

O/703/18

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003245291 BY
DISA FOODS LTD
TO REGISTER THE FOLLOWING SERIES OF MARKS:

Elissa

AND

elissa

AS A TRADE MARK IN CLASSES 29 AND 30

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 410746 BY
GIMA (UK) LIMITED

BACKGROUND AND PLEADINGS

1. On 21 July 2017, Disa Foods Ltd (“the applicant”) applied to register the series of trade marks shown on the cover page of this decision in the UK. The application was published for opposition purposes on 11 August 2017.

2. The application was opposed by Gima (UK) Limited (“the opponent”) in respect of the following goods in the applicant’s specification:

Class 29 Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats.

3. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the earlier UK Trade Mark registration no. 2252920 for the mark **Melis**, which has an application date of 15 November 2000 and a registration date of 11 May 2001. The following goods are relied upon in this opposition:

Class 29 Cheese, salami and sausages.

4. The opponent argues that the respective goods are identical or similar and that the marks are similar.

5. The applicant has filed a counterstatement denying the claim made (and requested that the opponent provides proof of use of its earlier trade mark relied upon).

6. The opponent was originally represented by Bowling & Co and is now represented by Harold Benjamin Solicitors. The applicant is represented by Fortis Rose Solicitors. The opponent’s evidence consists of the witness statement of Vehbi Keles dated 3 April 2018, which was accompanied by written submissions dated 4 April 2018. The applicant’s evidence consists of the witness statement of Ufuk Cengiz dated 5 June 2018. No hearing was requested and neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE

The Opponent's Evidence

7. As noted above, the opponent's evidence consists of the witness statement of Vehbi Keles dated 3 April 2018, with two exhibits. Mr Keles is the director of the opponent.

8. Mr Keles states that the opponent's mark has been used continuously in the United Kingdom since 2001. Mr Keles states that the mark has been used for the following goods:

“Yoghurt drink, Chicken Salami, Chicken Sausages, Cow Cheese, Goat Cheese, Sheep Cheese, Chicken and Beef Cocktail Sausages, Cottage Cheese, String Cheese, Cheddar Cheese, Red Leicester Chees, Feta Cheese, Filo Pastry, Puff Pastry, Halloumi, Sliced Beef Mortadella, Sliced Chicken Mortadella, Sliced Turkey, Garlic Sausage, Turkish Tulum Cheese.”

9. He goes on to state:

“6. The mark has been used on goods sold in food shops, markets and other outlets throughout the UK.

7. The goods which contain the mark are also sold on-line to the whole of the UK from the Opponent's web site found at URL www.gimauk.com.”

10. Exhibit VK1 to Mr Keles' statement consists of four pages, all marked with what appears to be a print out date of 21 March 2018. Mr Keles states that this exhibit shows a number of products on which the mark is used. The first two pages show a variety of products which all appear to be available for sale on an online store. Specifically, the site offers for sale sausages, cheese, salami and pastry. The print quality of these pages is poor and it is difficult to see the form in which the mark has been used. However, it does appear to display the mark in the variants shown below. The word 'MELIS' also appears in the text of the page. The price for each product is stated as

“Members Only”. The web address which appears across the bottom of the page is yakeh.raumh.servertrust.com.

11. The third page of Exhibit VK1 shows a picture of a packet of sausages displaying the opponent’s mark in the following variation:



12. The fourth page of Exhibit VK1 shows a picture of a packet of cheese displaying the opponent’s mark in the following variation:



13. The labels on both of the products shown are in English (although they include translations to at least one other language).

14. Exhibit VK2 to Mr Keles’ statement is a chart showing annual sales of products displaying the opponent’s mark. The table shows sales totalling £394,672.30 for 2013, £536,157.80 for 2014, £612,515.46 for 2015, £719,797.05 for 2016 and £943,097.56 for 2017. The products that are identifiable as having been sold under the mark from this table are cheese, sausages, salami and pastry. Although no breakdown is given as to which market these sales relate, Mr Keles’ statement that the mark has been used in the UK implies that these sales at least in part relate to the UK market. This is supported by the fact that the sales figures are provided in pounds sterling.

15. Mr Keles’ statement was accompanied by written submissions. I do not propose to summarise these here, but will refer to them below as appropriate.

The Applicant's Evidence

16. As noted above, the applicant's evidence consists of the witness statement of Ufuk Cengiz dated 5 June 2018, with no exhibits. Mr Cengiz is the director of the applicant.

17. In his statement, Mr Cengiz states as follows:

a) There can be no likelihood of confusion for consumers who see the parties' marks even where the goods for which they are used are identical.

b) The marks are different in the way they are written without taking into account any size, graphic or design elements.

c) Melis is a shortened name for Melissa, which is a popular girl's name in Turkey, whilst Elissa is a popular Hebrew and American name.

d) Both words sound different in that the applicant's mark is longer and the emphasis is on 'sa' at the end of the word. The opponent's mark starts with the letter 'M' and does not have the same 'sa' sound at the end.

PROOF OF USE

18. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

"Raising of relative grounds in opposition proceedings in case of non-use

6A-(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form of which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

19. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

20. According to section 6(3)(a) of the Act, the relevant period in which genuine use must be established is the five-year period ending on the date of publication of the applied for mark. The relevant period is, therefore, 12 August 2012 to 11 August 2017.

21. What constitutes genuine use has been subject to a number of judgments. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office*

for Harmonisation in the Internal Market (Trade Marks and Designs) [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

...

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetzky-Orden v Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] to [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not always the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

22. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic

sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

Form of the mark

23. In *Colloiseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“the CJEU”) found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are

analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

24. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act as follows:

"33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

25. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered but as part of a composite mark.

26. Where the mark has been used in the same form as it is registered (such as in the text of the webpage at Exhibit VK1) this will be use upon which the opponent may rely. As noted above, the mark also appears in two variants in the opponent's evidence, specifically:



27. In variant a), the mark is presented in an uppercase, slightly stylised font. The stylisation is minimal and this will be covered by notional and fair use of the opponent's word only mark. It is also combined with a banner-style background presented on a white circle with a darker border. A picture of an Islamic-style building is displayed below the word MELIS and what appears to be Arabic writing is displayed above it. It is clear from the case law in *Colloseum*, cited above, that use in conjunction with other matter falls within the ambit of genuine use. That applies here. I consider that the use of the mark in variant a) is use upon which the opponent may rely.

28. In variant b), the mark is presented in uppercase, slightly stylised font. There is a small circle at the top of the letter 'I' and the word MELIS is presented on a darker banner-style background. The stylisation is minimal and this will be covered by notional and fair use of the opponent's word only mark. I consider that the principle outlined in *Colloseum* (as described above) also applies here. I consider that the use of the mark in variant b) is use upon which the opponent may rely.

Sufficient Use

29. I have no submissions from the applicant on the evidence provided by the opponent to prove use of the earlier mark.

30. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself¹.

31. Clearly, there are deficiencies in the opponent's evidence. No breakdown is provided as to what proportion of the sales figures listed in Exhibit VK2 relate to the UK market. The webpage print out provided at Exhibit VK1 is not dated and the mark displayed on the products is illegible in parts. However, Mr Keles has confirmed that sales have been made in the United Kingdom, which is supported by the product labelling and the website pages being displayed in English. It follows that at least a proportion of the sales shown will relate to those made in the UK. The evidence, in combination, creates a picture which is sufficient to establish genuine use of the mark by the opponent during the relevant period.

Fair Specification

32. I must now consider whether, or the extent to which, the evidence shows use for all the goods relied upon.

33. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

34. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

¹ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been

used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

35. I am satisfied that the opponent has demonstrated use of its mark in relation to cheese, salami and sausages. It is therefore able to rely on all of the goods for which its mark is registered.

PRELIMINARY ISSUES

36. The parties have made reference to the fact that one of the shareholders of the applicant was previously employed by the opponent. The applicant states that the opponent is being “hostile” and “has an axe to grind” and the opponent states that the applicant has “deliberately set out to replicate or mimic” the opponent’s business and marks. These arguments are not relevant to a determination under section 5(2)(b), which focuses only on the similarity of the marks and the goods to which they relate and not to the intention of the parties. These arguments will not, therefore, assist either party.

DECISION

37. Section 5(2)(b) of the Act reads as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

(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.”

38. 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.”

39. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions.

Section 5(2)(b) – case law

40. 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 to mind the earlier mark, 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

41. As a result of my finding at paragraph 35 above, the competing goods are as follows:

Opponent's goods	Applicant's goods
<u>Class 29</u> Cheese, salami and sausages.	<u>Class 29</u> Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats.

42. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, C-39/97, the court stated at paragraph 23 of its judgment that:

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

43. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(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 goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

44. 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.”

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

46. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

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

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

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

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.”

48. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

49. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons (see *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38]).

50. I have no submissions from the applicant on the similarity of the goods. In its written submissions, the opponent states:

“13. The Applicant’s trade mark application in Class 29 and 30 is either identical and/or similar to that of the Opponent’s Class 29 existing registration in terms of the goods covered.”

51. “Cheese” in the opponent’s specification falls within the broader category of “milk and milk products” in the applicant’s specification. “Salami and sausages” in the opponent’s specification fall within the broader category of “meat, fish, poultry and game” in the applicant’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

52. “Meat extracts” in the applicant’s specification will be products derived from meat such as a meat stock. There will be some overlap between the users and trade

channels of these products and “salami and sausages” in the opponent’s specification because they are all consumer products. There will also be some overlap in the nature of the goods as they are all products made from meat. However, their uses and method of use will be different as meat extracts will be used during cooking to create a secondary product, whereas salami and sausages will be consumed in their existing form. I consider there to be a low degree of similarity between these goods.

53. Similarly, there will be some overlap in the users and trade channels of “eggs” in the applicant’s goods and all of the opponent’s goods because they are all products derived from animals and are all consumer products. However, their nature will be different as the opponent’s goods are processed goods that have been created from produce derived from animals. “Eggs” in the applicant’s goods are animal products in their original form. I consider there to be a low degree of similarity between these goods.

54. “Edible oils and fats” in the applicant’s specification will include goods such as butter. This is similar in nature to cheese as they are both processed products that are traditionally made from milk. The users and trade channels will be similar on a superficial level because they are all consumer goods. There will be some overlap in the methods of use as both may be added to a meal for additional flavour (such as cheese being grated over pasta or butter being added to potatoes). They are often also sold in the same area of a supermarket. I consider there to be a high degree of similarity between these goods.

55. That leaves “preserved, frozen, dried and cooked fruits and vegetables” and “jellies, jams, compotes” in the applicant’s specification. I have considered the uses, users, nature and trade channels for the goods and whether there is a competitive or complementary relationship between these and any of the opponent’s goods. In the absence of any substantive submission to assist me, I am not satisfied that there is any similarity between the goods in issue. As some degree of similarity is required for there to be a likelihood of confusion², the opposition must fail in respect of these goods.

² *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

The average consumer and the nature of the purchasing act

56. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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.”

57. I have no submissions from the applicant on the average consumer or the nature of the purchasing process for the goods in issue. In its written submissions, the opponent states as follows:

“26. The goods are sold through a range of channels including on line and retail premises such as supermarkets where they will be displayed on shelves and obtained by self-selection. Some of the goods will be displayed in close proximity whilst others will not. Direct comparison may therefore not always be possible and instead there may therefore be reliance on an imperfect picture retained in the mind of the consumer.

27. Whilst some consumers will pay more attention and others less, the average consumer is likely to pay an average degree of attention in their selection of their goods. The selection process is likely to predominantly be visual, rather than aural one, although aural will not be irrelevant given that it may influence the

recall of a name. The conceptual similarities will also be a factor given their high level of conceptual similarity.”

58. The goods in issue are all consumer goods and so the average consumer will be a member of the UK general public. These purchases are likely to be fairly frequent and of low cost. The level of attention paid by the average consumer during the selection process is likely to be average.

59. The goods are, in my experience, most likely to be obtained by self-selection from the shelves of a retail outlet or from an online equivalent. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of the goods given that advice may be sought from a sales assistant.

Comparison of trade marks

60. 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 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.”

61. 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 marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impression created by the marks.

62. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade marks
Melis	Elissa elissa

63. In its written submissions, the opponent states as follows:

“Visual

20. Considered as a whole, the words “Melis” and “Elissa” are visually similar. Both words are shortened versions of the girl’s name “Melissa” and both comprise the central component part “elis”.

21. There is no addition of a device element to the mark so the similarity of the names is all the more important.

22. The average consumer is not always able to compare trademarks side by side and must instead rely on an imperfect picture of them. The small difference in the words are therefore likely to be overlooked or misremembered. Direct confusion is therefore likely.

23. In addition, given the similarity in the names, the average consumer may also believe the marks are connected so there is a likelihood of indirect confusion.

Phonetic

24. Considered as a whole the marks are phonetically very similar. Both marks have an identical “Elis” sound.

Conceptual

25. Conceptually the names are very similar. Both “Melis” and “Elissa” are shortened versions of the girl’s name “Melissa”. Given the marks are being applied to similar goods, the average consumer will either be confused and/or believe the two are associated.”

64. As noted above, Mr Cengiz argues that the words sound and are spelled differently and the applicant’s mark is a name in its own right and not a shortened version of the same name as the opponent’s mark. He also makes reference to design and graphic elements of the marks. For the avoidance of doubt, both marks are word only marks and the comparison I must make is on the marks as registered/applied for and not the way in which the marks are used by the parties during the course of trade.

65. The opponent’s mark consists of the five-letter word – MELIS. There are no other elements to contribute to the overall impression, which is contained in the word itself. The applicant’s marks consist of the six-letter word – ELISSA. There are no other elements to contribute to the overall impression, which is contained in the word itself.

66. Visually, the opponent’s mark is presented in lower case with the first letter capitalised. The first of the applicant’s marks is also presented in lower case with the first letter capitalised. The second of the applicant’s marks is presented all in lower case. As notional and fair use means that the applicant’s marks could be used in any standard typeface, differences created by the capitalisation are irrelevant. The marks all contain the letters “ELIS”. This is a point of visual similarity between the marks. However, in the opponent’s mark they are the last four letters which follow the letter “M”. In the applicant’s mark they are the first four letters and are followed by the letters “SA”. The different positions of the letters “ELIS” in the marks creates a point of visual difference between them. As a general rule, the beginnings of marks tend to make

more of an impact than the ends³ and the different positioning of the letters in each mark means that the beginnings of the marks are different. The result is that the visual impact of the common letters is reduced. I consider there to be a medium degree of visual similarity between the marks.

67. Aurally, the opponent's mark will be pronounced MEL-ISS. The applicant's marks will be pronounced EL-ISS-AH. The end syllable of the opponent's mark will be pronounced identically to the middle syllable in the applicant's marks. There is also some similarity between the pronunciation of the first syllable of the marks. I consider there to be a medium degree of aural similarity between the marks.

68. Conceptually, the parties both agree that the marks will be recognised as names. Whilst the parties agree that the opponent's mark will be recognised as a shortened version of the name Melissa, the applicant argues that its own mark will be recognised as a name in its own right and not a shortening of the same name. I consider it unlikely that both marks will be recognised as names. In my view, it is more likely that the applicant's marks will be recognised as a name than the opponent's mark because of the similarity with more traditional UK names such as Melissa or Eliza. In any event, even if both marks are recognised as names this will only create a low degree of conceptual similarity in the sense that they are both names. I do not accept that the average consumer will recognise the marks as shortened versions of the name Melissa. In the UK, the usual shortening for the name Melissa is Mel. If the average consumer does not recognise either or both marks as a name, then they will be viewed as made-up words reducing any conceptual similarity between them. In my view, there is (at best) a low degree of conceptual similarity between the marks.

Distinctive character of the earlier trade mark

69. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

³ *El Corte Ingles, SA v OHIM*, Cases T-183/02 and T-184/02

“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-2779, 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).”

70. Registered trade marks possess varying degrees of inherent distinctive character, ranging from very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

71. As the opponent has not filed any evidence to show that its mark has enhanced its distinctiveness through use, I have only the inherent position to consider. I have no submissions from the parties on the inherent distinctiveness of the earlier mark.

72. I must make an assessment of the inherent distinctiveness of the earlier mark as a whole. In my view, it is likely that the mark will be seen as a made-up word. There is nothing descriptive or allusive about it. I therefore consider the mark to have a high degree of inherent distinctive character. If I am wrong, and the mark is recognised as a name, then I consider there will be a medium degree of inherent distinctive character.

Likelihood of confusion

73. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to 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 that has been retained in his mind.

74. I have found there to be a medium degree of visual and aural similarity between the marks. At best, I have found there to be a low degree of conceptual similarity between the marks. I have found the earlier mark to have a medium or high degree of inherent distinctive character, depending on whether the average consumer recognises it as a name or considers it to be a made-up word. I have identified the average consumer to be a member of the general public and I consider that the goods will be selected primarily by visual means (although I do not discount an aural component). I have concluded that an average degree of attention will be paid during the purchasing process. I will consider the likelihood of confusion in respect of the parties' goods which are identical as, if there is no likelihood of confusion in respect of those goods which are identical, there will be no likelihood of confusion in respect of those goods which share a lesser degree of similarity. Notwithstanding the principle of imperfect recollection, I consider that the visual, aural and conceptual differences between the marks are sufficient to prevent them being misremembered as each other. I am satisfied that there is no likelihood of direct confusion.

75. I will now consider whether there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

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

76. Having recognised the differences between the marks, bearing in mind my conclusions listed at paragraph 74 above, I can see no reason why the average consumer would assume that the marks came from the same or economically linked undertakings. I am, therefore, satisfied that there is no likelihood of indirect confusion.

CONCLUSION

77. The opposition has been unsuccessful and the application will proceed to registration.

COSTS

78. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of £700 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the opponent's statement	£200
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Preparing evidence and considering the opponent's evidence	£500
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Total	£700
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79. I therefore order Gima (UK) Limited to pay Disa Foods Ltd the sum of £700. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 7th day of November 2018

S WILSON

For the Registrar