

**O-513-19**

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
TRADE MARK APPLICATION NO 3316126  
BY HAVWOODS LIMITED  
TO REGISTER**

**VETRO**

**AS A TRADE MARK  
IN CLASSES 1 & 19  
AND OPPOSITION THERETO (UNDER NO. 413491)  
BY  
ECZACIBASI HOLDING ANONIM SIRKETI**

## Background & Pleadings

1. Havwoods Limited ('the applicant') applied to register the mark **VETRO** on 7 June 2018. The mark was published in the Trade Mark Journal on 22 June 2018 for the following goods in classes 1 and 19.

*Class 1: adhesives for flooring; additives (chemical-) for grouting materials; cements for fixing flooring.*

*Class 19: Ceramic floorings; grout for ceramic flooring; ceramic tiles; ceramic tiles for flooring and facing and lining; parts and fittings for all the aforesaid goods.*

2. Eczacibasi Holding Anonim Sirketi ('the opponent') opposes the application under section 5(2)(b) of the Trade Marks Act 1994 ('the Act') on the basis of its earlier UK and EU trade marks set out below and the following goods specified in class 19.

Marks relied on	Goods relied on
UK TM No.1515314  <b>VITRA</b>  Filing date: 12 October 1992 Registration date: 27 September 1996	Class 19: Ceramic floor coverings; ceramic wall coverings; floor tiles; wall tiles; all included in Class 19.
EU TM No.7314024  <b>VitrA</b>  Filing date: 14 October 2008 Registration date: 14 May 2009	Class 19: Tiles; ceramic wall tiles, ceramic floor tiles, porcelain floor tiles, tiles for adjoining partitions, external tiles for buildings.

3. The opponent's above trade marks both have a filing date that is earlier than the filing date of the application and, therefore, they are earlier marks, in accordance with Section 6 of the Act. As the registration procedure was completed more than 5 years prior to the publication date of the contested application, they are subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods it relies on.

4. The applicant filed a counterstatement in which it denied the ground of opposition and put the opponent to proof of use of the earlier marks.

5. During the proceedings the opponent has been represented by Urquhart-Dykes & Lord LLP and the applicant by Withers & Rogers LLP.

6. The opponent filed evidence. Both parties filed written submissions in lieu of a hearing. I make this decision from the material before me.

### **The opponent's evidence**

7. The opponent submitted a witness statement in the name of Erol İsmail Özgür, the opponent's finance director, who appended 8 exhibits. Mr Özgür states that the earlier marks have been used in the UK since 1992. Although no turnover figures have been stated, the declarant provided the following information on the volume of tiles sold in the UK and stated that 1 metre squared of tiles retails at between £20-£50.

<b>Year</b>	<b>UK - Number of metres squared of tiles sold</b>
2013	1,213,741
2014	1,497,898
2015	1,469,762
2016	1,368,152
2017	1,490,576
2018	1,567,958

By my reckoning this would equate to between £24m-£60m in 2013 and has increased in each subsequent year. The declarant also states that the UK advertising expenditure for the goods in the last 5 years has been approximately £3m.

8. Exhibit EIO1 consists of an undated list of UK tile distributors who retail the opponent's goods.

9. Exhibit EIO2 consists of a number of images from various commercial projects for which the opponent's tiling goods have been used. These include a Moscow shopping centre; the Queen Mary 2 liner; four German sports centres; Berlin, Munich, Istanbul and Heathrow airports; Danish TV Broadcasting HQ and a housing and business complex in Moscow. The earlier mark **VitrA** appears in the captions and the technical rubric on each page. The declarant does not state the purpose of the documents or whether they were generated for internal or external customer use.

10. Exhibit EIO3 consists of a 2015 tile catalogue containing the opponent's goods. The following stylised mark is used on the title page:

VitrA

11. Exhibit EIO4 consists of an undated catalogue outlining the opponent's specialist tile ranges for swimming pools. The above mentioned stylised mark appears on the title page and in headers within the catalogue.

12. Exhibit EIO5 consists of a number of advertisements showing the stylised mark dated between 2016 and 2018. The declarant states the advertisements were used in both direct advertising and in the tiling industry trade press. Some of the advertisements are clearly aimed at the UK, i.e. they indicate UK based journals, websites and showrooms. One advertisement relates to a stand at an exhibition in Italy and one referenced as a 'Lookbook', is in dual languages, namely English and Turkish, and it is unclear where this publication was used.

13. Exhibit EIO6 consists of screenshots of the opponent's Facebook account pages dated between 2016-2018 and a screenshot of a selection of YouTube videos featuring the opponent's goods. Both earlier marks feature as does the stylised mark.

14. Exhibit EIO7 consists of a number of press releases dated between 2006 and 2018 setting out the opponent's award successes for its tile goods and other sanitaryware products. It is unclear if these are UK or international awards.

15. Exhibit EIO8 consist of several invoices to 3 UK customers dated between 2013-2018 priced in GBP for tile consignments. The invoices were generated by Ekom Eczacibasi Dis.Tic. AS, which the declarant states is a subsidiary company of the opponent.

16. That concludes my summary of the evidence.

### **Proof of use**

17. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),

(b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

18. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it”.

19. As one of the earlier marks is an EU TM, the following case law is also relevant. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the CJEU noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create

or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

20. The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

21. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the



use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is

that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.”

22. The General Court restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

23. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- iv) The geographical extent of the use shown

24. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v*

*Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or

services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

### Form of the mark

25. As noted above in paragraph 10, one of the marks used on the goods is in this

form, *VitrA*, in addition to the registered earlier marks **VITRA** and **VitrA**.

However, s.6A(4)(a) enables an opponent to rely on use of a mark “in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered.” In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s. 46(2) of the Act (which is analogous to s. 6A(4)(a)) as follows:

“33. [...] The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all”.

26. The registered marks' distinctive character resides in their word element alone. One mark is presented in capital letters and the other presented with a capital letter at the beginning and end of the mark. The stylised mark follows a similar pattern of a capital letter at the beginning and end and the middle letters **i-t-r** are clearly readable and have no additional embellishment and, in my view, do not alter the distinctive character of the registered marks. I find the stylised mark can be considered as an acceptable variant.

### **Sufficiency of use**

27. Although no formal turnover figures were provided, the declarant provided figures for the volume of goods sold in the UK and the unit price range. From that figure a turnover range of approximately £24m to £60m can be extrapolated for 2013 up to £31m to £78m for 2018. In addition, the declarant stated that around £3m had been spent on advertising in the UK in the relevant 5-year period prior to the publication of the contested mark. In my view, the use established in the UK is by extension sufficient to constitute genuine use of an EUTM. Overall, I find there has been genuine use of the marks.

### **Fair specification**

28. The next stage is to decide whether the opponent's use entitles it to rely on all the goods it has claimed in class 19. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

29. The evidence demonstrates that the opponent has used its mark on all goods for which it is registered namely *Ceramic floor coverings; ceramic wall coverings; floor*

*tiles; wall tiles and Tiles; ceramic wall tiles, ceramic floor tiles, porcelain floor tiles, tiles for adjoining partitions, external tiles for buildings.*

### **Section 5(2)(b)**

30. Section 5(2)(b) of the Act states 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.

31. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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 great degree of similarity between the marks, and vice versa;

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

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

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

(k) if the association between the marks creates a risk that the public 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

32. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

33. 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.

34. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion 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 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”.

35. The goods to be compared are:

Opponent’s goods	Applicant’s goods
UK TM No. 1515314 Class 19: Ceramic floor coverings; ceramic wall coverings; floor tiles; wall tiles	Class 1: Adhesives for flooring; additives (chemical-) for grouting materials; cements for fixing flooring.
EU TM No. 7314024 Class 19: Tiles; ceramic wall tiles, ceramic floor tiles, porcelain floor tiles, tiles for adjoining partitions, external tiles for buildings.	Class 19: Ceramic floorings; grout for ceramic floorings; ceramic tiles; ceramic tiles for flooring and facing and lining; parts and fittings for all the aforesaid goods

36. In the applicant’s written submissions dated 30 May 2019 at paragraph 15, it was admitted that the applicant’s class 19 goods are identical to the opponent’s class 19 goods and that the applicant’s class 1 goods are complementary.

37. I agree the class 19 goods in each case are identical. With regard to the remaining goods, the applicant’s class 1 goods comprise adhesives and cements for fixing tiles. Although the physical nature of such goods and the tiles themselves are different, they have a close connection in the sense that one will be used with the

other. Furthermore, the users of the goods will be the same and the trade channels are likely to be the same as they will be in close proximity to each other in a retail environment. In my view an average consumer will believe that the same undertaking is responsible for each product. To that extent I find the goods are complementary to a medium degree.

### **Average consumer and the purchasing process**

38. It is necessary to consider the role of the average consumer and how the goods are purchased. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

39. 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.”

40. The average consumer for the contested goods are both the public and businesses. The contested goods will vary in price depending on the size and nature of the area to be tiled especially as some commercial projects have very specific technical requirements such as water repellence or other safety concerns. As such I would expect a normal to high level of attention will be paid during the purchasing process. The goods can be sold in physical retail premises as well as online and through catalogues, so the purchasing process will be primarily visual

although I do not discount any aural consideration as advice may be sought from a technical specialist prior to purchase.

### **Comparison of the marks**

41. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

42. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

43. The marks to be compared are:

Opponent's marks	Applicant's mark
VITRA	VETRO
VitrA	

44. The marks are word marks with no other aspect to them and the overall impression of all marks reside solely in these words.

45. In a visual comparison, the marks are the same length and they share the same consonants in the same order, namely V-T-R, whilst differing in their vowels. The opponent's marks have the letters I and A whereas the applicant's have the letters E and O. Clearly the marks are both short words at five letters long. However, having a two letter difference is likely to be more noticeable in a short word than in a long word. Overall I find that there is a medium degree of visual similarity.

46. Turning to the aural comparison, the marks are invented words there is no accepted way of pronunciation as there would be for regular dictionary words. The differences in vowel sounds in these marks is likely to alter the pronunciation of the words. If the opponent's marks are verbalised as VIT-RAR or even VEET-RAR and the applicant's mark is verbalised as VET-ROW then there is some aural distinction. Taking these factors into account I find that marks are aurally similar to a medium degree.

47. With regard to the conceptual comparison, I have previously stated that the marks are invented words and neither has an immediately graspable concept<sup>1</sup>. As such I find the marks to be conceptually neutral.

### **Distinctive character of the earlier mark**

48. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of

---

<sup>1</sup> It has been highlighted in numerous judgments such as *The Picasso Estate v OHIM*, Case C-361/04 that it is only concepts capable of immediate grasp by the consumer that are relevant.

other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

49. The opponent’s marks are invented words which have no meaning in relation to the goods, so I consider them to be inherently distinctive to a very high degree. I have considered the evidence filed on this case showing use of the earlier marks, but in my view, this does not put the opponent in any stronger position with regard to the distinctiveness of the earlier marks.

### **Likelihood of confusion**

50. Drawing together my earlier findings into the global assessment of the likelihood of confusion, I keep in mind the following factors and those outlined in paragraph 25:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) Imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer*).

51. Confusion can be direct (when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks, goods and services down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

52. So far in this decision, the contested goods in class 19 were found to be identical and complementary to a medium degree for those goods in class 1. Furthermore, I found that average consumer will pay a normal to high level of attention during a primarily visual purchasing process and that the earlier marks have a very high level of inherent distinctiveness. In the comparison of the marks I found they were visually and aurally similar to a medium degree and conceptually neutral.

53. Although I found some visual similarities between the marks, namely sharing three letters in common, these are outweighed by the visual and aural differences. The marks are short and the vowel differences are noticeable to the eye and the ear. None of the marks have an immediately graspable concept so there is nothing to assist a consumer with fixing the marks in their mind. Therefore even taking the notion of imperfect recollection into account I do not consider there to be a likelihood

of direct confusion between the applicant's mark and the opponent's marks, on the part of an average consumer paying a normal to high level of attention.

54. Having found no likelihood of direct confusion, I have to consider indirect confusion. Looking at the guidance give in *L.A. Sugar* above I do not consider that the average consumer is likely to believe that the respective goods come from the same or linked undertakings simply because the mark share three letters in common. Neither do I consider that the application would be seen as another brand of the earlier marks. Therefore I do not find that there is a likelihood of indirect confusion.

### **Outcome**

55. The opposition fails. Subject to any appeal against this decision, the application can proceed to registration.

### **Costs**

56. As the applicant has been successful, it is entitled to a contribution towards the costs incurred in these proceedings. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Using the guidance in TPN2/2016, I make the following award:

£200 Considering of the Notice of Opposition and preparing a counterstatement

£500 Considering evidence

£300 Preparation of submissions

**£1000 Total**

57. I order Eczacibasi Holding Anonim Sirketi to pay Havwoods Limited the sum of £1000. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.



**Dated 3 September 2019**

**June Ralph  
For the Registrar,  
The Comptroller General**