

O-152-18

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3206894

BY ISMAIL URTEKIN & HASAN AYHAN

TO REGISTER:

GAZIANTEPLILER PASTANESI

AS A TRADE MARK IN CLASS 43

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 408776 BY HUSEYIN EREN

BACKGROUND & PLEADINGS

1. On 16 January 2017, Ismail Urtekin and Hasan Ayhan (“the applicants”) applied to register the trade mark **GAZIANTEPLILER PASTANESI** for services in class 43 (shown in paragraph 10 below). The application was published for opposition purposes on 10 February 2017.

2. The application has been opposed in full by Huseyin Eren (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon United Kingdom trade mark registration No. 3030654 for the trade mark **Gaziantep Pastanesi** which was applied for on 14 November 2013 and registered on 21 February 2014. The opponent relies upon all the goods for which his trade mark is registered, shown in paragraph 10 below.

3. The opponent states:

“The earlier mark is trading as a bakery and the opposition is also going to be trading as a bakery. The word “PASTANESI” means “BAKERY” in the Turkish language. Therefore the services provided is identical and the mark is very similar, therefore there is a likelihood of confusion.”

4. The applicants filed a counterstatement in which the basis of the opposition is denied. They state:

“I would like to explain to you that “GAZIANTEPLILER PASTANESI” and “GAZIANTEP PASTANESI” even though it may sound similar however it has a completely different meaning. GAZIANTEP is a city in Turkey, GAZIANTEPLILER means society who was born or live in the city of (GAZIANTEP). I strongly believe that it will not be any confusion about this. Adding the word “LILER” changed the full meaning. Also apart from the

meanings to be different, it sounds different as well. There is 5 letters added to the word of course it changes the pronunciation as well. Lastly this two words spell different, they mean different and they sound different, and there is a difference between something to be similar or same.”

5. In these proceedings, the opponent represents itself. The applicants are represented by Mr Sami Ozkan. Neither party filed evidence or submissions during the course of the evidence rounds nor did they elect to attend a hearing or file written submissions in lieu of attendance at a hearing.

DECISION

6. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

7. An earlier trade mark is defined in section 6 of the Act, which states:

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. In these proceedings, the opponent is relying upon the UK trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As this earlier trade mark had not been registered for more than five years at the date the application was published, it is not subject to the proof of use provisions contained in section 6A of the Act. As a consequence, the opponent is entitled to rely upon it without having to demonstrate genuine use.

Section 5(2)(b) – case law

9. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to

make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

10. The competing goods and services are as follows:

Opponent goods	Applicants' services
Class 30 – Bakery Goods.	Class 43 - Bistro services; Cafe services; Café services; Cafés; Cafeteria services; Cafeterias; Canteen services; Canteens; Carvery restaurant services; Catering; Catering (Food and drink -); Catering for the provision of food and beverages; Catering for the provision of food and drink; Catering in fast-food cafeterias; Catering of food and drink; Catering services for the provision of food; Catering services for the provision of food and drink; Food and drink catering for cocktail parties; Grill restaurants.

11. In his Notice of Opposition, the opponent explains that “the earlier mark is trading as a bakery”, adding that “the [applicants are] also going to be trading as a bakery”.

However, in conducting a comparison, what I must do is compare the words in the

competing specifications whilst keeping the case law which appears below firmly in mind.

12. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

13. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

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

15. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated:

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

16. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

17. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

18. In approaching the comparison, I begin by reminding myself that there are several decisions of this Tribunal which have considered the similarity of foodstuffs to the provision of services in class 43. For example, in *Flaming Grill* (BL-O-198-12), the Hearing Officer conducted a comparison between “services for providing food and drink; restaurant, bar and catering services” in class 43 and a range of goods in classes 29 and 30, which included the term “bakery products...” in class 30. The Hearing Officer stated:

“18. In comparing goods with services (the opponent only has cover for services), there is, of course, a difference between the nature of a good and the nature of a service, which also affects the method of use comparison. Goods and services can, however be complementary, share channels of trade and they can be in competition with one another. This is particularly pertinent when considering services which provide food and drink, against food and drink goods which have been prepared. Takeaway services are within the scope of the opponent’s services. A takeaway service is complementary to the takeaway, which is a prepared meal. The supply of the goods is essential to the supply of the services; the purpose of both the takeaway and the service is to satiate hunger or thirst; the channel of trade will be the same, and the users will be the same. In relation to restaurants and bars, consumers have a choice whether to visit an establishment where they can eat and/or drink, or they can buy a prepared meal and/or drink and take it home: the users are the same, the goods and services have the same purpose, but this time the goods and services are in competition. There is a high degree of similarity between the opponent’s services and the following goods of the application which are either specified as prepared meals or drinks, or are in the nature of prepared meals or desserts for taking away (such as chips, soups, pasties, doughnuts and ice cream)...”

19. In her decision, the Hearing Officer made a distinction between food products that were in competition with restaurant services and those that were not. The reason for this is that some food products may be ready to eat and may be chosen by the consumer as an alternative to visiting a restaurant or cafe. Consequently, they are in competition with each other. Further, they may share trade channels where, for example, an eating establishment may also prepare food for consumption off the premises. That appears to me to be the correct approach and is the approach I shall adopt in these proceedings.

20. "Bakery goods" is a broad term which would include a wide range of goods many of which will be ready to eat and may be selected as an alternative to eating at the type of venues mentioned in the applicants' specification. The respective goods and services have the same end users and purpose and are in competition with one another. Food products which are ready to eat are essential to the provision of many of the applicants' services which are, in my view, likely to lead the average consumer to assume the goods and services have the same trade source. As a consequence, there is, in my view, a high degree of similarity between the opponent's goods and the applicants' services shown below:

Bistro services; Cafe services; Café services; Cafés; Cafeteria services; Cafeterias; Canteen services; Canteens; Carvery restaurant services; Catering; Catering (Food-); Catering for the provision of food; Catering for the provision of food; Catering in fast-food cafeterias; Catering of food; Catering services for the provision of food; Catering services for the provision of food; Food catering for cocktail parties; Grill restaurants.

21. However, having applied the relevant case law, I find no meaningful degree of similarity between the services shown below and the opponent's bakery goods in class 30.

Catering (drink -); Catering for the provision of beverages; Catering for the provision of drink; Catering of drink; Catering services for the provision of drink; drink catering for cocktail parties.

22. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by

holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

23. Where there is no similarity in the competing goods and services at issue there can be no likelihood of confusion, Having concluded that is the case in relation to the services shown in paragraph 21 above, the opposition to those services fails and is dismissed accordingly.

The average consumer and the nature of the purchasing act

24. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods and services I have found to be similar. I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

25. The average consumer of the goods and services I have found to be similar is a member of the general public in the United Kingdom (which would include, as a sub-set, those in the Turkish community). Insofar as the opponent's goods are concerned, these are fairly frequent, low cost purchases which are most likely to be selected with, at best, a moderate (i.e. between low and medium) degree of care from, for example, the shelves of bricks and mortar outlets such as a bakeries and supermarkets or from the equivalent pages of a website. While visual considerations are likely to dominate the selection process, aural considerations in the form of, for example, word-of-mouth recommendations or requests to sales assistants may play a part, albeit, in my view, to a much lesser extent.

26. As to the services at issue, my own experience informs me that such services are most likely to be selected having considered, for example, promotional material and reviews (in hard copy and on-line) and on signage appearing on the high street; once again visual considerations will be an important part of the selection process. However, as such services are also, in my experience, very likely to be the subject of word-of-mouth recommendations, aural considerations will be a not-insignificant feature of the process. The degree of care the average consumer will display when selecting the services at issue is likely to vary. Contrast, for example, the low degree of care likely to be taken when one selects a venue for an impromptu cup of coffee, with the fairly high degree of attention one is likely to take when selecting a restaurant for an important family event.

Comparison of trade marks

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

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

28. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are:

Opponent's trade mark	Applicants' trade mark
Gaziantep Pastanesi	GAZIANTEPLILER PASTANESI

29. The competing trade marks consist of the two words shown above presented in a conventional font in title case (the opponent's trade mark) and in block capital letters (the applicants' trade mark). In their counterstatement, the applicants state that “Gaziantep” is a city in Turkey and collinsdictionary.com confirms that to be the case explaining that it is:

“a city in S Turkey: base for Ibrahim Pasha's campaign against the Turks (1839) and centre of Turkish resistance to French forces (1921). Pop: 1 004 000 (2005 est).”

30. The applicants also state that “GAZIANTEPLILER” means “society who was born or live in the city of “GAZIANTEP”. I take that to mean that a person from GAZIANTEP is known as a GAZIANTEPLILER in the same way as a person from London is known as a Londoner.

31. In his Notice of Opposition, the opponent states that “PASTANESI” means “BAKERY” in the Turkish language. Although no evidence has been filed in support of that assertion, I note that the applicants have not taken issue with that definition in their counterstatement.

32. Absent evidence to assist me, I think that an average consumer (who is not part of the Turkish community) is unlikely to be familiar with either of the words in the parties’ trade marks. For such an average consumer both words are likely to make a roughly equal contribution to both the overall impression the trade marks convey and their distinctiveness. I accept that the position may be different for those in the Turkish community. I shall return to this point later in my decision.

33. The applicants’ trade mark consists of two words consisting of fourteen and nine letters respectively, whereas the opponent’s trade mark consists of two words each consisting of nine letters. Although the first word in the applicants’ trade mark contains the additional letters “LILER” in the tenth to fourteenth letter positions, as the nine letters of which the first word in the opponent’s trade mark is composed are identical to the first nine letters in the first word in the applicants’ trade mark and as the second word in each trade mark is identical, it leads to a high degree of both visual and aural similarity between them.

34. As I mentioned earlier, the average consumer is a member of the general public in the United Kingdom (which would include, as a sub-set, those in the Turkish community). For those in the first category (who are unlikely to be familiar with the words), the competing trade marks are unlikely to convey any conceptual message, leading to conceptual neutrality. For those in the second category (who are more likely to be familiar with Turkey and the Turkish language), the words may convey the meaning the parties suggest i.e. a geographical location, a person from that location and a bakery. The conceptual messages the competing trade marks send to those in the second category may, as a consequence, be highly similar.

Distinctive character of the earlier trade mark

35. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

36. As the opponent has filed no evidence of any use he may have made of his earlier trade mark I have only its inherent characteristics to consider. For members of the general public in the United Kingdom who are not part of the Turkish community, the words will be meaningless, leading to a high degree of inherent distinctive character. However, as there is nothing to suggest that despite it being a sizeable geographical location in Turkey, Gaziantep has any reputation for the goods upon which the opponent relies, even for those in the Turkish community, the word is likely to be regarded as distinctive. Notwithstanding that the word “Pastanesi” is unlikely, given the goods at issue, to add much (or any distinctive character) to the opponent’s trade mark, even for a member of the Turkish community, the opponent’s trade mark as a whole is likely to be regarded as averagely distinctive.

Likelihood of confusion

37. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of

similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

38. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods/services down to the responsible undertakings being the same or related.

39. Earlier in this decision I concluded that certain of the applicants' services are to be regarded as highly similar to the opponent's goods. Having identified the average consumer as a member of the general United Kingdom public (which includes, as a subset, those in the Turkish community), I further concluded that the competing trade marks were visually and aurally highly similar and either conceptually neutral or, in relation to a member of the Turkish community, potentially conceptually similar to a high degree. Finally, I concluded that even for a member of the Turkish community the opponent's trade mark was likely to be averagely distinctive and for those average consumers not part of that community, distinctive to a high degree.

40. I am satisfied that even if the average consumer is a member of the Turkish community paying a high degree of attention to the selection of the goods and services at issue (making them less prone to the effects of imperfect recollection) and for whom the opponent's trade mark may be only averagely distinctive, the high degree of similarity in the competing goods and services together with the high degree of visual and aural similarity and what may be the high degree of conceptual similarity between the competing trade marks, is likely to result in direct confusion and the opposition to

those services succeeds accordingly. That conclusion is even more clear-cut when the position is considered from the perspective of a member of the Turkish community paying only a moderate to average degree of attention when selecting the goods and services at issue (making them more susceptible to the effects of imperfect recollection), or for the vast majority of average consumers in the United Kingdom (even those paying a high degree of attention during the selection process) for whom the opponent's trade mark will be highly distinctive.

Overall conclusion

41. The opposition has succeeded in relation to:

Bistro services; Cafe services; Café services; Cafés; Cafeteria services; Cafeterias; Canteen services; Canteens; Carvery restaurant services; Catering; Catering (Food-); Catering for the provision of food; Catering for the provision of food; Catering in fast-food cafeterias; Catering of food; Catering services for the provision of food; Catering services for the provision of food; Food catering for cocktail parties; Grill restaurants.

But failed in relation to:

Catering (drink -); Catering for the provision of beverages; Catering for the provision of drink; Catering of drink; Catering services for the provision of drink; drink catering for cocktail parties.

Costs

42. As neither of the parties to these proceedings is professionally represented, at the conclusion of the evidence rounds the Tribunal invited them, inter alia, to indicate whether they intended to make a request for an award of costs, and if so, to complete a pro-forma indicating a breakdown of their actual costs, including providing accurate

estimates of the number of hours spent on a range of given activities relating to the prosecution of the opposition; it was made clear to the parties that if the pro-forma was not completed “no costs, other than official fees arising from the action and paid by the successful party...will be awarded”; neither party elected to respond to that invitation. As both parties have achieved a reasonable measure of success, I direct that they should both bear their own costs.

Dated this 09th day of March 2018

C J BOWEN
For the Registrar