

O-462-18

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3245283 BY
DISA FOODS LTD
TO REGISTER:**

**Sultans
sultans**

AS A SERIES OF TWO TRADE MARKS IN CLASS 29

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 410375 BY
EGETÜRK WURST- UND FLEISCHWARENFABRIKATION GmbH & Co KGaA**

Background and pleadings

1. Disa Foods Ltd (“the applicant”) applied to register the trade mark series

Sultans
sultans

in the UK on 21 July 2017. It was accepted and published in the Trade Marks Journal on 11 August 2017 in respect of the following goods:

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.

2. Egetürk Wurst- und Fleischwarenfabrikation GmbH & Co. KGaA (“the opponent”) opposes the trade mark application on the basis of Section 5(2)(a) and (b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier European Union (formerly Community) Trade Mark 13809322. The earlier trade mark, SULTAN, is registered for the following goods which are relied upon in this opposition:

Class 29

Sausages and prepared meat products.

It was applied for on 9 March 2015 and registered on 30 July 2015. The opponent argues that the respective goods are highly similar, if not identical, to the goods covered by its earlier mark, and that the marks are identical or highly similar. This similarity, it claims, would result in a high likelihood of confusion and association with the earlier marks on the part of the relevant consumer. As nothing turns upon the fact that the application is for a series of marks, for convenience, I will, from this point, refer to the series in the singular.

3. The applicant filed a counterstatement denying the claims made.
4. Neither side filed evidence in these proceedings.
5. Only the opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.
6. In these proceedings the opponent is represented by D Young & Co LLP and the applicant is represented by Fortis Rose Solicitors.

Decision

7. Section 5(2)(a) of the Act states that:

A trade mark shall not be registered if because –

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the 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.

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

A trade mark shall not be registered if because –

...

- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

9. An “earlier trade mark” is defined in section 6(1) of the Act as:

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.

10. The registration upon which the opponent relies qualifies as an earlier trade mark under the above provision. As this earlier mark was registered within the five years before the date on which the applicant’s mark was published, it is not subject to proof of use. The opponent is therefore entitled to rely upon it for all the goods for which it stands registered.

Case Law

11. In reaching a decision, I have borne in mind the following principles, 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 goods and services

12. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer* (Case C-397/97).

13. Guidance on this issue has come from Jacob J in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281, where the following factors were highlighted as being relevant when making the comparison:

(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.

14. In comparing the goods, I have considered the meaning of the expressions used in the specifications, following the comments of Floyd J in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158:

... 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.

15. The opponent has claimed that the following goods in the applicant's specification are identical to goods covered by its own trade mark:

Meat, poultry and game; meat extracts.

The opponent has also claimed that the following goods in the applicant's specification are similar to goods covered by its own trade mark:

Fish; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams and compotes; eggs; milk and milk products; edible oils and fats.

16. Goods that are not worded identically may still be considered identical if one term is encompassed by a more general term used in the specification of the earlier mark, or vice versa, as set out by the General Court in *Gérard Meric v OHIM* (T-133/05), paragraph 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.

17. The opponent's mark covers "Sausages and prepared meat products". In *Sainsbury's Top Dog* BL O/044/16, Miss Emma Himsworth QC, sitting as the Appointed Person said (my emphasis):

23. Firstly, Class 29 is concerned with goods, mainly foodstuffs of animal origin that have been prepared for consumption or conservation. 'Meat, fish, poultry' form a part of the class heading for Class 29 and it seems to me that 'hot dogs; meat products; meat pies; sausages; hamburgers; beef burgers; poultry products; snack foods in Class 29; prepared meals in Class 29' are, as stated by the Opponent, a subset of the goods identified within the wording of the class heading. It does not seem possible to me to suggest otherwise.

24. Secondly, it does not seem to me that the reasoning behind the distinction drawn by the Hearing Officer between *'hot dogs; meat products; meat pies; sausages; hamburgers; beef burgers; poultry products; snack foods in Class 29; prepared meals in Class 29'* being goods *'which [are] ready to eat'* and *'Meat, poultry and game; meat extracts; mincemeat; constituents for meals in Class 29'* being goods *'which need further processing'* or are to be regarded as

'the "raw" food goods' can be drawn in the way that is suggested by the Hearing Officer.

25. All of the goods within Class 29 have been prepared for consumption or conservation. It seems to me that '*Meat, poultry and game; meat extracts; mincemeat; constituents for meals in Class 29*' do not necessarily require further processing or indeed cooking before they are '*ready to eat*'.

18. Consequently, I find that the applicant's meat, poultry and game covers the opponent's sausages and prepared meat products and so these goods are identical. Following this reasoning, I also find that meat extracts are identical to prepared meat products. A meat extract is a product that has been prepared from meat. If, however, I am wrong that meat extracts are identical, they are, in my view highly similar to prepared meat products.

19. I shall now consider the remaining goods in the applicant's specification. I find that the users of all these foodstuffs will be the same: humans who want something to eat. My comparison of the remaining goods will therefore concentrate on the other factors identified in *Treat*.

20. "Fish" may describe a whole fish or part of one, and has the same uses as sausages and prepared meat products. Although their nature is more different and they are not sold by butchers, the supermarket is the main trade channel and these goods are often stocked near each other in the chiller cabinets. There is a degree of competition between the goods. I find that fish has a medium degree of similarity to sausages and prepared meat products.

21. Turning to preserved, frozen, dried and cooked fruits and vegetables, I find that the uses are not the same: the sausages and prepared meat products form the main part of a meal, while preserved, frozen, dried and cooked fruits and vegetables are more of an accompaniment. The nature of the goods is different (plant-based, as opposed to animal-based) and they would be located in different places in the shop and are not in competition with each other. The opponent states that preserved, frozen, dried and cooked fruits and vegetables are often consumed

as “an accompaniment to sausages and prepared meat products”, and that they are therefore complementary products.

22. The purpose of examining whether there is a complementary relationship between goods and/or services is to assess whether the relevant public is liable to believe that responsibility for the goods and/or services lies with the same, or with an economically connected, undertaking. It is not sufficient for a finding of complementarity that the goods are often used together, as Mr Daniel Alexander QC, sitting as the Appointed Person, noted in *Sandra Amalia 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.

23. The opponent notes that:

Consumers are used to a range of foodstuffs being branded by one company. For example: Sainsbury’s, Tesco, Lidl, Aldi, Marks and Spencers and Waitrose. It would not be unusual to buy a variety of food products under the same label.

All these companies are retailers that stock “own brand” products alongside those from other brands. Such products are not confined to foodstuffs. It would not be unusual for consumers to buy a wide range of goods – for example, food, toiletries, household goods – under the same “own brand” label. It does not follow that such goods are necessarily similar.

24. Having made a careful comparison in line with the guidance in *Treat*, I find that preserved, frozen, dried and cooked fruits and vegetables are dissimilar to sausages and prepared meat products.
25. The opponent uses a similar argument of complementarity in the cases of jams, jellies and compotes, and of eggs. I find that these also are dissimilar goods: the

nature and uses are different; while the trade channels are the same, the goods are sold in different parts of the supermarket; and they are not in competition with sausages and prepared meat products.

26. Milk and milk products are, the opponent notes, cooking ingredients. The opponent goes on to say that they “could be used in the same dishes, for example, sausages and milk are used in the well-known British dish ‘toad in the hole’”. The fact that ingredients may be used together is not sufficient for finding that the products are similar, if their nature, uses and users are different (see *Intermark Srl v OHIM (Naty’s)*, T-72/10, paragraphs 35-36, referred to in *Newlat GmbH v Van Berkel International Srl*, EUIPO Opposition No B 2 524 562). The same argument applies to edible oils and fats. The nature and uses are different and, as with the goods discussed in paragraphs 24-28 above, they are stocked in different parts of the shop. Milk is sold in chiller cabinets, but these are often separated from the cabinets containing sausages and prepared meat products. Again, these goods are not in competition with each other. The same applies to edible oils and fats. I find that milk and milk products and edible oils and fats are dissimilar to sausages and prepared meat products.

27. In summary, I find that the following goods are identical or similar to sausages and prepared meat products:

Meat	Identical
Poultry	Identical
Game	Identical
Fish	Medium similarity
Meat extracts	Identical or highly similar

I find that the following goods are dissimilar:

Preserved, frozen, dried and cooked fruits and vegetables; jellies, jams and compotes; eggs; milk and milk products; edible oils and fats

Average consumer and the purchasing act

28. 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*.
29. The average consumer will be a member of the general public who regularly shops for food, most likely on a weekly basis, either in a physical outlet, such as a supermarket, or online. They can be expected to be paying no more than average attention when selecting the goods. The goods are likely to be selected primarily by visual means.

Comparison of marks

30. For economy of process, I will consider the position under section 5(2)(b), which requires only that there is similarity between the marks and the goods.
31. It is clear from *Sabel BV 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 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.

32. It would be wrong, therefore, artificially to 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.

33. The respective marks are shown below:

Opponent's mark	Applicant's marks
SULTAN	Sultans sultans

34. The applicant's marks consist of the word "sultans", with the first letter in either upper or lower case, in a standard font with no stylisation. The overall impression of the contested marks rests in just that word.

35. The opponent's mark consists of the word "SULTAN", presented in upper-case letters in a standard font with no stylisation. The overall impression of this earlier mark rests in just that word.

Visual comparison

36. The earlier mark comprises the singular noun "SULTAN" in capital letters. The contested marks are made up of the same word in the plural form, with the additional "s" at the end. Registration of a mark in capital letters covers use in lower case¹. The marks are visually highly similar, the only difference being the pluralisation.

¹ See paragraph 16 of the decision of Professor Ruth Annand, sitting as the Appointed Person, in BL O/158/17, *Bentley Motors Limited v Bentley 1962 Limited*.

Aural comparison

37. The earlier mark will be articulated as SUL-TAN, while the contested marks will be articulated as SUL-TANZ. The sounds are almost identical, with a single additional element at the end of the contested marks. I consider there to be a high degree of aural similarity between the marks.

Conceptual comparison

38. A sultan is a ruler, generally in the Middle East. In my view, the average consumer would make this connection. The only difference is that the earlier mark brings to mind one sultan, while the contested marks bring to mind more than one. I consider there to be a high degree of conceptual similarity between the marks.

Distinctive character of the earlier trade mark

39. Having compared the marks, it is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

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).

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).²

40. The opponent has not filed any evidence to show that it has used its mark, so I must consider only the question of inherent distinctiveness. The word “sultan” has, as I have already found, a meaning that will be known to the average consumer. It does not describe, or allude to, sausages and prepared meat products. Accordingly, I find that the mark has a medium level of distinctiveness.

Conclusions on likelihood of confusion

41. I have so far considered the factors that need to be taken into account when assessing the likelihood of confusion and now come to a global assessment. As the CJEU stated in *Canon Kabushiki Kaisha*:

A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods and services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.³

² Paras 22-23.

³ Para. 59

42. In my view, the identity and similarity between sausages and prepared meat products and meat, poultry, fish, game and meat extracts is such that it is likely that the average consumer would pick up any products showing the contested marks and mistake them for the earlier mark, given the high degree of similarity between the marks and the imperfect recollection of the average consumer as to how the word is presented and whether it is in the singular or plural form.
43. I found that the other goods applied for were dissimilar and accordingly there is no likelihood of confusion.
44. The opposition succeeds under section 5(2)(b) of the Act in respect of the following goods: meat, poultry, fish and game; meat extracts.
45. The opposition fails under section 5(2)(b) of the Act in respect of the other goods specified in the application.

Conclusion

46. The opposition has been partially successful. The application will be refused in respect of the following goods in Class 29:

Meat, poultry, fish and game; meat extracts.

47. It can proceed to registration in respect of the following goods in Class 29:

Preserved, frozen, dried and cooked fruits and vegetables; jellies, jams and compotes; eggs; milk and milk products; edible oils and fats.

Costs

48. Both parties have achieved a measure of success, with the applicant succeeding on a slightly higher proportion of the goods. In the circumstances I award the applicant the sum of £100 as a contribution towards the cost of considering the opposition and filing a counterstatement.

49. I therefore order Egetürk Wurst- und Fleischwarenfabrikation GmbH & Co KGaA to pay Disa Foods Ltd the sum of £100. The above 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 25th day of July 2018

Clare Boucher

For the Registrar,

The Comptroller-General