O/1094/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 3990988

IN THE NAME OF HALEPLIOGLU ENDUSTRIYEL FISTIK GIDA SANAYI VE TICARET LIMITED SIRKETI

TO REGISTER THE FOLLOWING TRADE MARK:

IN CLASSES 29, 30 & 35

AND

THE OPPOSITION THERETO UNDER NUMBER 447090

BY NORDEX HOLDING A/S

Background and pleadings

1. On 13 December 2023, HALEPLIOGLU ENDUSTRIYEL FISTIK GIDA SANAYI VE TICARET LIMITED SIRKETI ("the applicant") applied to register the figurative trade mark shown on the previous page in the UK. It was accepted and published in the Trade Marks Journal on 15 March 2024. The following goods are opposed in these proceedings:

Class 29: Dairy products and dairy substitutes.

2. On 24 April 2024, Nordex Holding A/S ("the opponent") opposed the trade mark based upon Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). This is on the basis of its two earlier UK comparable trade marks:[1]

1. **YESILOVA**

UK registration number: UK00901160126
Filing date: 3 May 1999
Registration date: 2 June 2000
("*the opponent's earlier '126 registration")*

The following goods are relied on for this opposition:

Class 29: Milk products; cheese.

2. YEŞİLOVA

[1] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent's EUTM being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original priority date.

UK registration number: UK00911558368
Filing date: 8 February 2013
Registration date: 20 June 2013
("*the opponent's earlier '368 registration")*

The following goods are relied on for this opposition:

Class 29: Milk products; cheese.

3. By virtue of their earlier filing dates, the opponent's above registrations constitute earlier marks in accordance with section 6 of the Act. As the opponent's earlier '126 and '368 registrations had been registered for more than five years before the filing date of the applicant's mark, they are, in principle, subject to the use provisions set out in section 6A of the Act. The opponent has stated that it has used the marks for all the goods and services relied upon.

4. Under section 5(2)(b), the opponent claims that the respective goods and services are identical or highly similar and that the marks are similar. As such, the opponent submits there will be a likelihood of confusion between the marks, including a likelihood of association.

5. The applicant filed a counterstatement in which they concede that the goods and services are similar but deny that there is any similarity between the marks. The applicant requested the opponent to file proof of use for the opponent's earlier registrations relied upon.

6. Both parties filed evidence. The opponent filed submissions in reply to the applicant's evidence, the applicant did not file submissions. No hearing was requested and so this decision is taken following a careful perusal of the papers.

7. The opponent is represented by Stevens, Hewlett & Perkins. The applicant is represented by RightPro IP & Legal Consultancy Ltd.

8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the

European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Preliminary issues

9. In its submissions in reply, the opponent submits that "at no point in the counterstatement does the applicant refer to the opponent's prior trade mark registration UK00901160126 YESILOVA (word)". It submits that the lack of reference to this earlier mark should be taken as an admission of the opponent's claim. In its counterstatement, the applicant's states "the Opposition has been filed for the above goods only. The Applicant confirms a degree of similarity between the above goods, however, for the Article 5(2)b of the Trade Mark Act, the other criteria, namely similarity between the signs and likelihood of confusion are not met". Although it would have been preferable for the applicant to have conducted its comparison of the signs referring to both earlier marks, this is not a requirement. I consider that the applicant's general statement applies to the opposition based on both earlier marks, stating that its position is that there is no similarity between its mark and either of the opponent's earlier marks, and no likelihood of confusion. I also note that, had this point been raised by the opponent earlier in the proceedings, this could have been raised with the applicant, at which point it would have had the opportunity to amend its counterstatement if required (although I note that, for the reasons given, this would not have been strictly necessary).

10. I also note that the opponent relies on the goods "milk products; cheese" within its TM7, but 'cheese' does not appear in the list of goods for either mark. However, I note both earlier marks are registered for the goods 'milk and milk products'. The relied upon 'cheese' falls within the scope of milk products. The reference to cheese therefore makes no difference to the scope of the opponent's pleaded case, and it is acceptable for the opponent to rely upon this term.

Evidence

11. The opponent's evidence was filed in the form of a witness statement, dated 4 September 2024. This was filed by Martin Aagaard Pedersen, the CEO of Nordex Holding A/S, the opponent. The witness statement introduces six exhibits labelled Exhibit 1 to Exhibit 6. The purpose of the evidence is to address the applicant's request for the opponent to show proof of use for the opponent's earlier '126 and '368 registrations.

12. The applicant also filed evidence in the form of a witness statement, dated 11 November 2024. This was filed by Hatice Ahu Güneyli Havelock, a trade mark lawyer and part-qualified UK trade mark attorney representing the applicant. The witness statement includes one exhibit showing the applicant's brochure in which the contested mark is used.

13. I do not intend to summarise the evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

Decision

Relevant period

14. The opponent's earlier '126 mark was registered on 2 June 2000 and its earlier '368 mark on 20 June 2013. The contested mark was filed on 13 December 2023. As previously set out, as the earlier marks had been registered for more than five years on the date on which the contested application was filed, Section 6A of the Act applies. It states:

> "(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), (aa) 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 relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

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

(3) The use conditions are met if –

(a) within the relevant period 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 (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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)-(5A) [Repealed]

(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."

15. As the earlier marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

> "7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.
>
> (2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—
>
> (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and
>
> (b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.
>
> (3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —
>
> (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and
>
> (b) the references in section 6A to the United Kingdom include the European Union".

16. The relevant period for proof of use of the opponent's marks is from 14 December 2018 to 13 December 2023. I note that the relevant territory will be considered the EU (including the UK) from 14 December 2018 to 31 December 2020, and the UK only from 1 January 2021 to 13 December 2023.

PROOF OF USE

Relevant case law

17. In *easyGroup Ltd* v *Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C40/01 Ansul BV v Ajax Brandbeveiliging BV [2003] ECR I-2439, Case C-259/02 La Mer Technology Inc v Laboratories Goemar SA [2004] ECR I-1159, Case C-416/04 P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [2006] ECR I-4237, Case C-442/07 Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'[2008] ECR I-9223, Case C-495/07 Silberquelle GmbH v Maselli-Strickmode GmbH [2009] ECR I-2759, Case C-149/11 Leno Merken BV v Hagelkruis Beheer BV [EU:C:2012:816], Case C-609/11 Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], 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], Case C-689/15 W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 Ferrari SpA v DU [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised 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] and [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]; Ferrari at [32].

(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]; Gözze at [37], [40]; Ferrari at [32].

(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]; Ferrari at [33].

(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 the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: Reber at [32].

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and Ferrari at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 Lidl Stiftung & Co KG v European Union Intellectual Property Office [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. Lidl at [33]. In Awareness Ltd v Plymouth City Council [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

> ‘19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. […]
>
> 22. […] it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal […] comes to take its final decision, the evidence must be sufficiently solid and specific

> to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

18. Proven use of a mark which fails to establish that "the commercial exploitation of the marks 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.

Genuine use

19. In the opponent's witness statement, Mr Pedersen states that Nordex Holding A/S ("the opponent") was founded in 1984 in Denmark and is now one of Northern Europe's largest suppliers of white cheeses, with customers throughout the UK, and the EU more broadly.

20. YESILOVA is one of the opponent's ranges of white cheese. Mr Pedersen provides sales volumes for goods bearing the YESILOVA trade mark sold in the UK from 2019 to 2023, which vary between 25,603kg and 47,320kg per year.

21. Exhibit 1 contains two product catalogues relating to the YESILOVA range from October 2019, which Mr Pedersen says are still in use. The catalogues show the earlier '368 figurative trade mark on the pages, as well as on the products depicted in the catalogue. The catalogues show what appears to be four different types of cheese for sale under the YESILOVA brand, with one of the types being available in different sized containers, along with packaging specifications. The products are sold in a range of weights, from 400g to 16kg, suggesting that the volume of goods sold equates to a significant number of individual items.

22. Exhibit 2 contains the current price list of products offered by the opponent, including the YESILOVA range, however the prices have been redacted so it is not possible to ascertain the value of the products.

23. Exhibit 3 contains a selection of invoices dated between 2019 and 2023. The invoices do not show the YESILOVA mark on the main body of the invoice, but they

all show that YESILOVA products have been bought. Again, the cost of the products has been redacted. Although a number of invoices are provided, they only relate to two UK companies, one in Middlesex and one in Gloucestershire.

24. Exhibit 4 contains invoices to three additional customers within the EU between December 2019 and December 2020. These invoices also show products named YESILOVA being sold.

25. Exhibit 5 contains printouts from the opponent's website, showing one of the YESILOVA cheese products, and a printout of the "Wayback Machine" which shows that this website was available between 14 August 2022 and 5 December 2023. I note that the website URL contains '.eu', suggesting it is an EU website, and the phone numbers at the bottom of the webpage have the area code +45, which relates to Denmark. Given that the relevant period was in the UK only from 1 January 2021 to 13 December 2023, I do not consider that this exhibit demonstrates use in the relevant territory for that portion of the relevant period.

26. Exhibit 6 contains printouts from third-party websites selling YESILOVA cheese products. The third-party websites list an 800g packet of cheese for £6.75 on one website and the same packet for £2.69 on another website. The first three printouts are from UK-based companies, so it seems reasonable to assume that they will have been selling their products to UK consumers. However, I cannot determine the geographical location of the fourth printout, and the website is written partly in English and partly in a different language, so I am not confident that this website is targeted to a UK audience.

27. The evidence is not without its limitations. For example, there are no prices given for the YESILOVA products in the product catalogues in Exhibit 1, although there are some prices listed on the third party websites. There is also no information provided regarding turnover figures and no details as to the amount spent on marketing the goods in the UK, nor is there any reference to the size of the relevant market.

28. An assessment of genuine use is a global assessment, which includes looking at the evidence as a whole.[2] The evidence presented demonstrates that cheese bearing

[2] *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T-415/09

the opponent's mark were purchased by a number of different consumers across the UK and the EU during the applicable portions of the relevant period. The invoices show sales to consumers in various locations across the EU and UK. Whilst I have not been made aware of the turnover figures, the sales volumes of goods bearing the YESILOVA mark in the UK, the weight of the individual products shown in the catalogues and the prices listed on the third-party websites in Exhibit 6 show that the turnover would not be insignificant. Taking all of the evidence into account, I am satisfied that the opponent has shown genuine use of its mark on cheeses.

Fair specification

29. Having reached the above conclusion, I must determine a fair specification upon which the opponent is entitled to rely, bearing in mind the use that has been demonstrated.

30. 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."

31. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

> "245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
>
> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in

relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

32. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J pointed out that 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.

33. Having reviewed the evidence, I am satisfied that the use of the marks has been established for a number of cheeses. I am therefore satisfied that genuine use has been shown for the opponent's 'cheese'.

34. The opponent's relied upon goods include 'milk products'. As noted above, I am satisfied that use has been shown for cheese, which is a milk product. However, there are many other types of milk products that I have not been shown evidence for. Although, as noted above, trade marks need not be limited to the narrowest possible terms of use, I consider that the average consumer would fairly describe the goods evidenced by the opponent as cheese, not as milk products at large, as the average consumer would see this as term as covering a wide variety of goods. I consider that the portion of this term that has been evidenced is covered by the opponent's term 'cheese'.

35. As such, fair specifications for the earlier marks are as follows:

1. YESILOVA

(the opponent's earlier '126 registration)

Class 29: cheese.

2. 

("*the opponent's earlier '368 registration")*

Class 29: cheese.

Section 5(2)(b)

36. 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".

Section 5A

37. Section 5A of the Act is as follows:

> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

The principles

38. The following principles are gleaned from the decisions of the Court of Justice of the European Union ("CJEU") 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 C120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

> <u>The principles</u>
>
> (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

39. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

> "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."

40. 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 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.

41. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the General Court ("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 fur 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."

42. 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."

43. Further, in *Kurt Hesse v OHIM*,[3] 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 OHIM*,[4] the GC stated that "complementary" means:

> "…there is 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 that the responsibility for those goods lies with the same undertaking."

44. With this in mind, the goods for comparison are as follows:

[3] Case C-50/15 P
[4] Case T-325/06

Opponent's goods:[5]	**Applicant's contested goods:**
Class 29: Cheese.	*Class 29: Dairy products and dairy substitutes.*

45. In its written submissions, the applicant admits that, subject to the provision of the proof of use requested, the goods in question are similar.

Dairy products

46. The opponent's 'cheese' falls under the scope of the above goods. These goods are therefore considered identical according to the principles set out in *Meric*.[6]

Dairy substitutes

47. The above goods include substitutes for cheese, so I will compare this to the opponent's 'cheese'. Although there are many dairy-substitutes for cheese, these are typically not labelled "cheese", nor would consumers consider them to be cheese. As such, I consider the ordinary and natural meaning of cheese to be a dairy-based product. The purpose of the goods overlaps as the goods can be used interchangeably. The users overlap as all will be used by the general public but differ where the above goods are used by persons following a vegan diet, who would not be using dairy-based cheese. The nature of the goods differs where the opponent's goods are made of dairy and the above goods are made of alternative sources but overlap as the consistency and texture of the goods is likely to be similar. Trade channels will overlap as both goods will be sold in supermarkets. There is competition between the goods because a consumer will choose whether to buy a dairy-based cheese, or a cheese substitute. There is no complementarity. Overall, I consider the above goods to be highly similar to the opponent's 'cheese'.

[5] The goods relied upon for each of the opponent's earlier registrations are identical. I have not repeated the goods twice in this table for clarity.
[6] Case T-133/05

Comparison of marks

48. 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 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."

49. It would be wrong, therefore, to dissect the trade marks artificially, 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.

50. The respective trade marks are shown below:

The opponent's earlier marks	**The Applicant's contested mark**
1. YESILOVA *"The opponent's earlier '126 registration"* 2.  *"The opponent's earlier '368 registration"*	

51. In its statement of grounds in respect of both earlier marks, the opponent submits that the marks are highly similar, and that all three marks are 8 letters in length and start with the prefix “YESIL”.

52. In its counterstatement, the applicant states that the marks have visual, aural and conceptional differences, and as such there will be no association between the marks.

Overall impression

53. The opponent’s earlier ‘126 registration is a word-only mark consisting of the non-dictionary word “YESILOVA”. There are no other elements in the mark, therefore the word plays a dominant role.

54. The opponent’s earlier ‘368 registration is a figurative mark consisting of the word “YEŞILOVA” in dark blue uppercase lettering, inside a yellow banner which is curved. The word element of this mark is dominant.

55. The contested mark is a figurative mark comprising two words: “yeşil” and “tat” in white lettering, on top of a dark green rectangle with rounded corners and a light green rectangle underneath it, offset so that it is visible in the top right and bottom left of the dark green rectangle. It further comprises two curved lines underneath the wording overlapping the rectangles, the top one being red and the bottom one being light green. The word element of this mark is dominant.

Visual comparison

<u>The opponent’s earlier ‘126 registration</u>

56. The visual similarity between the marks resides in the first five letters “YESIL” in both marks. The contested mark also contains an accent underneath the letter S, and the final letters of the marks differ.

57. Since the similarities between the marks are at the beginning, they have a larger visual impact than if they were at the end.[7] However, the differences in the ending of the words in the marks, and the stylisation of the contested mark still acts as points of

[7] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

visual difference. Overall, I consider that the marks are visually similar to just above a medium degree.

The opponent's earlier '368 registration

58. The visual similarity between the marks is in the first five letters "YESIL" in both marks. The marks differ in their final three letters. The stylisation of both marks is also different, with a different font, colours and figurative elements used. However, as above, the similarities are at the beginning of the marks, where they have more impact than at the end.[8] Additionally, I consider that the word element of the earlier '368 mark is dominant over the figurative elements. Overall, I consider that the marks are visually similar to just above a medium degree.

Aural comparison

59. The opponent's earlier '126 and '368 marks consist of the word 'YESILOVA', either with or without an accent below the S. This will be pronounced as four syllables: "*yes-il-oh-va*". The accent below the S will not affect the pronunciation for the average consumer as this accent is not one that is familiar to the general population of the UK.

60. The contested mark consists of the two words 'yeşil tat'. The consumer will pronounce this word as three syllables: "*yes-il-tat*".

61. The pronunciation of the marks overlaps in the first two syllables, "*yes-il*", but differs where the earlier marks consist of the third and fourth syllables "*oh-va*", and the contested mark consists of the third syllable "*tat*".

62. As it is the first two syllables that are identical between the marks, and the beginnings of marks tend to have more aural impact, I consider that the marks are similar to just above a medium degree.

Conceptual comparison

63. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgements of the GC and

[8] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

the CJEU including Ruiz Picasso v OHIM.[9] The assessment must be made from the point of view of the average consumer.

64. In its counterstatement, the applicant provides translations for the words used in the marks. It states that in the contested mark, the word “yeşil” means “green” and the word “tat” means “taste”. Is also states that in the earlier marks, the word “yesilova” means green meadow. The opponent confirms these translations in their submissions in lieu. I appreciate these translations. However, I consider that a very small portion of UK consumers are likely to understand Turkish. I therefore do not consider that these meanings will be apparent to a significant portion of UK consumers.

65. The earlier ‘126 and ‘368 marks consist of the word “YESILOVA”, which is not an English dictionary word. Some consumers may view this as a foreign word, but they are unlikely to understand the meaning of it. Consumers will therefore attribute no meaning to the earlier marks.

66. The contested mark consists of the words “yeşil” and “tat”, which are not English dictionary words. As above, some consumers may view these as foreign words but they will not understand the meaning of them. Consumers will therefore attribute no meaning to the contested mark.

67. As none of the marks have a meaning that is immediately graspable to the average consumer, the marks are conceptually neutral.

Average consumer and the purchasing act

68. As the case law above indicates, it is necessary 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:

[9] [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

> "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."

69. The goods at issue will be purchased by the general public. The products are low-cost and are likely to be bought frequently by consumers. I therefore consider that members of the general public will pay a low degree of attention during the purchasing process.

70. The goods and services at issue will be purchased from supermarkets. Although I do not discount aural considerations as advice may be sought from a shop assistant, I consider that visual considerations will play a larger role as the consumer will see the products on the shelf.

Distinctive character of the earlier trade mark

71. 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 *WindsurfingChiemsee* 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)."

72. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

73. Both parties have submitted that earlier marks use a foreign word. I consider that this word may be viewed by the average consumer as either an invented word or a foreign word. Either way, the word will have no evident meaning to the average consumer, and therefore does not allude to or describe the goods at issue. Therefore, I am of the view that both earlier marks are inherently distinctive to a high degree.

74. As the opponent has filed evidence of use of their marks, I will consider whether this evidence demonstrates enhanced distinctiveness of the marks. The sales volumes in the table provided in Mr Petersen's witness statement appear reasonable, particularly in light of the weights of the items shown in the product catalogue, and the prices of the items shown on the third-party websites. The invoices demonstrate use of the marks across the UK and the EU during the relevant period. However, there is no indication of the relevant sales figures, or the market share held by the opponent, nor are there any details regarding the amount spent on advertising the goods. Overall, although I consider that the evidence shows use of the earlier marks, I do not consider that the distinctiveness of the earlier marks has been enhanced to a higher degree than the inherent distinctiveness, which as mentioned is already high.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

75. 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 (or services) and vice versa (*Canon* at [17]). It is necessary to keep in mind the distinctive character of the opponent's trade mark, the average consumer of the goods and the nature of the purchasing act. 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 they have retained in their mind (*Lloyd Schuhfabrik* at [26]).

76. 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 down to the responsible undertakings being the same or related.

77. Earlier in this decision, I found that the goods were either identical or highly similar. I found all the marks to have a just above medium visual and aural similarity. I found the marks to be conceptually neutral. I found the opponent's earlier registrations to possess a high level of inherent distinctive character for the relevant goods. I identified the average consumer to members of the general public, paying a low degree of attention. I found that the goods would be selected primarily by visual means.

78. As noted above, 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 they have retained in their mind (*Lloyd Schuhfabrik* at [26]).

79. Considering direct confusion, I note the just above medium visual and aural similarity. Whilst I note the differences, being that the suffix "OVA" in the earlier marks is replaced by a second word "tat" in the contested mark, as noted above, I consider that this difference being at the end of the marks makes it less obvious to the

consumer.[10] The average UK consumer is likely to recognise the beginning of the word and conclude that the applicant's goods are the same brand as a previously purchased product from the opponent. I do not consider that the figurative elements of the earlier '368 mark and the contested mark are significant enough to affect this conclusion. Bearing in mind the consumer's imperfect recollection, and the low degree of attention that would be paid, I am satisfied that the average consumer would likely fail to notice or misremember the end of the marks in respect of the identical or highly similar goods. The average consumer would therefore mistake the parties' marks for each other in respect of the same.

80. Taking all of this into account, I consider there to be a likelihood of direct confusion between the contested mark and the opponent's earlier marks in relation to all of the goods at issue.

Final Remarks

81. The opposition under section 5(2)(b) has been successful in respect of all of the opposed goods. Subject to any successful appeal, the application will be refused in relation to the following goods:

Class 29: Dairy products and dairy substitutes.

COSTS

82. The opponent has achieved success in these proceedings and is therefore entitled to a contribution towards its costs. In the circumstances, I award the opponent the sum of £950 as a contribution towards the cost of the proceedings, in accordance with Tribunal Practice Notice 1/2023. The sum is calculated as follows:

Preparing and filing the TM7 and statement of grounds and considering the TM8 and counterstatement:	£250
Official fee:	£100

[10] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Preparing evidence and considering and commenting on the other side's evidence:	£600
Total:	**£950**

83. I therefore order HALEPLIOGLU ENDUSTRIYEL FISTIK GIDA SANAYI VE TICARET LIMITED SIRKETI to pay Nordex Holding A/S the sum of £950. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 25th day of November 2025

K HARBACH

For the Registrar