

TRADEMARK EXAMINATION GUIDELINES



**GUIDELINES CONCERNING PROCEEDINGS BEFORE THE
TURKISH PATENT INSTITUTE
(Version 1 November 2011)**

INTRODUCTORY REMARK

The purpose of the present Guidelines is to indicate the practice of the Turkish Patent Institute with regard to the Decree-Law No. 556 on the Protection of Trademarks as amended by Law No. 4128 of November 7, 1995 (in the following: "TML"). They have been drafted with a view to practical use both by the Institute's personnel in charge of the various procedures and by the users concerned therewith.

The Guidelines have been drawn up to cover the majority of current cases, and consequently can be regarded only as general instructions. They are not legislative texts. The parties, and the Institute, must where necessary refer to the above mentioned Decree-Law No. 556, its implementing regulations (in the following "IR") and the interpretation of these texts handed down by the competent Courts.

The present Guidelines are the result of a joint effort of the staff of the Institute's Trade Mark Department and Boards of Appeal, judges from the German Federal Patent Court and experts from the Office for Harmonization in the Internal Market (OHIM). The parties came together in the framework of an EU Twinning Project between the Turkish Patent Institute and the German Foundation for International Legal Cooperation (IRZ). The English and the Turkish versions of the Guidelines were produced in close cooperation, however, it must be noted that – while coinciding as regards the contents - the English version is not a direct translation or copy of the Turkish version.

Part A: EX OFFICIO EXAMINATION OF TRADE MARK APPLICATIONS

1. GENERAL PRINCIPLES

Each application will be considered on its own merits, taking account of its own particular circumstances and having particular regard to the trade mark and the goods or services the subject of the application. The examiner has to bear in mind the nature of the trade concerned, the manner in which the goods or services are provided and the relevant public, for example whether they are specialized or the general public.

In all cases where examiners take decisions adverse to applicants the grounds for the decision must be given. They shall address any arguments raised by the applicant in his observations to the extent they are pertinent.

Applicants have a right to appeal against any decision of the Institute (Article 47). The notice of appeal must be filed in writing at the Institute within two month after the date of notification of the decision.

2. RECEIPT OF APPLICATION AND FORMALITIES

Applications received at the Institute will be marked with the date of receipt and its file number. The Institute issues a receipt which will contain details of the applicant and the list of goods and services as entered in the Institute's database.

2.1. Formalities required for according a filing date

In order to accord a filing date the application must be checked to ensure that it contains (Article 23):

- (a) a request, the form and contents of which shall be specified in the Implementing Regulations, including information identifying the applicant.
- (b) a representation of the trademark suitable for reproduction;
- (c) a list of the goods or services for which the trademark is to be used;
- (d) the original receipt attesting payment of the application fees;
- (e) the original receipt attesting payment of the class fees;
- (f) the power of attorney if an agent is appointed;
- (g) a signature circular where the applicant is a legal person;
- (h) documents evidencing the applicant's business activity.

The application fee shall be paid at the time of filing for the trademark registration application to be valid.

2.1.1. Applicant

Any natural or legal person, or person assimilated to these persons under the national law applicable to them, including authorities established under public law, may be proprietor of a Turkish trade mark if they have industrial or commercial establishment within the territory of the Turkish Republic, or if they have application rights deriving from the Paris or Berne Conventions or the Agreement Establishing the World Trade Organization (Article 3 paragraph 1).

Natural or legal persons other than those referred to in the previous paragraph of who are nationals of States that accord legal and de facto protection to nationals of the Turkish Republic shall enjoy trademark protection in Turkey according to the principle of reciprocity (Article 3 paragraph 2).

The applicant must state his name, address, nationality and the State in which he is domiciled or has his seat or establishment. Names of natural persons must be indicated by the person's family name and given name(s). Companies, firms and other legal entities must indicate their official designation, which may be abbreviated (e.g. PLC, S.A.), *and their legal representatives (e.g. responsible legal executives)*.

2.1.2. Graphical representation (Article 5)

The application must contain a representation of the trademark suitable for reproduction. If the applicant does not wish to claim any special graphic feature or colour the mark must be reproduced in normal script, for example by typing the letters numerals and signs in the space provided in the application form (paper or online). The use of small and capital letters is permitted.

If colour or special scripts are used the mark is categorised as figurative.

In other cases the mark must be reproduced on a separate sheet of paper, no larger than A4 size and the space used for the reproduction must be no larger than 26.2 cm x 17cm, with a minimum margin of 2.5 cm on the left hand side.

The correct orientation of the mark, where this is necessary, must be indicated by adding "top" to each reproduction. The mark must be capable of being reproduced clearly in a space 8cm wide by 16cm high. One copy is sufficient when filed on paper. An attachment must be made in jpg format when filed electronically.

- Colour mark

Where registration in colour is applied for the representation must be in colour and the colours making up the mark must be indicated. The representation of a one colour mark per se must consist of a representation of the applied colour on a sheet of paper or attached file. Normally as it is without contour - which cannot be transferred – it should be performed in a rectangular. The applicant must add the reference to an internationally accepted colour code (e.g. RAL, Pantone, HSK, Cielab).

Is there no defined scale number for the applied colour, the newly created colour must be defined by the code numbers of the colours used for the mixing. In addition this colour has to be represented on a sheet of paper or attached file as well.

Where there is more than one colour (colour combination trademark) the proportion of each colour and how they will appear must be specified (for example: one third above in yellow

HSK 123 two third at the bottom in blue HSK 456; one half or fifty per cent in yellow HSK 123 on the left, one half or fifty per cent in blue HSK 456 on the right).

Where a graphic representation (on a sheet of paper or attached file) is given but the conditions as to its preciseness are not fulfilled a filing date will be given but later an objection will be raised.

- Three-dimensional mark

Where registration of a three-dimensional mark is applied for the application must indicate this fact. It should be said if it should be coloured or black and white and if it is the shape of the applied product itself or its packaging. The representation must consist of a photographic reproduction or a graphic representation of the mark which gives the impression of its three-dimensional character to point out the scope of protection. Up to six different perspectives may be supplied on the one sheet.

Other trademarks: All other trademarks should be filed indicating "other trademark".

- Smells or olfactory (odour) signs

For smells/odour signs, there is presently no means of representing them graphically because there is not yet an internationally accepted smell/odour code (ECJ C-273/00, "Sieckmann", par. 70 - 72).

- Sound mark

For sounds, the Institute accepts musical notations specified by key and rhythm. In addition a representation in sound should be added (e.g. CD). A sonogram for a non musical sound (sound of a car motor) is accepted. Electronic sound files are accepted (ECJ C-283/01, "Shield mark", par. 59 – 61).

- Motion mark

The substantial character of the motion mark is the changing feature of the sign. It is accepted under the provision that the graphic representation of the motion can be performed in a series of pictures. Those pictures shall be attached to each other in a chronological way (e. g. flip-book).

Moreover a written description explaining the motion should be submitted, the motion that is the subject matter of the application should be clearly and comprehensibly stated in the description in question, the information such as what the vision pictures that is what changes have been done in the vision.

In addition to the motionless vision series and description in order to be comprehended easier and clearer by both the examiner of the application and the relevant third parties and for the judicial specification of the scope of protection, the electronic record of the motion claimed for must be submitted with a CD with application form, in a way that enables to watch and store in the computer environment (preferably in mpeg format). The electronic record of the motion should totally correspond to the graphical presentation (motionless vision series) submitted in the application form. If an inconsistency is detected between the electronic record and motionless vision series (graphical presentation), the application does not completely fulfill the prerequisite of "presentation with a drawing or indication in a similar way" stated in the Article 5 TML and therefore the application will be refused pursuant to the Article 7/1-a TML.

It is recommended that the computerized state (preferably in jpeg format) of the graphical presentation to be added to the application form with a CD – including the electronic record of the motion- in order to be easier to be examined. In case the graphical presentation submitted in the field of the trademark example is not clear to read and examine, the examiner may demand the computerized version of the graphical presentation.

- Hologram

Basically a hologram is eligible for registration if it features only a limited number of pictures, for instance two or three. It may be graphically presented like a motion mark: pictures in a row (see e.g. flip-book, German Federal Patent Court 24 W (pat) 102/03).

2.1.3. Classification of goods and services (Article 24)

The goods and services covered by the application should be indicated with their class numbers and grouped according to the classes of the Nice classification. The Institute can make the necessary revisions concerning the classification of the goods and services. It may charge a fee for revising the list.

Particularities as regards retail services marks

Under Article 2 of Council Directive 89/104/EEC, a trademark may be registered for retail services in class 35 for sellers and wholesalers. The ECJ held that “for the purposes of registration of a trade mark for such services, it is not necessary to specify in detail the services in question. However, details must be provided with regard to the goods or types of goods to which those services relate” (ECJ, 7 July 2005, Case C-418/02, “Praktiker”).

Consequently, the Institute considers the activity of retail in goods as a service which does not consist in the mere act of selling the goods, but in the services rendered around the actual sale of goods, in the words of the explanatory note to class 35 of the Nice Classification “the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods.” It is not required to specify in what exactly those activities consist. Nor is it required to indicate the type of establishment undertaking the retail sales (for example, supermarket or department store). Following the “Praktiker” judgment, an exact specification of the goods to be sold is not required, but merely the indication of the type of goods concerned. The Institute will therefore accept any reference to the goods expressed in broad categories (general terms), regardless of whether they could be properly classified under the Nice classes. Indications such as “retail trade in building, home improvement and gardening tools for the do it yourself sector” (see paragraph 11 and 50 of the judgment), foodstuff, or any other general category of goods, are acceptable. It is equally acceptable to refer to class headings.

It is not acceptable, however, to indicate the relevant goods by referring to particular classes or class numbers, for example “retail services in respect of goods falling in class 9” or “retail services in respect of goods in classes 7, 9, 12, and 16”.

2.1.4. Professional Representation

Natural or legal persons not having either their domicile or their principal place of business or a real and effective industrial or commercial establishment in Turkey must appoint an agent who is recorded in the Registry of Agents kept by the Institute in order to register their marks and for other procedures after registration (Article 12 (j) of the Implementing Regulations).

2.1.5. Deficiencies

If there is a deficiency in any of these respects (except for the priority fee) the examiner will issue a notification, indicating that a date of filing cannot be given to the application and

allowing two months for the deficiencies to be remedied or to make observations. The application shall be accorded the filing date as of the date, hour and minute the deficiency is rectified (Article 13 of the Implementing Rules).

3. PRIORITY

3.1. Convention priority (Article 25)

The applicant may claim the priority of one or more previous trade mark applications, namely a national (or Benelux) application filed in or for a State party to the Paris Convention. Natural or legal persons who are nationals of any state party to the Paris Convention or if not nationals who are domiciled or have an active business in these states, shall enjoy a right of priority of six months from the date of filing a valid application for registration of a trademark at the authorised bodies of these states, for the purpose of filing an application for obtaining a registration certificate in Turkey in respect of the same trademark. The priority rights not exercised within this period are considered to be void.

If a natural or a legal person who is a national of a state party to the Paris Convention has filed a valid application in a state not party to the Paris Convention he shall enjoy within the provisions of this Article priority right in respect of that filing.

The applicant may claim the priority either in the trade mark application or subsequent to the filing of the application, in which case he must submit the declaration of priority, indicating the date on which and the country in which the previous application was made, within a period of 3 months from the filing date .

3.2. Exhibition priority (Article 26)

An applicant who has displayed the goods or services to which the trademark is affixed at national or international exhibitions in Turkey or at official or officially recognized national or international exhibitions in States party to the Paris Convention may claim a right of priority for registration of the trademark in Turkey if the application claiming priority is filed within six months from the date of the first display of the goods.

If the goods or services to which the trademark is affixed have been displayed at the exhibition before the official opening date, the right of priority shall start from the date on which the goods or services were first displayed at the exhibition.

The officials of the exhibition held in Turkey shall supply evidence specifying the names of the goods or types of the services, the date of first display and the official opening date on which the goods or services were displayed to the public.

With respect to goods and services displayed in foreign countries, the evidence specified mentioned before shall be supplied by the relevant authorities of the State concerned.

Goods to which the trademark is affixed may not be prevented from being displayed at an exhibition in Turkey or from being returned to their country of origin after the close of the exhibition.

Where there have been two or more applications for the same products or services in respect of the trademark registered or registration applied for, the applicant who first displayed the

goods or services or, if both displayed at the same time, the one who files his application first shall enjoy the right of priority.

4. ABSOLUTE GROUNDS FOR REFUSAL

4.1. Distinctiveness (Article 7(1)(a))

4.1.1. Introduction

Article 7(1)(a), in combination with Article 5 of the TDL, provides that a sign which lacks distinctive character shall not be registered as a trade mark. A mark is distinctive if it can fulfill its essential function to guarantee the identity of the origin of the marked goods or services to the consumer by enabling him without any possibility of confusion to distinguish the goods or services those of another undertaking. A trade mark must distinguish the goods or services concerned as originating from a particular undertaking. A finding on the distinctiveness always necessitates a thorough analysis of the sign as it would be perceived by the consumer of the goods and services for which protection is sought.

The distinctive character must be assessed in relation to the goods or services covered by the application and in the light of the presumed perception of an average consumer the goods and services in question, who is reasonably well informed and reasonably observant and circumspect. The distinctive character must be examined individually vis-à-vis each item covered by the list of goods and services. If the refusal is based on different reasons in relation to different goods or services, they all must be stated. If a reasoning is applicable to a group of goods, then it is not necessary to motivate the refusal for each good or service individually.

If the target consumer of the goods and services is the general consumer, he should be assumed that the relevant public is made up of average consumers who are deemed to be reasonably informed and reasonably observant and careful. However, the attention level of the average consumer can vary according to the goods and services concerned. For instance, the average consumer will pay utmost attention when buying contact lenses, hi-fi equipment, computer products and microphones. If the goods and services target an expert consumer group then the relevant consumers should be considered more attentive and informed (see GC, 26 November 2003, Heron Robotunits/OHIM, T-222/02, paragraph 36). Any product may be targeting both experts and average consumers.

In the evaluation of the distinctive character of a trademark, the overall impression should be considered. In fact, the average consumer perceives the trademark as a whole and does not usually analyze the details of the trademark (ECJ, 7 October 2004, Mag Instrument/OHIM, C-136/02 P, paragraph 20).

4.1.2. Distinctiveness of specific categories of signs

4.1.2.1. Simple geometric devices

Simple geometric devices such as rectangles, circles, or even pentagons, risk to be refused as non-distinctive since the consumer will often perceive them as decorative elements.

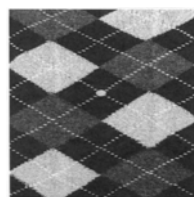
4.1.2.2. Commonplace or usual figurative elements

Figurative representations that are commonly used either in relation to the goods and services applied for, or in a decorative, functional, or even descriptive manner, will regularly be refused.

For example, the naturalistic representation of a wine leaf is not distinctive for wine. Commonly used pictograms, for example a white “P” on a blue background to designate a parking place or the design of an ice cream to designate that ice cream is sold in the vicinity, are not distinctive. Also, graphic symbols commonly used in a functional manner have to be refused, such as the “@” symbol or the symbols representing currencies such as €, £, \$. This objection applies to all goods and services.

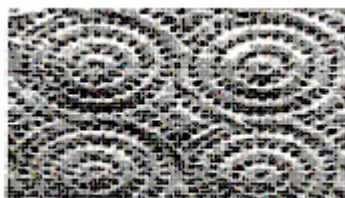
4.1.2.3. Patterns

Commonly used patterns will have difficulties in reaching the necessary distinctiveness threshold because the consumer will rather understand them as a decorative element than as a badge of commercial origin.



2010/53506

In the judgment of European GC regarding the application for the registration of the shape consisting of a kitchen paper motif (GC, Georgia-Pacific Sarl v OHIM, T-283/04), 17/01/2007 it is emphasized that the consumer will understand the sign as a functional or decorative element.



4.1.2.4. Numerals, single letters

Numerals and single letters are, in general, registrable as any other word or figurative element, unless the number/letter has, or might be considered by the relevant public to have, a specific (indicative) function in respect to the products applied for. For example, tools are normally categorized by numbers to point out their strength or size; size numbers for clothing as well as the letter combinations XL, XXL, S, or XS; zero for beverages as it normally indicates in advertising the concept of “no calories”.

4.1.2.5. Verbal elements

Verbal elements are non-distinctive if they are so frequently used that they have lost any capacity to distinguish goods and services.

The following terms, alone or in combination with other non-registrable elements, fall foul under this provision:

Top level domain endings, such as .com, only indicate the place where information can be reached on the Internet and thus cannot render a descriptive or otherwise objectionable mark registrable. Thus, www.books.com is as objectionable for printed matter as the term “books” alone. Likewise, abbreviations of the legal form of a company such as Ltd., GmbH cannot add to the distinctiveness of a sign.

Likewise, terms designating that the goods and services are rendered by a group of people are unregistrable, such as “company” or “people” (for establishments), or “Club”. For example, “Kitchen Company” is unregistrable for kitchens.

The “@” symbol is non-distinctive. The letter e- in front of goods and services to be delivered electronically is non-distinctive (i.e. e-learning, e-commerce, e-business, e-filing, etc.). Likewise, indications that merely denote a superior geographic scope of business activity, such as national, international or global, are generally not registrable, either alone or in combination with descriptive terms. However, if the use of the term appears fanciful e.g. “Global Hairdressing” for hairdressing services, it can be acceptable.

The following terms merely denote a particular superior quality or function of the goods and services and should be refused, either alone or in combination with descriptive terms:

- Extra;
- FLEXI, synonymous for flexible;
- Multi;
- Mini,
- Plus ;
- Bio;

provided, of course, that the respective goods or services fit the descriptor and can be considered organic, multiple, small, flexible, etc.

The terms “world” and “land” most commonly denote that a wide variety of a particular type of goods and services can be found in the same place and are not distinctive if applied together with the corresponding descriptive terms. For example, “Investorworld” should be refused for financial services (GC, T-360/99, OJ OHIM 2001, 1192).

The terms “series” and “type” merely refer to the nature of the goods rather than to their commercial origin and cannot render an otherwise objectionable term distinctive.

Names of individual persons are usually distinctive, irrespective of the frequency of the name and even in the case of the most common surnames such as Smith or García (ECJ, C 404/02, Nichols, paragraph 30, 26).

4.1.2.6. Slogans

A slogan is always registrable if it contains verbal or figurative elements which are distinctive on their own.

Examples: “Carlsberg - Probably the Best Beer in the World”

or:



A slogan can be descriptive (see below, ‘criteria for descriptiveness of word combinations’) if it is limited to highlighting desirable characteristics of the goods or services. Examples for descriptive slogans include: “Mehr für Ihr Geld” (more for your money), (CFI T-281/02) “Looks like grass, feels like grass, plays like grass” (CFI, T-130/01) “Real people, real solutions” (CFI T-130/01). Descriptive slogans are also non-distinctive.

Furthermore, slogans are non-distinctive if they are limited to general invitations to buy, laudatory statements or seek to promote the superior knowledge, client friendliness, economic success, or availability of the trade mark applicant. Examples: “WE KNOW INSURANCE” (class 36), “TWO DAYS A WEEK” (class 41) R943/04-4.

In decision n. 2010-M-3780, the TPI Re-Examination and Re-Evaluation Board decided that the trademark “MIDDLE OF THE MONTH, HALF OF THE LABEL” directly evokes the price of the good or service on sale or promotes the lower associated price and is thus not distinctive.

On the other hand, slogans are distinctive if they are inventive in respect to the goods or services covered by the application, or contain a fanciful element, such as play on words, irony, alliteration, rhyme, or subliminal messaging.

Examples include:

“YOUR SPARE CHANGE COULD CHANGE YOUR LIFE” (class 41), “FEEL AT HOME WHILE YOU ROAM” (class 38), “LISTEN AND YOU’LL SEE” (class 9), “IMPOSSIBLE IS NOTHING” (class 25, 28 and 41).

- İŞİNİZİ BÜYÜTMİYİ GÖZÜNÜZDE BÜYÜTMİYİN (Do not overrate to expand your business) (class 35, 36, 38)
- AŞ KENDİNİ GEL AŞKA (Go beyond yourself, get carried away) (class 30)

In the case concerning the application for the trade mark “BECOME WHAT YOU ARE”, the Supreme Court (Yargıtay 11. HD., E. 2000/9346, T. 20.11.2000) stated that “the trademark does not fall under the registration obstacles provided for in Articles 7 and 8 of the Decree Law, as there is no connection between the mentioned slogan and the cleaning products, electronic products, goods for jewelry for which registration was sought...”

4.1.2.7. Event marks

Event marks provide the sponsors with an exclusive right to use the name of an event commercially. The criteria applied in the examination of event marks are not different from the general criteria applied to other categories of marks.

Indications such as “championship, cup, festival, fair, etc.” on their own are terms which give a clear information to the relevant part of the public and are thus descriptive. If the name of the event establishes a direct connection with the activity and the claimed goods and/or

services, the sign will be descriptive and thus lacking distinctive character. If used for fan club goods, music instruments, or clothes, the name of the event will be perceived as an information on, or promotion of, the event rather than functioning as a badge of commercial origin. Thus applications consisting of the name of the country and a date, thereby indicating the place and date of the activity without any additional distinctive character, such as "Turkey 2016", will regularly fall within the scope of Article 7(1)(a) due to their lack of distinctiveness.

Trademark protection, however, will be granted to applications consisting of a descriptive word element with a dominant figurative element if the consumer can perceive the combination of the activity name and figurative element as a trademark. Such compound trademarks, consisting of figurative element and the name of the activity, will be registered if the figurative element is distinctive per se and helps the consumer to perceive the event mark as a badge of commercial origin.

The following trademark registrations have been refused on the grounds that they are descriptive of the claimed products and lack distinctiveness.

KİTAP FUARI (7/1 a,c refusal) (BOOK FAIR)

İSTANBUL KİTAP FUARI (7/1 a,c refusal) (ISTANBUL BOOK FAIR)

Gelibolu Balıkçılık Festivali (7/1 a,c refusal) (Gallipoli Fishing Fest)

İstanbul Kitap Fuarı 2011 (7/1 a,c refusal) (Istanbul Book Fair 2011).

4.1.2.8. Colours

a) Colour marks may be filed

- as figurative marks showing depicting geometric shapes or goods in a particular colour or colour combination;

- or for a single colour or a combination of colours as such ("colour per se").

The graphic representation must consist of a sheet of paper or image demonstrating the colours. In addition,

- the actual colours must be indicated in words;

- and for colours per se, it is recommended to specify the colour shade by use of an internationally recognized colour code (see also above).

The registration of a combination of colours per se will be defined by the graphic representation as filed in the application. This representation must clearly indicate the proportion and position of the various colours (ECJ C-49/02 of 24.6.2004, "Heidelberger", para 33). For example, a mark consisting of a small yellow stripe on top of a red stripe is different from red and yellow presented in even proportion with the red being on the left side. An abstract claim, for two colours "in any possible combination" or "in any proportion", is not allowed.

This rule must be distinguished from the indication of the colour combination's appearance on the product. The latter is not required because the application must focus on the appearance of the mark seeking registration rather than the way it is or can be used on the product.

b) An application for colours or colour combinations per se must be examined to determine whether the colours are distinctive in relation to the goods or services sought or the advertising thereof. Marks lacking distinctiveness in respect of either of these functions shall

be refused. It is assumed that the distinctiveness of a colour combination would appear the same on the package of the goods or in advertising/promotional material, as it does in the application.

It has been confirmed by the decision of the European Court of Justice (C-104/01 “Libertel”), that a single colour is not distinctive for any goods or services except under very special circumstances. As the Court explains: “whilst colours are capable of conveying certain associations of ideas, and of arousing feelings, they possess little inherent capacity for communicating specific information, especially since they are commonly and widely used, because of their appeal, in order to advertise and market goods or services, without any specific message” (ECJ, “Libertel”, at para. 40).

For this reason, the Institute adopted the general rule that a colour per se can only be registered if it demonstrated acquired distinctiveness through use. The 11th Civil Chamber of the Supreme Court has confirmed this reasoning. In the case concerning the colour SILVER GREY for LBG tankers, the Court held that colours per se may not be the subject of trademark protection. If a monopoly right on colours would be given, there would be no colours left for competitors (Yargıtay 11. HD.; 07/07/1997 tarih, E. 1997/3559 ve K. 1997/5453 sayılı karar).

There is no specific rule for the exclusion of colour combinations consisting of two or more arbitrary colours. The term “arbitrary colours” denotes that one of the two colours in the combination is common place in relation to the natural or usual colour of the goods covered by the application. Thus, only one of the two colours possesses distinctive characteristics. An examination of such applications shall focus on the distinctiveness of the latter colour.

Situations in which a combination of two arbitrary colours will be refused include:

- In many instances, a colour will be perceived as a mere decorative element of the goods or compliance with the consumer’s request for customization (typical examples: colours of cars or T-shirts), irrespective of the number of colours used.
- A colour can be descriptive of a technical function (example: colour red for fire extinguishers, various colours used for electric cables).
- A colour may also be usual or generic (example: again, red for fire extinguishers; yellow for postal services).
- A colour may indicate a particular characteristic of the goods such as a taste (yellow for lemon taste, red for strawberry taste).

4.1.2.9. 3-Dimensional trade marks

3-Dimensional trade marks can be grouped into three categories:

- Shapes unrelated to the goods themselves:
- Shapes that consists of the shape of the goods themselves;
- The shape of packaging or containers.

Graphical representation

According to the practices of TPI, there shall be no limitations as to the graphical representations of the trademarks applications for three-dimensional marks. Representations such as drawings, pictures, photograph, etc., depicting the trademark shall be accepted as

valid. Generally, one representation of the trademark submitted by the applicant shall be deemed as sufficient as long as the example of the trademark represented in the application is obvious and comprehensible without any doubt. However, it is also possible to fulfill this requirement by including the photographs of the trademark taken from different angles. Said photographs must appear in the appropriate portion of the application and comply with size and dimension regulations. The submission of multiple photographic representations shall not be interpreted as several trademark examples. It shall be regarded as a supplementary depiction of the trademark including different angles and submitted to facilitate examination.

The graphical representation of the trademark application Then the “sign” which is the subject of the application shall not be the individual presentations of the trademark but the three-dimensional shape (the shape of the product or the package) itself. For the application to be more comprehensible and accommodation for the examination, the applicants are advised to present the three-dimensional trademarks graphically through photographs taken from different angles. The following are examples of graphical presentations done this way and which are admissible (taken from OHIM guidelines):



Shapes which are unrelated to the goods or services themselves

Shapes which are unrelated to the goods or services themselves (for example, the Mercedes Star or the Michelin Man) do not cause any problems and should, for all practical purposes, in general be considered distinctive.

Shape of the goods themselves

For the shape which is the shape of the goods themselves, examination will be conducted in three steps.

First, it has to be checked whether the representation of the 3-dimensional trade mark contains other elements, such as words or labels, which render the mark distinctive either alone or in combination with the shape. Typical examples are word marks or figurative marks that appear on the shape and remain clearly visible, or labels on bottles. Even the standard shape of the goods or the shape of a standard bottle can be registered as a 3-D mark if a distinctive word mark or label appears on it.

Then, the criteria for distinctiveness of the shape itself must be checked.

In doing so, it must be taken into account that for trade marks which consists of the shape of the goods itself, no stricter criteria apply than for other marks, but it may be more difficult to come to a finding of distinctiveness as such marks will not necessarily be perceived by the relevant public in the same way as a word or figurative mark (ECJ, C-136/02, “Maglite”, paragraph 30). In relation to most products, consumers are not used to perceive the shape of the product as a badge of commercial origin.

The following criteria are to be used when examining the distinctiveness of three dimensional trade marks consisting exclusively of the shape of the goods themselves:

The more closely the shape resembles the shape most likely to be taken by the product in question, the greater the likelihood that it is not distinctive (ECJ, C-136/02 P, “Maglite”, paragraph 31). In other terms, the shape must depart from the shape which is expected by

the consumer. The shape must depart significantly from the norm or customs of the sector (to cite: ECJ, C-136/02 P, “Maglite”, paragraph 31).

It is not enough for the shape to be just a variant of a common shape or a variant of a number of shapes in an area where there is a huge diversity of designs (ECJ, C-136/02 P, “Maglite”, paragraph 32, GC, T-88/00, “Maglite”, paragraph 37.)

Functional shapes or features of a three dimensional mark will be perceived by the consumer in that manner for example, for washing tablets, bevelled edges avoid damage to the laundry, and layers in another colour represent the presence of another active ingredient. Aesthetic originality, if achieved through reduction to basic shapes and colours or optimization of ergonomics (form follows function), does not plead in favour of trade mark distinctiveness.

In the case on the registration of a three dimensional shape of a product's package Ankara IP Court stated that “...the registration of the three dimensional shape of the product's package is possible. However, the registration of the model (three dimensional shape) shall not be possible, if it is the normal and known shape of the product; for example the product sold is chocolate and the 3D shape mark is the chocolate itself or a usual shape, that is not distinctive or a shape acquired due to the function and technical compulsion.” (Ankara FSHM 2004/885 E., 2005/260 K. sayılı, 03.05.2005 tarihli kararı (Yarg. 2005/10856 E., 2006/11671 K. sayılı, 13.11.2006 tarihli kararı))

Containers, bottles

The same criteria apply for the shape of bottles or containers for the goods. The shape applied for must be materially different from a combination of basic or common elements and must be striking. Also in the area of containers, regard must be had to any functional character of a given element. As in the field of containers and bottles the usage in trade might be different for different types of goods and in order to forgo subjective considerations, it is recommended to make a search as to which shapes are on the market, by choosing a sufficiently broad category of the goods concerned (see, in that regard, the opinion of the Advocate General in the case “Standbeutel”, C-173/04).

The Following shapes are given as examples of shapes that are in general and common use on the market and that are simple and usual and thus non distinctive:



Nice Class: 33



Nice Class: 04



Nice Class: 32 (Re-Evaluation and Re-

Examination Board decision Nr: 2009-M-1758)

4.1.2.9. Sound marks

Sound marks must be filed either in the form of a graphical representation or, if filed electronically, in the form of a graphic representation in addition to a sound file representing the sound itself. The Institute accepts as a graphic representation which is sufficient in particular to comply with the criterion of the ECJ judgement “Shield mark”, only traditional musical notations, not frequency oscilograms or sonograms. However, the Office accepts non traditional (non musical) sounds if the graphic representation by means of an oscilogram or sonogram is accompanied by the sound file, through electronic filing.

Graphical presentation should fit into the 7 cm x 7 cm space left for the trademark example in the application form. However it is thought that if the graphical presentation provided with the portrait in the sound marks, submitted only in paper may cause difficulties during the examination under some occasions. Therefore it is recommended that the graphical presentation is added to the application with a CD – including the sound record - in the electronic environment (preferably in jpeg format) for it to be easily read and comprehended.

A sound will lack distinctive character if it is the natural consequence of the work of the product, which is the subject matter of the registration or if it is technically compulsory during the work of the product. For instance, a typical sound that is generated when a vacuum cleaner works is a sound that emerges as a technical and natural consequence of the work of the product, and is not possible to be perceived as a trademark and must, moreover, be used freely by other producers of the product of the same kind (example taken from: Karadenizli, H.T., a.g.e, 2008, s. 89). Similarly, the sounds such as the typical sound of the motor for the motorcycles, the opening sound of a bottle/can for the fizzy drinks etc. shall not be deemed to be distinctive.

If the sound mark includes a whole music piece or a long part of a musical piece, it is not deemed to be distinctive.

4.1.2.11. MOTION MARKS

The distinctiveness should be assumed for each individual concrete case in the motion trademarks, and it should be considered whether the motion can be perceived as a trademark by the relevant consumer group, whether it is suitable to be related to a specific commercial origin, i.e. whether the motion that is the subject matter of the application is suitable to distinguish by fulfilling the trademark function.

4.2. Marks identical or confusingly similar with earlier trademarks (Article 7 (1)(b))

Article 7 (1)(b) of the Decree Law 556 provides that a trademark shall not be registered if it is identical or confusingly similar to an earlier trademark registered for identical or similar goods or services.

The Institute shall conduct a search of earlier registered trademarks during the application examination. In order to constitute as grounds for refusal, an identical or confusingly similar earlier trademark must also be registered for identical or similar goods or services. It is possible that identical/similar goods/services exist under different class numbers due to erroneous classification or incongruence between earlier trademark registration and the Nice Classification system. In such cases, the evaluation shall focus on the nature of the goods/services as opposed to the class number.

Goods/services shall be deemed identical if the earlier mark is registered for a general category of goods/services that covers the goods/services of the trademark application. For example, an application for automobiles shall be deemed identical to an earlier mark covering motor vehicles. The same reasoning shall apply if the application includes a general category of goods/services covering the goods/services of the earlier trademark. Thus, an application covering motor vehicles shall be deemed identical to an earlier trademark registered for automobiles.

The following section shall examine the identicalness and confusing similarity of trademarks under article 7(1)(b).

4.2.1. Identicalness

“A sign that is the subject of a trademark application shall be deemed identical to a sign with an earlier application or registration if the signs are indistinguishable or a direct copy. Signs characterized by even slight differences shall not be deemed identical. However, the size variance of figurative marks and typeface or colour variance of word marks is not sufficient to defeat the identicalness of the signs.” (Ankara 3rd IP Rights Court 2009/19 principle – 2010/70 numbered decision).

Trademarks shall NOT be deemed identical if:

- The elements constituting the trademarks are not completely identical.
- The figurative elements are different, even if the verbal elements are identical. (This situation shall give rise to an examination of confusing similarity.)
- The figurative and/or verbal elements are identical, but the auxiliary elements are different. (This situation shall give rise to an examination of confusing similarity.)
- All of the elements are identical, but the arrangement of said elements would lead to a different overall impression. (This situation shall give rise to an examination of confusing similarity.)

As mentioned, identical trademarks shall be deemed identical even if their figurative elements vary in size or verbal elements vary in typeface or colour.

4.2.2 Confusing Similarity

A trademarks application shall be deemed confusingly similar to an earlier trademark if the average consumer cannot differentiate the dominant distinctive elements of the two signs.

Confusingly similar trademarks are not identical. However, their overall impression is almost identical from the perspective of the average consumer. If the average consumer perceives two trademarks as identical from a visual or phonetic perspective, then the trademark application shall be deemed identical to an earlier trademark.

“Trademarks may consist of more than one equally distinctive element. These elements can be defined as “dominant” (leading) or “auxiliary” (supporting). It is important to determine the leading element of a trademark consisting of a combination of verbal and/or figurative elements. If a trademark consists of both a figurative element and a verbal element, such as a written and pronounceable word, then the figurative element is deemed to be supporting (auxiliary to) the verbal element which plays a leading (dominant) role. It is presumed that consumer focuses on the verbal element of a trademark consisting of both verbal and figurative elements.”

“... the dominant element should be isolated if the trademark consists of more than one element. The dominant element is the image that emphasizes a mark’s distinctiveness and is thereby the most striking feature of the mark’s overall impression. Additionally, the root word and suffixes added must be examined if the dominant element is a word. The trademark application shall be deemed confusingly similar to the earlier trademark if the suffixes do not sufficiently distinguish the application from the earlier registered mark.” (Ankara 4th IP Rights Court 2009/219 principle – 2010/84 numbered decision).

“...distinctive verbal elements that form the dominant elements of a sign leave a more significant and memorable impression in the mind of the consumer than descriptive signs commonly used in trade. Different usage of size and/or colour does not enhance the distinctiveness of a descriptive word mark. Signs commonly used in trade lack distinctiveness from the perspective of the consumer and constitute grounds for refusal...” (Ankara 2nd IP Rights Court 2009/266 principle – 2010/44 numbered decision).

“...the words ERMADEN and ERMADENCİLİK are the dominant distinctive elements of the marks in question. The common verbal elements (ERMADEN) are more strongly perceived by the consumer than differences in the size and colour of the marks. Therefore, the trademark application is not sufficiently distinctive from the perspective of the average consumer...”

“... although both marks consist of more than one element, no difference exists between the signs ERMADEN and ERMADENCİLİK. The suffix -LİK is not capable of distinguishing one mark from the other;”

“Under Article 7/b of the Decree Law 556, similarity between the trademark application and the earlier sign can be determined by first impression without any further examination concerning confusion...” (Ankara 2nd IP Rights Court 2009/246 principle – 2010/58 numbered decision).

“It has been held that the concept of similarity under Article 7/1(b) of the Decree Law should be interpreted narrowly. In this case, the TPI erred in applying the stricter examination approach of Article 8/1(b). The sign that is the subject of the trademark application is not highly distinctive and appears similar to the earlier mark at first glance. However, the similarities between the signs are not sufficient to constitute similarity under 7/1(b) in spite of the identity/similarity between the goods and services. Therefore, the TPI’s decision is not

legally founded...” (Ankara 4th IP Rights Court 2007/46 principle – 2010/71 numbered decision).

In light of the 2010 Special Courts' decisions cited above, as well as academic literature and the TPI's standard practices, the following principles should be taken into consideration for the examination of confusing similarity:

Confusing similarity under Article 7/1(b) of the Decree Law 556 is substantively different from similarity under Article 8/1(b). The trademarks that are compared for confusing similarity under Article 7/1-(b) are not identical, instead they create a nearly identical overall impression in the mind of the average consumer. A nearly identical overall impression from the perspective of the average consumer exists when the dominant distinctive elements of the trademarks in questions display a high level of similarity. The test for determining similarity shall not involve the detection of near identicalness by means of a direct comparison of the trademarks' visual differences. Instead, it must be determined whether the identical or similar elements of the trademarks possess such a high level of similarity that they create a confusingly similar overall impression. No further examination shall be necessary. According to the Special Courts, the differences between two marks are insignificant if they marks are perceived as identical by the consumers with regards to phonetic, aural, and visual similarities.

The auxiliary elements that are descriptive or commonly used in trade shall not be considered in the assessment of confusing similarity under Article 7/1(b). They shall not affect the analysis. The assessment of confusing similarity, as highlighted by the Special Courts, must focus on the dominant distinctive elements of the marks in question.

If the marks possess different figurative elements in addition to similar verbal elements, the similarity test under Article 7/1(b) shall focus on the distinctive verbal elements which take priority from the perspective of the consumers.

4.2.3 Principles for the examination of confusing similarity in special cases

The examples below illustrate the principles employed by the Institute's when assessing trademark applications. These general principles are not applicable in every case. Although the examples pertain to specific cases, they should be understood as a general assessment. If any doubts relating to the trademarks under examination should arise, then the general principles referred to in chapters A and B shall be applied.

4.2.3.1. Word marks consisting of similar letters

Aural Similarity

An aural similarity is not a sufficient criterion for establishing confusing similarity if the signs in question are visually different. Visual differences can outweigh the aural similarities.

An examiner must consider that:

- Longer word marks are more likely to be similar than shorter word marks;
- The potential for similarity is greater in cases involving distinctive trademarks;
- The classes of goods or services covered by the trademark also play an important role in the assessment of similarity. Sectors with a high number of consumers, such as food and clothing, tend to increase the potential for similarity as opposed to sectors with a lower volume of consumption, such as electronics and automobiles.

As a result, the following marks that share a semantic similarity shall not be treated as similar due to their visual differences:

PHONE

FON

CASHMERE

KAŞMİR

(No confusing similarity)

Signs are considered confusingly similar only if a visual similarity accompanies the aural similarities.

ANJELICA

ANGELICA

(Confusing similarity)

Visible, aural and conceptual similarity constitutes confusing similarity.

POLİMER

POLYMER

(Confusing similarity)

In exceptional cases, aural similarity to a well-know trademark can alter the importance of visual and conceptual similarities.

DAKIRS

DOCKERS

(Confusing similarity)

As illustrated the by the example above, the renown or reputation of an earlier trademark must be taken into consideration in addition to aural, visual and conceptual similarity for the assessment of confusing similarity under 7/1(b).

Visual Similarity

In cases of low aural similarity, trademarks shall be considered similar when letter combination in the verbal component results in a visual similarity. Examples of similar letter include a-o, q-g-p, b-d. In addition, letters from the Turkish alphabet that look similar to letters in the Latin alphabet can result in a perceivable visual similarity (i.e. o-ö, u-ü, ı-i, c-ç, s-ş).

angel

(Confusing similarity)

anqel

Visually similar expressions characterized by a conceptual difference are not considered similar.

kolay

(No confusing similarity)

kalay

Repetition of the same letter

Trademarks consisting of a letter repetition are considered similar to identical trademarks with a single letter due to the fact that an additional single letter is not sufficiently distinctive.

ALTERA

(Confusing similarity)

ALTERRA

4.2.3.2. Trademarks with prefixes/suffixes or add-ons

4.2.3.2.1. Applications containing the suffixes “_oğlu”, “_kızı”, “_zade”, “_oğulları”, “_ler”, “_lar” to a distinctive word element

As a general principle, distinctive Turkish words including such suffixes as “_oğlu”, “_kızı”, “_zade”, “_oğulları”, “_ler”, “_lar” shall not be considered confusingly similar to otherwise identical earlier trademarks (i.e. consisting of the common word element without the suffix).

In the following cases, however, the trademarks shall be considered confusingly similar:

- (a) Where an earlier mark consists of two or more words and the trademark application contains the abovementioned suffixes but is otherwise identical.
- (b) Where the common word element is long and/or highly distinctive from the perspective of the average consumer.
- (c) Where the common word element belongs to a renowned or reputable trademark.

ÖZTÜRK

(No confusing similarity)

ÖZTÜRKÖĞLU

GÜNEYOĞLU

GÜNEYOĞULLARI

(Confusing similarity)

KAYA

KAYALAR

(No confusing similarity)

KARAHİSARLI

KARAHİSARLILAR

(Confusing similarity)

4.2.3.2.2. Applications containing the possessive case suffix in addition to the distinctive word element

Applications consisting of possessive case suffixes such as “_m”, “_n”, “_ı”, “_miz”, “_niz”, “_leri” added to distinctive words belonging to earlier trademarks registered for identical or similar products or services must be assessed on case-by-case basis. The analysis should consider whether the suffix sufficiently alters the distinctive character of the word mark from a visual or conceptual perspective, the number of letters in the distinctive word element, and the peculiarity of the newly formed word.

For this purpose;

- The word in question must be of Turkish language origin.
- Plural possessive suffixes (us, you, they) consist of at least 3-4 letters and are thereby considered sufficient for the elimination of visual similarity. Marks consisting of an otherwise common verbal element shall not be considered confusingly similar.
- Single possessive suffixes (me, you, he/she) consist of 1-2 letters and are thereby not sufficient for the elimination of visual similarity. Thus, marks consisting of an otherwise common verbal element shall be considered confusingly similar.
- Trademarks shall not be considered confusingly similar if the addition of the possessive suffix to the common word element results in a distinctive meaning.

**CAN
HARA**

**CANIM
HARAM**

(No confusing similarity)

- The addition of possessive suffixes consisting of 1-2 letters to marks with a common distinctive verbal element will lead to confusing similarity (i.e. trademarks like “kol” – “kolum”; “ip” – “ipim” will cause confusing similarity).
- If the common verbal element consists of a long sequence of letters, the addition of a possessive suffix may result in a visually, phonetically, and conceptually, distinctive new word. For example, the addition of three letters to çiçek (a flower) to create çiçeğim (my flowers) results in a sufficient dissimilarity avoiding confusing similarity, while zirve – zirvem (peak – my peak) are considered confusingly similar.
- Where an earlier mark consists of two or more words and the trademark consists of the same verbal elements with the addition of a possessive suffix to one of the common words, the trademarks will be considered confusingly similar regardless of whether the suffixes are singular or plural.

As an exception to the examples above, confusing similarity shall exist if the common core word element of the trademark application is similar to that of a well-known earlier trademark.

However, the addition of a possessive suffix shall not cause confusing similarity if the common core word element of the trademark is a widely used name or surname even the registration covers similar goods and services. For examples, trademarks such as zafer – zaferim and zeynep – zeynebim do not cause confusing similarity.

KARAHİSARLI

KARAHİSARLIM

(Confusing similarity)

4.2.3.2.3. Applications with the letter “s” added to the end of a distinctive word element

Although “s” is not a suffix in the Turkish language, due to its universal application around the world, it is considered well-known and widely used in Turkey as possessive suffix. The addition of an “s” to an identical or confusingly similar common word element is considered an “add-on”. This short suffix does not sufficiently change the overall impression of the mark thereby leading to confusing similarity.

CEMAL

CEMAL’S

(Confusing similarity)

However, the suffix “_s” is also used to indicate the plural form of a word in a foreign language. Trademarks will not be considered confusingly similar if the addition of plural suffix “_s” results in a word with its own new meaning.

PEN

PENS’

(No confusing similarity)

As an exception, there shall be no confusing similarity even if the resulting word has a meaning in Turkish.

4.2.3.2.4. Applications consisting of the word “by” before the distinctive word element

The English prefix “by”, which means “made by...” or “belonging to...”, is commonly used in trade in Turkey and around the world to express possession or origin. Thus, it is understood by the average Turkish consumer. Consequently, a trademark application consisting of “by” plus a verbal element similar to that of an earlier mark, shall be rejected as confusingly similar if seeking protection for similar or identical goods or services.

KASABALI

**BYKASABALI or
bykasabalı**

(Confusing similarity)

As an exception, trademarks consisting of the word “by” plus additional letters that result in a word with a definite meaning shall not be deemed confusingly similar (i.e. byte, Byzantine, etc.).

At the discretion of the examiner, an application consisting of the word “by” followed by a short adjoined verbal element may create a sufficiently distinctive overall impression to avoid confusing similarity with an earlier trademark that lacks distinctiveness.

MK

BYMK

(No confusing similarity)

4.2.3.2.5. Applications containing the suffixes “-san”, “-mak”, “-pen” and “-tech” at the end of distinctive word element

As a general rule, applications composed of suffixes “-san” (used in industry), “-mak” (used in machinery, spare parts and maintenance), “-pen” (used for the production of doors, windows and other related materials) and “-tech” following a distinctive verbal element will not be considered confusingly similar to earlier mark consisting of a similar distinctive verbal element registered for identical or similar products or services.

AKIN

AKINPEN

(No confusing similarity)

As an exception, the examiner shall find the existence of confusing similarity if the common word element of the application is comprised of a long sequence of letters and/or a highly distinctive verbal element that is similar to a well-know earlier mark registered for similar goods/services.

KARAHİSAR

KARAHİSARSAN

(Confusing similarity)

OPET

OPETTECH

(Confusing similarity)

4.2.3.2.6. Applications consisting of the word “my” and a distinctive word element:

The English word “my” indicating possession is also well known and widely used in Turkey. An application consisting of the term “my” plus a subsequent distinctive verbal element is not considered similar to an earlier trademark consisting of solely the same distinctive verbal element.

MY WORLD

WORLD

(No confusing similarity)

However, the term “my” shall not influence the assessment of confusing similarity if the trademark application consists of an English-Turkish or foreign language word combination lacking precise meaning.

As an exception, if the common word element belongs to an well-known earlier trademark, then trademark application consisting of the word “my” and the common word element shall be deemed confusingly similar.

SİMFEL

MY SİMFEL

(Confusing similarity)

4.2.3.2.7. Applications including the term ‘Group’

The addition of the word “group” before or after a word mark is not sufficient for the elimination of confusing similarity between two otherwise similar trademarks. The evaluation of confusing similarity shall be made according to the perception of the average consumer. Confusing similarity exists if the addition of the term “group” does not sufficiently differentiate the mark of the applicant from the earlier mark from the perspective of the average consumer.

The examination shall focus on the distinctive verbal element and not on the term “group”. If the verbal element is highly distinctive, the marks shall not be deemed confusingly similar.

Terzioğlu

Terzioğlu Grup

(Confusing similarity)

However, trademarks shall not be considered confusingly similar if the integration of the term “group” and the distinctive verbal element into a single compound word creates different overall impression.

4.2.3.2.8. Applications including the terms Euro and the Türk

The addition of the terms “Euro” and “Türk” (meaning “Turkish”) to word that has little to no distinctive value sufficiently increases the trademark’s distinctiveness to avoid confusing similarity.

TÜRK STAR

STAR

EURO ASYA

ASYA

(No confusing similarity)

As an exception, trademark applications consisting of “Euro” or “Türk” and a common verbal element that is commonly used in trade or a well-known earlier trademark shall be considered confusingly similar.

Euro Pidar

Pidar

Philips

Philips Türk

(Confusing similarity)

4.2.3.3. Applications including geographical names

Geographical names, on their own, cannot be registered as trademarks. However, they may be registered if accompanied by another word. Such applications shall be examined for confusing similarity.

4.2.3.3.1. Applications including the names of provinces

Applications including a province name and a distinctive word element

Trademark applications consisting of a province name and a highly distinctive verbal element must be evaluated in relation to the goods or services for which protection is sought and their similarity with the earlier mark’s distinctive verbal element.

BOLU ARAGON

ARAGON OTEL

(Confusing similarity)

In addition, the use of a province name which is not related to the distinctive verbal element shall not be considered confusingly similar according to the totality principle.

KONYA STAR DUŞ

STAR GIDA

Applications consisting of a province name and a non-distinctive word

In cases where the trademarks in question consist of identical province names and a identical or confusingly similar non-distinctive word, the trademarks shall be evaluated as confusingly similar.

**ANTEP OTOMOTİV
OTOMOBİLCİLİK**

ANTEP

(Confusing similarity)

If both trademarks consist of an identical province name and dissimilar non-distinctive verbal elements, the trademarks shall not be considered confusingly similar.

ŞANLIURFA OPTİK

ŞANLIURFA

POLİKLİNİK

EDİRNE İNŞAAT

EDİRNE JEANS

(No confusing similarity)

4.2.3.4. Trademarks consisting of indications of goods or services

4.2.3.4.1. Good or service term appearing after the primary word element

Good or service term related to the good or service registration

The inclusion of a related good or service term does not increase the distinctiveness of a trademark. In such cases, the similarity examination shall ignore the product/service term and only take into account the primary element.

KASABA SÜT

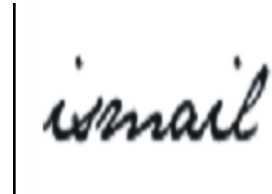
KASABA

(Confusing similarity)

A trademark application consisting of a good or service term and any another name may create the impression that the trademark is actually a name and surname. In such cases, similarity shall exist for the goods or services related covered by the earlier mark.

İSMAİL TATLI

class)



(30.

(Confusing similarity for “deserts” and identical type of products)

Good or service term not related to the good or service registration

A good or service term included in a trademark can be considered as the distinctive verbal element if it is not related to the goods and services in the application. Thus, the following trademarks are not considered similar in the jewellery class.

PETEK İNCİ

PETEK

In some cases, a trademark term may point out the relevant industry sector without including the specific term of a good or service. In such cases, the industry term shall not be considered distinctive. Thus, the primary distinctive element shall be regarded as similar to an identical or confusingly similar earlier mark.



(Confusing similarity)

4.2.3.4.2. Good or service term appearing before the primary element

If good or service term appears before the primary verbal element, the degree of distinctiveness provided by the primary verbal element shall be taken into account for assessment of similarity. The primary verbal element may consist of one or more words.

Primary distinctive elements consisting of one word

A trademark consisting of good or service term appearing before a commonly used Turkish name shall be attributed a low level of distinctiveness in relation to the same goods or services. However, the trademarks, as well as the classes of goods and services, shall be analyzed globally and thereby not considered identical or confusingly similar.



KAPORTACI ABDULLAH

FRENCİ ABDULLAH

(Abdullah auto body repairs)

(Abdullah brake repairs)

CİĞERCİ EMİN

EMİN

(Emin cooking liver)

(No confusing similarity)

Applications lacking distinctiveness shall be evaluated on the basis of Article 7/1(b) if, in addition to the good or service term, the primary distinctive element is identical or confusingly similar to a mark commonly used in trade, a highly distinctive mark, or a mark that is well-known in the related sector.

KÜRKÇÜ KARAHİSARLI

KARAHİSARLI

(Karahisarlı Fur)

**BAKLAVACI
GÜLLÜOĞLU**

GÜLLÜOĞLU

(Güllüoğlu Baklava)

(Confusing similarity)

Primary distinctive elements consisting of more than one word

The probability of confusing similarity increases if common word elements of both trademarks contain more than one word. The probability of confusing similarity is further increased if the common word element is a common Turkish name.



KEBAPÇI ADEM BABA

(Adem Baba Kebab)

(Confusingly similar)

KEBAPÇI ADEMUSTA

ADEMUSTA'NINTATLILARI

(No confusing similarity)

4.2.3.5. Word marks containing names of persons

Some Turkish names are more common, while other can be more distinctive. In principle, trademarks including names and surnames are not considered similar according to 7/1(b).

İSMAİL ŞEN ŞENMAK



(No confusing similarity)

However, the following criteria must be taken into consideration when assessing confusing similarity between trademarks consisting of names and surnames:

- the reputation or renown of the earlier mark;
- the distinctiveness of the identical or similar word element;
- the similarity of the marks' primary word elements;
- consumer perception of the additional word elements.

ARÇELİK

ARÇELİK Ali Üstün

(Confusing similarity)

4.2.3.6. Similarity between identical digits and written numbers

Trademarks consisting of digits shall be deemed confusingly similar to trademarks consisting of identical written numbers. In such cases, the aural and conceptual similarities between the marks outweigh the visual differences. An exception is made in the case of single digit numbers and their written equivalents.

4 KARDEŞ

DÖRT KARDEŞ

1223

binikiyüzyirmiüç

(Confusing similarity)

(One thousand two hundred and twenty three)

However, two-digit numbers can convey various meanings such as age and province codes on license plate numbers. Such numbers are often used as verbal trademark elements. Thus, it is up to the discretion of the examiner to determine whether a trademark application

consisting of a two-digit number and an additional verbal element is confusingly similar to an earlier registration consisting of the same number and a different verbal element.

In the case of identical two-digit numbers, the examiner must consider:

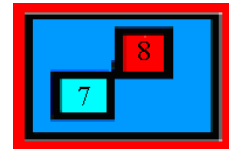
- the position of the number in relation to the additional verbal element;
- the marks' figurative or other additional elements;
- the average consumer's perception of the two marks containing the same two-digit numbers.

If the expert finds that the identical two-digit number is not the dominant element of the trademarks in question from the perspective of the average consumer, then the trademarks shall not be considered confusingly similar.

61 HALK OYUNLARI KULÜBÜ
(No confusing similarity)

ALTMİŞBİR KOLBASTI MERKEZİ
(Folk Dance Club – 61 Kolbastı Center)

78



(No confusing similarity)

4.2.3.7. Word marks containing letters and digits

4.2.3.7.1. Similarity between the combination of verbal and numeric elements

As a general principle, the addition of number after the verbal element of an earlier registered trademark does not eliminate confusing similarity.

KAZAN

KAZAN 1985

FIORICCI

FIORICCI 15

(Confusing similarity)

However, if the common word element reflects low distinctiveness or consists of short sequence of letter, the addition of a number may sufficiently change the overall impression to avoid confusing similarity.

AB

AB2

(No confusing similarity)

4.2.3.7.2. Trademarks consisting of two letters separated by punctuation marks or the “&” symbol

If the dominant verbal element of two trademarks consists of the same two letters in the same sequence, the trademarks shall be deemed confusingly similar. The inclusion of punctuation marks (i.e. “.”, “-”) is not sufficient to avoid confusing similarity.

S.E.

S-E

(Confusing similarity)

Assuming that the earlier mark is not reputable or renowned, the inclusion of the “&” symbol between two identical letters arranged in the same sequence is sufficient for the elimination of confusing similarity.

GB

G&B

(No confusing similarity)

If the trademarks consisting of two identical letters in the same sequence appear different due to distinctive positioning, stylized writing or other figurative elements that can be perceived by the average consumer, the examiner may conclude that the trademarks are not confusingly similar.



(No confusing similarity)

4.2.3.7.3. Similarity between stylized one-letter and one-digit marks

Stylized one-letter or one-digit trademarks can be registered as long as they are not displayed in a standard typeface. Such trademarks are not considered similar to earlier marks if the typeface of the same number or letter is different.



(Confusing similarity)



(No confusing similarity)

4.2.3.8. Applications including abbreviations

4.2.3.8.1. Abbreviations containing the first letters of the verbal elements

Trademark applications consisting of abbreviations representing the first letter of each word in the mark are considered low in distinctive character. If the abbreviation does not add distinctiveness to the other verbal elements, the trademarks shall be considered confusingly similar.

HG

HASK GİYİM

(Hask Clothes)

HASK GİYİM

CS CAN SEBZECİLİK

(CS Can Grocery)

CAN SEBZECİLİK

(Can Grocery)

(Confusing similarity)

4.2.3.8.2. Abbreviations with letters not related to the first letters of the verbal elements

The distinctiveness of an abbreviation which does not consist of the first letters of the trademark's verbal elements must be taken into account. The examination shall consider whether the abbreviation is commonly known or conveys any meaning. Furthermore, the length of the abbreviation and the distinctiveness of additional verbal elements must be examined.

It is presumed that the consumer perceives the abbreviation as subsidiary element of the mark. Thus, the consumer appreciates the trademark as whole and not only the abbreviation component. All such factors must be assessed in the analysis of confusing similarity from the perspective of the average consumer under 7/1(b).

4.2.3.8.2.1. Applications consisting of multiple words and an abbreviated term

If the abbreviated term in the trademark application is not the principal element of the mark and earlier trademark is highly distinctive, the marks will be deemed confusingly similar.

Ş ACAYİLE GİYİM

ACAYİLE TEKSTİL

(Ş. Acayile Clothes)

(Acayile Textile)

(Confusing similarity)

However, if the abbreviation is considered as the primary distinctive element due to its positioning and the common word element possesses a low distinctive character, no confusing similarity shall exist between the marks. The overall distinctive value of the trademarks must be considered.

SPT CAN BAKKAL

CAN BAKKALİYE

(No confusing similarity)

4.2.3.8.2.2. Application consisting of an abbreviation and a distinctive word element

Trademarks consisting of a short, non-distinctive abbreviation and a common distinctive word element shall be deemed confusingly similar. The length of the abbreviation plays an important role in this assessment. The potential for confusing similarity is higher if the abbreviation is short or less distinctive in relation to the distinctive verbal element.

CR SARABIYTON

SARABIYTON

(Confusing similarity)

However, if the abbreviation consists of more than two letters, conveys a special meaning, or the additional verbal element reflects a low distinctive character, the trade marks will not be considered confusingly similar.

EC KAAAN

KAAN

(No confusing similarity)

4.2.3.8.3. Applications consisting of a word's consonant letter abbreviation

4.2.3.8.3.1. Applications consisting of only a word's consonant abbreviation

The aural, visual and conceptual characteristics of a trademark application consisting of a consonant abbreviation of the verbal element of an earlier mark must be examined for the assessment of confusing similarity.

CNDN

CANDAN

(No confusing similarity)

The existence of aural and visual similarity shall give rise to confusing similarity.

MYWORLD

MYWRDL

(Confusing similarity)

4.2.3.8.3.2 Applications consisting of a verbal element its equivalent consonant abbreviation

Trademarks consisting of a verbal element and its equivalent consonant abbreviation shall be considered similar to trademarks consisting of only the same verbal element. Nonetheless, aural and visual differences must be taken into account as the length and pronunciation of the abbreviation can provide sufficient distinctive character for the elimination of confusing similarity.

KRM KERİM

KERİM

(No confusing similarity)

4.2.3.9. Word marks consisting of the same words in a different arrangement

4.2.3.9.1. Repetition of word elements

Trademarks consisting of the repetition of the highly distinctive verbal elements of earlier marks shall be considered confusingly similar. A repetition of the same verbal element is not considered sufficiently distinctive.

DARCAN
DARCAN

DARCAN

(Confusing similarity)

An application consisting of the repetition of an earlier mark's verbal element is not considered confusingly similar if the verbal element of the earlier mark displays a low distinctive character. If the repetition of a verbal element of low distinctive character acquires a new meaning, it will further differentiate the trademark application from the earlier mark.



('Step')

('Step, step' meaning 'step by step')

(No confusing similarity)

4.2.3.9.2. Different arrangement of the same word elements

The visual and aural differences arising from a different arrangement of two verbal elements is sufficient to eliminate confusing similarity from the perspective of the average consumer. Thus, applications consisting of a different arrangement of verbal elements of an earlier mark shall not be deemed confusingly similar.

Techart



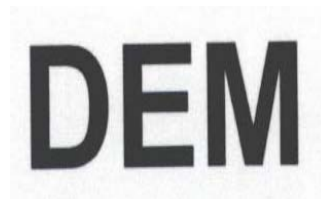
(No confusing similarity)

4.2.3.10. Word marks containing descriptive elements

4.2.3.10.1. Descriptive elements that elevate distinctiveness

4.2.3.10.1.1. The addition of a descriptive element to form a word with a new meaning

A descriptive expression added to the end of a word mark shall sufficiently differentiate the mark from its good or service registration if the neologism creates a new conceptual meaning from the perspective of the average consumer.



(No confusing similarity)

4.2.3.10.1.2. The addition of a descriptive element without formation of new meaning

In word marks consisting of a descriptive element where the primary and secondary verbal elements cannot be easily differentiated and the descriptive element increases the mark's distinctiveness, the examination of the similarity between the primary and secondary elements shall be conducted according to the "totality principle". The two elements shall not be separated.

STARWOOD (19. class)

STAR

(No confusing similarity)

SERAMALL (35. class)

SERA

(No confusing similarity)

The examination of the impact of the descriptive element on the average consumer's overall impression shall take various factors into account. Such factors include:

- the distinctiveness of the secondary element based on its meaning and characteristics;
- the intense use of the expression in trade;
- the average consumer's familiarity with a foreign language descriptive expression;
- the term's descriptiveness in relation to goods, services, or industry sectors.

COSMOPOLITAN CLUB class)

COSMOPOLITAN (6.

(Confusing similarity)

NEVCLUB

NEV (3. class)

(No confusing similarity)

Terms such as club, structure, line, concept, electronics, residence, etc. are only descriptive in specific sectors and are widely used as a result of their meaning. In this case, the examination will focus on the primary descriptive element by separating it from the secondary verbal element in order to determine if the average consumer perceives a connection between the descriptive term and the industry sector for which registration is sought. For this purpose, the descriptiveness of the isolated primary descriptive element shall be examined according to the "totality principle".

4.2.3.10.2. Non-distinctive descriptive elements

Non-distinctive descriptive terms which are commonly used in trade shall not be considered for the examination of similarity. Such terms shall be separated from the other verbal element in order to determine if the average consumer can easily differentiate the two separate elements.

FIRAT SÜPERMARKET

FIRAT

HUNCAMETAL

HUNCA

(Confusing similarity)

If the trademark application consists of a common word element comprised of a short sequence of letters or low distinctive character and the name of a product or service, its similarity in relation to an earlier mark shall only be assessed for the products/services referred to in the name. The similarity examination in relation to the remaining goods and services in the application shall not differentiate between the primary and secondary elements.

SUNVALF

SUN

In the example above, the “SUN” trademark application can be deemed similar to earlier “SUNVALF” registration in relation to the products described in the mark (i.e. valves). However, the trademarks are considered similar in relation to other products.

4.2.3.11. Possessive noun phrases

Trademarks forming a meaningful phrase through the combination of a possessive suffix and a noun shall not be considered confusingly similar.

Sizin Aktar

(Your herbalist)

SİZİN KASAP

(Your butcher)

benimtatilim

(My sweet)

Tatilim

(My sweet)

(No confusing similarity)

However, if the addition of the possessive suffix results in a word with no meaning, the trademarks shall be assumed confusingly similar as the addition of the possessive suffix will have no effect on the distinctiveness of the otherwise identical mark.

BİZİMÇULLAS

ÇULLAS

If the common word element is well-know, the addition of a possessive suffix shall not sufficiently enhance the distinctiveness of the trademark application in order to avoid confusion with the well-know earlier mark.

BİZİM VAKKO

VAKKO

(Confusing similarity)

4.2.3.12. Prefixes “Has” (peculiar), “öz” (self) and “yeni” (new)

In general, the addition of prefixes has (special), ön (self) and yeni (new) to an earlier mark with a common word element does not provide sufficient distinctiveness to avoid confusing similarity. They are likely to lead the consumers into thinking that origin of the goods or services is the same.

HAS KARACANLAR

KARACANLAR

ÇULLAS

YENİ ÇULLAS

(Confusing similarity)

However, the addition of said prefixes can avoid a finding of confusing similarity if:

- the combination of the prefix and the other word element creates a different overall impression;
- the trademark creates an overall different impression in the absence of the prefix;
- if the other word element used with the prefix is considered to display low distinctiveness.

ÖZAKIN

AKIN

HAS BEY

BEY

YENİYURT

YURT

(No confusing similarity)

4.2.3.13. Applications containing slogans

Slogan trademark applications shall be examined without consideration of the mark's primary element. If the application can be easily distinguished from the earlier mark through a global examination from the perspective of the average consumer, the trademarks shall not be considered confusingly similar.

If the difference between two slogans results from the usage of different words, the trademarks will not be found confusingly similar.

TEK İSTEĞİMİZ BAŞARINIZ

TEK İSTEĞİMİZ HUZURUNUZ

(Our only wish is your success)

(Our only wish is your comfort)

(No confusing similarity)

However, if the difference between the slogans results from the addition of prefixes, the trademarks will be found confusingly similar.

TEK İSTEĞİMİZ BAŞARINIZ TEK İSTEĞİMİZ BAŞARI

(Our only wish is your success)

(Our only wish is success)

(Confusing similarity)

4.2.3.14. Confusing similarity of figurative elements or three dimensional elements

"... similarity can exist between one, a few, or all of the elements of two marks..." (Supreme Court 11th Chamber 2006/11 ground, 2006/338 numbered decision).

The figurative elements of trademarks can consist of photographs, pictures, drawings, logos, emblems, graphics, seals, labels, etc.

Visual similarity is the most important criterion in the examination of similarity under Article 7(1)(b). However, confusing similarity between two figurative marks only occurs after a finding of overall similarity. In order to constitute confusing similarity, drawings, photographs and figurative elements must display a high level of similarity. Thus, the marks must be conceptually and not only visually similar. In the following example, the figurative elements depicting two open winged eagles do not display sufficient similarity to constitute confusing similarity.



(No confusing similarity)

Differences in the specific details of highly similar figures do not avoid confusing similarity. For example, if the two eagles were identical with the exception that of one having an opened beak, the figurative marks would still be found confusingly similar.

However, if the similar figurative elements are not stylized and consist of a simple geometric figures or figures commonly used in trade, the marks shall not be deemed confusingly similar. For example, the existence of a fork figure in two marks from the food & beverage sector shall not result in confusing similarity unless the forks are highly similar or identical stylized drawings.

4.2.3.14.1. Evaluation of purely figurative (including three dimensional) trade marks

The abovementioned principles shall also apply to the assessment of trademarks only consisting of figurative elements.

4.2.3.14.2. Comparison of word and device and purely figurative trademarks

If a trademark application consisting of a word and figurative device is found identical or confusingly similar to an earlier figurative mark according to the above stated principles, then the subsequent assessment shall focus on the following factors:

- the uniqueness of the identical/confusingly similar figurative element;

- whether the trademark application is a direct copy of or very similar to an earlier mark;
- whether the trademark application is clearly a copy of a well-known trademark.

If the trademark application is found confusingly similar to the earlier mark, then the application shall be rejected for identical/similar products. If the figurative element is not unique, lacks distinctiveness, or fails to attract attention as the supportive element of the trademark, then the examiner may come to a finding of no confusing similarity from a global analysis.

5.3.14.3. Comparison of trademarks consisting of different word elements and identical or confusingly similar figurative elements

In cases where the trademark application consists of an identical or confusingly similar figurative element but an entirely different verbal element in comparison to an earlier mark, the examination shall be conducted as follows:

The examination of the identicalness or confusing similarity of the figurative elements shall be conducted according to the general principles.

If the figurative element displays a low level of distinctiveness and fails to attract attention as a supportive element of the mark, as a result of the differences between the verbal elements, the examiner shall conclude that there is no confusing similarity between the marks.

The following circumstances can lead to a finding of confusing similarity:

- the identical/confusingly similar figures are the primary elements of the trademarks in questions;
- the figurative element displays a high level of distinctiveness;
- the trademark application contains a direct copy of the earlier mark's figurative element;
- the figurative element of the trademark application is so similar to that of the earlier mark that it is an obvious attempt at copying;
- the figurative element is identical or confusingly similar to a well-known earlier mark.

In such cases, the trademark application shall be rejected for identical or similar goods or services.



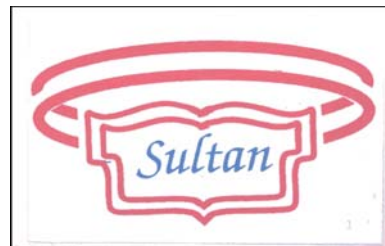
(Confusing similarity)

4.2.3.14.4. Comparison of trademarks consisting of different figurative elements and identical or confusingly similar verbal elements

The abovementioned situation is addressed in the general principles of the introduction and is reiterated as follows:

The Article 7/1(b) examination of trademarks consisting of dissimilar figurative elements and identical or confusingly similar verbal elements shall focus on the comparison of the verbal elements which are of primary importance from the consumer's perspective. The trademarks shall be subjected to a standard examination and the dissimilar figurative elements shall have no effect on the outcome.

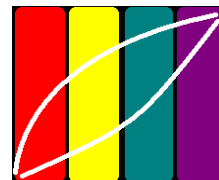
For example, the following trademarks are considered confusingly similar despite the differences between their figurative elements.



(Confusing similarity)

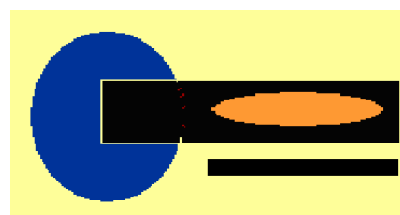
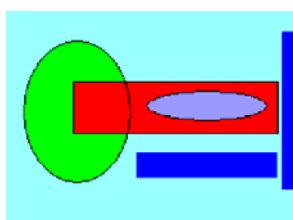
4.2.3.14.5. Similarity between colours and colour combinations

In cases of a high colour similarity which may lead the consumer to believe that goods or services originate from the same company, the trademarks shall be deemed confusingly similar. In the example below, the slightly different shading of the colours in the combination is not sufficient to avoid confusing similarity.



(Confusing similarity)

If trademarks consist of a figurative element and a colour combination, the distinctiveness of the figurative element must be taken into account. If the figurative elements of both trademarks are highly distinctive, then the importance of the colour combination is diminished. Two trademarks employing a similar and highly distinctive figurative element shall be deemed confusingly similar in spite of the different colour combination.



(Confusing similarity)

4.3. Descriptiveness (Article 7 (1) (c))

4.3.1. General

Descriptive terms shall be refused under Article 7 (1) (c). Descriptive terms are those which consist of signs or indications “which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or rendering of the service, or other characteristics of the goods or services”.

As regards descriptiveness, an objection applies for those goods and services for which the term is directly descriptive, as well as for a generic term covering various terms one of them describing the characteristics of the goods and services. For example, “EUROHEALTH” is to be refused for “insurances” as a whole and not only for health insurances (GC, T-359/99 “Eurohealth”, paragraph 33).

An objection also arises for those goods and services which are directly linked to those for which the descriptive meaning pertains. Furthermore, if the descriptive meaning arises for a complex activity involving the use of several goods or services mentioned separately in the specification, then the objection arises for all of them (see GC, T-355/00, “Tele Aid” concerning a number of goods and services that were in conjunction with, or are applied in, offering aid to car drivers at a distance).

It is possible to claim goods and services as so-called auxiliary goods or services in the sense that they are meant to be used with, or support, the use of the main goods or services. Typically, this covers paper and instruction manuals for the goods to which they belong or which are packed in them, advertisement or repair. These auxiliary goods or services obviously share the objection on lack of distinctiveness or descriptiveness.

Descriptive marks are those that limit themselves to provide information about the goods and services in question. The trade mark must consist *exclusively* of descriptive matter. Additional matter in the trade mark that is not descriptive brings the mark outside the scope of Article 7(1)(c).

The **reference base** is the target consumer's understanding of the word in question.

That consumer's understanding can be construed by help of **dictionary entries**, examples of the use of the term in a descriptive manner found on Internet **Websites**, or it may clearly follow from the **ordinary understanding** of the term. It is not necessary for the examiner to prove that the word is as such subject to dictionary entries. In particular for a composite term,

dictionaries do not mention all possible combinations. What matters is the ordinary and plain meaning. In addition, terms which are used in a specialist terminology to designate the respective relevant characteristics of the goods and services are to be considered descriptive.

A second category of descriptive terms are those which consist of **abbreviations**. In order to be able to refuse them, it is not only necessary for the examiner to show that the abbreviation actually is a composition of terms which on their own are purely descriptive, but in addition it must be shown that this abbreviation is commonly used or at least understood by the relevant specialists in the fields, as an abbreviation identifying the goods as to their characteristics, rather than as an abbreviation used by only one or two traders to designate their own products. Again, in this group of cases, if the abbreviation is generally accepted in the relevant field, it is not necessary to show that the end consumer understands the abbreviation. Example: LITT descriptive for certain medical apparatus because used as an abbreviation in medicinal literature for “laser-induced thermo therapy” (CD, C 573).

A third category of descriptive terms are those which are **descriptive as of law**, because the descriptive nature of the term has been specified in a legal instrument which is either binding or to be taken into account by the Office. This applies for all registered geographical indications, as well as for international non-proprietary names. Examples: Vinho verde, Cava. Also, international non-proprietary names fall into this category, which are protected by the World Health Organisation for the purposes of identifying medicinal substances through unique, internationally accepted terms.

The public interest underlying Article 7 (1) (c) is that no exclusive rights should be created in purely descriptive terms which other traders might wish to use as well, as well as in the interest of the public that terms which have a purely informational value should not be reserved for one single trader (subject, of course, of the possibility to obtain registration through evidence of acquired distinctiveness). However, it is not necessary for the examiner to show that there is already a descriptive use by competitors of the trade mark applicant. It is not necessary for the term to be in real use in commercial life for the mark to be refused on grounds that it is descriptive - the existence of the possibility of such a use is sufficient. Nor is the examiner required to establish that third parties in the future might have a specific interest in using the term as a descriptive term (see ECJ, C-108/97 “Chiemsee”) This has in particular the consequence that if a word is descriptive in its ordinary and plain meaning, this ground for refusal cannot be overcome by showing that the applicant is the only person who produces, or is capable of producing, the goods in question.

4.3.2. Subcategories of descriptiveness

The following **subcategories** of Article 7 (1) (c) can be mentioned:

Kind of the goods:

The goods or services themselves, that is, their type or nature. This is also referred to as generic terms. Examples: “Bank” for financial services. “scomber mix” for fish products.

Quality:

Includes both laudatory terms, referring to a superior quality of the respective goods, as well as the inherent quality of goods. Covers terms such as “light”, “extra”, “fresh”, “hyper light” for goods that can be extremely light.

Quantity:

Covers indications of the quantity in which the goods are usually sold, such as “six pack” for beer, “one litre” for drinks, “100” (gram) for chocolate bars, “2000” for referring to the size of

the motor for cars. Only quantity measurements relevant in trade, not those that are hypothetically possible, count.

Intended purpose:

The intended purpose can be the way, the means of application, or the function in which a good or service is to be used. This also covers the matter of use. This argument for objection is frequently overlooked. In particular, it is wrong to reduce Article 7 (1) (c) to generic indications as to the nature of the goods and services. On the basis of the aforesaid: "Inhale" for pharmaceuticals must be refused as indicating the purpose of the goods that can be inhaled. "Therapy" must be refused for massage tools. This objection also applies as regards accessories: A term that describes the type of goods describes also the intended purpose for accessories to those goods. Therefore, "Hallux" is objectionable for shoes and "Rockbass" for accessories for rock guitars (GC, T-315/03).

Value:

Covers both the (high or low) price to be paid, as well as the value in quality. Covers therefore not only expressions such as "extra" or "top", but also expressions such as "cheap" or "more for your money". Covers also expressions indicating, in common parlance, goods that are superior in quality, such as "premium".

Geographical origin:

a) An application containing a geographic term is only objectionable under this provision if it consists exclusively of such a term. This provision therefore does not apply if the mark contains elements which would be registrable on their own. If the mark contains other non-distinctive or distinctive elements, the registrability of the combination (of the mark as a whole) must be assessed in the same way as in other cases where descriptive elements are coupled with distinctive or non-distinctive elements.

b) Protected geographical indications enjoy special protection under Turkish law:

For the goods and services for which they are so protected, these indications are geographically descriptive as of law. This applies irrespective of consumer recognition and irrespective of whether the term actually designates an existing geographical place (which is for example not the case for "vinho verde" from Portugal).

c) Criteria for geographical terms not enjoying special protection

What follows concerns only those geographical terms which do not enjoy special protection as a geographical indication within the meaning of subparagraph b) above.

It must be emphasized that Article 7 (1) (c) CTMR does not exclude geographic indications, but "trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, geographical origin or other characteristics of the goods or services". Like for all other descriptive terms,

- the test is whether the geographic term describes objective characteristics of the goods and services,

- and, this must be assessed with reference to the goods and services claimed and with reference to the perception by the relevant public.

The descriptive character of the geographical term may pertain to

- the place of production of the goods,

- the subject matter of a good (for example, what city or region a travel guide is about, or the area covered by a newspaper),
- the place on which the services are rendered,
- the place where the company rendering the services has its seat and from where the rendering of the services is managed and controlled,
- the nature of the goods to which the service relates (e.g. "Chinese restaurant").

It must be checked that the trade mark is not descriptive in any of these respects.

Notion of geographical term

A geographical term is every existing name of a country, region, landscape, city, lake or river. Old fashioned terms fall under this notion only if still commonly used or generally understood as the synonym for the current indication (doubtful: "Batavia").

The first test: Is the term understood as a geographical term?

Where the term is an existing city, region etc., it must still, in a first test, be ascertained, whether the term is known to the relevant public as a geographical term. An objection under Article 7 (1) (c) CTMR therefore does not apply in respect of names of towns, villages etc., which are not readily understood as being a geographic term. This question shall not be ascertained through opinion polls, but rather in a normative way by taking as the basis a reasonably well informed consumer with a sufficient common knowledge, without being a specialist in geography.

Although the size of a city or village cannot be an absolute criterion (because small cities may be widely known for particular reasons), it is safe to say that already a high number of geographical terms from outside of Turkey, and a high number of smaller villages or municipalities, are thus excluded from objection under of Article 7 (1) (c).

The second step: Is the geographical term not only recognised, but also perceived as such?

It is not only necessary that the relevant public knows the geographic term as such, but also understands it as a reference to the geographic place when used in connection with the claimed goods or services. In other words, the geographic term must not be understood as a mere suggestive or fanciful term. Example: whereas the North Pole and the Mont Blanc are commonly known, in the context of ice cream or sports cars, they would not be understood as a possible place of production, but as a merely suggestive and fanciful term.

The third step: the link between the geographical place and the goods or services

Even when the second step is passed, it is not enough to require that the goods or services can theoretically be produced or rendered in the given geographic place. Save where there are climatic restrictions, that would nowadays be possible almost everywhere in the world. Rather, the following criteria set up by the European Court of Justice in "Chiemsee" and "Oldenburger" must be satisfied:

The geographical place must be currently associated, in the mind of the relevant public, with the category of goods in question, or the geographical name must be liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods (Chiemsee, par. 31, 37); in this assessment, regard must be had to the degree of familiarity amongst the public with the geographical name, with the characteristics of the place designated by the name, and with the category of the goods concerned (Chiemsee, par. 32).

Registration is excluded not only for geographical names which are already famous or known for the goods concerned, but also for those geographical names which are liable to be used by undertakings and must remain available to such undertakings as indications of the geographic origin of the category of goods concerned (Oldenburger, par. 31); however, the registration of geographical names is not excluded, when, because of the type of place they designate, the public is unlikely to believe that the category of goods concerned originate there (Oldenburger, par. 33).

This has two consequences: on the one hand the assessment whether a geographical name, although not actually used to designate the geographic origin of the product, is liable to be so used in the future, must be made on the basis of the consumer perception of today and on the basis of objective criteria, taking into account in particular the relevance of the geographic origin for the goods in question and the use in trade to use geographical names to indicate the origin of the goods or to refer to certain qualitative and objective criteria of the goods. On the other hand Article 7 (1) (c) is not limited to geographic terms already having a reputation or for which the Office is able to demonstrate an actual need to keep it free for the competitors. Consequently, the very fact alone that the geographical term is used by only one producer is not sufficient to overcome an objection (although it will be a very important argument to be taken into account in assessing acquired distinctiveness).

h) In many instances, the second and third step will actually be one and the same mental operation.

Whether an existing geographical term will, for the relevant goods, be understood as having an informational value about the place of production, or rather as a fanciful term, also largely depends on the nature of the goods. It is widespread practice to use fashionable city names for goods unrelated to the ground for which the city is known (Hollywood for chewing gum) or names of certain fashionable suburbs or shopping streets (Champs Élysées, Manhattan). These will be perceived as suggestive terms and shall not be refused.

For certain mechanical goods like cars where the public knows that they are not produced on a great number of different places, city names may serve to build up a series of model designations, such as Cordoba, Toledo, Malaga.

For services, the geographic term will, in many instances, be perceived as the place of the location of the enterprise and has to be kept free if that location is a relevant location for those services (to be refused: Munich financial services).

In the area of hotels and restaurants, a geographical term might relate to the type of dishes, the place of origin of the owner of the restaurant, the suburb or street whether the hotel is located, or have no relevance for the services at all. The mere fact that the service can be rendered at the place concerned does not justify a refusal (see case “Cloppenburg”, as regards retail services).

The assessment of geographical terms changes, of course, if those terms are combined with distinctive devices (see also further below).

In its “Konya Jant” (Konya Wheel Rim) decision the Supreme Court stated that notwithstanding the individually descriptive elements, considering the overall impression conveyed by the sign consisting of KONYA JANT and a figurative element, it was to be considered distinctive and not descriptive. This is because the scope of protection derives from the overall impression of the sign, not from individual words, and therefore the existence of the indication Konya will not give the trade mark owner an exclusive right. Since the city of Konya does not have a reputation for the product wheel rim, the sign as a whole is not deceptive in means of geographical origin. (Esas no: 2007/13026; Karar no: 2009/2015, Yargıtay 11.İdare, 23.02.2009).

The Re-Examination and Re-Evaluation Board decided that the indication “SWISSMETAL”,

which means “the metals of Swiss origin”, shall be directly descriptive for the products of metal, or including metal, since they are not distinctive for these kinds of goods the indication cannot be evaluated for the goods and services under the classes 3, 18, 25, 40 and 42, but should be examined pursuant to Article 7(1) (a) and (c) of the Decree Law 556 (YİDK, 2009-M-4530 sayılı karar)

Time of production of the goods or of rendering of the service:

Covers expressions concerning the time on which services are rendered, either expressly (“evening news”, “24 hours”) or in a usual manner (24/7). Also covers the time on which goods are produced if that is relevant for the goods (late vintage for wine). For wine, the numeral “1998” indicating the vintage year would be relevant, for chocolate not.

Other characteristics of the goods

This item must be construed as also covering other characteristics of the services. This item shows that the preceding list of items in Article 7 (1) (c) is only by way of example. Any relevant characteristic of the goods and services must lead to a refusal under Article 7 (1) (c).

Examples of “other characteristics”:

- the subject matter: “Elektronika” for fairs and exhibitions (GC T-32/00)
- the definition of the targeted consumer: “children” or “ellos” (GC, T-219/00) for clothing.

This also covers technical characteristics of the goods not falling under the above sub items, for example “Trustedlink” for goods and services in the IT-Sector aiming at securing a safe (trusted) link. (GC, T-345/99).

4.3.3. Categories of marks

One word

The term need not be the precise and exact definition of a particular characteristic of the goods. It suffices for a refusal under Article 7 (1) (c) if there is a sufficiently direct and concrete relationship between the term and the goods and services. To rely on: GCFI T-106/00, “Streamserve”, paragraph 40; GCFI T-173/03, “Nurseryroom”, paragraph 20.

The mark is descriptive if either for the general public (if the goods are addressed to them) or for a specialized public (irrespective whether the goods are also addressed to the general public) the trade mark has a descriptive meaning. On this basis to be refused:

Such terms are excluded from registration for almost all goods and services. However, it is important to distinguish laudatory terms in the sense that they describe, although in general terms, desirable characteristics of goods and services as being cheap, convenient, of high quality etc., which are excluded from registration, from those terms which are laudatory in a broader sense, without specifically referring to the goods and services, but referring to vague positive connotations or to the person of the purchaser or producer of the goods.

Not descriptive:

- BRAVO (ECJ C-517/99, “BRAVO”)

The relationship between the mark and the descriptive meaning must be concrete, direct and without further reflection (GC, T-345/99, “Trustedlink”, paragraph 35). There must be a

sufficiently close relationship between the goods and services and the mark (GC, T-219/00, “Ellos”, paragraph 35).

On the other hand, Article 7 (1) (c) does not apply to those terms which are only suggestive or allusive as regards certain characteristics of the goods. Sometimes this is also referred to as vague or indirect references to the goods (GC, T-135/99, “Cine Action”, paragraph 29).

Neologisms made up of several words

As it is not necessary for a refusal to show that the mark appears in a dictionary or is actually in descriptive use, the mark must also be refused under Article 7(1) (c) if it consists of two descriptive terms which cannot be shown to have been used together, but which are juxtaposed in a grammatically correct structure and are actually understood in their descriptive meaning. This applies when the two terms create a new descriptive meaning or reinforce each other in their descriptive meaning.

The test is: As a general rule, a mere combination of elements each of which is descriptive of characteristics of the goods or services itself remains descriptive of those characteristics. Merely bringing those elements together without introducing unusual variations, in particular as to syntax or meaning, cannot result in anything other than a descriptive mark. A trade mark consisting of a neologism composed of elements each of which is descriptive of characteristics of the goods or services in respect of which registration is sought is itself descriptive, unless because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts (see: ECJ, C-265/00, “Biomild” paragraph 39, 43.)

In the example “Biomild”, this must be refused for yoghurt as referring to yoghurt being mild and organic. Other examples of terms which fall foul under Article 7 (1) (c): Companyline, Trustedlink, CineComedy, Teleaid, Quickgripp, Twist and Pour.

Those notions, “unusual nature of combination”, “impression sufficiently far removed” and “more than the sum of its parts” have to be interpreted as meaning that Article 7 (1) (c) does not apply when the way in which the two descriptive elements are combined is in itself fanciful.

Misspellings, omissions

Frequently a word, or word combination, will not be filed exactly in the correct way it is to be written, but slightly changed.

First of all, the mere writing together of two words without a back space, or the addition of or omission of a hyphen, is irrelevant and the mark remains objectionable. This is in particular true for the English language.

Misspellings of letters that are usually misspelled, for example due to influences of American English, in slang language or to make the word more fashionable, remain all objectionable. Examples: “Lite”, GC, T-79/00.

On the other hand, if the misspelling is fanciful and/or striking or changes the meaning of the word (invented example: Minute Maid instead of Minute made), the mark is acceptable (cf. paragraph 99 of ECJ, C-363/99, “Postkantoor”).

As regards omissions, frequently applicants argue that the trade mark as filed is not the full descriptive term as it would be used. This argument has to be refused from the outset because it insinuates examination of another trade mark, not the one actually filed.

Abbreviations and acronyms

Abbreviations of descriptive terms are in themselves only descriptive if they have actually been used that way and the relevant (general or specialized) public recognizes them as being identical to the full descriptive meaning. The mere fact that an abbreviation is derived from a descriptive term is not enough.

Examples of refused applications, because the descriptive meaning for the specialized public could clearly be shown:

- SnTEM, GC, T-367/02, OJ OHIM 2005, 544
- TDI, GC, T-16/02
- LIMO, GC, T-311/02, OJ OHIM 2005, 734
- BioID, GC, T-91/01, OJ OHIM 2003, 466;

If a clear, and not only hypothetical, descriptive function of the abbreviation cannot be ascertained or if there are so many possible meanings that the abbreviation is not directly referring to any of them, the mark is registrable.

Slogans

A slogan is always registrable if it contains a word (or words) which is (are) distinctive on its (their) own. Example: "Carlsberg - Probably the Best Beer in the World".

A slogan can be descriptive (see above, criteria for descriptiveness of word combinations) if it is limited to highlighting desirable characteristics of the goods or services. Examples for descriptive slogans: "Mehr für Ihr Geld", (GC T-281/02) "Looks like grass, feels like grass, plays like grass" (GC, T-130/01) "Real people, real solutions" (GC T-130/01). Descriptive slogans are also non-distinctive.

On the other hand, slogans are distinctive if they contain an element of fancifulness, for example by playing with words, using an element of irony, by alliteration and rhyme, or by conveying subliminal messages.

Examples: "YOUR SPARE CHANGE COULD CHANGE YOUR LIFE" (class 41), "FEEL AT HOME WHILE YOU ROAM" (class 38), "LISTEN AND YOU'LL SEE" (class 9), "IMPOSSIBLE IS NOTHING" (class 25, 28 and 41).

Descriptive terms + non distinctive word or device elements

A mark is distinctive if at least one of its elements is distinctive on its own. Therefore, if a descriptive term is coupled with a distinctive term, the mark is registrable (easy example: light is not registrable, Pepsi light is).

The mark is also distinctive if, although none of its elements is distinctive on its own, the overall combination (the mark as a whole) is distinctive. In this case the mark is distinctive if the way the two words are combined is a syntactically unusual juxtaposition, fanciful or "more than the sum of its parts".

The same criteria must be applied if a descriptive term is coupled with the term which is not descriptive, but also not distinctive. Also in this case, combining two unregistrable elements can only render the mark distinctive as a whole if the way the two elements are combined has something fanciful or being "more than the sum of its parts" (cf. ECJ C-329/02, SAT2).

Descriptive terms +distinctiv figurative elements

Again, if a figurative element which is distinctive on its own is added to a descriptive term, the mark is clearly registrable.

In order for the mark to be registrable, the added figurative element, if in itself distinctive, needs not be “dominant” or “co-dominant”. It suffices that it is clearly recognizable.

Where the figurative element, separately recognizable, is not distinctive on its own, or where the descriptive term is presented in a non-standard type face or with coloured letters, underlining or other graphic presentation, the situation is:

Presenting a word as a figurative mark, or presenting it in standard type faces or italics, cannot render the mark distinctive. Examples: GC, T-32/00, “Elektronica”; GC, T-91/01, “BioID”. In this sense, standard typefaces are not just Arial and Times New Roman, but all typefaces that by an average consumer would be perceived as just another common typeface.

Anything that has a higher degree of fancifulness than those should be acceptable, if it can be granted that the mark with all its components appears as a distinctive entity of its own and thus more than the sum of its individual parts (see: E. 2000/7590, K 2000/9528, verdict of the 11. Chamber of the Supreme Court – Computer Bild).

If that distinctive figurative element is not the dominant element in the whole mark at first sight, if it stands too much in the background comparing to the word element, insignificant or as a silhouette then the word element would be regarded as descriptive element and the decision would be taken in framework of the evaluation that the figurative element does not bring any distinctiveness to the mark.



The line of reasoning in the decision “Number 1” 2004/238 number 2004/204 in Ankara IP Court may be helpful when identifying the dominant element: *“Since the overall impression of the trademark is the leading principle, the examination of the trademark by separating it into parts and especially the identification of figurative parts, which do not have distinctiveness individually, as dominant elements may not lead to correct results. Surely this kind of indications may be considered with regards to their effects on the overall impression of the trademark. On the other hand, the consideration of the auxiliary elements, which have a small effect on the general impression of the mark, would not lead to correct results either even though they provide distinctiveness on the dominant elements of the mark.... However, if the picture or shape stands out completely and constitutes the dominant element, the other elements in the mark will remain in the impression as auxiliary elements.”* (Ankara Fikri ve Sınai Haklar Hukuk Mahkemesi 2004/238 esas 2004/204 karar sayılı “Number 1” kararı, s. 3).

In cases where neither the figurative elements per se nor the term are distinctive on their own and both are separately recognizable, the situation is as follows:

In general the distinctiveness of a word/figurative combination cannot solely derive from the following figurative elements: coloured letters, underlining, circles, triangles, rectangles, stars, swoosh, handwriting, capital letter inside a composed word, coloured background or frame, shadowing, multi-colour, standard decorations and at least the @ (Reexamination and Evaluation Board – spor.net; Supreme Court - “Teknoloji”).

Assessing the sign applied for in its overall impression, several of these simple figurative elements altogether can cause distinctiveness. In the figure (picture) + word combination trademark even descriptive words are taken into consideration and may lead to a distinctive mark in its overall view (see 2004/238, 2004/204, verdict of the Ankara Intellectual and Industrial Property Rights Court – Number 1).

Non-essential alienations in the figurative element cannot overcome the descriptiveness of the word element. The more descriptive the word element is, the higher a degree of graphical fantasy is demanded.

Descriptive words in foreign languages

Apart from being rejected because they would not be perceived as trademarks by the consumers, descriptive terms shall also be rejected because they must stay free for common use by other producers. Following this logics, words that have a descriptive content in any step of the trade chain must be kept free for use by all tradesmen. From this point of view, foreign words that are in common use in Turkey and in international commerce may be found to be descriptive and excluded from the scope of protection. Especially, words in languages that are in common use in the relevant commercial sector, particularly English, should be considered ex officio.

Consequently, applications filed in foreign languages shall be refused due to their meanings, if the Turkish equivalent is the name of the relevant goods/services, or if it is directly descriptive concerning the relevant goods/services.

The 11th Civil Chamber of the Supreme Court adopted the same approach in its decision number E. 2000/236, K. 2000/1141: *“The refusal of the sign is decided on grounds that the according to the evidence in the file, the word CHIFFON that the plaintiff seeks registration as a commercial trademark is a fabric name in French, and used in Turkish with the meaning as translucent, thin fabric and indicates the type, kind and quality both for the purpose and the way of use in Turkish.”*

APPLICATIONS CONSISTING OF DOMAIN NAMES

By way of principle, since domain name extensions such as “com”, “net” and indications such as “www”, “http”, do not convey distinctiveness to the indications they are used with, the assessment shall be done on the element(s), these indications excluded (See RE-Examination and Re-Evaluation Board, decision number 2009-M-5343 on the refusal of the application number 2008/63273 **“sahibinden.com figurative”**).

4.4. Signs that have become customary in trade (Article 7(1)(d))

Under Article 7 (1) (d), trademarks consisting exclusively of signs and names that are used to distinguish specific groups of craftsmen, professionals or tradesmen or have become customary in the current and established practices of the trade cannot be registered.

These are trademarks which consist exclusively of signs or indications which have become customary in colloquial and everyday language or in the bona fide and established practices of the trade for the applied goods or services. The focus is here on the fact whether the applied sign is a characteristic or indication of quality or not with respect to the applied goods or services (ECJ C-517/99 – BRAVO: accepted for typewriters, but it cannot be registered for cultural activities; German FCJ: YES accepted for cigarettes; BONUS accepted for different food products; ABSOLUT accepted for alcohol; FOR YOU accepted for different classes). Also common words in advertising, marketing or distribution and general terms of quality like “super”, “first class”, “Worlds best” cannot be registered, if they are used and common in the applied sector.

Examples: fresh is a common term in the sectors of nutrition, beverages or tobacco, but not for financial services, real estates or medical care (overlapping with Article 7 (1) (c); OHIM – “brand” for class 34 registrable. “Super” is used in any class and therefore not registrable at all.

In order to define the term “common”, almost all concerned public, i. e. the informed and attentive average consumer in the concerned sector, must see a sign as nothing else but a word of praise and not as an indication of commercial origin. If the examiner belongs to the concerned public or is professionally involved as examiner in the applied classes, his knowledge can be introduced. Unless the applicant has to provide evidence which might be done by a poll (examples: lottery or walkman for entertainment).

Article 7 (1) (d) may be overlapping with Article 7 (1) (c) on the one hand and 7 (1) (a) in connection with Article 5 on the other hand. This is the fact in cases when the sign is already lacking distinctiveness (Supreme Court – “florist”; - “Digital Platform A.Ş.”).

Names used to distinguish specific groups of craftsmen, professionals or tradesmen are examined in the same way (*taylor* for construction material may be registered; *police* for sun-glasses, but not for clothing or weapons).

As a result, in case there is a characteristic or indication of quality for the applied goods and services the application is refused according to Article 7(1)(d). As the ECJ in the “BRAVO”-Case (C-517/99 Paragraph 31) pointed out, articles of 7/(1)(c) and 7/(1)(d) generally coincide.

To sum up, the registration of the trademark should be refused when the applied sign with respect to the applied goods and services has become usual in the current language and in local commerce. It is not necessary that the sign is directly descriptive for the goods and services. It is adequate if they are customary in the applied sector as a word of praising or advertising or any other word (i. e. “hey” for juvenile products) for the goods and services in question.

4.5. Signs constituted by the shape of the product, resulting from the nature of the product, necessary to obtain a technical result or giving substantial value to the product (Article 7(1)(e))

When assessing the registrability of shapes, firstly, it has to be ascertained whether one of the grounds for refusal under Article 7 (1) (e) applies, as they cannot be overcome through acquired distinctiveness. While it is true that the ground for refusal that the shape must not be necessary to achieve a technical result is to be interpreted as applying irrespective of whether there are other shapes that can achieve the result (to refer to: ECJ, C-299/99, “Philips”, par. 81, 83; CD, 63 C, shape of a Lego brick), this ground for refusal must still be interpreted narrowly and in particular only covers shapes whose modification would change the technical result itself, and not those which are merely functional. Article 7 (1) (e) (i) is limited to those shapes which are identical to the goods, for example the shape of a football for a football. Article 7 (1) (e) (iii), “the shape which gives substantial value to the goods”, is limited to shapes which exclusively realize an aesthetic function, such as the shape of an object of art for objects of art, and in particular has nothing to do with the commercial value of the goods.

The aim of the provision is to prevent the trademark proprietors to monopolize technical solutions or the functional features of a product. The shapes, whose basic features are the implementation of a technical function or chosen to implement this function, should be open to the public use, thus the scope of this provision is related to public interest. If the shape of a product can only be attributed to a technical result, the ground for refusal shall not disappear or the registration of the product in question shall not be possible, even if the same technical result is achieved in other ways.

4.6. Deceptiveness (ARTICLE 7 (1) (f))

Article 7 (1) (f) excludes marks which are of such a nature as to deceive the public for instance as to the nature, quality or geographical origin of the goods or services.

In order to fall foul under this provision, the mark must contain an objective indication about characteristics of the goods which is clearly in contrast to the reality contained in the list of goods and services. As long as the mark has not been used, this assessment can only be made with respect to the list of goods and services, assuming that the mark be used for the goods and services claimed but, if possible, in a non-deceptive manner. If there is a possible non-deceptive use, the mark must not be refused. Invented example: The mark “John Miller’s Genuine Leather Shoes” is objectionable for “plastic shoes” but not objectionable for “shoes” as these comprise leather shoes.

Article 7 (1) (f) does not apply where the term is merely suggestive: Example, “Metal Jacket” suggestive and non-deceptive for textile jackets. Those marks will be refused as deceptive that falsely represent an official status or recognition. Example: “International star registry” for a private service consisting in giving names to stars. This does not apply if the reference to something official is merely allusive.

However, references in the mark to official recognition are deceptive if they cannot be proven to be true by the applicant, for example “by appointment of her majesty”, whereas “Royal” does not promise an official status.

This ground for refusal also relates to marks which are of such a nature as to deceive the public as to the geographical origin of the goods or services. This ground for refusal also applies where the mark contains other elements than the geographical term.

For geographical indications not protected under the above provisions, a likelihood to deceive the public can result from undue de-localising additions, inherent contradictions (“Munich Beer brewed in Hamburg”). These cases will be quite rare. In principle it suffices that a non-deceptive use of the mark is conceivable under the circumstances. In no case shall an objection on deceptiveness be based on a geographic location of the applicant since this is irrelevant for the place of production of the goods.

Examples of Implementation

1) Applications indicating geographical origin



The trademark “Feast Adana Kebab” is deceptive for “urfa kebab”, but not for “meat products”, “kebabs” or “dairy products”. Similarly the trademark “Kavaklıdere Anatolian Wines” is deceptive for “whiskies”, but not for “alcoholic beverages”.

If the trademark indicates an internationally reputed geographical origin, then the goods deemed to stem from that related geographical origin. For instance; the trademark

“Favorswiss” would only be deceptive for “German made watches” but not for “Swiss made watches” or “watches”.

2) Trademarks applied for dangerous or precarious products as to quality

Descriptive elements in the trademark, whose registration is sought for goods that imply an important level of jeopardy to the human health and safety, should be in accordance with the related goods. Considering the fields and conditions of use of the trademark and the target consumer group, if there is a possibility of deception of the consumer which may result in damage, the application shall be rejected.

As the trademark “BABYSPA” evokes health products which are applicable and specially developed for babies, it is deemed to be deceptive because health threatening for goods such as “Harmful vegetables, animals and fungicide exterminating substances. Sanitizers, germicidal, medical detergents” (Benzer yöndeki karar için; bkz. 2007/27977 başvuru numaralı “İspanak doğal ve organik ürünler” markası hakkındaki 2008-M-3235 sayılı YİDK kararı).

3) Descriptiveness for addressing a specialized public

Evaluation shall be done within the frame of the characteristics of target consumer group and the concrete case. The trademark “BEBE” is deemed to be deceptive for “personal care, skin care, cosmetic products” which fall under Nice Classification class 3 consists of different qualities for men, women, children and babies and effects the decision of the consumer. The trademark “WINE OH!” would be deceptive for “non-alcoholic beverages”, but it was registered for “computers, clothes and catering services”.

4.8 Signs Article 7/1(h)

“Trademarks which are excluded from the scope of Article 6ter of the Paris Convention, but concern the public and possess historical and cultural value due to their incorporation of armorial bearings, emblems, or hallmarks which have not been authorized by the competent authorities” shall not be registered.

The following criteria should be taken into account for the evaluation of signs under the scope of Article 7/1(h) of the Decree Law 556:

- i. Whether the indication contained in the application concerns the public in any way;
- ii. Whether the indication contained in the application is of cultural and historical value (Bkz. “Gulliver” kararı (Bir romanın Türkiye’de bilinmesi ve tanınması, onun kültürel değerler bakımından mutlaka halka mal olmuş bir nitelik kazanmasını gerektirmeyeceğinden onun adını taşıyan bir işaret marka olarak sicile tescil edilebilir.) (Yargıtay 11. HD., E. 2000/4541, K. 2000/5500, T. 15.06.2000);
- iii. Whether the trademark is related to national cultural and historical assets (Bkz. “Alpacino” kararı (“Alpacino” ibaresi her ne kadar İtalyan asıllı bir Amerikan film yıldızının ismi ise de, ülkemizin kültür ve tarih değerleriyle ilgisi olmadığı, bu sözcüğün başkaca bir anlamının da bulunmadığı gerekçeleri ile anılan ibarenin marka tescilinde bir sakınca bulunmadığı sonucuna varılmıştır.) (Yargıtay 11. HD., E. 1999/6187, K. 1999/8216, T. 22.10.1999)
- iv. Whether the use of the mark has been authorized by the competent authorities.

Applications refused on the basis Article 7/1(h) consist of, but are not limited to, the following examples:

- i. The signs and indications which are of general public concern and do not possess economic value (i.e. the indication and logo of the Supreme Court, the names and logos of political parties, the name and logo of the Ministry of Industry and Trade, etc.)
- ii. The names of famous Turks containing cultural and historical value (i.e.: Atatürk, Fatih Sultan Mehmet, Kanuni Sultan Süleyman). The names of famous actors, sportsmen, authors, artists, etc., are not subject to this evaluation.
- iii. Indications containing terms such as “Osmanlı İmparatorluğu”, “Osmanlı Devleti”, relating to the Ottoman Empire, Ottoman governmental hallmarks and heraldry, or signs and indications containing the same meaning. Applications consisting of indications such as “Osmanlı” or “Ottoman” as the sign itself, or as a dominant element thereof, are not subject to this evaluation depending on the nature of the goods and/or services they cover and assuming that they are not accompanied by other offensive or insulting elements.
- iv. Trademark applications containing photos, pictures or names of historical and cultural structures shall be evaluated within the scope of this provision. (i.e. Anıtkabir - Atatürk's mausoleum, Hagia Sophia, Selimiye Mosque, Dolmabahçe Palace, etc.). Ancient names for cities and geographical locations, such as “Efes” and “Anatolia” shall not be subject to this evaluation.
- v. Trademark applications including the names and surnames of the presidents and prime ministers of the Republic of Turkey, shall be evaluated within the scope of this provision. However, applications filed by institutions and organizations with a public service purpose, such as universities and airports bearing the names of presidents or prime ministers shall not be evaluated within this context (i.e. Atatürk University, Süleyman Demirel University).

4.9. Trademarks that have not been authorized by their owners and well-known marks within the meaning of Article 6bis of the Paris Convention (Article 7(1)(i))

According to Article 7(1)(i), trademarks that have not been authorized by their owners and well-known marks within the meaning of Article 6bis of the Paris Convention shall not be registered. This provision is examined by the Institute ex officio. According to the regulation which refers to the Paris Convention, well-known trademarks need not be in use in Turkey in order to benefit from protection. However, they must be known in Turkey.

An application consisting of a well-known trademark shall not be refused on the grounds of Article 7/1(i) if the applicant obtained permission from the trademark owner. The consent of the owner of a well known trademark will, however, not effect an examination under Article 7(1)(b). The owner's consent must be formalized in a written permission document drafted between the parties. If the proprietor is a natural person, the document should be signed by the proprietor himself. If the proprietor is a legal entity, the document should be signed by an authorized legal representative. In this case, a specimen of the representative's signature must be submitted. Furthermore, the document must explicitly indicate the beneficiary, the sign, as well as the goods and/or services covered by the consent.

Under the scope of Article 7/1(i), well-known trademarks benefit from protection in relation to the same and similar goods and/or services for which they are registered. The protection provided by Article 7/1(i) shall not extend to goods and/or services which are not identical, complementary or similar to those of the well-known trademark. Factors such as the distinctiveness and level of notoriety of the well-known mark, as well as its similarity to the trademark application, must be taken into account for the extension of the well-known mark's scope of protection to similar goods and/or services. For instance, the refusal of a trademark application for classes 29, 30, and 32 may be warranted by the existence of a well-known trademark covering class 29. Furthermore, a well-known trademark covering class 5 may result in the refusal of an application for classes 10 and 44 if the goods and services are

related to the class 5 goods. On the other hand, the evaluation of classes including a wide variety of goods, such as class 9, should focus on the sub-groups of goods related to the goods of the well-known mark.

Example:

In the Re-examination and Re-evaluation Board decision 2007-M-5287 KENT, the Board did not extend the scope of protection for the well-known trademark “KENT” registered for class 30 to food sector goods and/or services. Similar decisions of the Re-Examination and Re-Evaluation Board include: Nr. 2009-M6245 İDAŞ, Nr. 2010-M1722 Barbee, Nr. 2010-M-1094 Kaşmir, Koza İpek and Uno.

Under article 7/1(i), signs which are identical or similar to an earlier well-known trademark cannot be registered. However, it is necessary to consider the well-known sign's distinctiveness and notoriety during the evaluation of the similarity between the signs. A trademark application which passes the similarity test of Article 7(1)(b) may be rejected under article 7 (1)(i). For instance, the trademark application “b&a Blu&Armani” for class 25 was rejected under Article 7 (1)(i), on the grounds of the existence of the well-known trademark “Armani”.

4.10. Trademarks containing religious symbols (Article 7 (1) (j))

Article 7(1)(j) precludes the registration of “trademarks, which contain religious value and symbols”. Signs aimed at harming, abusing and/or imposing religious values upon the public and the commonwealth shall be evaluated under this provision.

Two main considerations for the examination of a sign under Article 7/1(j) of the Decree Law exist:

1. Signs containing or referring to a religious term or symbol (i.e. Allah, the Prophet Mohammed, names of Holy Scriptures etc.), whether exclusively or as a dominant element, shall be refused under this provision.

2. Sign containing religious elements but lacking direct religious connotation shall not be evaluated within this context. However, public perception and overall impression shall be taken into account in relation to the goods and/or services sought. Thus, signs which directly evoke a religious connotation or have the potential to harm religious values shall be evaluated within this scope of this provision.

i. Names and titles of religious officials:

Indications such as imam, priest, pope, and rabbi are commonly used in public with different meanings in addition to being the names or titles of religious officials. They do not necessarily evoke religious connotation. These types of indications may be acceptable as a general rule. However, the nature of the goods and services sought by the application should be examined. Furthermore, signs considered offensive or insulting from the perspective of the general public, shall be evaluated under Article 7/1(j) of the Decree Law.

ii. Holy words:

Signs consisting of terms such as “Allah”, “Quran”, “Old Testament”, and “Bible”, as a dominant element directly evoke religious meaning and contain signs and indications that are sacred to the members of a religious community. Such signs fall within the scope of Article 7/1(j) of the Decree Law.

iii. Holy Places and/or names thereof:

As a principle, signs, containing photos, pictures or names of sacred religious places such as “Kaaba”, “Al-Aqsa Mosque”, “mosque”, “church”, “synagogue” exclusively or as a dominant element, shall be evaluated within the framework of Article 7/1(j) of the Decree Law. However, if these indications are used with other elements in a way that does not evoke religious meaning, such as “ulu mosque” or “blue church”, they may not fall within the framework of this provision depending on the nature of the goods and services. Indication containing the names of well-known sacred places, such as “Hagia Sophia” or “Blue Mosque” shall be evaluated under the scope of this provision.

iv. Names of religions and religious sects:

Signs which contain, whether exclusively or as a dominant element, the names of religions or religious sects, or the names of the members thereof, shall be evaluated under Article 7/1(j) of the Decree Law (i.e. Christian, Muslim, Jewish, Naqshbandi, Protestant, etc.). However, signs which contain such terms but do not evoke religious connotation due to their additional elements, shall not be evaluated within this context (i.e. Islam Albayrak).

v. Sacred words, names of people, symbolic concepts:

Signs containing, exclusively or as a dominant element, words that are sacred to the members of a religion, as well as the names of sacred people or symbolic concepts, are considered to evoke religious meaning and are thereby evaluated under Article 7/1(j) of the Decree Law (i.e. Rahman, Vedud, God, Mother Mary and symbols related thereto). Signs containing the abovementioned terms may not evoke religious connotation if they possess additional elements. Such signs shall not be evaluated under the scope of this provision.



For instance:

4.11. Public policy or morality (Article 7 (1) (k))

Article 7(1)(k) prohibits the registration of trademarks that are contrary to public policy or to accepted principles of morality.

“Public policy” is the body of all legal rules that are necessary for a functioning democratic society and a state of law. “Accepted principles of morality” are those that are absolutely necessary for the proper functioning of a society.

Article 7(1)(k) thus excludes blasphemous, racist or gender discriminatory phrases. It also excludes all direct references to criminal activity or incitements to commit criminal acts. Furthermore, the provision excludes names of terrorist organizations as such sign are perceived as direct support for illegal organizations.

Signs that contain elements contrary to human rights and democratic order shall be deemed as contrary to the public order. Signs that contain elements which are against public order and permanent customs shall be deemed contrary to public morality (Yargıtay 11 HD. E. 1999/7314 K. 2000/1195).

Signs, shapes and indications which are harmful to the public, encourage bad habits, incite crime or include insults, coarse language, racism, and discrimination are considered contrary to public order and morality. Furthermore, indications and symbols which include the names, symbols and/or abbreviations of terrorist organizations, or create an impression direct relation thereto, are deemed contrary to public order.

For example, indications related to terms such as cocaine, heroin, ecstasy, and the equivalents thereof in any other language or synonyms thereof, or the encouragement of the use of such products, shall be deemed contrary to public order and/or morality.

The examination of a sign alleged to be contrary to public order and/or morality shall be conducted from the perspective of a person living in Turkey having an average level of awareness.(Yargıtay, Uzak Doğu ülkelerinde özel bir seks tekniği anlamına gelen “Kamasutra” ibaresinin, “prezervatif” ürünü için tescil edilebilir nitelikte olduğuna hükmetmiştir. (11 HD. E. 2002/868; K. 2002/4651).

The concept of public order and morality can change over time. A sign which was once considered acceptable may become contrary to public order due to changes in public perception since the date of registration (“Barış Gelini” adıyla dünya barışı için İtalya’dan Filistin’e seyahat ederken 2008 yılı içerisinde Türkiye’de öldürülen “Pippa Bacca” ibaresi için yapılan 2008/24106 ve 2008/57471 numaralı başvurular, başvuru sahibi haklı bir gerekçe sunamadığı için 7/1-(k) maddesi kapsamında değerlendirilmiştir.). In addition, signs that insult the names of historical characters, or contain curse words or offensive figures or racist insults, shall be evaluated within this context.

5. ACQUIRED DISTINCTIVENESS THROUGH USE (ARTICLE 7 (2))

The rules concerning acquired distinctiveness are defined by Article 7(2) according to which “the provisions of subparagraphs (b), (c) and (d), may not be invoked to refuse the registration of a trademark that has been used before registration and through such use has acquired distinctive character in relation to the goods and services for which it is to be registered.”

Consequently, a trade mark may be deemed distinctive if it is recognized by a sufficiently large part of the relevant public as a mark related to one specific undertaking.

Proof of acquired distinctiveness can result in the registration of marks which would otherwise not be registrable on grounds of:

- lack of distinctiveness (a)
- descriptiveness (c)
- common use in trade (d)

Marks that are unregistrable on basis of other absolute grounds not mentioned above cannot benefit from registration based on acquired distinctiveness through use.

In order for an application to benefit from acquired distinctiveness in light of the abovementioned absolute grounds for refusal, an applicant must submit a formal request. (See decision number E. 2000/6135 K. 2000/8767 of the 11th Civil Chamber of the Supreme Court).

Acquired distinctiveness must exist as of the filing date. Proof of acquired distinctiveness after the filing date is not sufficient. To rely on: CFI, T-247/01, “Ecopy”, par. 36, 37.

Acquired distinctiveness requires that the use of a mark:

- does not vary significantly from the mark indicated in the application;
- relates to the same goods and/or services covered by the application.

In assessing the nature and extent of use, the examiner must consider the characteristics of the relevant industry or sector, the manner in which the goods and services are provided, and the relevant public (i.e. specialized or general public). The mark's lack of distinctiveness must be weighed against the evidence of use provided.

ASSESSMENT OF ACQUIRED DISTINCTIVENESS THROUGH USE

It must be proven that the sign indicated in the application is presently in use and has acquired distinctiveness through its use.

It must be proven that the sign's acquired distinctiveness relates to the same goods and/or services indicated in the application.

It must be proven that the sign is perceived as a trade mark in Turkey. Proof of acquired distinctiveness abroad is not sufficient.

The evidence submitted must relate to the relevant public for the goods and/or services covered by the mark. Unless these goods and/or services in question are, by their very nature, addressed to specialists or a limited public, the goods and/or services are considered as aimed at the general public. For example, products in Class 1 are generally aimed at specialists, while food and beverage products are available to all consumers.

The evidence must further demonstrate that a sufficiently large portion of the public is aware that the sign functions as a trade mark (even though its source may be unknown). It is not possible to require fixed percentages for evidentiary purposes as such requirements would effectively limit the available evidence to public opinion surveys. Instead, the examiner must evaluate the evidence provided and draw an inference regarding the recognition of the sign by the relevant public. Examiners must be prepared to accept opinion polls, surveys, statements from trade and consumer organizations, articles, brochures, samples, turnover and advertising/promotion figures, successful infringement prosecutions, previous trade mark registrations, etc.

Well-conducted opinion polls are particularly persuasive if the questions are relevant and not leading. This applies in particular to polls or surveys carried out by independent and well-recognized organizations or institutions.

Trade evidence

Evidence from independent trade associations, consumer organizations and competitors should also be given weight. Evidence from suppliers or distributors should, generally, be given less weight. The degree of independence of the latter will influence the probative value.

In all cases, the evidence should indicate when the use commenced. Evidence must relate to the period before the filing date. The greater the extent of use, the greater the evidentiary value.

Turnover and advertising

Figures for turnover or advertising should only relate to the goods or services in respect of which registration is sought. If the application is for "coffee" the figures supplied should not relate to "food". In order to provide a context for the assessment of such evidence, the applicant should give a general indication of the size of the relevant market. The turnover figures should be divided by year in order to indicate annual turnover.

Market share figures must relate to the sign claiming acquired distinctiveness. A company employing multiple trademarks in its product marketing should not submit total company

turnover figures. Figures related to the specific mark claiming acquired distinctiveness shall be attributed with greater probative value for the purpose of market share calculation.

Sales figures provided as evidences should indicate the product sales in relation to total market sales figures. A sequence table demonstrating the sales figures of other undertakings within the same market segment would be attributed with high probative value.

Evidence should show examples of how the mark is used (brochures, packaging etc). Use of a substantially different mark shall not be given much weight. In some cases, the evidence of use relates to a sign which is similar to that of the application yet distinctive nonetheless. Such evidence should be disregarded.

In other cases, the evidence shows use of the mark indicated in the application as part of a more complex sign, frequently associated with a "House Mark" or a more general identifier of the applicant. Such cases must be assessed in order to determine if they constitute use.

The duration of use in addition to the amount (volume) of use is of particular relevance. Thus, the evidence should show the commencement of use, unless this fact is immaterial because it is apparent that the use began long before the filing date. The evidence should also show that the use has been continuous or indicate reasons for apparent discontinuity.

Evidence that was collected after the filing date can only be accepted inasmuch as it proves that acquired distinctiveness already existed before said date. Evidence relating to the period after the filing date will be admitted but given less weight than evidence relating to the pre-filing period. The length of time that elapsed between the filing date and the date of the evidence, as well as the duration and intensity of use before the filing date must be taken into account. Thus, the shorter the time gap between the filing date and post-filing evidence period, the greater the probative value of the evidence. Evidence must be disregarded if it does not demonstrate any use before the filing date.

This information must be published along with the mark if the mark is accepted on the basis of Article 7(2).

6. GUARANTEE MARKS AND COLLECTIVE MARKS (Articles 54 et seq.)

6. 1. Guarantee mark (Art. 54)

A guarantee mark is a mark under the control of the proprietor of the mark, that serves the purpose of the guaranteeing the common characteristics of the products from different undertakings relating to production methods, geographical origin and quality.

6. 2. Collective Mark (Art. 55)

A collective mark is a mark used by a group of undertakings of producers or traders or providers of services. A collective mark serves the purpose of distinguishing the goods and services of the undertakings belonging to the group from the goods and services of the other undertakings.

Therefore the proprietor of a collective mark is a community of undertakings. Proprietors of a collective mark shall act collectively for the registration of a collective mark.

6.3 Statutes/Regulations of use for collective and guarantee marks (Art. 56)

When filing an application for registration of a guarantee or a collective mark, statutes specifying the ways and means of using the mark must be filed. The specific content of the statutes is regulated in Article 56. As results from Article 57 (2), not only amendments but also the content of the technical regulation filed initially has to be in accordance with public policy and principles of morality.

Imperatively the guarantee mark's statutes must contain provisions regarding the common characteristics of the goods and services under guarantee and supervision procedures as to the use of the mark and the penalties to be administered when necessary (Art.56 (2)).

The collective mark regulation must specify the undertakings authorised to use the mark (Art. 56 (2)).

6.4 Assessment of guarantee and collective marks

The statutes are to be filed as a part of the application.

The Institute examines whether the statutes satisfy the legal requirements for the content (Article 58). Any changes of the statutes have to be approved by the Institute.

Furthermore, applications for guarantee marks and collective marks will be subject to broadly the same procedure and conditions as for ordinary marks.

Substantive differences to the assessment of ordinary marks result from the special purpose of guarantee marks. Because the guarantee mark serves to guarantee the common characteristics of the products relating to production methods, geographical origin and quality under certain circumstances it may be possible to register a mark containing a designation which describes for example a production method or the geographical origin and represents the dominant element in the mark. Nevertheless the mark may not consist exclusively of a mere descriptive indication and be perceived by the trade circles as such. For example a word mark: "100 % pure nature wool" would be rejected because it represents a mere description. By contrast a word-/figurative mark 100 % pure nature wool, having the character of a logo or symbol and therefore of an (at least rudimentary) sign, can be registered as a guarantee mark, although the graphical configuration would not be sufficient to surpass the distinctiveness threshold for a usual mark.

However this cannot mean that the proprietor of a guarantee mark gets a monopoly on the descriptive indication. It has to be kept in mind that, pursuant to Article 12 TML, the proprietor of a mark cannot prevent third parties from using the descriptive indication in accordance with honest practices in industrial or commercial matters. Therefore in cases of collisions (between two guarantee marks as well as between a guarantee mark and an individual mark) it may not be sufficient to state a likelihood of confusion that the two marks match only in the descriptive element although this element often may be the striking element in a guarantee mark. The likelihood of confusion has to be assessed taking into account all relevant circumstances which should include the purpose of Article 12 and the specific function of the descriptive element of guaranteeing the common characteristics of the products (and not the origin of the products from a certain individual business establishment).

A guarantee mark can mislead the public in the sense of Article 7 (1) (f) if it gives the impression that it symbolizes a certification although the technical regulation does not guarantee that the certified quality standard will be surveyed by a neutral third person. This applies correspondingly if the mark gives the impression that the quality standard is surveyed by the state or public authorities.

The application might also mislead, if the technical regulation contains provisions which are contrary to the message or content of the mark. For example, if the technical regulation for the guarantee mark 100 % pure nature wool would provide just a percentage of 90 % pure

nature wool for the quality of the goods traded under the mark it would not be in accordance with the message of the sign which promises a level of 100%.

An opposition based upon a guarantee or collective mark can be raised within three years from the date of expiry of the guarantee or collective mark (Art. 8 (6)).

PART B EXAMINATION UPON REQUEST: INTER PARTES OPPOSITION PROCEEDINGS

1. OPPOSITION ON THE BASIS OF IDENTITY (Article 8 (1) (a))

1.1. Identity as a condition for the application of Article 8(1)(a)

Upon opposition by the proprietor of an earlier trade mark (registered or applied for), the trade mark applied for shall not be registered if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected (double identity, Art. 8 (1) a). There is no need for any likelihood of confusion to be established (ECJ C-291/00 – Arthur/Arthur et Félicie).

The relative bar to protection is identical with the absolute bar to protection provided in Article 7(1) (b) insofar as the provision requests identity. Therefore double identity can be assessed both ex officio and by opposition.

1.2. Identity of goods and services

For the examination of identity only the registered or applied content of the list of goods and services has to be considered while the actual or intended use of the goods and services not stipulated in the specification is not relevant.

The comparison of the goods and services must be based on the wording indicated in the respective specifications. In cases of doubt about the exact meaning of the terms used in the specification, these terms have to be interpreted both in the light of the Nice Classification and from a commercial perspective. In doubt the meaning under the Nice Classification prevails.

Where the specification of the earlier right includes a generic term that covers the goods or services of the contested application in their entirety, the goods and services will be identical, for example, if the earlier mark is registered for motorvehicles and the younger mark shall be registered for motorbikes.

An identity of goods is as well given, if the earlier mark is registered only for specific goods that are covered by a generic term used in the applied mark. For example if the earlier mark is registered for motorbikes and the mark applies for motorvehicles.

Furthermore, an interpretation of the wording of the supplementary specifications might be required to determine the scope of the goods and services of the two specifications. This is especially true where terms such as “in particular”, “namely”, or equivalents are used in order to show the relationship of an individual product with a broader category. The term “in particular” (or “for example”, “such as”, or other equivalent) indicates that the specific products are only examples of items included in the category, and that protection is not restricted to them. On the other hand, the term “namely” (or “exclusively” or other equivalent) is exclusive and restricts the scope of the registration only to the specifically listed goods.

1.3 Identity of the marks

The criterion of identity of the sign and the trade mark must be interpreted strictly. The very definition of identity implies that the two elements compared should be the same in all respects. There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.

However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question. Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer (ECJ C-291/00 (No. 50-53) – *Arthur/ Arthur et félice*).

Where double identity is found, the opposition shall be upheld on the basis of Article 8 (1) (a) and no further analysis of Article 8 (1) (b), in particular no assessment of the likelihood of confusion needs be done.

2. LIKELIHOOD OF CONFUSION (Article 8 (1) (b))

2.1. Introduction

The trademark applied for shall not be registered if because of its identity with or similarity to a trademark which has an earlier application date or a registered trademark and because of the identity or similarity of the goods and services covered by the trademarks there exists a likelihood of confusion on the part of the public, including the likelihood of association (Art. 8 (1) b)).

The similarity mentioned in Art. 8 (1) b) is not identical with what is called “confusingly similar” in Art. 7 (1) b). The term “confusingly similar” in Art. 7 (1) b) is narrower than the pure similarity mentioned in Art. 8 (1) b). Art. 7 (1) b) requires a high degree of similarity meanwhile in the sense of Art. 8 (1) b) also a low degree of similarity under certain circumstances might be sufficient. Therefore the lack of “confusingly similar” signs or products does not necessarily lead to the conclusion that the signs or products are not similar in the sense of Art. 8 (1) b).

Likelihood of confusion means the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings (ECJ C-39/97 (No. 29) – *Canon*).

This results from the essential function of the trade mark, which is to guarantee the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. To fulfill this function the mark must offer a guarantee that all the goods or services bearing it have originated under the control of a specific undertaking which is responsible for their quality (ECJ C-39/97 (No.28) – *Canon*).

2.2. Global assessment of the likelihood of confusion

The appreciation of the likelihood of confusion depends on numerous elements and, in particular, on the recognition of the trade mark on the market, on the association that the public might make between the two marks and the degree of similarity between the signs and the goods. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case (ECJ C-251/95 (No. 22) - Sabèl), with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect (ECJ C-342/97 (No. 26) – Lloyd Schuhfabrik). As a consequence a global assessment of the likelihood of confusion implies some interdependence between the relevant factors, in particular the similarity between the trade marks and between the goods or services covered. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa (ECJ C-342/97 (No. 19) - Lloyd).

2.3. Distinctive character

Marks with a high distinctiveness have a wider range of protection. Therefore the more distinctive the earlier mark, the greater will be the likelihood of confusion in terms of the law (ECJ C-251/95 (No. 24) - Sabèl).

Assessing the distinctiveness, account must be taken, in particular, of the inherent characteristics of the mark (ECJ C-342/97 (No.23) – Lloyd Schuhfabrik) 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;
- statements from chambers of commerce and industry or other trade and professional associations.

It follows that it is not possible to state in general terms, for example by referring to given percentages relating to the degree of recognition attained by the mark within the relevant section of the public, if a mark has a strong distinctive character (ECJ C-342/97 (No. 24) – Lloyd Schuhfabrik).

The inherent distinctive character of an earlier mark is examined ex officio by the Institute. On the opposite, the assessment of reputation is based, in principle, on matters of fact which it is for the parties to present. If the opposing party intends to rely on the fact that its mark is well known, it is required to put forward facts and, if necessary, evidence to enable the institute to determine the truth of such a claim (compare GC T-57/03 (No. 30, 32) – Hooligan). Usually prima-facie evidence will be sufficient. Documents will have to be presented in the original version or as a certified copy. Documents containing foreign languages additionally must be filed translated.

The relevant facts must concern the application date of the contested mark and include information about how intensive, geographically widespread and long-standing use of the mark has been or the amount invested by the undertaking in promoting them (compare GC T-8/03 (No. 71, 73) – Emilio Pucci / Emidio Tucci). To produce evidence for alleged reputation of the mark an opinion poll can be inter alia appropriate.

2.4. Similarity of goods and services

As said before the similarity mentioned in Art. 8 (1 b) is not identical with what is called “confusingly similar” in Art. 7 (1 b). Therefore there might be a similarity due to Art. 8 (1 b) between goods or services although they are not on the “declaration-list for confusingly similar goods and services” published by the PTE. For the rest the above mentioned principles (see 1.2 Identity of goods and services) apply.

The assessment of the similarity of the goods and services has to be made by the presumed expectations of an average consumer who is reasonably well-informed and reasonably observant and circumspect. Thereby all the relevant factors relating to the goods or services themselves have to be taken into account. Those factors include, inter alia (ECJ C-39/97 (No. 23, 28) – Canon):

- their origin from undertakings of the same industrial sector or line of business,
- their nature,
- their end users,
- the intended purpose,
- their method of use and
- whether they are in competition with each other or are complementary.

Further criteria are:

- the physical appearance,
- the sales channels used to reach the market,
- the presentation in the same section or shelf .

Because of the main function of a mark, which is to guarantee the identity of the origin of the marked product to the consumer or end user (ECJ C-39/97 (No. 28, 29) – Canon), one of the most important (or even the most important) factor will be the question whether the two goods or services derive usually or to a considerable extent from the same sort of business establishment.

The Nice Classification is not sufficient to decide whether the goods or services in question are similar or not. In particular the grading of the goods or services into the same class does not give an explicit answer whether there is a similarity or not. Nevertheless in some cases it might be helpful. For example if the goods and services belong to the same class and group (generic term) of the Nice Classification there will often be a similarity.

There can also be cases where goods are similar to services, but due to the unphysical appearance of services a similarity with physically present goods will only be found under certain circumstances. For example a similarity might be found between service “café” and the goods “pastry” or between the goods “printed publications” and the service “publication of books”.

The similarity of the goods and services has to be assessed irrespective of the signs or their distinctive character (ECJ C-16/06 (No. 67) – MOBILIX/ OBELIX). That means that assessing the similarity between for example apples and peaches will always lead to the same conclusion, as to say the same degree of similarity.

In the outcome of the assessment there can be a low, a medium or a high degree of similarity or no similarity at all. In the latter case the likelihood of confusion is automatically excluded so that the examination is finished.

By using these criteria courts came, for example, to the following conclusions:

- Clothing, shoes and hats are slightly similar with leather and leather articles (GC T-443/05 (No. 47) – PiraNAM/ PIRANHA).
- Perfumery products and leather goods within Class 18 are not similar (GC T-150/04 (No. 31) – TOSCA BLUE/TOSCA), because of different nature, purpose and method of use. Aesthetically complementary nature and marketing practice with vice versa granted licenses is not sufficient.
- Articles of glassware and wine are not similar goods (GC T-105/05 (No. 30-35) – WATERFORD STELLENBOSCH/ Waterford, confirmed by ECJ C-398/07 P).
- There is a low degree of similarity between, on the one hand, the marketing services – namely 'sole agencies, representation services, wholesaling, retailing, export, import; all the aforesaid relating to vinegars', in Class 35 – and, on the other hand, wine (GC T-138/09 (No. 40-44) – RÍOJAVÍNA/RÍOJA).

Example of a comparison (in brief outlines): Pastries vs. coffee (coffee beans or coffee grounds)

- Manufacturers:

cakes: pastry shops;

coffee: coffee roasters

(-)

- Nature, consistence:

cakes: bakery product made of flour, sugar, eggs, oil;

coffee: beans of coffee plants or grounds of such beans,

only occasional common ingredients where cakes have a coffee flavour

(-)

- Intended purpose:

Both goods belong to the category of luxury foodstuff or drinks, in which coffee serves as a stimulating drink (+) (but no exact match, only approximation)

- Complementary?:

Often consumed side by side (+)

- Distribution channels / shops:

Often sold side by side in bakeries, pastry shops, coffee shops (+)

(But note: weak criterion)

- Users:

Both goods are sold to broad circles of end consumers (+),

(But note: This is a very weak criterion which nearly can be disregarded when goods, like in the example, are intended for the end consumer, because totally different goods (like cars and food) are designated to the end consumer).

Conclusion: Low degree of similarity.

2.5. Similarity of signs

2.5.1 Overall impression

The similarity of the marks at issue must be assessed from the point of view of the average consumer by referring to the intrinsic qualities of the marks such as their visual, phonetic and conceptual impression and not to circumstances relating to the conduct of the person applying for a Community trade mark. The assessment must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of that likelihood of confusion. The average consumer, who is deemed to be reasonably well informed, reasonably observant and circumspect, normally perceives a mark as a whole and does not proceed to analyse its various details (ECJ C-254/09 P (No. 45, 46) - CK CREACIONNES KENNYA/ CK Calvin Klein; ECJ C-251/95 (No. 23) – Sabel). Experience shows that the similarities are more significant than the dissimilarities for the outcome of this evaluation, because consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question. Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer.

The similarity of trademarks should be based on the approach of the average consumer depending on the visual, aural, conceptual similarity of the trademarks; the intentions of the applicant shall not be a base in the assessment of the similarity of trademarks. The assessment of bad faith should have an independent content of the assessment of likelihood of confusion.

The Supreme Court has evaluated the necessity of not looking for a deficiency or intention in the assessment of likelihood of confusion in its decision number 2006/11-338 as follows:

“... It shall lead to the acceptance of the possibility that there is a likelihood of confusion if merely risk of confusion arises even if the applicant of a sign that uses all or a part of the elements in an earlier registered mark or marks, has no intention of such a result. The existence of likelihood of confusion does not necessarily require an intention or deficiency...”

In the examination of the similarity of trademarks, the similar elements in the trademarks shall have a priority in the assessment to the dissimilar elements.

In order to assess the degree of similarity between the marks concerned the degree of visual, aural or conceptual similarity between them has to be determined. In the light of the foregoing it is possible that a mere aural similarity between trade marks may create a likelihood of confusion (ECJ C-342/97 (No. 27, 28) - Lloyd Schuhfabrik).

However, it must be noted that the existence of such a likelihood must be established as part of a global assessment as regards the conceptual, visual and aural similarities between the signs at issue. In that regard, the assessment of any aural similarity is but one of the relevant factors for the purpose of that global assessment. There is not necessarily a likelihood of confusion each time that mere phonetic similarity between two signs is established. A global assessment means that conceptual and visual differences between two signs may counteract aural similarities between them, provided that at least one of those signs has, from the point of view of the relevant public, a clear and specific meaning, so that the public is capable of grasping it immediately (ECJ C-206/04 P (No. 21, 22) – ZİRH/SİR; ECJ C-361/04 (No. 20) – PİCARO/PİCASSO).

2.5.2 Word Marks

2.5.2.1 Phonetic comparison

Concerning the most goods and services the question of phonetic similarity has a high importance since goods and services often are offered and ordered orally in particular by telephone.

Recently the European General Court took into account that the purchase of certain goods like clothing involves a visual examination and obviously gave the aural similarity a minor status (“ ... In that regard, it must be pointed out that the degree of aural similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods.”, GC T-194/03 (No. 116) – Bainbridge, with further evidence, see also T- 57/03 (No. 66) – HOOLIGAN / OLLY GAN; T- 355/02 (No. 54, 55) – ZİHR/SİR). Even the usual purchase of the goods in question in self service markets effects, pursuant to the General Court, a minor importance of the phonetic similarity (GC T-106/06 (No. 48) – BAU HOW/BAUHAUS).

Although the assessment of any aural similarity is but one of the relevant factors for the purpose of the global assessment and there is not necessarily a likelihood of confusion each time that mere phonetic similarity between two signs is established (see above) the mentioned tendency of the General Court should be noticed and kept in mind but it should not be overvalued. Until now the European Court of Justice has not given a clear own statement to that tendency of the GC, but approved that part of the GC-decisions as factual findings not to be replaced by the ECJs own assessment for reasons of the procedure law (for example ECJ C-234/06 (No. 38-40) – Bainbridge). On the other hand at least in principle the ECJ expressively stated that the mere aural similarity between two trade marks may create a likelihood of confusion (ECJ C-347/97 (No. 28) – Lloyd Schuhfabrik; C-206/04 (No.21) – ZİHR/SİR).

In any case, it should be considered that there might be special circumstances on the Turkish market, for example a considerable part of illiterate end-consumers or consumers with few or no knowledge of foreign languages which may stand in the way of adopting the above mentioned tendency of the General Court, at least as it concerns mere word marks without any graphical addition. Even when goods like clothing are marketed primarily visually, there will be many cases of verbal offers or requests, for example when a customer asks for clothing with a special mark ("Do you have Levis jeans?") or in sales conversation, especially when they are held by telephone.

For the exercise of the phonetic comparison, the following phonetic rules should be observed:

- The average consumer will normally attach more attention to the first part of a word than to other parts (ECJ C-23/09 (No.43) – Ecoblue/BLUE). Especially typical endings are of minor effect for the phonetic character of a word. This does not apply where the beginning is descriptive or the accentuation of the word is at its end.

- Vowels and their order of appearance should be paid more attention than the consonants. Nevertheless a strong consonant at a noticeable position (for example “k” at the beginning of the word or a syllable thereof) can have considerable effect to the phonetic character of the word.
- Vowels or consonants can phonetically be related (for example “e” and “i”, “o” and “u”, “n” and “m”, ...), so that they cause only slight differences.
- Beside vowels and their order of appearance the apportionment of the word into syllables is an important criterion to determine its phonetic character. Nevertheless an additional and not accented syllable in the middle or ending of a word often cannot alter the phonetic character.
- Another phonetic criterion is the (same or differing) accentuation of the words.
- A further criterion can be the rhythm of pronunciation, which concerns the question whether a whole word or parts of it are pronounced in a quick or slow manner.
- Short words are affected to a greater extent by a phonetic dissimilarity than longer words. A clearly perceivable dissimilarity of only one phoneme may be able to eliminate any similarity between words consisting of only three or four letters. This applies also to marks consisting of mere letters or numerals. On the other hand dissimilarities between long words have a slighter effect to their phonetic character.
- Local accents are not to be taken into account concerning (nationwide) registered trademarks. Exceptions apply if a word clearly represents a term existing only in a regional dialect or is written contrary to the correct orthography in a way that even a consumer of other regions of Turkey is forced to pronounce it as a word in a certain dialect.
- When a sign contains foreign words, it should be assumed that the relevant public is either unfamiliar with that foreign language, or even if it understands the meaning in that foreign language, will still tend to pronounce it in accordance with the phonetic rules of their native language. Nevertheless as to a wide spread international language, like English, also a correct pronunciation by consumers with a certain education and professional specialists should be taken into account.

Example of a phonetic comparison (in brief outlines):

Mark applied for: Jupiter

Opposing mark: Jennifer

- Vowels and their order of appearance: u-i-e / e-i-e

Identical in the middle and at the end, but a clear difference at the important initial part of the words.

- Apportionment of syllables: Ju-pi-ter / Je-n(n)i-fer : Identical.
- Beginnings of the words: Initial phoneme (“j”): identical. Further identities at the beginnings cannot be ascertained.
- Accentuation: Jupiter / Jennifer: Identical.
- Rhythm of pronunciation: Identical: Quick pronunciation of all syllables of both words.

- Further special features of the case: The consonant “t” in “Jupiter” initiating the last syllable “ter” is a well perceivable hard consonant which gives the ending part of the word a relatively hard character while the opposing mark “Jennifer” is pronounced smoothly in its entirety. Nevertheless this difference does only appear at the ending part of the word which is normally perceived by the consumer with less attention.

Conclusion: Phonetic similarity between a low and a medium degree.

Remark: In a further step of the examination of the above mentioned example, it will be taken into account that the two words have a given meaning (a roman god and a planet / female first name) which may offset the stated degree of phonetic similarity.

2.5.2.2 Visual comparison

Also for word marks, the visual comparison plays an important role. In the case of word marks, the word as such is protected and not its written form. Therefore it is irrelevant whether word marks are represented in small or capital letters. The same applies to different letter-types, at least insofar as they are common in the relevant market. That means all forms of reproducing the word in the commercial practice, for example in the commercial correspondence, are to be taken into account. Normally this applies also to word marks with a graphically modified typeface except where an intense graphical modification hinders the average consumer to identify the word or is the only cause for the registrability of a (non-distinctive and/or descriptive) word.

Criteria for the visual assessment:

- For word marks, the visual comparison is based on an analysis of the number (word length) and sequence of the letters, the number of words and the structure of the signs.

- Also for the visual comparison it should be considered that the first part of a word and similarities or dissimilarities therein have more effect to the visual character of the word than the ending parts. Nevertheless the last letter has (relatively) more effect than a letter in the inner part of a word because the outer elements will be easier to perceive.

- Further particularities may be of relevance, such as the existence of special letters or accents that may be perceived as an indication of a specific language.

- Long words can rather be confused than short words. In trademarks consisting of two or three letters, the degree of similarity would be rather low, if one letter is different. Since abbreviations consisting of the initial letters of company names are commonly used in the market as trademarks, the average consumer encounters these kinds of trademarks often and is used to distinguish them from each other. For trademarks consisting of four or less letters one differing letter in the other mark can exclude the similarity.

- For word marks, the visual comparison often coincides with the phonetic comparison unless the word is not pronounced as it is written (for example if the word belongs to a foreign language). However it must be taken into account that the visual perception of the word allows a more precise, even a repeated perception in contrast to the brief phonetic perception. Therefore visual differences between the signs can have more effect than phonetic differences.

Example of a visual comparison:

Mark applied for: Magnum

Opposing mark: Macgun

- Word length: identical (6 letters in both words).
- First letter / initial part of the mark: identical (up to the second letter).
- Last letter: "m/n" or "M/N": not identical but similar letters.

Furthermore even the next to last letter "u"/"U" is identical. Therefore the visually easy to perceive initial and ending parts of the marks are (nearly) identical.

- Further aspects: Both marks contain the letter "g" in the middle of the word. Therefore in normal writing (first letter as capital letter, the rest as small letters) there is a descender (letter element downward) at nearly the same position. That means in normal writing the contour of the words is nearly identical.

Conclusion: High degree of visual similarity.

2.5.2.3. Conceptual comparison

A case in the European jurisdiction where a mere conceptual similarity was sufficient to create a likelihood of confusion is not known up to now. Nevertheless since the ECJ stated that a mere aural similarity between the marks may create a likelihood of confusion it has to be assumed that a mere conceptual similarity may create a likelihood of confusion too.

On the other hand the requirements for this specific form of similarity should not be attached on a low level because a mere conceptual similarity means that there are severe aural and visual dissimilarities between the marks which normally would exclude any likelihood of confusion.

- Therefore a (mere) conceptual similarity can only be ascertained if the marks represent synonyms ("Jenny/Jennifer") or nearly synonyms, for example "farmer/Rancher" (on the assumption that the average consumer will not realize the conceptual difference between these English words).

- It will be even more difficult to ascertain a conceptual similarity if one or even both of the words belong to a foreign language. The conceptual similarity will be reduced by the required translation or even excluded concerning consumers with less knowledge in the foreign language. Therefore a conceptual similarity can only be ascertained in case of common foreign words of a widespread foreign language (or common technical terms if special goods or services are concerned).

- A conceptual identity relating only to a descriptive word or part of the word is not sufficient. Indications which are not capable of protection cannot be the basis of a likelihood of confusion.

Example of marks with a conceptual similarity: "Slimquick / SLIM-FAST"

(because in addition to the identity of the descriptive elements "quick / fast" there are further conformities in the characteristic manner of composing an information "slim-quick/fast" contrary to the rules of the English language).

Examples of marks with insufficient conceptual similarity: "Duke / Lord"; "ESPADA / Sword"; "Cinque / No. 5".

2.5.2.4 Principle of "counteraction" / differing meanings

Contrary to the conceptual similarity a differing meaning can offset the phonetic and/or visual similarities of two words. A clear and specific meaning of one or even both words that can be grasped by the relevant public will help the consumer to perceive the phonetic and/or visual differences of the words.

It is established case law of the General Court of the European Union that such conceptional differences even can offset a given phonetic or visual similarity. Although a (for example) phonetic similarity alone can create a likelihood of confusion, it must be noted that the existence of such a likelihood must be established as part of a global assessment as regards the conceptual, visual and aural similarities between the signs at issue. That global assessment means that conceptual and visual differences between two signs may counteract aural similarities between them, provided that at least one of those signs has, from the point of view of the relevant public, a clear and specific meaning, so that the public is capable of grasping it immediately (ECJ C-206/04 (No. 21 - 23, 35) – ZIRH/SIR; C-361/04 (No. 20 – 25) – PICARO/PICASSO).

However this perception should not be exaggerated. Especially where the two marks show equally aural and visual similarities, the global assessment will often lead to a similarity although one or both marks have a specific meaning. Especially if the aural or visual similarity has an extent that may cause mishearing or misreading, and therefore leads to the other mark, the differing meaning cannot have any counteracting effect.

2.5.3 Similarity of figurative marks

Figurative marks can bear visual and/or conceptual similarities.

2.5.3.1 Visual similarities of figurative marks

- The same (or differing) motif has an essential importance for the question of visual similarity of figurative marks (applies to the conceptual similarity too).

Nevertheless a common motif alone never can be a sufficient reason to establish a similarity of figurative marks which may cause a likelihood of confusion. Further figurative similarities apart from the common motif are requested because a visual similarity hardly can be caused only by picturing the same motif. There are too many possibilities for the concrete manner of the graphical representation. Therefore:

- Further similarities concerning the graphical carrying out are required to constitute a visual similarity. Such (dis-) similarities may be found in the technique of designing or painting, the degree of abstractness or naturalness, further common or differing objects in the marks apart from the central motif, colours etc.

- A figurative mark which represents a popular motif with only low imaginative content will be easier to distinguish from a figurative mark which bears the same motif (cp. ECJ, C-251/95 (No. 25) - Sabèl). Slight differences between such marks can exclude a similarity because the public is used to pay attention to the differences.

- Figurative marks will even less than word marks be remembered by the public in all their particulars. The public will only remember an imperfect rough picture. Therefore the differences between two figurative marks must be noticeable to reduce or exclude a visual similarity.

- A figurative mark with a certain dominant design element will be similar to another mark bearing the same dominant element although in one of the marks there are additional but only accessory elements (for example frames, adornment or further decorative or typical promotional elements).

- A differing size of a design or picture is not a noticeable difference. The same applies for example to black-/white- or mirror-inverted representations of the same elements.

- Figurative marks with black-and-white-designs normally will not be altered noticeably by the same representation in colours.

On the other hand if the earlier mark is coloured it is a question of its scope of protection whether a black-and-white-representation or a representation in other colours still is in the range of a visual similarity because the earlier mark was applied for and registered only in certain colours. It should be considered whether the represented object apart from the colours is the essential part of the mark and whether it is distinctive or not.

2.5.3.2 Conceptual similarity of figurative marks

A conceptual similarity can only be ascertained when the public is expected to name the two representations with the same term. The restricting rules of the conceptual similarity of word marks (cp. above) apply to figurative marks too.

- The more general a common meaning of the marks is the fewer can be ascertained a conceptual similarity.

- The common motif has essential importance for the examination of the conceptual similarity.

- However a common motif that is descriptive cannot be the basis for a conceptual similarity. In such cases the protection of the older mark is limited to its concrete graphical representation.

- This applies also to motifs which are popular or often used in the field of the goods or services in question, for example pictures of crowns, hearts, stars, ... ("used up motifs"). Such motifs are not capable to indicate the origin of the goods or service from a specific enterprise. Insofar a mark has protection only for its special form of representation (ECJ C-251/95 (No. 25) – Sabèl concerning a figurative mark representing the silhouette of a jumping or running cat of prey for leather, goods made there from (bags) and clothing: "However ... where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion.").

2.5.3.3 Similarity between figurative and word marks

(Only) a conceptual similarity can exist between a figurative and a word mark. Nevertheless it has to be considered that there is a clear difference between these two categories of marks, which are normally perceived in different ways. The restricting rules of the conceptual similarity of word marks and figurative marks (see above) should be applied in an even more reluctant manner where a word mark collides with a figurative mark.

Therefore a (conceptual) similarity can only be ascertained in cases where the word is the obvious, direct and exhaustive denomination of the picture. The mere possibility to denominate the picture also with the word is not sufficient. This applies even more if the term in question has a broad or general meaning.

2.5.4 Similarity of composite signs and elements of composite signs (dominant element, independent distinctive role)

2.5.4.1 Introduction

In many cases marks collide which are composed of two or more elements (“composite sign”/ “complex sign”) and they only match in one of their elements. Generally this is not sufficient to ascertain a likelihood of confusion. The assessment of the similarity between two marks does not amount to taking into consideration only one component of a complex trade mark and comparing it with another mark (ECJ C-3/03 (No. 32) – Matratzen). On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (ECJ C-343/05 (No. 41) – Limoncello).

Although the relevant public does not tend to analyse a sign in detail when confronted by it according to experience the consumer pays more attention to the distinctive and dominant components of signs. The consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. Thus consumers do not clearly recollect all the details of the signs, but rather their more distinctive and dominant components. Therefore, the comparison of signs will always have to take into account whether some components are more distinctive and dominant than others are. This applies to both signs under comparison.

Therefore under certain circumstances the correspondance of composite signs in only one of their elements can be sufficient to ascertain a similarity that may lead to a likelihood of confusion, for example if the corresponding element is the dominant element of the mark(s).

2.5.4.2 Definition composite / complex sign

The ECJ did not define what is to be regarded as such a “composite sign”/ “complex sign” (ECJ C-342/97 (No.23) – Lloyd Schuhfabrik). This cannot depend on whether a sign is visually divided into different parts, but rather the perception of the sign by the relevant public is decisive. The relevant public often regards one-word-signs as composed of different elements, in particular, in cases where a part has a clear and evident meaning whereas the rest is meaningless, or where there are visual indications such as a dash or the use of different type sizes and / or typefaces. In such cases, the elements of one-word-signs could be regarded as “components” as mentioned by the Court. Nevertheless it is not appropriate to split up a sign artificially, that is, in those cases where it is not likely that the public will perceive the sign as composed of different elements.

2.5.4.3 Other elements of the mark

According to established case-law, in order to assess the similarity of two marks, it is necessary to consider each of the marks as a whole, although that does not rule out the possibility that the overall impression created in the mind of the relevant public by a complex trade mark may, in certain circumstances, be dominated by one or more of its components (ECJ C-3/03 No. 32 – MATRATZEN CONCORD / Hukla; ECJ C-254/09 (No. 56-57) – CK CALVIN KLEIN). However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (ECJ C-334/05 (No. 43) – Limoncello; ECJ C-254/09 (No. 56-57) – CK CALVIN KLEIN). If only one of the composite-signs is dominated by one of its elements meanwhile the other composite-sign does not have an identical/similar dominant component there cannot be a likelihood of confusion.

2.5.4.4. Dominant Elements

A dominant element is one on which the consumer concerned will to a very great extent focus his attention (ECJ C-254/09 (No. 57) – CK CALVIN KLEIN). Assessing the dominant role of the elements account must be taken of both lawful and factual aspects.

- The relevant public will generally not consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by the mark (GC T-385/03 (No. 44) - Biker Miles; GC T-169/02 (Nr. 34) - Negra Modelo). This applies also to word elements which are perceived in its generic meaning, for example the word “group” as designation of a group of companies (GC T-31/03 (No. 54) - Grupo SADA).

- Above all where the common descriptive element forms part of the earlier mark a likelihood of confusion can not be deduced from this element. Otherwise the owner of the earlier mark would be able to avoid unlawfully the bars to protection of Art. 7 (1) c) – e) by applying a composite mark consisting of descriptive and non-descriptive elements and basing his opposition only on the descriptive part which as such is not registrable. In such cases a likelihood of confusion is excluded by reasons of law.

- Analogous considerations apply to non-distinctive elements, which have a very general meaning for example suggesting a positive quality attributable to a large range of different goods or services like “special”, “vita” (GC T-356/02 (No. 52) – VITAKRAFT; GC T-312/03 (No.44) – SELENIUM-ACE).

- On the other hand elements which have a high distinctiveness, for example because of their imaginative character, will appear more likely to be kept in mind by the relevant public (GC T-6/01 (No. 43) – Matratzen) and therefore could be dominant.

- Elements may make an impression on consumers and be remembered by them because of their optical appearance, their position in the sign, their size or colour. Therefore a word, which appears optically exposed, for example in a bigger letter type, a noticeable colour or in a position above or before another word, is more likely to dominate the mark than the other word-element (cp. GC T-31/03 (No. 54) - Grupo SADA). Nevertheless the presence of such indicators does not automatically confer the character of a dominant element (cp. GC T-287/06 (No. 54 - 56) – Torre Albéniz).

- If the concrete combination of the words in a composite mark is the decisive factor of its distinctiveness, especially when they form a unique logical and conceptual unit (example: “Princess of Wales”), none of them will dominate the mark (GC T-287/06 (No. 55, 58, 59) – Torre Albéniz).

2.5.4.5 Marks containing word- and figurative elements

- Marks which have word- and picture-elements are phonetically often dominated by the word elements because words are often more suitable to designate the entire mark precisely than the picture element.

- Nevertheless there is no general rule that the word element of a complex mark is systematically dominant in the overall impression given by that mark (ECJ C-488/06 (No. 84) - Aire Limpio) and even if the word is dominant, the picture can not be disregarded in the overall view (ECJ C-343/05 (No. 41) – Limoncello). This applies especially where the word is descriptive. In such cases the figurative element will often dominate.

- Assessing the visual similarity the picture-elements can more often be dominant, because images, shapes and colours might be so significant that even distinctive words can recede and be subsidiary in relation to the figurative element (ECJ C-498/07 (No. 65) - ACEITE DE OLIVA).

2.5.4.6 Marks consisting of names

- If a mark consists of a first name and a surname the surname often has a more distinctive character than the forename. Therefore in the case law of the General Court the surname was often given a dominant character (for example GC T-11/09 (No. 34) - James Jones/JACK & JONES; GC T-259/06 (No. 34) - MANSO DE VELASCO/VELASCO; GC T-40/03 (No. 63-65) - Julián Murúa Entrena/MURÚA).

- Nevertheless it must be held that, in a composite mark, a surname does not retain a dominant or independent distinctive role in every case solely because it will be perceived as a surname. The finding with respect to such a role may be based only on an examination of all the relevant factors of each case, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. Account must also be taken of whether the person is well known, since that factor may obviously influence the perception of the mark by the relevant public (ECJ C-51/09 (No. 36-38) - BARBARA BECKER).

2.5.4.7 Independent distinctive role

Beside or instead of signs with dominant elements there might also be elements with an independent distinctive role in marks consisting of more than one element. Similarity in such independent elements might also lead to a likelihood of confusion.

For example it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of that third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element therein (ECJ C-120/04 (No. 30-31) - Thomson Life).

For example:

Earlier mark: LIFE

Younger mark: THOMSON LIFE (name of the company: "Thomson")

In such case, there is no dominant component in the composite sign "THOMSON LIFE" nevertheless the overall impression produced by this mark, which contains the name of the manufacturer ("Thomson") and the same word as the older mark ("LIFE") may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established (ECJ C-120/04 (No. 30-31) - Thomson Life).

Furthermore an element might have an independent role if the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known because the overall impression would be, most often, dominated by the widely-known mark included in the composite sign. It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark (ECJ C-120/04 (No. 34) - Thomson Life).

For example:

Earlier mark (not widely known): METRO

Later mark (with the widely known mark "ülker" as an element): ülker METRO

Beyond the above mentioned decision the General Court ascertained a likelihood of confusion between the earlier mark “SPA” and the younger mark “SPA THERAPY”, both dealing with cosmetic products, because of the independent distinctive role of the component “SPA” as being the first element within the composite mark “SPA THERAPY” although in this case “SPA” was neither found to be a widely-known mark nor the dominant element nor the name of the manufacturer. As sub-marks are usual on the field of cosmetics the court concluded that the consumer might get the impression that the younger sign “SPA THERAPY” is a sub-mark (GC T-109/07 (No. 22, 31-33) – SPA THERAPY).

If in the outcome of the assessment it can be concluded that the public will not confuse the marks but only the commercial origin of the goods identified by the signs or that the public may believe that the goods or services at issue derive from companies which are linked economically, a likelihood of association should be stated (see below) or the question can be left open with the statement that at the very least the public will confuse the commercial origin of the goods or services or may believe that they derive from companies, which are linked economically (so did the ECJ in the “THOMSON LIFE”-case).

2.6. Likelihood of association (Art. 8 (1) b), last sub-clause)

A Likelihood of association mentioned at the end of Art. 8 (1) b) is not designed as an alternative to the likelihood of confusion, but serves, as follows from the wording, to define its scope. Therefore it applies only if, by reason of the identity or similarity both of the marks and of the goods or services, which they designate, there exists a likelihood of confusion on the part of the public because of the association with the earlier trademark. The terms of the provision itself exclude its application where there is no likelihood of confusion on the part of the public (ECJ C-251/95 (No. 18) – Sabèl).

A likelihood of association is stated when the younger mark is noticeable different from the earlier mark, that is to say it will be perceived by the consumer as a different sign, but there is a danger that the younger mark is allocated to the proprietor of the earlier mark or, as the case may be, the consumer believes that the proprietors of both marks are linked economically. This might be the case where, for example, the younger mark is allocated by the consumer to a “series” or “family” of the proprietor of the earlier mark or if, due to the specific circumstances on the market sector, the younger mark is held as a sub-brand of the latter.

When there is a “family” or a “series” of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for and considers erroneously that the trade mark is part of that family or series of marks (ECJ C-234/06 (No. 63) – Bainbridge; GC-T-287/06 (No. 80) – Torre Albéniz).

There can be said to be a “series” or a “family” of marks when either those earlier marks reproduce in full the same distinctive element with the addition of a graphic or word element differentiating them from each other, or when they are characterised by the repetition of the same prefix or suffix taken from an original mark (GC T-194/03 (No. 123) - BAINBRIDGE). In such circumstances, a likelihood of confusion may be created by the possibility of association between the trade mark applied for and the earlier marks forming part of the series where the trade mark applied for displays such similarities to those marks as might lead the consumer to believe that it forms part of that same series and therefore that the goods covered by it have the same commercial origin as those covered by the earlier marks, or a related origin. Such a likelihood of association between the trade mark applied for and the earlier marks in a series, which could give rise to confusion as to the commercial origin of the goods identified by the signs at issue, may exist even where the comparison between the trade mark applied for and the earlier marks, each taken individually, does not prove the existence of a likelihood of direct confusion (GC T-194/03 (No. 124) - BAINBRIDGE).

However, according to the above case-law, the likelihood of confusion attaching to the existence of a family of earlier marks can be pleaded only if both of two conditions are satisfied:

- First, the earlier marks forming part of the “family” or “series” must be present on the market.

No consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly there will only be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a “family” or “series”, if the earlier trade marks which are part of that “family” or “series” are present on the market (ECJ C-234/06 (No. 64) – Bainbridge).

- Secondly, the trade mark applied for must not only be similar to the marks belonging to the series, but also display characteristics capable of associating it with the series.

That might be the case where the marks reproduce in full the same distinctive element with the addition of a graphic or word element differentiating them from each other, or when they are characterized by the repetition of the same prefix or suffix taken from an original mark (GC T-194/03 (No. 123) - BAINBRIDGE; GC T-287/06 (No. 80) – Torre Albéniz)

On the other hand that might not be the case, for example, where the element common to the earlier serial marks is used in the trade mark applied for either in a different position from that in which it usually appears in the marks belonging to the series or with a different semantic content (GC T-287/06 (No. 81) – Torre Albéniz).

3. UNAUTHORISED FILING BY AGENTS - ARTICLE 8(2)

3.1. PRELIMINARY REMARKS

The purpose of Article 8(2) is to safeguard the legitimate interests of trade mark owners against the arbitrary appropriation of their trade marks, by granting them the right to prohibit registrations by agents or representatives that are applied for without their consent. Article 8(2) is a manifestation of the principle that commercial transactions must be conducted in good faith. Article 8(2) has its origin in Article 6septies of the Paris Convention which was introduced into the Convention by the Revision Conference of Lisbon in 1958.

3.2. ENTITLEMENT OF THE OPPONENT

The right to file an opposition on the grounds of Article 8(2) is reserved only for the proprietors of the earlier trade marks. Contrary to opposition based on 8(1), which can also be filed by licensee, only the proprietor is entitled.

If the opponent fails to prove that he was the rightful owner of the mark when the opposition was filed, the opposition will be dismissed without any examination of its merits. The current proprietor may also invoke the rights of his predecessor in title, if the agency/representation agreement was concluded between the previous owner and the applicant.

3.3. SCOPE OF APPLICATION

3.3.1. Kinds of marks covered

In the absence of any restriction in Article 8(2) and in view of the need to provide effective protection to the legitimate interests of the real owner, the term “trade marks” should be interpreted broadly and must be understood as also encompassing pending applications, since there is nothing in this provision restricting its scope exclusively to registered trade marks.

For the same reasons unregistered marks or well-known marks within the meaning of Article 6bis of the Paris Convention¹ also fall within the term “trade marks” in Article 8 (2). Consequently, both registered and unregistered trade marks are covered by this provision, to the extent of course that the law of the country of origin recognises rights of the latter kind. In contrast, the express reference to “trade marks” means that Article 8(3) does not apply to mere signs used in the course of trade, other than unregistered trade marks.

3.3.2. Origin of the earlier mark

In the absence of any other reference in Article 8(2) to a “relevant territory”, it is immaterial whether the earlier trade mark rights reside in Turkey or not. The practical importance of this provision lies precisely in the legal capacity it confers on holders of trade mark rights outside the Community to defend these rights against fraudulent filings, since owners of trade mark rights within the Community may rely on the rest of the grounds provided for in Article 8 to defend their earlier rights from such acts.

3.4. CONDITIONS OF APPLICATION

3.4.1. Agent or representative relationship

In view of the purpose of this provision, which is to safeguard the legal interests of trade mark owners against the misappropriation of their trade marks by their commercial associates, the terms “agent” and “representative” should be interpreted broadly to cover all kinds of relationships based on some contractual arrangement where the one party is representing the interests of another, regardless of the nomen juris of the contractual relationship between the principal-proprietor and the applicant.

Thus, it is sufficient for the purposes of Article 8(2) that there is some agreement of commercial co-operation between the parties of a kind that gives rise to a fiduciary relationship by imposing on the applicant, whether expressly or implicitly, a general duty of trust and loyalty as regards the interests of the trade mark owner. It follows that Article 8(2) may also extend, for example, to licensees of the owner, or to authorised distributors of the goods for which the mark in question is used.

Given the variety of forms that commercial relationships may acquire in practice, a case-by-case approach is applied, focusing on whether the contractual link between the owner-opponent and the applicant is only limited to a series of occasional transactions, or if, conversely, it is of such a duration and content that could justify the application of Article 8(2).

3.4.2. Form of the agreement

It is not necessary that the agreement between the parties assumes the form of a written contract. Of course, the existence of a formal agreement between the parties will be of great value in determining exactly what kind of relationship exists between the parties. As mentioned above, the title of such an agreement and the terminology chosen by the parties should not be taken as conclusive. What counts is the kind of commercial co-operation established in substance and not its formal description.

Even though the letter of Article 8(3) does not make any reference to the territorial scope of the agreement between the trade mark proprietor and his agent or representative, an inherent limitation to relationships covering Turkey must be read in this provision (?).

The agent-representative relationship must have been established prior to the filing date of the CTM application. Therefore, it is immaterial whether after that time the applicant entered negotiations with the opponent, or made unilateral proposals with the purpose of becoming a representative or agent of the latter.

3.4.3. Application in the agent's name

According to Article 8(2) CTMR, the trade mark applied for shall not be registered where the agent or representative applies for registration thereof in his own name. It will usually be easy to assess whether this requirement has been fulfilled, by comparing the name of the applicant with that of the person appearing in the evidence as the agent or representative of the owner.

However, there may be cases where the agent or representative will try to circumvent this provision by arranging for the application to be filed by a third person, whom he either controls, or with whom he has entered into some form of understanding to that effect. In such cases it is justified to adopt a more flexible approach. Thus, if it is clear that because of the nature of the relationship between the person filing the application and the agent, the situation is effectively the same as if the application had been filed by the agent himself, it is still possible to apply Article 8(2), notwithstanding the apparent discrepancy between the applicant's name and the name of the owner's agent.

Such a case could arise if the application is filed not in the name of the agent's company, but in the name of a natural person that shares the same economic interests as the agent, as for example its president, vicepresident or legal representative. Given that in this case the agent or representative could still benefit from such a filing, it should be considered that the natural person is bound by the same limitations as the company.

3.4.4. Application without the owner's consent

Even though the absence of the proprietor's consent is a necessary condition for the application of Article 8(2), the opponent does not have to submit evidence which shows that the agent was not permitted to file the TM application. A mere statement that the filing was made without his consent is generally sufficient. This is because the opponent cannot be expected to prove a "negative" fact, such as the absence of consent. In these cases the burden of proof is reversed and it is up to the applicant to prove that the filing was authorised, or to give some other justification for his acts.

Even if there are indirect indications and evidence pointing to an implied consent, any ambiguity or doubt should be interpreted in favour of the opponent, as it will usually be quite difficult to assess whether such a consent is sufficiently clear and unequivocal.

3.4.5. Absence of justification on the part of the applicant

The applicant may invoke any other kind of circumstance showing that he was justified to file the application in his own name. However, in the absence of evidence of direct consent only exceptional reasons are accepted as valid justifications, in view of the need to avoid a violation of the owner's legitimate interests without sufficient indications that his intention was to allow the agent to file the application in his own name. For example, it could be possible to infer that the owner has tacitly consented to the filing of the application if he does not react within a reasonable period of time after having been informed by the applicant that he intends to apply for a TM in his own name. However, even in such a case it will not be possible to assume that the application has been authorised by the owner if the agent had not made sufficiently clear to him in advance in whose name he would file the application.

Another case of valid justification could be if the proprietor causes his agent to believe that he has abandoned the mark, or that he is not interested in obtaining or maintaining any rights in the territory concerned, for example by suspending the use of the mark over a relatively long period of time.

The fact that the proprietor does not want to spend money on a registration of his trade mark, does not give the agent a right to act on his own initiative, as the proprietor might still have an interest in using his trade mark in the territory although it is not registered. Such a business decision cannot be taken in itself as a sign that the owner has given up the rights in his mark.

Justifications exclusively linked to applicant's economic interests, such as the need to protect his investment in setting up a local distribution network and promoting the mark in the relevant territory, cannot be considered valid for the purposes of Article 8(2). Nor can the applicant successfully argue in his defence that he is entitled to some financial remuneration for his efforts and expenditure in building-up goodwill for the mark.

3.4.6. Applicability beyond identical signs - goods and services

Article 8(2) provides that a TM application will not be registered where "an agent or representative of the proprietor of the mark applies for registration thereof in his own name". Such an explicit reference to the principal's trade mark gives the *prima facie* impression that the TM applied for must be the same as the earlier mark.

It should also be noted that the text Article 8(2) does not make any reference to the goods and services for which the application has been filed and for which the earlier mark is protected, giving thus no guidance as to what the exact relationship between the respective goods and services should be for it to apply.

However, applying Article 8(2) exclusively to identical marks for identical goods or services would render this provision largely ineffective, as it would allow the applicant to escape its consequences by merely importing slight modifications either to the earlier mark or to the specification of goods and services. In such a case, the interests of the owner would be seriously prejudiced, especially if the earlier mark is already in use and the variations made by the applicant are not significant enough to rule out confusion. What is more, if the application is allowed to proceed to registration despite its similarity to the earlier mark, the applicant will be in a position to prevent any subsequent registration and/or use of the earlier mark by the original proprietor.

Thus, in view of the necessity to effectively protect the legitimate proprietor against unfair practices by his representatives, a restrictive interpretation of Article 8(2) must be avoided. Article 8(2) must therefore be applied not only where the respective signs are identical, but also where the sign applied for by the representative or agent essentially reproduces the earlier mark with slight modifications, additions or deletions, which do not substantially affect its distinctiveness.

4. OPPOSITION BASED ON UNREGISTERED MARKS OR SIGNS USED IN THE COURSE OF TRADE – Article 8 (3)

Upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade, the trademark applied for shall not be registered provided that:

- a) the rights to the sign were acquired prior to the date of application for registration of the trademark, or the date of priority claimed for the application for registration;
- b) the sign in question confers on its proprietor the right to prohibit the use of a later mark.

The right to prohibit to which Article 8 (3) (b) refers to is to be found in Article 57 of the Turkish Commercial Code which states: “To attempt to create imitations by means of the commodities, products, activities or commercial enterprise owned by others or resorting to measures to facilitate it, especially to use the name. Commercial, title, trademark, mark or other promotional means fairly used by others or to sell the commodities which cause imitation either knowingly or not knowingly or to possess the same due to whatsoever reason other than personal use shall be considered as the actions not compliant with the principles of good will.”

4. 1. SIGNS WITHIN THE SCOPE OF ARTICLE 8(3)

4.1.1. Unregistered Marks:

Unregistered marks shall be those which are considered ‘in use’ under trademark law but have not been registered pursuant to the Decree Law 556. According to trademark law, ‘use’ requires that the sign appears on the good or package, or along with the service provided.

4.1.2. Sign Used in the course of trade:

The indication “another sign used in the course of trade” refers to all the signs that are protected by unfair competition regulations but are not offered protection as industrial or intellectual property rights. Signs used in commerce in relation to copyright works, computer software, etc., benefit from protection under Article 8(3). However, trade titles, company names, domain names, etc. are not protected under copyright law.

Trade Titles

Pursuant to Article 41 of the Turkish Trade Law, a “trade title is the name used by a merchant in relation to the businesses and activities concerning his commercial undertaking.” Trademarks establish the relationship between goods/services and undertakings enabling the distinction between similar goods produced by different undertakings. Trade titles represent the undertaking itself. The right to use a trade title that is registered and published according to law and procedure belongs to the proprietor/merchant as a monopoly right. Turkish trade titles can be registered by natural or legal persons at the registration Office. The monopoly right on its own, obtained through the registration of a trade title shall not provide the title holder with a right to oppose the registration of a mark under Article 8(3). The title must also be used in trade. The General Assembly of Civil Chambers has clearly articulated the prerequisite of *use in commerce* through its interpretation of Article 8(3) in the MNG decision (date 27/02/2002 nr. E. 2002/11-62, K. 2002/115); “...the fact that the plaintiff used a sign with some distinctive words in his title is not sufficient for granting the plaintiff protection under the law of unfair competition. The unregistered sign should be ‘used in commerce’ in order for the plaintiff’s right of objection to be valid.”

Article 8 of the Paris Convention includes the statement that “The trade title... shall be protected without any obligation of registration or resignation in all Member States”. This provision must be interpreted in light of Article 2 of the same Convention. Therefore, unregistered Turkish trade titles that are used in commerce shall benefit from protection against unfair competition under Article 8(3).

Copyright works, computer software, etc.

Works protected under copyright law shall be evaluated within the scope of Article 8(5) due to an open regulation in the provision. Signs which are not the object of a copyright may obtain protection under Article 8(3) provided that they fulfill additional requirements. Such signs must be used in commerce and not result in a likelihood of confusion in relation to an earlier mark.

Domain Names

Oppositions based solely on domain names rarely occur in practice. Domain names are often accompanied by a trade title or a company name. In such cases, the opponent can demonstrate that the domain name is used in relation to the trade title rather than it being the sole basis for the opposition. However, theoretically, a registered domain name that is used in commerce, even if it does not directly represent a trade title, can obtain protection under Article 57(5) of the Turkish Trade Law and may for a basis form opposition under Article 8(3).

4.2. OPPOSITION REQUIREMENTS

The validity of an opposition based upon Article 8(3), also known as ‘the right to oppose based on the grounds of prior use’, is dependent on the fulfillment of certain conditions.

4.2.1. Use in Commerce

TPI practice and decisions stipulate that the sign must be used in commerce in order to benefit from the right to an opposition under Article 8(3). The 11th Civil Chamber of the Supreme Court stated in its GRIN NICCI decision number (E. 1998/5372, K. 1999/256) that, “...The right to oppose the registration of a later mark has been enabled by the Article 8(3) of the Decree Law, even if an earlier sign or mark is unregistered, provided that it has already been used in commerce...”. The Assembly of Civil Chambers has clearly defined the prerequisite of use in its abovementioned MNG decision (page 2).

The inclusion of the statement “an unregistered mark or another sign used in commerce” in article 8(3) of the Decree Law indicates that both signs used according to trademark law (as an unregistered mark) and signs used in commerce, whether in business documents, advertisements and/or promotion, etc., may form the grounds of an opposition under Article 8(3). In this case, it is necessary to establish a “likelihood of confusion”. An opposition based on an unregistered sign under trademark law claiming likelihood of confusion is more common. However, it is also possible, though less likely, to establish a likelihood of confusion on the basis of a sign used in trade. The establishment of a likelihood of confusion increases through regular and intensive use and/or reputation.

4.2.2. Similarity between an Unregistered Mark or Sign Used in Trade and the Application for Registration

A further prerequisite to a valid opposition under Article 8(3) is the close similarity or identity between the unregistered mark, or sign used in trade, and the trademark application. However, it should be mentioned that there is a negative correlation between the distinctiveness/reputation of the unregistered sign and the requisite level of similarity.

4.2.3. Similarity between Goods and/or Services

An opposition based on use in commerce may be accepted for the identical and/or similar goods and/or services related to the prior sign used in trade. Although no such provision exists in the Article, the admissibility of an opposition based on an unregistered mark or a sign used in commerce is appropriate. Likelihood of confusion is assessed according to the individual character (originality) of the marks in question and can result in the refusal of the application in relation to goods and/or services of a similar nature.

4.2.4. Establishing the priority of an unregistered mark

This prerequisite is stated in Article 8(3)(a) of the Decree Law 556. The right to a sign forming the basis of an opposition should be acquired before the application date or priority date of the contested mark. Article 15(2) of Mülga Trademark Law 551 requires “active formation and offset”, and that the mark is “recognized by the market” in order to establish a right through first use. Although the requirement for the mark to be “recognized by the market” is not mentioned in the Decree Law 556, it shall be accepted that it is implied by Article 8(3). In order for an unregistered sign to obtain protection, it must have acquired economic value through use that is worthy of legal protection. This is only possible through the mark’s achievement of a “minimum level of reputation”. A minimum level of reputation can be established by consumer awareness of the sign through use in a specific place, territory or market.

The same practice applies to foreign unregistered marks or signs used in trade. A mark or sign that is not registered in Turkey may also be protected by virtue of this provision assuming that it meets the enumerated requirements. However, according to the principle of territoriality, a right acquired in another country cannot be claimed in Turkey. Thus, it is not possible to provide protection under Article 8(3) for marks or signs based on foreign registration. The claimed right must have been acquired in Turkey.

The Re-Examination and Re-Evaluation Board emphasized the principle of territoriality in decision 2008-M-742 by stating that, “the principle of territoriality for the purposes of registering, protecting, developing, or acquiring trademarks must be assessed individually.” Thus, trademarks shall be protected within the territory where they are registered. Consequently, unregistered marks or signs used in commerce that form the basis of a registration opposition must have been acquired and used in Turkey. Rights acquired in other jurisdictions are not valid in Turkey in accordance to the principle of territoriality under international intellectual property law.

According to Article 6(1) of Paris Convention, the application and registration conditions for a trademark shall be specified by the internal law of each country. Pursuant to Paragraph 3 of the same Article, a trademark registered in one of the Member States shall be accepted as independent from the marks that are registered in any other Member States, including the country of origin. Thus, it is a result of principle of territoriality that the trademark “CARLO PAZOLINI” is currently registered in different countries by different right holders. However, a right holder can only seek protection in the territory where the right is registered. In their explanation of the territoriality principle, Yasaman and Yusufoğlu state that “Italian or other foreign right holders of the trademark ‘CARLO PAZOLINI’ do not possess a valid right under Turkish trademark law” (Trademark Law, page 4).

4.3. EVIDENCE AND PROOF OF USE

Opponents may submit various forms evidence to support their claims. Various forms of evidence effectively demonstrating the use of a sign on the packages or goods, or in relation to the provision of services by means of catalogues, invoices, documents, photographs, newspaper and magazine articles, various promotional media (brochures, calendars, advertisement, TV commercial etc.), trade register entries, commercial correspondence, etc., may be submitted for the purpose of establishing commercial use. The evaluation may attribute varying probative value to the different forms of evidence. Evidence in the form of legal documentation establishing dates, such as invoices, is deemed to have a higher

probative value. However, other forms of evidence furnished by the claimant, such as catalogues or calendars, may not be sufficient for establishing proof of use.

By stating that, "... the opposition is admissible because the title Mine Halı Tic. ve San. Koll Şti has been effectively used by the opponent as evidenced by documents such as sales figures, invoices, correspondences with the Ministry of Transportation Directorate of İzmir Telsiz Territory, and sales contracts that have been submitted in the opposition appendix" the Re-Examination and Re-Evaluation Board, in decision 2007-M-7733, provided a list of acceptable forms of evidence for establishing proof of use.

5. TRADE MARKS WITH REPUTATION – ARTICLE 8 (4)

According to the provision of Article 8(4) which sets out the requisites for the protection of well known trademarks in view of applications for different goods and services, such application shall be refused if the earlier trade mark has reached a certain level of notoriety in the public and if the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to the distinctive character or repute of the registered trade mark.

In the examination of an opposition based on Article 8(4) TML, an assessment in the following order should be made:

- Whether there is an application for registration or registration of the trademark in Turkey.
- Whether there is similarity, which may lead to a likelihood of confusion including the possibility of association, between the opposed application and the trademark on which the opposition is based.
- Whether the trademark, on which the opposition is based, is known in Turkey.
- Whether there will be an unfair profit because of the level of notoriety.
- Whether the use of the trade mark applied for may bring discredit to the mark.
- Whether the trade mark applied for may result in harming the distinctive character of the well known mark.

In case any of the first 3 bullet points mentioned above is not fulfilled, it is not necessary to assess the following. On the other hand, in case the first three bullet points are fulfilled, then the existence of one of the last 3 bullet points shall be sufficient.

However, it shall not be considered that there will be an unfair profit only because of the notoriety of the mark or that the registration may bring discredit to the mark or the distinctive character will be harmed, solely because of the use of the well known mark on different goods and services. The must prove that the above mentioned conditions apply in the individual case. The condition that the trademark should be known in the country, where protection is sought, is just one of the necessary conditions for the well known trademark to be protected against different goods or services.

As the 11th Civil Chamber of the Supreme Court stated in the MERİDİEN decision (11th civil chamber, 18.06.2007, E. 2007/5927, K. 2007/9302 "Meridyen Bilişim + Figure"): if the evaluation concerning the individual case is based exclusively on the condition of the notorious character, the assessment is deemed to be inadequate. For the protection to be granted, the existence of the other conditions shall be sought and once the decision on the notoriety is granted, the other conditions should be evaluated. Consequently, to accept the notoriety in the country for the protection of different goods and services as the only condition is not a proper approach to the wording and purpose of the provisions, which shape the

protection of the well known marks for different goods and services (see also Re-Examination and Re-Evaluation Board with the decision 2007-M-3621).

The protection provided by Article 8(4) – although the wording only refers to dissimilar goods and services - also applies vis-à-vis similar goods.

5.1. Obtaining an Unfair Advantage

An unfair advantage may be obtained by benefiting of the potential and high commercial value of the well known trademark. Consumers may easily prefer such products, thinking that the products with the well known trademark were produced with the help, the sponsorship or with the license given by the proprietor of the well known trademark and with the technology owned by the well known trademark owner. In the judgments of Supreme Court 11th Civil Chamber on Advantage (11. HD, 14.02.2006, E. 2005/1385, K. 2006/1426) and Intel (11. HD, 07.03.2005, E. 2005/1513, K. 2005/2080), it was found that there was an intention to obtain unfair profit by riding on the coattails of the notoriety of the trademark.

Furthermore, as stated above, the use of the trademark on different goods and services shall not necessarily mean that such use would imply obtaining an unfair profit from the notoriety of the trademark. As mentioned in the judgment of 11th Civil Chamber, 2006, MAGGI, it must be proven that there is a possibility of harm to the proprietor's interests due to the use in different goods and services and a connection is established between the well known trademark and the latter trademark by the consumer because of the use (11. HD, 25.04.2006, E. 2005/2196, K. 2006/4611).

Bad faith is not stated among the prerequisites of the article 8 (4) of the Decree Law. However during the examination of the opposition, in case there is obvious proof of actions in bad faith, it may be concluded that the applicant is in intention to obtain an unfair profit. If the applicant lodges an application for a trademark which is substantially similar or identical to the well known trademark, without any valid reason, it may be interpreted as a proof showing the bad faith consisting in the intention to obtain an unfair profit from the well known trademark's distinctive character.

5.2. Causing Detriment to the Reputation of the Trademark

The use of the well known trademark in an identical or similar way on different goods and or services may be detrimental to the well known trademark. These situations may be categorized as follows: The use of the trademark in low quality goods, the use of trademark in the goods that contrast with the image of the well know marks, the use of the trademark in a way, which may result in establishment of undesired connections and the use of trademark in a defaming manner.

The use of the well known trademark in low quality goods may discredit the trademark. If the consumer cannot find the high quality that the well known trademark has, in the goods that the latter trademark is being used, a connection may be established between two trademarks. In such case, the consumers would turn away from the products of the well know trademark.

The use of the well known trademark on goods contrasting the image it has in the public's mind can also bring discredit to the trademark (see the Case R 283/1999-3; Hollywood S.A.S v. Souza Cruz S.A; 25.04.2001, decided by OHIM's Board of Appeal concerning Chewing gums on the one side and Tobacco on the other side).

The use of the trademark in a defamatory manner may also cause harm to the well known trademark by affecting its prestige (e.g. "Enjoy Cocain" with the reason that it may bring discredit to the trademark due to its resemblance of the trademark "Enjoy Coca Cola").

5.3. Harming the Distinctive Character of the Trademark

Harming the distinctive character of the trademark refers to the decrease in the distinctiveness of the trademark due to the existence of various similar trademarks, belonging to different companies, on the market. The fact that the trademark is being used on different goods and services shall not automatically mean that there will be harm to the distinctiveness of the well known mark.

However, the higher the distinctiveness of the earlier trademark, the easier it is to accept that there will be harm to the distinctiveness of the well known trademark (see YIDK in its Roman, Koza İpek and Apple decisions (YİDK'nın 2010-M-1167 Roman, 2010-M-1091 sayılı Koza İpek, 2009-M-6116 sayılı Apple kararları).

In examining the potential harm to the distinctive character of the well known trade mark, the fact that this trademark is currently in use by different enterprises may be taken into account as an indication that the owner of the trademark is not concerned about the consumers relating the trademark only with its own commercial origin.

5.4. Proof of the prerequisites

In principle, the opponent is responsible for proving his claim. In the present case, the opponent must prove that in case the trademark applied for is registered, it would gain an unfair profit due to his own trademark or result in harming the prestige or distinctive character of his own well known trademark. The opponent may not rely on the potential occurrence of such effect (see: Supreme Court Meridien, Bizim and Uni judgments, ECJC Intel judgment and TPE YIDK “tamek gurme” judgment).

Depending on the type of damage or unfair profit claimed, the opponent may argue his claims based on various evidences. Considerable decrease in sales of the goods with the trademark, consumer loss and reduction in the level of notoriety in public may be given as examples. The objector may submit the public surveys on the reduction in the level of notoriety and concrete economical data, showing the decrease in sales figure and commercial records to prove the active damage. Furthermore, as the ECJ stated in its Intel judgment, the opponent should also submit evidence on the changes of the average consumers' economical attitudes against the goods and services of the well known trademark.

5.4.1 Similarity of Signs

In examining the requirements of the well known trademark protection, one of the prerequisites to be assessed is the similarity between the signs. In case the latter trademark is not identical or similar, no further examination is necessary.

When defining the scope of protection for the earlier trademark, the distinctive character of the trademark is one of the factors to be taken into account. Distinctiveness of a trademark may originate from the trademark's own characteristics, as well as the notoriety thereof. In this sense the trademarks with high distinctiveness enjoy a larger scope of protection.

5.4.2. Similarity of Goods and Services

When well known trademarks are in question, the similarity of the goods and trademarks still can play a role in the assessment of a potential harm to the reputation or distinctiveness of the well known trademark. It is not a prerequisite for the application of Article 8(4) though.

5.4.3. Elements of the assessment of reputation

The Level of Reputation

For the determination of the level of notoriety, the goods and services that the trademark protects shall be evaluated individually.

Relevant Public

In the Uni judgment of the Supreme Court NR E2005/14028 K2007/5223, it has been stated that in order to consider a trademark as well known in the meaning of KHK 556 article 7(1)(i), a service or a trademark must be well known among a relevant part of the public. The Court defined the relevant sector in the above mentioned judgment as the real and potential buyers of the goods and services the trademark is affixed to in Turkey, the business environment in this field and the persons and sellers within the distribution channel of the goods and services the trademark uses.

In the examination of the notoriety of a trademark, potential consumers should be taken into account as well as the active consumers of the trademark during the assessment of the relevant public. Potential consumer refers to persons having indirect contact with the trademark instead of a direct one. This contact may be during the use of a different trademark for the same goods and services or may be established via promotional activities.

Relevant Geographical Area

The trademark should be well known in the country, where the protection is sought. In this sense being well known in the relevant geographical area requires being known in an important part of the country, not in the whole country (see judgment of 11th Civil Chamber of the Supreme Court 2005 tarihli E2005/14028 K2007/5223 UNİ kararı). The evidences to prove the notoriety should therefore show sales figures obtained in Turkey and promotional activities in Turkey.

Time of Reputation

Reputation is a variable fact in time depending on various factors (market conditions, promotional activities, market share, etc.). An important aspect in the definition of the notoriety is to evaluate the time, when the notoriety is claimed. For instance, the opponent should prove that the trademark objected is well known on the date of application. Besides the evidence of notoriety, it must be shown that the trademark that serves as basis of opposition is known on the date of application. In the Form judgment of Ankara 3rd IP Court (Ankara 3. FSHHM, 27.12.2006, E. 2006/300, K. 2006/105), the Court emphasized that the protection for well known marks does not mean “infinite” protection (see also the Pixar judgment of the same Court (Ankara 3. FSHHM, 21.10.2005, E. 2006/7, K. 2006/85).

5.4.5. Assessment of Notoriety: Elements

Distinctiveness

The distinctiveness level of a trademark, that shall be confirmed as a well known trademark is an important criteria. In this sense it shall be an aspect to be taken into account if a sign which claims notoriety is registered for others for several times even if in different sectors.

Notoriety may also be possible for the trademarks, which do not have sufficient distinctiveness. In such a case, the notoriety of the trademark may be confirmed but the scope of protection should be kept rather narrow due to the weakness of the distinctiveness.

Court Judgments on the Notoriety of the Trademark, Efficient Protection of the Trademark Rights

The existences of judgments directly referring to the notoriety of a trademark or the activities of the proprietor of a trademark to protect his trademark are elements that may be taken into account in order to conclude on the notoriety. Clear and repetitive decisions of the Institute

are also important in this sense. However, it should not be assumed that the decisions on the notoriety of the trademark will be valid indefinitely. It would not be logical to judge in advance that the trademark is well known without any examination on the current case, due to an old dated notoriety decision. Since notoriety on the date of the current case is important, the evaluation of notoriety should be done based on evidence relating to the time of the current case.

Promotional Activities

Television, radio advertisements, advertisements posted in newspapers and magazines for the trademark, leaflets, booklets, advertisements on the billboards and similar activities may be among these activities.

Other activities contributing to the promotion of the trademark include: the display of the goods with the trademark on the exhibitions, the news on the trademark in written and visual media organs, sponsorship and civil society initiatives.

In the judgments of the 11th Civil Chamber of the Supreme Court on well known trademarks, the quality of ongoing promotional activities are an important criterion in defining the well known character of the trademark. The 11th Civil Chamber recognized the promotional activities done by the trademarks owners among the criteria used for defining the well known trademark in its judgments on Maserati (11. HD, 11. HD, 07.11.2005, E. 2004/13194, K. 2005/10629 ,MASERATİ Kararı), Johnson (11. HD, 27.02.2006, E. 2005/2143, K. 2006/1923. Aynı yönde YİDK'nın 2008-M-3311 sayılı "ttnet" kararı) and Rodi (11. HD, 29.06.2005, E. 2005/11479, K. 2006/13335). However, while accepting these activities as criteria to define the notoriety, it must also be examined whether the promotional activities are done in Turkey, as well as the amount spent for the promotion, whether this promotion spread through a large part of the public and whether the promotional activities are consistent.

Recognition Level of the Trademark

One of the most important means to reveal the notoriety level that the trademark has reached in the public are public opinion polls done for the trademark. It is essential to provide polls produced by objective, professional and independent companies. In order to obtain the desired results from the survey, it is important that the sample size chosen for the survey is at a level that is able to represent the target public.

Length of Use, Scope and Geographical Area of the Trademark

Although it is per se not sufficient that the trademark is in use for a long time, it shall be one of the criteria to be considered in the evaluation of the notoriety. Long standing use should be corroborated by other elements.

Besides the length of use, the geographical area that the use of trademark spreads is one of the other criteria to be considered.

Other Factors

The qualities of the trademark proprietor company are also factors to be considered. Accordingly, the size of the company, the number of the employees, its turnover, the distribution channels it owns, the amount of exports and such information on the trademark proprietor company may also contribute to the assessment. Yet, information and documents directly related to the company such as the size of the company, the number of employees shall individually not be sufficient.

In determining the notoriety, rewards and the certificates related to the product bearing the trademark or the trademark proprietor company shall also be considered.

The criteria explained under these headlines shall not be subjected to any order of priority; sometimes the fulfillment of a single criterion will be sufficient for the finding of notoriety and sometimes it will be necessary to examine several criteria together.

Proof of Notoriety: Evidence

The information and documents submitted to prove the notoriety should be clear and comprehensible and should not contain a burden of information and documents. It is important that the content of the documents submitted should be substantiating and convincing the decision makers on the issue.

The evidences submitted to prove the notoriety of the trademark should be evidences which are able to prove the notoriety in Turkey. For instance for the notoriety in Turkey, a trademark proprietor originating from Germany should not submit the promotional activities in Germany, but should submit evidences on the promotional activities in Turkey or, alternatively, prove that the promotional activities have reached the consumers also in Turkey. Otherwise, even though the submitted documents shall be taken into account, they would individually not deem to be sufficient as evidence for notoriety.

Evidences submitted to prove the notoriety of the trademark should be from objective sources and should not contain any individual opinions or predictions.

The following information and documents can be used to prove the well known character:

- Information and documents related to the use of the trademark,
- Information and documents related to the advertisement and promotions,
- Court or TPI decisions on the notoriety of the trademark,
- Activities undertaken by the proprietor of the trademark, in order to protect his trademark,
- Survey studies on the notoriety of the trademark,
- Market share and sales figures of the trademark,
- Information on the proprietor of the trademark (number of branches, distribution channels),
- Certificates, rewards,
- Publications about the trademark in media organs such as newspapers, magazines, TV etc.,
- Newspaper articles.

6. OPPOSITIONS BASED ON OTHER INTELLECUAL OR INDUSTRIAL PROPERTY RIGHTS - Article 8 (5)

6.1 General requirements

In addition to the earlier rights protected by Article 8(3), Article 8(5) provides for the protection of other non-registered rights, such as rights to a name, photograph, copyright work or any other industrial property rights vested in third parties. Such rights can result in the rejection of a trademark application through opposition.

This protection is offered against trademarks applications that “contain” the earlier right. No further requirements are specified. However, the spirit of the regulation requires the fulfillment of certain prerequisites for the establishment of the right since the mere existence of a right to a mark is not sufficient.

The right invoked under Article 8(5) must have priority in relation to the trademark application. A comparison of the dates on which the conflicting rights were obtained must be conducted in order to determine the earlier of the two rights. The filing date or a valid priority date is employed as evidence of a trademark right. The date of acquisition of the exclusive right under national law is decisive for establishing other rights asserted under Article 8(5). Where the law permits mere use, the use must have existed before the trademark application date. Where recognition in trade or reputation is required, it must have been acquired before the trademark application date.

Furthermore, earlier rights protected under Article 8(5) are only valid if they confer upon their proprietors the right to prohibit the use of a later right, such as a trademark. This means that the opposing right must be deemed exclusive.

The opponent must be the proprietor of the right or a person authorized by the proprietor to assert the right, because Art. 8 only provides relative grounds for refusal and not an absolute claim.

6.2 Right to a name

The right to a name only relates to individual or personal rights. Therefore trade names, company names (corporate names), and other business designations like establishment or store names, titles of publications, or other similar works, do not fall within this category. Said rights must be asserted under Art. 8(3).

Art. 26 of the Turkish Civil Law

Trademark applications containing a surname shall be refused upon opposition by the surname proprietor if the surname is used exclusively or as a dominant element of the application without due cause (such as prior use, name and surname of the applicant, etc.).

Titles appearing before the name are considered auxiliary elements. Thus, an application for the mark “Dr. Engin Yavuz” shall be rejected by opposition of the person named “Engin Yavuz”.

Opposition to a name with a suffix shall be rejected with the exception of characters in the concrete case. For example, an opposition against the registration of the mark “Engin Yavuzlar” by a person named “Engin Yavuz” shall be rejected.

The opponent must submit a formal identity document, such as a passport or an identity card, in the appendix to his petition. The information on the identity card shall be taken into account for people who use more than one name/surname. For example, an application for the registration of the mark “Ahmet Engin Yavuz” shall be rejected if the opponent’s name is “Engin Yavuz”.

In general, this provision is only applied to oppositions initiated by living people. However, the application may also be refused if it refers to the name and surname of a deceased person and it is believed that the application would result in an abuse of the name or a commercial profit generated through the fame of the person in question. In such cases, competent opponents include wives, children, parents, siblings of the deceased person. Competent institutions (i.e. foundations, societies, companies etc.) bearing the name of the deceased person may also object to use of the name.

Surnames of Famous People, Nicknames, and Pseudonyms

An application shall be rejected upon opposition if the surnames of nationally or internationally known people are included exclusively, or as a dominant element, in the trademark application. Furthermore, a likelihood of association between the indication in the application and the famous person in question can also lead to the rejection of an application. For example, indications such as “Beckham” or “D. Beckham” may be associated with the famous football player, David Beckham, and indications such as “Mandela” or “N. Mandela” may be associated with the famous politician and Former South African President, Nelson Mandela. However, there shall be no likelihood of association in cases such as “Aksu”, Sezen Aksu, and “Gates”, Bill Gates.

Trademark applications shall be rejected not only if they contain an identical or sufficiently similar indication to the correct civil name of a famous person, but also if they consist of altered expressions of the name that clearly relate to a famous person. For example, “Lionhardo di Capri” (an alteration of name of actor Leonardo Di Caprio) and “Gouvernator” (a widely known nickname or pseudonym for Arnold Schwarzenegger) could be rejected through opposition. The provision may also apply to registration seeking indications containing just the first of last name of a famous person.

Applications including the nicknames of nationally or internationally known people as an exclusive or dominant element shall also be rejected upon opposition. A likelihood of association must be established. For example, an objection raised by Fahrettin Cüreklibatür, also known as “Cüneyt Arkın”, is acceptable against a trademark application containing the indication “Cüneyt Arkın”.

Moreover, oppositions raised against applications containing pseudonyms of famous people may be partially or fully rejected depending on their originality and goods/services covered by the registration. For example, the pseudonym “imparator” (emperor) used for Fatih Terim or İbrahim Tatlıses is a common and indistinctive indication which is not directly or solely associated with said celebrities. Hence, such an opposition would be rejected. However, the opposition may succeed, if another element in the trademark creates an association between the mark and a given celebrity. Thus, “İmparator Terim” (Terim the Emperor) would be rejected as it is perceived as “Fatih Terim” by the general public.

6.3. Right to a photograph

The wording of the provision provides protection to photographs. However, this can be expanded to include caricatures or any other detailed designs which are capable of visually identifying a person.

6.4. Copyright

A trademark consisting of a copyright protected work, or a part thereof, can be refused on relative grounds.

6.5. Other industrial property rights

Industrial property rights under Article 8(5) refer only to the industrial property rights not mentioned in Article 8(3) (i.e. designs and plant varieties). Those can be:

6.5.1. Names of characters

Names of fictional characters in films, series and plays

The originality of the names of fictional characters from a production, as well as the likelihood of association between the trademark application and production, are taken into account for the purpose of this evaluation. The application shall be refused if there is a likelihood of association by the majority of the public on the date of the opposition's evaluation. For example, the characters "İnek Şaban" and "Güdük Necmi" are identified with "Kemal Sunal" and "Halit Akçatepe". The character "Burhan Altıntop" in the series "Avrupa Yakası" is identified with Engin Günaydın. In both situations, the opposition would succeed since a major part of the public associates said character names with their respective actors and/or productions. However, an opposition shall fail if based on character names that are commonly used in many productions or by the public. Oppositions based on characters from the series "Avrupa Yakası" such as "Volkan", "Aslı", "Sertaç" shall be rejected since the names in question are commonly used by the public and cannot be directly associated with neither the actors nor the production.

The perception of majority of the public shall be taken into account for the assessment of claims based on character names. However, character names from productions aimed at a small segment of the public shall be assessed according to the following two criteria:

First, the application may be rejected if the characters in question were created before the date of the opposition's examination and are not part of a current broadcast.

The application may also be rejected if the characters were recently created and were disclosed to the public via visual media so that it can be presumed that a majority of the public will soon be aware of said characters.

Characters from foreign films

The names or nicknames of the characters in question should possess a national and international reputation. For example, "Clark Kent" is a character from the nationally and internationally broadcasted and distributed movie, television series, and cartoon entitled "Superman". However, an opposition based on a copyright over a foreign production character name or nickname which is not known in Turkey among a major part of the public shall fail in spite of the copyright originality.

Oppositions based on characters from a production based on a literary work may be raised by the author or right holder. For example, the novel "Da Vinci Code" has been adapted into a screenplay by Dan Brown. An opposition initiated by the film director on the basis of the character "Robert Langdon" shall fail if the director is not a copyright holder. According to the Code of Intellectual and Artistic Works (58846), oppositions based on characters from a movie, series, or play can be initiated by the production's rights holders or the relevant actors.

Characters in Books, Comics, and Cartoons

Oppositions based on characters from works created in Turkey are valid if the trademark application would create a likelihood of association between the work and the mark from the perspective of the public majority. For example, the character “Avanak Avni” is a famous comic character created by Oğuz Aral for the magazine, *Girgir*.

However, such copyright based oppositions shall be rejected if the name or nickname of a character from a foreign copyright work is not well known in Turkey despite its foreign renown.

Oppositions based on single character names which would otherwise fail, may succeed in cases where two character names are used together. For example, an opposition based on the single character name “Tom” or “Jerry” would fail since both names are common abroad. However, an opposition based on the characters “Tom and Jerry” would succeed because the contested mark would create an association with the internationally renowned cartoon.

An association may also exist when the originality of the work and its characters is low. For example, the indications “Çalikuşu” and “Feride” may be separately registrable, but “Çalikuşu Feride” can be refused by opposition of the right holder since the sign directly refers to the work “Çalikuşu.”

Furthermore, the names of certain cartoon characters are not well known in Turkey. For example, the comic book “Lucky Luke” drawn by a Belgian cartoonist, Maurice De Bevere, is called “Red Kit” in Turkish. The Turkish name for the character “Jolly Jumper” is “Düldül”, and “Rantanplan” is “Rintintin”. In such cases, the reputation of the original character should be taken into account.

An application shall be rejected upon opposition by the right holder regardless of additional verbal or figurative elements, and in the absence of an indication of the character’s name, if the copyright work’s characters are visually represented in the sign.



Opposition accepted, application rejected (see YİDK 2010-M-2919 sayılı kararı) (Class 25)

Opposition accepted, application rejected (see YİDK 2007-M-3028 sayılı kararı) (Class 16, 18)

6.5.2. Titles of copyright protected works

(i) Literary Works

Trademark applications identical to the title of a literary work or consisting of such a indication as a dominant element may be rejected by means of opposition depending on the originality renown of the title. The opposition can be raised by a living author or by the heirs or right holders of the copyright within 70 years of the author’s death (Code of Intellectual and Artistic Works 5846).

The titles of well-know newspaper columns or regular magazine articles may also derive protection for this provision. For example, the journalist Çetin Altan has been writing the column entitled “Şeytanın Gör Dediği” which has been associated with him for many years.

In order for a title to benefit from this provision, an association between the indication in the trademark application and the copyright work in question must be established.

(ii) Titles of TV Shows, Films, Theatrical Plays, Operas, Musicals, Cartoons, Comics, etc.

Titles of copyright works such as films, plays, operas, cartoons, etc., appearing exclusively or as a dominant element of a trademark application may result in a rejection by opposition depending on the likelihood of association as well as the originality and renown of the copyright work in question. Oppositions shall succeed if based on names of famous copyright works such as “Zügürt Ağa”, “Forrest Gump”, “Ben 10”, and “Shrek”.



2009/23864

Moreover, the opposition may succeed if the trademark application contains a portion of the original title or an image associated with the work, such as a poster, a character depiction, or a screen captured image from one of the movie scenes, which may lead to likelihood of association.



MATRIX

Opposition may fail if based on foreign language works/titles of low original character that may not be know in Turkey. Titles of series and sequels must be assessed for their renown and originality.

Oppositions based on the names of works possessing a high original character my succeed even if the works are not well know in Turkey (i.e. Animated films such as the Australian made “Hoota and Snoz” or the Russian made “Cheburashka”)

6.5.3. *Photographic works, Pictures, Paintings and Architectural works*

Applications containing representations of photographic works, pictures, paintings and architectural works shall be refused upon opposition by the right holder.



Building in the shape of a piano (Huainan, China); Ankara Hittite Statue (Architect: Aydın Tiryaki, 1978)

6.5.4. Musical works

(i) Titles of Musical Works

Musical works encompass all forms of musical composition whether they include lyrics or not. The title, lyrics and composition of the work should be taken into account. An application containing a copyright work shall be refused upon opposition by the author or right holder of a highly distinctive or well-known musical work. For example, the works entitled “Rindler’in Akşamı (Dönülmez Akşamın Ufkundayız)” and “Endülüs’te Raks” were composed by Münir Nurettin Selçuk and the lyrics were written by Yahya Kemal Beyatlı. The compositions and their titles are considered highly distinctive. However, a musical work such as “Kalamış” lacks distinctiveness as it is also the name of a place.

(ii) Applications containing Lyrics and Composition Together

Should a trademark application contain both the lyrics and the composition together then the authors of the lyrics or the composition, or legal successors thereof, may object separately. The application may be rejected if it incorporation of the complete work, or a part thereof, results in an association between the application and the musical composition.

For an objection based on lyrical copyright, the opponent must prove that he is the holder of the right. Objections based on compositions must be accompanied by an electronic recording (i.e. mp3, wav, etc.) submitted in CD format along with the proof of copyright title.

(iii) Applications without lyrics

An electronic recording must also be submitted in addition to proof of copyright ownership for the opposition of trademark applications not including lyrics.

6.5.5. Other rights

(i) Industrial Designs, Patents, Utility Models, and Integrated Circuit Topography

An application shall be refused upon objection by the right holder if the trademark application contains a prior industrial property right which is similar or confusingly similar.

Oppositions based on unregistered design rights must be accompanied by proof of use. Acceptable forms of evidence include magazines, newspapers, visual media publications, catalogues, etc. The evidence must also establish the opponent’s design ownership.

Objections based on prior industrial property rights shall be assessed according to the nature of the right in question. During this evaluation, the objection shall be examined in relation to the goods/services sought by the application, as well as the confusing similarity or identity between the sign and the prior right in question.

(ii) Geographical Indications

An application shall be refused for similar goods and services if they contain an indication registered and protected under Article 18 of the Decree Law 555 on the Protection of Geographical Indications.

(iii) Trade Name

Trademark applications consisting of trade names shall be refused upon opposition by the trade name owner.

6.6. Documents taken into consideration for the evaluation of the opposition claim:

- Invoices
- Copyright certificates
- Catalogues
- Newspaper, magazine, and visual media publications
- Public polls
- The work itself
- Any document establishing ownership in the work
- Notarized identity card photocopies
- CD Sound recordings (for objections to the sound mark registration)
- Contracts of acquisition and transfer of the rights in question
- Registration certificates for the Turkish industrial property rights (including application)

7. OPPOSITION BASED ON GUARANTEE OR COLLECTIVE MARKS - ARTICLE 8(6)

An opposition based on guarantee or collective marks can be claimed within three years after the mark's expiry date (Art. 8 (6)).

The trademark application shall be refused for the identical or similar goods services covered by the expired guarantee or collective mark registrations.

8. OPPOSITION BASED ON EXPIRED TRADE MARK - ARTICLE 8(7)

The registration application filed for an identical or similar mark for identical or similar goods and services shall be refused upon opposition within two years after of expiry date (6 months extension is not included) of the protection time of a mark due to not renewing.

In the objections based on the article in question, after the expiry date of the protection of the mark that is the ground for opposition due to non renewal, the documents that prove the use on goods/services within the scope of registration should be submitted. If there is no evidence submitted within this purpose then the oppositions raised within this scope shall be refused.

PART C: EXAMINATION UPON REQUEST: BAD FAITH

Under Article 35 of the Trade Mark Law, notices of opposition to the registration of the trademark on the grounds that it may not be registered under the provisions of Articles 7 and 8, and notices of opposition on the ground that there exists bad faith in the application shall be submitted within three months of the publication of the application. Normally the claim for annulment of a trade mark registration based on the ground of bad faith is made in the interest of a competitor, but is nevertheless in the interest of the public as well. Although a specific procedure for annulment is not (yet) foreseen in the Turkish TM-Law, a trademark which is applied for in bad faith may fall within the group of absolute grounds for refusal listed in Article 7 (1) (k): It may not be eligible for registration because it is against the public order. This may be the case in particular circumstances such as corruption or unfair competition during the application procedure. The following cases give an indication of TPI practice.

Examples:

Former business partners are fighting each other. They used to use an unregistered sign. One of them - after breaking up - is very quick and applies to the Institute for this sign to be registered in his/her name.

Similar are cases in which resigned employees apply for registration as trademarks of the unregistered sign of their former employers.

Associations fall apart and one or a group of the former members applies for the name of the association to hinder the other group from using the name or running the association any longer.

A company is in bankruptcy. During the procedure at the court the name of the company - which was not registered as a trademark - was applied for at the Office. This causes damage to the bankrupt estate of the company and lowers the financial interests of the creditors, when the name was of worth and part of the insolvency assets of the company.

The name of a famous restaurant in a city (Istanbul) is copied for a restaurant in another city (Izmir) and applied for as a trademark. This fact is even published in the media and the prior restaurant owner is complaining in interviews about this fact. He even communicates the fact that the new trademark owner offered him an expensive license already for using the name which he created originally.

A famous coiffeur sells his company's name to another coiffeur, because he emigrates to the USA. After a while he returns and establishes again a coiffeur company nearby under the same name as sold and applies for his name as a trademark.

It is contrary to accepted principles of morality when an applicant applies for the registration of a trademark exclusively with the intent of abusing his legal right at the expense of other persons.

This is the case, when the applicant is not interested in using the registered trademark for his products and/or services, but exclusively intends to prevent other persons from using the trademark for their products and/or services. The applicant acts in bad faith as well, when he intends to use the registered trademark only for selling the trademark at an unjustified price or for getting unjustified royalties.

Another example for acting in bad faith is the case when the applicant applies for the registration of a sign which another person or company has used for his own products and/or services within the country for a long time and there is no reason for the applicant applying for the registration of this sign as a trademark. His application must then be considered an unjustified interference provided he knows all the facts mentioned above before applying for registration.

The applicant acts in bad faith when the application is exclusively made with the intent of preventing competition of other persons or undertakings.

A case of acting in bad faith exists when the applicant gives false statements, submits falsified documents or conceals important matters of fact with regard to his application.

Finally the applicant acts in bad faith if he/she has tried to obtain the registration by corruption.