



**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**  
**CANCELLATION DECISION**  
**N° 3000450**  
**of 20 July 2023**

**Claimant:** **AL FAKHER INTERNATIONAL CO**  
P.O. BOX 309, Uglan House  
Grand Cayman KY1 1104  
The Cayman Islands

**Representative:** **HGF B.V.**  
Gedempt Hamerkanaal 147  
1021 KP Amsterdam  
Netherlands

*against*

**Defendant:** **Abdullah Abdullah**  
Admiraal de Ruijterweg 15 2  
1057 JT Amsterdam  
Netherlands

**Contested trademark: Benelux registration 1432912**

Fahker Gold

## I. FACTS AND PROCEEDINGS

### A. Facts

1. On 31 May 2022 the claimant filed an application for cancellation with the Benelux Office for Intellectual Property (hereinafter: "the Office" or "BOIP") in accordance with Article 2.30bis (1)(b) of the Benelux Convention on Intellectual Property (hereinafter: "BCIP"), invoking the relative grounds for invalidity as stated under Article 2.2ter (1)(b) BCIP, namely that there exists a likelihood of confusion on the part of the public.

2. The application for cancellation is based on the earlier European Union trademark 18142616, filed on 24 October 2019 and registered on 30 May 2020 for goods in class 34, of the semi-figurative trademark



3. According to the register, the earlier trademark is now in the name of AL FAKHER INTERNATIONAL CO by virtue of a total transfer of ownership. The claimant is therefore the actual holder of the earlier trademark invoked.

4. The application for cancellation is aimed at Benelux registration 1432912 of the word mark "Fahker Gold", filed on 5 January 2021 and registered on 2 April 2021 for goods in class 34.

5. The cancellation claim is directed against all goods of the contested trademark and is based on all goods of the invoked earlier trademark.

6. The language of the proceedings is English.

### B. Course of the proceedings

7. The application for cancellation is admissible and was notified by the Office to the parties on 2 June 2022. During the administrative phase of the proceedings both parties filed arguments. The course of the proceedings meets the requirements as stated in the BCIP and the Implementing Regulations (hereinafter: "IR"). The administrative phase was completed on 23 August 2022.

## II. ARGUMENTS

### A. Claimant's arguments

8. In comparing the signs, the claimant considers that the word elements 'FAKHER' in the invoked trademark and the element 'FAHKER' of the contested mark are the most dominant respective elements of the marks at issue because they have no meaning for the relevant Benelux public. He explains that the element "AL" of the invoked trademark is clearly separated from the element "FAKHER" and is likely to be recognized as the Arabic word for "the" – noting that a significant number of Arab people live in the Benelux. Therefore, the term "AL" as such will have a low impact on the consumers' perception of the sign as a whole. Moreover, the claimant indicates that the graphic elements of the invoked trademark are very basic geometrical shapes and/or very common decorative features, therefore, these elements are weak. The

applicant adds that the crown is also weak because it is a common symbol denoting high quality. Finally, the applicant states that the term "GOLD" is commonly used to denote high quality and, accordingly, this element is weak.

9. Visually, the claimant believes that the contested trademark coincides in the letters F, A, K, H, E, R albeit that the letters K and H are switched in the contested trademark. Since the letter combinations at the beginnings and ends of these elements coincide and the only difference is in the middle, this difference will not be particularly noticeable. The claimant underlines that the marks differ in the word "GOLD" in the contested sign and "AL" in the trademark invoked, nevertheless, it must be taken into account that these elements are either non-distinctive or weak. In the claimant's view, the signs in question are visually similar.

10. Phonetically, the claimant argues that the signs coincide in the sound of the letters "FAKHER" in the trademark invoked and "FAHKER" in the contested trademark, which will produce an identical sound considering that the letter H is silent when spoken. The claimant states that the pronunciation differs in the sound of the letters "AL" in the trademark invoked and "GOLD" in the contested trademark, however, these elements are quite weak. The claimant concludes that the signs in question are phonetically highly similar.

11. Conceptually, the claimant is of the opinion that neither of the signs taken in their entirety has any meaning in the Benelux and therefore, a conceptual comparison is not possible.

12. In the context of the comparison of the goods, the claimant explains that the respective goods are identical.

13. According to the claimant, the trademark invoked is distinctive *per se*, which increases the likelihood of confusion. He also states that the goods in question are directed at the public at large.

14. In view of the above and relying on the principle of interdependence, the claimant considers that there is a likelihood of confusion between the marks at issue on the part of the relevant public.

15. The claimant is requesting the Office to grant the invalidity and order the defendant to bear the costs.

## **B. Arguments of the defendant**

16. The defendant contests the existence of a likelihood of confusion between the trademarks in question. He explains that the invoked trademark is composed of the word elements "AL FAKHER" which means "The Luxurious" in Arabic, associated with a crown sign and the word elements "AL FAKHER" in Arabic, whereas the contested trademark has no associated devices or sign, and therefore, the two marks share only a few letters.

17. According to the defendant, "AL" in Arabic means "The" in English and removing "AL" changes the structure of the word, making it grammatically wrong in Arabic since "AL" is an integral part of the name, which, in the words of the defendant "*dubbing the trademark the most luxurious*". The luxurious character is further emphasized by the crown sign in the visual aspect of the trademark invoked. The defendant argues that "FAHKER GOLD" has no literal meaning but is emphasized by the word GOLD which holds the main part of the trademark with "FAHKER" being a name.

18. The defendant considers that the trademarks share a similar word component, the name "FAHKER" and the adjective/name "FAKHER", and that the differences in the meaning between the two words said to

be similar, as well as other word components of the trademarks being "AL" and "GOLD", show signs of differences between the two trademarks.

19. The defendant indicates that *"regarding claim of identical goods description based on shared recommendations on BOIP databases for a Class number and having other different goods also mentioned"* and that *"it must hold against this claim"*.

20. According to the defendant, the marks are distinguished by the different main word in each of the respective marks "FAKHER" (Arabic for luxurious) and "GOLD" (colour), which constitutes the clear verbal distinction between the two marks because it is half of the contested trademark "FAKHER GOLD" and the main word of this trademark. The defendant relies on an example of existing tobacco trademarks to assert that new potential customers carefully pay attention to new goods to avoid confusion.

21. The defendant maintains the validity of its trademark and indicates that if it is deemed too similar to any other trademark, to the point where it might cause confusion to the public, the application would not have been made it through the (application) examination and the opposition period.

### **III. DECISION**

#### **A.1 Likelihood of confusion**

22. Pursuant to Article 2.30bis (1)(b)(i) BCIP the proprietor of an earlier trademark may file an application for invalidation with the Office against a trademark which ranks after his own in accordance with the provisions in Article 2.2ter BCIP.

23. Article 2.2ter (1) BCIP stipulates, as far as relevant in this case: *"a trademark shall, [...], if registered, be liable to be declared invalid where: (...) b. because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark."*<sup>1</sup>

24. A likelihood of confusion within the meaning of this provision exists if the public may believe that the goods or services designated by that trademark and those covered by the trademark applied for come from the same undertaking or, where appropriate, from undertakings which are economically linked.<sup>2</sup>

25. According to settled case-law of the CJEU, the existence of a likelihood of confusion in the mind of the public must be assessed globally, considering all the relevant circumstances of the individual case, including the degree of similarity between the signs at issue and the goods or services concerned, the degree of recognition of the earlier trademark and the degree of distinctiveness – inherent or acquired through use – of the earlier trademark.<sup>3</sup>

#### **Comparison of the goods**

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<sup>1</sup> Article 2.2ter, 1 (b) BCIP implements article 5, 1 (b) Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks. A similar provision can be found in article 8, 1 (b) Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark.

<sup>2</sup> CJEU 11 June 2020, C-115/19 P, ECLI:EU:C:2020:469, point 54 (China Construction Bank).

<sup>3</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 57 (Equivalenza) and the case-law mentioned there.

26. In assessing the similarity of the goods or services concerned, all the relevant factors relating to these goods or services themselves should be considered. These factors include, inter alia, their nature, their end-users and their method of use and whether they are in competition with each other or are complementary.<sup>4</sup>

27. In comparing the goods or services, the goods or services shall be considered in the terms set out in the register, and not the actual or intended use.<sup>5</sup>

28. The goods to be compared are the following:

<b>Cancellation based on:</b>	<b>Cancellation directed against:</b>
CI 34 Tobacco; smokers' articles; matches; absorbent paper for tobacco pipes; articles for use with tobacco; ashtrays for smokers; Ashtrays, not of precious metal; chewing tobacco; cigarettes; cigars; cigarillos; cigarettes containing tobacco substitutes; cigarette paper; cigarette tips; cigarette tubes; cigarette filters; cigarette cases; cigarette holders; cigarettes (pocket machines for rolling); cigarette pipes- not of precious metal; cigarette boxes- not of precious metal; cigar cases; cigar cutters; cigar holders; cigar boxes not of precious metals; cigar and cigarette dispensers for tables and desks; electronic cigarettes; electronic cigarettes flavored tobacco; electronic hookahs; electronic cigarette boxes; electronic cigarette cases; electronic smoking pipes; electric or non-electric lighters; filter-tipped cigarettes; firestones; firestones for hookas; flavorings other than essential oils, for use in electronic cigarettes; flavoured tobacco; flavourings for tobacco and hookahs; gas containers for cigar lighters; herbal molasses (tobacco substitutes); herbs for smoking; hookahs (shisha); hookah (shisha) tobacco; hookahs with flavored tobacco; hookah (shisha) pipes; hookah parts namely hookah foil, hoses, bowls, hookah stems, hookah hose tips and hookah tongs; humidors; leaf tobacco; Liquid nicotine solutions for use in electronic cigarettes; lighter flints; lighters for smokers; Wicks for lighters; lighter tanks; lighter fuel tanks; long tobacco pipe sheaths; match boxes and match cases and match holders not of precious metal; mentholated tobacco; Herbal molasses [tobacco substitutes];	CI 34 Shisha tobacco; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Flavorings, other than essential oils, for tobacco; flavorings for hookahs.

<sup>4</sup> CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

<sup>5</sup> General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

mouthpieces for cigarette holders; mouthpieces for hookahs; oral vaporizers for smokers; pipe cleaners for tobacco pipes; smoking tobacco; Smokeless cigarette vaporizer pipes; steam stones for hookahs; tobacco filters; tobacco cans; tobacco jars and tins; tobacco substitutes; tobacco tins not of precious metal; tobacco pipes; tobacco pipe cleaners; tobacco powder; tobacco pouches; tobacco cases; tobacco pots and jars not of precious metal; rolling tobacco; smokeless tobacco; Tobacco, raw or manufactured; shredded tobacco; vaporizers for smoking purposes; Filters for tobacco goods.	
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29. The contested goods *Shisha tobacco; Flavorings, other than essential oils, for tobacco; flavorings for hookahs* are reproduced identically in the claimant's list of products.

30. The contested goods *Electronic cigarette Liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin* are highly similar, if not identical, to *liquid nicotine solutions for use in electronic cigarettes; flavorings other than essential oils, for use in electronic cigarettes* covered by the invoked trademark since they at least coincide in purpose, distribution channels, producers and relevant public.

#### *Conclusion*

31. The defendant's goods are identical or at least highly similar to the claimant's goods.

#### **Comparison of the signs**

32. To assess the degree of similarity between the conflicting signs, their visual, phonetic and conceptual similarity should be determined. Although the comparison must be based on the overall impression that the signs leave in the memory of the relevant public, it must nevertheless be made in the light of the intrinsic qualities of the conflicting signs.<sup>6</sup>

33. Although the comparison must be based on the overall impression made by those signs on the relevant public, account must nevertheless be taken of the intrinsic qualities of the signs at issue.<sup>7</sup> The overall impression created in the mind of the relevant public by a complex trademark may, in certain circumstances, be dominated by one or more of its components. Regarding the assessment whether this is the case, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition, and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.<sup>8</sup>


<sup>6</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 (Equivalenza).

<sup>7</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivalenza).

<sup>8</sup> General Court (EU) 23 October 2002, T-6/01, ECLI:EU:T:2002:261, points 34 and 35 (Matratzen) ; and 13 December 2007, T-242/06, ECLI:EU:T:2007:391, point 47 (El Charcutero Artesano).

34. The assessment of the similarity between the signs, regarding the visual, aural and conceptual similarity of the signs, must be based on the overall impression created by them, taking into account, inter alia, their distinctive and dominant components.

35. The trademarks to be compared are the following:

Earlier trademark:	Contested trademark:
	<p data-bbox="1027 618 1193 645">FAHKER GOLD</p>

#### Visual comparison

36. The trademark invoked is a black and white semi-figurative mark consisting of the terms AL FAKHER placed centrally against a white/grey background. The mark also contains an image of a stylized crown represented above the elements AL FAKHER and some inscriptions in Arabic below the elements AL FAKHER. The entire mark is inside a black rectangle.

37. The contested trademark is a word trademark consisting of the word elements "FAHKER GOLD".

38. Where a sign is composed of verbal and figurative elements, the former should, in principle, be regarded as more distinctive than the latter, since the average consumer will more readily refer to the goods and/or services in question by citing the name than by describing the figurative elements of the sign.<sup>9</sup> In the present case, although the figurative element in the contested sign is not negligible<sup>10</sup>, the consumer's attention will be directed primarily to the word element AL FAKHER, given its size and position within the sign, and then to the wording in Arabic. The figurative elements will be perceived more as decorative elements emphasizing the words.

39. As regards the contested mark, it is settled case law that consumers generally attach more importance to the first part of a trademark<sup>11</sup>, therefore, the consumer's attention will first be drawn to the dominant word element FAHKER.

40. The contested trademark coincides in the identical letters F, A, K, H, E, R albeit that the letters K and H are switched in the contested sign.

41. Since the letter combinations at the beginnings and ends of these elements coincide and the only difference is in the middle, this difference will not be particularly noticeable.

<sup>9</sup> General Court (EU) 14 July 2005, T-312/03, ECLI:EU:T:2005:289, point 37 (SELENIUM-ACE).

<sup>10</sup> Court of Appeal of The Hague 11 September 2012, 200.105.827/0, ECLI:NL:GHSGR:2012:BX8916 (MOOVE-4MOVE).

<sup>11</sup> General Court (EU) 17 March 2004, T-183/02 and T-184/02, ECLI:EU:T:2004:79, point 81 (Mundicor).

42. The trademarks are visually similar.

*Phonetical comparison*

43. As regards the phonetic comparison, it should be borne in mind that, strictly speaking, the phonetic reproduction of a complex sign consists of the reproduction of all its verbal elements, irrespective of their graphic specificities, which are more a matter for the visual analysis of the sign.<sup>12</sup>

44. The pronunciation of the signs coincides in the sound of the letters "FAKHER" in the invoked trademark and the dominant element "FAHKER" in the contested trademark, which will produce an identical sound considering that the letter "H" is silent when spoken.

45. The trademarks are phonetically similar.

*Conceptual comparison*

46. The Office recalls that the public will not consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression produced by the mark.<sup>13</sup>

47. Regarding the English word "GOLD" in the contested trademark, it refers to a colour and the Office considers that it is commonly used to indicate superior quality.<sup>14</sup>

48. The respective dominant elements "AL FAKHER" and "FAHKER" have no meaning in one of the relevant languages in the Benelux territory.

*Conclusion*

49. The marks are visually and phonetically similar. A conceptual comparison cannot be carried out.

**A.2 Global assessment**

50. The global assessment must be made by reference to the average consumer, who is well-informed and reasonably observant and circumspect about the goods or services in question. However, account must be taken of the fact that the average consumer rarely has the opportunity to make a direct comparison between the different trademarks but relies on the imperfect impression left upon him. It must also be borne in mind that the average consumer's level of attention may vary depending on the type of goods or services at issue.<sup>15</sup> In the present case, the goods covered are aimed at the public at large for which the level of attention is deemed to be normal.

51. The greater the degree of distinctiveness of the earlier trademark, the greater the likelihood of confusion. Trademarks with a highly distinctive character, either by their nature or because of their reputation on the market, enjoy greater protection than trademarks with a weak distinctive character.<sup>16</sup> The invoked earlier trademark considered in its entirety has a normal distinctiveness for the goods concerned, as it does not describe characteristics of these goods.

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<sup>12</sup> General Court (EU) 25 May 2005, T-352/02, ECLI:EU:T:2005:176, point 42 (PC Works) ; and 21 April 2010, T-361/08, ECLI:EU:T:2010:152, point 58 (Thai Silk).

<sup>13</sup> General Court (EU) 3 July 2003, T-129/01, ECLI:EU:T:2003:184, point 53 (Budmen).

<sup>14</sup> General Court (EU) 21 September 2012, T-278/10, EU:T:2012:459, point 62 (Western Gold).

<sup>15</sup> CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

<sup>16</sup> CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).



52. The global assessment of the likelihood of confusion presupposes a certain coherence between the factors to be considered and between the similarity of the conflicting signs and the goods or services to which they relate. Thus, a low degree of similarity between the goods or services in question may be offset by a high degree of similarity between the signs, and vice versa.<sup>17</sup>

53. The trademarks are visually and phonetically similar in their dominant elements. A conceptual comparison is not possible. The relevant goods are identical or at least highly similar. Based on the above grounds, and given their interdependence, the Office finds that the relevant public might believe that the goods originate from the same undertaking or from economically linked undertakings.

#### **B. Other factors**

54. The fact that a trademark has passed the examination and registration stages and therefore the opposition period (see point 21), does not mean that it cannot be contested. According to Article 2.30bis (1)(b) BCIP, the owner of an earlier trademark can object to a later trademark that conflicts with its own, after it has been registered.

#### **C. Conclusion**

55. Based on the abovementioned factors and considerations, the Office finds that there exists a likelihood of confusion.

#### **IV. DECISION**

56. The application for a declaration of invalidity is upheld.

57. Benelux registration 1432912 is cancelled.

58. The defendant shall pay the claimant 1,420 euros in accordance with Article 2.30ter (5) BCIP in conjunction with rule 1.44 (2) IR, as the cancellation application is upheld in its entirety. This decision constitutes an enforceable order pursuant to Article 2.30ter (5) BCIP.

The Hague, 20 July 2023



Flavie Rougier  
(*rapporteur*)

Tineke Van Hoey

Pieter Veeze

Administrative officer: Vincent Munier

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<sup>17</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 (Equivalenza) and the case-law mentioned there.