

O-299-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 3088058
BY HASHIM MEHMOOD MALIK**

TO REGISTER THE TRADE MARK



IN CLASS 43

**AND OPPOSITION THERETO BY
AZHAR HUSSAIN UNDER NO 404281**

Background and pleadings

1) On 5 January 2015, Hashim Mehmood Malik (“the applicant”) applied to register the following trade mark (“the application”):



2) It was accepted and published in the Trade Marks Journal on 6 February 2015 in respect of the following services:

Class 43: Services for providing food & drink; restaurant, bar and catering services; all of the aforesaid services providing Halal food and drink.

3) On 5 May 2015, Azhar Hussain (“the opponent”) opposed the trade mark on the basis of Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In a letter dated 17 November 2015 the opponent subsequently withdrew its claims under section 5(3) and 5(4)(a) of the Act. Therefore, the opposition proceeds under section 5(2)(b) only. This ground is based on its two earlier UK trade mark registrations (“the earlier marks”). Pertinent details of the earlier marks are detailed below:

Mark	DAR-E-KHYBER
(series of two):	Dar-e-Khyber
Number:	2591081
Filing date:	11 August 2011
Publication date:	30 September 2011
Date of entry on register:	9 December 2011
Services:	Class 43: “Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for

restaurants and holiday accommodation; retirement home services; creche services”



Mark

(series of three:)

Number: 2550107

Filing date: 8 June 2010

Publication date: 9 July 2010

Date of entry

on register: 17 June 2010

Services: Class 43: “Services for providing food & drink; temporary accommodation, restaurant, bar and catering services; provision of holiday accommodation; retirement home services; creche services”

4) The opponent contends that its earlier marks are similar to the application to the extent that a likelihood of confusion exists. This is based on the prominent and distinctive part of the respective marks being KHYBER. It also claims that the word KHYBER is very distinctive for restaurant services “and the like”. The opponent argues that the class 43 services are identical to those covered by its earlier marks.

5) The applicant filed a counterstatement denying the claims made. Section 7 of the counterstatement is headed “Request for “proof of use”” and it asks the applicant “Do you want the opponent to provide “proof of use”?”. The applicant should either tick yes, no or list which of the earlier rights (if there are more than one) in the box provided. Whilst the applicant ticked “No”, it also listed the two earlier marks, which may have led the opponent to believe that the opponent was required to provide the necessary proof. However, since the application was published on 6 February 2015, and the earlier marks were registered on 17 September 2010¹ and 9 December

¹ No. 2550107

2011², i.e. less than five years prior to publication of the application, they are not subject to the proof of use requirements set out in s.6A of the Act. This means that the opponent was not required, even if it had been expressly requested, to provide evidence. Accordingly, it may assert that there is a likelihood of confusion based on its notional use of its earlier marks for the services covered by the registrations.

6) Only the applicant filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary.

7) Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful consideration of the papers.

Applicant's evidence

Witness statement of Hashim M Malik and exhibits HM1 to HM18

8) Mr Malik has been the owner and a director of Al Hashim Khayber Restaurant since 1 September 2015. The witness statement largely consists of submissions, which I shall refer to where necessary. The only "facts" which may be drawn from the witness statement are as follows:

- The Khyber Pass gate was made by the British ruler in 1925 to connect a railway line into the Khyber Pakhtunkhwa, a province of Pakistan. It passes between Afghanistan and Pakistan.
- It is approximately 33 miles long.
- It is also referred to as Khaibar Pass or Khaybar Pass.

9) The witness statement also refers to numerous existing UK trade mark applications and registrations which either include the words KHYBER, KYBER or devices of a bridge. The comparison I must make is between the application and the earlier mark for the services which it is registered for. The existence of other trade

² No. 2591081

marks on the register is not relevant to the judgment I must make. See the judgments of the Court of Justice of the European Union (“CJEU”) in *Henkel KGaA v Deutsches Patent- und Markenamt*, Case C-218/01 and the General Court (“GC”) in *Zero Industry Srl v OHIM*, Case T-400/06.

10) A further submission made by the applicant is the how the registry refers to the applied for mark. Mr Malik states:

“the record of registered trade mark of the registry office clearly shows the spellings of the mark KYBER PASS, NEW KYBER PASS, and KYBER PASS ORIGINAL not KHYBER PASS vides registration uk00002550107. Claim for the word KHYBER is baseless and meaningless; record of registered trade mark of the registry office is not deniable. The registry office recorded the KYBER PASS in the list with spelling KYBER if someone put the word KHYBER the result does not show the word KYBER.”

11) The way the data capture teams within the UK Trade Marks Registry categorise the trade mark application is not reflective as to how the average consumer would perceive the mark. I must consider how the mark would be viewed by consumers rather than the data capture. A similar argument was put forward to the GC in *Omnicare, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-289/09 and rejected. In view of this, I reject this line of argument.

Legislation and case law principles

12) Sections 5(2)(b) of the Act is 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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

13) 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 services

14) In my view the opponent's best case rests in its earlier number 2550107 (stylised KHYBER PASS plus device). I shall focus the opponent's case on this earlier trade mark and should I conclude that there is no likelihood of confusion it must follow that it is in no better position by relying upon the other earlier mark (no. 2591081). The respective services are as follows:

Application	Earlier mark no. 2550107
Class 43: Services for providing food & drink; restaurant, bar and catering services; all of the aforesaid	Class 43: Services for providing food & drink; temporary accommodation, restaurant, bar and catering services; provision of holiday accommodation; retirement home services;

services providing Halal food and drink	creche services
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15) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated at paragraph 29 that:

“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”.

16) It is clear that the applied for services are identical to those covered by the earlier ‘107 mark. Whilst the application is limited to the provision of Halal food and drink, this is irrelevant to my assessment of whether the respective services are identical or similar since the services of the earlier mark will nevertheless cover Halal food and drink. Therefore, applying the principle set out in *Merici* the respective services are identical.

Comparison of marks



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

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

that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

18) 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 marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

19) The respective trade marks are shown below:

Application	Earlier mark (2550107)
 <p>The logo for AL-HASHIM KHYBER RESTAURANT features the name 'AL-HASHIM' in a small red font above 'KHYBER RESTAURANT' in a large, bold red font. Below this, the text 'Special Traditional Peshawari Food' is written in a smaller blue font. To the left of the main text is a red icon of a bridge or gate. At the bottom left, the text 'WE DO CATERING' is written in a very small font. There is also a small Urdu character 'ہال' to the right of 'AL-HASHIM'.</p>	 <p>Three variations of the 'KHYBER PASS' logo are shown. Each features the words 'KHYBER PASS' in a bold, green, sans-serif font. The first variation has a green leaf-like graphic above the 'Y'. The second variation has a green leaf-like graphic above the 'Y' and a small 'ORIGINAL' tag to the right. The third variation has a green leaf-like graphic above the 'Y' and the word 'NEW' in a small font to the left.</p>

20) The application consists of a number of elements. At the top of the mark is the name AL-HASHIM. Below the name, in larger font, are the words KHYBER RESTAURANT, then underneath this in smaller font are the descriptive words “Special Traditional Peshawari Food”. To the left of KHYBER RESTAURANT is a device which appears to be either a bridge or gate with the strapline, in very small font, WE DO CATERING. Due to the relative size and position within the mark, I consider the word KHYBER to be the dominant and distinctive element of the application. To consumers who are familiar with the Khyber Pass they would see the device as reinforcing the word KHYBER.

21) Since the name AL-HASHIM is not descriptive of the services in question it does contribute to the overall impression of the mark. However, it is likely to be viewed as the name of the proprietor of the “KHYBER RESTAURANT”. Therefore, I consider the name to be less dominant and distinctive within the mark as a whole. Since the remaining words in the mark are either descriptive or promotional they have a negligible contribution towards the distinctive character of the mark.

22) With regard to the earlier mark this consists of the words KHYBER PASS, a device and other decorative elements. The letter H in the application has been replaced with the device of a gate or bridge which is shaped the same as a capital H. Accordingly consumers would view the device as being a fanciful substitution for the letter H. I find that the overall impression of the earlier mark being KHYBER PASS, with the device reinforcing this message. I consider the remaining decorative elements to be negligible.

23) Visually, both marks contain the word KHYBER and the device of a gate. The applicant argues:

“The building device used in the applied for trade mark has absolute different appearance, it is different in shape, color, size, from top, from bottom furthermore it’s separate image at the extreme left side of trademark having a unique identity. Whereas the opponent building device it totally different in appearance, different in shape, it has green color and applicant’s device is red color.”

24) The opponent claims that:

“The various finer visual differences between these two building devices highlighted by the Applicant are not sufficient to diffuse this obvious visual and conceptual commonality between these particular aspects of the signs.”

25) Each of the gates (or buildings) comprise two large pillars which are connected together by a bridge. Taking a microscopic view of the marks may lead to there being some visual differences, though each are essentially the same in size and shape and are very similar. Whilst the application does contain additional words, and the earlier mark some further decorative matter, I find that the marks are visually similar to a moderate degree.

26) From a conceptual perspective, the applicant argues that:

“The word **KHYBER** is absolutely different from the word **KYBER** which has no meaning in Urdu or any other language, it is self created to avoid the opposition”.

27) As previously stated, given the shape and proximity of the device it would be viewed as H. Therefore, I do not accept the applicant’s argument. Moreover, whether somebody is familiar or not with KHYBER they are unlikely to be aware of its exact spelling.

28) Whilst I do not believe that all consumers would know what or where Khyber or the Khyber Pass is but it would be sufficiently recognised to create a conceptual hook in a consumer’s mind. Some consumers, who are less familiar with Khyber, may remember the application under the name Al-Hashim though I believe this is less likely. Therefore, the degree of conceptual similarity for the group of consumers that would remember Khyber (which I consider to be in the majority) would be highly similar. With regard to the group of consumers who would primarily remember the mark by the name (the minority group) they would still absorb Khyber to the extent that there will still be a moderate degree of conceptual similarity.

29) Aurally, the applicant argues that: “The word **kyber** pronounced in Urdu (key-ber) and **KHYBER** pronounced as (khay-bar)”, whereas the opponent claims that “The presence or not of an “h” has no bearing phonetically as both KYBER and KHYBER would be pronounced the same way.” I have already stated that I consider the shape of the device would be viewed as an H to consumers so the marks would be verbalised in the same manner. Notwithstanding this, I agree with the opponent that the presence of the letter H would not affect pronunciation. Whilst some consumers may pronounce the name Al-Hashim (whom I consider to be in the minority), given that I consider the more prominent element of the application to be KHYBER, this is more likely to be verbalised by the majority of consumers. Therefore, I find that the application would be verbalised as either Khyber or Khyber Restaurant and the earlier mark as Khyber Pass. On this basis, I consider there to be a medium degree of aural similarity.

Average consumer and the purchasing act

30) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose 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 or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

31) 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 at paragraph 60 in these terms:

“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.”

32) In essence, the services in question are the provision of food and drink. These are broad services which would be used by the general public and businesses, albeit on a less frequent basis. The cost of the services will vary from top-end restaurants to inexpensive fast food outlets. Nevertheless, all of the services will involve a medium degree of care and attention paid when deciding whether to use the services. The relevant marks are likely to be encountered visually on signage, on the internet, in advertisements and brochures, food reviews, etc., but word-of-mouth recommendations and telephone ordering will also play a part. Therefore, the services would be sought following a visual inspection but I shall also take into account aural references.

Distinctive character of the earlier mark

33) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

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

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).”

34) The opponent has not filed any evidence, nor has it made any claim to an enhanced degree of distinctive character. Therefore, I only have the inherent distinctive character to consider.

35) The earlier mark consists of the words KHYBER PASS and two devices, one being the device of a gate which would also be seen as the letter H. Above the words KHYBER PASS is a decorative border which does not add any notable degree of distinctiveness to the mark as whole. The H in KHYBER has been replaced with the device of a gate, which does contribute to the distinctive character of the mark.

36) Overall, I consider the earlier mark to have a medium degree of inherent distinctive character.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

37) It has been argued by the applicant that, KHYBER (the full name being KHYBER PAKHTUNKHWA) is a province of Pakistan and that “it does not belong to any individual, it’s a national heritage of Pakistanis and every Pakistani has the same privilege to use this image. There are many restaurants and other organisations are registered in the UK with this word KHYBER and image.” There is no restriction on registering a place name, region, country, etc. per se unless it is reasonable to believe that the sign would be recognised by the relevant class of persons as a description of one of the characteristics or devoid of distinctive character for the goods or services in question. No evidence or argument has been put forward to suggest that KHYBER has any connection with the applied for services and I do not see any merit in this line of argument.

38) A further argument put forward by the applicant is that there are many restaurants and other organisations that are registered and incorporate the word KHYBER. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated at paragraph 80 that:

“.....the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has

been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

39) In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”

40) In view of the above, the existence of any other use of the word KHYBER by restaurants cannot be taken into consideration.

41) The applicant also makes reference to the earlier trade mark registration no. 2459482 for the mark KHYBER PASS. This registration is not owned by the applicant or any party to these proceedings. The existence of other marks (regardless of who they belong to) which contain “KHYBER PASS” has no bearing on these proceedings and it cannot be taken into consideration when assessing whether there is a likelihood of confusion between the respective marks³.

42) Having addressed the numerous issues raised by the applicant, I shall now set out what I should take into account when deciding whether there is a likelihood of confusion. It is not scientific process, it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). I must also keep in mind the distinctive character of the opponent's mark as the more distinctive these marks are, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services and the nature of the purchasing process.

³ Paragraph 65 of *Henkel KGaA v Deutsches Patent-und Markenamt*, Case C-218/01, the Court of Justice of the European Union and paragraph 73 of *Zero Industry Srl v OHIM*, Case T-400/06, the General Court

43) I summarise my key findings as follows:

- The respective services are identical.
- The average consumer of the services are the general public who are likely to purchase the services following a visual perusal, though I do not discount aural considerations.
- The earlier mark does not have an enhanced degree of distinctive character by virtue of the use made of the mark. Inherently I consider the earlier mark to have a medium degree of distinctive character.
- The marks are visually similar to a moderate degree. They are aurally similar to a medium degree and conceptually similar to a high degree.

44) The applicant has argued that there are visual differences between the respective gates. Whilst I accept that the marks are visually similar to a moderate degree, I bear in mind that consumers do not have the benefit of viewing the marks side by side and must instead rely upon imperfect recollection. I do consider that consumers will remember “KHYBER” and this will act as a conceptual hook in consumer’s minds which when faced with another “KHYBER” mark is likely to lead them into believing the services derive from the same undertaking.

45) The applicant also states that since the earlier mark does not contain the words “SPECIAL TRADITIONAL PESHAWARI FOOD” and “WE DO CATERING” the opposition is irrelevant. As stated above, the likelihood of confusion and the comparison of the respective marks must be in reference to the elements of the marks which I consider to be dominant and distinctive. I consider the aforementioned words to be descriptive and promotional and whilst they have been taken into consideration, they do not alter my view that overall the marks are sufficiently similar to the extent that there is a likelihood of confusion. This view is supported by the services being identical, which does offset any lesser degree of similarity between the marks.

46) For the avoidance of doubt, for those consumers who may remember the application by the name AL-HASHIM rather than KHYBER, I still find that this sufficient conceptual similarity for there to a likelihood of confusion.

47) In view of the above I find that there is a likelihood of direct confusion between the application and the opponent's earlier 2550107.

OUTCOME

48) The opposition under section 5(2)(b) of the Act succeeds. Subject to appeal, the application shall be refused in its entirety.

COSTS

49) The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £600 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Opposition official fee	£100 ⁴
Preparing a statement and considering the other side's statement	£300
Preparing submissions and considering the other side's evidence	£200
TOTAL	£600

50) I therefore order Hashim Mehmood Malik to pay Azhar Hussain the sum of £600. The above sum should be paid within fourteen days of the expiry of the appeal

⁴ I have reduced the official fee from £200 to £100 since the opponent dropped the section 5(3) and 5(4)(a) claims prior to the decision being issued. If it had opposed the application on the basis of 5(2)(b) only then the fee would have been £100 and this is what I consider to be a fair amount to award.

period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of June 2016

MARK KING

For the Registrar