

O-034-15

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3017785
BY CANSA ELEKTRONİK SANAYİ VE DIŐ TİCARET LİMİTED ŐİRKETİ
TO REGISTER
THE TRADE MARK:

Dünya Optik

IN CLASSES 9, 35 & 40

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 401331 BY
DUNYA GOZ HASTANESI
SANAYI VE TICARET ANONIM SİRKETİ

BACKGROUND

1. On 27 August 2013 (claiming an International Convention priority date of 6 August 2013 from Turkey), Cansa Elektronik Sanayi Ve Dış Ticaret Limited Şirketi (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application was published for opposition purposes on 11 October 2013, for the following goods and services:

Class 9 - Eye protectors; Eye refractometers; Eye glasses; Eye protectors; Eye refractometers; Eyeglass cases; Eyeglass chains; Eyeglass cords; Eyeglass frames; Eyeglass shields; Eyeglasses; Eyepieces; Eyepieces (Instruments containing -); Aerial amplifiers; Aerial boosters; Aerial combiners; Aerial converters; Aerial filters; Aerial sockets; Aerials; Cash dispensing machines; Electric adaptors; Electric battery chargers; Electric blanking plugs; Electric boosters; Electric breakers [switches]; Electric cables; Electric capacitors; Electric control apparatus; Electric convertors; Fire extinguishers; Fire extinguishing apparatus; Glass ophthalmic lenses; Glasses cases; Laboratory centrifuges; Laboratory dispensers; Laboratory filters; Laboratory furniture [specifically adapted]; Laboratory glassware; Laboratory incubators [other than for medical use]; Laboratory instruments [other than for medical use]; Laboratory mixers; Laboratory optical apparatus; Laboratory oscilloscopes; Laboratory trays; Magnet boards; Magnetic badges; Magnetic carriers; Magnetic coded card readers; Magnetic data carriers, recording discs; Magnetic data media; Magnetic detectors; Magnetic discs; Magnetic disk drives; Magnetic diskettes; Magnetic disks; Magnetic drums; Magnetic encoded card readers; Magnetic encoded cards; Magnetic encoders; Magnetic recording charts; Magnetic recording discs; Magnetic recordings; Measuring devices, electric; Measuring glassware; Measuring instruments; Measuring sensors; Meters; Protection devices against X-rays, not for medical purposes; Protection devices for personal use against accidents; Protection masks; Protective clothing; Protective clothing made from ballistic resistant materials; Protective eyeglasses; Protective eyewear; Protective face-shields for protective helmets; Protective footwear for the prevention of accident or injury; Protective glasses; Protective goggles; Protective headgear; Protective spectacles; Protective work clothing [for protection against accident or injury]; Radar; Radar instruments; Satellite aerials; Satellite apparatus; Satellite receivers; Satellite signal receiving antennae; Satellite transceivers; Satellite transmission apparatus; Satellites; Satellites for communication purposes; Sonar apparatus; Sonars; Sun glasses; Sunglasses; Sunglasses frames; Ticket dispensers; Traffic control apparatus [lighting]; Traffic guidance apparatus [electric]; Traffic guidance apparatus [luminous sign]; Traffic-light apparatus [signalling devices]; Video devices; Video digitisers; Video editing apparatus; Video graphics controller; Voice processing systems; Voice processors; Voice recognisers; Voice response equipment; Voice synthesizers; Voice transmission apparatus.

Class 35 - Administration of businesses; Administration of foreign business affairs; Administration of the business affairs of retail stores; Administration relating to marketing; Exhibitions (arranging-) for advertising purposes; Exhibitions (arranging-) for business purposes; Exhibitions (arranging-) for commercial purposes; Exhibitions (arranging-) for trade purposes; Exhibitions (conducting-) for advertising purposes; Exhibitions (conducting-) for business purposes; Exhibitions (conducting-) for commercial purposes; Exhibitions (conducting-) for trade purposes; Exhibitions (Organization of -) for commercial or advertising purposes; Exhibitions (organization of-) for commercial or advertising purposes; Market campaigns; Market research; Shop window dressing; Shop window dressings; Shop-window dressing; Advertisement and publicity services by television, radio, mail; Advertising; Business administration services; Business administration services for processing sales made on the internet; Business advertising services relating to franchising; Consultancy (professional business-); Consultancy relating to business efficiency; Consultancy relating to the selection of personnel; Consultations relating to business management; Customer club services, for commercial, promotional and/or advertising purposes; Customer loyalty services for commercial, promotional and/or advertising purposes; Import agency services; Import and export agencies; Import and export agencies services; Import and export services; Import-export agencies; Office administration services [for others]; Office functions; Office functions services; Office machine rental services; Office machines and equipment rental ; Office machines (Rental of-); Office management services [for others]; Office support staff recruitment services; Permanent staff recruitment; Personal management consultancy services; Personality testing for business purposes; Personnel consultancy; Personnel management.

Class 40 - Abrasive polishing; Metal brazing; Metal casting; Metal coating; Metal coating [not painting]; Metal colouring [not painting]; Metal cutting; Metal finishing; Metal forging; Metal hardening; Metal laminating; Metal machining; Metal moulding; Metal plating; Metal plating and laminating; Metal polishing; Metal pressing; Metal stamping; Metal tempering; Metal treating; Metal treatment services; Photographic developing; Photographic duplicating; Photographic enlarging; Photographic etching; Photographic etching of articles of clothing; Photographic etching of fabrics; Photographic etching of household articles; Photographic etching of paper; Photographic etching of printed matter; Photographic etching of textiles; Photographic film developing; Photographic film development; Photographic image processing; Photographic preservation; Photographic preservation and conservation; Photographic printing; Photographic printing apparatus (rental of-); Photographic processing; Photographic processing apparatus (rental of-); Photographic reproduction; Photographic restoration; Photographic restoration services; Photographic retouching; Photographic slide and print processing; Photogravure; Photogravure printing; Photo-printing; Air treatment; Animals (Slaughtering of -); Chemical processing of liquids; Cloth dyeing; Cloth edging; Cloth fireproofing; Cloth pre-shrinking; Cloth treating; Cloth waterproofing; Clothing (hot-pressing of -)

[forming of clothing]; Clothing (shrinking of -); Food and drink preservation; Food canning; Food grinding; Food milling; Food preservation; Food processing; Food smoking; Foods (Freezing of -); Fur (custom fashioning of-); Fur cutting; Fur dyeing; Fur working; Gas compression services; Gas processing services; Gas production services; Glass blowing; Glass etching; Glass polishing; Glass tinting; Glass-blowing; Grinding and polishing glass for eyeglasses; Grinding of lenses; Grinding of optical glass; Grinding (optical glass-); Grinding (Optical glass -); Leather working; Metal casting; Metal coating; Metal cutting; Metal finishing; Metal forging; Metal hardening; Metal laminating; Metal machining; Metal moulding; Metal plating; Metal plating and laminating; Metal polishing; Metal pressing; Metal stamping; Metal treating; Metal treatment; Metal treatment services; Paper bleaching; Paper finishing; Paper treating; Paper treatment; Photofinishing; Photographic developing; Photographic duplicating; Photographic enlarging; Photographic etching; Photographic film developing; Photographic film development; Photographic image processing; Photographic printing; Print finishing [binding] services; Print finishing [cutting] services; Print finishing [folding] services; Print finishing services; Printing; Saddlery working; Wood-carving; Wood-working.

2. The application was opposed by Dunya Goz Hastanesi Sanayi Ve Ticaret Anonim Sirketi ("the opponent") originally on the basis of sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). However, as the opponent elected not to file any evidence in these proceedings, the claim based upon section 5(4)(a) was struck out. The opposition, which was originally directed against all of the goods and services in the application (but see paragraph 12 below), was based upon the services shown below in the following International Registrations ("IR"):

IR no. 1129389 for the trade mark:



which designated the United Kingdom on 12 March 2012 and the registration process for which was completed on 3 January 2013:

Class 44 - Medical services, namely, medical assistance services, hospitals, medical clinics, blood banks, dentist services, nursing care, optician services, physical rehabilitation, massage services, pharmaceutical advice, pharmacists' services to make up prescriptions, mental health services, psychiatric services; consultation services relating to beauty care, Turkish baths, beauty salons, cosmetician services; health spa services, namely, cosmetic body care services; hairdressing services, manicuring; veterinary services, animal grooming, animal breeding, animal care, pet care services, namely, dog walking, dog bathing, non-medicated pet grooming and in-home medical care; agricultural advisory

services, gardener and gardening services, horticultural services, garden care services, lawn care services, plant care services, planting of trees, plant nurseries, insecticide spraying in agriculture, spreading of fertilizers and other agricultural chemicals by aerial or surface means, rental of agricultural equipment, landscaping services, namely, landscape design, landscape gardening.

IR no. 854381 for the trade mark:



which designated the United Kingdom on 11 November 2004 and the registration process for which was completed on 22 January 2006:

Class 44 - Medical services, medical assistance, hospitals, medical clinics, medical nursing, opticians' services.

IR no. 1098924 for the trade mark:



which designated the United Kingdom on 25 July 2011 (claiming an International Convention priority date of 27 June 2011 from Turkey) and the registration process for which was completed on 21 March 2012:

Class 44 - Medical services, namely, medical assistance services, hospitals, medical clinics, dentist services, nursing care, optician services, physical rehabilitation, pharmacists' services to make up prescriptions; cosmetician service; health spa services, namely, cosmetic body care services; hairdressing services, manicuring; veterinary services, animal grooming, animal breeding, animal care, pet care services; agricultural advisory services, gardener and gardening services, horticultural services, garden care services, lawn care services, plant care services, planting of trees, rental of agricultural equipment, landscaping services, namely, landscape design, landscape gardening; rest homes.

3. In its Notice of Opposition, the opponent states:

“3. It is submitted that the contested mark is similar to the earlier marks and covers similar goods and services...

4. The beginning of the contested mark is identical to earlier mark No. 1129389 and the emboldened and most dominant element of earlier mark no. 854381. The marks are conceptually identical, alternatively highly similar, one meaning “world eye” and the other “world optic”. To those who do not attribute a meaning to the Turkish elements of the marks, the identical element will have an even greater impact. The contested mark is a direct, alternatively, near direct, translation.”

4. The applicant filed a counterstatement which consists, in essence, of a denial of the grounds upon which the opposition is based. In its counterstatement, it states, inter alia:

“DÜNYA, in English means world, and is a universal word in the Turkish language. Anyone can use the word DÜNYA (world).

There is no similarity in the goods and services offered by these two companies. The Opponents business is in class 44 and the Applicant’s business is in class 9, 35 and 40.

The Opponent runs Eye Hospitals and the Applicant runs Optical shops which sell contact lenses, prescription glasses and sun glasses in Turkey. Under Turkish law, Eye Hospitals cannot sell or offer glasses and contact lenses: and Optical Shops are not allowed to offer medical eye examinations or treatments.

Therefore, there is no likelihood of confusion as the Applicant’s business is in prescription glasses, sun glasses and contact lenses, whereas the Opponent’s business is only in medical eye treatment in hospitals in Turkey. It is for this reason that the Opponent business is only registered under Trademark class 44 in the UK. Therefore as both companies are providing a different service, there would be no confusion in the nature of their business.

The average consumer would easily understand that the two companies are undertaking two completely different types of business. These two companies are also registered in two different nice classes.

In addition, the logos are not identical The circle represents the “world” which in Turkish means “Dünya”. The meaning of “Optik” in Turkish is Optician. “Dünya Optik’ in Turkish means “World Optician”. however ‘Dünyagoz” in Turkish means ‘World Eye’.

As "Optik" is an optician related word, consumers will not be confused with the goods and services offered as defined under classes 9, 35 and 40. In addition. 'Optik' does not mean "eye". The Applicant has applied for "DÜNYA OPTIK": "DÜNYAGOZ" does not have the same meaning as DÜNYA OPTIK".

...the logos are different also. Turkish speaking consumer can easily differentiate that "DÜNYA OPTIK' is related prescription glasses, contact lenses and sun glasses whilst the Opponent's logo is related to medical eye treatment in hospitals. Both companies are already well known in Turkey with regards the nature of their businesses."

5. In an official letter dated 18 February 2014, the Tribunal wrote to the applicant. It stated, inter alia:

"The Registry has noted the website printouts filed by the applicant with the Form TM8, which the Registry classes as evidence. Should the applicant wish to file documents to be considered as evidence, then any such evidence should be filed at the appropriate time and in the correct format. A period for the applicant to file evidence will be provided later in the proceedings."

6. As the applicant elected not to respond to that direction, the documents attached to the counterstatement will play no part in my decision. Neither party filed evidence or asked to be heard, nor did they file written submissions in lieu of attendance at a hearing.

DECISION

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

"5 (2) A trade mark shall not be registered if because -

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

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

8. 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.”

9. In these proceedings, the opponent is relying upon the three trade marks shown in paragraph 2 above, all of which qualify as earlier trade marks under the above provisions. In its counterstatement, the applicant asked the opponent to provide proof of use in relation to “Classes 9, 35 and 40”. However, as the Tribunal pointed out in an official letter dated 18 February 2014, as none of the earlier trade marks were registered in those classes and as IR nos. 1129389 and 1098924 had not been registered for more than five years when the application was published and were not subject to the proof of use provisions as per section 6A of the Act (although IR no. 854381 was), the applicant should reconsider its request. Although the applicant was allowed until 11 March 2014 to file an amended counterstatement, it elected not to respond to that invitation. In the circumstances, the opponent is entitled to rely upon all of the services upon which it indicates it wishes to rely (i.e. those shown in paragraph 2 above).

Section 5(2)(b) – case law

10. 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 the earlier mark to mind, is not sufficient;

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

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

Comparison of goods and services

11. In a letter to the opponent dated 1 December 2014, I stated:

“The above set of proceedings has been passed to me to issue a substantive decision from the papers.

Having reviewed the proceedings, I note that your client’s opposition, which is based upon three earlier trade marks protected in class 44, is directed against all of the goods and services in the application. However, although in its Notice of Opposition the opponent states, inter alia, that the application “covers similar goods and services” to those contained in its earlier trade marks, it has not indicated which services in its earlier trade marks it considers to be similar to which goods and services in the application and, importantly, it has not explained why it considers that to be the case.

From a cursory review of the competing specifications, I am unable to discern why the services upon which the opponent relies ought to be considered similar to many of the goods and services in the application. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. **If there is no similarity at all, there is no likelihood of confusion to be considered.** If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”(my emphasis).

In view of the above, **I direct the opponent to identify, within 14 days of the date of this letter**, which services in its earlier trade marks it considers to be similar to which goods and services in the application and to explain **precisely** why it considers this to be the case. Where it is unable to do so, **it should indicate against which goods and services in the application its opposition is to be withdrawn.**

The opponent’s letter should be copied to the applicant, **who will then be allowed a period of 14 days from the date that it receives a copy of the letter to provide comments.** At the conclusion of that period, the proceedings will be returned to me for substantive determination.”

12. The opponent responded to that direction in a letter dated 16 December 2014. It restricted both the breadth of its opposition and the services upon which it relied; the applicant elected not to file any submissions in response to the opponent’s letter. The competing services are now as follows:

Opponent’s services being relied upon in class 44	Applicant’s goods and services
<p>IR no.1129389 - Medical services, namely, medical assistance services, hospitals, medical clinics, blood banks, optician services.</p> <p>IR no. 854381 - Medical services, medical assistance, hospitals, medical clinics, opticians’ services.</p> <p>IR no. 1098924 - Medical services, namely, medical assistance services, hospitals, medical clinics, opticians’ services.</p>	<p>Class 9 - Eye protectors; Eye refractometers; Eye glasses; Eye protectors; Eye refractometers; Eyeglass cases; Eyeglass chains; Eyeglass cords; Eyeglass frames; Eyeglass shields: Eyeglasses; Eyepieces; Eyepieces (Instruments containing -); Glass ophthalmic lenses; Glasses cases; Laboratory optical apparatus: Protective eyeglasses; Protective eyewear; Protective glasses; Protective goggles; Protective spectacles; Sun glasses; Sunglasses; Sunglasses frames; Laboratory centrifuges; Laboratory</p>

	<p>dispensers; Laboratory filters; Laboratory furniture [specifically adapted]; Laboratory glassware; Laboratory mixers; Laboratory trays.</p> <p>Class 40 - Glass polishing; Glass tinting; Grinding and polishing glass for eyeglasses; Grinding of lenses; Grinding of optical glass; Grinding (optical glass-); Grinding (Optical glass -).</p>
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13. The use of the word “namely” in the opponent’s registrations nos. 1129389 and 1098924 must be approached, as indicated in the Trade Mark Registry’s classification guidance, on the following basis:

“Note that specifications including “namely” should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above “dairy products namely cheese and butter” would only be interpreted as meaning “cheese and butter” and not “dairy products” at large. This is consistent with the definitions provided in Collins English Dictionary which states "namely" to mean "that is to say" and the Cambridge International Dictionary of English which states "which is or are".”

14. In its letter of 16 December 2014, the opponent stated:

“3. The services and contested goods are confusingly similar. Opticians’ services include design, fitting and making spectacles and lenses for the correction of a person’s vision. There is a complementary relationship between them. As stated by the Hearing Officer in Opposition No 400400 (Decision No O- 335-14 of 31/07/2014) concerning the same parties and comparing eyeglasses, sunglasses, contact lenses, contact lens cases, containers for contact lenses with opticians’ services: “whilst it is possible to buy these goods from other sources, it is common knowledge that opticians also supply such goods direct to their customers as part of their services” (at paragraph 33). Therefore the following goods are confusingly similar to the Opponent’s services: **eye glasses; sunglasses, sunglasses frames, glass ophthalmic lenses, eyeglass frames.**

4. The contested **eyeglass chains, eyeglass cords and glasses cases** are all accessories for these goods and highly complementary. They are offered for sale by opticians if not already attached to or provided as part of the sale of a pair of glasses or sunglasses.

5. The contested **eye protectors, eyeglass shields, protective eyeglasses, protective eyewear, protective glasses, protective goggles, protective spectacles** are goods which can be prescribed by or purchased from an opticians in order to protect the eye. Similarly, they are provided by hospitals

following eye surgery or injuries to the eye. Eye shields for example are provided to prevent the rubbing of the eye, protective eyewear is supplied to protect eyes in a variety of hazardous environments, for example in sports (see. <http://www.visionexpress.com/lasses/sports-and-protection-glasses/>), and protective goggles are supplied for those suffering, for example, from glaucoma. Similarly, opticians offer special lens treatments, for example lenses which are antiglare and offer protection from UV light.

6. Glass polishing; Glass tinting; Grinding and polishing glass for eyeglasses; Grinding of lenses; Grinding of optical glass; Grinding (optical glass-); Grinding (Optical glass -) are all services provided by an optician. An optician is a technician who not only retails lenses and frames and analyses prescription but who also makes and repairs lenses and frames which includes grinding and polishing lenses. These services are provided by the same undertaking in the same outlets. They are complementary.

7. Eye refractometers and laboratory optical apparatus are equipment used by opticians when assessing the patients/consumers' eyes and by onsite optical lab technicians in preparing prescriptions, repairing spectacles and glazing lenses, It is respectfully submitted that there is a close connection between these goods and opticians' services, in the sense that one is indispensable or important for the use of the other. The use of eye refractometers is integral to the eye examination performed by an optician. Upon seeing the applicant's mark on such goods and in the Opponents environment, the public is likely to think that the responsibility for the goods lies with the same undertaking. Professionals and undertakings in the optician industry, upon seeing the Applicants mark upon goods of this nature, will believe the goods are those of the Opponent or come from an economically linked undertaking. The same can be said for **Laboratory centrifuges; Laboratory dispensers; Laboratory filters; Laboratory furniture [specifically adapted]; Laboratory glassware; Laboratory mixers; Laboratory trays."**

15. In its counterstatement, the applicant states:

"There is no similarity in the goods and services offered by these two companies. The Opponents business is in class 44 and the Applicant's business is in class 9, 35 and 40.

The Opponent runs Eye Hospitals and the Applicant runs Optical shops which sell contact lenses, prescription glasses and sun glasses in Turkey. Under Turkish law, Eye Hospitals cannot sell or offer glasses and contact lenses: and Optical Shops are not allowed to offer medical eye examinations or treatments."

16. I have no knowledge of the relevant provisions of Turkish law, however, for the purposes of these proceedings that does not matter. As the application for registration

seeks registration in the United Kingdom, it is the Trade Marks Act 1994 and the related case law upon which my considerations must be based.

The case law relating to similarity of goods and services

17. 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.

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

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.”

In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

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

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

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

Whilst on the other hand:

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

18. In my view, the goods and services to which the opponent now objects fall into two categories. For essentially the reasons outlined by the opponent in its letter of 16 December 2014, I find that:

Eye protectors; Eye glasses; Eye protectors; Eyeglass cases; Eyeglass chains; Eyeglass cords; Eyeglass frames; Eyeglass shields; Eyeglasses; Glass ophthalmic lenses; Glasses cases; Protective eyeglasses; Protective eyewear; Protective glasses; Protective goggles; Protective spectacles; Sun glasses; Sunglasses; Sunglasses frames” (in class 9)

And:

“Glass polishing; Glass tinting; Grinding and polishing glass for eyeglasses; Grinding of lenses; Grinding of optical glass; Grinding (optical glass-); Grinding (Optical glass -)” (in class 40),

are, given the manner in which a trade in such goods and services is conducted in the United Kingdom (a pattern of trade with which the average consumer will be very familiar), highly similar, given the complementary relationship that exists between them, to the opponent’s “optician services” in class 44.

19. That leaves the following goods in class 9 to be considered:

“Eye refractometers; Eyepieces; Eyepieces (Instruments containing -); Laboratory optical apparatus; Laboratory centrifuges; Laboratory dispensers; Laboratory filters; Laboratory furniture [specifically adapted]; Laboratory glassware; Laboratory mixers; Laboratory trays.”

20. Although the opponent objects to “Eyepieces” and “Eyepieces (Instruments containing)”, it does not, despite my direction, identify to which goods in its earlier trade marks it considers these goods to be similar nor does it explain why it considers this to be the case. As to the remaining goods, the opponent relies upon its “optician services”, arguing, that:

“the use of eye refractometers is integral to the eye examination performed by an optician”,

and that in relation to all of the goods which remain:

“professionals and undertakings in the optician industry, upon seeing the applicant’s mark upon goods of this nature, will believe the goods are those of the opponent or come from an economically linked undertaking.”

21. At first blush those may appear attractive arguments. However, whilst I have already accepted that there is a complementary relationship between the opponent’s “optician services” and various goods and services in the applicant’s trade mark, that conclusion was reached on the basis of the opponent’s submissions and my own (and what I consider will be the average consumer’s) experience of the closely related nature of the goods and services I have identified (I consider the average consumer further in paragraph 25). However, as the opponent has provided no evidence to demonstrate that a provider of “optician services” also conducts a trade in, for example, eye refractometers (let alone the other (primarily) laboratory related goods to which it objects), I find, having applied the case law mentioned, there to be no meaningful

similarity between the opponent's "optician services" and the goods identified in paragraph 19.

22. Insofar as the opponent comments on "professionals and undertakings in the optician industry" they are not, as will become clear, in my view, the average consumer for the goods and services which I have found to be similar. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

23. As there is, in my view, no similarity in the opponent's "optician services" and the applicant's goods in paragraph 19, there can be no likelihood of confusion and the opposition against these goods fails accordingly.

The average consumer and the nature of the purchasing decision

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

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

25. The average consumer of the goods and services I have found to be similar is, in my view, a member of the general public. Although I have no submissions to assist me, my own experience tells me that as the goods in class 9 and services in classes 40 and 44 are likely to be self selected from signage displayed on the high street, on websites and in catalogues, visual considerations are likely to dominate the selection process. However, as, in particular, the services in class 44 may be recommended by word of mouth, aural considerations will also play their part. As to the degree of care taken during the selection of the goods and services at issue, my own experience tells me that

the cost of, for example, eyewear can vary considerably. Whilst the average consumer is, in my view, unlikely to pay a high degree of attention to the selection of a cord or case for eyewear, they will, when selecting even relatively low cost eyewear, be conscious of, for example, style, size, frame colour, lens type/colour/material. This suggests to me that the average consumer will pay at least an average degree of attention to the selection of the majority of the goods in class 9 and services in class 40 and a somewhat higher degree of attention to the selection of optician services, where factors relating to the average consumer's health are likely to be uppermost in their mind.

Comparison of trade marks

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

27. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks. The trade marks to be compared are as follows:

Opponent's trade marks	Applicant's trade mark
<p data-bbox="186 1465 375 1497">No. 1129389</p> 	

<p>No. 854381</p>  <p>No. 1098924</p> 	
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28. Although the opponent bases its opposition on the three trade marks shown above, I intend to base my comparison on No. 1129389. If the opponent is unable to succeed on the basis of this trade mark, and given that No. 854381 has a number of additional features whilst No. 1098924 is relied upon on the basis of conceptual similarity (of which more below), it will not be in any better position in relation to these other trade marks.

29. The opponent's trade mark consists of a circular device presented in orange (although no colour is claimed). Within this circular orange device there appears (towards the top right) a smaller white circle. To the right of this device element there appears the word "dünyagöz" presented as a single word in lower case; above each of the letters "ü" and "ö" there appears an umlaut, giving the word element of the opponent's trade mark the feel of a word from a language other than English. In my view, both elements are distinctive. Although the device element appears as the first element of the opponent's trade mark, as the word which accompanies it is larger and occupies a much more significant proportion of the trade mark as a whole, it is likely to have a higher relative weight than the device element which accompanies it, and is, in my view, likely to make a much greater contribution to the overall impression the opponent's trade mark creates.

30. As to the applicant's trade mark, this consists of the two words "Dünya" and "Optik" presented as separate words in title case and a cursive script; it too has an umlaut above the letter "ü". When considered in relation to the goods and services I have found to be similar, it is possible, given the similarity of the word "Optik" to the English language word "optic", that the word "Dünya" will assume a degree of dominance over the word which accompanies it. Whilst that may be the case, as both words are of the same length and occupy the same proportion of the applicant's trade mark, they will, in my view, make a roughly equal contribution to the overall impression it creates.

31. Although the opponent's trade mark contains an element presented as one word in lower case and the applicant's trade mark consists of two words presented in title case and a cursive script, the fact that the word elements of both trade marks begin with the letters d-ü-n-y-a and D-ü-n-y-a respectively, results, in my view, notwithstanding the device element present in the opponent's trade mark and the differing suffixes i.e. "göz" v "Optik", in at least a reasonable degree of visual similarity between them.

32. Insofar as aural similarity is concerned, it is well established that when a trade mark consists of a combination of figurative and word elements, the average consumer is most likely to refer to the trade mark by the word element; that, in my view, is the case here. As the word elements of both trade marks begin with the same five letters in the same order and because, as a general rule, the first element of trade marks tend to have more impact (the comments of the GC in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 refer) and notwithstanding the differing suffixes, there remains, in my view, a reasonable degree of aural similarity between the competing trade marks.

33. Finally, in relation to the conceptual position, in its Notice of opposition, the opponent states:

"The marks are conceptually identical, alternatively highly similar, one meaning "world eye" and the other "world optic"...The contested mark is a direct, alternatively, near direct, translation."

34. Whilst the applicant agrees that the opponent's trade mark means "World Eye" in Turkish, it argues that its trade mark means "World Optician" in Turkish and that the competing trade marks are, as consequence, conceptually different. In my view, both parties' submissions miss the point. The average consumer is a member of the general public in the United Kingdom, not Turkey. Although I have no evidence as to what percentage of the general public in the United Kingdom is familiar with the Turkish language, it is, in my view, likely to be quite low. Whilst I am prepared to accept that the presence of the umlaut in the competing trade marks is likely to convey the feel of a word from a foreign language, and that the visual similarity between the word "Optik" in the applicant's trade mark and the English language word "Optic" is unlikely to go unnoticed, there is nothing to suggest that the average consumer in the United Kingdom will recognise the words in the competing trade marks as being of Turkish origin or that the trade marks will convey any meaning to them. As a consequence, the conceptual position is, in my view, neutral.

Distinctive character of the opponent's earlier trade mark

35. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has

been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As the opponent has not filed any evidence, I have only the inherent characteristics of its trade mark to consider. Consisting as it does of a distinctive device and a word element from a language with which the average consumer in the United Kingdom is, in my view, unlikely to be familiar, the opponent's trade mark is possessed of a high degree of inherent distinctive character. However, even if the average consumer was familiar with the meaning of the word element of the opponent's trade mark, as the parties agree that the word element translates as "worldeye", the opponent's mark trade mark (which also includes a distinctive device), when considered in the context of the services relied upon, in my view, would still be possessed of a fairly high degree of inherent distinctive character.

Likelihood of confusion

36. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. The opposition has been withdrawn in relation to the following goods and services:

Class 9 - Aerial amplifiers; Aerial boosters; Aerial combiners; Aerial converters; Aerial filters; Aerial sockets; Aerials; Cash dispensing machines; Electric adaptors; Electric battery chargers; Electric blanking plugs; Electric boosters; Electric breakers [switches]; Electric cables; Electric capacitors; Electric control apparatus; Electric convertors; Fire extinguishers; Fire extinguishing apparatus; Laboratory incubators [other than for medical use]; Laboratory instruments [other than for medical use]; Laboratory oscilloscopes; Magnet boards; Magnetic badges; Magnetic carriers; Magnetic coded card readers; Magnetic data carriers, recording discs; Magnetic data media; Magnetic detectors; Magnetic discs; Magnetic disk drives; Magnetic diskettes; Magnetic disks; Magnetic drums; Magnetic encoded card readers; Magnetic encoded cards; Magnetic encoders; Magnetic recording charts; Magnetic recording discs; Magnetic recordings; Measuring devices, electric; Measuring glassware; Measuring instruments; Measuring sensors; Meters; Protection devices against X-rays, not for medical purposes; Protection devices for personal use against accidents; Protection masks; Protective clothing; Protective clothing made from ballistic resistant materials; Protective face-shields for protective helmets; Protective footwear for the prevention of accident or injury; Protective headgear; Protective work clothing

[for protection against accident or injury];Radar; Radar instruments; Satellite aeralis; Satellite apparatus; Satellite receivers; Satellite signal receiving antennae; Satellite transceivers; Satellite transmission apparatus; Satellites; Satellites for communication purposes; Sonar apparatus; Sonars; Ticket dispensers; Traffic control apparatus [lighting];Traffic guidance apparatus [electric];Traffic guidance apparatus [luminous sign];Traffic-light apparatus [signalling devices];Video devices; Video digitisers; Video editing apparatus; Video graphics controller; Voice processing systems; Voice processors; Voice recognisers; Voice response equipment; Voice synthesizers; Voice transmission apparatus.

Class 35 - Administration of businesses; Administration of foreign business affairs; Administration of the business affairs of retail stores; Administration relating to marketing; Exhibitions (arranging-) for advertising purposes; Exhibitions (arranging-) for business purposes; Exhibitions (arranging-) for commercial purposes; Exhibitions (arranging-) for trade purposes; Exhibitions (conducting-) for advertising purposes; Exhibitions (conducting-) for business purposes; Exhibitions (conducting-) for commercial purposes; Exhibitions (conducting-) for trade purposes; Exhibitions (Organization of -) for commercial or advertising purposes; Exhibitions (organization of-) for commercial or advertising purposes; Market campaigns; Market research; Shop window dressing; Shop window dressings; Shop-window dressing; Advertisement and publicity services by television, radio, mail; Advertising; Business administration services; Business administration services for processing sales made on the internet; Business advertising services relating to franchising; Consultancy (professional business-);Consultancy relating to business efficiency; Consultancy relating to the selection of personnel; Consultations relating to business management; Customer club services, for commercial, promotional and/or advertising purposes; Customer loyalty services for commercial, promotional and/or advertising purposes; Import agency services; Import and export agencies; Import and export agencies services; Import and export services; Import-export agencies; Office administration services [for others];Office functions; Office functions services; Office machine rental services; Office machines and equipment rental ;Office machines (Rental of-);Office management services [for others];Office support staff recruitment services; Permanent staff recruitment; Personal management consultancy services; Personality testing for business purposes; Personnel consultancy; Personnel management.

Class 40 - Abrasive polishing; Metal brazing; Metal casting; Metal coating; Metal coating [not painting];Metal colouring [not painting];Metal cutting; Metal finishing; Metal forging; Metal hardening; Metal laminating; Metal machining; Metal moulding; Metal plating; Metal plating and laminating; Metal polishing; Metal pressing; Metal stamping; Metal tempering; Metal treating; Metal treatment services; Photographic developing; Photographic duplicating; Photographic enlarging; Photographic etching; Photographic etching of articles of clothing; Photographic etching of fabrics; Photographic etching of household articles;

Photographic etching of paper; Photographic etching of printed matter; Photographic etching of textiles; Photographic film developing; Photographic film development; Photographic image processing; Photographic preservation; Photographic preservation and conservation; Photographic printing; Photographic printing apparatus (rental of-);Photographic processing; Photographic processing apparatus (rental of-);Photographic reproduction; Photographic restoration; Photographic restoration services; Photographic retouching; Photographic slide and print processing; Photogravure; Photogravure printing; Photo-printing; Air treatment; Animals (Slaughtering of -);Chemical processing of liquids; Cloth dyeing; Cloth edging; Cloth fireproofing; Cloth pre-shrinking; Cloth treating; Cloth waterproofing; Clothing (hot-pressing of -) [forming of clothing];Clothing (shrinking of -);Food and drink preservation; Food canning; Food grinding; Food milling; Food preservation; Food processing; Food smoking; Foods (Freezing of -); Fur (custom fashioning of-);Fur cutting; Fur dyeing; Fur working; Gas compression services; Gas processing services; Gas production services; Glass blowing; Glass etching; Glass-blowing; Leather working; Metal casting; Metal coating; Metal cutting; Metal finishing; Metal forging; Metal hardening; Metal laminating; Metal machining; Metal moulding; Metal plating; Metal plating and laminating; Metal polishing; Metal pressing; Metal stamping; Metal treating; Metal treatment; Metal treatment services; Paper bleaching; Paper finishing; Paper treating; Paper treatment; Photofinishing; Photographic developing; Photographic duplicating; Photographic enlarging; Photographic etching; Photographic film developing; Photographic film development; Photographic image processing; Photographic printing; Print finishing [binding] services; Print finishing [cutting] services; Print finishing [folding] services; Print finishing services; Printing; Saddlery working; Wood-carving; Wood-working.

37. In addition, as I indicated above, where there is no similarity in the competing goods and services there can be no likelihood of confusion. As a consequence, the opposition fails in relation to:

Eye refractometers; Eyepieces; Eyepieces (Instruments containing -); Laboratory optical apparatus: Laboratory centrifuges; Laboratory dispensers; Laboratory filters; Laboratory furniture [specifically adapted]; Laboratory glassware; Laboratory mixers; Laboratory trays.

38. In relation to those goods and services I found to be similar i.e.

Eye protectors; Eye glasses; Eye protectors; Eyeglass cases; Eyeglass chains; Eyeglass cords; Eyeglass frames; Eyeglass shields: Eyeglasses; Glass ophthalmic lenses; Glasses cases; Protective eyeglasses; Protective eyewear; Protective glasses; Protective goggles; Protective spectacles; Sun glasses; Sunglasses; Sunglasses frames; (in class 9)

And:

“Glass polishing; Glass tinting; Grinding and polishing glass for eyeglasses; Grinding of lenses; Grinding of optical glass; Grinding (optical glass-); Grinding (Optical glass -)” (in class 40),

I am satisfied that the presence in the opponent’s trade mark of the device element and the differences in the suffixes of the word elements, is sufficient to avoid direct confusion i.e. where one trade mark is mistaken for the other. However, I agree with the opponent that for “those who do not attribute a meaning to the Turkish elements of the marks, the identical element [i.e. dünya v Dünya] will have an even greater impact”. Although I have concluded that the average consumer is likely to pay at least an average degree of attention to the selection of the vast majority of the goods and services I have found to be highly similar, the presence of these elements as the first part of the word elements of the competing trade marks combined (albeit to a much lesser extent) with the fact that both words include the same foreign language punctuation mark, results, in my view, in a likelihood of indirect confusion i.e. where the similarities in the competing trade marks lead the average consumer to assume the competing goods and services come from undertakings which are economically linked. As a consequence, the opposition succeeds in relation to these goods and services.

Overall conclusion

39. The opposition succeeds in relation to:

Eye protectors; Eye glasses; Eye protectors; Eyeglass cases; Eyeglass chains; Eyeglass cords; Eyeglass frames; Eyeglass shields; Eyeglasses; Glass ophthalmic lenses; Glasses cases; Protective eyeglasses; Protective eyewear; Protective glasses; Protective goggles; Protective spectacles; Sun glasses; Sunglasses; Sunglasses frames; (in class 9)

And:

“Glass polishing; Glass tinting; Grinding and polishing glass for eyeglasses; Grinding of lenses; Grinding of optical glass; Grinding (optical glass-); Grinding (Optical glass -)” (in class 40).

The application will, subject to any successful appeal, be refused in respect of these goods and services, but may proceed to registration for all of the other goods and services which remain in the application.

Costs

40. I remind myself that the opposition was originally targeted against all of the goods and services in the application and that the opponent relied upon all of the services for which its earlier trade marks were registered. Given the dissimilarity in the vast majority of the goods and services for which the application was filed, the opponent, once

challenged by the Tribunal, limited both the scope of its opposition and the services upon which it relied. The consequence of the opponent's revised approach is that the vast majority of the applicant's goods and services are no longer opposed, and in relation to those goods and services against which the opposition was maintained, the opponent has only been partially successful. Considered overall, the applicant has been substantially successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, but bearing in mind that the only part the applicant has played in these proceedings is to consider the Notice of Opposition, file a counterstatement and consider the opponent's letter of 16 December 2014, I award the applicant **£400** as a contribution to its costs in respect of these activities.

41. I order Dunya Goz Hastanesi Sanayi Ve Ticaret Anonim Sirketi to pay to Cansa Elektronik Sanayi Ve Diş Ticaret Limited Şirketi the sum of **£400**. This sum is to 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 21st day of January 2015

C J BOWEN
For the Registrar
The Comptroller-General