

O/702/18

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003245283 BY  
DISA FOODS LTD  
TO REGISTER THE FOLLOWING SERIES OF MARKS:

**Sultans**

AND

**sultans**

AS A TRADE MARK IN CLASS 29

AND

IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 410747 BY  
GIMA (UK) LIMITED

## BACKGROUND AND PLEADINGS

1. On 21 July 2017, Disa Foods Ltd (“the applicant”) applied to register the series of trade marks shown on the cover page of this decision in the UK. The application was published for opposition purposes on 11 August 2017.

2. The application was opposed by Gima (UK) Limited (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the earlier UK Trade Mark registration no. 2601289 for the mark **Sultanim**. The opponent’s mark has an application date of 14 November 2011 and a registration date of 24 February 2012. The following goods are relied upon in this opposition:

Class 29 Meat, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; milk products; edible oils and fats; prepared meals.

Class 30 Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices.

Class 31 Agricultural, horticultural and forestry products.

Class 32 Non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages.

3. The opponent argues that the respective goods are identical or similar and that the marks are similar.

4. The applicant has filed a counterstatement denying the claims made (and requested that the opponent provides proof of use of its earlier trade mark relied upon).

5. The application was also subject to another opposition by Egeturk Wurst- und Fleischwarenfabrikation GmbH & Co. KgaA. A decision was issued in that case on 25 July 2018 and the appeal period expired on 22 August 2018. No appeal was received and as a result of that decision, the applicant's specification is limited to the following goods:

Class 29      Preserved, frozen, dried and cooked fruits and vegetables; jellies, jams and compotes; eggs; milk and milk products; edible oils and fats.

6. The opponent was originally represented by Bowling & Co and is now represented by Harold Benjamin Solicitors. The applicant is represented by Fortis Rose Solicitors. The opponent's evidence consists of the witness statement of Vehbi Keles dated 3 April 2018, which was accompanied by written submissions dated 4 April 2018. The applicant's evidence consists of the witness statement of Ufuk Cengiz dated 5 June 2018. No hearing was requested and neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **EVIDENCE**

### **The Opponent's Evidence**

7. As noted above, the opponent's evidence consists of the witness statement of Vehbi Keles dated 3 April 2018, with two exhibits. Mr Keles is the director of the opponent.

8. Mr Keles states that the opponent's mark has been used in relation to "Biscuits, Sunflower seeds, Tomato paste, Wafers". Mr Keles states that:

"6. The mark has been used on goods throughout the UK.

7. The goods which contain the mark are also sold on-line to the whole of the UK from the Opponent's web site found at URL [www.gimauk.com](http://www.gimauk.com)."

9. Exhibit VK1 to Mr Keles' statement consists of four pages, all marked with what appears to be a print date of 21 March 2018. Mr Keles states that this exhibit shows a

number of products on which the mark is used. The first page shows a variety of biscuit products as well as sunflower seeds, tomato paste and wafers, which all appear to be available for sale on an online store. Each product displays the opponent's mark in a stylised form (as shown below) but the opponent's mark also appears as registered in the text of the page. The price for each product is stated as "Members Only". The web address which appears across the bottom of the page is [yayek.raumh.servertrust.com](http://yayek.raumh.servertrust.com). The top of the page displays a number of tabs including "Poland", "Turkey", "Bulgaria", "Romania" and "Other Countries" and the page is presented in English.

10. The second, third and fourth pages of Exhibit VK1 show a picture of a packet of cookies, a packet of sunflower seeds and a can of tomato paste respectively. Each product displays the opponent's mark in the following variation:



11. The labels on all of the products shown are in English (although some include what appears to be a translation to at least one other language).

12. Exhibit VK2 to Mr Keles' statement is a chart showing annual sales of products displaying the opponent's mark. The table shows sales totalling £172,732.96 in 2013, £196,336.74 in 2014, £231,168.25 in 2015, £428,831.04 in 2016 and £472,226.05 in 2017. The products listed as having been sold include a variety of beans and pulses, tomato paste, green peas, dried apricots, Ceylon tea, olives, wafers, walnuts, pepper flakes, sunflower seeds, olive oil and biscuits. Mr Keles states that the mark has been used in the UK. Although no breakdown is given as to which market these sales relate to, the inference is that these at least in part relate to the UK market. This is supported by the fact that the sales figures are provided in pounds sterling.

13. Mr Keles' statement was accompanied by written submissions. I do not propose to summarise these here, but will refer to them below as appropriate.

## **The Applicant's Evidence**

14. As noted above, the applicant's evidence consists of the witness statement of Ufuk Cengiz dated 5 June 2018, with two exhibits. Mr Cengiz is the director of the applicant.

15. In his statement, Mr Cengiz states as follows:

a) The intention is that the applicant's mark will be used on tin tomato paste, tin chopped tomato; tin plum chopped tomato, tin butter beans, tin chickpeas, tin sweetcorn, tin broad beans, tin black eye beans and other pulses products.

b) The word Sultan is a name with a broad meaning including the traditional use of referring to a head of state and wider meanings such as being the best. The word is widely used for branding different products and services.

c) There are several businesses both in Europe and in the UK which operate businesses selling similar goods and there are hundreds of products and businesses which use the name Sultan. Because of the number of businesses using that name, the end consumer will not be confused.

d) The end user of the applicant's business is different to the end user of the opponent's business because the applicant does not target the Turkish market whereas the opponent does. The applicant's mark is an English word and the opponent's mark is a Turkish word. Because the marks will be read in different languages they will sound different and the meaning will be understood differently.

e) The marks are different in size, shape and colour and will therefore not be confused.

f) The meaning of Sultan as being a Muslim head of state means that it indicates products which are halal and is not, therefore, seen by consumers as a brand, but rather as a mark indicative of the goods being halal.

g) Consumers will be aware of the differences between the two marks.

16. Exhibit UC1 to Mr Cengiz's statement consists of pictures of goods, webpage print outs and registered marks of other businesses which use the word SULTAN. It also includes a list of products produced by another business which do not make reference to the word SULTAN.

17. Exhibit UC2 to Mr Cengiz's statement consists of a letter from the tribunal to the applicant dated 28 July 2017 which warned that their trade mark was similar to other marks already registered and that the owners of those marks would be notified of the application. Attached to that letter is a list of the similar marks.

## **PROOF OF USE**

18. 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 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 of 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 Community 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 Community.

(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.”

19. 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.”

20. According to section 6(3)(a) of the Act, the relevant period in which genuine use must be established is the five-year period ending on the date of publication of the applied for mark. The relevant period is, therefore, 12 August 2012 to 11 August 2017.

21. What constitutes genuine use has been subject to a number of judgments. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237 ). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in 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 that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

...

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court



of Justice, which also includes Case C-442/07 *Verein Radetzky-Orden v Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, 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] to [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]; *Centrotherm* at [71]; *Leno* 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]; *Centrotherm* at [71]; *Leno* at [29].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(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]; *Leno* at [55].

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

22. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

## Form of the mark

23. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“the CJEU”) found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

24. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act 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."

25. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

26. Where the mark has been used in the format in which it is registered (such as in the text of the webpage print out provided at exhibit VK1) this will clearly be use upon

which the opponent may rely. As noted above, the mark also appears in the following variation in the opponent's evidence:



28. In this variant, the mark is presented in upper-case font which gives a slight three-dimensional appearance. It is not clear from the evidence whether black and white shading is used or whether there is use in a particular colour. The additional stylisation and the additional graphics used in its presentation in this variant, in my view, do not alter the distinctive character of the mark (as explained in *Nirvana*). The mark is presented, in this variant, in an oval outline and in combination with the words "FARM SELECTION". It is clear from the case law in *Colloseum*, cited above, that use in conjunction with other matter falls within the ambit of genuine use. I, therefore, consider that this is use upon which the opponent may rely.

### **Sufficient Use**

29. I have no substantive submissions from the applicant on the evidence provided by the opponent to prove use of the mark.

30. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself<sup>1</sup>.

31. Clearly, there are deficiencies in the opponent's evidence. No breakdown is provided as to what proportion of the sales figures listed at Exhibit VK2 relate to the UK market. The webpage print out shown at Exhibit VK1 is not dated and so it is not clear whether it shows the position within the relevant period. However, Mr Keles has confirmed that sales have been made in the United Kingdom, which is supported by

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<sup>1</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

the product labelling and the website pages being displayed in English. It follows that at least a proportion of the sales shown will relate to those made in the UK. The evidence, in combination, creates a picture which is sufficient to establish genuine use of the mark by the opponent during the relevant period.

### **Fair Specification**

32. I must now consider whether, or the extent to which, the evidence shows use for all the goods relied upon.

33. 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.”

34. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

35. It is plain that the evidence does not support the claim for use in relation to all of the goods claimed in the notice of opposition.

36. The evidence shows that the opponent's mark has been used in relation to sunflower seeds, tomato paste, wafers, Ceylon tea, walnuts, pepper flakes.

37. I am satisfied that the use of the mark in relation to a range of beans, pulses, green peas, olives, dried apricots and olive oil is sufficient to allow the opponent to rely on "preserved, dried and cooked fruits and vegetables" and "edible oils and fats" in class

29 of its specification. I am also satisfied that the opponent's use of the mark in relation to Ceylon tea and pepper flakes will allow it to rely on "tea" and "spices" in class 30 of its specification.

38. The opponent's use of the mark in relation to biscuits and wafers falls within "flour and preparations made from cereals, bread, pastry and confectionery, ices" in class 30 of its specification. However, it is my view that this would be too broad for the use demonstrated by the opponent. In my view, this should be limited to "pastry and confectionery" only.

39. The opponent has provided no evidence of use in relation to its class 31 goods. Whilst the opponent's use in relation to Ceylon tea would also fall within "Non-alcoholic drinks" in class 32 of its specification, as the opponent already has "tea" in class 30, I do not consider that it would be fair to allow it to rely on both (and, in any event, it would not assist the opponent's case). Accordingly, I consider that a fair specification for the earlier mark is:

Class 29      Preserved, dried and cooked fruits and vegetables; edible oils and fats.

Class 30      Tea; pastry and confectionery; spices.

## **PRELIMINARY ISSUES**

40. As noted above, part of the applicant's argument centres on their view that, because a number of other businesses use or have registered marks relating to the word SULTAN, there has been or will be no confusion on the part of the public. However, this argument does not assist the applicant as the existence of other trade marks on the register is not relevant to the decision I must make<sup>2</sup>.

41. Both parties have made reference to the fact that one of the shareholders of the applicant was previously employed by the opponent. The applicant states that the opponent is being "deliberately hostile" and the opponent states that the applicant has

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<sup>2</sup> *Zero Industry Srl v OHIM*, Case T-400/06



“deliberately set out to replicate or mimic” the opponent’s business and marks. These arguments are not relevant to a determination under section 5(2)(b), which focuses only on the similarity of the marks and the goods to which they relate and not to the intention of the parties. These arguments will not, therefore, assist either party.

## **DECISION**

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

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

(a)...

(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.”

43. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

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

44. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions.

### **Section 5(2)(b) – case law**

45. The following principles are gleaned from the decisions of the EU courts 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 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 to mind the earlier mark, 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**

46. As a result of my finding at paragraph 39 above, the competing goods are as follows:

Opponent's goods	Applicant's goods
<p data-bbox="204 255 336 286"><u>Class 29</u></p> <p data-bbox="204 309 783 398">Preserved, dried and cooked fruits and vegetables; edible oils and fats.</p> <p data-bbox="204 472 336 504"><u>Class 30</u></p> <p data-bbox="204 526 751 562">Tea; pastry and confectionery; spices.</p>	<p data-bbox="810 255 943 286"><u>Class 29</u></p> <p data-bbox="810 309 1390 510">Preserved, frozen, dried and cooked fruits and vegetables; jellies, jams and compotes; eggs; milk and milk products; edible oils and fats.</p>

47. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, 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.”

48. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

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

“... 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.”

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

“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.”

51. 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 (“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 the responsibility for those goods lies with the same undertaking.”

52. 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.”

53. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category,

designated by trade mark application (Case T-388/00 *Institut for Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

54. In its written submissions, the opponent states:

“The goods provided by the Applicant and the Opponent are virtually identical and directly compete with each other.”

55. In his statement, Mr Cengiz stated:

“16. The products of the Applicant and the Opponent will be available on different shelves because they are different products. In this case, if one keeps in mind that there are different products on different shelves, the confusion of the customer’s mind is not at all likely.”

56. “Edible oils and fats” appears in both the applicant’s specification and the opponent’s specification. These goods are plainly identical. “Preserved, dried and cooked fruits and vegetables” in the opponent’s specification falls within the broader category of “Preserved, frozen, dried and cooked fruits and vegetables” in the applicant’s specification. These goods are identical on the principle outlined in *Meric*.

57. That leaves “jellies, jams and compotes”, “eggs” and “milk and milk products” in the applicant’s specification. The uses and users of these products will overlap on a superficial level with the opponent’s goods in that they are all consumer items. However, this is not sufficient to find similarity on its own. I have considered the nature and trade channels for the goods and whether there is a competitive or complementary relationship between them. In the absence of any substantive submissions to assist me, I am not satisfied that there is any similarity between the goods at issue.

58. As some degree of similarity is required for there to be a likelihood of confusion<sup>3</sup>, the opposition can only proceed in respect of “edible oils and fats” and “preserved, frozen, dried and cooked fruits and vegetables”.

### **The average consumer and the nature of the purchasing act**

59. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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.”

60. In its written submission, the opponent stated as follows:

“26. The goods are sold through a range of channels including on line and retail premises such as supermarkets where they will be displayed on shelves and obtained by self-selection. Some of the goods will be displayed in close proximity whilst others will not. Direct comparison may therefore not always be possible and instead there may therefore be reliance on an imperfect picture retained in the mind of the consumer.

27. Whilst some consumers will pay more attention and others less, the average consumer is likely to pay an average degree of attention in their selection of

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<sup>3</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA



their goods. The selection process is likely to predominantly be visual, rather than aural one, although aural will not be irrelevant given that it may influence the recall of a name. The conceptual similarities will also be a factor given their high level of conceptual similarity.”

61. I have no substantive submissions from the applicant on the average consumer or the purchasing process for the goods in issue. The average consumer for the goods will be a member of the general public. These purchases are likely to be fairly frequent and of low cost. The level of attention paid by the average consumer during the purchasing process is likely to be average.

62. The goods are, in my experience, most likely to be obtained by self-selection from the shelves of a retail outlet or from an online equivalent. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of the goods given that advice may be sought from a sales assistant.

### **Comparison of trade marks**

63. 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 mark must be assessed by reference to the overall impressions created by the trade marks, 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.”

64. 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 impression created by the marks.

65. The respective trade marks are shown below:

<b>Opponent's trade mark</b>	<b>Applicant's trade marks</b>
Sultanim	Sultans  sultans

66. In its written submissions, the opponent states:

**“Visual**

20. Considered as a whole, the words “Sultans” and “Sultanim” are visually very similar. Both words comprise the letters “Sultan” at the start of the mark and only differ in the choice of final letters with the addition of “s” versus the “im”.

21. There is no addition of a device element to the mark so the similarity of the names is all the more important.

22. The average consumer is not always able to compare trademarks side by side and must instead rely on the imperfect picture of them. The small difference in the final parts of each word are therefore likely to be overlooked or misremembered. Direct confusion is therefore highly likely.

23. In addition, given the similarity in the names, the average consumer may also believe the marks are connected so there is a likelihood of indirect confusion.

## **Phonetic**

24. Considered as a whole the marks are phonetically very similar. As per the visual elements the marks are phonetically very similar only differing with the less dominant final syllable.

## **Conceptual**

25. Conceptually the names are very similar. Sultan and the Applicant's "Sultans" are shortened versions of the word "Sultanim" which is the word used to call the head of a Muslim state, particularly during, and in relation to, the head of the Ottoman Empire. The words "Sultan", "Sultans", "Sultanim" are synonymous. Given the marks are being applied to identical, or very similar goods, the average consumer will either be confused and/or believe the two are associated."

67. Mr Cengiz's comments on the similarity of the marks are summarised above. In its counterstatement the applicant states:

"The Defendant denies that the two marks 'Sultans' and 'Sultanim' are visually and phonetically and conceptually similar, and that there can be no likelihood of confusion on the part of the public..."

68. The opponent's mark consists of the eight-letter word – Sultanim. There are no other elements to contribute to the overall impression, which is contained in the word itself. The applicant's marks both consist of the seven-letter word – sultans. Again, there are no other elements to contribute to the overall impression, which is contained in the word itself.

69. Visually, the first six letters of the marks – SULTAN - are identical. The applicant's marks both end with the letter 'S'. The first of the applicant's marks is presented in lower-case but with the first letter capitalised. The second of the applicant's marks is presented all in lower-case. The opponent's mark ends with the letters 'IM'. The opponent's mark is presented in lower-case but with the first letter capitalised. As

notional and fair use means that all three marks could be used in any standard typeface, differences created by presentation in upper or lower case will not be relevant. As a general rule, the beginnings of marks tend to make more impact than the ends<sup>4</sup>. Mr Cengiz has stated that the marks are different in size, shape and colour. However, all three marks are word only marks. Presumably, Mr Cengiz is referring to the presentation of the marks in the course of trade. However, it is only the marks as registered/applied for that are relevant to my decision<sup>5</sup>. The different endings to each mark in this case create a point of visual difference because the addition of the letter “S” means that that the applicant’s marks have the appearance of an ordinary dictionary word. The addition of the letters “IM” means the opponent’s mark has the appearance of a made-up (or foreign) word. I consider the marks to be visually similar to a medium degree.

70. Aurally, Mr Cengiz has stated that the end users for both marks are different (the Turkish market for the opponent and the English market for the applicant), meaning the marks will be read in different languages and consequently pronounced differently. This argument does not assist the applicant. The average consumer for the assessment of the likelihood of confusion is the general public of the United Kingdom. The applicant’s marks will be pronounced SUL-TAN and the opponent’s mark will be pronounced SUL-TAN-IM. The first six letters of all three marks will, therefore, be pronounced identically. The difference is created by the end of each mark (“S” in the case of the applicant’s marks and “IM” in the case of the opponent’s mark). I consider there to be a medium degree of aural similarity between the marks.

71. Conceptually, the applicant’s marks are the plural of the ordinary dictionary word ‘Sultan’, being a title for a head of state. I consider that it is this meaning that the average consumer will recognise (as opposed to meaning the “best” as suggested by the applicant). Although Mr Cengiz states that the opponent’s mark is the Turkish word for ‘Sultan’ I do not think that the average consumer will be aware of this. The average consumer is likely to think that the opponent’s mark is either a made-up word or a word in another (unidentified) language. In both cases, the consumer may recognise that

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<sup>4</sup> *El Corte Ingles, SA v OHIM*, Cases T-183/02 and T-184/02

<sup>5</sup> *O2 Holdings Limited, O2 (UK) Limited v Hutchinson 3G UK Limited*, Case C-533/06

the word relates in some way to the ordinary dictionary word Sultan. Other consumers may not make the connection. For those consumers who do consider that the made-up or foreign word is in some way linked with the ordinary dictionary word 'Sultan', there will be a point of conceptual similarity between the marks. For those who do not, the marks will be conceptually different. In any event, consumers will recognise the opponent's mark as a made-up word or a foreign word and will recognise the applicant's mark as an ordinary dictionary word. This creates a point of conceptual difference, irrespective of whether the presence of the word 'sultan' in the opponent's mark is recognised. For those consumers who do not recognise the word 'sultan' in the opponent's mark, there will be no conceptual similarity between the marks. For those who do, there will be a medium degree of conceptual similarity between the marks.

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

72. 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 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-2779, 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).”

73. Registered trade marks possess varying degrees of inherent distinctive character, ranging from very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

74. As the opponent has not filed any evidence to show that its mark has enhanced its distinctiveness through use, I have only the inherent position to consider. I have no submissions from the opponent on the inherent distinctiveness of the earlier mark. The only submissions I have from the applicant on the distinctiveness of the earlier mark is its argument that the word ‘Sultan’ is allusive to the goods provided under the mark being halal because of the meaning of ‘Sultan’ as being a Muslim head of state.

75. I must make an assessment of the inherent distinctiveness of the earlier mark as a whole. The mark will be seen as either an invented word or as a word taken from another language. As noted above, some consumers will recognise that, whilst it is a made-up or foreign word, the opponent’s mark contains the ordinary dictionary word ‘Sultan’. I do not consider there to be any merit in the applicant’s argument that the word ‘Sultan’ is allusive to the nature of the goods provided. For those consumers who do not recognise the word ‘Sultan’ in the opponent’s mark, I consider there will be a high degree of inherent distinctive character. For those who do, I consider that there will be a medium degree of inherent distinctive character.

### **Likelihood of confusion**

76. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment

where 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 necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

77. I have found there to be a medium degree of visual and aural similarity between the marks. I have found that there will be either a medium degree of conceptual similarity between the marks or no conceptual similarity between the marks, depending on the perception of the average consumer. I have found the earlier mark to have a medium to high degree of inherent distinctive character. I have identified the average consumer to be a member of the general public and I consider that the goods will be selected primarily by visual means (although I do not discount an aural component). I have concluded that the average consumer will pay an average degree of attention when purchasing the goods. I have found "edible oils and fats" and "preserved, frozen, dried and cooked fruits and vegetables" in the applicant's specification to be identical to the opponent's goods. There is no similarity between the rest of the applicant's goods and the opponent's goods. Notwithstanding the principle of imperfect recollection, I consider that (even where the marks are conceptually similar to a medium degree) the visual, aural and conceptual differences between the marks are sufficient to prevent them being misremembered as each other. This is particularly the case given that the applicant's marks have a clear and specific meaning that will be immediately grasped by the average consumer, whereas the opponent's mark will be perceived as a made-up or foreign word<sup>6</sup>. I am satisfied that there is no likelihood of direct confusion.

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<sup>6</sup> *The Picasso Estate v OHIM*, Case C-361/04 P

78. I will now consider whether there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

79. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. He pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion. Having recognised the differences between the marks, bearing in mind my conclusions listed at paragraph 77 above, I can see no reason why the average consumer would assume that the marks come from the same or economically linked undertakings. I am, therefore, satisfied that there is no likelihood of indirect confusion. At best, the later mark will merely call to mind the earlier mark.

## **CONCLUSION**

80. The opposition has been unsuccessful and the application will proceed to registration.



## **COSTS**

81. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of £700 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the opponent's statement	£200
Preparing evidence and considering the opponent's evidence	£500
<b>Total</b>	<b>£700</b>

82. I therefore order Gima (UK) Limited to pay Disa Foods Ltd the sum of £700. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 7<sup>th</sup> day of November 2018**

**S WILSON**

**For the Registrar**