

O-094-21

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**TRADE MARK APPLICATION NO. 3398709**

**BY FINDER YANGI GÜVENLİK ELEKTRONİK SİSTEMLERİ MÜHENDİSLİK SAN.  
VE TİC A.Ş**

**TO REGISTER**



**AS A TRADE MARK IN CLASS 9**

**AND**

**OPPOSITION THERETO**

**UNDER NO. 418243**

**BY JAGUAR LAND ROVER LIMITED**

## Background and pleadings

1. On 13 May 2019, Finder Yangı Güvenlik Elektronik Sistemleri Mühendislik San. ve Tic A.Ş (“the applicant”) applied to register the trade mark shown below under number 3398709:



2. The application was published for opposition purposes on 26 July 2019 for fire extinguishing systems; fire fighting apparatus; automatic fire extinguishing apparatus, all in Class 9.
3. Jaguar Land Rover Limited (“the opponent”) filed a notice of opposition on 28 October 2019. The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all the goods in the application. The opponent bases its claim on the following European Union (“EU”) trade mark registration:<sup>1</sup>

**Mark:** DEFENDER

**EU registration no.** 015433436

**Filing date:** 12 May 2016

**Registration date:** 17 January 2019

**Good relied upon:**

Class 9 sensors; integrated electronic safety systems for land vehicles; safety and driving assistant systems; alarm sensors; gauges; temperature sensors; electrical sensors; fire extinguishing apparatus; emergency warning lights; emergency notification system; computer software, mobile applications and wireless transmission and receiving equipment for use in connection with

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<sup>1</sup> Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act 1994 relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

autonomous and hands-free driving, automobile safety features and warning or alarm functions, accident prevention and traffic alerts; Downloadable software and on-board computer software that provides users with remote and in-vehicle access to motor vehicle functions and functions relating to driver safety, convenience, communication, entertainment, and navigation; diagnostic apparatus consisting of sensors for use in testing vehicle function and in diagnosing vehicle electrical and mechanical problems; highway emergency warning equipment; drivers helmets; racing driver protective clothing; apparatus, gloves and clothing, all for use in protection against accident or injury; parts and fittings for any of the aforesaid goods.

4. Given its date of filing, the trade mark upon which the opponent rely qualifies as an earlier trade mark in accordance with section 6 of the Act.
5. The opponent argues that there is a likelihood of confusion, including a likelihood of association, because the respective marks are similar and the goods are identical or similar. The applicant filed a counterstatement denying the grounds of oppositions.
6. The opponent is represented by Reddie & Grose LLP, and the applicant is represented by mehmet gokhan alper yalcin. Neither party filed evidence. Only the opponent filed written submissions in lieu of a hearing. I make this decision after a careful reading of all the papers filed by the parties.

## **DECISION**

### **Section 5(2)(b)**

8. The opposition is based upon section 5(2)(b) of the Act, which read 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 of the part of the public, which includes the likelihood of association with the earlier trade mark”.

### **Section 5(2)(b) – case law**

7. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L.Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) The matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) The average consumer normally perceives the 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 greater 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the

same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

8. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“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”.

9. It is an established case law that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application - and vice versa.<sup>2</sup>

10. The opponent submits that the applicant’s goods are either identical to the opponent’s fire extinguishing apparatus or similar to apparatus and systems such as “alarm sensors” or “emergency notification system” aimed at preventing and warning the public of fires.<sup>3</sup>

11. For its part, the applicant submits:

“Finder A.S has applied to register Defender trademark for class 9 (fire extinguishing systems; fire fighting apparatus; automatic fire extinguishing apparatus) in a very limited subservices to IPO in UK and

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<sup>2</sup> *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05

<sup>3</sup> See the opponent’s written submissions dated 18 November 2020, paras 33 and 34.

this subservices do not conflict to opponent registered trademark as mentioned in the objection.”<sup>4</sup>

## **Contested goods**

### Fire extinguishing systems; fire fighting apparatus

12. The above-mentioned terms in the application are broad enough to encompass various equipment that detect, suppress or extinguish a fire such as, fire/smoke sensors, fire extinguishers or sprinkler systems. I, therefore, find that the opponent’s fire extinguishing apparatus is included in the applicant’s terms. The competing goods are identical under the *Merit* principle.

### Automatic fire extinguishing apparatus

13. The applicant’s automatic fire extinguishing apparatus are apparatus that functions without human intervention to extinguish fire. Given that the term fire extinguishing apparatus in the opponent’s specification includes both hand-operated and automatic fire extinguishing apparatus, I find that the competing goods are identical under the *Merit* rule.

## **The average consumer and the nature of the purchasing act**

14. As the case law above indicates, I must determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which these goods are likely to be selected by the average consumer.

15. 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:

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<sup>4</sup> See counterstatement.

“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”.

16. I consider that the average consumer of the competing goods is likely to be a member of the general public and business users. The purchases are likely to be dominated by visual considerations as the goods are most likely to be bought after visiting stores or any online equivalents or browsing through catalogues. However, I do not discount the possibility of aural considerations. When selecting the goods, the consumer is likely to consider various factors such as the type of fire the goods are effective against, the kind of fire suppression agent used in the goods, its reliability or other features, for example, size or weight. Given that the competing goods are used to guard against fire, both groups of average consumers are likely to pay a high degree of attention to the purchase process.

### **Distinctiveness of the earlier mark**

17. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or



services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

18. As the opponent filed no evidence, I have only the inherent position to consider. Invented words usually have the highest degree of distinctive character. However, the earlier mark comprises an ordinary dictionary word “Defender”. According to the *Oxford English Dictionary*, the term means a person who defends a place, person, or thing against physical attack.<sup>5</sup> Although the definition refers to defender as a “person”, I think the average consumer is likely to perceive this term to mean both a person or a thing that protects from danger. Fire extinguishing apparatus in the opponent’s specification, which I have found to be identical to the applicant’s goods, are used to guard against danger/hazard (fire). In that context, I think, the word “Defender” is allusive of the purpose of the opponent’s goods. Nonetheless, it does not seem to me that any allusive character goes far enough to lower the inherent distinctive character of the mark to a great extent; I consider the mark is distinctive to a medium degree, or at any rate, not much lower than that.

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<sup>5</sup> <https://www.oed.com/view/Entry/48792?redirectedFrom=defender#eid> [accessed 4 February 2021]

## Comparison of marks


19. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 between the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components.

20. The CJEU stated in 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.”

21. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

22. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
DEFENDER	 The logo for the applicant's trade mark, featuring a blue circle with a white 'D' inside, followed by the word 'Defender' in a bold, blue, sans-serif font.

23. The opponent's mark is a word mark for "DEFENDER". The overall impression and the distinctiveness of the mark lie in this word.
24. The applicant's mark consists of the word "Defender" presented in an unremarkable font in a shade of blue. Next to the word on the left-hand side is a letter "D" in upper case enclosed within two non-intersecting crescents of varying sizes. The shape at the top is smaller than the bottom, and its edges slightly curve inwards into the figure at the bottom. I have already concluded that the word "Defender" possesses a medium degree of distinctive character for the goods at issue – or not much lower than that. Although the device will not go unnoticed, given its size and length, it is the word "defender" that dominates the overall impression of the mark and is the more memorable aspect of the mark.
25. Visually, the opponent's mark is wholly contained in the applicant's mark. The notional and fair use would entitle the opponent to use its mark in any ordinary font type/typeface or colour. Therefore, the colour and the typeface difference between the marks are not relevant to my comparison. With that in mind, the only relevant difference between the marks is the device element in the applicant's mark, which I note takes up only about one-third of the applicant's mark, and does not have a counterpart in the opponent's mark. Considering these factors and bearing in mind the overall impression of the marks, I find that the marks are visually similar to a reasonably high degree.
26. In an aural comparison, the only element that will be articulated in the applicant's mark is the word "defender"; the device is unlikely to be verbalised when the mark is referred to orally. Therefore, the competing marks coincide in the pronunciation of the word "defender" which is the only component of the opponent's mark. The competing marks are aurally identical.
27. From a conceptual perspective, the marks coincide in the concept of "defender" meaning a person or a thing that protects from harm. In terms of differences, the applicant's mark contains an additional device element. The letter D in the device appears to be the first letter of the word "defender". This letter is

presented as enclosed within a ring-like shape that is likely to be understood as symbolising protection. Therefore, I think, for some average consumers, the device is likely to represent the protection that goods bearing the mark “defender” may provide. However, I acknowledge that there may be another group of average consumers who is likely to see the crescent shapes as a stylised border for the letter D and, therefore, will not attribute any conceptual connotation to the device. In any event, it does not seem that this device will introduce any additional concept to the applicant’s mark, nor alter the conceptual impression derived from the word “defender”. From that perspective, I find that the competing marks are conceptually identical.

### **Likelihood of confusion**

28. The factors considered above have a degree of interdependency and must be weighed against one another in a global assessment (*Canon* at [17]; *Sabel* at [22]). They must be considered from the perspective of the average consumer and a determination made as to whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

29. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods/services down to the responsible undertaking being the same or related).

30. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that

these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

31. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls another mark to mind. This is mere association not indirect confusion.

32. Earlier in the decision, I concluded that:

- The respective marks are visually similar to a reasonably high degree, and are aurally and conceptually identical;
- The goods will be selected primarily by visual means with a high degree of attention by the general public and the business users;
- The goods are identical;
- The earlier mark is distinctive to a medium degree (or not much lower than that) in respect of the goods where the identity exists.

33. Considering the similarity between the marks and the identity between the goods, I find that the average consumer is likely to be directly confused. The only relevant difference between the marks is introduced by the device element in the applicant’s mark. Even though a high degree of attention is paid during the purchase process, considering the weak role this device plays in the overall impression of the applicant’s mark, and allowing for imperfect recollection, the

average consumer is likely to misremember the difference between the marks. In those circumstances, the consumer is likely to mistake one mark for the other. Where the average consumer recollects the device element, I find a likelihood of indirect confusion. The dominant and distinctive role played in the overall impression of the trade marks by the shared component “defender”, will, in my view, lead the average consumer in both groups to think that the marks are variant marks used by the same undertaking or economically linked undertakings to provide identical goods.<sup>6</sup> There is a likelihood of confusion, both direct and indirect.

## Conclusion

52. The opposition has succeeded in full. The application will be refused.

## Costs

53. The opponent has been successful and is entitled to an award of costs. Awards of costs are governed by Tribunal Practice Notice (“TPN”) 2/2016. I award costs to the opponent on the following basis:

Official fee:	£100
Preparing the notice of opposition and considering the counterstatement:	£200
Filing written submissions:	£200
Total:	£500

54. I order Finder Yangı Güvenlik Elektronik Sistemleri Mühendislik San. ve Tic A.Ş to pay Jaguar Land Rover Limited the sum of £500. This sum is to be paid within twenty-

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<sup>6</sup> The distinctive character of the coinciding element is only likely to only increase a likelihood of confusion (see *Kurt Geiger v A-List Corporate Limited*, BL O-075-13).

one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 8th day of February 2021**

**Karol Thomas**  
**For the Registrar**