# O/112/21

**TRADE MARKS ACT 1994**
**IN THE MATTER OF**
**OPPOSITION No. 418033**
**IN THE NAME OF YASAR DONDURMA VE GIDA MADDELERI ANONIM SIRKETI**
**TO TRADE MARK APPLICATION No. 3420057**
**IN THE NAME OF UFUK GULENER**

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**DECISION**

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1. This is an appeal against a successful opposition brought under s.5(2)(b) of the 1994 Trade Marks Act against registration of the following mark in respect of goods in the following classes:


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. The Opponent relied upon its European Union trade mark number 15037931 ("the Earlier Mark"), which consists of the following mark registered in classes 29, 30 and 43:


3. Before the Hearing Officer, the Applicant filed evidence in the form of a witness statement of Ufuk Gulener dated 15 May 2020. The parties were given the option of an oral hearing but neither requested to be heard nor filed written submissions in lieu of a hearing. Therefore, the decision was taken based on the papers and issued on 2nd October 2020 by the hearing officer, James Hopkins.

4. The Applicant appeals the decision of the hearing officer to allow the opposition.

5. Before me the Applicant/Appellant, Mr Gulener, appeared in person at a hearing held remotely on 11 February 2021. I am grateful to him for his submissions.

## STANDARD OF APPEAL

6. I refer to the principles set out in the decision of Daniel Alexander QC, sitting as the Appointed Person, in *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17 at [52], with minor revisions as supplied by Phillip Johnson sitting as the Appointed Person in O-173-17:

> "52. Drawing these threads together, so far as relevant for the present case, the principles can therefore be summarized as follows.
>
> (i) Appeals to the Appointed Person are limited to a review of the decision of Registrar (CPR 52.21). The Appointed Person will overturn a decision of the Registrar if, but only if, it is wrong (CPR 52.21).
>
> (ii) The approach required depends on the nature of decision in question (*REEF*). There is spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision. At one end of the spectrum are decisions of primary fact reached after an evaluation of oral evidence where credibility is in issue and purely discretionary decisions. Further along the spectrum are multi-factorial decisions often dependent on inferences and an analysis of documentary material (*REEF, DuPont*).
>
> (iii) In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it (*Re: B and others*).

(iv) In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF, BUD, Fine & Country and others*).

(v) Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be "clearly" or "plainly" wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar's decision was wrong, should the appeal be allowed (*Re: B*).

(vi) The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account. (*REEF, Henderson and others*).

Bearing in mind the repeated reminders that different points are likely to be particularly relevant in other cases, this is not intended to be a summary of universal application for other cases where particular aspects of the approach may require different emphasis."

7. To this can be added specific guidance for appeals in relation to oppositions founded on a likelihood of confusion. This is set out in the decision of Ian Purvis QC, sitting as the Appointed Person in ROCHESTER Trade Mark (O-079-17), where he stated:

33. I fear that far too much ink has been already spilled by Appellate Courts on these issues with diminishing returns, and I therefore do not propose to say a great deal more. So far as the particular context of this appeal is concerned, I would simply add that the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:

(i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case

(ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person

(iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal

(iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. Jacob J (as he then was) made this point in the passing off case *Neutrogena v Golden* [1996] RPC 473 at 482:

> 'It was certainly my experience in practice that my own view as to the likelihood of deception was not always reliable. As I grew more experienced I said more and more "it depends on the evidence."'

Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.

34. I shall therefore approach this appeal on the basis that in the absence of a distinct and material error of principle, I ought not to interfere with the decision of the Hearing Officer unless I consider that his view on the issue of likelihood of confusion was clearly wrong in the sense that it was outside the range of views which could have been reasonably taken on the established facts."

8. In order to allow the appeal I must therefore be satisfied that there was an error of law or that the decision is outside the bounds within which reasonable disagreement is possible.

9. I also bear in mind that to the extent that it may be suggested on appeal that the Hearing Officer did not understand the arguments before him or deal with the arguments in the way they are now presented, that may be at least in part as a result of the parties' decision not to supply oral or written submissions to the Hearing Officer. As Lewison LJ memorably put it in *Fage v Chobani* [2014] EWCA Civ 5 at §114:

> The trial is not a dress rehearsal. It is the first and last night of the show.

10. Parties to proceedings in the Trade Mark Registry would be well advised to heed this advice. As a result of the fact that any appeal is limited to a review of the decision

below, they should always endeavour to ensure that they have put their best case before the Hearing Officer, whether orally or in writing.

## THE FINDINGS OF THE HEARING OFFICER

11. The Applicant did not dispute the Hearing Officer's summary of the law which recited the familiar cases and principles relevant to the assessment of s.5(2)(b).

12. The Hearing Officer summarised his findings about the respective marks in §72 as follows:

- 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.

13. As will be explained below, there is no complaint about the Hearing Officer's assessment of the goods. The appeal focuses on his assessment and comparison of the Earlier Mark and the mark applied for.

14. The Hearing Officer went on to conclude:

> 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.

15. The Applicant/Appellant did not provide a skeleton argument for the appeal. However, grounds of appeal had been prepared on his behalf by solicitors then

acting for him. It is most convenient to address the issues arising on this appeal by reference to those grounds.

16. The grounds of appeal identified in paragraphs 8 and 9 some eleven separate alleged errors, three by reference to the findings on the similarity of the marks and eight by reference to the finding of likelihood of confusion.

17. I have been through each one by reference to the relevant paragraphs of the Hearing Officer's decision. On this basis it is apparent that the criticisms can be split conveniently into five heads which I deal with below in turn (with bracketed reference to the paragraph number in the grounds of appeal). I have also taken into account the oral submissions made by Mr Gulener at the hearing and refer to those where appropriate.

**Failure to take into account other trade mark applications and registrations containing the word 'MARAS' (8e)**

18. The Applicant submitted that the existence of the word 'MARAS' in other trade mark applications and registrations is evidence that the word is known to the public and that this word is likely to be understood by the average consumer as referring to a geographical place. Mr Gulener referred to other such marks in his oral submissions to me.

19. The Hearing Officer dealt with this in paragraph 21 of his decision where he concluded that "*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*".

20. This ground can be dealt with very briefly. It is well established that mere evidence of the state of the register is of little assistance in determination of disputes of this nature. Without evidence of use and reputation, the existence of other registrations can have no bearing on the question of likelihood of confusion. The Hearing Officer was therefore correct to dismiss it and hold that it was something which could not assist the Applicant.

**Error in concluding that Maras would be seen of as an invented term and not a geographical location which the average consumer would recognise (8b, c, d & h)**

21. These grounds turn on whether the average consumer would recognise Maras as a city in Turkey (and therefore potentially lacking distinctiveness) or would instead

consider it to be an invented word. The Applicant relied on the fact that the Opponent had not filed any evidence or made any submissions to show that Maras would not be understood as a geographical location by the average consumer. It was also said that the Hearing Officer conflated the concept of being Turkish speaking with having a knowledge of a city in Europe such that even if the average consumer did not speak Turkish, they may well still know of Maras as a European city. Further, it was said that the Hearing Officer failed to take into account that the goods and services were likely to be targeted at Turkish speaking consumers. Accordingly, the average consumer would understand the Earlier Mark to convey 'Maras ice cream' which is descriptive of the goods and services.

22. The Hearing Officer addressed these points in paragraph 56 of his decision. He held in relation to the Earlier Mark that:

> 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] [See *Matratzen Concord GmbH v OHIM*, Case C-3/03] 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.

23. I am unable to find any fault in the reasoning of the Hearing Officer. True it is that the Applicant had adduced evidence that Maras is an alternate name for Kahramanmaras, a city in Turkey, and that the Opponent had not adduced any evidence to the contrary. But the Applicant had not gone further and suggested in

evidence that it was known to the average consumer that Maras is a city in Turkey. Therefore the Hearing Officer was not only entitled but also, in my view, right to conclude that the average consumer would not know this. He was also plainly right to base his decision on the notion that the mark applied for would be used in relation to goods offered to the public at large, and not only to those speaking Turkish or familiar with Turkish geography.

24. There is therefore no basis to interfere with the Hearing Officer's finding that the average consumer would find the word Maras to be highly distinctive when applied to these goods.

**Error in finding that the word 'MARAS' was a dominant element of the Trade Mark (8g)**

25. It was argued on this appeal that the Hearing Officer erred because the combination of the number '46', the word 'MARAS' and the figurative elements of the Trade Mark (including the stars and banner devices) are collectively more distinctive than the word 'MARAS' in itself.

26. Some of these arguments are connected to the previous ground of appeal, in that Mr Gulener emphasised at the hearing that Maras would be recognised as lacking distinctiveness because it is the name of a Turkish city. I have already dealt with and dismissed that ground.

27. The Hearing Officer addressed the topic of the impact of Maras in the mark applied for in his paragraph 64. He concluded:

> "…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."

28. Again, I can find no error in the Hearing Officer's analysis and I agree with it. The dominant features of the mark applied for are the word MARAS and the number 46. Indeed, this was what Mr Gulener submitted to me at the hearing, suggesting that 46 MARAS was the brand with the wording underneath seen as a mere slogan. The

Hearing Officer found that both MARAS and 46 were prominent, but that the word MARAS would have more impact because it was more distinctive than “46”. I agree with this – what would be seen as a made-up word will be seen as more distinctive than a two-figure number. The Hearing Officer went on to break this down further in the following paragraphs where he compared the marks visually, aurally and conceptually. I turn to this under the next heading.

**Error in relation to the similarity of the Marks (9a-c)**

29. Here it was said that the Hearing Officer gave too much significance to the word 'MARAS', and too little significance to the other elements of the Trade Mark and the Earlier Mark. In particular it was said that the combination of the features of the Trade Mark would be dominant with the result that the word 'MARAS' would be given less weight within the mark as a whole. As a result the Hearing Officer ought to have concluded that the marks were visually similar to a low or very low degree.

30. The Hearing Officer dealt with visual similarity in his paragraph 65 and concluded that the marks were visually similar to a low to medium degree. His findings therefore overlap with those which I am asked to substitute, in that there is agreement that the marks are similar to a low degree. His findings in full were as follows:

> 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.

31. I confess that seeking to establish that the marks are similar to a very low to low degree as opposed to a low to medium degree appears to amount to the sort of tinkering that the Appointed Person in ROCHESTER warned against. In any event, I can see no reason to interfere with this aspect of the Hearing Officer’s decision.

There are differences between the marks but they have the words MARAS and 'DONDURMASI' / 'DONDURMAYI' in common. Therefore I find that the Hearing Officer was entitled to determine that they were visually similar to a low to medium degree.

**Error in concluding that the average consumer would assume a commercial association or sponsorship between the parties (8a & f)**

32. This is at the heart of the Hearing Officer's conclusion and is also at the heart of the Applicant's appeal. It was said that the Hearing Officer erred in finding that the word 'MARAS' was so strikingly distinctive that the average consumer would assume that no other undertaking would use it in a trade name. It was also said that the marks create a different overall impression and the differences between them are not consistent with a brand extension.

33. The Applicant expanded on this at the hearing. He submitted that the 'DONDURMASI' / 'DONDURMAYI' elements of the marks would be ignored by consumers on the basis that these were just descriptive of ice cream. He also sought to draw an analogy with brands of water where consumers would ignore the reference to "water" in the bottle and use only the brand names (e.g. VOLVIC/EVIAN) instead.

34. There are two problems with this submission. First, as I have found, the Hearing Officer was correct to conclude that the average consumer would not know that 'DONDURMASI' / 'DONDURMAYI' refers to ice cream in Turkish. Even if, as the Applicant submitted, regular users of the Applicant's brand might come to recognise this from other elements of the Applicant's packaging, confusion could occur the first time the consumer comes across the Applicant's product and the Hearing Officer was required to consider notional use of both marks without making assumptions about the way the Opponent's mark is used. Moreover, the submission again appears to fall into the trap of wrongly assuming some understanding of Turkish on the part of the average consumer.

35. Secondly, the submission ignores the most distinctive elements of the marks, MARAS, which was the real basis for the Hearing Officer's finding. See his comments in his paragraph 74 quoted above. There is every reason to think that because of the use of MARAS in both marks a consumer familiar with the Opponent's mark used for the registered goods would consider that there was a connection with the Applicant's mark used for the same or similar goods. The consumer might well think that it was a sub-brand or re-brand or a way of indicating

that, for example, the same undertaking could now offer a range of 46 flavours of ice cream.

36. For all these reasons, again I find no reason to interfere with the findings of the Hearing Officer. He correctly summarised the law on indirect confusion and was entitled to find that this case would be an example of it. Indeed it seems to fall squarely within the sorts of category set out in *L.A. Sugar*, particularly (a) and (b). MARAS is a distinctive mark and 46 would not be seen to be a distinctive enough addition to take the mark applied for far enough away from the Earlier Mark for there to be no likelihood of indirect confusion when used on identical or medium to highly similar goods.

37. Standing back, I acknowledge that this is a borderline case because it is one in which the Hearing Officer found only a likelihood of indirect and not direct confusion. However, for the reasons given I am not able to identify any error in the approach of the Hearing Officer. Nor can I conclude that overall he was wrong. I therefore dismiss the appeal.

38. Finally I acknowledge the Applicant's submission that the Opponent is not on the market in the UK and so there is no present likelihood of actual confusion. That may be, but it is legally irrelevant for the purposes of the present application. As the Hearing Officer pointed out in his paragraph 5, because 5 years had not yet elapsed since the registration of the Earlier Mark, the Applicant was not at the time of filing able to require proof of use or consider a non-use attack.

## COSTS

39. The Hearing Officer ordered the Applicant to pay £400 to the Opponent within 21 days of the conclusion of the appeal proceedings. As the Opponent has taken no active part in the appeal, I make no additional order on this appeal.

Thomas Mitcheson QC
The Appointed Person
19 February 2021