

O/488/20

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3420057
BY UFUK GULENER
TO REGISTER AS A TRADE MARK:



IN CLASSES 30 & 43

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 418033
BY YASAR DONDURMA VE GIDA MADDELERİ ANONİM SİRKETİ

BACKGROUND AND PLEADINGS

1. On 8 August 2019, Ufuk Gulener (“the applicant”) applied to register the trade mark displayed on the cover page of this decision, under number 3420057 (“the application”). It was accepted and published in the Trade Marks Journal on 23 August 2019 in respect of the following goods and services:

Class 30: Ice cream; ice cream desserts; ice cream cakes; ice cream mixes; ice cream powders; ice cream cones; ice cream drinks; water ices; ice cream confectionery; ice cream sandwiches; fruit ice cream; frozen yogurt; biscuits; cakes; candy; coffee; tea; sauces.

Class 43: Ice cream parlor services; food preparation services.

2. On 10 October 2019, Yasar Dondurma Ve Gida Maddeleri Anonim Sirketi (“the opponent”) filed a notice of opposition. The opposition is brought under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all the goods and services of the application.

3. The opponent relies upon its European Union trade mark number 15037931 (“the earlier mark”), which consists of the following:



4. The earlier mark was filed on 26 January 2016 and was entered into the register on 23 June 2016 for the following goods and services, all of which are relied upon for the purposes of the opposition:

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, namely milk, cheese, yoghurt, ayran (drink based on yoghurt), cream, milk powder, milk based beverages containing fruits; edible oils and fats; soups; bouillon, processed olives; olive paste; tomato paste; eggs; potato chips; nuts; dried fruits as snacks; dried pulses, namely, beans, chickpeas, lentil, soy beans.

Class 30: Coffee, cocoa; coffee or cocoa based beverages, chocolate based beverages; pasta, stuffed dumplings, noodles; pastries and bakery products based on flour; desserts based on flour and chocolate; bread; honey, bee glue for human consumption, propolis for food purposes; condiments for foodstuff, vanilla (flavouring), spices, sauces (condiments), tomato sauce; yeast, baking powder; flour, semolina, starch for food; sugar, cube sugar, powdered sugar; tea, ice tea; confectionery, chocolate, biscuits, crackers, wafers; chewing gums; ice-cream, edible ices; salt; cereal-based snack food, popcorn, crushed oats, corn chips, breakfast cereals, processed wheat for human consumption, crushed barley for human consumption, processed oats for human consumption, processed rye for human consumption, rice; molasses for food.

Class 43: Services for providing food and drink; temporary accommodation; self-service restaurants; cafeterias; cafés, canteen services, cocktail lounges, snack bars, catering, pubs; rental of food service equipment used in services providing food and drink.

5. Given the respective filing dates, the opponent's mark is an earlier mark, in accordance with Section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified in Section 6A of the Act. Consequently, the opponent is entitled to rely upon all the goods and services listed above without having to establish genuine use.

6. The opponent argues that the competing marks are similar in so far as they share the word 'MARAS', which it contends is the dominant and distinctive element of both

marks. This word, the opponent submits, is likely to be the element which “sticks in the mind of the general public”. Furthermore, the opponent argues that the respective goods and services, particularly those relating to ice cream, are identical. These factors, the opponent contends, will result in a likelihood of confusion. Accordingly, the opponent submits that registration of the contested mark would be contrary to Section 5(2)(b) of the Act.

7. The applicant filed a counterstatement denying the ground of opposition. The applicant submits that, aside from the word ‘MARAS’, the competing marks contain other elements, and produce different overall impressions. In this regard, the applicant highlights that there are differences in case, font, figurative elements and layout. Further, the applicant contends that the word ‘MARAS’ is not capable of designating trade origin alone as it is a geographical location in Turkey. In this connection, the applicant provides examples of other registered marks which contain the word ‘MARAS’ and considers this demonstrative that it is a common word used in the market of Turkish ice cream. In respect of the goods and services at issue, the applicant disputes that they are identical and submits that its specification covers a very narrow and specific range of goods and services. Based on these factors, the applicant denies that there is a likelihood of confusion and puts the opponent to proof of “any real and actual instances of confusion between the marks”.

8. Both parties have been professionally represented throughout these proceedings; the opponent by HGF Limited and the applicant by Surjj Legal Limited. Only the applicant filed evidence, which will be summarised to the extent that is considered necessary. Both parties were given the option of an oral hearing but neither requested to be heard on this matter or filed written submissions in lieu of a hearing. Therefore, this decision is taken following a careful perusal of the papers before me, keeping all submissions in mind.

EVIDENCE

9. The applicant’s evidence consists of a witness statement dated 15 May 2020 of Ufuk Gulener. Mr Gulener is the applicant in these proceedings and explains that he

created the contested mark. He is clear that he has not been informed by others of any confusion between the competing marks.¹

10. Mr Gulener provides an overview as to the various elements within the contested mark and his rationale in its creation. He explains that Maras is an alternative name for Kahramanmaraş, which is a city in Turkey.² He further explains that the other words present in the contested mark, namely, 'DONDURMAYI ADIYLA ISTEYİN', combine to form a play on words which roughly translates from Turkish to mean 'ask the ice cream its name'.³

11. In respect of the earlier mark, Mr Gulener states that the word 'MARAS' is to be given the same geographical meaning, while the word 'DONDURMASI' means 'to freeze' in Turkish but is often used as a description of ice cream.⁴ According to Mr Gulener, other traders use the words 'Maras' and 'Dondurmasi' as descriptions; in this regard, he contends that no person can claim exclusivity of their use.⁵

12. Mr Gulener continues by highlighting the visual differences he believes exist between the competing marks. In this connection, Mr Gulener points to the differences in colour, layout and figurative elements.

13. In his evidence, Mr Gulener refers to the opponent's lack of evidence of use in these proceedings. He argues that such evidence would have been useful in assessing whether there is a likelihood of confusion. This is because the range of goods and services covered by the earlier mark is, in his view, quite extensive; he is unsure whether the earlier mark has been used in the UK or whether the opponent has any intention to use the mark in relation to some of its goods or services.⁶

14. Furthermore, Mr Gulener intimates that evidence of the target audience for the opponent's goods and services would have been helpful in the determination of these

¹ Witness statement of Ufuk Gulener, §18

² Gulener, §7.1

³ Gulener, §7.2

⁴ Gulener, §8

⁵ Gulener, §9

⁶ Gulener, §13 – 15

proceedings. If the goods and services are intended for the Turkish-speaking community, he argues, the words in the earlier mark have no distinctiveness as this community is not likely to perceive geographical locations or product descriptions as indications of commercial origin.⁷

PRELIMINARY ISSUES

15. In its counterstatement and evidence, the applicant highlights that the opponent has not provided any evidence of use of its earlier mark, intimating that this defeats any possibility of confusion. For reasons which I will now explain, the applicant's points on this issue will, as a matter of law, have no bearing on the outcome of this opposition.

16. A trade mark registration is essentially a claim to a piece of legal property (the trade mark). Every registered trade mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods/services if there is a likelihood of confusion. Once a trade mark has been registered for five years, Section 6A of the Act is engaged and the opponent can be required to provide evidence of use of its mark. Until that point, however, the mark is entitled to protection in respect of the full range of goods/services for which it is registered.

17. As previously stated, the mark relied upon by the opponent had not been registered for five years at the date on which the application was filed. Consequently, the opponent is not required to prove use for any of the goods or services for which the earlier mark is registered. The earlier trade mark is entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use of that earlier mark for all the goods and services as they appear in the register.

18. So far as the applicant's claimed use of its applied-for mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06), the Court of Justice of the European Union ("CJEU") stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new

⁷ Gulener, §16

trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. As a result, even though the applicant has suggested the ways in which the mark will be used, my assessment later in this decision must take into account only the applied-for mark – and its specification – and any *potential* conflict with the opponent’s earlier mark. Any differences between the *actual* goods and services provided by the parties, or differences in their trading styles, are not relevant unless those differences are apparent from the applied for and registered marks. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

19. The applicant also argues that there has been a lack of actual confusion by consumers. While I appreciate the applicant’s comments, I must, at this early stage, clarify that an absence of confusion will not have any bearing on whether there exists a likelihood of confusion between the applied-for mark and the opponent’s earlier mark. While evidence of actual confusion may be persuasive where it exists, the absence of confusion in the marketplace is rarely significant. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchin L.J. stated that:

“80. ...the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that

the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

20. Furthermore, in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”

21. Finally, the applicant refers to other trade mark applications and registrations containing the word ‘MARAS’. On this basis, the applicant argues this demonstrates that the word is commonly used for class 30 goods and, therefore, the opponent should not be permitted to prevent others from using it. I must state that, contrary to the applicant's argument, the existence of other earlier registered marks will not have any bearing on whether there exists a likelihood of confusion between the mark applied for and the opponent's earlier mark. This is because there is no evidence that the marks are in use and that consumers have become accustomed to differentiating between them.

22. In *Zero Industry Srl v OHIM*, Case T-400/06, the General Court (“GC”) stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by

analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).”

23. Again, my assessment later in this decision must take into account only the applied-for mark – and its specification – and any potential conflict with the opponent’s earlier mark. The existence of other earlier registered marks is not relevant for the purposes of this assessment. The dominant and distinctive elements of the competing trade marks is a matter which will form part of my assessment and will be discussed later in this decision, though the existence of other trade marks which have been applied for, or registered, containing the word ‘MARAS’ will not be considered evidence per se as to its distinctiveness.

DECISION

Section 5(2)(b): legislation and case law

24. Section 5(2)(b) of the Act reads 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.”

25. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98,

Matratzen Concord GmbH v OHIM, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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

26. In the judgment of the CJEU in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

27. 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.

28. Moreover, 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."

29. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They

should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

30. In *Kurt Hesse v OHIM*, Case C-50/15 P, 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, GC stated that “complementary” means:

“...there is a 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”.

31. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

32. Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

33. The GC confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

34. The opponent has contended that the goods and services for which the applicant seeks registration of its mark are identical to those covered by its earlier mark. The applicant has denied this. Further, the applicant has argued that its specification is very narrow and that, to the extent that there is any overlap or similarity, this is solely limited to ice cream and the provision of ice cream.

35. The goods and services to be compared are set out at paragraphs 1 and 4 above and will not be repeated here in the interest of procedural economy.

36. The terms ‘ice cream’, ‘biscuits’, ‘coffee’, ‘tea’ and ‘sauces’ in class 30 of the application all have direct counterparts in class 30 of the earlier mark. These goods are self-evidently identical.

37. The terms ‘ice cream desserts; ice cream cakes; ice cream mixes; ice cream powders; ice cream drinks; ice cream confectionery; ice cream sandwiches; and fruit ice cream’ in class 30 of the application all refer to ice cream products, in various forms. To my mind, they are all encompassed by the broader category of ‘ice-cream’ in class 30 of the earlier mark. Accordingly, these goods are identical under the principle outlined in *Merich*. Even if I am wrong in this finding in relation to ‘ice cream mixes’ and ‘ice cream powders’, it remains the case that there will be an overlap in nature, use, intended purpose and channels of trade with ‘ice-cream’, as well as a degree of competition, rendering the respective goods highly similar.

38. 'Water ices' in class 30 of the application refers to a dessert consisting of frozen fruit juice or flavoured water and sugar. 'Edible ices' in the opponent's class 30 specification describes frozen ice products which may contain sugar, syrup, fruit juices and flavourings. Although they are expressed in slightly different ways, I consider these goods identical.

39. 'Cakes' in the applicant's specification refers to a form of baked dessert made from flour, sugar and other ingredients. The term is encompassed by the broader category of 'desserts based on flour and chocolate' in class 30 of the earlier mark and, as such, the goods identical under the principle outlined in *Meric*.

40. The term 'candy' in class 30 of the applicant's specification is a synonym for the word confectionery. Although the word is more commonly used in North America, its meaning would be readily understood by the average consumer in the UK. Consequently, the term is identical to 'confectionery' in class 30 of the earlier mark.

41. The applicant's 'ice cream cones' describes dry, cone-shaped pastries which enable ice cream to be held in the hand and eaten without a bowl or spoon. Although other types of ice cream cone are available, they are typically made of a wafer similar in texture to a waffle. 'Wafers' in class 30 of the earlier mark refers to thin, light, crisp, dry cookies, which are often sweet. They are ordinarily used to decorate ice cream or as a garnish on sweet dishes. While the shape of these respective goods may differ, there is a significant overlap in nature; ice cream cones are, effectively, wafers in conical form. I am also of the view that the goods share common uses, methods of use and intended purpose: both are consumable products which are eaten with desserts, namely, ice creams, to complement the consumer's experience with additional flavour and texture. Further, the users of the respective goods will be the same. Moreover, the way in which the respective goods reach the market are often likely to be through the same distribution channels, most commonly through supermarkets and ice cream or dessert vendors. In the case of supermarkets and other retail establishments, it is noted that the goods are self-serve consumer items which are likely to be found on the same shelves, or at least in the same vicinity. It is considered that there is a degree of competition between the goods; a consumer may select a cone for their ice cream, or instead choose to have their ice cream in a bowl,

accompanied by a wafer. Notwithstanding the goods often being used and sold together, I do not consider the goods complementary in the sense described in case law; there is a close connection between the goods, though they are not indispensable to each other. In light of the above, I find that these goods are similar to a medium to high degree.

42. *'Frozen yogurt'* in class 30 of the applicant's specification describes a frozen dessert made with yogurt. It is typically produced using the same basic ingredients as ice cream, though also contains live bacterial cultures. In my view, while some of the ingredients may differ, there is an overlap with *'ice-cream'* in the opponent's specification in respect of nature, intended purpose and method of use; the respective goods are both consumable frozen desserts. In this connection, the respective uses and users of the both goods will also be the same. The goods will also reach the market through the same trade channels, namely, supermarkets and dessert vendors. In relation to the former, the respective goods are self-serve consumer items which, in practice, are likely to be found in very close proximity; frozen yogurt and ice cream are often found on the same or adjoining shelves, in the same freezer section. Moreover, the goods are competitive to a significant extent. It is not uncommon for frozen yogurt to be presented as a healthier alternative to ice cream and, therefore, consumers will regard the goods as interchangeable, selecting one over the other. There is no complementarity between the goods in the sense outlined in case law. Considering the above, I find the respective goods similar to a medium to high degree.

43. *'Services for providing food and drink'* in class 43 of the earlier mark is a broad term which would reasonably include providing ice cream and other desserts in an ice cream parlour. Moreover, the provision of food would logically incorporate the preparation of food. On this basis, the applicant's *'ice cream parlor services'* and *'food preparation services'* in class 43 are encompassed by the opponent's broader category of services. Therefore, I find these services identical under *Meric*.

The average consumer and the nature of the purchasing act

44. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion,

it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

45. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

46. The opponent has argued:

“The average consumer would be an everyday consumer of ice cream. The average consumer would not have any specialist knowledge of the goods in question which have a low pricepoint (sic) and therefore the level of attention would be low.”

47. For its part, the applicant has disagreed with the opponent’s assessment of the average consumer of the goods and services at issue, though it has not provided any alternative view.

48. The goods at issue in these proceedings are foodstuffs and beverages. The average consumer of such goods will be the general public at large. The goods are everyday consumable items which fulfil the purpose of satisfying hunger or thirst and are likely to be purchased frequently. Moreover, the goods are likely to be purchased without an overly considered thought process as, overall, they are relatively inexpensive. The consumer will, however, take into consideration things such as personal taste and dietary requirements, as well as the nutritional content and type of

goods they are selecting. The goods are typically sold in supermarkets, where the goods are likely to be selected from shelves, chilled cabinets or freezers. In these circumstances, visual considerations would dominate. The goods are also sold in cafés and restaurants – such as coffee shops or dessert outlets – where there will be an oral component to the selection process, such as requests to bar or waiting staff. However, while the goods may be ordered orally, the selection process would still include a visual inspection of a menu, for example, prior to the order being placed. Considered overall, I am of the view that the purchasing process for the goods would be predominantly visual in nature, though aural considerations will play their part. Taking the above factors into account, I find that the level of attention of the general public in respect of these goods would be medium.

49. The services at issue are those for the provision of food and drink. The average consumer of the services will be the general public at large. The services are likely to be purchased relatively frequently for the dining out experience and for enjoyment. The cost of the services may vary but, overall, would not require a significant outlay. The purchasing of these services is likely to be more casual than careful, though the choice of the consumer will typically factor in individual taste, as well as the quality, cost and type of the food, beverages and service. In my view, the purchasing process for these services would be largely visual in nature; the services are likely to be purchased upon sight of the establishment, after perusing a menu, viewing information on the internet or advertisements. However, I do not discount aural considerations such as word of mouth recommendations. In light of the above, I find that the level of attention of the general public in respect of these services would be medium.

Distinctive character of the earlier mark

50. 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).”

51. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

52. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask *in what does the distinctive character of the earlier mark lie?* Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

53. I have no submissions from the opponent regarding the overall distinctiveness of the earlier mark. However, the opponent has argued that the word 'MARAS' is the distinctive element of the mark. The applicant has disputed this, claiming that the word is non-distinctive by virtue of it being descriptive of a geographical location in Turkey. Furthermore, the applicant has contended that the word 'DONDURMASI' in the earlier mark is descriptive of ice cream. Contrary to the opponent's argument, the applicant has submitted that the distinctive element of the earlier mark is the black container device.

54. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, the opponent has filed no evidence of use (nor was it required to do so). Consequently, I have only the inherent position to consider.

55. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will be somewhere in the middle.

56. The earlier mark is figurative and consists of the words 'MARAS' and 'DONDURMASI', presented in standard typeface. I do not agree with the applicant's assertion that the words will be regarded as a descriptive reference to ice cream from Maras by consumers. The specification of the earlier mark does not suggest that the goods and services are targeted solely at a particular audience, such as the Turkish diaspora. To the contrary, and as I have already found, the goods and services at issue are available to the general public at large. Although it is possible that some consumers who are more versed in the Turkish language would understand the meaning of the words, I am unconvinced that this would be the case for the vast majority of consumers in the UK. In my judgement, Maras is not a geographical

location which the average consumer would recognise, not least because – according to the applicant – it is a shortening of the official name of a city. No evidence has been provided by the applicant to demonstrate that the word would be perceived in the manner it has claimed. Moreover, while the average UK consumer is considered to have some appreciation for the more commonly understood European languages, this does not include Turkish and ‘DONDURMASI’ is not a term which the average consumer would be familiar with.⁸ To my mind, it is more reasonable to find that the average consumer would have no understanding of the words in English. The words may be perceived as words of another language, especially if the consumer notices the small tail-like cedilla on the letter ‘S’. However, since the words will be unfamiliar and will carry no descriptive or allusive characteristics for the average UK consumer, they may be perceived as akin to invented terms and, therefore, highly distinctive.

57. Between the words appears a black device with three lighter horizontal bands. Notwithstanding the poor quality of the image, the device is reminiscent of a container such as a bucket, pot or cup. Consumers may not appreciate what the device is intended to represent and may, instead, simply perceive the device as a dark, banal shape. In the event that consumers do recognise the device as a container, it will likely be regarded as allusive of the goods and services for which the earlier mark is registered. In either eventuality, despite its size, the device will not be attributed much (if any) meaningful brand significance by consumers. Therefore, I do not consider that the device increases the distinctive character of the mark to any material degree. The distinctive character of the earlier mark predominantly rests with the words ‘MARAS DONDURMASI’. In light of the above, I find that the earlier mark possesses a high level of inherent distinctive character.

Comparison of trade marks

58. 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



⁸ See *Matratzen Concord GmbH v OHIM*, Case C-3/03

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.”

59. Therefore, it would be wrong to artificially dissect the trade marks, though it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

60. The competing trade marks are as follows:

Earlier trade mark	Applicant's mark
	

61. The opponent has submitted that the dominant element of both marks is the word 'MARAS', intimating that the other words and figurative elements play lesser roles. It is the opponent's contention that this word is easily recognisable and pronounceable and is therefore more likely to be the element which is retained in the mind of the average consumer.

62. Conversely, the applicant considers the opponent's assessment of the competing marks incomplete and has submitted that the inclusion of the word 'MARAS/maras' in both marks is the only point of coincidence. The applicant has argued that the number '46', the word 'maras', as well as the gold star and banner devices, all dominate the contested mark in combination. In this connection, the applicant has contended that the average consumer will perceive the contested mark as a whole and is "unlikely to analyse it in detail".

Overall impression

63. The earlier mark is figurative and consists of the words 'MARAS' and 'DONDURMASI', presented in an unremarkable font. In between the words is a black container shaped device, the image of which is of poor quality. I have already found that the words in the mark are likely to be regarded as akin to invented terms by the average consumer. As such, they are highly distinctive, and combined with the principle that the eye is naturally drawn to elements in trade marks that can be read,⁹ the words 'MARAS' and 'DONDURMASI' will dominate the overall impression of the earlier mark. It is an established general principle in trade mark case law that the attention of the consumer is usually directed to the beginnings of marks because the UK consumer reads from left to right. Accordingly, out of the two words, given that the word 'MARAS' is shorter (than another, longer word with which consumers are not familiar) and appears at the beginning of the mark, I am of the view that it will have a degree more impact than the word 'DONDURMASI'. I have also previously found that consumers will either fail to recognise what the device portrays or perceive it as a container. Irrespective of whether consumers regard the device as a dark, banal shape or pictorially alluding to the goods and services offered, it will have less impact than the words and, therefore, play a lesser role in the overall impression.

64. The contested mark is also figurative and comprises a number of elements. At the centre of the mark is the number '46', presented in a large, black and bold font. Below the number appears the word 'maras', presented in a smaller – though still relatively large – white font. The word is presented within a gold banner device which has a

⁹ *Wassen International Ltd v OHIM*, Case T-312/03

polished, shiny effect. The banner device is obscuring part of the number '46', resulting in the banner (and the word 'maras') appearing in the forefront of the mark with the number behind. The effect of this is that one's attention is immediately drawn to the word 'maras'. Under the banner device are the words 'DONDURMAYI ADIYLA ISTEYIN' in a much smaller black font. At the uppermost point of the mark, five gold star devices with the same shiny effect as the banner are presented in an arc. Of all the elements, the number '46' takes up the greatest proportion of the mark. The word 'maras' is also relatively large and shares the centre of the mark with the number. In fact, the word will immediately grasp the consumer's attention. Moreover, as indicated previously, the word 'maras' will not be attributed any meaning by the average consumer and is highly distinctive. For these reasons, the number '46' and the word 'maras' will dominate the overall impression of the mark in equal measure, with the latter having a degree more impact. The banner and star devices, whilst still contributing to the overall impression, will be perceived as aesthetic embellishments and will provide smaller contributions to the overall impression of the mark, as will the colour combinations. The words 'DONDURMAYI ADIYLA ISTEYIN' may, as the applicant has argued, have a meaning in the Turkish language; however, in keeping with my previous findings, I consider it likely that the average UK consumer would regard them as unfamiliar words of a foreign language, akin to invented terms. Nevertheless, the words are presented in a much smaller font, resulting in them playing a lesser role in the overall impression of the mark. All the words in the mark are presented in a basic typeface and, to my mind, the minimal degree of stylisation will likely be overlooked by consumers.

Visual comparison

65. Visually, the competing marks are similar insofar as they both contain the word 'MARAS/maras' in prominent positions. I do not consider the difference created by the use of lowercase and uppercase in the respective marks to be significant; the words will be perceived in the same way, despite the use of different cases and fonts, neither of which aspect will be particularly memorable to the average consumer. The presence of the words 'DONDURMASI' and 'DONDURMAYI' in the respective marks is another point of visual similarity; the words will both be perceived as unfamiliar foreign terms and differ only in their penultimate letters, sharing nine out of ten letters in the same

order. There are points of visual difference between the marks. Firstly, the contested mark contains the number '46' and the words 'ADIYLA ISTEYIN', which have no counterparts in the earlier mark. Moreover, the applicant's mark contains the gold banner and star devices, which are not replicated in the earlier mark. Further, the earlier mark contains the black container device, which is not included in the contested mark. In light of the above and bearing in mind my assessment of the overall impressions, I consider there to be a low to medium degree of visual similarity between the marks.

Aural comparison

66. Aurally, the earlier mark comprises six syllables, i.e. ("MAH-RASS-DON-DER-MAH-SEE"). In respect of the contested mark, given their relative size and position within the mark, I am unconvinced that the average consumer would articulate the words 'DONDURMAYI ADIYLA ISTEYIN'. In my view, consumers are likely to pronounce the mark in one of two ways. Some consumers will pronounce the mark as ("FORE-TEE-SIX-MAH-RASS"), with the marks coinciding in ("MAH-RASS"). However, these syllables will arise in different positions and the remaining sounds of the respective marks will be very different. In these circumstances, the competing marks will be aurally similar to a low to medium degree. For other consumers, the mark will be pronounced as simply ("MAH-RASS"), resulting in a medium degree of aural similarity. I have considered various alternatives to the pronunciation of the respective marks where the verbal elements are articulated in various combinations. However, I believe this results in an overly analytical assessment which I do not consider would be undertaken by the average consumer when first encountering the marks.

Conceptual comparison

67. Conceptually, the words in the earlier mark will not be understood to have any clear and obvious meaning by the average consumer. As previously explained, the words will be perceived as akin to invented terms (or more likely as unfamiliar words of another language) and are conceptually neutral as a consequence. As I have already found, the image in the mark is of poor quality and may not be perceived as anything other than a conceptually neutral, dark, banal shape. If consumers do

perceive the device as a representation of a container, it will evoke a weak concept of food and beverages, such as those in the opponent's specification. In respect of the applicant's mark, the number '46' will be understood as such and will offer no other clear and obvious meaning. The words 'maras DONDURMAYI ADIYLA ISTEYIN' will not be attributed any particular meaning by the average consumer. The banner device, being purely decorative, will not provide any concept to consumers. Likewise, the star devices are decorative, however, may also convey laudatory connotations; stars are often emblematic of quality and, in many ratings systems, five stars are regarded as representing the best quality. Consumers of a wide variety of goods and services, not least in the food and drink industry, are accustomed to seeing stars as indications of the level of quality of those goods and services. Despite the competing marks coinciding in the word 'MARAS/maras', there is no conceptual similarity between them. The common word is conceptually neutral and there is no overlap in the limited meanings provided by the other elements. While I find no clear conceptual similarity based on the shared word, nor do I find the banal concepts arising from the star devices or the number '46' sufficient to establish a clear, material conceptual difference between the competing marks. Overall, the conceptual analysis produces a more or less neutral conclusion.

Likelihood of confusion

68. 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. One such factor 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, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and the nature of the purchasing process. 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.

69. 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.

70. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, 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 recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

71. I have borne in mind that these examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.

72. Earlier in this decision I concluded that:

- Many of the goods and services of the competing marks are identical, while others are similar to at least a medium to high degree;
- Average consumers of the goods and services at issue are members of the general public, who would demonstrate a medium level of attention during the purchasing act;
- The purchasing process for the goods and services would be predominantly visual in nature, though I have accepted that it will include an aural element in certain circumstances;
- The earlier mark possesses a high level of inherent distinctive character;
- The overall impression of the earlier mark would be dominated by the words ‘MARAS’ and ‘DONDURMASI’, the former having more impact, while the device would play a lesser role;
- The overall impression of the contested mark would be dominated by the number ‘46’ and the word ‘maras’, the latter having a degree more impact, whereas the devices, colour combinations, stylisation and the words ‘DONDURMAYI ADIYLA ISTEYIN’ will play reduced roles;
- The competing marks are visually similar to a low to medium degree;

- Aural similarity would factor upon how consumers pronounce the contested mark, the competing marks being aurally similar to a low to medium degree where the number '46' is articulated and aurally similar to a medium degree where it is not;
- On balance, the competing marks are conceptually neutral.

73. Although the competing marks share the identical word 'MARAS/maras' and similar words 'DONDURMASI/DONDURMAYI', there are differences between the marks which, to my mind, would not be overlooked by the average consumer during the purchasing process. I accept that the identical element is highly distinctive and jointly dominates both marks. I also appreciate that the earlier mark is highly distinctive in totality. However, the earlier mark also includes the black container device; although I have found the device to play a lesser role in the overall impression of the mark, it still contributes to it and would not be entirely overlooked by consumers. More significantly, the contested mark includes a number of elements which have no counterparts in the earlier mark, namely, the number '46', the banner and star devices and the words 'DONDURMAYI ADIYLA ISTEYIN'. I have already found that the number jointly dominates the contested mark and consider it implausible that consumers would overlook it. With regards the other diverging elements, although I have found these to play lesser roles in the overall impression of the mark, they, too, still contribute and would not be wholly overlooked by consumers. Taking all the above factors into account, the various differences between the competing trade marks are, in my judgement, likely to be sufficient to avoid the average consumer mistaking one trade mark for the other, even on goods and services which I have found to be identical. Therefore, notwithstanding the principles of imperfect recollection and interdependency, it follows that there will be no direct confusion.

74. Nevertheless, although I consider that the average consumer will recognise that there are differences between the marks, the consumer will also recognise the identical shared word 'MARAS/maras'. Whether consciously or unconsciously, this will lead the average consumer through the mental process described in case law by Mr

Purvis, namely, that there is a difference between the marks, but there is also something in common. Despite the number '46' jointly dominating the contested mark due to its relative size and positioning, it does not convey any clear, immediately graspable distinguishing meaning – other than that of the number – and is only moderately distinctive. When applied to goods and services related to food and beverages, it is possible that the number could be perceived by consumers as, for example, a variety number. In this sense, the contested mark may be perceived by consumers as a sub-brand or a brand extension of the earlier mark. Even if I am wrong in this regard, the common word 'MARAS/maras' will be perceived as akin to an invented term and is, therefore, highly distinctive. It jointly dominates both marks, appearing at the beginning of the earlier mark and holding a prominent position in the forefront of the contested mark. This common element is, in my view, so strikingly distinctive that the average consumer would assume that no other undertakings would be using it in a trade mark. Given that the respective goods and services are identical or at least similar to a medium to high degree, I am satisfied that the average consumer would assume a commercial association between the parties, or sponsorship on the part of the opponent, due to the shared dominant element 'MARAS/maras'. Consequently, I consider there to be a likelihood of indirect confusion.

CONCLUSION

75. The opposition under Section 5(2)(b) of the Act has succeeded in its entirety. Subject to any successful appeal against my decision, the application will be refused.

COSTS

76. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. This decision has been taken from the papers without an oral hearing. The opponent did not file evidence in these proceedings, nor did it file written submissions in lieu of a hearing. In the circumstances I award the opponent the sum of **£400** as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the applicant's counterstatement	£200
Considering the applicant's evidence	£100
Official fee	£100
Total	£400

77. I therefore order Ufuk Gulener to pay Yasar Dondurma Ve Gida Maddeleri Anonim Sirketi the sum of **£400**. 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 2nd day of October 2020

James Hopkins
For the Registrar,
The Comptroller General