

TRADE MARKS ACT 1994

IN THE MATTER OF the application

(Declaration of Invalidity No 12501) by Ülker Gıda Sanayi Ve Ticaret AS

For invalidity of Registration

No. 2113583

DECISION

1. The trade mark



has been registered since 12 September 1997 under number 2113583, in respect of:-

Class 29

Meat, fish, poultry and game, meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces, eggs, milk and milk products, edible oils and fats.

Class 30

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

and stands in the name of Ian McDonald and Zia Khurshid.

2. By an application filed 3 May 2001, Ülker Gıda Sanayi Ve Ticaret AS (the ‘applicants’) applied for invalidity of this registration under the provisions of Section 47(2)(a) and (b) of the Trade Marks Act 1994. The applicant says that the mark is invalid having regard to sections 5(1), 5(2)(a) and (b), 5(3), 5(4)(a) and (b), 3(6) and 32(3).

3. A copy of this application was issued to the registered proprietor at his recorded address for

service on 21st May 2001.

4. The registered proprietor did not file a counterstatement within the six weeks specified by Rule 33(2) of the Trade Mark Rules 2000.

5. On 12th November 2001, I wrote to the applicants (copied to the registered proprietors) drawing attention to the Firetrace case (BL 0-278-01). At paragraph 17 of that decision, the registrar's hearing officer says:

It is not sufficient to simply allege that a registration offends either section 46 or 47 of the Act without doing more to prove that the allegation has substance. That said, when an application for revocation (other than non-use) or invalidation is made and the registered proprietors choose not to respond to such a request, I do not think that it is necessary for the applicants in those circumstances to have to fully substantiate their allegations beyond providing evidence which supports the prima facie case.

The reason that the hearing officer arrived at this view is the statutory presumption contained in section 72 of the Act which states:

In all legal proceedings.....the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.

6. I said in my letter that without further submissions or evidence I doubted that the Registrar would consider that a prima facie case had been made, and which would render the mark totally invalid for all the goods registered. Whilst I copied this letter to the registered proprietors I also said that as they had filed no defence of the mark their right to take part in these proceedings was apparently waived. In response the applicants submitted evidence to support their case, and also made a number of submissions with which I propose to deal, so far as I need , in my decision below, but first I will set out and factual basis of the applicants' case.

7. Sabri Ülker, the applicants' founder, has given evidence. He says that the company was founded in 1944 and used the name Ülker in advertising and as a trade mark. In 1973 an advertising agent, a citizen of the Turkish Republic, was commissioned to design a logo form of Ülker. The agent has since died and no written records showing formal ownership of the logo exist. Nevertheless since 1973 the applicant has used the logo and has been considered to be the owner. Turkish newspapers and advertising material are exhibited to show use of the logo.

8. In 1990 the applicant first sold a range of chocolate and biscuit confectionary in the UK under the name Ülker using the logo. Invoices show this and sales have continued up to the present day. The founder says that by 1996 the applicant had established goodwill and reputation in the UK. He says that he understands that the registered proprietors have never used the mark, the subject of the registration, and had they done so the company's distributors would have found out immediately and taken action to prevent such use.

9. The applicant has a community trade mark 000221861 which was filed on 1st April 1996 and registered on 25th November 1998. The mark is:



and the specification reads:

Class 30: Cocoa; cocoa based products; biscuits; cakes; edible decorations for cakes; flavorings, other than essential oils, for cakes; candy for food; caramels (candy); chewing gum; chocolate; chocolate based products; cookies; flour based products; fondants (confectionery); macaroons (pastry); pastilles (confectionery); sweets; petit-beurre biscuits; petits fours (cakes); pralines; sugar confectionery; waffles; pastry; confectionery; crackers.

10. It is an earlier registered trade mark for the purposes of the Act and the form of the mark corresponds in all material respects to the logo devised back in 1973. I should mention for completeness that the applicant has also recited in their statement of case a CTM 'family' of Ülker marks, but for the purposes of this decision I do not intend to refer to the family as, in my view, the applicant's best case rests with the mark cited above.

Decision

11. In the light of submissions made by the applicant's agent in his letter of 13th December 2001, I feel I need to consider further the hearing officer's comments in Firetrace. A statutory presumption of validity exists in all cases; it would be wrong in my view for the registrar to blindly declare marks invalid, irrespective of whether the grounds for invalidity are made out, simply because no counterstatement has been filed. I can find no legal basis for that approach. In my view, in the absence of a counterstatement, the registrar is required to consider the grounds for invalidity; in some cases she may feel that the grounds are made out without further substantiation on the part of the applicant, but in others she may feel that the applicant should supply further evidence or develop their submissions. This is the consequence of the statutory presumption; the registered proprietor's complete disinterest in this case is not, of itself, decisive of the invalidation, nor am I persuaded that, as the applicant puts it, the presumption 'varies in degree', and is very low where the registered proprietor opts not to defend. The presumption itself does not vary; the burden the applicant is faced with to displace that presumption may well vary.

12. In this case, the applicant makes a broad based attack on the registration. In my opinion some of the applicants grounds of attack are apt to render the mark invalid for all the goods registered, and other grounds are apt to render the mark invalid for some, but not all, of the goods registered.

13. The applicant's evidence goes largely to the section 5(4)(b) ground in relation to the question of an infringement of copyright in the logo. However, the applicant also develops the section 3(6) bad faith ground.

14. Bad faith is claimed on the basis that the mark in suit is an exact copy, without authorisation, of the logo used by the applicant company and that the mark has been registered for a large number of goods of which there is no evidence of use in the UK, nor any intention to use. These are legitimate 'bad faith' grounds, but is the prima facie case made out on the facts of the case ? Taking into account in particular:

- the very close resemblance of the marks;
- the lengthy and undisputed history of use of the applicants' mark as recounted by the founder and, in particular, the fact that no authorisation has been given to the registered proprietors in respect of the mark ;
- the broad specification of foodstuffs for which the mark in suit is registered; and finally,
- the fact that the registered proprietors have not contested the facts or provided any alternative version of events ;

I consider that the prima facie case is made out under section 3(6). The applicant succeeds under this section.

15. Lest I have erred in this finding under section 3(6), a further ground of attack is section 5(2)(b) and, given the applicant's submissions, I propose to consider this ground as well. In my view the applicant succeeds, at least partially, under section 5(2)(b) as well. To a UK consumer the trade mark Ülker will, I am sure, be distinctive, the penumbra of protection will therefore be broad. The difficulty in this case lies with the fact that the applicants' earlier registrations and the use of their own mark is for a narrower range of goods than the mark in suit is registered. Broadly speaking, the applicants' interest and legal protection goes to confectionery products only, whereas the mark in suit covers a broader range of foodstuffs. To overcome this difficulty, the applicant submits that at least some of the registered proprietor's class 29 goods in particular: "preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces, eggs, milk and milk products, edible oils and fats" are similar to some of the applicants class 30 goods. The applicant says that all such foods are normally located close to each other in supermarkets and a consumer wishing to make a pie for example would be confused by concurrent purchases of goods originating from two different sources bearing the same uniquely distinctive mark. I agree with this. This finding under section 5(2) (b) would, however, leave the registered proprietor with the following goods which I do not consider 'similar' for the purposes of section 5(2)(b):

Class 29

Meat, fish, poultry and game, meat extracts.

Class 30

Salt, mustard; vinegar, sauces (condiments).

16. Because I have found for the applicant in relation to section 3(6), and partially under section 5(2)(b), I do not intend to make findings under any of the other grounds pleaded.

17. Under the provisions of Rule 33(3) of the Trade Mark Rules 2000, the trade mark is declared invalid and I direct that it be removed from the register, and deemed never to have been made.

Dated this 24 Day of January 2002

**Edward S Smith
For the registrar
the Comptroller General**