

O-502-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3044577 BY
DR HAMMAD LODHI**

TO REGISTER:

BIMA

**AS A TRADE MARK
IN CLASSES 16, 35, 41, 42 & 44**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600000121 BY
YOUSOF OSKROCHI**

BACKGROUND

1. On 11 April 2014, Dr Hammad Lodhi (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application was published for opposition purposes on 2 May 2014, for the following goods and services:

Class 16 - Printed Matter.

Class 35 - Organising and conducting employment counselling and support.

Class 41 - Educational services, namely providing classes, courses, workshops, conferences, seminars in the medical field and the distribution of printed materials in connection therewith; providing education and training (including Continuing Professional Development training) to Muslim professionals and the wider medical community in the UK.

Class 42 - Research in the field of medicine, Islamic medical history and Islamic medical ethics.

Class 44 - Medical services; medical analysis for the diagnosis and treatment of people; consultancy services relating to health.

2. The application is opposed by Youssof Oskrochi (“the opponent”) under the fast track opposition procedure. The opposition, which is directed against all of the goods and services in the application, is based upon section 5(1) of the Trade Marks Act 1994 (“the Act”), for which the opponent relies upon all the services in the following trade mark registration:

UK no. 3017565 for the trade mark: **BIMA** which was applied for on 9 August 2013 and for which the registration process was completed on 22 November 2013:

Class 41 - Provision of correspondence courses; arranging and conducting of educational conferences and seminars relating to medicine, dentistry and allied healthcare; arranging and conducting of educational exhibitions relating to medical and dental matters; medical tuition services; continuing professional development courses and accreditation.

A review of the Intellectual Property Office’s (“IPO”) database indicates that Mr Oskrochi is the joint owner of the trade mark along with the British Iranian Medical Association.

3. In his Notice of opposition, the opponent states:

“Both organisations use similar sounding names and acronyms with respect to identifying their organisations. Both operate in the same field, targeting an overlapping cohort, the majority of Iranians are also muslims. We have already had substantial confusion from our member base with regards to the British Islamic Medical Association using the term BIMA, which we have been using for over 3 years now. This is not only at risk of causing confusion within

the targeted population, but also the general public who will be uncertain which organisation is being represented when “BIMA” is stated.”

4. The applicant filed a counterstatement in which the basis of the opposition is denied. Inter alia, he stated:

“Firstly, it is unclear exactly what the opponents’ grounds of opposition are. This is because in Question 11, he has ticked box 5(1) arguing that the applicants mark is identical with an earlier registered mark for identical goods or services. If you use this test, under Section 5(1) of the Trade Marks Act 1994, you would not need to show a likelihood of confusion. However, in Question 13, he has stated that both organisations use similar sounding names (so he has not said identical here) and has then stated that they have had substantial confusion from their member base. He has not ticked the other two boxes in Question 11, but has then spoken about them in Question 13. So, it is unclear whether he is using section 5(1), section 5(2) (a) or (b). The applicant thinks that the case is not correctly pleaded and will answer all grounds...”

5. In an official letter dated 16 September 2014 addressed to the opponent, the Tribunal stated:

“The applicant’s comments made in the counterstatement at section 8 of the form have been noted. As your notice of opposition only contained the ground of opposition under Section 5(1), which does not cover the issue of likelihood of confusion, the Hearing Officer when making a decision will not consider whether there is a likelihood of confusion between the marks.”

6. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

7. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (1) the Office requests it or (2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken. A hearing was neither requested nor considered necessary; neither party filed written submissions.

DECISION

9. The opposition is based solely upon section 5(1) of the Act, which reads as follows:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

10. 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.”

11. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As the opponent’s earlier trade mark had not been registered for more than five years when the application for registration was published, it is not subject to proof of use, as per section 6A of the Act. As a consequence, the opponent is entitled to rely upon all of the services for which his earlier trade mark is registered.

Comparison of trade marks

12. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

13. Although in his counterstatement the applicant argues that the competing trade marks are not identical, that conclusion is based upon a misunderstanding of the comparison I am required to carry out. It matters not how the respective parties use or propose to use their trade marks, what I must do is compare the trade mark applied for i.e. the word BIMA in upper case, with the trade mark the subject of the earlier registration i.e. also the word BIMA in upper case. The competing trade marks are clearly identical.

Comparison of goods and services

14. The competing goods and services are as follows:

Opponent's services	Applicant's goods and services
<p>Class 41 - Provision of correspondence courses; arranging and conducting of educational conferences and seminars relating to medicine, dentistry and allied healthcare; arranging and conducting of educational exhibitions relating to medical and dental matters; medical tuition services; continuing professional development courses and accreditation.</p>	<p>Class 16 - Printed Matter.</p> <p>Class 35 - Organising and conducting employment counselling and support.</p> <p>Class 41 - Educational services, namely providing classes, courses, workshops, conferences, seminars in the medical field and the distribution of printed materials in connection therewith; providing education and training (including Continuing Professional Development training) to Muslim professionals and the wider medical community in the UK.</p> <p>Class 42 - Research in the field of medicine, Islamic medical history and Islamic medical ethics.</p> <p>Class 44 - Medical services; medical analysis for the diagnosis and treatment of people; consultancy services relating to health.</p>

15. However, as the opponent has based his opposition solely upon section 5(1) of the Act i.e. which prohibits the registration of identical trade marks/for identical goods and or services, it is only the applicant's services in class 41 against which the opponent has any prospect of success. The use of the word "namely" in the applicant's specification in class 41 must be approached, as indicated in the Trade Mark Registry's classification guidance, on the following basis:

"Note that specifications including "namely" should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above "dairy products namely cheese and butter" would only be interpreted as meaning "cheese and butter" and not "dairy products" at large. This is consistent with the definitions provided in Collins English Dictionary which states "namely" to mean "that is to say" and the Cambridge International Dictionary of English which states "which is or are."

16. Considered on that basis, the comparison is between the following:

Opponent's services	Applicant's services in class 41
<p>Class 41 - Provision of correspondence courses; arranging and conducting of</p>	<p>Providing classes, courses, workshops, conferences, seminars in the medical</p>

educational conferences and seminars relating to medicine, dentistry and allied healthcare; arranging and conducting of educational exhibitions relating to medical and dental matters; medical tuition services; continuing professional development courses and accreditation.	field and the distribution of printed materials in connection therewith; providing education and training (including Continuing Professional Development training) to Muslim professionals and the wider medical community in the UK.
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17. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359,

paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

18. In my view, “providing classes, courses, workshops, conferences, seminars in the medical field and the distribution of printed materials in connection therewith” in the applicant’s specification would be encompassed by both “arranging and conducting of educational conferences and seminars relating to medicine, dentistry and allied healthcare” and “medical tuition services” in the opponent’s specification; the competing services are, as a consequence, identical on the *Meric* principle. As the remaining phrase in the applicant’s specification i.e. “providing education and training (including Continuing Professional Development training) to Muslim professionals and the wider medical community in the UK” includes education and training at large, it would, as a consequence, include, for example, “medical tuition services” and “continuing professional development courses and accreditation” in the opponent’s specification, and the competing services are, once again, identical on the principles outlined in *Meric*.

19. As the competing services in class 41 are identical and as I have already concluded that the competing trade marks are identical, **the requirements of section 5(1) of the Act are satisfied and the opposition to the application in class 41 succeeds accordingly.**

Overall conclusion

20. The opposition based upon section 5(1) of the Act succeeds in relation to class 41 of the application, and subject to any successful appeal, the application will be refused in class 41 and will proceed to registration in respect of classes 16, 35, 42 and 44.

Costs

21. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Although the opponent has been successful in relation to class 41 of the application, the applicant has succeeded in retaining 80% of the classes for which he originally applied. As a consequence, the applicant is entitled to a contribution towards his costs, albeit reduced on a “rough-and-ready basis” to reflect the measure of the opponent’s success; Using TPN 4/2007 as a guide, I award costs to the applicant on the following basis:

Preparing a statement and considering the opponent’s statement:	£160
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Total:	£160
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22. I order Youssof Oskrochi to pay to Dr Hammad Lodhi the sum of **£160**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 28th day of November 2014

C J BOWEN
For the Registrar
The Comptroller-General