

O-030-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 3088451
BY
TAYFUN PERINCEK
TO REGISTER THE TRADE MARK**

GreenBazaar

IN CLASSES 29, 30 and 43

**AND
OPPOSITION 404279 THERETO
BY
SBE LICENSING, LLC**

Background and pleadings

1. Tayfun Perincek (the applicant) applied to register the trade mark 'GreenBazaar' on 08/01/2015. It was accepted and published in the Trade Marks Journal on 06/02/2015 in respect of the following goods and services:

Class 29

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals; soups and potato crisps.

Class 30

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

Class 43

Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.

2. SBE Licensing, LLC (the opponent) opposes the trade mark under Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier Community Trade Mark 9864851 'THE BAZAAR'. The following services are relied upon against the applicant's services in Class 43.

Class 35

Business management of hotels, resorts, restaurants, bars, and nightclubs.

Class 41

Night club services.

Class 43

Restaurant and bar services; hotel and resort services; provision of general purpose facilities for meetings, conferences and exhibitions; reservation services for hotel accommodations; catering, food, and beverage services.

3. The opponent argues in its statement of case that the respective services are identical or similar, and that the marks are similar. No mention is made of the goods of the applied for mark. Given its date of filing (4 April 2011) the opponent's mark is an earlier mark for the purposes of the Act and as it had not been filed more than five years prior to the date of publication of the applicant's mark, it is not subject to proof of use.
4. The opponent makes submissions, filed later in the proceedings, regarding the similarity of the applicant's goods in classes 29 and 30 to its services in class 43. However, having limited its opposition to the applicant's services in class 43 in its

statement of case and not having made an application to amend, it may not introduce new grounds via its submissions. The opposition is restricted to the applicant's services in class 43.

5. The opponent is stated in submissions of 27 July 2015 to be 'unsure' of the extent to which the applicant has a bona fide intention to put his mark to use in the UK. This appears to be a vague reference to a potential objection under section 3(6) of the Act that the application was made in bad faith, though no such claim appeared in the opponent's statement of case. The opponent's second submissions of 3 November 2015 criticise the applicant for not having refuted such a claim in its counterstatement. However, no 3(6) ground was pleaded by the opponent except by abstract reference in the submissions. No application was made to amend the pleadings, for which I note the opponent paid the reduced fee of £100 based on having pleaded only section 5(2)(b). Therefore the applicant has no 3(6) claim to refute.
6. The applicant filed a counterstatement denying the claims, which was challenged by the opponent, but ultimately deemed sufficient by the Registry in a letter dated 19 June 2015.
7. Neither party filed evidence, and only the opponent filed written submissions, dated 27 July 2015 and 5 November 2015. These will not be summarised but will be referred to where appropriate. No hearing was requested and so this decision is taken following a careful perusal of the papers.

DECISION

8. Section 5(2)(b) of the Act is as follows:

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. 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 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

10. In the judgment of the Court of Justice of the European Union in *Canon*, Case 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.

11. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

12. As noted at paragraph 4 above, the opposition is restricted to the applicant's services in Class 43. It is unnecessary to consider the opponent's services in Classes 35 and 41; they will put the opponent in no better position than its services in Class 43. The services to be compared are therefore:

Applicant	Opponent
Class 43 Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.	Class 43 Restaurant and bar services; hotel and resort services; provision of general purpose facilities for meetings, conferences and exhibitions; reservation services for hotel accommodations; catering, food, and beverage services.

13. A number of the applicant's services are identical to those of the opponent, which can be grouped as follows:

Applicant's services	Opponent's identical services
Class 43 Services for providing food and drink; restaurant, bar and catering services;	Class 43 Restaurant and bar services; catering, food, and beverage services.
provision of holiday accommodation; temporary accommodation; booking and reservation services for holiday accommodation;	hotel and resort services; reservation services for hotel accommodations;

14. There may be services contained within the applicant's wider term 'holiday accommodation' that would not be identical to the opponent's 'hotel and resort services', e.g. self-service apartments. However these would still be highly similar to the services of the opponent.
15. The remaining services of the applicant for which the opponent has no identical services are 'retirement home services', 'creche services' and 'booking and reservation services for restaurants', the latter of which is similar to the restaurant services of the opponent. The opponent concedes in submissions dated 27 July that retirement home services "may fall outside the scope of the earlier registration". No mention is made of creche services.
16. The closest match for 'retirement home services' would be 'resort services', and for 'creche services' would be 'provision of general purpose facilities for meetings', but to find that these are identical would require the terms to be stretched beyond their natural meaning. Nor can they be regarded as similar, due to the very different nature, intended purpose and method of use. As Jacob J. as he then was said in *Avnet Incorporated v Isoact Limited*, [1998] FSR 16;

In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.

17. More recently, 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."

Average consumer and the purchasing act

18. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. 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*.

19. 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.

20. The average consumer of the services in question is a member of the general public, who will select most of the services with an average level of care and attention through primarily visual means via websites and other advertising materials, and possibly also via the telephone following word-of-mouth recommendations when aural considerations will be more prevalent. There will also be business customers for any of these services. For both categories of consumer, there will be a slightly elevated level of care and attention taken when selecting certain catering services such as those for particular functions, for example weddings or AGMs.

Distinctive character of the earlier trade mark

21. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, 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).

22. The opponent correctly states that the applicant's statement regarding other marks on the Register containing the word 'Bazaar' must be given no weight, as mere presence on the Register is not evidence of the use of such marks in the marketplace. However the opponent incorrectly goes on to submit that this same absence of evidence should be regarded as evidence of absence of use in the marketplace, and that the opponent's mark's distinctiveness and ambit of protection should therefore be regarded as enhanced. I reject this.
23. The opponent has filed no evidence of use of its mark, consequently, I have only its inherent characteristics to consider. The mark is comprised of a real and commonly understood word denoting a marketplace, plus definite article. The word Bazaar is not descriptive of the services, though it may be slightly allusive of 'food and beverage services'. Overall I find that the mark is possessed of an average level of inherent distinctive character.

Comparison of marks

24. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the 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.

25. 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 impressions created by the marks. The marks to be compared are: **GreenBazaar** and **THE BAZAAR**.
26. The opponent's mark consists of the words 'THE BAZAAR'. The definite article has little relative weight in the overall impression of the mark, the overall impression of which will therefore be based upon the word 'bazaar'.
27. The applicant's mark consists of the conjoined words 'GreenBazaar', a compound of the words 'Green' and 'Bazaar', highlighted by the capitalisation of the second word. As a phrase it hangs together as a unit to give the impression of a marketplace that is either the colour green, or is in some way environmentally responsible. The word 'Green' qualifies the word 'Bazaar', which will therefore have the greater impact in the overall impression of the mark.

28. I recognise that the mark of the opponent is registered in uppercase, whereas the mark of the applicant is presented with only the initials capitalised – however this will have no bearing on the outcome as the opponent is not restricted only to upper case usage under this registration.
29. Visually and aurally the marks share the common element ‘Bazaar’, which is the latter element of both marks. The former elements differ, being ‘THE’ in the opponent’s mark and ‘Green’ in the applicant’s mark. I do not agree with the opponent that the word ‘Green’ should be seen as ‘negligible’ in the applicant’s mark, though it does carry lower relative weight than the word ‘Bazaar’. I do however agree that the word ‘The’ will play very little role in the opponent’s mark. This is so notwithstanding the general importance placed upon the beginnings of marks (see for example *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, *Castellani SpA v OHIM*, T-149/06, *Spa Monopole, compagnie fermière de Spa SA/NV v OHIM*, T-438/07 (similar beginnings important or decisive), *CureVac GmbH v OHIM*, T-80/08 (similar beginnings not necessarily important or decisive) and *Enercon GmbH v OHIM*, T-472/07 (the latter for the application of the principle to a two word mark)).
30. On balance and bearing in mind the above factors, I find there to be a degree of visual and aural similarity slightly above the medium.
31. Both marks are conceptually evocative of a marketplace, though the applicant’s mark has an additional conceptual significance on the basis of the qualifier ‘Green’. On balance I find there to be a medium degree of conceptual similarity.

Likelihood of Confusion

32. By way of summary, I have found that average consumer is a member of the general public, or a business consumer, both of whom will take an average degree of care and attention in the selection process of most of the services. There will be a slightly elevated level of care and attention paid in circumstances where the service is for catering to be used for a particularly special function. I have found that there is a level of visual and aural similarity slightly above medium, and a medium degree of conceptual similarity. The earlier mark is possessed of average inherent distinctiveness.
33. The services in class 43 are identical or similar, with the exclusion of retirement home services and creche services which are neither identical nor similar to any of the opponent’s services. Where there is no similarity between the services then the opposition must be rejected (see for example *Waterford Wedgwood plc v OHIM* (Case C-398/07)).
34. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted that:

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.

35. Given the above findings and taking into account all the relevant factors, I find that the shared use of the word 'Bazaar' by the two marks will lead to indirect confusion by consumers of the services, who will conclude that the services emanate from linked economic undertakings; i.e. they will read the two marks and mistakenly form the view that there is some link between the two marks owing to the shared word 'Bazaar'.

Conclusion

36. The opposition has been partially successful in relation to the opposed services, succeeding in respect of the following services in Class 43:

Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation.

37. The application may proceed to registration for the remaining goods and services:

Class 29

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals; soups and potato crisps.

Class 30

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

Class 43

Retirement home services; creche services.

COSTS

38. The opponent has been only partially successful and, whilst entitled to a contribution towards its costs, this has been reduced according to its measure of success. In the circumstances I award the opponent the sum of £350, calculated as follows:

Official fees

£100

Preparing a statement and considering the other side's statement:	£100
Preparing submissions	£150
Total	£350

39. I therefore order Tayfun Perincek to pay SBE Licensing, LLC the sum of £350, payable 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 19th day of January 2016

**Andrew Wall
For the Registrar**