

O-473-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 3117948
BY SUN MARK LIMITED TO REGISTER THE TRADE MARK**



IN CLASS 3

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO 405426
BY HAYAT KINYA SANAYI A.S.**

Background and pleadings

1) On 15 July 2015 (the “relevant date” in these proceedings), Sun Mark Limited (“the applicant”) applied to register the following mark



2) It was accepted and published in the Trade Marks Journal on 7 August 2015. The specification of goods was subsequently voluntarily limited and it is this limited specification that identifies the goods at issue in these proceedings. They are:

Class 3: *Household bleach only*

3) Hayat Kinya Sanayi A.S. (“the opponent”) opposes the mark. On page 3 of the opposition form it did not tick any of the boxes that indicate that the opposition is based upon section 3 or section 5 of the Trade Marks Act 1994 (“the Act”), but rather, it ticked the final box to indicate “opposition based on other grounds”. However, on the next page (Section E) it ticked the box indicating grounds based upon “Section 5(1), (2), (3)” (where the opponent is “claiming protection for an earlier trade mark under Section 6(1)(c) which is a well known trade mark as defined in Section 56(1)”. The opponent goes on to provide the following details regarding the nature of its grounds of opposition:

Well-known mark: BINGO (word) and BINGO (stylised) [See continuation sheet]

The Opponent relies upon its use of its BINGO trade marks for a range of homecare and cleaning products which are identical and similar goods to those claimed in the application.

The Opponent's BINGO trade marks have been used to such an extent that they are well-known marks in accordance with the requirements of Section 56(1) and can be relied upon in these proceedings as earlier trade marks as defined by Section 6(1)(c).

The Opponent submits that the applied-for mark is identical and highly similar to its well-known BINGO trade marks and the goods claimed in the application are identical and highly similar to the goods for which the BINGO trade marks are well known.

As a result, the Opponent submits that use of the applied-for mark by the Applicant would cause confusion.

4) The earlier mark relied upon by the opponent is shown below:



5) Grounds based upon section 5(2) and section 5(3) both have the requirement for the opponent to be the owner of an earlier mark. Section 6(1)(c) defines an "earlier mark" as including "a trade mark which [at the relevant date] was entitled to protection under the Paris Convention as a well known trade mark". The opponent elaborates its grounds in the following way:

"... the applied for mark is identical and highly similar to its well known ...mark and the goods claimed ... are identical and highly similar to the goods for which [its mark is] well known. As a result, the Opponent submits that use of the applied for mark by the Applicant would cause confusion" [my emphasis]

6) The language of these grounds is repeated in written submissions provided on behalf of the opponent. It also filed evidence but this deals solely with the issue of demonstrating that its mark is well known within the meaning of section 56(1).

7) The applicant filed a counterstatement, stating that "(it) believes that visually, aurally and conceptually [the] applicant's mark is dissimilar to the Opponent's mark". The applicant also filed evidence and this is also limited to addressing the issue of whether the earlier mark is well known.

8) Taking all of this into account, whilst not expressly stated, both sides appear to have proceeded on the basis that the opposition is based upon Section 5(2) of the Act. However, I keep in mind that section 5(3) may be relevant to my considerations.

9) I will summarise the parties' evidence to the extent that I consider it appropriate/necessary. No hearing has been requested by either side and I make my decision after careful consideration of all the papers.

Opponent's Evidence

10) This consists of a witness statement by Graeme Murray, registered Trade Mark Attorney and an Associate of WP Thompson, the opponent's representative in these proceedings. He states that the information contained in his statement has been provided by the opponent's Turkish attorneys.

11) Worldwide turnover under the opponent's BINGO mark is provided for the years 2010 to 2015. No denomination is indicated, but the figures vary between about 11.6 million and 18.6 million.

12) Mr Murray states that between 2011 and 2016, the opponent has spent approximately £10 million promoting the goods sold under its BINGO mark.

13) Mr Murray states that the opponent's website bingohomecare.com is available in English and extracts from the website are provided at Exhibit GM1 to demonstrate this. These pages show goods such as laundry care products, washing up and dishwasher products and surface cleaners. The packaging of these products all show a BINGO mark as the most prominent part of the packaging, but its stylisation is slightly different to that relied upon and only the first letter is shown as a capital (and shown in paragraph 4, above)

14) Mr Murray states that the mark is registered "in a significant number of countries worldwide". A list of these registrations is provided at Exhibit GM2. This lists about 120 registrations in numerous countries in South and Central America, Africa, the

Middle East and Far East as well as some countries in Eastern Europe, and also New Zealand, Australia, China and a number of ex-Soviet states such as Ukraine, Uzbekistan, Latvia and Azerbaijan.

Applicant's Evidence

15) This takes the form of a witness statement by Harmeet Ahuja, Director of the applicant. Mr Ahuja makes many criticisms of the opponent's evidence. These are submissions that I will keep in mind, but I will refer to them later, as relevant, later in my decision not detail here. The evidence of fact provided by Mr Ahuja can be summarised as follows:

- Exhibit HA1 consists of printed pages of searches conducted on 24 June 2016 on www.eBay.com for "Bingo fabric conditioner" (no listings), "bingo foam booster" (no listings), "bingo fabric conditioner" (one hit from Australia on page 6 of 7 pages of results), "bingo surface cleaner" (no listings), "Bingo surface cleaner" (no listings), "bingo washing powder" (no listings) and "Bingo washing powder" (no listings);
- Exhibit HA2 consists of printed pages of the first page of a search on the Google search engine for "washing powders". Mr Ahuja states that he "cannot definitely state that the search did not contained any reference to Bingo washing powders in following webpages, none were visible to me from the results which the web crawler considers most relevant to the search term."

Opponent's claim that its sign qualifies as a well known mark

16) Section 56 of the Act reads:

"(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who-

(a) is a national of a Convention country, or

(b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on business, or has any goodwill, in the United Kingdom. References to the proprietor of such a mark shall be construed accordingly.

(2) The proprietor of a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark which, or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

This right is subject to section 48 (effect of acquiescence by proprietor of earlier trade mark).

(3) Nothing in subsection (2) affects the continuation of any bona fide use of a trade mark begun before the commencement of this section.”

17) In his decision in *Le Mans Autoparts Limited v Automobile Club de l'Ouest de la France (ACO)* O-012/05, Richard Arnold QC, sitting as the appointed person, identified the WIPO Joint Recommendation concerning the Protection of Well-Known Marks as detailing the relevant test for assessing if a trade mark qualifies as a “well-known mark” and he later endorsed this view when sitting as a high court judge in *Hotel Cipriani SRL et al v Cipriani (Grosvenor Street) Limited et al* [2008] EWHC 3032 (CH). The relevant extract from *Le Mans* is reproduced below:

“59. In September 1999 the Assembly of the Paris Union for the Protection of Intellectual Property and the General Assembly of the World Intellectual Property Organisation (WIPO) adopted a Joint Recommendation concerning Provision on the Protection of Well-Known Marks. Article 2 of the Joint Recommendation provides:

(1)(a) In determining whether a mark is a well-known mark, the competent authority shall take into account any circumstances from which it may be inferred that the mark is well known.

(b) In particular, the competent authority shall consider information submitted to it with respect to factors from which it may be inferred that the mark is, or is not, well known, including, but not limited to, information concerning the following:

1. the degree of knowledge or recognition of the mark in the relevant sector of the public;
2. the duration, extent and geographical area of any use of the mark;
3. the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
4. the duration and geographical area of any registration, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;
5. the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities;
6. the value associated with the mark.

(c) The above factors, which are guidelines to assist the competent authority to determine whether the mark is a well-known mark, are not pre-conditions for reaching the determination. Rather, the determination in each case will depend upon the particular circumstances of that case. In some cases all of the factors may be relevant. In other cases some of the factors may be relevant. In still other cases none of the factors may be relevant, and the decision may be based on additional factors that are not listed in subparagraph (b), above. Such additional factors may be relevant, alone, or in combination with one or more of the factor listed in subparagraph (b), above.

(2)(a) Relevant sectors of the public shall include, but shall not necessarily be limited to:

- (i) actual and/or potential consumers of the type of goods and/or services to which the mark applies;
- (ii) persons involved in channels of distribution of the type of goods and/or services to which the mark applies;
- (iii) business circles dealing with the type of goods and/or services to which the mark applies.

(b) Where a mark is determined to be well known in at least one relevant sector of the public in a Member State, the mark shall be considered by the Member State to be a well-known mark.

(c) Where a mark is determined to be known in at least one relevant sector of the public in a Member State, the mark may be considered by the Member State to be a well-known mark.

(d) A Member State may determine that a mark is a well-known mark, even if the mark is not well-known or, if the Member State applies subparagraph (c), known, in any relevant sector of the public of the Member State.

(3)(a) A Member State shall not require, as a condition for determining whether a mark is a well-known mark:

- (i) that the mark has been in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, the Member State;
- (ii) that the mark is well known in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, any jurisdiction other than the Member State; or
- (iii) that the mark is well known by the public at large in the Member State.

(b) Notwithstanding subparagraph (a)(ii), a Member State may, for the purpose of applying paragraph (2)(d), require that the mark be well known in one or more jurisdictions other than the Member State.

60. Two points of interest emerge from Article 2 of the Joint Recommendation. The first is that the list of six criteria contained in Article 2(1)(b) is not inflexible, but provides as it were a basic framework for assessment. The second is that *prima facie* the relevant sector of the public consists of consumers of and traders in the goods or services for which the mark is said to be well known.”

18) I need to consider if the mark BINGO benefits for enhanced protection by virtue of being a well known trade mark in the UK in respect of “homecare and cleaning products”. The opponent’s evidence is somewhat sparse in providing the necessary support to this claim. Mr Ahuja, in his witness statement, made a number of valid criticisms of this evidence. He submitted that it is insufficient because it does not illustrate the extent of use of the mark nor the level and distribution of sales revenue. The opponent has provided global turnover figures but the denomination of these figures is unknown and is not supported by invoices or other documents that might support the claim. I would add to this that the goods for which the mark has been used are household and cleaning products. The opponent has not explained why its mark is well known to UK consumers. Such goods are not routinely sourced from abroad and, consequently, the UK consumer is not likely to be the consumer for these goods. Neither are such goods the type of products that the UK consumer likely to purchase whilst on holiday abroad. Mr Ahuja points out that the opponent has not provided any evidence regarding the degree of knowledge of the consumer. This is an important issue, particularly because the nature of the goods alone suggests that UK consumers are unlikely to encounter the mark at all in the UK and not to any great extent when abroad.

19) The opponent provides a list of trade mark registrations for BINGO in numerous countries around the world, but as Mr Ahuja has pointed out, there is no evidence to demonstrate that the mark is in use in these countries. In the absence of such

evidence, the existence of such registrations has little impact upon my considerations.

20) The opponent has provided evidence demonstrating that its website is in English, but nothing rests on this because English is the international language of business. I cannot conclude that this is evidence that the opponent has UK customers or that it illustrates that UK consumers would be more aware of its products and mark.

21) Taking all of the above into account, I conclude that the opponent has failed to demonstrate that its mark is well known in the UK within the meaning a Section 56 of the Act.

Section 5(2) and section 5(3)

22) In light of my findings regarding the claim to a well known mark, the opponent has no earlier right in the UK that it can rely upon for the purposes of grounds based upon Section 5(2) of the Act. In light of this, the opposition fails in its entirety.

23) Such a finding also results in the opponent being unable to succeed if its pursued grounds under section 5(3) of the Act. If this ground was intended to be pleaded (see my comments at paragraph 8, above), the absence of an earlier mark would be fatal to its chances of success.

COSTS

24) The applicant has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. I take account that both sides filed evidence, that the opponent also filed written submissions and that no hearing took place. I award costs as follows:

Considering statement and preparing counterstatement	£300
Evidence	£600
Considering written submissions	£100
Total:	£1000

25) I order Hayat Kimya Sanayi A.S. to pay Sun Mark Limited the sum of £1000 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

Dated this 5th day of October 2016

Mark Bryant
For the Registrar,