the present proceedings is the shipment of 21,840 herbal tea bags (for a value of \$15,700) to London in September 2021. For the avoidance of doubt, I will say no more about the irrelevant invoices.

23. The Opponent's evidence shows use of Mark 2 as registered and Mark 1 (i.e., word-only element contained within Mark 2) applied on the Opponent's packing list documentation No. S21PK905 referring to the invoice as shown below:

Customer : PAVLY LTD			Packing list For Bill No. S21PK905			Date : 01/09/2020	
Address : Gable House 239 Regent's Park Road London N3 3LF England						TEL: 00447468573326	
#	Description	QTY / Bags	QTY / Pieces	Unit	QTY / Case	Pro. Date	Exp. Date
1	Attar Herbal Tea 20 Bags	20 Bags	10800	24	450	23/08/2021	22/08/2024
2	Shami Herbal Tea 20 Bags	20 Bags	11040	12	920	23/08/2021	22/08/2024
Total			21840		1370		



24. It is my view that the evidence provided does not sufficiently show the Opponent has maintained genuine use of the Earlier Mark 1 and Earlier Mark 2 in the UK in relation to the contested goods throughout the relevant period.

25. Firstly, the Applicant submits that the Opponent's evidence of use does not show actual use of Mark 1 and Mark 2 applied to the registered goods in Class 3, but exclusively on the shipping documentation and that there is no evidence the relevant public has viewed such marks except for those handling the export shipment of the goods.<sup>3</sup> Additionally, the Applicant contends that the evidence of use is limited to the use of Mark 1 and Mark 2 exclusively in relation to "herbal tea made from flowers". Mr Saleh confirms in his witness statement that the goods to which the evidence refers "comprise herbal tea made from flowers and plants which have a medicinal effect". Therefore, whilst it is my view that the shipping documentation constitutes valid evidence for showing trade mark use, I find that the evidence of use does not apply to the registered goods in Class 3 upon which the Opponent is relying on for its opposition. It is worth noting that "herbal teas" are proper to Class 5 (medicinal) and/or

<sup>3</sup> Submissions in lieu dated 08 September 2023.

Class 30 (non-medicinal herbal teas) and do not relate to the contested goods in Class 3.

26. Secondly, I note the commercial invoices filed in evidence carry the letterhead and are signed by 'Albajes Company For Natural Herbs and Honey Production' and their respective Packing Lists carry the letterhead of 'Al Bages For Production Herbs & Honey'. Similarly, the respective Health Certificate for Export show 'Al Bages For Production Herbs & Honey' as the 'Export Company'. While noted, there is no mention of the Albajes (or Al Bages) company in the Witness Statement so as to suggest the relationship between it as the Opponent. In addition, there is no express confirmation that this company has the Opponent's consent to use the earlier marks. Without anything before me to suggest the nature of the relationship between these parties or any express confirmation of consent, I do not consider it reasonable to infer that the use was with the Opponent's consent. As a result, I do not consider that this use is capable of supporting the Opponent's claim to have genuinely used its marks.
27. Lastly, the Opponent provided evidence of sales for one client based in the UK (London). This is not sufficient to show genuine use of Mark 1 and Mark 2 in the UK. This is because the Opponent merely provided one invoice (No. S21PK905) referring to the relevant period concerning the sale of herbal tea and shipped to one single business based in London. I appreciate that the case law cited above sets out that use need not be quantitatively significant for it to be deemed genuine, however, it does require that the evidence show that the Opponent has made a genuine attempt to create or preserve a market share for the relevant goods. In my view, one invoice to a single UK customer in 2021 is not sufficient to demonstrate such an attempt, especially in light of the nature of the market for said goods.
28. In light of the above, I find that the evidence submitted does not show proof of genuine use because: 1) it does not refer to the Contested goods, 2) the invoices demonstrate use by companies that do not appear to have the consent of the Opponent, 3) the invoices are addressed to the same single business in London, and 4) the volume of sales does not justify the issuing of one invoice for the UK within the relevant period. Therefore, I find that the Opponent is not entitled to rely upon Mark 1 and Mark 2 for all the goods contained in Class 3.

29. It follows that the Opposition is based exclusively on Mark 3. For the remainder of this decision I will refer to Mark 3 as the Earlier Mark or the Opponent's mark.

### **Section 5(2)(b)**

#### **The law**

30. Sections 5(2)(b) and 5A of the Act read 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.”

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

31. 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:

(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 great 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 the earlier mark to mind, 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

32. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

“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”.

33. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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

34. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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 fur 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”.

35. The competing goods are as follows:

Opponent’s goods	Applicant’s goods
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<u>Class 3</u>	<u>Class 3</u>
Bleaching preparations; other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery; essential oils; cosmetics; hair lotions; dentifrices.	Soaps; perfumes; eaux de toilette; perfumery products and beauty products; cosmetics products and toiletries products; beauty serums; face and body cream for cosmetic purposes; face and body milk for cosmetic purposes; oils for cosmetic purposes; essential oils; oils for massage purposes; cosmetic preparations for hair care; hair lotions; shampoos; hair masks; dentifrices; make-up preparations; make-up removing preparations.

36. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

### Class 3

- ‘*Soaps; perfumery products; cosmetics products; hair lotions; essential oils.*’

37. The above terms all appear in the opponent’s specification, be that word identically or slightly differently. Regardless, the goods are self-evidently identical.

- ‘*Perfumes; eaux de toilette*’

38. The above terms fall within the Opponent’s general category of ‘perfumery’ or vice versa. They are identical on the principle outlined in *Meric*.

- ‘*Toiletries products*’

39. Toiletries are defined as products that one uses when washing or taking care of the body, for example soap and toothpaste.<sup>4</sup> It follows that the Applicant’s term ‘toiletries

<sup>4</sup> <https://www.collinsdictionary.com/dictionary/english/toiletries>.

products' is identical on the principle outlined in *Meric* with the Opponent's terms 'soaps' and 'dentifrices'.

- *'Beauty products; beauty serums; face and body cream for cosmetic purposes; face and body milk for cosmetic purposes; cosmetic preparations for hair care; make-up preparations; make-up removing preparation; hair masks'*

40. The Applicant's terms above fall within the wider category of the Opponent's 'Cosmetics'. Cosmetics are defined as preparations intended to beautify the hair, skin, or complexion.<sup>5</sup> Thus, these terms are identical on the principle outlined in *Meric*.

- *'Oils for massage purposes; oils for cosmetic purposes'*

41. The Applicant's terms are sufficiently broad enough to cover a range of essential oils used for differing purposes. Regardless, I find that both terms fall within the Opponent's general category of 'essential oils'. Thus, these terms are identical on the principle outlined in *Meric*.

- *'Shampoos'*

42. I find the term 'Shampoos' to be highly similar to the Opponent's term 'hair lotions'. This because shampoos and hair lotions share the same users, have the same nature (i.e., hair products), method of use, and may have the same intended purpose (e.g., moisturise, condition, and soften hair). Shampoos and hair lotions are also sold through the same trade channels; the same undertakings will produce and sell shampoos and hair lotions and these goods are likely to be displayed on the same shelves in shops or in the same sections in online stores.

### **The average consumer and the nature of the purchasing act**

43. It is necessary to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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:

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<sup>5</sup> [https://www.oed.com/dictionary/cosmetic\\_adj?tab=meaning\\_and\\_use#8235478](https://www.oed.com/dictionary/cosmetic_adj?tab=meaning_and_use#8235478).

“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”.

44. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods in question.<sup>6</sup>

45. The average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96, *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31).

46. The contested goods will be purchased by the general public as well as those working professionally, such as beauticians, make-up artists and massage therapists. Both the general public and the professionals will take various factors into consideration such as quality, ingredients, fragrance, price, and suitability for the user’s needs (for example, in accordance with the purchaser’s type of hair, skin, or complexion). The cost of the purchase is likely to vary, although it is unlikely to be particularly high. The frequency of the purchase is also likely to vary, but for the most part they are likely to be bought fairly frequently. Accordingly, the level of attention paid will be medium for everyday goods bought by members of the general public and above medium for professional purchasers since the products’ selection will be important for their business. However, the likelihood of confusion must be assessed from the perspective of the former (the general public) since they are the group who will pay the lower degree of attention.<sup>7</sup>

47. The goods are likely to be obtained directly from the provider via websites, specialised retail outlets, or by self-selection from the shelves in supermarkets. As such, it is my view that the purchasing process will be predominantly visual in nature. However,

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<sup>6</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, (Case C-342/97, para 26).

<sup>7</sup> Case T-356/14, [25] – [26].

aural considerations in the form of word-of-mouth recommendations or verbal discussions with the provider (e.g., in beauty shops the hairdresser or beautician will use the product on the customer and then recommend it to them) cannot be excluded entirely.

### **Comparison of trade marks**

48. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

49. 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”.

50. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

51. The trade marks to be compared are as follows:

<b>Earlier trade mark</b>	<b>Contested trade mark</b>
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<p style="text-align: center;">  </p>	<p style="text-align: center;">ATTAR BABOHANDA</p>
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### The Overall Impression of the marks

52. The Earlier Mark consists of the word 'ALATTAR' in the Latin (i.e., Roman) alphabet placed underneath a word (or sentence) in the Arabic alphabet. Most of the relevant UK public would not be familiar with the Arabic alphabet and the consumers' eye would naturally be drawn to the verbal element of the mark that can be read. Thus, 'ALATTAR' would play the greater role in the overall impression, with the Arabic word playing a lesser role and likely to be seen as an additional device. The overall impression of the Opponent's mark lies in the combination of these two elements although the Roman-charactered word will have a greater impact since, as a general rule, words speak louder than devices.

53. In the Contested Mark, I find that the words "ATTAR" and "BABOHANDA" are not correlated to create a unitary meaning, but each retain an independent distinctive role being equally dominant in the mark and equally contributing to the overall impression.

### Visual similarity

54. The Earlier Mark is comprised of the word 'ALATTAR' in Roman characters and an Arabic word placed above it. The word 'ALATTAR' is six letters long and fully contains the first word of the Contested Mark 'ATTAR'. The two words share the last four letters out of the six composing the word 'AL-ATTAR'. UK consumers read from left to right. The Earlier and Contested Mark differ in the prefix "AL-" present in the Opponent's mark, in the Arabic word in the Opponent's mark, and the word 'BABOHANDA' placed at the end of the Contested Mark following "ATTAR". I therefore find the marks to be similar to a medium degree.

### Aural similarity

55. The average consumer in the UK will be able to read the three-syllable word 'ALATTAR' in the Opponent's mark. They will not, however, voice the Arabic word on the basis that they will not know how to pronounce it. As a result, the aural element of the Opponent's mark will be made up solely of the word "ALATTAR". On the other hand, the Applicant's mark will be pronounced in full, being the two-syllable word "AT/TAR" and the four-syllable word "BABOHANDA". I find consumers are likely to pronounce the "ATTAR" section in the same manner in both marks.
56. In his statement of grounds, the Opponent argues that the marks share the same first letter "A" and that consumers will not stress the "L" sound, pronouncing the two words "ALATTAR" and "ATTAR" in a very similar manner. The Applicant, in its defence, argued that the only aural similarity would reside in "-attar". I agree with the Applicant. Whilst I appreciate that both marks begin with the same letter "A", I do not see why the UK consumers would overlook the letter "L" in pronouncing "ALATTAR".
57. In the Contested Mark, the consumers will carry on and read the word "BABOHANDA" which separates phonetically from the first part "ATTAR" as well as to the Earlier Mark.
58. In light of the above considerations, I find the marks to be aurally similar to a medium degree.

### **Conceptual similarity**

59. In its statement of grounds, the Opponent submitted that "ALATTAR" is his surname. Whilst I appreciate that "ALATTAR" might be seen as a surname in Syria (the Opponent's country of origin), I do not believe that the UK consumer will understand it as such. The Applicant submits that according to 'Names.org' "*Al attar is a business title of someone who trades tea medicine and herbs*"; "*A family title that means a person that trades tea, medicine and herbs*"; "*Perfume maker*"; "*Herbal and perfume merchant*"; "*The apothecary*".<sup>8</sup> The Applicant's evidence shows that the "various users familiar with the English language" who might know the meaning of "ALATTAR" consist in users from Singapore, Australia, Jordan, Canada, and the USA.<sup>9</sup> I derive, thus, that there is no evidence showing that the relevant UK consumer might understand the word "ALATTAR" as having any clear meaning. As a result, I find that

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<sup>8</sup> Submissions in lieu dated 08 September 2023.

<sup>9</sup> Page 4/12 of Submissions in lieu dated 08 September 2023.

'ALATTAR' will be understood as either a foreign language or made-up word with no obvious meaning.

60. Turning to the Arabic word in the Opponent's mark, the Applicant submits that the Opponent seems to suggest that the Arabic word translates as "ALATTAR"; the Applicant argues that a translation made through Google Lens on 07 September 2023 (exhibited as evidence) showed the Arabic letters translating as "Apothecary".<sup>10</sup> Leaving aside the meaning of the Arabic word, I find that the relevant UK consumer, being mostly unfamiliar with Arabic, will not understand the Arabic word in any of these meanings. As such, the average consumer is likely to see the Arabic word as carrying no obvious meaning.

61. The Applicant, in its defence, argued that the Contested Mark would clearly be understood as a name. The Applicant also submitted a dictionary definition showing "ATTAR" as meaning "an essential oil from flowers, esp the damask rose, used pure or as a base for perfume". I am not convinced that the relevant consumer would perceive "ATTAR" as having any of these meanings; for a concept to be relevant, it must be capable of immediate grasp by the relevant consumer (*The Picasso Estate v OHIM*, Case C-361/04 P). Neither party provided a meaning for the word "BABOHANDA". It follows that the relevant consumer will perceive the Contested Mark as a combination of two words devoid of any clear known meaning.

62. In light of the above, I find the marks to be conceptually neutral.

### **Distinctive character of the Earlier Mark**

63. 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-

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<sup>10</sup> Submissions in lieu dated 11 September 2023.

109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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).”

64. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the services, to those with high inherent distinctive character, such as invented words. 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.

65. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it. In that regard, I note that whilst the Opponent did not directly submit evidence of the use of the Earlier Mark, the Opponent’s evidence includes use of the word ‘alattar’. Nonetheless, the evidence provided is (1) in relation to goods not at issue in these proceedings, (2) does not appear to be use by the Opponent and (3) is limited to one commercial invoice for the UK territory. It follows that there is no evidence provided that would enable me to determine the Opponent’s market share, nor any details of advertising expenditure, and the geographic extent of the use of the mark does not appear to be significantly widespread. Accordingly, I have only the inherent position to consider for the Earlier Mark.

66. The Earlier Mark comprises the word “ALATTAR” with the first “A” capital. The word “ALATTAR” is placed under a device that resembles an Arabic word. “ALATTAR” will be perceived either as a foreign language or made-up word with no obvious meaning and does not describe or allude in any way to the goods for which the Earlier Mark

has been registered. Therefore, I find that it possesses a high level of distinctive character. As for the Arabic word device, while I do not consider that it will be disregarded altogether, it does not contribute to the mark to any sufficient degree so as to increase its distinctiveness beyond that which is created by the word “ALATTAR”. I say this because it will either be viewed as a mere figurative device or will be understood simply as the Arabic lettering of “ALATTAR”. As a result, I find that, overall, the Earlier Mark possesses a high degree of distinctive character.

### **Likelihood of confusion**

67. There is no simple formula for determining whether there is a likelihood of confusion.

The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

68. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. The concept of indirect confusion was explained by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10 as follows:

“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 recognized 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 as a whole, I conclude that it is another brand of the owner of the earlier mark”.

69. The goods at issue are identical or highly similar. I have concluded that the members of the general public (being those upon my assessment of confusion will focus) are likely to pay a medium level of attention for the contested goods. The distinctiveness of the Earlier Mark is high. The marks have a medium degree of visual and aural similarity and are conceptually neutral.
70. Taking all of the above into account and even bearing in mind the principle of imperfect recollection, I find that consumers will notice the differences between the marks and be able to accurately recall and remember which mark was which. I find that this is particularly the case because the marks differ in their beginnings, the Earlier Mark features an additional figurative element (i.e., Arabic characters), and the Contested Mark contains a long additional word (“BABOHANDA”) that is not contained in the Earlier Mark. Consequently, I do not find there is a likelihood of direct confusion between the marks, even on identical goods.
71. Having found that there is no likelihood of direct confusion between the marks, I must now consider the possibility of indirect confusion. It should be borne in mind that a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion.<sup>11</sup> Further, there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.<sup>12</sup>
72. I appreciate that the word ‘ALATTAR’ enjoys a high degree of distinctive character, however, this element is not directly replicated in the Contested Mark. Instead, the marks at issue share the string of letters “ATTAR”. Therefore, it does not follow that the marks can be said to share an element so strikingly distinctive that consumers would believe that only one undertaking would use it. Further, I see no reason why the relevant consumers would view the differences between the marks (being the initial letters “AL-“ in the Earlier Mark and the second word “BABOHANDA” in the Contested Mark) and believe them to be logical indicators consistent with a brand extension or sub-brand. Even in the eventuality the consumers may call to mind “ALATTAR” when seeing “ATTAR BABOHANDA”, this would amount to mere

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<sup>11</sup> In *Liverpool Gin Distillery Limited v Sazerac Brands LLC* [2021] EWCA Civ 1207, paragraph 13, Arnold LJ approved this “consolation prize statement” as made by James Mellor QC’s (sitting as the Appointed Person) statement in *Cheeky Italian Ltd v Sutaria* (O/219/16) paragraph 16.

<sup>12</sup> *Ibid*, Arnold LJ’s words at paragraph 13.

association and not confusion.<sup>13</sup> I therefore find there to be no likelihood of indirect confusion, even on identical goods.

### **Conclusion**

73. The Section 5(2)(b) opposition fails, and the application may proceed to registration.

### **Costs**

74. The Applicant has been successful and is entitled to a contribution towards its costs. In approaching the award, I notice that the Applicant complained about the Opponent's multiple amendments to its pleadings and the repeated failures to copy the Applicant in the correspondence. Regarding the request of the retrospective extensions of time and the notification of submitted evidence of use, according to the Office's communication of 13 April 2023, the Applicant did not receive correct communication due to an internal error from the Office which led to the relevant communication not being sent. A copy of the evidence of use was then sent on the same date. Nonetheless, I appreciate that the Opponent has repeatedly failed to copy the Applicant in the relevant communications, and this may have caused the Applicant to incur in higher costs. Considering that the Opponent has had professional representation throughout the whole proceedings, I am minded to award the Applicant with an additional 10% of the total cost award. Bearing in mind the relevant scale set out in the TPN 2/2016, I award costs as follows:

Considering the notice of opposition and filing a counterstatement	£200
Submissions in lieu	£500
Sub-total:	£700
Additional 10%	+£70
<b>Total:</b>	<b>£770</b>

75. I order Tarek Kudsi Alattar to pay ESSENCES DU MAROC the sum of **£770**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within

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<sup>13</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.

twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 30<sup>th</sup> day of September 2024**

**Andrea Rossi**

**For the Registrar**