

O-556-22

**TRADE MARKS ACT 1994
(AS AMENDED)**

DECISION IN THE CONSOLIDATED PROCEEDINGS:

(1) OPPOSITION No: 419119 BY GHAMKOL SHARIF UK
AGAINST APPLICATION NO. 3423237
BY DAR UL ULOOM ISLAMIA RIZWIA (BRALAWAI)
TO REGISTER "GHAMKOL SHARIF"
AS A UK TRADE MARK IN CLASSES 16, 36, 41, 43 AND 45

(2) OPPOSITION NO: 419120 BY GHAMKOL SHARIF UK
AGAINST APPLICATION NO. 3423235
BY DAR UL ULOOM ISLAMIA RIZWIA (BRALAWAI)
TO REGISTER AS A UK TRADE MARK (SERIES OF 2):



IN CLASSES 16, 36, 41, 43 AND 45

(3) APPLICATION No. CA503243 BY DAR UL ULOOM ISLAMIA RIZWIA (BRALAWAI)
FOR A DECLARATION OF INVALIDITY
AGAINST UK TRADE MARK NO. 3388116:



REGISTERED IN THE NAME OF GHAMKOL SHARIF UK
FOR SERVICES IN CLASS 41

BACKGROUND AND PLEADINGS

1. This decision deals with the three sets of consolidated proceedings set out on the cover page, where the parties are Dar Ul Uloom Islamia Rizwia (Bralawai) (referred to in this decision as “**the Applicant**”) and Ghamkol Sharif UK (referred to in this decision mainly as “**GSUK**”, but also as “**the Opponent**” and “**the Registered Proprietor**”, according to context). GHAMKOL SHARIF is the name of a spiritual movement within Sunni Islam and the parties are two charitable Muslim organisations devoted to the sustenance of Muslim causes.
2. The papers filed in these proceedings include references to many named individuals, and some of those names are presented in various ways, often involving slight differences in spellings, various abbreviations of the full names and / or including honorific elements. In general, in this decision I have not used the fullest presentations, but have tried to reflect what appears to be an accepted form to identify relevant individuals in a consistent way.
3. The Applicant applied on 22 August 2019¹ for the word mark “GHAMKOL SHARIF” (“**the Word Application Mark**”) and for a series of two figurative marks (“**the Logo Application Mark**”):



4. Both applications were published for opposition purposes on 18 October 2019 in respect of the same specifications of goods and services in 16, 36, 41, 43, 45, as follows:

Class 16: *Printed publications; printed materials; books; religious books; bookmarks; calendars; diaries; religious circular letters; periodicals publications; stationery; printed instructional materials; educational materials for use in teaching; printed award certificates.*

¹ It is noted that parties have referred to the word mark having been applied for on 22 September 2019, which indeed is the date shown as the “filing date” on IPO’s own electronic system. However, the filed application form bears a date stamp showing that the word mark was in fact received at IPO on 22 August 2019 (which date is shown as “the receiving date” on the system).

Class 36: *Provision of housing accommodation; housing agency services; housing management; charitable fundraising services; arranging charitable fundraising events; organisation of charitable collections; financial advisory services.*

Class 41: *Education; education services; supplemental education services; further education services; adult education services; tutoring; training; arranging and conducting conferences, seminars and exhibitions; providing facilities for educational purposes; nursery school services; community engagement education services; libraries; library services; computer based library services; providing online electronic publications; online publication of electronic books and journals; religious education; religious training; educational services relating to religious development; religious education services; educational services relating to the study of Islam; educational services relating to the study of the Qur'an with Tajweed, Du'aa, Tawheed, Fiqh, Seerah, Hadith, and Uloom al-Hadith; career and vocational counselling; career information and advisory services (educational and training advice); provision of training courses for young people in preparation for careers; entertainment, sporting and cultural activities; organising community sporting and cultural events; publication of texts; arranging musical and theatrical events; provision of facilities for musical and theatrical events; providing recreational facilities; club education services.*

Class 43: *Day nursery services; crèche services; catering services; catering for the provision of food and drink; provision of food and beverages; cafeteria services; soft play cafeteria services; providing community centres for social gatherings and meetings; hiring of rooms for social functions; provision of temporary accommodation; arranging temporary accommodation; emergency shelter services.*

Class 45: *Religious services; conducting religious ceremonies; conducting religious prayer services; organisation of religious meetings; providing information about religion; counselling relating to spiritual direction and moral guidance; emotional support and guidance; spiritual mentoring; spiritual advice; marriage guidance counselling; marriage counselling; pastoral counselling; charitable services; crime prevention services; funerals; funeral services, funeral director services, bereavement services; memorial services; conducting funeral services.*

5. On 24 July 2020 GSUK filed oppositions against both trade mark applications.

Opposition to the Logo Application Mark

6. With respect to the Logo Application Mark GSUK relies on grounds of opposition under the following sections of the Trade Marks Act 1994 (“**the Act**”).

Sections 5(1), 5(2)(a), 5(2)(b) and 5(3)

7. These grounds were invoked with respect to *some* of the goods and services applied for.²



For these grounds, GSUK relies on its trade mark No. 3388116

3

The list of the Opponent’s services in Class 41 initially applied for and registered ran to around 27 pages, but the vast majority of those specified services were surrendered by means of a Form TM23 filed on 16 June 2021.⁴ Following that reduction in the specification, the Earlier Mark stands registered in respect of the following services:

Administration [organisation] of cultural activities; Adult education services; Arranging and conducting of classes; Arranging and conducting of cultural activities; Arranging and conducting of entertainment activities; Arranging and conducting of entertainment events; Arranging and conducting of entertainment events for charitable fundraising purposes; Arranging and conducting of entertainment events for charitable purposes; Arranging and conducting of in-person educational forums; Arranging and conducting of lectures; Arranging and conducting of seminars and workshops; Arranging and conducting of tutorials; Arranging, conducting and organisation of seminars; Arranging, conducting and organisation of workshops; Arranging for students to participate in educational activities;

2 See paragraphs 7 to 22 of the Statement of Grounds

3 On 8 July 2019, the Opponent’s attorneys informed the Registry that Junaid Akhtar had assigned the Earlier Mark to Umar Hussain, with an effective assignment date of 24 June 2019 (Assignment recordal ref: RC131989). On 13 November 2019, the Opponent’s attorneys informed the Registry that Umar Hussain had assigned the Earlier Mark to Ghamkol Sharif UK, with an effective assignment date of 11 November 2019 (Assignment recordal ref: RC140376).

4 (See Exhibit MJA28 to second witness statement of Junaid Akhtar)

Arranging for students to participate in educational courses; Arranging for students to participate in recreational activities; Arranging of classes; Arranging of conferences relating to cultural activities; Arranging of conventions for cultural purposes; Arranging of courses of instruction; Arranging of cultural events; Arranging of demonstrations for cultural purposes; Arranging of displays for cultural purposes; Arranging of educational conferences; Arranging of educational events; Arranging of lectures; Arranging of musical events; Arranging of presentations for cultural purposes; Arranging of presentations for educational purposes; Arranging of seminars; Arranging of seminars relating to cultural activities; Arranging of seminars relating to education; Arranging teaching programmes; Audio-visual display presentation services for educational purposes; Book and review publishing; Career and vocational counselling; Career counselling and coaching; Career counselling relating to education and training; Career counselling [training and education advice]; Coaching services; Conducting classes in nutrition; Conducting courses, seminars and workshops; Conducting guided tours of cultural sites for educational purposes; Conducting of conventions; Conducting of cultural activities; Conducting of cultural events; Conducting of educational conferences; Conducting of educational courses; Conducting of entertainment events; Conducting of instructional, educational and training courses for young people and adults; Conducting of instructional seminars; Conducting of live entertainment events; Conducting of seminars and congresses; Conducting seminars; Conducting training seminars; Courses of instruction (Provision of -); Courses (Training -) relating to religious subjects; Cultural services; Development of educational courses and examinations; Development of educational materials; Dietary education services; Dissemination of educational material; Distance learning courses; Distance learning services; Distance learning services provided online; Education and instruction; Education (Religious -); Education services relating to religion; Education services relating to the development of children's' intellectual faculties; Education services relating to the development of children's' mental faculties; Educational services relating to religious development; Electronic publication; Entertainment in the nature of ethnic festival; Exhibition services for educational purposes; Festivals (Organisation of -) for cultural purposes; Festivals (Organisation of -) for educational purposes; Fetes (Organisation of -) for cultural purposes; Fetes (Organisation of -) for educational purposes; Higher education services; Information (Education -); Information relating to cultural activities; Information services relating to books; Interviewing of contemporary figures for educational purposes; Issue of publications; Issuing of educational awards;

Language courses; Language teaching; Management of education services; Multimedia publishing; Online publication of electronic books and journals; Organisation and holding of fairs for cultural or educational purposes; Organisation of conferences relating to education; organisation of conferences relating to vocational training; Organisation of congresses and conferences for cultural and educational purposes; Organisation of continuing educational seminars; Organisation of cultural events; Organisation of educational events; Organisation of educational seminars; Organisation of entertainment and cultural events; Organisation of youth training schemes; Organising events for cultural purposes; Organising of festivals; Organization of cultural shows; Organization of events for cultural purposes; Organizing cultural and arts events; Personal coaching [training]; Personal development courses; Personal development training; Planning of lectures for educational purposes; Planning of seminars for educational purposes; Practical training; Preparation of educational courses and examinations; Providing courses of instruction; Providing cultural activities; Providing educational entertainment services for children in after-school centers; Providing electronic publications; Providing information about cultural activities; Providing recreation facilities; Provision of audio and visual media via communications networks; provision of courses of instruction; Provision of courses of instruction in languages; Provision of language schools and language courses; Provision of training and education; Publication and editing of printed matter; Publication of calendars; Publication of calendars of events; Publication of educational materials; Publication of printed matter, also in electronic form, except for advertising purposes; Recreation and training services; Religious education; Religious educational services; Religious training; School services for the teaching of languages; Teacher training services; Teaching; Teaching academy services; Teaching of foreign languages; Ticket reservation for cultural events; Training and education services; Tuition; Vocational guidance [education or training advice]; Vocational training services; Workshops for cultural purposes; Workshops for educational purposes; Writing and publishing of texts, other than publicity texts.

8. The grounds under sections 5(1), 5(2)(a), 5(2)(b) and 5(3) are founded on the identity or similarity between the parties' marks. Shortly before the hearing, the Opponent's barrister supplemented information from GSUK's notices of opposition (*Annex 1* and *2* thereto), with a further annex that grouped terms from within the Class 41 services under the Earlier

Mark and identifying which specified terms in the contested trade mark applications were claimed to be identical or similar.

9. In support of GSUK's section 5(3) claim, the notices of opposition also included an *Annex 3* that identifies the services specified under its Earlier Mark in respect of which the Opponent claims, through investment and significant long-term use, to have built up a substantial reputation. The Opponent claims that services bearing the Earlier Mark are recognisable by a significant part of the relevant public as originating from the Opponent. *Annex 4* in the notice of opposition identifies goods and services specified under the Applicant's trade marks in respect of which GSUK claims that use of the applied-for mark(s) would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent's Earlier Mark.

Section 5(4)(a) (Passing off)

10. GSUK relies on this ground to oppose all of the applied-for goods and services. It claims that use of the applied-for mark would be contrary to the law of passing off protecting the Opponent's earlier right in the unregistered trade mark "GHAMKOL SHARIF".⁵ GSUK claims that it has been "developing its brand throughout the UK" since **as early as 1975** in respect of the following goods and services:⁶

Printed publications and materials; books; religious books; calendars; diaries; religious circular letters; periodicals publications; stationery; printed instructional materials; educational materials; printed award certificates. Provision of housing accommodation; housing management; charitable fundraising services; organisation of charitable collections. Education; education services; tutoring; training; arranging and conducting conferences, seminars and exhibitions; libraries; providing online electronic publications; religious education; religious training; educational services relating to religious development; religious education services; educational services relating to the study of Islam; educational services relating to the study of the Qur'an with Tajweed, Du'aa, Tawheed, Fiqh, Seerah, Hadith, and Uloom Al-Hadith; career information and advisory services; entertainment, sporting

5 It is noted that neither TM7 relies on any alleged prior goodwill in the GS Logo.

6 Paragraphs 20 and 24 of the two statement of grounds and Section C, Q1 of the Form TM7 Notice of Opposition.

and cultural activities; publication of texts; arranging musical and theatrical events; providing recreational facilities; club education services; catering services; provision of food and beverages; providing community centres for social gatherings and meetings; hiring of rooms for social functions; religious services; conducting religious ceremonies; conducting religious prayer services; organisation of religious meetings; providing information about religion; counselling relating to spiritual direction and moral guidance; emotional support and guidance; spiritual mentoring; spiritual advice; marriage counselling; pastoral counselling; charitable services; funeral services, bereavement services.

11. The Opponent's stated case under section 5(4)(a) is:

- (i) that such use of the unregistered trade mark "GHAMKOL SHARIF" has given rise to goodwill (attributable to GSUK) in relation to the above goods and services under that sign;
- (ii) use of the Applicant's trade marks in the UK in relation to the applied-for goods and services would constitute a misrepresentation leading the public to believe that the goods or services offered by the Applicant are those of the Opponent, or are in some way economically linked, sanctioned, licensed or endorsed; and
- (iii) that the Opponent is therefore likely to suffer damage as a result the erroneous belief engendered by the Applicant's misrepresentation.

Section 5(4)(b) (Copyright)



Section 3(6) (Bad faith)

13. The section 3(6) ground is also directed against all of the goods and services under the trade mark application, which GSUK claims was filed in bad faith. It claims that the application was filed in a manner that is inconsistent with honest practices and which falls below the normal standards of commercial behaviour, based on the allegations that:
- (a) the Applicant did not conceive the Application trade mark independently and in good faith;
 - (b) the Applicant was fully aware of the Opponent's rights and activities when the Application was filed (including being fully aware that the Opponent was using the logo in question, with precisely the same image, font and wording); and
 - (c) that use of the Applicant's trade mark would infringe the Opponent's copyright and undermine the interests of the GSUK.

Opposition against the Word Application Mark

14. The Opposition against the Word Application Mark is comparably based to that against the Logo Application Mark, except that it relies only on the claims under sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Act.

The Applicant's defence and invalidity claim

15. The Applicant filed notices of defence including counterstatements in which it denies all grounds of opposition, based on its position that:
- (i) the Earlier Mark relied on by GSUK is invalid;
 - (ii) GSUK has no prior rights under section 5(4)(a). GSUK was registered as a charity on 30 September 2019 and did not exist at the filing date;
 - (iii) any copyright subsisting in the Logo belongs to the Applicant; and
 - (iv) the Applicant, not the Opponent, has prior rights in the applied-for marks and that it was therefore acting in good faith when filing. The Applicant denies that the

Opponent had any rights in the applied-for marks and/or that it carried out any activities under the applied-for mark.

16. The Applicant's counterstatements included a four-page summary account of why the Applicant considered itself to have prior rights in relation to the applied-for marks.
17. At the same time as filing its defences to the oppositions, the Applicant filed a cancellation action to have the Opponent's Earlier Mark declared invalid in its entirety based on section 5(4)(a) and on section 3(6) of the Act.⁷ I note the following claims that underpin the Applicant's case:
 - a) By the filing date of the Earlier Mark, the Applicant had generated and owned a substantial and valuable goodwill in the Logo sign (that is the Earlier Mark), through use since 2012, in relation to the provision of services which are identical or similar to those for which the earlier mark is registered, such that use of that contested mark by the Proprietor (GSUK) could have been prevented under the law of passing off.
 - b) That at all material times since around **1998/1999** (shortly after the construction and renaming of the large mosque for which the Applicant is responsible), the Applicant has carried out the following services from the mosque under and by reference to the name "Ghamkol Sharif" and/or Central Jamia Mosque Ghamkol Sharif. The services relied on by the Applicant for its section 5(4)(a) claim are set out at paragraph 7 of its statement of grounds as follows:

*"The principal object of the Applicant is and has at all material times been to provide a place of worship and religious teaching, including a supplementary education centre. The breadth of its services has expanded such that it also now provides and has at all material times provided: a 50-place nursery; mental health day care services; legal services; counselling; employment and training services for adults; advice and guidance; supported housing; and youth clubs, all for the benefit of the local community (together "**the Services**")."*

⁷ In conjunction with the provisions under section 47(2)(b) and section 47(1) of the Act.

- c) The Applicant's use of the Logo sign and of the words "GHAMKOL SHARIF" has included: signage on the outside of the mosque itself, on the education centre(s), and signage for the supported housing project; use in a domain name and the associated website; on social media; on general correspondence; and use on promotional materials such as calendars and posters.
- d) An account is given of the origin of the movement **Darbar e Aliya Ghamkol Sharif** founded in Pakistan in 1952 by Hazrath Zinda Pir ("**Zinda Pir**") as a Sufi spiritual movement and its later presence in the UK. (I return to this as part of a longer account of the events, individuals and relationships that feature in the parties' narratives and evidence around their respective claims to own relevant goodwill.)
- e) In or around 2012, a group of volunteers, working for the Applicant, created the contested Logo on behalf of and for the Applicant, and the Applicant began to provide, and has continued to provide, the services under and by reference to the Logo (which is identical to the challenged Earlier Mark).
- f) In respect of the Applicant's bad faith ground, it is claimed that Junaid Akhtar (who as I mentioned above, filed the initial application for the Earlier Mark on 30 March 2019) had been a trustee of the Applicant from 4 March 2019 until he was voted out on 9 January 2020.
- (i) Mr Akhtar therefore knew of the Applicant, its use of and rights in the contested Mark and was in fact a trustee of the Applicant when he filed for the Earlier Mark;
 - (ii) He was laying claim to a mark belonging to the Applicant;
 - (iii) He intended to take advantage of the Applicant's goodwill and reputation enjoyed in relation to the Mark and / or knew that use by him of the Mark would damage the same; and/or
 - (iv) He knew that use of the Mark by him in relation to the services would result in deception and / or confusion to the detriment of the Applicant; and / or
 - (v) Knew that registration of the Mark would prevent the Applicant from continuing to use the Mark in the UK;

- (vi) Further or alternatively, the Proprietor acted in bad faith in applying to register the mark because he had no intention of using the mark in relation to some or all of the services, and had the intention either of undermining, in a manner inconsistent with honest practices, the interests of the Applicant, or of obtaining, and exclusive right for purposes other than those falling within the functions of the trade mark;
- (vii) As a result of the above, it was claimed that the application to register the Earlier Mark was made dishonestly and/or without any honest intention and/or that such action falls short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the field in which the applicant operated at the relevant time such that the application was made in bad faith.

GSUK's counterstatement

18. The Proprietor filed eleven pages of counterstatement, denying the grounds of invalidity claimed by the Applicant. Despite its length, I consider it helpful to set out many of its points and claims below. Matters such as the chronology of events, differences in location addresses and nomenclatures, and aspects of claimed separate and shared endeavours were all significant factors in the parties' claims and submissions pursued at the hearing. The counterstatement provides a useful reference point in my consideration of the narratives from both parties and a context for analysis of the evidence, as well as an introduction to certain Islamic terms.

GSUK's claimed chain of proprietorship

19. GSUK submits that references to "**the Proprietor**" in its counterstatement are to be taken to include the activities not only of **Ghamkol Sharif UK**, but also of those who continuously provided services in the United Kingdom under the GHAMKOL SHARIF signs, **namely** (and in chronological order) Sufi Abdullah Khan Sahib (henceforth herein "**Sufi Sahib**"), his son, Sufi Javed Sahib, (henceforth herein "**Sufi Javed**"), and then his son, **Junaid Akhtar**, and, most recently, Ghamkol Sharif UK, resulting in goodwill being transferred from one party to another and now vested in the charity Ghamkol Sharif UK.

Leadership by succession

20. Whereas paragraph 3 of the Applicant's statement of grounds states that the hierarchy of the Movement has Zinda Pir's descendants in Pakistan as leaders, the Proprietor claims that "this is true only of his seat in Kohat, whereas the son and grandsons of Sufi Sahib are leaders of the Ghamkol Sharif Movement in the United Kingdom. This is in accordance with the practice of sons and grandsons continuing the work of their fathers and grandfathers."

Separateness of the UK movement

21. The **Tariqa** (the Sufi doctrine or path of spiritual learning) sets practices which its disciples are expected to follow in their daily lives relating to personal conduct and spiritual training, and also in relation to the weekly Dhikr (devotional acts), prayers and annual gatherings. The Opponent claims that Sufi Sahib established his own Tariqa different and separate from that of Ghamkol Sharif Pakistan to include, for example, adding litanies in the weekly Dhikr and altering its structure and adding two annual processions.
22. A **Khalifa** is one who is deputised to continue the work of a Shaykh or leader. They represent him and have the authority to tailor and propagate the Tariqa as they wish. Sufi Sahib was sent by Zinda Pir to the United Kingdom (Birmingham) in 1962 and established Ghamkol Sharif in the United Kingdom. From that date he began religious services, educational initiatives (such as daily Quran classes and lectures incorporated into the various events) and counselling.

38 Warwick Road, Birmingham

23. **38 Warwick Road** in Birmingham was bought in **1975** and has borne the sign "**Mosque Darbar e Aliya Ghamkol Sharif**" since that date "in relation to Quran classes, counselling sessions and monthly talks and prayers." It denies the Applicant's claim that 38 Warwick Road was purchased with the help of followers and maintains that Sufi Sahib bought it entirely independently and dedicated the ground floor of 38 Warwick Road for the works of the Tariqa.
24. I note here, that it is the date of the acquisition of this property and the affixing of its signage – the name of the movement - that serves as the date from which the Opponent claims its relevant goodwill for its section 5(4)(a) claim.

First Golden Hillock Road acquisitions and Registration of the Applicant as a charity

25. In 1983 the management committee for 38 Warwick Road purchased a row of properties comprising 107-113 Golden Hillock Road, Small Heath, Birmingham. The same management committee, then responsible for Golden Hillock Road, was established as a charitable trust in 1986 – it is that charitable trust that is the Applicant, which was registered with the name Dar Ul Uloom Islamia Rizwia (Bralawai). As space in 38 Warwick Road became limited for the larger events, the larger Golden Hillock property was used as the venue for some of the prayers and devotional activities. The GSUK counterstatement states these were organised by Sufi Sahib and that larger events continued at Birmingham Central Mosque Highgate and were operated under the name Ghamkol Sharif.

Separateness from the Opponent at Warwick Road

26. The GSUK counterstatement claims that the purchase in 1983 of the Golden Hillock Road properties was an inclusive community project for the broader Muslim community, regardless of which Tariqa they adhered to, and that as such was separate from Ghamkol Sharif UK.
27. It states that Ghamkol Sharif organised further educational events at Golden Hillock Road, but that the Applicant and Ghamkol Sharif remained distinct.
28. It also states that Sufi Sahib continued to hold the Proprietor's main annual events at Birmingham Central Mosque (Highgate), when it was available, and not the Applicant's first Golden Hillock building. As an exception to this, it states that from 1985, one annual event was held in collaboration between the Applicant and the Proprietor. However, it argues that even for that event the posters state that the organisers were the "management committee of Dar Ul Uloom Islamia Rizwia and Helpers of Darbar E Alia Naqshbandiya Ghamkol Sharif", which it claims shows two separate organisations contributing to the event. It claims that the funding and organisation was always by Ghamkol Sharif UK and the Applicant's contribution was the venue and the students of its Dar Ul Uloom who participated.

29. All the while, daily prayers, Quran classes and counselling have continued at 38 Warwick Road since then and to date, under the signage (in Urdu) referring to the name of the movement.
30. The Proprietor admits that after the opening of the Applicant's larger mosque in 1997, the events were held there, but always, according to the Proprietor, indicating that the Applicant's mosque was simply the venue, and the organiser was the Proprietor, based at 38 Warwick Road.
31. It also states that Sufi Sahib also organised annual events in Manchester, Rochdale, Derby and Watford and that the Applicant neither organised nor funded those events.

The 1997 big mosque

32. A still larger mosque was then envisaged and taken forward by the Applicant with Sufi Sahib in a leading role (which is borne out by press coverage). Construction of the Applicant's mosque at 150 Golden Hillock Road was completed in **1997**. Its initial name was "Mosque Central Jamia Mosque Ghamkolvia", but in **1998/99** it was changed to 'Central Jamia Mosque Ghamkol Sharif'. The Opponent (GSUK) maintains that this name change was only by permission of Sufi Sahib as only he was able to give such permission, on the basis that he had received the original permission from Zinda Pir to establish the Ghamkol Sharif UK Tariqa, and that he was the one who subsequently built up the goodwill and reputation around the name **as reflecting his work in the UK from his base at 38 Warwick Road**. It is the Opponent's position that the naming of the Applicant's mosque as Ghamkol Sharif has hence been with the Opponent/Proprietor's permission
33. The name Dar-UI-Uloom Islamia was used on its paperwork and documentation, such as receipt books. As an example, **calendars** from the time are exhibited which the Proprietor says show the Applicant and Ghamkol Sharif as separate entities. **Posters** for Ghamkol Sharif events held at the Applicant's Mosque state that the organiser of the event is Ghamkol Sharif, of 38 Warwick Road. Hence, the Applicant's mosque has been **a venue** for the Opponent/Proprietor's Ghamkol Sharif events, but **not the provider or organiser** of those events. **Funds and organisation of the two sides' activities** remained separate.

34. To support its claim that in the perception of the public, the parties have separate identities, the Opponent/Proprietor exhibits extracts from a 2001 hard copy directory of Masaajid and Islamic Schools, wherein the Applicant is listed as Central Jamia Mosque Ghamkolvia and the Opponent/Proprietor is listed as Mosque Ghamkol Sharif Darbar-e-Alia. It also refers to calendars produced *by the Applicant* under its name “Central Jamia Mosque Ghamkol Sharif” which include photos of the Proprietor’s property at 38 Warwick Road under the name “Darbar-i-Alia Ghamkol Sharif”. It claims that this is evidence that there are “plainly two separate entities and that the parties’ activities are clearly distinct.”

Name differences

35. GSUK’s counterstatement states that the Applicant’s services have been known by various names (such as Big Mosque, Central Jamia Mosque/Masjid Ghamkol Sharif) whereas the Proprietor is known as Darbar E Alia Naqshbandiya Ghamkol Sharif, Darbar i/e Aliya Ghamkol Sharif, Ghamkol Sharif UK or simply Ghamkol Sharif.

Roles of Sufi Sahib and Sufi Javed

36. Sufi Sahib served as a trustee of the Applicant right from its initial registration as a charity, until his death in 2015. In the 1990s, his son, Sufi Javed, too became a trustee of the Applicant and remained so until his death in 2019. Sufi Javed had been made a Khalifa and succeeded to be head of the order based at 38 Warwick Road when Sufi Sahib died in 2015.

The Applicant’s services

37. The Opponent states that the range of the Applicant’s services has not at all times been as described in Paragraph 7 of the Applicant’s Statement of Grounds. With reference in particular to the **Applicant’s educational services, before 2013**, its education centre was called Dar Ul Uloom (as an abbreviation of the Applicant’s full name). Following the construction of a new centre at Golden Hillock Road, completed in 2014, the Opponent claims that the centre was run by the Applicant in partnership with the Proprietor from 2014 – February 2019. From 2014 the name of the building was Ghamkol Sharif Education Centre, with the permission of the Proprietor. They then gave this building to The City of Knowledge academy in September 2019 and the name of this building changed to The City of Knowledge Academy. Further to the dispute between the parties,

the building has very recently – within the last couple of months – been renamed again as the Ghamkol Sharif Academy, this time without the consent of the Proprietor.

38. In relation to the remaining Services claimed by the Applicant in its Statement of Grounds, the Proprietor denied various claims, as follows:
- i) The Applicant does not provide counselling;
 - ii) The Applicant does not itself provide nursery and supported housing services: these services are provided by other entities which rent space from the Applicant;
 - iii) The Applicant does not provide a youth club;
 - iv) The job centre has been closed for several years;
 - v) The day care centre has been closed for over a year;
 - vi) Legal services were provided in the 1990s and possibly into the early 2000s, but these services were provided by a legal firm that was at all times independent from the Applicant.

The Proprietor's services

39. The services provided by the Proprietor under the Ghamkol Sharif name date from 1962 (i.e. even prior to the purchase of 38 Warwick Road) to the present and include:
- i) The services of a mosque;
 - ii) Education; weekday Quran classes, adult classes weekly;
 - iii) Spirituality; weekly Dhikr gatherings, counselling and litanies daily to address spiritual and mental health issues, training to individuals, advice and guidance, monthly Ghiyarvi Sharif and annual Urs and Milad events.
 - iv) Social/ Religious; daily prayers facility, monthly prayer timetables, yearly Ramadhan night prayers and Nikahs (marriage ceremony).
 - v) Charity; financially supporting many local and international organisations, providing cooked meals twice a year from 1970s in Saudi Arabia, Foodbank.
 - vi) The provision of annual events in Birmingham and elsewhere attended by circa three thousand to five thousand people
 - vii) The provision of monthly events in Birmingham attended by up to 500 people;

40. GSUK's counterstatement continues, with the claim that from 2014/15 and to the present day, the Proprietor has provided various new services, including (the start dates are given in brackets):

- i) Education: Suhba Academy which is a holiday school (Feb 2017), Adult and Junior Arabic school (January 2018), Islamic Studies classes (July 2017), Publishing Literature (2016), Sex Education (Feb 2018), Youth Programme which included Sports for Teens (November 2015)
- ii) Spiritual: Dalail ul Khayrat (2015)
- iii) Social/ Religious: Monthly Moonsighting (2018)
- iv) Community: Blood donations (2015) to encourage people in our community to donate blood, WMFS Safe and Well visits (2020), Halt Heartache (2017) which was a project to reduce Road Traffic Collisions by working with partners including WMP & WMFS. Elderly project (2015) which involved visiting a local care home to reduce loneliness.

Creation of the Logo

41. It contests the Applicant's account that a group of volunteers, working for the Applicant, created the Logo, and, revealing further detail around the Opponent's copyright claim, states that it was an artistic work commissioned from Print Xpress instructed by Mr Umar Hussain in March 2012, and that copyright was formally assigned to the Proprietor on 6 November 2019. The Proprietor states that the copyright in the logo has thus at no time been in the Applicant's ownership.

Proprietor's use of the Logo

42. Posters, education signage and calendars (bearing the logo) were all commissioned by Ghamkol Sharif UK. It therefore denies the goodwill claimed by the Applicant, because goodwill under the signs GHAMKOL SHARIF and the Logo is and was at all material times possessed by the Proprietor. Any such use made by the Applicant of the signs was with the consent of the Proprietor, that consent now having been withdrawn.

Fundraising collections

43. GSUK's counterstatement claims that only in the last few months of 2019, after the Applicant filed its trade mark applications and after the filing date of the Proprietor's trade mark, did the Applicant start collecting and allocating money for its own events. Before 1998 and after 1998 it was commonly known by the followers of Darbar E Alia Naqshbandiya Ghamkol Sharif that if they wanted to give money towards the Applicant's mosque they should do so at its main office, but if they wanted to give the Proprietor money for its events and other services then they would give it to Sufi Saab or people he had designated. To the present day, the same principles apply.
44. The counterstatement claims that over the last five years, the Proprietor's activities have resulted in charitable donations made to it in excess of £125,000 per year, with expenditure ranging from £90,000 to over £350,000.

The Proprietor's pre-existing rights and denial of bad faith

45. The Applicant has no claim to rights of any kind which pre-date the goodwill in either the sign GHAMKOL SHARIF or the Logo sign arising from the activities of the Proprietor.
46. Prior to Junaid Akhtar's dismissal as a trustee, he had worked extensively at the education centre since 2014, and before that as a volunteer, he says with the aim of bringing together the objectives of the Proprietor and the Applicant's Mosque.
47. It is denied that the registering of the Mark was in any way in bad faith. The Mark was registered with the bona fide intent of using it to continue the promotion of the work begun by Zinda Pir and Sufi Sahib and continued by Sufi Sahib's descendant Junaid Akhtar and the charity Ghamkol Sharif UK. Given this, the role of Junaid Akhtar as trustee of the Applicant is irrelevant, as the goodwill in the signs GHAMKOL SHARIF and the logo was at all material times vested in the Proprietor.
48. GSUK's counterstatement concludes by emphasising that goodwill is a matter of public perception: the public has at all times been aware of the separate identities of the Applicant and the Proprietor and no misrepresentation or deception has taken place, at least not until the Applicant chose to use the Mark and the name GHAMKOL SHARIF without permission in late 2019.

Hearing and representation

49. Boulton Wade Tennant LLP are the attorneys acting for GSUK; Veale Wasbrough Vizards LLP are the attorneys for the Applicant. Both parties requested an oral hearing, which took place via TEAMS on 24 January 2022, both sides engaging counsel. Emma **Himsworth** QC acted for GSUK; Victoria **Jones** acted for the Applicant. Both filed skeleton arguments. The Hearing required a full day and included, as preliminary matter, consideration of whether to admit evidence filed only in the week before the hearing and included too, a cross-examination of the relevant witness.

Evidence

50. Both parties filed evidence in support of the consolidated proceedings, which - as will be apparent from the list below - was extensive.

Evidence in chief on behalf of GSUK

51. Witness statements of:
- (1) Junaid Akhtar dated 19 January 2021 ("**Akhtar 1**") together with Exhibits MJA01 to MJA50;
 - (2) Mohammed Fiaz;
 - (3) Mumtaz Ali;
 - (4) Shahid Butt;
 - (5) Haji Akram;
 - (6) Haji Bostan (in Urdu) with translation into English; and
 - (7) Mohammed Sajid.

Evidence in chief on behalf of Applicant

52. Witness statements of:
- (1) Ahsan UI-Haq ("**UI-Haq 1**");
 - (2) Pir Habib Ullah Shah;
 - (3) Khalifa Fazal Illahi;
 - (4) Mohammed Imran Talib;
 - (5) Parvaiz Akhtar;

- (6) Khalifa Dr Allah Detta; and
- (7) Amjad Kamal.

Evidence in reply on behalf of GSUK

53. Witness statements of:

- (1) Mohammed Yassar Khan;
- (2) Haji Abdul Malik;
- 3) Haji Qurban Hussain;
- (4) Khalifa Mohammed Pervaiz;
- (5) Khalifa Muhammed Yasin;
- (6) Second witness statement of Junaid Akhtar ("**Akhtar 2**") with Exhibits MJA1 - MJA32;
- (7) Dr Ather Shabaz Hussain, with Exhibits ASH01 to ASH04; and
- (8) Sultan Mahmood, with Exhibits SM01 to SM04.

Evidence in reply on behalf of the Applicant

54. Second witness statement of Ahsan UI-Haq ("**UI-Haq 2**") together with Exhibit AUH2.

Additional evidence filed for GSUK

55. On 23 November 2021, GSUK filed additional evidence in the form of the Witness Statement of Umar Hussain together with Exhibits UH01 to UH04.

Additional evidence in response filed for the Applicant

56. On 23 December 2021, the Applicant filed additional evidence in response in the form of the third witness statement of Ahsan UI-Haq ("**UI-Haq 3**") together with Exhibit AUH3.

Additional evidence in reply filed for GSUK

57. On 17 January 2022 GSUK filed additional evidence in reply in the form of the witness statement of Aftab Khan.

58. The Applicant objected to the admission of this witness statement, but at the hearing I confirmed my preliminary view to admit into these proceedings the witness statement of Aftab Khan. In making that decision, I acknowledged the advanced stage of proceedings and the very substantial amount of evidence already filed, especially on the part of GSUK. However, while there is a need for proportionality in matters of evidence before the tribunal, I took the view that since the Applicant's latterly filed witness statement UI-Haq 3 had stated that Exhibit UH01 was "not a genuine invoice", a piece of evidence that had been filed for the best part of a year, that it was desirable to admit the Opponent's evidence from Aftab Khan with regard to that exhibit and the circumstances around the creation of the logo.
59. I bore in mind the content of the letter from GSUK's attorneys (dated 17 January 2022) which addressed factors set out in case law regarding the admissibility of late evidence;⁸ and bore in mind too Ms Himsworth's submissions that the opportunity to cross-examine Mr Khan would largely deal with any prejudice to the Applicant arising from the late admission of his evidence. Mr Khan had made himself available for cross-examination and he duly provided an affirmation as to the truthfulness of his witness statement and to the oral evidence he provided at the hearing. The cross-examination focused on testing his statement that his printing company maintained separate accounts as between GSUK and the Applicant, and the reliability of post-facto invoice evidence. I shall return to what conclusions I drew from the evidence and testimony of the witness where I deal with the copyright claim under section 5(4)(b).
60. At the hearing, and in skeleton argument, counsel for both sides directed me to numerous points within the evidence. I have considered the submissions and have read all of the evidence filed, including in light of the transcript of the hearing. I have considered matters in the round and refer to particular aspects only to the extent warranted for the purposes of making my decision.

The approach in this decision

61. GSUK has the benefit and advantage of an earlier registered trade mark on which it relies to oppose registration of the Applicant's identical/similar marks in relation to the goods

8 [2016] EWHC 3103 (Ch) TITANIC SPA paragraph 34

and services in 16, 36, 41, 43, 45, many of which are self-evidently identical or highly similar to the services registered under the Earlier Mark. However, by the time of the hearing, both sides acknowledged that the central issues in these proceedings were those concerning:

- (i) whether either party was entitled to rely on actionable goodwill to sustain a claim under section 5(4)(a) of the Act; and
- (ii) whether GSUK was able to rely on a claim under section 5(4)(b) of the Act, based on the copyright in the commissioned logo.

62. GSUK's claim under section 3(6) of the Act, that the Applicant applied for the Word and Logo Marks mark in bad faith, essentially stands or falls with the outcome of the two section 5(4) claims. I shall deal with the other grounds on both sides as necessary. However, the starting point of my decision shall be my consideration of whether the Applicant has a basis on which to invalidate the Earlier Mark on the basis of the provisions of section 5(4)(a) of the Act.

Applicable legislative provisions and legal principles

63. Section 47 of the Act deals with invalidity. Section 47(2)(b) provides that registration of a trade mark may be declared invalid on the ground that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied.

64. Section 5(4)(a) of the Act provides that: "*... a trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met.*
(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application"

Section 5(4) also states that "*A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of 'an earlier right in relation to the trade mark'.*"

65. The principles of the law of passing off are well known. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the *Jif Lemon* case,⁹ namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. In relation to deception, it must be determined whether “a substantial number” of a claimant’s customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived.¹⁰

Relevant date

66. The relevant date for the purposes of determining whether or not a registered trade mark is validly registered is the date when the application was filed. In the present case the relevant dates are:

- (1) For GSUK’s Earlier Trade Mark Registration: **30 March 2019**; and
- (2) for the Applicant’s contested UK Trade Mark Applications: **22 August 2019**.

67. However, where an applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.¹¹ In *Croom’s Trade Mark Application* [2005] RPC 2, Geoffrey Hobbs QC sitting as the Appointed Person set out the position as follows (references omitted):

“45. I understand the correct approach to be as follows. When rival claims are raised with regard to the right to use a trade mark, the rights of the rival claimants fall to be resolved on the basis that within the area of conflict:

- (a) the senior user prevails over the junior user;
- (b) the junior user cannot deny the senior user's rights;
- (c) the senior user can challenge the junior user unless and until it is inequitable for him to do so.

9 *Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, 11 [1990] RPC 341, HL

10 *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)

11 *SWORDERS TM* (O-212-06), per Allan James

46. ... The principles themselves are, in my view, deducible from:

- (a) the right to protection conferred upon senior users at common law ...;
- (b) the common law rule that the legitimacy of the junior user's use of the mark in issue must normally be determined as of the date of its inception ...; and
- (c) the potential for co-existence to be permitted in accordance with equitable principles ...

68. In view of the considerable length of the background and pleadings set out above, I note here the following foundation points in relation to the parties' section 5(4)(a) claims, as developed in oral submissions at the hearing:

- (i) The Applicant relies on goodwill for its claimed goods and services in connection with the words "Ghamkol Sharif" since 1998, and through use of the Logo sign since 2012.
- (ii) GSUK claims to be the proprietor of a still earlier right, dating back to at least 1975, as successor to an unincorporated association that comprised Sufi Sahib, Sufi Javed and Junaid Akhtar.
- (iii) Sufi Sahib is claimed to have been the leader of an organisation, whose son and grandson worked with him in official capacities and that GHAMKOL SHARIF was associated with the spiritual teachings of the tariqa as taught by Sufi Sahib and his successors.
- (iv) GSUK submits that 38 Warwick Road was effectively the headquarters of the GHAMKOL SHARIF movement in the UK, which property is not owned by the Applicant, and which, since 1975, has borne the sign, in Urdu, Darbar e Aliya Ghamkol Sharif. The property has continued to operate as a mosque and madrassa since 1975 and is listed separately in directories of UK mosques by reference to a name that includes the words GHAMKOL SHARIF.
- (v) GSUK claims that it has the goodwill of an entity that is separate from the Applicant and that any use by Applicant of the signs "Ghamkol Sharif" and the Logo has been

only with the permission of the Opponent/Proprietor/GSUK, which permission is now withdrawn.

Points not in dispute

69. I have considered whether it may be said that *neither* party uses the sign Ghamkol Sharif *distinctively*, since both sides use it, with/as part of longer names, so as to indicate adherence to or affiliation with Ghamkol Sharif as a religious pathway. I note, for instance, that the Applicant, in a public statement about this trade mark case,¹² describes itself as the largest mosque in the UK that subscribes to the Darbar e Aaliya Ghamkhol Sharif movement. This might suggest that other mosques may likewise legitimately subscribe to the movement. I note too the comment by Mohammed Imran Talib at paragraph 11 of his witness statement that he understands “*that anyone who is associated with the movement can possibly display the Ghamkol Sharif name and identify with it, or to indicate that they belong to the movement ... but that by no means does this mean that they have the right to call it their own.*”
70. However, the parties appear to agree (a) that relevant services were provided around events and activities associated with a mosque, including religious services and education (b) that the sign GHAMKOL SHARIF is distinctive of those services and (c) that authority from within the movement is needed to use the name. The central point of disagreement between the two parties, is over who is able to claim ownership of the goodwill associated with the sign in the context of the goods and services in evidence. It is widely accepted (including by the parties in these proceedings) that charities, including religious charitable organisations, can enjoy goodwill and that even a non-trading charity can maintain a passing off action against another similar charity.¹³
71. I also note that there are various references in the evidence to the movement having a presence in other cities in the UK, including Coventry, Derby, Watford and Manchester.¹⁴ However, I find that such references are fleeting and far too undeveloped to found or contest a claim of goodwill. The goodwill claimed by both sides, is therefore to be

12 Akhtar 2, Exhibit MJA22

13 See *British Diabetic Association v Diabetic Society* [1996] F.S.R. 1. Also see more generally Section D of Chapter 3 of Wadlow on The Law of Passing Off 6th Edn

14 (See for instance, paragraphs 9 and 11 of the witness statement of Fazal Illahi, and page 3 of AUH1.)

determined based on the evidence relating to the activities under the sign(s) in Birmingham. I find this is the case despite the origination of the name as a Sufi movement in Pakistan, as I explain next.

Relevance of Pakistan origin

72. In determining a section 5(4)(a) claim, the trade mark tribunal must take account of the legal principles that arise from case law to establish the locus of goodwill and its nature and extent. Central to the matter of goodwill is the presence of customers in the UK (or at least users/consumers of the goods and services). It is the perception of those UK consumers that is paramount in determining who is the owner of an actionable earlier right.
73. Although there was disagreement in the submissions and evidence from the parties as to whether the movement known as Ghamkol Sharif was a separate tariqa in the UK, distinct from the original of the same name founded (and still operating) in Pakistan, I find that from a legal perspective, this is not centrally pertinent. In that regard, I agree with Ms Himsworth that any suggestion that a reputation for activities, spiritual or otherwise, outside the jurisdiction is sufficient to found a claim for passing off would be misconceived as a matter of law.¹⁵ Nonetheless, I make the following observations.
74. The Proprietor states in its counterstatement that Ghamkol is the name of a geographical location in Pakistan near Kohat, where Zinda Pir spent time and that “Sharif” is an honorific suffix, added to any revered name. It may be surprising that if Sufi Sahib had wished to distinguish a tariqa of his own from that of Zinda Pir, that he would not have chosen a distinguishing name. There was evidence from both sides around standard practice in that direction – although the Proprietor contended that there is precedent for distinct tariqas having the same name.
75. I also find that it is far from apparent that Sufi Sahib considered himself to be establishing a new, distinct tariqa. In fact, I find to the contrary; the evidence shows his enduring devotion to Zinda Pir and that he understood himself to be sent to the UK as a Khalifa to

¹⁵ See Starbucks (HK) Ltd v. British Sky Broadcasting Group and others (No 2) [2015] UKSC 31

work in the service of Islam, with the authority of Zinda Pir.¹⁶ I note the evidence filed on the part of GSUK, includes the transcript of interview from the 1980s with Sufi Sahib himself, at which were also present Khalifa Fazal Illahi and Ahsan UI Haq (witnesses for the Applicant).¹⁷ In that interview, Sufi Sahib states that Zinda Pir told him to act according to the circumstances in the UK. Sufi Sahib says that “brothers in the tariqa and a few people who are close and part of the management ... contribute voluntarily ...” Sufi Sahib’s own words in the interview include references to the effect that it is thanks to Zinda Pir Ghamkolvi “that everything gets done” and he attests that things have been made possible “in services for the religion” “based on the teachings of [Zinda Pir] and his guidance ...”

76. The differences of practice introduced in the UK version may fairly be attributed to pragmatic adaptations to local circumstances, rather than something fundamentally different from the original movement. There is also reference in GSUK’s evidence to people having been deputised (as Khalifa) only following the recommendation of Sufi Sahib to Zinda Pir.¹⁸ In my view, factors such as these very strongly indicate an essential adherence to, rather than a separation from, the movement founded by Zinda Pir. Such a conclusion is squarely supported by the witness statement of Khalifa Fazal Illahi, who was a very close friend and associate of Sufi Sahib from at least 1967.
77. That said, there is also evidence that does identify Sufi Sahib as a having the status of “pir”. For instance, Exhibit MJA08 to Akhtar 2, shows extracts from book by Pnina Werbner published in 2003, wherein Sufi Sahib is described as the most powerful and independent of the khulafa and as “a Pir in his own right”. Nonetheless, Sufi Sahib appears both inextricably linked with Zinda Pir and more prevalently referred to as a khalifa / khalifa-e-azam.¹⁹
78. In any event, I fully accept that it is important to keep firmly in mind that this tribunal is concerned with the position in the United Kingdom, that goodwill is a matter of public

16 For instance witness statement of Haji Abdul Malik (in the evidence filed by GSUK) at paragraph 18 Sufi Sahib to the UK as a Khalifa (a leader/deputy) “to preach and teach people about Islam”.

17 Exhibit MJA06 to second witness statement of Junaid Akhtar

18 See paragraph 20 of witness statement of Khalifa Mohammed Pervaiz.

19 See, for example, MJA 27 to Akhtar 2, at page 97, which shows a YouTube image from August 2015, marking the Urs (saints remembrance) both of Zinda Pir and Sufi Sahib. See too translation evidence such as from Dr Ather Hussain. See too Haji Qurban Hussain, in his evidence filed by GSUK, e.g. at paragraph 7.

perception and that under the law of passing off goodwill must attach to a business – or let us say an enterprise - in connection with the provision of goods or services.

Did the Applicant have goodwill based on its claimed signs?

79. Before I come on to consider whether GSUK may have predating goodwill, and whether the legitimacy of the Applicant’s use of the signs was dependent on the permission of GSUK, I will first consider whether the evidence shows that the Applicant had generated goodwill for its claimed goods and services by reference to the words “Ghamkol Sharif” and later the Logo, by the filing date of GSUK’s Earlier registered mark (30 March 2019).

Signage

80. The evidence shows that the Applicant owns various properties at Golden Hillock Road, including the large mosque and the education centre. The large mosque has, since 1998/1999, displayed the words Central Jamia Mosque Ghamkol Sharif as its signage, where the first three words merely denote the central gathering function of the mosque and where the words “Ghamkol Sharif” appear below those words in the signage in notably larger form.²⁰ This long-standing, prominent signage on the mosque is in itself strong evidence of use likely to lead to goodwill in relation to mosque services. Similarly, following demolition and rebuilding of the Applicant’s Golden Hillock Road properties in around 2012 the buildings are shown to have prominently borne signage of the words “Ghamkol Sharif” (on their own) above the separate sign for the Golden Hillock Centre, and then in signage for the separately-built Ghamkol Sharif Education Centre, again where the words “Ghamkol Sharif” are more prominent. There is also evidence that the Applicant was involved in a supported housing scheme, operated in conjunction with a third party, where the building is shown in 2010/2011 to have prominently borne the signage “Ghamkol Sharif House”.²¹

More than a venue

81. The role of the Applicant is not limited to its being merely the venue owner:
- (i) The evidence shows that it **employs staff**: Mr UI-Haq is Chair of Trustees of the Applicant charity overseeing external contractors; all trustees of the Applicant are

20 See page 43 of Exhibit AUH1

21 See page 44 Exhibit AUH1 and paragraph 79 of UI-Haq1

volunteers and followers of the Ghamkol Sharif movement. His evidence includes payroll documents.²²

- (ii) The Applicant arranges the clearance of volunteers working at its education centre. The **DBS checks** (Disclosure and Barring) are paid for by the Applicant and returned to the Applicant.²³ Examples are exhibited in AUH1, where the recipient is addressed as Central Jamia Mosque Ghamkol Sharif (as opposed to Dar Ul Uloom Islamia Bralawai). Those example DBS checks are dated July 2015 and December 2017, and include Junaid Akhtar (volunteering) and Mohammed Khizar, employed by the Applicant as head teacher.
- (iii) Junaid Akhtar admits that it was the Applicant that **ran the education centre** from 2014 - 2016.²⁴ Mr Akhtar claims that GSUK took over in 2017 until 2019, whilst admitting that even then it was the Applicant that paid wages and bills. Mr Akhtar's claim is denied by the Applicant: UI-Haq 1 states that until a partnership with City of Knowledge in July 2020, the Ghamkol Sharif Education Centre has always been solely run by the Applicant, and not in partnership with GSUK.²⁵
- (iv) The Applicant provides evidence that it maintains accounts and it summarises its **income and expenditure** for the five years 2015 to 2019, where annual income ranges from around £430,000 to nearly £600,000 and where annual expenditure ranges from around £170,000 to nearly £270,000.²⁶ The information from the accounts does not give great detail on what money is spent on, but it at least shows expenditure on premises costs (charges, insurance, maintenance etc) and staffing costs and income from donations and the retention of "children fees." UI-Haq1 states at paragraph 95 that there were separate donations for the movement, but I agree with his statement that this does not indicate that there was a *separate entity* operating the movement or that the Applicant was collecting on behalf of a *separate entity*.

22 See paragraph 80 of UI-Haq1 and the payroll evidence at pages 24-42 Exhibit AUH1

23 (Formerly known as CRB or Criminal Records Bureau checks)

24 Akhtar 2, page 22, paragraph 86

25 Page 18, paragraph 91

26 Pages 108- 125 of Exhibit AUH1; UI-Haq 1 at paragraph 93

(v) The evidence also shows that the Applicant in August 2014 commissioned **promotional goods**, including Ghamkol Sharif-branded rulers, rubbers and pencil cases (bearing the Logo) to mark the opening of its purpose-built Ghamkol Sharif Education Centre.²⁷ The Opponent's own evidence refers to goods that bear the sign "Ghamkol Sharif" as being those of the Applicant, particularly calendars and copies of the Quran.

(vi) UI-Haq1 also gives an account of the Applicant's use of the signs on its website and through social media channels. Some of the evidence in this area does feature references to "GSUK" and "Ghamkol Sharif UK", which makes for a confusing impression, and is point of dispute between the parties. For now, I note the following from paragraph 87(a)-(e) of UI-Haq1:

- **the website ghamkolsharif.org** was one of five URL domain names registered by June 2010 and paid for by Mohammed Imran Talib.²⁸ Mr Talib has been a volunteer, a staff member and trustee at the Applicant; his father was Khalifa Mirza Talib Hussain, one of the original members of the management committee that ran the ground floor of 38 Warwick Road and a founding trustee of the Applicant.
- Page 79 of Exhibit AUH1 shows an invoice, addressed simply to "Ghamkol Sharif" at 150 Golden Hillock Road (the Applicant's address) in respect of website design services "for Ghamkol Sharif". Page 80 of Exhibit AUH1 shows the first capture of the website available from waybackmachine (11 June 2010) and shows the following text: "*Welcome to Ghamkol Sharif's official website! Central Jamia Mosque Ghamkol Sharif welcomes you to its website and hopes that you find it informative and useful.*" (my underlining)
- the Applicant's **Facebook** profile was set up with the name "*Central Jamia Mosque Ghamkol Sharif Birmingham Events*" to promote events that were either organised by the Applicant, held at the Applicant's premises, or that were of interest to the Applicant's beneficiaries. Page 84 of Exhibit AUH 1 shows a Facebook page dated 2 August 2012. The post includes heading text "Ghamkol Sharif presents" above

27 Page 76 and 77 Exhibit AUH1

28 (The others having other suffices such as ghamkolsharif.co.uk and .net – Exhibit AUH1 page 78.)

the contested Logo, where the subject of the post is “Reality of Ramadhan”. The post is attributed (in 2012) to “Ghamkol Sharif UK”. However, page 83 of Exhibit AUH 1 shows that it was only on 2 June 2015 that the name of the Facebook profile was changed to “Ghamkol Sharif UK”. Mr UI-Haq states that this was not an authorised change of profile name. A consequence of that change of profile name on social media is that it looks as if the name on these accounts has always been ‘Ghamkol Sharif UK’ and that the accounts are those of GSUK, but Mr UI-Haq states that this is not the case, and that the accounts are and have always been those of the Applicant, advertising the Applicant’s Services. I note that page 86 of AUH1 shows a Facebook post dated 23 May 2013, seemingly in the name of Ghamkol Sharif UK, but where the opening and closing lines of the content of the post make it clear that it was “Central Jamia Masjid Ghamkol Sharif” (so no reference to GSUK) that condemned the then very recent murder in Woolwich of the soldier, Lee Rigby.

- **Youtube** – this channel was set up on 17 March 2012 with the name “Ghamkol Sharif Masjid” (mosque) – i.e. in connection to the Applicant. UI-Haq1 states that this too, again without authority, was changed, with the effect that the replacement name is applied retrospectively. Page 90 of Exhibit AUH1 shows a Facebook post from January 2017, in the name of Ghamkol Sharif UK, where the Youtube handle is given as “ghamkolsharifmasjid”. I note, incidentally the content of that post is “Ghamkol Sharif presents The Golden Legacy of Hadrath Sufi Abdullah Khan Sahib (RA)”, (which is Sufi Sahib) where the proceedings are “presided by Sufi Javed Akhtar Sahib” (i.e. Sufi Javed) and where the Logo also appears.
- **Twitter** – Page 94 of AUH1 shows a tweet from a Twitter account in the name of Ghamkol Sharif UK. It includes clear references to “Ghamkol Sharif UK” and to the address 38 Warwick Road, and to “Serving the community since 1962” and to having joined Twitter in August 2012. I note, incidentally, that the subject of the tweet appears in relation to educational analysis of various Hadiths (the sayings and accounts of Prophet Muhammad). However, I find it is difficult to draw reliable conclusions from the exhibit, since there is reference to a 2020 charitable campaign – which suggests that the post is from after the relevant date. Whereas

UI-Haq 1 states that the Applicant's Twitter account was set up in August 2012, Junaid Akhtar states that the Twitter account has always belonged to GSUK.

- **Instagram** – pages 46 – 56 show various posts from 2015 -2019 on Instagram, where the Insta handle is in the name of ghamkolsharifuk. The content of the posts focus on provision at the Applicant's Ghamkol Sharif Education Centre. The content covers what to me appears generalised Islamic provision (albeit under a Ghamkol Sharif banner and logo) covering learning about the life of the Prophet, hadiths, Arabic and Urdu, and aimed at children as well as women and men. One post on page 48 is dated January 2018, and refers to "Ghamkol Sharif presents The Golden Legacy of Hadrath Sufi Abdullah Khan Sahib" and invites the reader to "visit us: Ghamkol Sharif Education Centre" for a Sunday Arabic school. On page 49 there is an Insta post relating to the Suhba Academy (dated 17 July 2017). The Suhba course aims to teach children the essentials of Islamic belief and practice. A similar poster is shown on page from 12 October 2017, and on page 51 from 14 December 2017. In each case, the poster is headed "GHAMKOL SHARIF EDUCATION CENTRE PRESENTS THE GOLDEN LEGACY OF HADRATH SUFI ABDULLAH KHAN SAHIB (RA)" (my underlining). Other social media posts show Ghamkol Sharif Education Centre-related provision such as cookery club and sports.

82. I find overall that the evidence establishes that by 2019 when the Proprietor applied for its contested trade mark, the Applicant had generated goodwill associated with the sign Ghamkol Sharif and the contested logo. The goodwill is especially well established in relation to the provision of mosque services and related education services, which are the charity's objects emphasised in its trust deed. It seems to me that it is the Applicant who would be held responsible in the public perception if the services were unsatisfactory.²⁹ There is also evidence attesting to a wider spectrum of services,³⁰ and the Proprietor's counterstatement does not even deny some of the services claimed by the Applicant, but rather highlights that the housing, legal and nursery services involved third party providers. Such third-party arrangements are, in my view, not necessarily a

29 (In line with comment in Chapter 3 of Wadlow at 3-139 – 3-141.)

30 (See for instance, page 14 of the first witness statement of Ahsan UI-Haq at paragraphs 78 and 79; and the Witness statement of Mohammed Imran Talib at paragraph 24 and 33). Also paragraphs 16 and 19 of witness statement of Khalifa Mohammed Pervaiz.

bar to goodwill under the sign nonetheless flowing to the Applicant who arranged such provision.

83. That the Applicant does not include the words “Ghamkol Sharif” in its own name, nor refer to the movement in its Trust Deed, does not in my view undermine its claim to goodwill, which is based on its ample use of the sign in respect of goods and services, as I have set out. I also note that Umar Hussain, giving evidence for GSUK, states that he has also been chair of “Ghamkol Sharif Manchester CIO”, whose name, prior to October 2020 had not included the words Ghamkol Sharif, but was instead based on the words “Dar Ul Uloom Islamia”, which translates as “Islamic house of knowledge” and which is close to the Applicant’s own name, suggesting that it is not unusual that the Applicant, despite being thoroughly steeped in the Ghamkol Sharif movement, does not reference those words in its trust deed.³¹
84. I have found that, at the relevant date, the Applicant charity managed an undertaking, by reference to the signs, that enjoyed substantial goodwill, principally in relation to mosque services (as one of the largest mosques in the UK) and related education services. I therefore next consider the further elements in the trinity required for passing off, namely, misrepresentation and consequent damage.
85. The words “Ghamkol Sharif” are unfamiliar and inherently distinctive and striking in themselves. This is also at least equally the case with the logo, where the word sign is combined with the Urdu version of the words interwoven with the device of a dome of a mosque. Moreover, I have also found that the distinctiveness of the signs is accepted common ground between the parties. The Proprietor’s trade mark is essentially identical to the logo mark used in the promotion of the Applicant’s services (such as on posters and on social media), and contains the identical distinctive words in English as the word sign in respect of which the Applicant had goodwill at the relevant date.
86. On these premises, I find that use of Proprietor’s mark in respect of the services for which it stands registered in Class 41 would constitute a misrepresentation, whereby a “substantial number” of the relevant public³² – those who make use of the mosque or its

31 Paragraph 5(f)(iv) of UI-Haq 2 explains the significance of the Applicant’s name and its sectarian neutrality.

32 Lord Oliver in *Reckitt & Colman Products Ltd v Borden Inc (No.3)* at page 407

education and community services - would be likely to be deceived into believing that the services are from the same source or are connected. I also find that there is a real risk of consequent damage, since the Applicant has no control over the nature, quality or reliability of such services provided by the Proprietor and the potential for customer dissatisfaction with such provision entails a reputational risk that is not merely fanciful.

GSUK's claimed earlier goodwill

87. Having made those findings that the Applicant had a prima facie basis for a section 5(4)(a) claim at the filing date, I must now consider the claim by GSUK/the Proprietor/the Opponent, that GSUK is the proprietor of a still earlier right and that the Applicant's use of the signs was legitimate only so long as it was with the Proprietor's permission to indicate an arrangement between the parties marking an association with GSUK, such licence having since been withdrawn.
88. In order for this to be a tenable position, I must first be satisfied on the evidence that the goodwill for the services claimed by GSUK (which I set out at my paragraph 10 above) attached merely to three individuals, working together and successively (and, by implication, discounting the relevance of the work of other khulafa, followers or entities acting under the name of Ghamkol Sharif). Having taken all the evidence in the round and carefully considered the submissions from Ms Himsworth around the potential for goodwill to attach to unincorporated associations and to potentially to remain with the "last man standing", I find that I am far from satisfied that the evidence in the present case establishes that GSUK is the proprietor of an earlier right. I reach that conclusion having in mind the following points.
89. I agree with Ms Jones that there are various hurdles that GSUK must overcome to succeed with its claim based on passing off: firstly, the proprietor of an earlier right – the locus and owner of the goodwill - must be clearly identifiable, whether as an individual, or organisation or defined association; it must then be shown that the identified party has used a claimed name or sign over a period of time and that the party has carried out activity – providing goods or services – under and by reference to that sign.

Identity of claimed proprietor

90. The Opponent / Proprietor in these proceedings is GSUK. This is a charity that did not exist as an entity until it was registered as a charity on 30 September 2019 – some time after the filing dates of the parties’ marks at issue. The submitted position is that Junaid Akhtar, having worked alongside his father and grandfather, became the individual beneficiary of goodwill, dating from at least 1975, generated by those people under the sign “GHAMKOL SHARIF” for all of the claimed goods and services.
91. Perhaps the strongest anchor for this claim is that Sufi Sahib was the most prominent figurehead of the movement in the UK.
92. Despite various denials on the part of the Applicant that Sufi Sahib was “Khalifa e Azam”, which I understand to translate approximately to “head leader”, there are numerous references in the evidence, including from parts of the Applicant’s own evidence, that that is precisely how he was described. The phrase appears, for instance, on his memorial stone, where he is laid to rest in the grounds of the Applicant’s mosque.³³ It was Sufi Sahib who oversaw important aspects of the funeral of Zinda Pir in Pakistan, and it is Sufi Sahib whose passing attracted coverage in the Birmingham press and whose own funeral drew the attendance of thousands. The press coverage emphasises his community prominence and his being a driving force behind the construction of the large mosque, and instrumental in the neighbouring community centre and hostel for homeless people.³⁴
93. However, there is evidence from both sides Sufi Sahib was not the first Khalifa of the movement in the UK, when he arrived in 1962, nor even in Birmingham. There were two other Khulafa even in the small management committee supporting the work from 38 Warwick Road from 1975, and taking forward the developments at Golden Hillock Road. Paragraphs 27 and 28 of the witness statement of Khalifa Fazal Illahi, state that he and other khulafa carried out similar duties to Sufi Sahib. Mohammed Imran Talib - son of Khalifa Mirza Talib Hussain, who was one of the management committee at 38 Warwick Road and one of the four founding trustees of the Applicant – gives evidence that the teachers at 38 Warwick Road included Sufi Sahib, Khalifa Mirza Talib Hussain and Khalifa Fazal Illahi, and that he (Mohammed Imran Talib) himself helped younger children in learning Qur’anic Arabic. Khalifa Mirza Talib Hussain is stated to have provided catering,

33 Exhibit MJA13 to Akhtar 2.

34 Exhibit MJA1 to Akhtar 1.

cooking for events both at Warwick Road and Golden Hillock Road.³⁵ There does not appear to be a clear formal structure to the movement delineating lines of organisation, responsibility and membership. While it may rightly be said that Sufi Sahib became the most prominent Khalifa, and that in the UK, the movement became most identified with the location in Birmingham,³⁶ I do not find that any goodwill associated with the name Ghamkol Sharif in respect of *providing goods and services* could be said to have been his alone, despite his most significant and leading contributions to the movement in the UK.

94. As to the work and profile of Sufi Javed, the evidence filed by GSUK reveals very little. He is shown to have been a long-standing trustee of the Applicant; to have interacted in ceremonial ways with the Pakistan movement, and to have presided at events to mark “the Golden Legacy” of his father, Sufi Sahib. Therefore, following the death of Sufi Sahib in 2015, still less can it be said that Sufi Javed was the individual, exclusive beneficial proprietor of goodwill associated with the name Ghamkol Sharif in respect of the provision of goods or services. This is despite Sufi Javed having himself been a long-standing Khalifa in the movement, and having worked alongside and perpetuated the work of his prominent father.
95. In legal terms the succession of goodwill cannot be readily founded *simply* on the basis of hereditary expectation, even if that were in some degree culturally sanctioned.³⁷ The goodwill would need to attach to an individual or individuals or an entity (here a claimed unincorporated association) that provided goods or services in the UK by reference to the sign. Since I have found that neither Sufi Sahib nor Sufi Javed could individually claim exclusive goodwill based on the sign, nor can Junaid Akhtar sustain such a claim, and nor can the Proprietor - the subsequently incorporated GSUK.
96. The evidence filed on the part of GSUK is comprised largely of broad narrative assertions and which I find insufficiently substantiated. There is no clarity as to the composition of

35 See paragraphs 13 – 19 of his witness statement.

36 This point is acknowledged at paragraph 10 of the witness statement of Mohammed Imran Talib for the Applicant.

37 I note that the witness statement of Pir Habib Ullah Shah refers to his having been nominated by his grandfather Zinda Pir as the custodian during his lifetime, this having been by his and elder brother and seemingly duly recognised by the Office of the Deputy Commissioner in Kohat. Likewise, some witness evidence attests to perceptions that Junaid Akhtar followed in the footsteps of his father and grandfather.

GSUK, despite references in the evidence to its existence prior to its 2019 registration. The social media evidence includes numerous references to the phrase (used as a handle or descriptor) but it is implausible on the evidence filed that the public perception would have been that GSUK was, in personam, Sufi Javed and Junaid Akhtar.

97. The evidence from the Applicant is that it was the younger generation (generally working in voluntary capacities for the Applicant) that handled the social media side of things, and that there were changes made without authorisation such that the Applicant “lost control” over aspects of the content. I do not overlook that the phrase “Ghamkol Sharif UK” appears to have been deployed in social media for a number of years, and that the Applicant appears either not to have noticed that development or failed to take prompt effective action against it. However, I do not give great weight to the social media evidence for three reasons.

(i) Firstly, there is clearly a degree of retrospective effect, which the Applicant (alone) highlighted, which means that some of the evidence is misleading on its face. The Applicant’s website and Facebook were clearly not originally marked with Ghamkol Sharif UK.

(ii) Secondly, the Opponent is not relying on the use of the sign “Ghamkol Sharif UK”, but on the sign “Ghamkol Sharif”. So even if there are public-facing references to “Ghamkol Sharif UK”, that alone is not sufficient to conclude that there was an identifiable entity of that name.

(iii) And thirdly, there is such an intermingling of content in the social media content, touching on references to the movement and remembrance of Sufi Sahib and Zinda Pir, but also prominently highlighting the Applicant’s mosque and Education Centre, and general religious and education services, that it is not possible to reliably perceive that *an entity* called Ghamkol Sharif UK bears responsibility for the provision of goods/services, as opposed to an impression that the offerings are associated with adherents to a spiritual movement.

98. For instance, I note that Umar Hussain states that he is a volunteer and project manager at the charity Ghamkol Sharif UK, in which role “he has been responsible for all media-related issues for the charity from 2010 to the present”. Since the charity GSUK did not exist until 2019, Mr Hussain must be taken as stating that his role was working for the

charity GSUK in an unincorporated form. Indeed, at paragraph 4 he repeats the position claimed by the Opponent that any reference to the charity Ghamkol Sharif UK (“GSUK”) “should be taken to include the earlier activities of Sufi Sahib, Sufi Javed and Junaid Akhtar.” Despite that direction, it is still not clear what was the composition of the charity he states he worked for 2010 – 2019,³⁸ or what was its separate media content for which he was responsible. The evidence he exhibits at Exhibit UH03 offers no insight on such separate content: the second page of the exhibit is from after the relevant date; the first page (the only other page exhibited) is a November 2021-generated copy of a Facebook page.³⁹ The latter Facebook page shows a post bearing the date 17 July 2012 and is marked GhamkolSharif UK @ghamkolsharifuk and is said to show the first posting of the Logo mark. However, as I have noted, at July 2012, the Facebook profile would not have read Ghamkol Sharif UK – it would have read “Central Jamia Mosque Ghamkol Sharif Birmingham Events”, squarely representing the Applicant’s social media profile.

Lack of clarity as source of goods / services

99. Not only does the evidence fail to achieve clarity in the *composition* of the Proprietor (GSUK) prior to its registration as a charity, there is no clear evidence as to who was responsible for the goods and services it claims to have provided and in respect of which it claims goodwill. Its claimed goods and services include for instance: religious books; calendars; housing management; religious education services; arranging musical and theatrical events; catering services; provision of food and beverages; hiring of rooms for social functions; marriage counselling; funeral services. The evidence suggests that some of these are in fact more clearly attributable on the evidence to the Applicant.
100. I find there is a notable lack of objective documentary evidence to show that GSUK in the form of an unincorporated charity or association, or that any of the three individual family members (Sufi Sahib, Sufi Javed or Junaid Akhtar) bore responsibility for or directly provided the goods and services claimed. The most that can be said is that those individuals have presided over certain events or celebrations connected to the Movement and that Sufi Sahib had a central role on its spiritual aspects in the UK.⁴⁰ Perhaps, most

38 I note too that Yasser Khan refers in his witness statement to there being a small team, which grew over time.
39 (It is not clear whether it was a page that reached an external audience, since the URL descriptor ends “page=internal” and where the “shares” total just 1.)

40 See, for instance, UI-Haq-2 at paragraph 34.

notably, the Proprietor has not explained or documented – at all - on what it spent its considerable claimed annual income or shown that funds raised were directed to or paid from the bank account of a separate entity equating to GSUK.⁴¹

101. This is the case even where there are specific claims as to discrete provision made on the part of GSUK – for instance the Subha Academy and the claimed partnership with the Applicant’s Ghamkol Sharif Education Centre. Mr Akhtar does not furnish clear evidence to support his contention that there was a partnership – for example there is no written agreement, no service level agreements, no supporting email correspondence or minutes of meetings referencing such an arrangement, no documented division of labour, or execution of related tasks. Mr Akhtar gives no clear explanation as to why GSUK was unable to fund matters itself, either from the fee income or from the very considerable contributions he claims were collected each by GSUK. Akhtar 2 refers to a later change of name of the Applicant’s Ghamkol Sharif Education Centre to City of Knowledge Academy, as shown in Exhibit MJA26, which shows posters from November 2019. I note that this evidence is after the relevant date and does not anyway undermine the earlier identity and existence of the Applicant’s Ghamkol Sharif Education Centre.
102. I note that in support of its argued case (even at counterstatement stage) that GSUK and the Applicant have always been separate entities, it places some emphasis on the text of posters (some in translation from Urdu and dating from the 1980s) where acknowledgement for the organisation of the advertised event is given to the “management committee of Dar Ul Uloom Islamia Rizwia and Helpers of Darbar E Alia Naqshbandiya Ghamkol Sharif”.⁴² (Similar references are made in respect of calendars.) I do not find that this demonstrates the claimed distinction and separation of entities. References to “darbar e aaliya ghamkol sharif” (or similar) is simply a reference to the Movement. The management committee of the Applicant (Dar Ul Uloom Islamia Rizwia) was essentially a transposition of the people who managed the ground floor of 38 Warwick Road and all were directly affiliated with the movement. This is not to say that the movement *is* the Applicant; a mosque is inclusive of all muslims whether or not they identify themselves with Ghamkol Sharif. However, it is the case that of the four founding

41 See Paragraph 41 of UI-Haq 2

42 See translation evidence on part of GSUK, including Witness Statement of Dr Ather Hussain, at paragraph 7(f) in connection with Exhibits MJA 27 and 28.

trustees of the Applicant charity, three were khulafa of the movement and the fourth a follower.⁴³ In the late 1990s, following the death of one of the founding trustees, the four new trustees were also followers of the Movement (taking the number of trustees to its maximum of seven). It is clear that the Movement is at the core of the Applicant.

103. The Applicant's witnesses are better placed than GSUK's witnesses to give first hand evidence on this point and I am more convinced by the evidence from the Applicant that its work (through the developments at Golden Hillock Road) was essentially a continuation of work previously carried out at 38 Warwick Road. Just as at Warwick Road, the Applicant charity provided some services / activities going beyond the Movement - such as the provision of a mosque – but overall it may be seen as a continuation of the religious, spiritual and community work the followers and khulafa of the Movement were already doing. The Proprietor repeatedly claims that the separation of the activities of the Proprietor from the Applicant's activities has always been clear, but taking the evidence in the round, I do not find that to be the case. This is primarily because I have found no clear 'entity' separate from the Applicant, owning goodwill in the signs, but I also find that the claimed goods and services in evidence are not readily separated between those that are Movement-specific and those that are of wider interest to the Muslim community.
104. I also note the point made by Ms Jones that whilst the Applicant's statement of case for its invalidity claim asserts ownership of goodwill in GHAMKOL SHARIF since 1998/1999 (and the GS Logo since 2012) this is because, it is from this date that the Charity was both formally registered and 'formally' using the name GHAMKOL SHARIF following the naming and signage of the Applicant's large mosque as 'Central Jamia Mosque Ghamkol Sharif'. To the extent that the activities originating at 38 Warwick Road generated goodwill under and by reference to GHAMKOL SHARIF, such goodwill may reasonably be taken to have been transferred to the Applicant. Evidence in support of this is found in the Applicant's 1986 Trust Deed which states:

43 UI Haq1 at paragraph 67

“WHEREAS

- 1. For some time passed there was established at 38 Warwick Road, Sparkhill, Birmingham, U.K. aforesaid a Mosque and School for the advancement of the religion DAR UL ULOOM ISLAMIA under the direction of the Trustees.*
- 2. There has been a general expression of desire on the part of many persons professing the said faith of DAR UL ULOOM ISLAMIA and living in the neighbourhood of Great Tyseley Sparkhill Small Heath and surrounding areas in Birmingham aforesaid that the said Mosque and the School should be expanded and developed and in pursuance of such desire the Trustees are resolved established a Charity for the purpose hereinafter appearing.*
- 3. The Mosque and School were formerly held and carried on upon the freehold property of first trustees AL-HAJ SHAIKH MUHAMMAD ABDULLAH KHAN being Number 38 Warwick Road, Sparkhill, Birmingham aforesaid. But by virtue of Deeds of Transfer bearing date 10 May 1984, 14 June 1983, 7 October 1983 respectively the Trustees have purchased on behalf of the Charity land and premises at Golden Hillock Road, Sparkhill, Birmingham aforesaid number 107, 109, 111, 113a and 113b for the purposes of the erection of a new and larger Mosque and School.*
- 4. The Mosque and School has been and is now carried on upon the said premises in Golden Hillock Road, Sparkhill, Birmingham which the Trustees hereby declare are held by them upon with and subject to the Charitable trusts power and provisions hereinafter contained.”*

105. I agree that it is clear from the above wording that the Applicant purpose was and is to continue the services, namely the mosque and the school, carried out at 38 Warwick Rd. There is no carving out / exceptions provided for any services relating to the Movement/Ghamkol Sharif. Sufi Sahib was a member of the management committee at 38 Warwick Road, which transposed to become the founding trustees of the Applicant. Aside from references to counselling from Sufi Sahib’s home address of 38 Warwick Road– much as other Khulafa provided at their homes - GSUK provides no evidence of clear services being provided by Sufi Sahib or Sufi Javed (also a trustee of the Charity from 1997 until his death in 2018) outside of those in line with the explicit educational and mosque services facilitated by the Applicant in line with the objects of the Charity.

106. The activities at Warwick Road are poorly documented, and notwithstanding that it continued as a mosque / madrassa and correspondence address, the references in the evidence to 38 Warwick Road do not establish the existence of a separate entity to which GSUK is the beneficial successor. It is also understandable that 38 Warwick Road was not transferred to the Applicant, because its top two floors served as the home address

of Sufi Sahib and his family. The repeated references on various posters and occasional invoices (including the Print Xpress invoice) to contact details at 38 Warwick Road is entirely understandable since Sufi Sahib was a founding trustee of the Applicant and would naturally receive correspondence at his home address. Sufi Sahib, his son and his grandson were all trustees of the Applicant and leading figures in the movement Darbar e Aaliya Ghamkol Sharif.

107. For the reasons I have set out, I reject GSUK's claim that at the relevant dates it was the proprietor of a still earlier right that defeats the Applicant's earlier right. In the circumstances, use of the signs by the Applicant was not therefore dependent on the consent of the Proprietor.

Consequences of my findings based on section 5(4)(a)

108. The outcome of my findings above is that the Applicant succeeds in respect of the core issue on which the hearing focussed. There are other grounds that I will consider shortly, but insofar as the parties' claims were brought under section 5(4)(a), based on passing off, the Applicant's success on this ground entails the following consequences:

- i. **the Opponent's earlier mark is invalid.** It is enough to note that the Applicant succeeds on its section 5(4)(a) ground based on use of the words "GHAMKOL SHARIF", whether or not the Applicant additionally succeeds based on its use of the logo sign.
- ii. **The Opponent's own objection under section 5(4)(a), which relies only on the words "GHAMKOL SHARIF", simultaneously fails.**
- iii. In the absence of a valid earlier trade mark, the **Opponent's claims under sections 5(1), 5(2)(a), 5(2)(b) and 5(3) must fail.**

The copyright claim

109. I turn next to consider the opposition claim by GSUK that it owns the copyright in the Logo, such that the Logo Application Mark may not be registered as a trade mark by the Applicant.

110. Section 5(4)(b) of the Act provides that a trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented by virtue of an earlier

right including by virtue of the law of copyright. The section also states that “A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.” As I have noted earlier, there is no disagreement that the Logo constitutes a copyright work. Nor is it disputed that the Logo Mark applied for and is the essentially the same as the Earlier Mark. The dispute is over who may be considered to own the copyright in the work.

111. GSUK gives evidence on this claim at paragraph 67 of Junaid Akhtar’s first witness statement. He states that the logo was commissioned from Print Xpress instructed by Umar Hussain in March 2012, and that it was “formally assigned to GSUK on 6 November 2019.” He states that “Umar Hussain and his family are followers of Sufi Sahib” and that “Umar was one of the leading mureeds and main volunteers of GSUK, would give feedback on events to Sufi Sahib, and acted upon Sufi Sahib’s advice and instructions” and that he is now a friend of Junaid Akhtar and is chairman of Ghamkol Sharif Manchester.⁴⁴ Evidence in support of this claim also comes from Exhibits MJA38 and MJA39 and the witness statements of Umar Hussain and of Aftab Khan, on all of which I will comment shortly.
112. Akhtar 1 states that “Exhibit MJA38 is the Print Xpress invoice from March 2012 to Umar Hussain.” (my underlining)
113. Later in the proceedings, on 22 November 2021, a witness statement was filed from Umar Hussain. It states that in March 2012 Sufi Sahib asked Umar Hussain to take charge of a project to create a logo to identify GSUK services (not those of the Applicant) “so that his followers and public could easily identify the GSUK activities and work.” Umar Hussain states that he (Umar) was always aware of the clear distinction between the two parties’ services, and “the creation of the mark logo was for the benefit of GSUK and in no way for the Applicant.” Umar Hussain states that contrary to Ul-Haq1 at paragraph 82, he was not acting under the directions and instructions of the Applicant but rather under those of Sufi Sahib for GSUK.
114. Umar Hussain explains the stipulations he expressed to Print Xpress: that the logo should include “the words Ghamkol Sharif in Arabic, with the design of a Dome (which is typically

44 A mureed is a disciple or follower.

used in mosque architecture) to be incorporated into that Arabic script”, with the English translation below the Arabic words. He states that it was he and Yasser Khan who went to Print Xpress to monitor and approve the design. Mr Hussain states at paragraph 15 of his witness statement that Exhibit UH01 is “a copy of the invoice”. The document at UH01 is the same as at Exhibit MJA38. It purports to be an invoice, and is shown to be directed to “Umar Hussain, Mosque Ghamkol Sharif, 38 Warwick Road” and the description refers to “Ghamkol Sharif Logo”, and is dated 15 March 2012, for £180. Mr Hussain states that he subsequently paid the invoice out of his personal funds as a donation to GSUK.

115. On behalf of the Applicant, on 22 December 2021, a third witness statement of Ahsan Ul-Haq was filed, with further exhibited material, to respond to the above later filed evidence from Umar Hussain. One of the points raised in Ul-Haq 3 expressed the Applicant’s belief that the document at Exhibit UH01 (as at Exhibit MJA38) had been “drawn up after the event and was not a genuine invoice.” This conclusion is based on a comparison between copies of invoices from Print Xpress in 2008 and 2009, filed in evidence by the Applicant,⁴⁵ where the addressee is shown as “Ghamgol Sharif Mosque, United Kingdom” or “Ghamgol Sharif Mosque, 150 Golden Hillock Road”, and where the contact is shown as “Yasser”. The differences between those invoices to the Applicant, and the invoice filed as Exhibit UH01 / MJA38 include: (i) the omission from the latter of the logo and strapline for PrintXpress; (ii) omission of any terms of payment “*50% deposit required at time of placing order. Cleared funds required before collection of goods*”; and (iii) Print Xpress, though at the same address on Stratford Road, is shown in the UH01 document to have a different company registration number and VAT number from the invoices that the Applicant had filed. The Opponent’s document bearing the date 15 March 2012 showed Print Xpress as having registration number 11339214, whereas the Applicant’s exhibited invoices from 2008 – 2010 showed Print Xpress as having registration number 3592776.

116. In light of the Applicant’s questioning the inconsistencies in the document at Exhibit UH01 / MJA38 the Opponent filed the witness statement of Aftab Khan, dated 15 January 2022. I dealt with the admission of this late filed evidence as a preliminary matter at the hearing, and Mr Khan was put to cross-examination. Aftab Khan is the Managing Director of Print

45 Pages 69 – 73 Exhibit AUH1

Xpress Ltd (with the company number 11339214), which was registered on 1 May 2018. He is also a director of Malik Enterprises Limited, which has been registered under company number 3592776 since its incorporation on 30 June 1998, and which traded as Print Xpress until the registration of Print Xpress Ltd on 1 May 2018.

117. He states that where he refers in his witness statement to “GSUK”, it should be taken to mean “*Sufi Sahib, Sufi Javed, Junaid Akhtar and the volunteers who assisted with their work, together with charity Ghamkol Sharif UK.*” He states that “the Applicant and GSUK have been separate client accounts for many years.”
118. He states that the exhibit at UH01 was printed off from his computer systems following a request by Umar Hussain in October 2019 and that some of the details shown are more recent than the transaction itself because the details were generated by his computer system on the new company template, as the old one is no longer in use. He states that he clearly remembers the Logo as “a proud creation of his”. He confirms that Umar Hussain paid in cash; though no receipt is available owing to a change in computer management system in 2016, but his records show no outstanding debt on Logo creation work.
119. It was only from the account given in Mr Khan’s evidence that it became clear that the document at Exhibit MJA 38 / UH01 was not a true facsimile of a document from its shown date of 15 March 2012. Elements of it are indeed, as the Applicant highlighted in UI-Haq 3, from after the event. Despite Mr Khan’s account, based on the changes in an IT system, the reliability of the document is somewhat compromised by its post-facto generation. However, Exhibit UH02 shows two emails from Print Xpress seemingly to Umar Hussain, dated 28 May 2012 and 1 December 2012 that relate to delivery of the logo.
120. On the evidence in the round, I find that Umar Hussain was the point of contact for the logo creation and that the contact address appears from Exhibit UH01 to have been 38 Warwick Road.
121. However, I cannot find that Umar Hussain commissioned the logo on behalf of GSUK. I accept that he took instruction from Sufi Sahib, but I have not accepted that Sufi Sahib considered himself a unit separate/apart from his fellow khulafa in the UK or from his

fellow trustees at the Applicant charity that steered the primary vehicles through which the Movement provided goods and services here. The evidence is too thin and requires too much in the way of inference and supposition to accept that there was an unincorporated association to whom the benefit of the brand logo was intended to attach. I have found that there was no such association that was sufficiently identifiable as a separate entity.

122. The Applicant gave (unchallenged) evidence that it is a legal requirement to register a charity that has income of more than £5000 per year. I agree with the submission that as long-serving trustees of the Applicant charity, both Sufi Sahib and Sufi Javed would both have been very much aware of the importance of having a formal structure in place for a charity and would have understood compliance with charity law, yet there were no attempts to register GSUK until 2019.⁴⁶
123. I also note that in the cross-examination of Aftab Khan it became apparent that his witness statement that “the Applicant and GSUK have been separate client accounts for many years” was to be understood as meaning that they were not differentiated by named accounts, but that different clients were identified by way of address. However, that is shown not to have been a robustly reliable point of distinction. For instance, as mentioned above, one of the contemporaneous copies of invoices from Print Xpress in 2008 and 2009, filed in evidence by the Applicant, records the addressee as “Ghamgol Sharif Mosque, United Kingdom”. This clearly does not adequately identify a separate client account. Both 38 Warwick Road and 150 Golden Hillock Road have been referred to as Ghamkol Sharif mosque (or words close to that) which does not assist in a distinction. Nor does that fact that 38 Warwick Road was the home address of Sufi Sahib and that its ground floor was the base from which the work of the Applicant expanded and developed, with Sufi Sahib as a founding member and enduring trustee. Umar Hussain and Yasser Khan, who liaised with Print Xpress on the logo creation, were both volunteers for the Applicant at the time, and Yasser Khan is shown in the Applicant’s invoice evidence to have previously acted as a point of contact for the Applicant at 150 Golden Hillock Road. This further muddies any reliable perceptions.

46 See paragraphs 17d and e, and paragraph 42 of UI-Haq 2 and the extract from the UK Government website at pages 63-64 of AUH2.

124. Ms Himsworth criticised that the Applicant's position appeared to have shifted inasmuch as in the pleadings it was said that a group of volunteers working for the Applicant created the logo, but that UI-Haq1 (paragraph 82) is less clear as to the process under which the logo was created. I note that in each of his three witness statements,⁴⁷ Mr UI-Haq maintains that the Applicant commissioned the creation of the Logo, which he recalls from the time as a serving trustee of the Applicant charity, notwithstanding that he did not have close knowledge of the detail of who did what. I have found that Umar Hussain was indeed the point of contact, but for the reasons I have given, that does not establish that the logo was created for GSUK – I find the weight of the evidence points to it having been created for the Applicant.
125. Ms Himsworth also states, correctly, that there is no invoice produced by the Applicant in relation to the creation of the logo at all nor anything to show that they, at any stage, paid for any work for a logo to be created. Ms Himsworth contrasted this with the position of GSUK, where there is evidence both as to the commissioning and the payment in relation to the work that they claim was done on their behalf. However, since I find that GSUK did not as a matter of fact or law exist as a separate entity from the Applicant, I can give no weight to the perceptions of those who believed the logo to have been commissioned on its behalf.
126. Moreover, despite Umar Hussain's statement that in March 2012 Sufi Sahib had sought a logo to identify GSUK services and not those of the Applicant, so that his followers and public could easily identify the GSUK activities and work, I find that it telling that the logo created could not in any way achieve that claimed goal with any clarity. The logo includes a representation of a large mosque dome, as well as the name ("Ghamkol Sharif" in Arabic and English) that features prominently on the Applicant's central mosque; it is consequently clearly apt to signify services and goods connected with the Applicant.
127. The following poster is exhibited at AUH03 (by Ahsan UI-Haq), but which Aftab Khan states he printed at Malik Enterprises Ltd under GSUK's instructions:

47 Paragraph 82 of UI-Haq1; paragraph 39 of UI-Haq 2; paragraph 6e of UI-Haq3



The poster does include reference to the Twitter handle @ghamkolsharifuk, and to “Ghamkol Sharif presents” and to the supervision of Sufi Sahib. However, its focus is the Urs (the commemoration of a Sufi saint – Zinda Pir), the names of other participants do not include Sufi Javed (nor Junaid Akhtar), and nor do its other social media handles clearly communicate to the public that the activity or service is attributable to GSUK. The Applicant’s mosque is named as Ghamkol Sharif Masjid and it is its address that is given. Similarly, there are other examples in the evidence where promotional materials deploy the logo in the name of the Applicant’s education centre activities.

128. On the question of who therefore owns the copyright, I note the following:

- (i) Section 11 of the Copyright Designs and Patents Act 1988 deals with first ownership of copyright and provides that the first owner is the author of a work or where a literary or artistic work is made by an employee in the course of his employment, his employer (subject to any agreement to the contrary). An assignment of legal title to copyright is not effective unless it is in writing signed by or on behalf of the assignor.⁴⁸

48 Section 90(3) of the Copyright Designs and Patents Act 1988

(ii) I also note the content of Exhibit MJA39, which shows an assignment deed between “Print Xpress” (the trading name of Malik Enterprises, where the address given is that of the print business owned by Aftab Khan and his family) and “Ghamkol Sharif UK” signed by Aftab Khan and by Mohammed Hasnain Akhtar respectively (who is a trustee of the registered charity GSUK). Clause 2.1 states that the Assignor assigns to Ghamkol Sharif UK “with full title all intellectual property rights in the logo and the right to bring, oppose or defend any cause of action including passing off arising from ownership of the Logo whether occurring before or after assignment.” Further assurances are given in Clause 3 for the purpose of giving full effect to the Deed, and in Clause 4 Print Xpress gives a warranty that it is the sole creator of the Logo and are the sole legal and beneficial owner of all rights, and that it has full power and authority to enter into the Deed.

(iii) I note too, the criticisms from Ms Jones that it is not entirely clear whether Aftab Khan was personally the author (or whether the pride he expressed in his witness statement in relation to its creation derived from his business); that there is no firm evidence of his employment status within his company; that the assignment is made by “Print Xpress”, which is the *trading name* used both by Malik Enterprises Limited and by Print Xpress Ltd and it is unclear whether either of those companies was the owner of the copyright (based on the work of an employee); and the assignment document does not state which company is entering into this assignment, so there is uncertainty as to whether the assignor had the right to assign the copyright.

129. Since the assignment is signed by Mr. Khan in his capacity as director of the company trading as Print Xpress, and since Exhibit AUH3 shows him to be a director of both companies, Ms Himsworth invited me to find that the warranties and assurances within the assignment overcome the above criticisms made by Ms Jones in relation to the legal title. However, it is clear that the company trading as Print Xpress in 2019 was Print Xpress Ltd, not Malik Enterprises. The mere fact that Mr Khan is a director of both does not mean that he assigned the copyright on behalf of Malik Enterprises, or that Print Xpress Ltd acquired the copyright from Malik. In the absence of a clear account of how the later company came to own the copyright it purported to assign, it is not clear to me that the warranties are enough to ensure the validity of the assignment.

130. However, even if the assignment does effectively transfer legal title to the copyright to GSUK, I find that such legal title is held on trust for the Applicant. Whilst the author or employer of the author of a copyright work will become the owner of the legal title to the work, I accept that in relation to commissioned works the person or entity commissioning the work may become the full beneficial owner of the commissioned work by virtue of an implied term, and that such a term will be implied where the commissioned work is a trade mark logo.⁴⁹ The holder of the legal title to the copyright work will, in these circumstances, hold it on trust for the beneficial owner of the copyright and the beneficial owner is entitled to an assignment of the legal title to it.⁵⁰ I also accept, as Ms Jones submitted, that even before such an assignment, the beneficial owner is entitled to the remedies available under the 1988 Act as against the bare legal owner,⁵¹ and the beneficial owner would have a defence to a claim for infringement.⁵²

131. The equitable title is stronger than a legal title, and since I find that GSUK did not exist in 2012, and that Sufi Sahib's instigation of the commissioning of the logo (via Umar Hussain and Print Xpress), was, on the balance of probabilities, on behalf of the Applicant, it is the Applicant who has the right to (continue to) use the logo and to exclude others from using it. (This conclusion is based on my view that the Applicant appears on the evidence filed to have been at least the main user of the logo, the people who actually arranged for it to be created were volunteers of the Applicant (a clearly defined and established entity), and the very substantial interconnectedness of the Applicant with the Movement including Sufi Sahib). I therefore find that the Opponent's claim under section 5(4)(b) fails, because it could not prevent the Applicant's use of the logo under the law of copyright.

The allegations bad faith

132. I turn now to consider the parties' claims under section 3(6) of the Act that the applications for their respective had been made in bad faith.

133. Section 3(6) of the Act provides: "A trade mark shall not be registered if or to the extent that the application is made in bad faith."

49 *Griggs Group Ltd v Evans* [2005] F.S.R. 31 at [18] to [19]

50 *Ibid* at [6]. Also see: *Griggs Group Ltd v Evans* [2004] F.S.R. 31 at [34], the Trustee Act 1925 s.51 & Copinger and Skone James on Copyright 18th Edn at 5-225

51 Copinger at 5-225 and *Vitof Ltd v Alotft* [2006] EWHC 1678 (Ch) at [174]

52 Copinger at 5-227

134. There is no definition of “bad faith” in the legislation, rather the criteria for assessing “bad faith” have been set out in judgments of the Court of Justice of the European Union (CJEU) and UK Courts. Ms Himsworth and Ms Jones agreed on the relevant legal principles. Most recently in the Court of Appeal in Sky Limited (formerly Sky plc) v. SkyKick, UK Limited [2021] EWCA Civ 1121 Sir Christopher Floyd (with whom Nugee and Newey LJ agreed) summarised the approach as follows (case references added in footnotes):

“67. The following points of relevance to this case can be gleaned from these CJEU authorities:

1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: Lindt at [34].

2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: Malaysia Dairy Industries at [29].⁵³

3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: Lindt at [45]; Koton Mağazacılık at [45].⁵⁴

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: Hasbro at [41].⁵⁵

53 Case C-320/12 Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker EU:C:2013:435

54 Case C-104/18 P Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ EU:C:2019:724

55 Case T-663/19 Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening ECLI:EU:2021:211.

5. *The date for assessment of bad faith is the time of filing the application: Lindt at [35].*

6. *It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: Pelikan at [21] and [40].⁵⁶*

7. *Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: Hasbro at [42].*

8. *Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: Lindt at [37].*

9. *For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: Lindt at [41] – [42].⁵⁷*

10. *Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: Lindt at [49].*

11. *Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: Koton Mağazacılık at [46].*

12. *It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: Lindt at [51] to [52].*

56 Case T-136/11 pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening EU:T:2012:689)

57 Case C-529/07 Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH EU:C:2009:361; [2010] Bus LR 443

13. *Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: Psytech at [88], Pelikan at [54]*”.

135. It is necessary to ascertain what the applicant knew at the relevant date.⁵⁸ Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date.⁵⁹
136. I will deal first with the section 3(6) claim brought by GSUK. That claim is premised on:
- (i) the Applicant being fully aware of the long-standing rights and activities of GSUK under the name GHAMKOL SHARIF, which preceded the existence of the Applicant;
 - (ii) the Applicant being fully aware of the use by GSUK of the Logo since 2012, that the Applicant had not conceived of the Logo independently of GSUK, and that the Applicant should have appreciated that any use of the Logo Application mark would constitute an infringement of copyright and as such would infringe the interests of GSUK;
 - (iii) use of the marks by the Applicant prior to 2019 had been with the consent of GSUK and that no consent had been given by GSUK for the Applicant to make the trade mark applications in issue.
137. Given my earlier findings in respect of sections 5(4)(a) and (b) of the Act, wherein I effectively found that the Applicant had built up rights over time and was entitled to believe that it owned the UK goodwill in “Ghamkol Sharif” associated with (at least) mosque and education services, and that the Applicant may be considered the beneficial owner of the copyright in the logo, it must follow that the Opponent’s claim under section 3(6) cannot succeed. I turn therefore to deal with the section 3(6) invalidity claim made by the Applicant against the GSUK’s earlier registered mark.
138. I previously set out the Applicant’s bad faith claim at paragraph 17(f)(i)-(vii) in the pleadings section of this decision. I will deal first with allegation that there was bad faith on the part of Junaid Akhtar in making his trade mark application because it originally specified an enormous list of services, where, in respect of very many of which - for

58 *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch)

59 *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] R.P.C. 9 (approved by the Court of Appeal in England and Wales: [2010] R.P.C. 16)

instance, bob-sledding and cabin crew training - it is clear that there was no intention to use the mark.

139. Both counsel referred to parts of the recent Court of Appeal *Skykick* judgment that considered a lack of intention as a potential factor in establishing bad faith. I note that paragraph 23 of that judgment noted that “lack of intention to use could, in some circumstances, be relevant to and evidence of bad faith, but that if bad faith existed in relation to only some of the goods or services referred to in the specification of goods and services, then the mark was to be declared invalid only for those goods and services.” The Court of Appeal noted with respect to the judgment of the CJEU in the *Skykick* Case C-371/18 as follows:

70. Lack of intention to use is accordingly a factor which may be relevant to bad faith where there is no rationale for the application in accordance with the aims of the Regulation, and there are objective, consistent and relevant indicia of bad faith as defined in [77].

71. The Court does not expressly answer the third question in the terms posed by the judge, namely whether it constitutes bad faith simply to apply to register a trade mark without any intention to use it in relation to the specified goods and services. It is implicit, however, that the answer to this question is that it is not bad faith simply to apply to register without an intention to use. There will only be bad faith where the absence of intention to use is coupled with objective, relevant and consistent indicia of the additional positive intention identified in [77].

140. Paragraph 77 of the Court of Appeal judgment in *Skykick* highlights the difference between applying to register a specific category of goods or services with no intention of using the mark at all in relation to anything of that description, and an applicant who makes claim to a category which is wider than the goods for which he actually uses or intends to use the mark. In the first case there is a potential indication of bad faith, whereas the second case is fully consistent with a good faith description of the applicant’s use and intended use.

141. The judgment also considered the case law of the UK courts and tribunals and Sir Christopher Floyd concluded that:

80. I agree that such a cautious approach is mandated in all cases where bad faith is alleged, and that the concept of justification by considering whether there is an arguable claim to legitimate protection of the applicant's actual or potential business is a useful one.

142. Ms Jones argued that it is irrelevant that the great majority of the specification was surrendered on 16 June 2021. Ms Jones notes that that happened after these proceedings commenced and argued that it does not change the intent as at the date of the application of the Earlier Mark or erase bad faith existing at that date, but that the breadth of the specification applied for indicates that the initial application was a blocking application with no honest intentions to it at all. Ms Jones also argued that it is not excused by Junaid Akhtar's statement in evidence that he was unrepresented at the time of filing. While I take Ms Jones' point that it is easy to read a specification and determine whether or not you want to register a mark for a service or not, I do not accept that the breadth of the original application/registration warrants a finding of bad faith in this case. Certainly, the remaining registered services by the time of the hearing are ones in which Junaid Akhtar might have had an interest in pursuing by reference to the sign. I do not doubt Junaid Akhtar considered that he had personal interests in the mark in view of the strong family connections to the Movement, especially through his grandfather. I find that the original breadth of specification was more likely attributable to lay unfamiliarity with trade mark registration process than to any sinister motive.

143. I wish to record that several factors have proved challenging in this decision, including: the volume of the evidence, various unfamiliar terms and concepts; various conflicting averments; the existence of strong connections between individuals; elements of tradition, oral transmission and the lack of formality as to certain aspects of the Movement; and the voluntary nature of contributions made by those providing relevant services. There are doctrinal or at least practice differences particular to the Sufi movement, including variations in the version developed and promulgated by Sufi Sahib from Birmingham. It is difficult for this tribunal to gauge reliably the significance of those differences or the extent to which they draw individuals to engage with the goods and services that have been provided by reference to the sign Ghamkol Sharif. It is also clear from the evidence that there remain people for whom Sufi Sahib was a pivotal figure and most prominently associated in the UK with the sufi movement Ghamkol Sharif. These

include, understandably, his grandson, Junaid Akhtar, but also others who were drawn into affiliation with the Movement by Sufi Sahib. Such people, I have no doubt, sincerely wish to perpetuate his good memory and legacy as they see it. The reasons why the Applicant has succeeded as I so far found in this case, despite the Opponent/Proprietor having taken assignment of an earlier registered trade mark, boil down essentially to (i) the Applicant has been able to show that it was an identifiable body, providing relevant identifiable goods and services under its claimed distinctive signs, whereas (ii) the Proprietor has not provided sufficiently clear evidence to support its claims to be owner of a trumping earlier right, since it has not shown that it was an identifiable unincorporated association that provided the goods and services enjoying goodwill under the name Ghamkol Sharif.

144. However, whether Junaid Akhtar was acting in bad faith must be the subject of an overall assessment, taking into account all relevant factors particular to the case. In my view, the subjective perceptions of Junaid Akhtar, which I acknowledge to have been shared by others who have given evidence in support of the Proprietor, are not sufficient to justify the trade mark application in his own name, to be then passed to the latterly registered charity GSUK. He was undoubtedly very aware of the Applicant's use of and interest in the Logo and the name. He was laying claim to a mark in which the Applicant had acquired goodwill through use, and the copyright of which I have also found the Applicant to be the beneficial owner.

145. Moreover, he bore the responsibilities and duties of a trustee at the Applicant, a position to which he was appointed shortly before he applied for the Earlier Mark, and in which remained for months thereafter.⁶⁰ The Applicant's evidence included extracts from the Charity Commission's essential guidance for trustees.⁶¹ The obligations of a trustee include working in the best interests of the charity (the Applicant), including avoiding putting oneself in a position where the trustee's duties conflict with personal interests or loyalty to another person or body. The evidence does not show that Mr Akhtar even informed the Applicant of his trade mark registration and nor does it show that he took steps to address the conflict of interest. I find that such conduct falls short of the

60 See Exhibit AUH1 pages 144 – 148. The assignment of the Earlier Mark to Umar Hussain on 8 July 2019 and the assignment from Mr Hussain to GSUK on 13 November 2019 both took place whilst Junaid Akhtar was still a trustee of the Applicant.

61 Exhibit AUH1 pages 149-158

standards of acceptable commercial behaviour observed by reasonable and experienced men in the field in which the applicant operated at the relevant time such that the application, was in that regard, made in bad faith. **The Earlier Mark is therefore also invalid on the basis of the Applicant's section 3(6) objection.**

OVERALL OUTCOMES

146. GSUK has failed on all of its grounds claimed in Opposition 419119 against the Word Application Mark and Opposition 419120 the Logo Application Mark. Consequently Application No. 3423237 and Application No. 3423235 may both proceed to registration in respect of all of the goods and services applied for in Classes 16, 36, 41, 43 and 45.
147. The application under CA503243 for a declaration of invalidity in respect of the earlier mark registered in the name of Ghamkol Sharif UK succeeds on grounds under section 5(4)(a) and section 3(6) of the Act. Consequently, by virtue of section 47(6) of the Act, trade mark registration No. 3388116 is deemed never to have been made and is cancelled as from the date on which it was filed (30 March 2019).

COSTS

148. At the hearing, I asked for submissions on costs from both side's counsel. Ms Himsworth stated that GSUK requested only costs in accordance with the scale published in the annex to Tribunal practice notice (2/2016). Ms Jones stated that her client would seek an order for costs off the scale to reflect the further work that the Applicant has been put to as a result of the Applicant's exceeding guidelines on volumes of evidence and having given rise to additional rounds of evidence. In response to Ms Jones's submissions, Ms Himsworth invited me to reserve the position on costs, adding that her client would resist a request for an order for off-scale costs.
149. I have considered the merits of the above and do not consider that the conduct of the case by the Opponent warrants off-scale costs. However, the number of grounds raised across these consolidated proceedings have entailed a considerable amount of work, and the evidence has been exceptionally extensive, particularly on the part of GSUK and there have been more rounds of evidence than is usual. The award of cost will reflect these points and the upper-end of the scale.

Official fee for filing the application for invalidity	£200
Preparing statement of grounds and reviewing the counterstatement:	£650
Reviewing the statement of grounds and preparing counterstatement in the opposition (noting both the overlap and difference in the grounds of opposition)	£1200
Preparing evidence and considering and commenting on the other side's evidence across the proceedings, noting the provision for an increase within scale in exceptionally large cases.	£4000
Preparing for and attending a hearing	£1600
Total	£7650

- (i) I order Ghamkol Sharif UK to pay Dar Ul Uloom Islamia Rizwia (Bralawai) the sum of £7650 (seven thousand six hundred and fifty pounds). This sum is to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 29th day of June 2022

Matthew Williams

For the Registrar