

O-255-15

TRADE MARKS ACT 1994

TRADE MARK APPLICATION NO 3 047 898:



BY AHMET EROL

AND OPPOSITION NO 402 636

BY TUNCAY SOMEZ

Background and pleadings

1. Ahmet Erol (the applicant) applied to register the trade mark No 3 047 898



in the UK on 21 March 2014. It was accepted and published in the Trade Marks Journal on 13 June 2014 in respect of the following goods, namely clothing in Class 25.

2. Tuncay Somez (the opponent) oppose the trade mark on the basis of Section 5(3) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier



UK Trade Mark No 1 574 735, which it claims has a reputation in respect of articles of clothing in Class 25. In particular the opponent argues that (the applicant) will benefit from (the opponent's) investment in advertising, leading to advantage. Further that the applicant will ride on its coat tails and will benefit from the power of attraction, reputation and prestige of the earlier mark. The opponent also claims that the later use will be out of its control and that poor quality or offensive goods will cause detriment to its valuable reputation and business. It claims that use of the later mark will dilute the distinctive character and reputation of its marks.

3. The applicant filed a counterstatement denying the claims made.
4. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.
5. Only the applicant filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

Legislation

6. Section 5(3) states:

“(3) A trade mark which-
(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

Reputation

7. In this regard, the following guidance from the Court of Justice of the EU is helpful: *General Motors v Yplon* [1999] E.T.M.R. 950 (“Chevy”):

“23. Such a requirement is also indicated by the general scheme and purpose of the Directive. In so far as Article 5(2) of the Directive, unlike Article 5(1) , protects trade marks registered for non-similar products or services, its first condition implies a certain degree of knowledge of the earlier trade mark among the public. It is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks, even when used for non-similar products or services, and that the earlier trade mark may consequently be damaged.

24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

8. The earlier trade mark therefore must be shown to be known by a significant part of the public concerned by the goods covered by that trade mark. In these proceedings, the earlier goods are clothing and so the relevant public is the public at large. The opponent must therefore demonstrate that its mark is known by a significant part of the public at large.

Evidence filed

9. The opponent’s evidence is comprised of two witness statements from Guvench G Gench, the representative of the opponent. Details are provided of the use made of the earlier trade mark in respect of clothing items. There is no indication of market share. There appears to be limited use in London and Manchester. However the duration and intensity of this is unclear. Details of advertising spend are provided and these are very small indeed: around £7,000 per year. The conditions of section 5(3) are cumulative and start with the

O-255-15

opponent having to evidence their reputation. In proving a reputation, it is not enough for the opponent merely to show that its trade mark has been used. It must show that it is known by a significant part of the public concerned, which is the general public in this case. The evidence filed by the opponent fails to do so. The opponent has therefore not managed to clear the first hurdle in respect of Section 5(3) as it has not shown that its earlier trade mark has a reputation. The opposition must therefore fail.

Final Remarks

10. It is noted that the evidence and arguments filed by both parties in these proceedings focussed upon issues of use, similarity of trade marks and confusion. These considerations are proper to the ground of opposition based upon Section 5(2)(b) of the Act. Since this section of the Act has not been pleaded, it has not been considered.

COSTS

11. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £600 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement:
£300

Considering evidence and filing evidence: £300

TOTAL: £600

12. I therefore order Tuncay Somez to pay Ahmet Erol the sum of £600. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3rd day of June 2015

**Louise White
For the Registrar,
The Comptroller-General**