

O-541-18

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3244694
BY MOHAMMED YOUSAF
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 43:

Alaturka

AND

OPPOSITION THERETO UNDER NO. 410705
BY AZIZ ALI

Background and pleadings

1. The above trade mark was filed by Mohammed Yousaf (“the applicant”) on 19 July 2017. It was published for opposition purposes on 11 August 2017. Registration of the mark is opposed by Aziz Ali (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on UK Trade mark (“UKTM”) registration 3213012, which was filed on 15 February 2017 and registered on 05 May 2017. This case therefore involves a conflict between the following marks and goods and services:

Applied for mark	Earlier mark
<p data-bbox="204 831 384 875">Alaturka</p> <p data-bbox="204 965 783 1106">Class 43: Restaurants; Restaurant services; Restaurant services incorporating licensed bar facilities.</p>	<p data-bbox="810 831 1214 875">Alaturka Doner UK</p> <p data-bbox="810 965 1385 999">Class 29: Food pastes made from meat.</p> <p data-bbox="810 1077 1385 1272">Class 39: Food storage services; Food delivery services; Food delivery; Food transportation services; Delivery of food by restaurants.</p> <p data-bbox="810 1350 1385 1989">Class 40: Food and drink preservation; Food canning; Food preservation services; Food preservation; Food processing; Foods (Freezing of -); Food grinding; Food milling; Food and beverage treatment; Food smoking; Processing of foodstuffs for use in manufacture; Processing of foodstuffs for use in manufacture; Customized printing of company names and logos for promotional and advertising purposes on the goods of others.</p>

	<p>Class 43: Food sculpting; Food preparation services; Food preparation; Food and drink catering for cocktail parties; Food and drink catering for banquets; Food and drink catering for institutions; Food and drink catering; Food preparation for others on an outsourcing basis; Food service apparatus (Rental of -); Takeaway services; Restaurant services; Restaurants; Providing food and drink for guests in restaurants; Providing food and drink in restaurants and bars; Restaurants (Self-service -); Restaurant services; Restaurants; Provision of food and drink in restaurants; Providing restaurant services; Reservation of restaurants; Serving food and drink for guests in restaurants; Providing food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Providing food and drink in restaurants and bars; Restaurants (Self-service -).</p>
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2. In its notice of opposition the opponent contends that the applied for mark is similar to the earlier mark and that the goods and services for which the applied for mark is seeking protection are either identical or similar to the goods and services covered by the earlier mark. The opponent further contends that there exists a strong likelihood of confusion on the part of the public.

3. The applicant denies that there exists a likelihood of confusion. The applicant agrees, in its counterstatement, that the marks are similar, but makes various

submissions regarding the parties' respective goods and services, which I will deal with in the course of this decision.

4. The applicant is not represented. The opponent is represented by Forrester's LLP. The applicant did not file evidence. The opponent filed written submissions at the evidence stage. Whilst neither party asked to be heard, the opponent filed further written submissions in lieu of attendance at a hearing.

Preliminary issue

5. The applicant, in its counterstatement, makes several references to a separate trade mark application (no. 3244959), which is not relevant for the purposes of these proceedings. Consequently, I will not say any more about these submissions. I will refer to the relevant submissions, where appropriate, throughout the remainder of this decision.

6. The written submissions filed by the opponent in lieu of a hearing are mainly a repetition of the submissions filed at the evidence stage. I will therefore refer to the latter of these submissions, where appropriate, throughout the remainder of this decision, as they are the more detailed and substantive of the two.

The correct approach

7. The applicant relies on a number of factors which it says will avoid any likelihood of confusion. Before going any further into the merits of this opposition it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

- i. On visiting the premises at which the services are supplied, the consumer will be aware that they have visited either the applicant's premises or the opponent's premises, and that there is no connection between the two.

This only deals with one potential situation. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the Court of Justice of the

European Union (“CJEU”) stated at paragraph 66 that when assessing the likelihood of confusion, it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. Therefore, I must take into account all the ways in which the consumer may come into contact with the mark in question, for example, visually on marketing material or aurally by word of mouth. If there exists a likelihood of confusion in any of these circumstances, that confusion is enough to refuse the registration.

- ii. The opponent is “unnaturally constrained” to the sale of doner kebabs whereas the applicant’s use is in the service of a wider range of foods.

Differences between the services currently provided by the parties are irrelevant, except to the extent that those differences are apparent from the list of services they have tendered for the purpose of the registration of their marks. The opponent, on 15 February 2017, filed for registration of its mark to protect various goods and services in classes 29, 39, 40 and 43. Until a trade mark has been registered for five years (in accordance with section 6A of the Act), it is entitled to protection in relation to all the goods and services for which it is registered. Consequently, the opponent’s earlier UK mark must be protected for the services for which it is registered in class 43 without the opponent needing to prove that it is involved in more than the sale of doner kebabs, or needing to prove any use of its mark at all. This concept is known as fair and notional use and was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 as follows:

“22. ... It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark

is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

Therefore, matters such as the extent to which the applicant is using the goods and services its mark is registered for, is irrelevant to the assessment I am required to make.

iii. The applicant has been trading as Alaturka Limited since before the opponent's registration without any concerns.

This point is twofold in that the applicant claims: (a) they have been trading from an earlier date; and (b) there has not been any confusion to date. I will deal with each claim separately.

(a) Section 72 of the Act provides that registration shall be taken as *prima facie* evidence of the validity of a registered mark. The applicant has not sought to invalidate the earlier trade mark on the basis of a claim to an earlier common law earlier right. Consequently, the opponent's trade mark must be regarded as a validly registered mark. In this situation the law requires priority to be determined according to the filing dates of the applications for registration. This means that the opponent's mark has priority and a likelihood of confusion between the marks based on their notional use will be enough to justify the refusal of the applicant's later filed trade mark.

Tribunal Practice Notice ("TPN") 4/2009 is titled "*Trade mark opposition and invalidation proceedings – defences*" and is also relevant to these proceedings. Under the heading "*The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark*", the following is stated:

“4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker’s mark.”

That is the case here. In these proceedings, the opponent’s mark has priority as the earlier registered mark and, as the applicant has not sought to invalidate the earlier mark, any claim that the applicant was trading as Alaturka Limited prior to the opponent’s registration is not relevant to the matter before me.

(b) In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, Millett L.J. stated that:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered trade mark.”

Applying this case law to the matter before me, the fact that there has not been any confusion to date is not an important factor for me to consider, especially as there could be a significant number of reasons for this.

Decision

Section 5(2)(b)

8. Section 5(2)(b) of the Act states that:

“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.”

9. 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 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.”

10. In these proceedings, the opponent is relying upon the trade mark referred to in paragraph 1 above, which qualifies as an earlier trade mark under section 6 of the Act outlined above. As the opponent’s earlier mark had not completed its registration process more than five years before the publication date of the applied for mark, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods and services for which its earlier mark is registered.

11. The following principles are gleaned from the judgment 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 C3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L.Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) The matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) The average consumer normally perceives the 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 services

12. In this case, “Restaurants; Restaurant services; [and] Restaurant services incorporating licensed bar facilities” in the applicant’s specification are identical to “Restaurant services; [and] Restaurants” in the opponent’s specification. These are identical services.

The average consumer and the nature of the purchasing act

13. As principle (b) in paragraph 11 above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ services. 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.”

14. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

15. Neither the applicant nor the opponent has commented on who the average consumer would be. I am of the view that the average consumer of the services at issue is a member of the general public.

16. The purchasing process for the services at issue is likely to be predominantly visual: restaurant services are likely to be selected following inspection of the premises' frontage on the high street, on a website, or as a result of advertisements in magazines or on posters, flyers or other advertising material. Oral recommendations may also play a role, so I do not ignore that there may be an aural element to the purchase. I bear in mind that the average consumer may need to consider factors such as the type of food and drink provided, the cost of the service offered and the nature of the establishment. I consider that, overall, the level of attention that will be paid during the purchasing process will be average.

Comparison of marks

17. It is clear from *Sabel BV v Puma AG* 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 their 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.”

18. 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.

19. The trade marks to be compared are as follows:

Applied for mark	Earlier mark
Alaturka	Alaturka Doner UK

Overall impression

20. Both the applicant's mark and the opponent's mark are plain word marks. The applicant's mark consists solely of the plain word "Alaturka", the overall impression of which rests in the word itself. The opponent's mark consists of the plain words "Alaturka Doner UK". "Doner" is descriptive of some of the goods and services. "UK" simply suggests that the opponent is a UK business. "Doner" plays a greater role in the mark for the goods and services for which it is not descriptive. Even so, I find these words to have little distinctive character in relation to the services at issue. The word "Alaturka" plays the greatest role in the overall impression of the opponent's mark.

Visual comparison

21. Visually, the entirety of the mark applied for is the first word in the earlier mark. The difference between the two marks is the addition of the second and third words "Doner UK" in the opponent's mark. There are two elements in the earlier mark that are not present in the applied for mark, and I consider there to be a medium degree of visual similarity between the marks.

Aural comparison

22. The part of the opponent's mark that makes the greatest contribution to the overall impression is identical to the applicant's mark in its entirety. As the average consumer is unlikely to articulate 'doner', which describes the nature of some of the goods, and

'UK', which simply denotes a restaurant in the UK, the marks will be pronounced identically. It follows that I find that the marks are aurally identical. In the alternative, if the average consumer does articulate "Doner UK" or "Doner", I would find a medium degree of aural similarity between the marks.

Conceptual comparison

23. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgment of the General Court ("GC") and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29. The assessment must be made from the point of view of the average consumer.

24. The applicant submits that the word "Alaturka" is a Turkish word meaning 'Turkish style'. The average consumer cannot be assumed to know the meaning of everything. In the *Chorkee* case (BL O-048-08), Anna Carboni, sitting as the Appointed Person, stated in relation to the word CHEROKEE:

"36. ...By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one's own personal experience, knowledge and assumptions are more widespread than they are."

25. The meaning of "Alaturka", in the UK, is certainly not well known to the extent that I could take judicial notice of its meaning. The applicant has not filed evidence in support of its submission that Alaturka refers to something of a Turkish style and I cannot conclude that the average consumer in the UK would be familiar with such a meaning. In my view, the "Alaturka" part of both marks will be seen as an invented word or possibly a word from another language with which the average consumer is not familiar. The "Doner UK" element does not give any indication of the undertaking responsible for the goods or services. I therefore conclude that the marks are conceptually neutral.

Distinctive character of the earlier trade mark

26. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

27. The opponent asserts that its earlier mark is “distinctive, in a trade mark sense”. As no evidence has been filed, I have only the inherent distinctiveness of the earlier mark to consider. The distinctive element of the earlier mark is the word “Alaturka”. As per my findings in paragraph 25, above, I expect the average consumer to see Alaturka as an invented word. Consequently, I find that the mark has a high degree of inherent distinctive character.

Likelihood of confusion

28. 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 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, 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.

29. Earlier in this decision I found that:

- The average consumer is a member of the general public, who will select the services primarily by visual means (though I do not discount an aural component) and who will pay, in the main, an average degree of attention in their selection;
- The services are identical;
- The marks are visually similar to a medium degree, aurally identical (or aurally similar to medium degree where the average consumer articulates the words 'doner UK') and conceptually neutral;
- The opponent's mark is inherently distinctive to a high degree

30. The average consumer does not compare marks side by side. These are everyday services which are identical. The minor differences between the two marks, in elements which are either lowly or non-distinctive, are not sufficient for the average consumer to easily distinguish between them. These will both be seen as 'Alaturka' marks and, bearing in mind the concept of imperfect recollection, the average consumer will simply mistake one mark for the other, i.e. direct confusion.

31. However, if the average consumer does not directly confuse them, the presence of “Alaturka” in both marks, given its high degree of distinctiveness, will, in my view, inevitably lead to indirect confusion (where the respective similarities lead the consumer to believe that the respective goods/services come from the same, or related, trade source). In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis, sitting as the Appointed Person, noted that:

“Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

32. For example, an average consumer familiar with the Alaturka restaurant, encountering the Alaturka Doner UK restaurant would simply think that it was another restaurant provided by the Alaturka restaurant undertaking and vice versa.

Conclusion

33. There is a likelihood of confusion. **The opposition succeeds.**

Costs

34. As the opponent has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2/2016. Using that TPN as a guide, and bearing in mind my comments at paragraph

6, above, regarding the repeated submissions, I award costs to the opponent on the following basis:

Official fee: £100

Preparing a statement and
considering the other side's statement: £200

Written submissions: £300

Total: £600

35. I order Mohammed Yousaf to pay Aziz Ali the sum of **£600**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of August 2018

Emily Venables

For the Registrar,

The Comptroller-General