

O-303-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2649109
BY
YASAR DONDURMA VE GIDA MADDELERI ANONIM SIRKETI
TO REGISTER THE TRADE MARK**



IN CLASSES 29, 30 AND 43

AND

**THE OPPOSITION THERETO
UNDER NO 400525
BY
ZEKERIYA GÖZCÜ-FICHTNER**

BACKGROUND

1. On 24 January 2013, Yasar Dondurma Ve Gida Maddeleri Anonim Sirketi (the applicant) applied to register the above trade mark in classes 29, 30 and 43 of the Nice Classification system¹. The specification stands as follows:

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.

Class 30

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, cakes, dessert, puddings, bakery desserts, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; ice creams.

Class 43

Services for providing food and drink; temporary accommodation.

2. Following publication of the application, on 3 May 2013, Zekeriya Gözcü-Fichtner (the opponent) filed notice of opposition against the application.

3. The opposition was brought under section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent relies upon the Community Trade Mark (CTM) insofar as it is registered for the goods and services shown below:

Mark details and relevant dates	Goods and services relied on
CTM: 5710249 Mark: MADO Filing date: 26 April 2007 Date of entry on the register: 11 March 2008	Class 29 Milk and milk products. Class 30 Bonbons. Class 43 Providing of food and drink in cafés and other catering establishments.

4. On 4 October 2013, the applicant filed a counterstatement. It denies the grounds upon which the opposition is based and requested the opponent prove use of its earlier mark. It states:

“8.2. It is respectfully submitted that the opponent is not able to show that genuine use of the earlier mark has been made within the five years preceding the date of publication of the Application, specifically in the

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

period 4 May 2008-3 May 2013, and that there are no proper reasons for non-use of it. The opponent is required to furnish proof of use.

8.3. Further, or alternatively, the opponent's statement of grounds is denied, in particular its claim that there is a likelihood of confusion. The marks are dissimilar."

5. The opponent filed evidence and submissions, the applicant filed submissions in lieu of a hearing; neither party asked to be heard.

6. I give this decision following a review of all of the material before me.

EVIDENCE

7. The opponent's evidence consists of an affidavit by Zekeriya Gözcü-Fichtner, dated 1 January 2014, with five exhibits attached². Mr Gözcü-Fichtner is the Managing Director of Mado-Europa GmbH. His affidavit is in German with a translation provided by Christopher Francis Hatton of Hatton Anderson Associates. The translation is dated 13 January 2014. A witness statement is also provided by Jeremy Bridge-Butler, a trade mark attorney at Baron Warren Redfern (the opponent's representative for the purposes of these proceedings). It is dated 15 January 2014 and is accompanied by 3 exhibits. Looking firstly at the affidavit of Mr Gözcü-Fichtner, the main facts emerging from the evidence are as follows:

"1...the Company [Mado-Europa GmbH] is entitled to exploit the Mark [the subject of these proceedings] under a License Agreement dated 1 July 2011 (exhibit ZG1).

3. Since July 2011 the Company has been distributing a milk ice cream product under the name MADO (the Product) under the Mark within the European Union. Since October 2013 the Company has also operated an ice cream parlour (café) in Mannheim under the name MADO (the Café), which is also identified with the Mark.

4. The milk ice cream product which is distributed by the Company under the Mark is a product which is essentially made of milk since it contains at least 60% by weight of milk. The other components are sugar, oil, water, etc. The main component of the Product is milk and one of the most important flavours is designated 'Milk/Cream'. Moreover, the Product is not only made from milk, it also tastes of milk."

8. Sales figures are provided, at paragraph 6, as follows:

Year	Euros (€)
2011	11,000
2012	12,000
2013	Not completed

² The exhibits are numbered ZG1, ZG2, ZG3, ZG4 and ZG. There are no exhibits headed ZG5 and ZG6.

9. With regard to these figures the opponent states:

“6...It should be emphasised that the product is sold above all during the six months of every year. Approximately 65% of the sales of the Product take place in Germany and approximately 35% in the Netherlands, the United Kingdom and Austria...”

8. The sales made by the Café since its opening in 2013 average 2000.00 EUR per day.”

10. In respect of its promotional activities, the opponent states:

“9. The Company has promoted the Product on the television channel ATV broadcast for Turkish-speaking citizens in Germany with TV spots every year since 2011, above all during the period of Ramadan, when a 3-minute long TV spot in which the Mark MADO could be seen was broadcast every day for three days in succession. This followed Ramadan and the ‘Ramadan Festival’ in 2011, 2012 and 2013.

The Company has promoted the Café through local broadcasts in the Turkish language in Mannheim since October 2013, hourly after the news. The broadcasting of a corresponding radio spot is confirmed by affidavit. The Café also has its own homepage...

10. The Company owns the website www.mado-online.de on which the Mark has been used since 2011.”

11. Exhibit ZG2 is described in the translated document as photographs of the product but appears to be a photograph of three of the labels intended for use on the product. Each of the labels represents a different flavour and has a background photograph appropriate to that flavour. The first has a photograph of milk being poured from a coopered bucket. The second shows cocoa beans and the third, strawberries. Towards the top of the label, in the centre, the mark is shown as follows:



12. The right side of each label shows a light brown, rectangular panel which contains information commonly seen on food products such as, inter alia, the weight of the product, the ingredients and the nutritional information. The translation lists the ingredients as follows:

MILK

Ingredients: Milk powder, sugar, water, glucose syrup, vegetable oil, guar gum, carob bean gum, carrageen.

COCOA (CHOCOLATE)

Ingredients: Milk power, sugar, water, glucose syrup, vegetable oil, guar gum, carob bean gum, carrageen, cocoa powder.

STRAWBERRY

Ingredients: Water, sugar, strawberries, strawberry juice, lemon juice, guar gum, carob bean gum.

The labels are not dated.

13. Exhibit ZG3 is a photograph of the corner view of what is described as “the Café”. The corner of the building has a neon sign with the letters M-A-D-O, presented below each other. The right hand window has MADO on the window in capital letters. The left window has another neon sign with the mark presented in the following form:



14. The photograph is not dated, though paragraph 5 of the affidavit states that the Café has been trading under the mark since October 2013.

15. Exhibit ZG4 comprises 20 invoices and 4 proofs of purchase for stock shipped to other countries. The invoices are dated between 14 August 2009 and 22 December 2012. For ease of reference I have calculated the total sales by country shown in the invoices under the mark described in the invoices as ‘MADO ice cream’³:

Country	No. of invoices	Total sales (€)
Germany	16	3796.96
Netherlands	1	3576.25
Sweden	1	1592.40
United Kingdom	1	3477.54
Austria	1	7400.00

16. The invoice for Austria relates to what is described as, “4 x 3 hour ice show with MADO ice cream”.

17. In addition to the invoices, there are four proofs of shipping for EU tax purposes. The first is dated 17 June 2010 and refers to an address in Austria. It is for ‘21 cartons of MADO ice cream’. No total is given. The second is dated 28 October 2010 and is for 3 x 4g of MADO ice cream to an address in Amsterdam. No value is given. The third is also to an address in Amsterdam and is for 129 cartons of MADO milk

³ Most of these figures include VAT, though not where the invoices show a number of products, some of which are not sold under the mark at issue and have been removed from the calculation. In the absence of these figures provided by the opponent this is the closest approximation I can make of the relevant sales.

flavour ice cream and MARDO⁴ fruit flavour ice cream. It is dated 8 August 2011. It is not clear how many cartons relate to MADO and how many relate to MARDO products. The last of these documents is dated 23 May 2011 and also relates to an address in Amsterdam. It is for 188kg of MADO ice cream. Fourteen of these documents show the following mark in the top left corner of the page:



18. There are no exhibits numbered ZG5 or ZG6. The final exhibit is ZG7 and is a screen shot of the front page of Mado-Europa's website. The mark is shown in the top left corner of the page in the following form:



19. The background photograph at the top of the screen shows a number of different coloured ice cream scoops on a waffle cone, presented on its side. The text of the website refers only to goods sold under a different mark. A translation of the wording on the home page is provided and refers to:

“...our ‘Mardo’ brand famous Turkish ice cream...”

20. The witness statement of Jeremy Bridge-Butler has three exhibits attached. Mr Bridge-Butler states that all of these documents were printed on 15 January 2014.

21. The first, JBB1, is a copy of the Euroglaces Code for Edible Ices taken from <http://euroglaces.eu>. The document is made available by the European Ice Cream Association and is dated “Version 2013 (revision 2)”.

22. Exhibit JBB2 consists of two prints from <http://hagen-dazs.co.uk>. The first is the home page showing a photograph of a man eating ice cream. On the right of the page is a navigation menu. Häagen-dazs' trade mark is shown on the top left corner of the page. The second page is a ‘find a shop’ page which states: “Häagen-Dazs has over 900 shops in 54 countries worldwide.” The Häagen-Dazs trade mark is shown in the top left corner of the page.

23. Exhibit JBB3 comprises three prints from www.benjerry.co.uk. The first page is a

⁴ MARDO is another trade mark owned by the applicant and licensed to the company of which he is the Managing Director. It is not relevant to these proceedings.

print of the home page showing a competition winner. The top of the page shows the BEN&JERRY trade mark in the top left corner and a navigation menu along the top of the page. With regard to the remaining two pages of the exhibit, Mr Bridge-Butler states:

“4. On the same day I also visited the website www.benjerry.co.uk, and navigated to the page: <http://www.benjerry.co.uk/scoop-shops/scoop-shop-locator>. Once on that page I entered the post code of Baron Warren Redfern Hammersmith office and clicked submit to [product] a first result. I then entered the post code of the UK IPO Newport office and clicked submit to produce a second result.”

24. The two pages referred to show maps of London and Newport with a number of markers, shaped as ice cream cones, pointing at various locations. The corresponding addresses are shown on the right of the page. There are 25 locations returned for the London search and 4 in respect of the Newport search. In his submissions Mr Bridge-Butler states at 8.1 that this evidence shows that ice cream products are sold through dedicated stores under the same branding.

25. That concludes my summary of the evidence.

DECISION

26. The opposition is brought under section 5(2)(b) of the Act which reads as follows:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

27. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which,

if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

28. In these proceedings the opponent is relying upon the trade mark shown in paragraph 3 which constitutes an earlier trade mark under these provisions. The application was published on 3 May 2013. The opponent's earlier mark completed its registration procedure on 11 March 2008. Consequently, the opponent's registration is subject to proof of use, as per the Act.

29. The relevant sections read as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

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

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

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

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

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2)(application on relative grounds where no consent to registration).”

30. The relevant period is the five year period ending on the date of publication of the application, namely 4 May 2008 to 3 May 2013. The onus is on the opponent, under section 100 of the Act, to show genuine use of its mark during this period in respect of those goods relied on or, alternatively, to show that there are proper reasons for non-use of the mark during this period.

Proof of use

31. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation based on grounds of non-use.

32. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch) Arnold J commented on the case law of the Court of Justice of the European Union (“CJEU”) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

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

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider* [72].”

33. If it is necessary to consider the issue of fair specifications, I will keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“29. I have no doubt that Pumfrey J. was correct to reject the approach advocated in the *Premier Brands* case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor

the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for 'motor vehicles' only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to 'dig deeper'. But the crucial question is--how deep?

30. Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31. Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use."

34. The comments of Mr Justice Jacob in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

"20. The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pedantic way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) 'three-holed razor blades imported from Venezuela' is an accurate

description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say 'razor blades' or just 'razors'. Thus the 'fair description' is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ('the umbra') for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ('the penumbra'). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

35. The comments of the Court of First Instance (now the General Court) in *Reckitt Benckiser (Espana), SL v OHIM*, Case T- 126/03 are also relevant where it held that:

"45. It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46. Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories."

And the decision of Mr Geoffrey Hobbs QC, sitting as the appointed person in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*⁵, when he stated: 14 of 20

⁵ BL O/345/10

“However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. 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.”

36. First, I have to identify, as a matter of fact, whether the trade mark relied on by the opponent has been genuinely used and if so, in respect of which goods. Having reached a conclusion on that point, I must then go on to decide what constitutes a fair specification.

37. In these proceedings the opponent relies on:

Class 29 - Milk and milk products

Class 30 - Bonbons

Class 43 - Providing of food and drink in cafes and other catering establishments.

38. The opponent’s evidence shows the mark in the forms I have reproduced above and also (in the text of the invoices) in block capitals, MADO.

39. In reaching a decision regarding the opponent’s use of its mark, I am mindful of the decision of Daniel Alexander QC, sitting as the Appointed Person in *Awareness Limited v Plymouth City Council*.⁶ Whilst this decision was made in respect of revocation proceedings it is analogous to the issue to be decided here:

“22. The burden lies on the registered proprietor to prove use... However, 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 (which in many cases will be the Hearing Officer in the first instance) 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.”

40. And further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as ‘tuition services’,

⁶ [2013] RPC 34

is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to ‘tuition services’ even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

41. And in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*⁷, in which Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller-General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.’

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

⁷ BL 0/404/13

Use in respect of the opponent's goods in class 30

42. Having thoroughly examined the evidence, there is no use shown of any goods which can be considered to be bonbons in class 30, nor is there any suggestion that such use has occurred in the opponent's affidavit or submissions. Consequently, no use has been shown for these goods.

Use in respect of the opponent's services in class 43

43. With regard to class 43, the opponent has provided a photograph of a café on which the word MADO can be seen on the window and on the side of the building and also on a hanging neon sign, in which the word is presented in an oval.

44. In its affidavit the opponent states at paragraph 3:

“Since October 2013 the Company has also operated an ice cream parlour (café) in Mannheim under the name ‘MADO’ (the ‘Café’), which is also identified by the mark.”

The relevant period for which proof of use must be shown is 4 May 2008 - 3 May 2013. Clearly, by its own admission, the opponent's café did not open until five months after the relevant period.

45. In its written submissions, regarding use of the mark in respect of the services for which it is registered in class 43, the opponent states:

“7.2...whilst this is outside the relevant period of 4 May 2008 – 3 May 2013, it is clear from the photograph given in exhibit ZG3 that the outlet which has been opened is of a substantial size, and it is logical to assume that it will have been in the planning since prior to 3 May 2013. It is very unlikely that such an enterprise could have been co-ordinated in less than six months. Therefore it is contended that, on the balance of probabilities, the Opponent must have been making serious commercial preparations to use the mark MADO for class 43 services for a period of time which fell within the relevant period.”

46. The only evidence relating to use in class 43 is a single photograph of a café which opened five months after the end of the relevant period. Even if the opponent had been preparing to open its café for some time prior to the actual date of opening, there is no evidence that the mark was ever presented to the public in relation to the services during the relevant period.

47. Furthermore, even if the café had operated within the relevant period (which it did not) the opponent has one café in one town in Mannheim, Germany⁸. The turnover is estimated at 2000 EUR per day, though the opponent has stated elsewhere in its affidavit that the majority of its sales take place during the summer months. It is not clear whether this is average turnover or reflects daily takings during the summer months.

⁸ Population 295,000 in 2012

48. In ONEL⁹ the CJEU stated:

“58. A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

49. Whilst I do not have any evidence to show the size of the market in respect of ice cream parlours, these are low cost goods which will be bought locally. Taking into account the number of high street retailers of ice cream there are likely to be in most towns throughout the community, the territorial reach of one café in one town in Germany is likely to be far too narrow to constitute use such that would satisfy ONEL.

Use in respect of the opponent’s goods in class 29

50. At paragraph 3 of its affidavit the opponent states [my emphasis]:

*“Since July 2011 the Company [Mado-Europa GmbH] has been distributing a **milk ice cream product** under the name MADO (the Product) under the Mark within the European Union.”*

51. Throughout its written submissions and affidavit the opponent refers to its goods sold under the mark as ice cream. All of the invoices refer to the sale of goods described as, in most cases, MADO ice cream and in some cases Mardo ice cream/sorbet. The translation of the website homepage describes the opponent’s product as ice cream, though this is described as Mardo, not MADO, ice cream.

52. A fair specification for the opponent’s goods, taking into account the evidence filed by the opponent, is that use of the earlier mark as registered has been shown in respect of ice cream and that this is the way in which the goods would be described by the average consumer¹⁰.

53. However, the fundamental problem from the opponent’s perspective is that its earlier mark does not include ice cream in its specification. “Edible ices” and “ice cream” are classified in class 30 of the NICE classification system; the opponent has a registration for “milk and milk products” in class 29.

54. In its written submissions the opponent states:

⁹ C-149/11

¹⁰ There are very few references in invoices to goods other than ice cream which would be better described as edible ices but these relate to the mark Mardo, not the mark being relied on in these proceedings.

“3.4. The product is a Maras style dairy ice cream, and it is appreciated that the Nice classification system places the goods ‘ice cream’ in class 30. However, this is just a formal anomaly, and one of several examples in the classification system of potential alternative descriptions for one product type. The Opponent’s product is both a ‘milk product’ as well as theoretically an ‘ice cream’, but given that the term ‘ice cream’ includes goods with zero dairy content, it is contended that ‘milk product’ is actually the more suitable description of the Opponent’s product, given that it has such a high milk content, and in one variation is actually milk flavoured.”

55. In the introduction to its written submissions the applicant states:

“The Exhibits and proof of use relate to goods which are not the subject of the registration relied upon...”

56. At paragraph 6 it states:

“The Opponent advances the argument that the mark has been used in relation to ice creams containing milk as an ingredient and that this constitutes genuine use in relation to the goods, specifically ‘milk products’ in class 29. It contends at [3.4] of its observations that the classification of ice cream in class 30 is ‘just a formal anomaly’. This is strongly rejected.”

57. The applicant also submits that:

“7...class numbers should not be disregarded in deciding what goods are covered by a specification (Altecnic Ltd’s Trade Mark Application (CAREMIX) [2001] EWCA Civ 1928). This is important – the classification system is not solely a formality for examination purposes but also an index used by third parties seeking to establish the parameters of their competitor’s rights. In the decision of the [CJEU] in Case C-307/10 The Chartered Institute of Patent Attorneys (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49], it was stated:

‘...Economic operators must be able to acquaint themselves, with clarity and precision, with registrations or applications for registration made by their actual or potential competitors, and thus to obtain relevant information about the rights of third parties’.

8. An example is provided in Chapter 2 of the registry’s Trade Mark Manual, namely at page 6, paragraph 3.7 of the Classification Guide in which it is stated:

‘Care must be taken concerning the scope of what a particular item covers when viewed in the context of the class in which is applied for or registered. For example, a registration in respect of “articles of clothing” in class 25 does not include “articles of clothing for protection against accidents” in Class 9. Similarly, an application for

“cases” in Class 18 could not include within its scope “violin cases” in Class 15.’

9. It is the Applicant’s contention that the same can be said of the matter at hand: neither ‘milk’ nor ‘milk products’ in Class 29 includes in its scope ‘ice cream’ in Class 30. It is not sufficiently clear that ‘milk products’ should be interpreted to include ice cream.

...

14. It is respectfully submitted that having regard to this test for interpretation, in particular in light of the IP Translator, ‘ice cream’ is the fair way to describe the use that the Opponent has made of the mark and that ‘ice cream’ does not come within the normal and natural meaning of the expression ‘milk product’ as judged by the average reasonably informed consumer of the Opponent’s products. In common parlance, one would expect ‘milk products’ to include milk, milkshakes and milk ferments. ‘Ice cream’ is a separate category of goods. This is particularly so given that the evidence does not substantiate the claim that the overriding ingredient of the Opponent’s goods is ‘milk’. Indeed, two of the packaging samples mention powdered milk as an ingredient but with many other ingredients and without reference to the relative quantities. It is clear from the presentation of the packaging that the product is milk-flavoured in the same [way] that the product with cocoa beans on the front is ‘cocoa’ or ‘chocolate’-flavoured and the packaging with strawberries is for a strawberry-flavoured product. The invoices do not specify which of the three products on page 7 of the evidence have been sold: there is nothing to negate the fact that the sales could relate to the third product on page 7 which does not even contain milk. ‘Milk products’ should not be given an unduly wide construction. It does not follow that all milk-flavoured products are milk products in the same way that not all fruit-flavoured products are fruit products.”

58. The applicant concludes that the nature, methods of production and trade channels of ice cream are different from those of milk products and refer to the registry decision *Robert Wiseman Dairies Plc v Ferrero S.p.A.*¹¹ in which the HO stated:

“41...Within the applicant’s specification the terms ‘milk products, dairy products and edible fats’ in Class 29 do not cover ‘ice cream’ and ‘soft ice’ in Class 30 of the registered proprietor’s specification. This is clear from the ordinary meanings of the words and the fact that they are classified differently.”

59. The product shown in the opponent’s evidence is frozen and sold in containers of varying weights. It is described by the opponent as “ice cream” and appears in those terms on all of the invoices and supporting documentation in evidence. Three product labels are provided, which are the only indication of the ingredients of the product. Two show that the chocolate and milk flavoured versions of the goods have “milk powder” as an ingredient, though no quantity or percentage of total volume of

¹¹ *BL O/246/02*

product is indicated. The strawberry flavoured version of the product contains no milk or powdered milk or any other ingredient that could be described as relating to milk in any way.

60. In RED KOOGA¹² the Hearing Officer, considering whether a liquid supplement could be correctly classified in class 32 as a drink, stated:

“26. None of what I have said about the product is indicative of the average consumer considering the product to be a drink. I come to the view that the product in question would not be fairly described as a drink of any sort. I have answered the question in the negative (what it would not be described as), but in terms of what the product would be described as then it would be some form of liquid food/vitamin/mineral supplement. I consider Mr Brandreth to be correct in that the product is a food or vitamin product that is simply in liquid form for ease of administration. Such a product is likely to fall into class 5. It certainly does not fall within any of the terms listed in the specification. The outcome is consistent with the genuine use test. This test relates to use in such a way as to create or maintain a share in the market for the goods for which it is registered. Potters have not created or maintained a share of the market in the drinks sector.”

61. The same is true in this case. None of what I have concluded has led me to believe that the average consumer would describe the opponent’s goods as “milk products”. The average consumer would describe the product, as the opponent does, as “ice cream”. The term “milk product” is not an ordinary alternative way to describe ice cream. Milk and/or milk products may or may not be ingredients or a flavour of the finished product but do not serve to define the product category.

62. In my view, even if the product at issue were a 100% milk/cream dairy ice cream it would still fall in class 30. ‘Milk products’ in class 29 covers only milk products proper to that class of which ice cream is not one. The opponent has not created nor maintained a share in the market in the milk/milk products sector.

63. Consequently, there has not been use of the opponent’s mark in respect of the goods for which it is registered in class 29.

64. The material provided by the opponent does not show evidence of use of the mark, within the relevant period, in relation to the goods and services in classes 29, 30 or 43, for which it is registered. Consequently, this opposition fails at the first hurdle.

Conclusion

65. The opposition fails as the opponent has failed to prove use of its earlier mark on the relevant goods and services within the relevant period.

COSTS

¹² BL O/462/12

66. The opposition having failed, the applicant is entitled to a contribution towards its costs. I make the award on the following basis:

Preparing a statement and considering the other side's statement: £300

Considering the other side's evidence and preparing and filing submissions: £500

Total: £800

67. I order Zekeriya Gözcü-Fichtner to pay Yasar Dondurma Ve Gida Maddeleri Anonim Sirketi the sum of £800. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11th day of July 2014

**Ms Al Skilton
For the Registrar,
The Comptroller General**