

O-381-14

TRADE MARKS ACT 1994

IN THE MATTER OF CONSOLIDATED OPPOSITIONS  
UNDER NOS 401026 AND 401027 BY AKBAR ALI MALIK

AGAINST

APPLICATION NOS 2656848 FOR THE MARK



AND 2658271 FOR THE MARK

MALIK CHAMBERS

IN THE NAME OF SHAHZAD IMRAN MALIK

## Background

1. Application Nos 2656848 and 2658271 are for the trade marks shown on the front cover of this decision and have filing dates of 19 March 2013 and 28 March 2013 respectively. They stand in the name of Shahzad Imran Malik (“the applicant”) and seek registration for the following specification of services:

Class 45

Legal services; legal advice and assistance; legal research services; mediation [legal services]; information, advice and consultancy in relation to all the aforesaid services; all the aforesaid services relating to immigration law.

2. Following publication in the *Trade Marks Journal* 2013/028 on 12 July 2013, notices of opposition were filed by Akbar Ali Malik (“the opponent”). In both cases, the opposition is based on a single ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following trade mark:

Trade Mark	Dates	Specification of services
2592698 MALIK LAW	Filing date: 26 August 2011  Date of entry in register: 9 December 2011	Class 45: Legal services

3. Both parties filed evidence and written submissions but neither requested to be heard. I therefore give this decision after a careful review of all the papers before me.

## The evidence

4. This consists of witness statements from Mr Mitchell Willmott an employee of National Business Register LLP, acting as agent for the opponent and another from the applicant himself. Given the content of this evidence, all of which dates from after the relevant date in these proceedings, I do not intend to summarise it here but will refer to it, as necessary, later in this decision.

## Decision

5. The opposition is brought under section 5(2)(b) of the Act which states:

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

(a) ....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

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

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

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

7. In these proceedings, the opponent is relying on the trade mark as set out in paragraph 2 above. It is an earlier mark under the above provisions. Given the interplay between the publication date of the applied for marks and the date of entry in the register of the earlier mark, the earlier mark is not subject to the proof of use provisions set out in section 6A of the Act as it had not been registered for the requisite five year period. The opponent is entitled, therefore, to rely on it for all of the services for which it is registered.

8. The test for determining whether there is a likelihood of confusion is well established. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs Q.C., expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

### **The CJEU cases**

*Sabel BV v Puma AG* [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) C-334/05 P.

### **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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

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

## Comparison of services

10. Before I go on to compare the respective services, I note that in the counterstatements, the applicant comments that he seeks registration for only a limited range of services whereas the opponent has legal services at large. In his submissions, he states that the registrar “has every right to assess the Opponents earlier trade mark for its limited specification and the services the Opponent actually provide”. I am not entirely certain what he means by this but in any event I am mindful of the findings of the Court of First Instance (now General Court) in *Saint-Gobain SA v OHIM* Case T-364/05 where it said:

“67... it is important to reiterate that the comparison between the goods in question is to be made on the basis of the description of the goods set out in the registration of the earlier mark. That description in no way limits the methods by which the goods covered by the earlier mark are likely to be marketed.”

11. Whilst, in the above case, the court made its findings in relation to ‘goods’, the same is true of ‘services’. I also bear in mind the findings of the same court in the case of *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-414/05:

“71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant’s goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the respective importance to be given to visual, phonetic or conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, namely that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark proprietors-whether carried out or not- which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59).”

12. It is clear from these cases that regardless of the way the parties have conducted their businesses in the past, or may intend to in the future, the services I have to compare are those as registered and applied for. As I indicated earlier, the opponent is entitled to rely on its earlier mark for all services for which it is registered. For ease of reference, the services to be compared are as follows:

Opponent's services	Applicant's services
Legal services	Legal services; legal advice and assistance; legal research services; mediation [legal services]; information, advice and consultancy in relation to all the aforesaid services; all the aforesaid services relating to immigration law.

13. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05*, the General Court considered the matter of identical goods and said:

“...goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application...”

By analogy, the same is true in respect of services. All of the applicant's services are included within the term *legal services* which forms the opponent's specification and are therefore identical services within the principles laid down in *Meric*.


#### **Average consumer and the nature of the purchasing process**

14. As the above case law indicates, it is necessary for me to determine who the average consumer is for the respective parties' services and then to determine the manner in which these services are likely to be selected by the average consumer in the course of trade.

15. Legal services are provided by specialists, often regulated depending on the type of service being provided. The average consumer is a member of the general public, albeit those services relating to immigration law are most likely to be used by a member of the general public who either is an immigrant or is supporting an immigrant. Although widely available, the average consumer is likely to use such services relatively infrequently. This may require him to provide e.g. highly personal information which, coupled with the fact such services may involve regulation and significant input and charges, leads me to find that the average consumer is likely to take at least a reasonable degree of care in choosing a provider. Given that many legal matters involve a significant amount of paperwork, the visual aspects of the purchase are likely to dominate the purchasing process, however, not to the extent that the other aspects can be ignored.

## Comparison of marks

16. The marks to be compared are:

Opponent's mark	Applicant's marks
MALIK LAW	MALIK CHAMBERS (2658271)
	 <p>MALIK CHAMBERS (2656848)</p>

17. The opponent's mark consists of the two words MALIK and LAW. I consider MALIK would be known and recognised as a surname. It is, in my view, the dominant element of the mark as whilst the word LAW is also a surname, in the context of the services for which it is registered, it is most likely to be seen as a reference to the nature of those services and thus not distinctive of them.

18. The applicant's mark 2658271 also consists of two words, the surname MALIK and the word CHAMBERS. Again, the word CHAMBERS is also a surname but, in addition, has a meaning within the legal profession as either "a judge's room for hearing private cases not taken in open court or the set of rooms occupied by barristers where clients are interviewed") see Collins English Dictionary 3<sup>rd</sup> Ed . Again, I consider it is the word MALIK which is the dominant and distinctive element of the mark.

19. On a visual and aural consideration, both this mark and the opponent's earlier mark consist of two words the first of which is the surname MALIK. To this extent there is a degree of similarity between them. The second word of each mark differs and to this extent there is a degree of dissimilarity between them. Taken as wholes, the marks are visually and aurally similar to a reasonable degree. From a conceptual consideration, the first words of each mark will be seen as a surname. For some average consumers, it is possible that the second word in each mark will also be seen as a surname though I consider it more likely in each case that it will be recognised as referring to legal services per se (LAW) or to refer to rooms used by legal professionals (CHAMBERS). For those who recognise the legal connection of the word CHAMBERS, there is likely to be a greater degree of conceptual similarity with the opponent's mark. For those who do not and simply see the applicant's mark as a combination of two surnames, there will be a slightly lesser degree of conceptual similarity but still one of a reasonable degree.

20. The applicant's mark no 2656848 is a composite one comprising of a symmetrical combination of stars, leaves and what I take to be birds on the wing along with the letters MLA. At the bottom of the device, the words MALIK CHAMBERS in smaller font are present. The combination of stars, leaves and birds acts as something of a frame to the letters MLA. I am not aware, nor has any evidence or submission been provided, which gives any indication that the letters MLA are a known abbreviation or have any particular meaning in the context of the services and I consider them a distinctive element of the mark and, given their size and position, the dominant element of it, though given the letters do not make up a recognised word have no obvious meaning, the words MALIK CHAMBERS will be noticed and referred to.

21. The similarity between this mark and the opponent's earlier mark, from the visual perspective, rests in the presence in both of the MALIK which makes them similar to a relatively low degree. Aurally, the position is somewhat closer and leads to similarity of a reasonable degree. For the reasons given above, the presence of the words MALIK in both coupled with the words LAW or CHAMBERS leads to at least a reasonable degree of conceptual similarity.

#### **Distinctiveness of the earlier mark**

22. I must also assess the distinctive character of the earlier mark which can be appraised only, first, by reference to the services for which it is registered and, secondly, by reference to the way it is perceived by the relevant public –*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings –*Windsurfing Cheimsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

23. The opponent has not filed any evidence of use of his earlier mark. That being the case, I have only its inherent distinctiveness to consider. Both parties agree that MALIK is a surname/cast name, however, whilst the applicant says it is a common one, the opponent submits:

“...it is not the correct to simply assess the commonality of a surname to whether the surname is capable to function as a trade mark to denote origin of the services. The test is whether the surname is so commonly used in relation to the goods/services in question that consumers are unlikely to associate that surname with the goods/services provided by one undertaking.”

24. I am also referred to the cases of *Nichols Trade Mark* [2005] RPC 12 and *Oska's Trade Mark Application* BL O/317/04 regarding the distinctiveness of surnames. In the former case the court stated:

“...stricter general criteria of assessment based, for example, on:



- ...

-the number of undertakings providing products or services of the type covered by the application for registration or

-the prevalence or otherwise of the use of surnames in the relevant trade, cannot be applied to such marks”.

In the latter case the court stated:

“commonness of the surname is a factor that may be taken into account as part of a specific assessment of the distinctive character of the surname in relation to the goods or services in question, particularly where the field in question is one where the use of surnames to designate origin is prevalent.”

25. Both of these cases refer to distinctiveness in relation to the consideration under section 3 of the Act as to whether a mark meets the criteria for registration. The earlier mark is a registered mark and, in accordance with the findings of the CJEU in Case C-196/11 P, *Formula One Licensing BV v OHIM, Global Sports Media Ltd*, must be possessed of a degree of inherent distinctive character. Mr Willmott’s evidence exhibited at MW1, which consists of a printout taken from the *Marquesa* trade mark search system is intended to show the number of trade marks containing the string of letters: “MALIK-“ in Classes 42 and 45 for Reserved Words, pending, registered and lapsed trade marks at the UK IPO, OHIM and for international trade marks designating the United Kingdom or European Community”. The search was carried out on 19 February 2014 which, as I indicated above, is after the relevant date and as has been said in many previous decisions, such *state of the register* evidence does not assist in showing what the position might be in the marketplace. Exhibit MW2 is the result of a search said to have been conducted of the Law Society’s database of legal professionals intended to show how uncommon the surname is among law firms and legal professionals. Again, this material dates from after the relevant date. Whilst it might be useful in shedding light on what the position might have been at an earlier date, I note that page 22 of the exhibit indicates that “This is a test version of our new Find a Solicitor website” and it is in beta version “which means we are still finding and fixing problems” so appears only to relate to one part of the legal profession and may or may not be an accurate reflection of the position even within that part of it. That said, I have no evidence which shows the name is one in common use within the relevant field and I consider the earlier mark has an average degree of distinctive character.

### **Likelihood of confusion**

26. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. I also have to factor in the distinctive character of the earlier mark as the more distinctive it is the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade

marks and must instead rely on the imperfect picture of them he or she has retained in mind.

27. Earlier in this decision I found:

- the respective services are identical;
- the average consumer is a member of the general public, albeit one who is an immigrant or supporting an immigrant where those services are related to immigration law. The average consumer will take a reasonable degree of care in purchasing the services;
- in respect of application no 2658271, I found the respective marks to have a reasonable degree of visual and aural similarities and at least a reasonable degree of conceptual similarity. In respect of application no 2656848 I found the respective marks to be visually similar to a relatively low degree and to have a reasonable degree of aural and conceptual similarity;
- the opponent's earlier mark is of average distinctive character which has not been shown to have been enhanced through use.

28. Dealing first with application no 2658271, both marks consist of two words, share the first of those words and have a second word which is meaningful in the legal field and leads to conceptual similarities between them of at least a reasonable level. Identical services are also involved. Taking all matters into account, I find that there is a likelihood of direct confusion (where one mark will be mistaken for the other). In respect of 2656848, the differences between the respective marks are such that I do not consider there will be direct confusion, however, again taking all matters into account, I consider there will be indirect confusion (where the average consumer will assume the undertakings are economically linked) because of the presence of the words MALIK CHAMBERS. The opposition brought against both applications under section 5(2)(b) of the Act succeeds.

## **Summary**

29. The opposition succeeds in full against both applications.

## **Costs**

30. The opponent having succeeded is entitled to an award of costs in his favour. I note that his evidence consists of a single witness statement containing less than 20 lines of text, which would have taken very little time or effort to prepare. The exhibits provided were also brief and uncomplicated, consisting of prints taken from the internet and which did not go to the relevant date. I also note that the applicant's evidence was equally brief and would have taken very little time or effort to review. The decision has been reached from the papers and without a hearing. The proceedings were consolidated at any early stage.

31. I make the award on the following basis:

For filing a notice of opposition and reviewing the other side's defence:	£200 x 2
Fees:	£200 x 2
For filing evidence and reviewing the other side's evidence:	£200
For filing written submissions:	£200
<b>Total:</b>	<b>£1200</b>

32. With that in mind, I order Shahzad Imran Malik to pay Akbar Ali Malik to pay the sum of £1200. This sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 2nd day of September 2014**

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