

Absolute ground for refusal under Article 7/1(b) interpreted narrowly

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On September 28 2010 the Re-examination and Evaluation Board of the Turkish Patent Institute interpreted Article 7/1(b) of the Trademark Decree Law 556 in a narrow sense.

Diversey Inc (formerly known as JohnsonDiversey Inc), a leading global provider of cleaning and hygiene solutions, applied to the Patent Institute for the registration of the word mark DIVERSEY in Classes 1, 3, 5, 7, 21, 37 and 41 of the Nice Classification. The application was partially refused following an *ex officio* examination on absolute grounds for refusal under Article 7/1(b) of the Trademark Decree Law, which states that a trademark will not be registered if it is "identical or confusingly similar to an earlier trademark registration or application in respect of identical or similar goods or services". The refusal was based on the earlier trademark DIVERSE.

Diversey appealed to the Re-examination and Evaluation Board, alleging that the mark applied for was neither identical nor confusingly similar to the DIVERSE mark, as the latter:

- differed from the mark applied for in one letter; and
- had a specific meaning, while the mark applied for had not.

Diversey further argued that Article 7/1(b) applies only to trademarks which are very similar at first sight. Moreover, Diversey referred to the clear wording of Article 7/1(b), which does not require a likelihood of confusion between the marks at issue. Diversey also relied on court decisions which followed a similar logic.

The board upheld the appeal, finding that the trademark DIVERSEY differed from the earlier mark DIVERSE semantically. Therefore, the marks were not confusingly similar within the meaning of Article 7/1(b).

The decision illustrates the principle that the interpretation of confusing similarity under Article 7/1(b) should be very narrow. This conclusion is supported by various commentators in the doctrine and some court decisions. The board's decision also indicates a change in the Patent Institute's practice, as the latter used to interpret the relevant provision in a broad manner.

Arguably, this is a landmark decision, since many trademarks have remained unregistered due to the prevailing broad interpretation of Article 7/1(b). Decisions of the institute are not binding on it, but, at least, it shows that its approach to the interpretation of Article 7/1(b) may be changing. This is a significant development, as many companies use unregistered trademarks - trademark applications were often rejected on the grounds that they were confusingly similar to earlier

registered marks, even where the owner of the earlier mark did not oppose the application, or even consented to it.