

PTO confirms similarity of virtual and physical goods in landmark decision

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Legal updates: case law analysis and intelligence

- A company based in the US opposed an application for goods and services in Classes 25 and 35 based on an earlier mark in Classes 9, 35 and 41
- The PTO found that the physical goods/services covered by the application were similar to the virtual and online goods/services covered by the opponent's mark
- The similarity of virtual and physical goods/services has recently been a hot topic across the world

In a decision issued on 31 March 2023 (which was subsequently finalised), following an opposition based on an earlier trademark owned by a company based in the United States, the Trademarks Department of the Turkish Patent and Trademark Office (PTO) has determined that virtual and online goods/services were similar to physical goods/services, and rejected the trademark application pursuant to Article 6/1 of the Industrial Property Law (No 6769).

Background

The trademark application had been filed for the following goods and services, among others:

- "Underwear and outer clothing made from all kinds of materials, except those with a protective purpose, socks, mufflers, shawls, bandanas, scarves, belts; footwear: shoes, slippers, sandals; headgear: hats, flat caps, beanies, skullcaps, caps" in Class 25; and
- "Services of gathering goods - namely, underwear and outer clothing made from all kinds of material, except those with a protective purpose, socks, mufflers, shawls, bandanas, scarves, belts; footwear: shoes, slippers, sandals; headgear: hats, flat caps, beanies, skullcaps and caps to enable customers to examine and purchase them with convenience (the specified services can be provided by retail and wholesale shops, electronic media, catalogues and other similar methods)" in Class 35.

The opponent filed an opposition against the application insofar as it sought registration for clothes and retail services related to clothes, as it was identical to its earlier trademark covering the following goods and services, among others:

- “Downloadable virtual goods in the field of fashion; downloadable virtual goods in the field of fashion for use in virtual environments and worlds; downloadable virtual goods in the nature of clothing, jewellery, watches, bags, headwear, footwear” in Class 9;
- “Retail store and online retail store services featuring virtual goods - namely, clothing, jewellery, watches, bags, headwear, footwear, eyewear and other retail items” in Class 35; and
- “Entertainment services - namely, providing online, non-downloadable virtual clothing, jewellery, watches, bags, headwear, footwear and other retail items” in Class 41.

Decision

Upon examination of the opposition, the Trademarks Department determined that the trademarks were similar, and that the virtual and online goods/services covered by the opponent’s trademark were similar to the physical goods/services covered by the opposed trademark. As a result, the trademark application was rejected in accordance with Article 6/1 of the Industrial Property Law.

Comment

The similarity of virtual and physical goods/services has recently been a subject of discussion across the world, particularly in the European Union and the United States.

In this context, during the webinar entitled "[Trademarks and designs in the metaverse: legal aspects/EUIPO practice](#)" organised by the European Union Intellectual Property Office (EUIPO) on 13 September 2022, it was stated that the key aspect of virtual goods is to emulate core concepts of real-world goods and that the consumer perception criteria used for real-world goods can also be applied to virtual goods. Moreover, in the United States, a trademark application filed by a third party containing the word element ‘Gucci’, covering “downloadable virtual goods - namely, computer programs featuring footwear, clothing, headwear, eyewear, handbags, laptop bags, backpacks, luggage, briefcases, art, toys, jewellery, watches, hair accessories, pet collars, accessories and charms for use in online virtual worlds” in Class 9 and “retail store services featuring virtual goods - namely, footwear, clothing, headwear, eyewear, handbags, laptop bags, backpacks, luggage, briefcases, art, toys, jewellery, watches, hair accessories, pet collars, accessories and charms for use in online virtual worlds” in Class 35 was [rejected](#) by the US Patent and Trademark Office (USPTO) after a preliminary examination on 30 August 2022. The USPTO found that, due to the close association between virtual and physical goods/services, consumers encountering the parties’ goods and services would presume that they originated from the same source.

The decision of the Turkish PTO in the present case is consistent with the approach of the EUIPO and the USPTO. It thus seems that trademark offices across the world are acknowledging that virtual and physical goods/services are similar or related.

Gün + Partners represented the opponent in this case

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