

**TRADE MARKS ACT 1994  
IN THE MATTER OF AN APPLICATION NO 2372472  
BY MUHAMMAD MATLUB BINSADIQ HUSAYN-ALI-KHAN  
TO REGISTER A TRADE MARK IN CLASSES 9, 35, 38, 41, 42, 43, 45.**

**Decision and Grounds of Decision**

**Background**

1. On the 25<sup>th</sup> August 2004 Mr Muhammad Matlub Binsadiq Husayn-Ali-Khan of 34 Firshill Road, Burngreave, Sheffield, S4 7BB, applied to register the trade mark MERIDIAN COMMUNICATIONS AND PROMOTIONS (and Device) for:

**Class 09**

Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs.

**Class 35**

Advertising; business management; business administration; office functions, includes: the organisation, operation and production of television and radio advertisements; accountancy; auctioneering, trade fairs; opinion polling; data processing; provision of business information; certain specific services provided by retailers.

**Class 38**

Telecommunications, includes: all communication services; (e.g. e-mail services and those provided by Internet); providing user access to the Internet (service providers); operating search engines.

**Class 41**

Education; providing of training; entertainment; sporting and cultural activities, includes: electronic games services provided by means of the Internet; the provision of on-line electronic publications and digital music (not downloadable from the Internet).

**Class 42**

Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services, includes: computer consultancy services.

**Class 43**

Services for providing food and drink; temporary accommodation, includes: restaurant, bar and catering services; provision of holiday accommodation; (no alcohol), booking and reservation services for restaurants and holiday accommodation.

**Class 45**

Security services for the protection of property and individuals; a limited range of personal services not covered in the other service class, includes: dating services; funeral services and undertaking services; fire-fighting services, detective agency services.

2. The mark was applied for as shown below:



3. In the examination report of the 10<sup>th</sup> November 2004 an objection was taken against the application in classes 09, 35, 38, 41 and 42, under Section 5(2) of the Trade Marks Act, in respect of registered trade mark numbers 1230213, 1538216, pending application 2277411 and pending Community Trade Marks E3371036, E2333912, E3139318. The marks 2277411 and E3371036 have since proceeded to registration. However, E2333912 and E3139318 have since been withdrawn.

4. The applicant's letter (undated) sent by facsimile on 21<sup>st</sup> April 2005 proposed amendments to the specification in order to overcome the objection under Section 5(2). In response, the official letter of 13<sup>th</sup> June 2005 confirmed that the specification amendments had successfully overcome the objection against classes 35 and 42 which were waived on the basis of the following limited specification:

Class 35 – “Public relations services; opinion polling; auctioneering and organisation of trade fairs”

Class 42 – “Industrial research and analysis services; legal services”

The objection against classes 09, 38 and 41 were, however, maintained.

The citations remaining against the mark are therefore as follows:

**1230213** for the mark **MERIDIAN** (cited against classes 09 and 38)  
Proprietor, Nortel Networks Limited of 2351 Boulevard Alfred-Nobel, St. Laurent,  
Quebec, Canada, H4S 2A9.

Class 09: Telecommunications apparatus and instruments; computers; electronic data input and output apparatus for use with computers; electronic apparatus and instruments, all for the storage, handling, transmission and display of data; electrical switching apparatus; modems; parts and fittings included in Class 9 for all the aforesaid goods; but not including radio apparatus or goods of the same description as radio apparatus.

**1538216** for the mark **MERIDIAN** (cited against classes 09, 38 and 41)  
Proprietor, Meridian Broadcasting Limited of 48 Leicester Square, London, WC2H 7LY.

Class 09: Video tapes.

Class 16: Printed matter; printed publications; books; magazines; diaries; stickers; pens; stationery; cardboard and cardboard articles; paper.

Class 38: Broadcasting and transmission of television programmes; information and advisory services relating to the aforementioned services.

Class 41: Entertainment and education services by means of television; presentation, production, syndication and networking of television entertainment, news, education and current affairs programmes; production, promotion, organisation, management and sponsorship of television programmes, shows, competitions, conferences, concerts, theatrical performances or sporting events; employment training; provision and rental of television studios, studios and broadcasting facilities; information and advisory services relating to the aforementioned services.

**(OHIM) 3371036** for the mark **MERIDIAN** (cited against class 09)

Proprietor, Ametek, Inc. of 37 North Valley Road, Building 4 P.O. Box 1764, Paoli, PA United States 19301-0801.

Class 09: Power quality analyzers; electronic instrumentation for monitoring, analyzing, and recording power measurements, including current, voltage, frequency, power, energy, harmonics, transients, and impulses; computer software for use in monitoring, analyzing, and recording power measurements.

5. No further arguments were submitted by the Applicant. A Notice of Partial Refusal was issued on 13 October 2005 against classes 09, 38 and 41.

6. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of this decision and the materials used in arriving at it.

7. No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

## **DECISION**

### **The Law**

8. Section 5(2) of the Act reads as follows:

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of Association with the earlier trade mark.”

9. An earlier trade mark is defined in Section 6(1) which states:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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,”

10. In reaching a decision I take into account the well established guidance provided by the European Court of Justice (ECJ) in: *Sabel BV v. Puma AG* [1998] R.P.C 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723.

It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse it’s various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(h) further, 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; *Marca Mode CV v. Adidas AG + Adidas Benelux BV*, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

11. In essence, the test under Section 5(2) is whether there are similarities in trade marks and goods/services which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the trade marks, evaluating the

importance to be attached to those different elements and taking into account the degree of similarity in the goods.

### **Distinctive character of the earlier trade marks**

12. It is clear from the ECJ's judgment in the case of *Sabel BV v Puma AG* that the likelihood of confusion may be increased where the earlier trade marks have a highly distinctive character.

13. The earlier trade mark numbers 1230213, 1538216 and Community Trade Mark 3371036 are registered trade marks and are therefore deemed to be valid (Section 72 of the Act refers). All three earlier marks consist of the word MERIDIAN, which is a word with its own distinct meaning in the English language. The Collins English Dictionary (5<sup>th</sup> Edition first published 2000) defines the word as denoting 1a) "one of the imaginary lines joining the north and south poles at right angles to the equator, designated by degrees of longitude from 0 at Greenwich to 180". b) "the great circle running through both poles" 2) "Astronomy; a) the great circle on the celestial sphere passing through the north and south celestial poles and the zenith and nadir of the observer. b; (as modifier). e.g. a meridian instrument. 3)(Also called) meridian section; (Maths) a section of a surface of revolution, such as a paraboloid, that contains the axis of revolution. 4) the peak; zenith. E.g. the meridian of his achievements. 5) (in acupuncture, etc) any of the channels through which vital energy is believed to circulate round the body. 6) Obsolete; noon. 7) along or relating to a meridian. 8) of or happening at noon. 9) relating to the peak of something. [C14: from Latin meridianus of midday, from] meridius midday, from medius; midl + dies day. The meaning of the term MERIDIAN is therefore considered distinctive for all the goods and services detailed in relation to the marks.

### **Similarity of the goods and services**

14. I have considered the similarity of the goods and services contained within the applicant's specification with the goods and services contained within the specification of the earlier trade marks as follows:

Class 09: Mark number 1230213 specifies... "Electronic apparatus and instruments, all for the storage, handling, transmission and display of data" and 1538216 specifies "video tapes." In the case of these earlier marks, I consider there to be a close similarity between the goods at issue as the applicant's specification "Apparatus for recording, transmission of reproduction of sound or images; magnetic data carriers." A third citation, number 3371036, was also cited against the applicant's mark in class 9. Having reviewed the respective specifications I do not consider there to be a similarity between the goods specified in the two marks.

Class 38: Earlier marks 1230213 and 1538216 are cited against this class. The specification of mark 1230213 contains "Telecommunication apparatus and instruments" and I consider this to be closely similar to the applicant's specification covering telecommunication services at large. The specification of 1538216 contains "Broadcasting and transmission of television programmes;" and I consider this to be

identical to the applicant's specification of "Telecommunications, includes: all communication services;"

Class 41: Mark number 1538216 is cited against this class and includes in its specification the provision of "Entertainment and education services." The applicant's specification contains "Education, providing of training; entertainment; sporting and cultural activities,..." which I consider identical to those contained within the Class 41 specification of earlier cited mark.

### **Similarity of the marks**

15. Since the trade mark of this application is not identical to the earlier trade marks the matter falls to be decided under sub-section (b) of Section 5(2) of the Act. The question, therefore, is whether the mark of this application is so similar to the earlier trade marks that there exists a likelihood of confusion which includes the likelihood of association on the part of the public.

16. The similarity of the marks must be assessed by reference to the visual, aural and conceptual similarities of the trade marks. It is clear from the judgment of the ECJ in the case of *Sabel BV v Puma AG* that I must assess the overall impressions created by the marks bearing in mind their distinctive and dominant components. The applicant's mark comprises the word "Meridian" with the words "Communications and Promotions" in smaller font beneath. A device comprising 12 blue lines of unequal length is also present. Visually, whilst there are perceptible differences in the presentation of the applicant's mark when compared to the earlier registered marks which are for the word MERIDIAN only, the word MERIDIAN nonetheless serves as the dominant distinctive element within the applicant's mark. I therefore consider the mark to be visually similar and aurally identical to the earlier MERIDIAN marks. Conceptually, I consider that MERIDIAN plays an equally distinctive role within the applicants mark as it does in the earlier registered marks. Although I recognise that the applicant's mark contains additional word and device elements, I do not consider that as a result these would convey a different concept in the mind of the average consumer given that MERIDIAN is considered to be the dominant distinctive element. Accordingly, I consider the marks to be conceptually identical.

17. For the reasons set out above, I have concluded that there is a high degree of similarity when comparing the applicant's mark to the earlier marks. Each of the marks is liable to be perceived and recalled by the average consumer encountering the marks as indicating MERIDIAN as the source of origin for goods and/or services supplied under the marks.

### **Likelihood of confusion**

18. I must bear in mind that a mere possibility of confusion is not sufficient (See e.g. *React Trade Mark* [2000] RPC 285 at page 290). The Act requires that there must be a likelihood of confusion. I have already found, except in the case of earlier cited Community Trade mark 3371036, that the goods and services for which the earlier trade

marks are registered are either identical or closely similar to the goods and services applied for. Furthermore, it is now well established that the matter must be determined by reference to the likely reaction of an average consumer of the goods and services in question, who is deemed to be reasonably well informed, reasonably observant and circumspect. The goods and services at issue in classes 9, 38 and 41 are wide ranging and the approach of an average consumer will vary according to their nature. For example, an average consumer of recording discs is liable to select with a more limited degree of care being exercised than compared to education services.

19. I must further consider the likelihood of confusion by reference to the visual, aural and conceptual points of similarity in the marks. In my view the weight to be attached to all aspects of confusion is significant. As set out above, I consider the dominant distinctive component of the present applicant's mark to be MERIDIAN and the earlier registered marks remaining as citations are all MERIDIAN marks. The average consumer generally relies upon the imperfect picture of the earlier trade mark that he or she has kept in his or her mind and must therefore rely upon the overall impression created by the trade marks in order to avoid confusion. I do not consider that the differences in presentation between the present mark and the earlier registered marks are such that they would avoid a likelihood of confusion, particularly so for the goods and services where a limited degree of care is likely to be exercised by the average consumer.

20. It is established that where there is a lesser degree of similarity between the trade marks this may be offset by a greater degree of similarity between the goods and services (and vice versa) – see *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* In this respect, I do not consider that the variation in presentation between the marks is sufficient to alter the aural, visual and conceptual identities of the marks as essentially MERIDIAN marks. The similarities between the marks and the identical and similar goods and services which are in conflict are therefore likely to lead to both visual and aural confusion.

21. For the reasons set out above I consider that MERIDIAN is a distinctive term in relation to the goods and services under consideration and this is a factor that I have borne in mind in concluding that the marks are conceptually identical. In my view there appears to be two ways in which confusion could occur between these marks. Firstly, consumers are liable to recollect the earlier marks as MERIDIAN marks because that is the sole impression created by the marks. Secondly, even where consumers may notice a difference between the marks, due to the prominence of MERIDIAN in the marks, and the identity of the respective goods and services, they are likely to mistakenly believe that the applicant's mark is indicative of an economic connection between the applicant and the proprietors of the earlier marks.

## **CONCLUSION**

22. I have therefore concluded that the identical and similar goods and services coupled with the level of distinctive character of the marks and the similarity between them, is sufficient to give rise to a likelihood of confusion within the meaning of Section 5(2)(b) of the Act.

23. In this decision I have considered all of the information available to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 5(2) of the Act.

**Dated this 29th day of May 2007**

**R J SANDERS  
For the Registrar  
The Comptroller-General**