

O-579-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3092999
BY IBRAHIM UZUN**

TO REGISTER:



AS A TRADE MARK IN CLASS 43

AND

**THE OPPOSITION THERETO UNDER NO. 404763
BY ANADOLU EFES BIRACILIK VE MALT SANAYII ANONIM SIRKETI**

BACKGROUND

1. On 5 February 2015 Ibrahim Uzun (“the applicant”) applied to register the mark shown on the cover page of this decision for the services listed below:

Class 43: Services for providing food and drink; restaurant, bar and catering services and restaurant take away food services.

2. The application was accepted and published in the Trade Mark Journal on 24 April 2015.

3. Anadolu Efes Biracilik ve Malt Sanayii Anonim Sirketi (“the opponent”) opposes the application on the basis of Section 5(2)(b) of the Trade Mark Act (“the Act”). The opposition is directed against all the services in the application. The original statement of grounds was based upon five trade mark registrations but was subsequently amended to include the following International Registration (IR):

International Registration details	Goods relied upon
<p data-bbox="204 1294 496 1328">IR No: No. 1014738</p>  <p data-bbox="204 1603 671 1637">International registration date:</p> <p data-bbox="204 1659 389 1693">24 July 2009</p> <p data-bbox="204 1715 475 1749">Designation date:</p> <p data-bbox="204 1771 389 1805">24 July 2009</p> <p data-bbox="204 1827 699 1910">Date of Protection of the International Registration in UK:</p> <p data-bbox="204 1933 448 1966">14 January 2010</p>	<p data-bbox="809 1294 1046 1328">Class 32: Beers</p>

4. As this is the only mark upon which the opponent now seeks to rely, there is no need for me to set out the other trade mark registrations relied upon in the original statement of grounds.

5. The opponent claims that the respective goods and services are highly similar and that the distinctive and dominant element in the respective marks is the word EFES. Therefore, there is a likelihood of confusion on the part of the public. It also states that its mark has a reputation, which increases the likelihood of confusion.

6. The applicant filed a counterstatement denying any likelihood of confusion and requesting that the opponent provides proof of use of the earlier mark, on which it relies¹. He also refers to an unregistered mark for the word EFES and states that he has been using that mark since 1974 in connection with restaurant services. Further, he submits that there has been prior and honest concurrent use of his mark with the opponent's mark. He states:

“As either section 5(4) of the Trade Marks Act during the registration procedures of the earlier trade mark registrations on which the opposition is based could have applied or section 47(2)(b) could have also applied once the trade marks on which the opposition is based were registered or protected in the UK, section 48(1) should now be applied and by analogy the owner of the later registered marks is not entitled to oppose the registration of the contested trade mark application in the event the marks under comparison were found to be similar which is denied by the applicant”.

7. I pause at this juncture to note that, as far as I am aware, the applicant has not sought to counterattack the opponent's registration on the grounds that he owns earlier unregistered rights in the mark EFES. As the validity of the opponent's registration is not challenged, the applicant's submissions are no more than assumptions and therefore, are not pertinent. As to the reference to Section 48 of the Act, it is clear that the applicant has misconceived it. Section 48 is as follows:

¹ The applicant requested proof of use in relation to all the goods for which the opponent's mark is registered, i.e. beers, preparations for making beer. However, the opponent is relying only on beers for the purpose of this opposition. Consequently, the applicant's request to provide proof of use must be read as limited to beers.

“Effect of acquiescence

(1) Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of five years in the use of a registered trade mark in the United Kingdom, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right—

(a) to apply for a declaration that the registration of the later trade mark is invalid, or

(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

1) unless the registration of the later trade mark was applied for in bad faith.

8. The provision introduces a statutory defence of acquiescence in favour of the owner of a later registered mark against an invalidity action or an action to oppose use brought against that mark by the proprietor of an earlier mark who has acquiesced for a continuous period of five years to its use. Accordingly, Section 48 does not provide a defence to opposition actions and the provision is not applicable to the facts of the case.

9. Both sides filed evidence during the evidence rounds and the applicant also filed written submissions. I have read all the papers carefully, but I will only summarise the evidence/submissions to the extent that I consider it necessary. Neither party asked to be heard, but the applicant filed written submissions in lieu of attendance at a hearing. I do not intend to summarise these submissions here, but I will bear them in mind and refer to them where appropriate.

DECISION

10. Section 5(2)(b) of the Act reads:

“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.”

11. An earlier trade mark is defined in Section 6(1) of the Act, which states:

“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.

12. In these proceedings, the opponent is relying upon the mark shown in paragraph 3, which qualifies as an earlier mark in accordance with Section 6 of the Act. As this mark completed its registration process more than five years before the publication date of the applied for mark, it is subject to the proof of use provisions. The period for which the opponent must show use of the earlier mark is the five-year period ending with the date of the publication of the applied for mark, i.e. 23 April 2010- 24 April 2015 (“the relevant period”).

13. The relevant sections of the Act read 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.

.....

(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.”

The opponent's evidence

14. This consists of a witness statement by Graeme Murray of WP Thompson, who represents the opponent in these proceedings, plus exhibits. Mr Murray explains that the opponent has instructed him to prepare a witness statement on its behalf and that the contents of his statement are true to the best of his knowledge and belief. He states that where he gives evidence of matters of which he has been told by others, those matters are true to the best of his knowledge and belief. According to Mr Murray, the opponent's goods have been advertised and sold in the UK under the mark for a large number of years and in any event, prior to the filing of the application. He states that the opponent's goods are sold in the UK through independent restaurants, stores and pubs. Attached to his witness statement are the following exhibits:

- Exhibit GM1 are black and white photocopies of photographs of what are said to be containers transporting the opponent's goods. The copies are of poor quality, but it is possible to see cardboard packaging bearing the opponent's mark. The pages are dated 17 August 2010 and, according to Mr Murray, the opponent has confirmed that the containers were imported into the UK on that date;
- Exhibit GM2 are black and white print-outs from Tees Limited's website, the opponent's UK distributor. The pages, dated between 7 March 2013 and 17 March 2015, are obtained from the web archive Way Back Machine. The website identifies the opponent's mark as one of the beer brands supplied by Tees and shows prominent use of the opponent's mark. The mark also appears affixed to bottles and cans of beer. The exhibit includes two copy of invoices dated 13 February 2012 addressed to TEES LTD in London for the

supply of goods under the opponent's mark. According to Mr Murray, the mark is shown on the top of the invoices, though the element Pilsener is not discernable. The details on the face of the invoices are in Turkish followed by the corresponding terminology in English. One of the invoices shows that the following quantity of EFES Pilsener were sold: (i) 1,428 x EFES PILSENER (KOLI) 33 cl (unit price £4.36 total £6,226.08); (ii) 2,772 x EFES PILSENER (KOLI) 50 cl (unit price £5.50 total £15,246); (iii) 400 x EFES PILSENER (TAVA) 50 cl (unit price £ 4.75 total £1,900). The total value of those sales amounted to £23,372.08. There is no explanation of what KOLI or TAVA means but, given the cost of the products per unit, it seems reasonable to infer that they are cases in which a certain number of bottles/cans were delivered. The other invoice is for 2 x 100 x KOLI E-PILS 50 cl (unit price £0.21, total £42) but there is nothing to confirm that KOLI E-PILS is a shorthand for EFES Pilsener;

- GM3-GM4 are black and white photocopies of undated photographs purported to show EFES Pilsener beer on sale at a cash and carry outlet in Enfield and in other (unspecified) UK stores. The copies show cardboard packaging bearing the opponent's mark on shelves next to cases bearing other marks, including well-known brands of beer, e.g. Heineken and Peroni. The copies include pictures of in-store promotional banner stands reproducing images of bottles labelled with the opponent's mark. Once again, the quality of the copies is poor, but it is possible to see the price in sterling;
- GM5 is an undated black and white copy of an advertisement from what is said to be a UK publication, which shows the words "Efes is now on tap in UK". The images are of poor quality, but it is possible to discern the opponent's mark on labels affixed to bottles;
- GM6 is an undated black and white copy of a photograph purported to show use of the opponent's mark on the side of a restaurant signage, which is said to be Constolia Restaurant in Holloway Road, London, though the word Pilsener is not discernable;

- GM7 are undated black and white copies of photographs showing beer mats, which bear the opponent's mark, featuring prominently on a bar. The pictures are said to be representative of use of the opponent's mark at JD Wetherspoons pubs, though the locations are not confirmed. The mark shown on beer taps is without the word Pilsener.

The applicant's evidence

15. This consists of a witness statement by Lankanath Rathnayake of Freeman Harris Solicitors, who represents the applicant in these proceedings, plus exhibits. This evidence purports to show use of the name EFES in the UK by the applicant in relation to restaurant services. However, for the reasons explained in paragraph 7 above, this evidence is not pertinent, thus, I will say no more about it. The evidence also includes prints from the cross-search list on the Intellectual Property Office's (IPO) website and from the online similarity tool available through the European Union Intellectual Property Office's (EUIPO) website. I will refer to this evidence below when dealing with the comparison of goods and services.

Proof of use

16. 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 marks. He stated:

"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 Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [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] 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]; *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 the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

17. The correct approach to assessing the evidence is to view the picture as a whole, including whether individual exhibits corroborate each other². The evidence is hearsay and is arguably vague, for example there is no indication of turnover, marketing spend and/or market share held by the mark and the material provided is mostly undated. That said, despite its lacunas, it is clear from Mr Murray’s evidence that the opponent has imported, advertised and sold beer in the UK under the mark during the relevant period. This is supported by the invoices provided. This evidence, shows that a trade has taken place under the mark during the relevant period and that the opponent’s use is not merely “token use”, undertaken solely to preserve the registration of the mark. Mr Murray states that the opponent’s goods are sold in UK stores, pubs and restaurants, so on a reasonable reading, the evidence supplied constitute only examples of use. Further, Mr Murray makes a statement of truth in his witness statement, the content of which has been neither criticised nor challenged by the applicant. Whilst the only evidence that unambiguously shows use of the mark in the relevant period is limited to use by a single importer (TEES Ltd) this is not fatal, as such use can count towards genuine use³. I am also satisfied that the evidence

² *Brandconcern BV v Scooters India Limited* (“Lambretta”) BL O/065/14.

³ Court of Appeal’s judgment in *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 5 paragraph 33.

showing the mark in the colour black and white counts as genuine use of the mark as registered⁴ and that the invoices demonstrate UK sale of at least £23,372.08 worth of goods during the relevant period. Whilst the use set out is small compared to the large volume of beer sold by many beer brands, some beers are no doubt sold in small quantities, i.e. craft beers and micro-brewing. Overall, taking into account the low cost and the nature of the goods concerned, I consider that the opponent has made commercial use of the mark aimed at maintaining or creating an outlet for the goods or a share in the market. The level of use demonstrated is sufficient to constitute genuine use in relation to the goods relied upon, i.e. beers.

Section 5(2)(b) - case-law

18. 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:

- (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;

⁴ The UK courts have traditionally regarded the registration of a trade mark in black and white as covering use of the mark in any colour (and vice versa). Further, the evidence in black and white is in line with the MAD case (Judgment of 24/05/2012, T-152/11, 'MAD', paras. 41, 45), where the General Court considered that use of a mark in a different form is acceptable, as long as the arrangement of the verbal/figurative elements stays the same, the word/figurative elements coincide, are the main distinctive elements and the contrast of shades is respected.

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

19. In comparing the respective specifications, all the relevant factors should be taken into account. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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”.

20. The respective goods and services are shown below:

Applicant’s services	Opponent’s goods
Class 43: Services for providing food and drink; restaurant, bar and catering services and restaurant take away food services.	Class 32: Beers

21. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (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 fur 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”.

22. 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 users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

23. I also bear in mind the decision in *Boston Scientific Ltd v OHIM*, Case T-325/06, where the GC stated that “complementary” means:

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

24. 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.”

25. 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”

26. The opponent has been entirely silent as to why it considers the goods and services to be similar. Its only reference to the goods and services is in its notice of opposition, in which it merely states that they are highly similar. The applicant comments on the similarity in the following terms:

“The contested services in class 43 are intended to serve food and drinks, and thus providing also the goods of the opponent directly for consumption. The mere fact that drinks, in this case a type of beer, are consumed in a restaurant is not enough reason to find similarity between the beverages and the services. The consumer is aware that the foods and drinks being served are manufactured by different company (see judgment of 09/03/2005, T-33/03, “Hai”, paragraph 45; and decision of 20/10/2011, R1976/2010-4 “THAI SPA/SPA et al.”, paragraphs 24-26)⁵”.

27. The applicant considers that he is supported in his opinion by the results of a search conducted using the EUIPO’s online search tool for the assessment of similarity. This shows that, according to the UK IPO practice, beer and restaurants are dissimilar. He also relies on the cross-search list on the IPO’s website. While I accept that the EUIPO’s similarity tool may provide a useful starting point, it is only a guide and the comparisons in the tool are not legally binding upon any entity⁶.

⁵ R1976/2010-4 is a decision of EUIPO, however, opposition decisions of EUIPO do not bind national offices. As to the reference to Case T-33/03, in that case the comparison was between, inter alia, “non-alcoholic drinks; syrups and other preparations for making beverages” in class 32 on the one hand and “accommodation and catering for guests” in class 42 on the other hand and, therefore, the GC did not make a specific finding in relation to the similarity between beers and restaurants services.

⁶ See <http://euipo.europa.eu/sim/> where it is stated: “CF Similarity is a search tool which you can use in order to assess whether given Goods and Services are considered similar (and to what degree) or dissimilar according to the Participating IP Offices. The tool endeavours to reflect the practice of these IP Offices but the comparisons in

Likewise, the cross-search list is merely a guide to be used during the examination process; it is not determinative of the question of similarity of goods and/or services in inter partes proceedings. In *Proctor & Gamble Company v Simon Grogan*, O-176-08, Anna Carboni, sitting as the Appointed Person, stated:

“32. The International Classification system also applies to Community trade marks. Rule 2(4) of Commission Regulation 2868/95/EC implementing the Regulation on the Community trade mark (40/94) states as follows:

(4) The classification of goods and services shall serve exclusively administrative purposes. Therefore, goods and services may not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services may not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

33. It is thus made plain under the Community trade mark system that class numbers are irrelevant to the question of similarity of goods and services.

34. There is no similarly plain provision in the Act or the Directive. The Court of Appeal has held that, although the purpose of classifying goods and services is primarily administrative, that does not mean that the class numbers in an application have to be totally ignored in deciding, as a matter of construction, what is covered by the specification: *Altecnic Ltd's Trade Mark Application (CAREMIX)*. But neither the Court of Appeal, nor the ECJ, nor any other court or tribunal in the United Kingdom, has gone so far as to state that class numbers are determinative of the question of similarity of goods in the case of national trade marks. On the contrary, they are frequently ignored.”

28. In the absence of any evidence to assist me, I must form my own view on the similarity or otherwise in the respective goods and services. In deciding whether the

the tool are NOT LEGALLY BINDING upon any entity. Furthermore, practice may differ from office to office. The extent to which the comparisons accurately reflect the current practice of any participating IP Office is the sole responsibility of that office.”

respective goods and services are similar, I must consider the factors set out in the case law outlined above and am able to draw upon commonly known facts. Mr Geoffrey Hobbs QC sitting as the Appointed Person said in *Raleigh International trade mark* [2001] R.P.C. 11 at paragraph 20, that evidence of similarity will be required if the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered. But where there is self-evident similarity, and especially in relation to everyday items, evidence may not be necessary.

29. I will make the comparison with reference to the services for which protection is sought.

Services for providing food and drink

30. The Oxford English Dictionary defines a pub as “an establishment for the sale of beer and other drinks, and sometimes also food, to be consumed on the premises.” Accordingly, the term “services for providing food and drink” in the applied for specification is broad enough to encompass pub services, which commonly serve beer, other drinks and food of some type. The nature of the services, their methods of use and their purposes differ from those of beer though, in providing beer to customers, the service is a channel of trade for the goods. The users of the services will be the same as those who purchase beer from retailers for consumption off the premises. In this sense there is some degree of competition. However, both the social component offered by these establishments and the cost of the service, which will be reflected in the price, will contribute to the choice; so the competition has limits. Goods and services are clearly complementary as the goods are no doubt indispensable or important to consumers for their use in these establishments and it is not unusual in the UK for producers of beer (breweries) to operate their own pubs. I find that on account of the complementarity, competition, target audience and overlapping points of sale, **there is a medium degree of similarity between services for providing food and drink and beers.**

Bar services

31. A bar is a drink related service, i.e. an establishment and/or counter where one can purchase and consume drinks, principally cocktails and alcoholic drinks, including beers. A bar could also be a mobile facility provided at events (catered or otherwise) such as, for example, weddings and musical festivals. For the same reasons to those expressed above in relation to pub services, **there is medium degree of similarity between bar services and beers.**

Restaurant services

32. A restaurant is an establishment where meals are prepared and served to paying customers. Once again, the nature of the services, their methods of use and their purposes differ from those of beer. Restaurants will usually serve alcohol (including beers) in addition to food but any competition is remote. You would not go to a restaurant merely to drink a beer and the dining experience is the motivating factor. Whilst the goods are complementary to the service when offered through restaurants, the crucial question is whether they are important in such a way that consumers may think that the responsibility for those goods lies with the same undertaking. In this connection, I note that producers of beer do not routinely also provide restaurant services and whilst restaurants might well sell house wines under their own name, there is no evidence that restaurants sell their own private label beers under the same mark that identifies their services. The majority of restaurants in the UK, in my experience, offer a small range of beers (and other drinks) from a range of producers and so are not inextricably linked to a single producer. Balancing all the various factors, **any similarity between restaurant services and beers must be pitched at a very low level.**

Catering services

33. Catering services are in general the business of preparing and serving food for the public at a social/business event, i.e. weddings, or other gathering. The services are normally provided at a remote site, e.g. hotel, or other locations. There is no similarity between beer and catering services in term of nature, purpose and method

of use, and whilst providers of catering services may perhaps serve beverages, i.e. bottles of water, wine and beer, to their customers, the service would not include the serving of alcoholic drinks through a bar, as this would effectively be a bar service. If the catering provider offered a bar service, this would be a distinct and additional service. The average consumer will be the event organiser, not the one consuming the goods at the event, so users are not shared. There is no competition, as you would not choose between buying a beer from a retail outlet and using the services of a catering provider, simply because the services typically involve catering bookings for a minimum number of orders/people. Even if it is considered that the applied for catering services could cover mobile catering, where the service is provided directly to the end users, this would normally involve the provision of food not (alcoholic) drinks. Further, catering enterprises, even if they prepare the meals they provide, do not themselves manufacture the drinks that they serve to their customers. Overall, the services are one step removed from the opponent's goods and **there is no meaningful similarity between catering services and beers.**

Restaurant take away food services

34. Restaurant take away food services do not usually provide beer and there is no evidence to the contrary. Consequently, I find that **there is no similarity between restaurant take away food services and beers.**

The average consumer and the nature of the purchasing act

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

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the

relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

36. As the matter is to be approached on a notional basis, there is no need for me to consider the average consumer for the services which I have found are not similar, as in such circumstances there can be no likelihood of confusion. On the basis of my findings, there is no similarity between the goods of the earlier mark and the following applied for services:

Class 43: Catering services and restaurant take away food services.

37. Accordingly, **the opposition fails under Section 5(2)(b) of the Act in respect of the above services. As there is no need for me to consider these services further, they form no part of the rest of my decision.**

38. The average consumer of beer is the adult general public. The purchase is primarily a visual one; the average consumer will either visually self-select the goods from a shelf in a supermarket/off-licence or from a website or scan the goods from shelves, fridges, optics and hand pumps/taps in pubs and bars. However, I do not discount the potential for aural considerations, as goods may be ordered orally from a member of staff. Turning to the level of attention the average consumer will display when selecting the goods, the cost of the goods is likely to be relatively low, but bearing in mind that the consumers will wish to ensure they are selecting the correct type and/or flavour of beer, they are, in my view, likely to pay an average degree of attention to the selection.

39. In respect of the applicant’s contested services, i.e. services for providing food and drink (to the extent they include pub services), bar and restaurant services, the average consumer is the public at large, though over 18 when the services are used for the purchase of alcoholic drinks. The services are most likely to be selected visually by reference to the name of the establishments themselves or by reference to advertising whether in print form or online. That said, the services are often the

subject of oral recommendations, so I must not ignore aural considerations. The level of attention deployed during the selection of the services will vary from relatively low, i.e. a bar chosen on a night out on the spur of a moment, to higher than average, i.e. restaurant services chosen and pre-booked for a special event.

Distinctive character of earlier mark

40. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*²⁶, 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-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).”

41. The applicant submits that the term EFES refers to the Turkish name for the ancient Greek city of Ephesus. However, there is no evidence that the UK average consumer is aware of this meaning, thus, the element EFES in the opponent’s mark is likely to be perceived as an invented word. Invented words usually have a high

degree of inherent distinctive character. The decorative elements of the mark add some distinctiveness to it, however, as these elements have no counterpart in the applied for mark this cannot strengthen the opponent's case⁷. The opponent has not shown that any use of its mark has increased that high level of distinctive character to any material extent. Overall, the opponent's mark is endowed with a high degree of distinctive character.

Comparison of marks


42. 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 them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

44. The respective marks are shown below:

⁷ The level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the elements of the marks that are similar. See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

Applicant's Mark	Opponent's Mark
	

Overall impression

45. The applicant's mark consists of the word EFES in capital bold letters in an unusual stylised font with pointed features. The letters, presented against a brown rectangular background, are in the colour yellow with a thin brown outer line which itself is surrounded by a thin white outer edge. The stylisation makes a contribution to the overall impression of the marks, though the word EFES carries the greater weight.

46. The opponent's mark consists of word EFES in capital letters presented in a large thick bold font and in the colour white against an offset oval blue background. The letters E and S are slightly bigger to look as if they are raised and closer to the onlooker. The blue background has a thin white and red and thick gold surround and a degree of shading in the colour which creates a metallic appearance. Below the word EFES, is the word Pilsner presented in a significantly smaller font, in the colour white and in lower case with the initial P capital. The word Pilsener describes a type of beer⁸ and, in my view, the average consumer of beer would be aware of that meaning. Accordingly, the word Pilsener is not distinctive for the goods for which registration is sought and has little weight in the overall impression the mark conveys. Whilst the get-up is visually striking, it is a background to the words and I consider that word EFES has the greatest relative weight in the overall impression the mark conveys.

⁸ Oxford English Dictionary defines Pilsener as "a lager beer with a strong hop flavour, originally brewed at Pilsen (Plzeň) in the Czech Republic"

Visual similarity

47. The applicant's mark is presented in brown and yellow, the opponent's mark in blue, white, red and gold. Since neither the opponent's nor the applicant's mark is limited to colour the matter must be assessed on the similarity between the respective marks without regard to colour⁹.

48. Visually there is a similarity as both marks contain the word EFES. There are though some clear differences as a result of the get-up and background material which are significant distinguishing features. In my view there is a medium degree of visual similarity.

Aural similarity

49. Aurally, both marks are phonetically identical as far as the word EFES is concerned. Although the word Pilsener must also be taken into account, it is not easily pronounceable and in my experience, it is not unusual for the descriptive element of a mark to be dropped in speech. Consequently, it is likely that the average consumer will refer to the opponent's mark by the word EFES alone, in which case the competing marks would be aurally identical.

Conceptual similarity

50. From a conceptual perspective, the finding I have already made (that EFES is likely to be perceived as an invented word) means that no conceptual similarity is created due to the common presence of EFES in the respective marks. The position is more of a neutral one given that neither mark possesses a clear conceptual meaning.

Likelihood of confusion

51. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser

⁹ *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch).

degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

52. In his submissions, the applicant refers to *Corporation v Eagle Technologies Ltd* [2011] RPC 17, a case which relates to a claim for infringement under Article 5(1) of the Trade Mark Directive 2008/95/EC¹⁰ and to the requirement of damage to the origin function. However, this is not the correct test for the assessment of the likelihood of confusion under Section 5(2)(b) of the Act and the reference is clearly misconceived. The applicant also refers to the coexistence of the marks on the marketplace and argues that UK consumers “are well aware of the differences between the restaurant services provided by the applicant and the beer goods provided by the opponent”. In *Aceites del Sur-Coosur SA v OHIM*, Case C-498/07 P, the CJEU found that:

“82. First, although the possibility cannot be ruled out that the coexistence of two marks on a particular market might, together with other elements, contribute to diminishing the likelihood of confusion between those marks on the part of the relevant public, certain conditions must be met. Thus, as the Advocate General suggests at points 28 and 29 of his Opinion, the absence of a likelihood of confusion may, in particular, be inferred from the ‘peaceful’ nature of the coexistence of the marks at issue on the market concerned.

83. It is apparent from the file, however, that in this case the coexistence of the La Española and Carbonell marks has by no means been ‘peaceful’ and the matter of the similarity of those marks has been at issue between the two undertakings concerned before the national courts for a number of years.”

53. The applicant’s evidence only relates to use of his mark and the evidence of use by the opponent covers only a number of years. There is no evidence of a long

¹⁰ Implemented in the UK by Section 10 of the Act

period of peaceful and concurrent use of the respective marks and the applicant has filed no evidence to support his claim that UK consumers would be aware that the respective goods/services are being provided by different companies. Accordingly, I dismiss the applicant's claim as unsubstantiated.

54. Confusion can be direct, in the sense that one mark is mistaken for the other, or indirect, in the sense that the average consumer will assume that the common elements in the marks (and the similarity of the goods/services) mean that the undertakings responsible for the goods and/or services are the same or are economically related. In terms of direct confusion, it is unlikely to arise where the goods and services are not identical or highly similar¹¹. In the circumstances of the case, the differences in the goods and services, coupled with the visual differences between the marks means that one mark will not be mistaken for the other. **There is no likelihood of direct confusion.**

55. As to whether there is, nevertheless, a likelihood of indirect confusion, it is helpful to consider the comments of Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, case BL-O/375/10 where he stated:

“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.

¹¹ See BL-O-328/16 paragraph 29

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

56. As to the use of the applied for mark in connection with services for providing food and drink and bar services, I found that there is a medium degree of similarity between the respective goods and services. Whilst there are clear visual differences between the respective marks, the marks are aurally identical and there is no conceptual hook for the memory of the consumer, which would help him or her to distinguish between them. I also bear in mind the high distinctive character of the word EFES, the nature of the goods and services and the average degree of attention deployed through the purchase. Balancing all these factors, my conclusion is that the average consumer is likely to assume from the common use of the word EFES and the relatedness of the respective goods and services, that the producer of EFES beer is the source of EFES services. **There is a likelihood of indirect confusion in respect of the applied for services for providing food and drink and bar services.**

57. In relation to restaurant services, whilst I have detected a degree of similarity, I found that any similarity is at the lower end of the spectrum. On balance, I come to the view that the visual differences in the get-up of the marks, combined with the

minimal degree of similarity between the respective goods and services, are sufficient to prevent the high distinctive character of the EFES element from giving rise to indirect confusion. In the absence of evidence to the contrary, there is no reason to believe that the average consumer would expect a producer of beer to “branch out” into restaurant services. The average consumer is unlikely to assume that the applicant’s restaurant services are associated with the opponent’s beers; rather, the similarity between the marks will be attributed to coincidence not economic connection. **There is no likelihood of indirect confusion in respect of the applied for restaurant services.**

CONCLUSIONS

58. Given my findings, the opposition succeeds in relation to the following services:

Class 43: Services for providing food and drink; bar services

59. The opposition fails in relation to the following services:

Class 43: Restaurant services

COSTS

60. Both parties have achieved a roughly equal measure of success and so I direct each side to bear their own costs.

Dated this 8th day of December 2016



**pp Teresa Perks
For the Registrar
The Comptroller – General**