

O-007-11

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION No. 2516322
STANDING IN THE NAME OF
CHURCH WALK IP LIMITED**

AND

**IN THE MATTER OF THE REQUEST FOR A DECLARATION
OF INVALIDITY THERETO
UNDER No. 83634
BY TURKIYE IS BANKASI A.S.**


BACKGROUND

1) Church Walk IP Limited (hereinafter the registered proprietor) has the following trade mark registered in the UK:

Mark	Number	Date Applied for and date registered	Class	Specification
i\$	2516322	20.05.09 / 28.08.09	36	On-line search and selection of financial services providers and products.

2) By an application dated 20 November 2009 Turkiye Is Bankasi A.S. (hereinafter the applicant) applied for a declaration of invalidity in respect of this registration. The ground is, in summary:

a) The applicant is the registered proprietor of CTM 5753769 (shown below) which is very similar to the mark in suit and is registered for, inter alia, services which are also similar to those of the mark in suit. The mark offends against Section 5(2)(b) of the Trade Marks Act 1994.

Mark	Number	Date filed and registration date	Specification
	CTM 5753769	13.03.2007 / 25.08.2008	Class 36: Insurance; financial affairs; monetary affairs; real estate affairs.

3) The registered proprietor filed a counterstatement denying the above ground. The registered proprietor also states that the dotted letter “I” in the applicant’s mark is pronounced “ee” as in “meet” or “ea” as in “seat”; whilst the letter “S” (with punctuation device of a comma or apostrophe) beneath it is pronounced “sh” as in “sharp” or “bash”. It contrasts this with its mark which it claims will be pronounced “idollar”. In support of this it files copies of pages from the website <http://www.turkishlanguage.co.uk/alphabet.htm>.

4) Both sides filed evidence. Both ask for an award of costs. The matter came to be heard on 7 December 2010 when the registered proprietor was represented by Mr Maguire (a director of the registered proprietor) and the applicant by Mr Venner of Messrs Groom Wilkes & Wright LLP.

APPLICANTS’ EVIDENCE

5) The applicant filed a witness statement, dated 12 May 2010, by Robert Peter Wood the London Branch Operations Manager of the applicant company. He states that the applicant has used its registered trade mark in the UK and throughout the EU in respect of a wide range of financial and monetary services. Attached as an exhibit he provides a number of instances of use of the applicant’s registered trade mark. These include letter heads, mortgage documents as well as advertisements where the mark appears either between the words “Turkiye” and “Bankasi”, above these words in a much larger typeface or as a huge watermark covering half the page. All the use appears to be in relation to offering mortgages to people purchasing property in Turkey.

REGISTERED PROPRIETORS' EVIDENCE

6) The registered proprietor filed a witness statement, dated 17 June 2010, by Roland Dominic Maurice Maguire a director of the registered proprietor. He accepts that the applicant has used its mark in the UK. He denies that the marks are visually, phonetically or conceptually similar. He again provides an extract from the website www.turkishlanguage.co.uk/alphabet.htm. to corroborate his claims. He also states that the applicant's mark translates from Turkish to English as "business".

APPLICANT'S EVIDENCE IN REPLY

7) The applicant filed a second witness statement by Mr Wood, dated 17 August 2010. He provides his views on the similarity of the marks. He states that the marks would not be seen by the average UK consumer as "Turkish".

8) That concludes my review of the evidence filed in these proceedings insofar as I consider it necessary.

DECISION

9) The sole ground of invalidity is under Section 5(2)(b) of the Trade Marks Act 1994 which 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."

10) An "earlier trade mark" is defined in section 6, the relevant part of which states:

"6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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."

11) In these proceedings the applicant is relying upon an earlier mark, which has a registration date of 25 August 2008 and is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

12) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *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 and *Marca Mode CV v*

Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/ services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,
- (i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,
- (k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may

not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

13) In essence the test under section 5(2)(b) is whether there are similarities in marks and services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the services, the category of services in question and how they are marketed. Furthermore, I must compare the mark in suit and the mark relied upon by the applicant on the basis of their inherent characteristics assuming normal and fair use of the marks on the services in their specifications.

14) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchin Q.C. (as he was then) sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

15) The applicant has not shown any use of its mark and so cannot enjoy enhanced protection because of reputation. However, I do accept that the applicant’s mark is inherently very distinctive for the Class 36 services for which it is registered.

16) I must now determine the average consumer for the services of the parties, which are, broadly financial in nature. It is my view that the services offered by the two parties are aimed at the general public. In my view, financial services such as mortgages are not purchased without considerable consideration, although lower value financial services will be purchased / entered into with less care. I also believe that such services may be chosen mostly by eye, either via



websites, advertising or a phone book. I accept that word of mouth recommendations may also play a role. I must also take into account the concept of imperfect recollection.

17) I shall first consider the services of the two parties which are shown below for ease of reference.

Registered Proprietor's services	Applicant's Services
Class 36: On-line search and selection of financial services providers and products.	Class 36: Insurance; financial affairs; monetary affairs; real estate affairs.

18) The registered proprietor claimed that its services were conducted on-line and thus were different to the applicant's services. However, I note that on-line services are not excluded from the applicant's specification, and therefore the applicant's specification encompasses the registered proprietor's specification and the services must be regarded as very similar, if not identical. At the hearing the registered proprietor agreed with this view.

19) I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

Registered Proprietor's Trade Mark	Applicant's Trade Mark
	

20) Clearly, both marks contain more than one element and are, therefore, composite marks. The *Medion* case acknowledges that the overall impression conveyed to the relevant public by a composite mark may, in certain circumstances, be dominated by one or more of its components. I do not believe that that is the case here, where I believe that neither mark has a dominant element but both will be viewed as wholes and this is how I must compare the marks.

21) There are clearly visual differences between the marks, in that the registered proprietor's mark has the letter "i" and the letter "s" with a line through it or dollar sign alongside each other. The applicant's mark by contrast has the letter "s" wrapped around the letter "i" with a comma or apostrophe mark beneath it. I accept that when inspected closely the letter "s" in the registered proprietor's mark will be seen as the sign for a dollar or "\$". However, if the printing is of average size, or one is standing slightly away from the mark the line through the letter is less apparent and it looks more like a simple letter "S". Conversely, the applicant's trade mark could from a distance or if printed quite small be mistaken for a dollar sign.

22) There is said to be considerable aural difference between the marks, and I have been supplied with Turkish pronunciations. However, I have to consider the marks from the perspective of the average UK consumer, who I assume will not speak Turkish. I believe that they will pronounce the

registered proprietor's mark as "idollar", provided they look properly. The applicant's mark will I believe be vocalised as "eye-esse".

23) Conceptually, the marks are effectively meaningless for what can be broadly termed financial services. The dollar sign in the registered proprietor's mark is a money symbol but given its use in the UK it is relatively meaningless.

24) Considering the marks as wholes and acknowledging the differences I consider the marks to be similar.

25) I take all of the above into account when considering the marks globally. I also take into account the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between services, and vice versa. In the instant case the services are very similar and the marks are similar, if not identical. Despite the fact that financial services are usually purchased with considerable care I believe that there is a likelihood of consumers being confused into believing that the services provided by the registered proprietor are those of the applicant or provided by some undertaking linked to them. The application for invalidity under Section 5(2) (b) therefore succeeds in relation to the whole of the specification and the registration is deemed never to have been made.

COSTS

26) As the applicant has been successful it is entitled to a contribution towards its costs. I order the registered proprietor to pay the applicant the sum of £900. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Preparing a statement and considering the other side's statement	£200
Preparing evidence and considering and commenting on the other side's evidence	£100
Preparing for and attending interlocutory and main hearing	£400
Expenses	£200
TOTAL	£900

Dated this 10 day of January 2011

**G W Salthouse
For the Registrar
the Comptroller-General**