

Apple seeks recognition of IPOD as well known following landmark decision

By Uğur Aktekin and Hande Hançer

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Following a decision by the Re-examination and Evaluation Board of the Turkish Patent Institute (TPI) in opposition proceedings, Apple Inc has filed an application for the official recordal of IPOD as a well-known mark in the official registry. The board had rejected Turkish company Tunc Tekstil's application for the registration of the trademark IPOD for goods in Classes 25 and 35 of the Nice Classification on the grounds that the well-known status of Apple's IPOD trademark warranted grounds for opposition.

In 2005 Tunc Tekstil filed an application for the registration of the trademark IPOD for goods and services in Classes 25 and 35. Further to publication of the trademark application in the *Official Trademark Bulletin*, Apple filed an opposition against the application on the grounds that the mark applied for was identical to its well-known trademark IPOD, even though the mark was not registered for the relevant classes sought in the application. Apple filed an extensive volume of evidence in support of its arguments. At first instance, the Directorate of Trademarks rejected the opposition on the grounds that although the trademark applied for was identical to Apple's mark, the goods and services covered were different. The arguments and evidence filed in support of the well-known status of the trademark IPOD were not taken into consideration.

Apple appealed to the Re-examination and Evaluation Board of the TPI. Apple used the same arguments brought in the opposition writ, but placed more emphasis on the well-known status of its IPOD trademark and supplied additional evidence. The board upheld the opposition, expressly stating that Apple's IPOD mark is well known and should be protected against identical trademarks, even in different classes. The board reasoned that:

"the 'ipod' phrase is a phrase which has no definition in the dictionary and no meaning. It was completely created by Apple Inc and has become a well-known trademark as a result of its intensive advertising activities. Although the goods and services that the trademark application covers belong to different sectors, it is seen that the application and the trademark that are the grounds of the opposition may create a likelihood of confusion, particularly with respect to the source of the goods, and it is determined that the registration of the trademark application may result in an improper personal benefit from the trade reputation of the opponent company and infringe the distinguishing character of the trademark."

The board's decision is indicative of a new approach. Although not expressly stated in any of the TPI's decisions, there is an implied practice that it does not take into consideration the well-known status of a trademark - even in cases where it is obvious - unless the trademark has been recorded as a well-known mark within its official registry. However, in

this decision the board adopted a different approach in expressly concluding that IPOD is a well-known trademark on the face of the evidence submitted by Apple.

This decision is significant because the board examined and confirmed the well-known status of a mark based on the evidence filed by Apple within the opposition proceedings, even though Apple's IPOD trademark is not recorded as a well-known trademark at the TPI's official registry. Therefore, the decision may allow a well-known trademark to be recorded as such without any further action or lengthy application procedure. The decision also affirms the importance of filing substantial evidence during opposition proceedings, which should help trademark owners finalize disputes during such actions and avoid lengthy court proceedings.

Apple's application for the official recordal of IPOD as a well-known mark is still pending; however, it is likely to be accepted as an initial examination has already been made during the opposition proceedings.