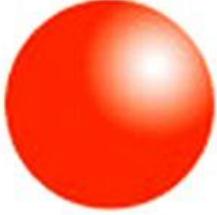


O-335-14

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO 1151541  
IN THE NAME OF  
CANSAN ELEKTRONIK SANAYI VE DIS TICARET LIMITED SIRKETI  
IN RESPECT OF THE TRADE MARK



*Dünya Optik*

AND

OPPOSITION THERETO UNDER NO 400400  
BY DUNYA GOZ HASTANESI SANAYI VE TICARET ANONIM SIRKETI

1. Cansa Elektronik Sanayi Ve Dis Ticaret Limited Sirketi (“the holder”) applied to protect International Trade Mark (“IR”) 1151541, shown on the front page of this decision, in the UK on 22 October 2012 (with a Turkish priority date of 20 July 2012). The mark claims the colours red, black and white.

2. The IR was accepted and published in the *Trade Marks Journal* on 12 April 2013 for the following goods and services:

**Class 9:**

Apparatus and instruments for recording, transmission or reproduction of sound, data and images, computer programs for data processing, magnetic and optical data carriers; antennas, satellite antennas, component parts for antennas; coin-operated mechanisms for vending machines, ticket dispensers, automated banking machines, connectors for electronic circuits, counters and electronic timers, clothing for protection against accidents, life saving apparatus and equipment, eyeglasses, sunglasses, contact lenses, contact lens cases, containers for contact lenses; access control and alarm monitoring systems, alarm bells, electric, traffic-light apparatus (signalling devices), fire extinguishers; fire hose nozzles; sprinkler systems for fire protection; fire alarms; radar apparatus, radars, sonars, night vision goggles, electro-dynamic apparatus for the remote control of signals; electrolysers, galvanometers, anodes, cathodes; magnets, decorative magnets.

**Class 35**

The bringing together, for the benefit of others, of a variety of spectacles (optics), spectacle glasses, contact lenses, spectacle cases', excluding the transport thereof, enabling customers to conveniently view and purchase those goods.

3. Dünya Göz Hastanesi Sanayi Ve Ticaret Anonim Sirketi (“the opponent”) opposes the IR relying on grounds under sections 5(2)(b) and 5(4) of the Trade Marks Act 1994 (“the Act”), a ground originally pleaded under section 3(6) having been subsequently withdrawn. In respect of the remaining grounds of opposition, the opponent relies on the following:

Mark	Relevant dates	Specification relied upon
 <p>IR No 1129389</p>	<p>IR date: 12 March 2012</p> <p>Date of protection in the UK: 3 January 2013</p>	<p>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</p>

		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 1098924	IR Date: 25 July 2011  Date of protection in the UK: 21 March 2012  Priority date (Turkey): 27 June 2011	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.
	IR Date: 11 November 2004  Date of Protection in UK: 22 January 2006	Class 44: Medical services, medical assistance, hospitals, medical clinics, medical nursing, opticians' services
DÜNYAGÖZ	Use claimed since 10 June 2010	Medical services; medical assistance; hospitals; medical clinics; all services being in the field of the human eye

4. I note that IR Nos. 1129389 and 1098924 include the qualifier “namely” within their specifications. The effect of this is that the general service which precedes the word ‘namely’ is restricted to those services which follow it, by analogy with the entry in the registrar’s Manual of Trade Mark Practice which states:

“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”.

5. The holder filed a counterstatement denying the claims made. Only the opponent filed evidence. The opponent indicated it wished to have a decision taken from the papers filed. The holder did not request to be heard and I therefore make this decision after a careful review of all the papers before me, noting that neither party filed written submissions in lieu of a hearing.

### **The evidence**

6. This takes the form of a witness statement by Adem Esgün who states he has been Vice Chairman of the opponent company since 30 July 2013. Mr Esgün states that the opponent was founded in 1996 and provides “specialized medical services in eye treatment in 18 health centres, specifically 14 centres in Turkey, 2 in Germany, 1 in Amsterdam and our centre in the UK”. At AE1 he exhibits address details of these centres downloaded from the dunyagoz.com website on 11 December 2013. One shows an address in Harley Street, London and, whilst it also bears a photograph of what I take to be those premises with signage in the window, the picture is too small for me to make out what that signage might show.

7. Mr Esgün states that it carries out its trade in the UK through VIP Global Clinics Ltd which trades as World Eye Clinics (“WEC”) and with whom it has entered into a cooperation agreement. At AE3 he exhibits a copy, along with a translation, of an agreement dated 25 October 2010 between the opponent (referred to in the document as “The Company”) and VIP Global Clinics Ltd (“The Organizer”). No detail is given of who might have carried out the translation but, whilst acknowledging that I am not familiar with the original language and have no qualifications to carry out such a translation, it has not been certified and it appears to me that the translation is the product of someone other than a professional translator such that I cannot be certain what the terms of the agreement might be. For example, the “Purpose of the Agreement” is translated as being:

“This agreement aim of the ORGANIZER’s and THE COMPANY’s UK and Ireland market, the only authorised, Turkey and outside Turkey Hospitals coming patients for “preliminary examination, travel organization and controls that will be organized after surgery” for the purpose of their exclusive collaborative arrangements with regard to the PARTIES mutual rights and obligations to specify”;

whilst some of the “Commitments and Obligations of ORGANIZER” are said to be:

“ORGANIZER could occasionally arrange contact meetings for the patients who are interested with the medical treatment which is handled by THE COMPANY. ORGANIZER must take the opinion and consent of THE COMPANY for these meetings. THE COMPANY could refer its doctors to the proper meetings.”

and;

“ORGANIZER immediately remits it (what “it” is has not been specified) to THE COMPANY and the bank transfer receipt is inappropriate, if discount surgery fees have invested in wages at least 3 days before date of arrival of the patient. Patients not treated, if they do not make full payment to ORGANIZER or THE COMPANY prior to surgery.”

8. Mr Esgün states that the WEC clinic opened on 10 June 2010 on Harley Street and that WEC “is responsible for providing consultations and advice, pre-operative examinations and laboratory tests for patients who will subsequently be operated on Turkey (sic). WEC also provide general eye examinations and also services for medical tourism, including arranging travel to the hospital and accommodation in Turkey if the patient is suitable for surgery. They also provide aftercare to those returning from surgery in Turkey”.

9. At AE4 Mr Esgün exhibits what appears to be some sort of report. Again with some questionable English (e.g. “Quality standarts”-page 53 of exhibit), the report refers to the availability of various examinations and surgical and other procedures relating to the eyes and surrounding tissues. Whilst it is not dated, the report contains a graphic in the form of what is called a “growth chart” for the “Dünyagöz Group” for the period 1996 to 2012. It shows what I take to be an indication of when it opened a clinic in a particular town or city though no other details of these clinics (if that’s what they are) are given. At page 38 is a graphic depicting air travel to Turkey from many parts of the world and which bears the heading: “Serving 30,000 foreign patients from 107 different countries of the world”. The report gives no further detail of these patients or the numbers that may have come from any particular country or continent at any particular time nor does it contain any financial or other company information.

10. Mr Esgün provides no details of turnover or advertising costs but states that “once a patient in the UK has paid for the services, an invoice is sent to us in Turkey and commission is paid to WEC”. No detail of any commission paid has been provided but at AE5 he provides copies of four invoices as follows:

1: on WEC headed paper and addressed to the opponent. It seeks payment of €545 for what is stated to be “Subat 2013 Komisyon Tutari” (which I take to refer to the amount of commission due for a particular month in that year). It is dated 15 March 2013.

2: on WEC headed paper and addressed to the opponent. It seeks payment of €215 for what is stated to be “Mart 2013 Komisyon Tutari”. It is dated 25 April 2013.

3: on WEC headed paper but with no addressee details. It seeks payment of €450 for “Aralik 2012 Komisyon Tutari”. It is dated 31 December 2012.

4: on WEC headed paper but with no addressee details. It seeks payment of €1225 for “Ocak 2013 Komisyon Tutari”. It is dated 5 February 2013.

11. Mr Esgün states approximately 1596 consultations and examinations have been carried out “in the last year” in the London Clinic with “more than 50 patients” having been referred to “our centre in Turkey to attend an examination and/or to have surgery performed”. Mr Esgün states these figures have been provided by Mr Sadun Atig who is the Manager and Patient Co-ordinator for WEC. At AE6 he exhibits a copy of a letter from Mr Atig along with a (non-certified) translation. The letter has no addressee but is said to contain the following information:

“Reviewing the last 12 months (the letter is dated 26 November 2013), the number of applications, examinations is as follows:

Monthly average	
EXPAT applications.....	30
UK & IRE applications.....	50
Commonwealth applicatşons(sic)..	25
Examination or surgery.....	28
Total.....	133
Annual average.....	1596”

12. Mr Atig has not provided a witness statement.

13. At AE7, Mr Esgün exhibits pages downloaded from the opponent’s Facebook page. All of them, numbered 66 to 161, were downloaded on 11 December 2013 and none are in English. At AE8 is exhibited a page from the opponent’s Twitter site, with the same download date and, again, not in English.

14. Mr Esgün states that the opponent’s corporate catalogue is available in English and, at AE9 he exhibits a loose-leaf copy of it. The document (pages 165 to 188) is in questionable English (e.g. “our medical team, diagnosing with our latest technology equipments by listening to you, offer the most ethical.....” (page 166), “if otherwise is not necessary, the patient may go to home after the cataract surgery is practiced with drop anesthesia in a short time. Surgered eye is kept closed only for one night. ” (page 173) and “It is important to make first examination at first age. Especially diagnosing the diseases like cataract, eye pressure, retinal problems avoids irremeable vision loss. Cataract or disorders at eye’s plexiform later cause permanent vision loss in 2-3 months and, aftermath, nystagmus which is unrecoverable for lifelong” (page 184). The catalogue is not dated and no details have been provided to show whether, and if so where, when and to whom the catalogue may have been circulated.

15. At AE10 are exhibited prints of photographs said to show “the inside and outside of the clinic”. Whilst the first four pages appear to be photographs of the Harley Street clinic each with a sign displayed in the windows, not all show the same signs. This suggests the photographs were taken at different points in time, however, none

are dated. The photographs of the inside of the clinic appear to show a television or similar screen on which is displayed what appears to be a trade mark, however, it does not appear to be any of the marks relied on by the opponent in these proceedings. These photographs are also not dated.

16. Mr Esgün states : “Dünya Göz and WorldEye are well-known in England and Ireland. In 2012 we were selected to represent Turkey as a National Finalist in the European Business Awards which were sponsored by UKTI (UK Trade and Investment)”. At AE11 he exhibits a certificate to support his claim. I note that it refers not to the opponent or its agent but to a third party. Mr Esgün does not explain what, if any, the connection is between the third party and the opponent or its agent.

### **Findings on the opponent’s evidence**

17. Whilst Mr Esgün states that “we are proud to be the biggest eye hospital group in Europe”, the evidence, as set out above, provides me with no details of e.g. the number of customers or extent of any advertising in any given country or continent, nor are any details provided of e.g. turnover or advertising expenditure, either as a total or for separate countries. Mr Atig has not filed evidence himself but in any case the information provided by him refers to a period after the relevant date. Most of the material exhibited dates from after the relevant date in these proceedings and is either not in English or, is the subject of some questionable translation such that I think it highly unlikely to have been published and/or circulated within the UK. Whilst some invoices have been exhibited which I am prepared to accept refer to commission payments, two of the four have no addressee details, all of them also date from after the relevant date in these proceedings and there is no indication of the specific services which were provided and led to their generation, nor under what marks such services might have been provided.

18. In short, the opponent has not shown that the distinctiveness of any of its marks has been enhanced through its use or that it has goodwill or reputation within the UK.

### **The objection under section 5(2)(b) of the Act**

19. The opponent bases its opposition under this ground on three IRs, however, I intend to confine my comparison to that based on its IR No 1129389 as if it cannot succeed on the basis of this mark, it will be in no better position as regards the others.

20. The test for determining whether there is a likelihood of confusion is well established. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs Q.C., expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

## The CJEU cases

*Sabel BV v Puma AG* [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) C-334/05 P.

## 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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

21. In essence, the test under section 5(2)(b) is whether there are similarities in marks and goods or services which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address factors such as the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods or services, the category of goods or services in question and how they are marketed.

### **The comparison of the respective goods and services**

22. For ease of reference, the goods and services to be compared are set out below:

Opponent’s services	Holder’s goods and services
<p>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.</p>	<p>Class 9:            Apparatus and instruments for recording, transmission or reproduction of sound, data and images, computer programs for data processing, magnetic and optical data carriers; antennas, satellite antennas, component parts for antennas; coin-operated mechanisms for vending machines, ticket dispensers, automated banking machines, connectors for electronic circuits, counters and electronic timers, clothing for protection against accidents, life saving apparatus and equipment, eyeglasses, sunglasses, contact lenses, contact lens cases, containers for contact lenses; access control and alarm monitoring systems, alarm bells, electric, traffic-light apparatus (signalling devices), fire extinguishers; fire hose nozzles; sprinkler systems for fire protection; fire alarms; radar apparatus, radars, sonars, night vision goggles, electro-dynamic apparatus for the remote control of signals; electrolyzers, galvanometers, anodes, cathodes; magnets, decorative magnets.</p> <p>Class 35:            The bringing together, for the benefit of others, of a variety of spectacles (optics), spectacle glasses, contact lenses, spectacle cases', excluding the transport thereof, enabling customers to conveniently view and purchase those goods.</p>

23. In its statement of grounds accompanying the notice of opposition, the opponent submits:

“The goods and services are confusingly similar. In particular, the contested *eyeglasses, sunglasses, contact lenses, contact lens cases, containers for contact lenses* in Class 9 and *the bringing together, for the benefit of others, of a variety of spectacles (optics), spectacle glasses, contact lenses, spectacle cases, enabling customers to conveniently view and purchase those goods* in Class 35 are confusingly similar to the Opponent’s *opticians’ services* which include the design, fitting and making of spectacles and lenses for the correction of a person’s vision. They are targeted at the same end user often through the same sales outlets. They share a common purpose.”

24. In its counterstatement, the holder submits:

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

It also submits:

“The Opponent has suggested on their statement of grounds number 16 that our application in classes 9 and 35 are similar to their opticians’ services. However, under Turkish Law, eye hospitals can not offer any design, fitting and making of spectacles and lenses inside any hospital premises. As a result, there will be no confusing of services on offer from the respective companies.”

25. I have no knowledge of them but, whatever they might be, the provisions of Turkish law can have no part to play in my decision. The application under consideration in this decision seeks protection in the UK and, as indicated earlier, these proceedings are to be determined under the provisions of the Trade Marks Act 1994 and associated case law.

26. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05*, the General Court said:

“...goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application...”

27. As to similarity, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28, Jacob J gave advice as to how it should be assessed. He identified the following factors to be taken into account:

- (a) The respective uses of the respective goods and services;
- (b) The respective users of the respective goods and services;
- (c) The physical nature of the goods or services;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify the goods or services, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

28. This does not mean that the fact that particular goods or services may be classified for trade mark registration purposes in different classes means they are necessarily dissimilar goods. As was subsequently said by the court, in *Canon Kabushiki Kaisha v MGM Inc*:

“23. In assessing the similarity of the goods or services concerned.....all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, intended purpose and their method of use and whether they are in competition with each other or are complementary.”

29. In relation to what constitutes complementary goods and services, the following comments of the General Court in *Boston Scientific Ltd v OHIM* Case T-325/06 are relevant:

“82 It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 Sergio Rossi v OHIM –Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM –Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM –Bolaños Sabri (PiraÑam diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

30. Also of relevance in determining whether goods and/or services are complementary are the comments of the appointed person Mr Daniel Alexander Q.C. in *Sandra Amalia Mary Elliott and LRC Products Limited* (BL O-255-13).

31. Finally, in *Oakley, Inc v Office for Harmonization in the Internal Market (Trade Marks & Designs)*(OHIM) Case T-116/06 the Court said:

“54 Clearly, in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As the Court held in paragraph 34 of *Praktiker Bau-und Heimwerkermärkte*,

paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods.”

32. Whilst the opponent’s statement of grounds alleges that each of the respective goods and services are similar, it has no evidence or submissions which support such a claim. Taking into account the case law set out above, I can find no meaningful way in which any of the opponent’s services are similar to the following goods of the holder:

Apparatus and instruments for recording, transmission or reproduction of sound, data and images, computer programs for data processing, magnetic and optical data carriers; antennas, satellite antennas, component parts for antennas; coin-operated mechanisms for vending machines, ticket dispensers, automated banking machines, connectors for electronic circuits, counters and electronic timers, clothing for protection against accidents, life saving apparatus and equipment, access control and alarm monitoring systems, alarm bells, electric, traffic-light apparatus (signalling devices), fire extinguishers; fire hose nozzles; sprinkler systems for fire protection; fire alarms; radar apparatus, radars, sonars, night vision goggles, electro-dynamic apparatus for the remote control of signals; electrolyzers, galvanometers, anodes, cathodes; magnets, decorative magnets

33. In respect of the remaining goods, which are: eyeglasses, sunglasses, contact lenses, contact lens cases, containers for contact lenses; I find them to be highly similar to the opponent’s *optician’s* services on the basis that there is a complementary relationship between them. 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 service. For the same reason, I also find the opponent’s *optician’s services* to be highly similar to the holder’s services in class 35.

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

34. The average consumer, for the goods and services I have found to be similar, is a member of the general public. As the goods in class 9 are, in my experience, most likely to be the subject of self selection from traditional retail outlets on the high street, catalogues and websites (whether from a specialist supplier or not), visual considerations are likely to dominate the selection process though not to the extent that aural considerations can be ignored. Visual considerations will also dominate the selection of the associated retail services in class 35. Services in class 44 could be selected, at least in the first instance, by reliance on either visual or aural considerations, as such services may be the subject of word of mouth recommendations. Whilst my own experience tells me that the cost of eyewear can vary widely, the need for the average consumer to ensure they choose the correct size, material, shape and colour, even where the goods are relatively inexpensive, will result in at least an average level of attention being paid to their selection; an at

least similar level of attention will also be paid to the selection of the services given the implications on the average consumer's health and well-being.

### Comparison of the respective marks

35. The marks to be compared are:

Opponent's mark	Holder's mark
	

36. The format of each of the respective marks is the same as each is a composite mark consisting of a circle device to the left of words. In each case the device has a lighter area towards the top right which is reminiscent of a reflection as would be seen on a 3D ball shape. The holder's mark is subject to a claim for the colours red, black and white whilst the opponent's is not subject to any such claim however, for the reasons given in *Specsavers Case C-252/12*, this does not serve to distinguish the two marks. As for the wording present in each mark, the opponent's is presented as a single word in lower case whilst the holder's is presented as two words in title case and script form. Whilst the endings of the respective words differ (göz v Optik), they each share the same five letters D-U-N-Y-A in the same order at the start of this element and both have an umlaut over the letter U. Taking the marks as wholes, I find they share a reasonably high degree of visual similarity.

37. It is well established that composite marks are likely to be referred to by the words that appear within them. In my view that is the case here. Given that both begin with the same five letters in the same order, there is an obvious point of aural similarity, however, the endings of each are very different. When taken as wholes, I find the respective marks share a reasonable degree of aural similarity.

38. In its statement of grounds the opponent submits the word Dünya is a Turkish word which translates as "world" whilst the word Göz translates as "eye". Because of this, it submits that the respective marks are conceptually identical or, alternatively, similar as the word Optik "will be associated with the eye".

39. The holder submits:

"... "Optik" does not mean "eye". The [holder] has applied for "Dünya Optik; "Dünyagöz" does not have the same meaning as Dünya Optik."

It also submits:

"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 "Dünyagöz" in Turkish means "World Eye".

As "Optik" is an optician related word, consumers will not be confused...."

40. I have no evidence to show how many people in the UK are familiar with the Turkish language though I consider it is likely to be a relatively small proportion of the population. It is possible that some, on seeing the respective marks, will notice the umlaut(s) which may lead them to see them as words of foreign origin. It is also possible that some will associate the word 'optik' which appears in the holder's mark with the English word "optic" because of the visual and aural similarities between the two words. But there is nothing to indicate that the average consumer will recognise any of the words within the respective marks as being Turkish nor anything to show they will know the meaning of the marks as wholes. I consider the position from the conceptual perspective to be neutral.

### **The distinctiveness of the earlier mark**

41. I must also assess the distinctive character of the earlier mark. The distinctive character of a mark can be appraised only, first, by reference to the goods for which it is registered 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 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 mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings –*Windsurfing Cheimsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

42. As I have indicated above, the evidence filed by the opponent does not show its mark to have any enhanced distinctive character through use. Whilst, for the reasons given above, the word within the mark may be recognised by the average consumer as one of foreign origin, its actual meaning is unlikely to be known. Both parties agree that the word can be translated into English as 'worldeye', however, even for those who do, in fact, recognise this meaning, the mark has a reasonably high degree of inherent distinctive character.

### **The likelihood of confusion**

43. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby 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. I also have to factor in the distinctive character of the earlier marks as the more distinctive they are 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 on the imperfect picture of them he or she has retained in mind.

44. Earlier in this decision I found:

- The respective marks share a reasonably high degree of visual similarity and a reasonable degree of aural similarity but I found the conceptual position to be neutral;

- The holder's goods, namely, *eyeglasses, sunglasses, contact lenses, contact lens cases, containers for contact lenses* and services, namely, *The bringing together, for the benefit of others, of a variety of spectacles (optics), spectacle glasses, contact lenses, spectacle cases', excluding the transport thereof, enabling customers to conveniently view and purchase those goods* to be highly similar to the opponent's *optician's services*. I found all other of the holder's goods to be dissimilar to any of the opponent's services;
- The opponent's mark to have a reasonably high degree of inherent distinctive character which has not been shown to have been enhanced through use;
- The average consumer for the goods and services which I have found to be similar is a member of the general public;
- The purchasing process is one in which visual considerations are likely to dominate through not to the extent that aural considerations can be ignored and is a process to which the average consumer will pay at least an average level of attention.

45. I have to consider both direct confusion (i.e. where one mark is mistaken for the other) and indirect confusion (i.e. where the average consumer assumes there is an economic link). There can be no finding of a likelihood of confusion where the goods or services are found to be not similar. Consequently, the opposition against those goods set out above which I have found not to be similar, fails.

46. As to the goods and services I have found to be similar, the similarities between the respective marks are such that I find there is a likelihood of confusion between them. I do not consider the different endings of the respective marks will be overlooked and this leads me to find there is no likelihood of direct confusion. I nevertheless conclude, given the format of the respective marks (i.e. a circle device to the left of words) is the same and both word elements begin with the same five letters, the second of which has the umlaut, (a diacritical mark which is likely to stand out to the average consumer as being somewhat uncommon) and taking a global approach as I am required to do, that there is a likelihood of indirect confusion between the respective marks.

#### **The objection under section 5(4)(a) of the Act**

47. Under the ground, the opposition is against all of the holder's services in class 35 and the following goods in class 9:

Apparatus and instruments for recording, transmission or reproduction of data and images, eyeglasses, sunglasses, contacts lenses, contact lens cases, containers for contact lenses, night vision goggles.

48. The objection under this ground can be dealt with very briefly. The opponent relies on its mark DÚNYAGÓZ which it claims to have used in the UK since 10 June

2010 in respect of *medical services; medical assistance; hospitals; medical clinics; all services being in the field of the human eye*. In its statement of grounds, the opponent submits that it is “widely recognised in the health tourism and ophthalmological and cosmetic services industries”. As I set out above, the evidence it has submitted does not show that it has the requisite goodwill for any services and certainly not at the date claimed nor at the relevant date in these proceedings which is the date of application for protection. Not only has the opponent not provided e.g. turnover or other figures relating to the provision of any services in the UK under the mark relied upon but it has provided no evidence from the trade or public either. That being the case, the objection under this ground is bound to fail and I decline to deal with it in any greater detail save to say that the distance between the respective goods and services is an important factor to be taken into account and it is likely that the opponent would have failed the misrepresentation test.

## **Summary**

49. The opposition succeeds under the provisions of section 5(2)(b) of the Act in respect of the following goods and services:

*Eyeglasses, sunglasses, contact lenses, contact lens cases, containers for contact lenses*

*The bringing together, for the benefit of others, of a variety of spectacles (optics), spectacle glasses, contact lenses, spectacle cases’, excluding the transport thereof, enabling customers to conveniently view and purchase those goods*

but fails in respect of:

*Apparatus and instruments for recording, transmission or reproduction of sound, date and images, computer programs for data processing, magnetic and optical data carriers; antennas, satellite antennas, component parts for antennas; coin-operated mechanisms for vending machines, ticket dispensers, automated banking machines, connectors for electronic circuits, counters and electronic timers, clothing for protection against accidents, life saving apparatus and equipment; access control and alarm monitoring systems, alarm bells, electric, traffic-light apparatus (signalling devices), fire extinguishers; fire hose nozzles; sprinkler systems for fire protection; fire alarms; radar apparatus, radars, sonars, night vision goggles, electro-dynamic apparatus for the remote control of signals; electrolyzers, galvanometers, anodes, cathodes; magnets, decorative magnets.*

## **Costs**

50. Both parties have achieved a measure of success and I consider each should bear its own costs.

**Dated this 31st day of July 2014**

**Ann Corbett  
For the Registrar  
The Comptroller-General**