



Article Navigation

Turkish Court of Appeal revisits the assessment of likelihood of confusion in case of weak trade marks ... changing its approach

Uğur Aktekin ; Güldeniz Doğan Alkan ; Zeynep Çağla Özcebe 

Journal of Intellectual Property Law & Practice jpx046. DOI: <https://doi.org/10.1093/jiplp/jpx046>

Published: 28 March 2017 Article history ▼

PDF Cite Share ▼ Tools ▼

Abstract

Turkish Court of Appeal, 11th Civil Chamber, merit No 2015/11147 and decision No 2016/6028, 1 June 2016

The approach of the 11th Civil Chamber of the Turkish Court of Appeals (CoA) regarding the assessment of likelihood of confusion for weak trade marks changed in its recent *BUDA BENİM* decision. Contrary to its previous approach, the CoA conferred a narrower protection to the trade mark on consideration of its weak nature.

Issue Section: [Current Intelligence](#)

Legal context

[Skip to Main Content](#)

The Industrial Property Law No 6769 (this regulates all IP rights in a single code) came into force on 10 January 2017, and the legislation on trade marks in force at the time of the *BUDA BENIM* decision was Decree Law No 556 on the Protection of Trade Marks (the Decree Law), as amended in 2004, and its implementing provisions.

Article 8 of the Decree Law governed relative grounds for refusal of trade mark registration. According to Article 8/1(b) of the Decree Law, if an application is for a sign that is identical or similar to an earlier registered trade mark or trade mark application, such trade mark application might be refused upon opposition of the relevant third party. As per Article 42/1(b) of the Decree Law, an invalidity action could be brought on the same grounds of Article 8 of the Decree Law.

Facts and analysis

In the case at hand, the CoA upheld the decision of the Court of First Instance which had found no likelihood of confusion between the registered trade marks GUN BENIM GUNUM (registered for goods in Class 5), ETI BENIMO, BENIMO!!!, BENIM'O, BENIM'O & device (registered for various goods in Classes 5, 29, 30 and 32) and the prospective trade marks BUDA BENIM and TORKU BUDA BENIM (to be registered for goods in classes 29, 30 and 32).

After determining that there was no likelihood of confusion between GUN BENIM GUNUM and the applicant's signs, due to the fact that they would cover different kinds of goods, the CoA determined that the ETI BENIMO, BENIMO!!!, BENIM'O, BENIM'O & device trade marks and the BUDA BENIM and TORKU BUDA BENIM prospective trade marks would cover the same types of goods and share BENIM (which means 'mine' in Turkish). For a better understanding it should also be noted that BENIM O means 'it's mine' and BUDA BENIM means 'it's also mine' in Turkish, while ETI and TORKU are the umbrella brands included in the trade marks.

The CoA found that, although the parties' signs have BENIM in common, BENIM is a weak word, which indicates possession and does not indicate the origin of the goods or services. It follows that likelihood of confusion can be eliminated with minor changes. From this perspective, the CoA ruled that there was no likelihood of confusion between the parties' signs. The CoA also noted that, even if it is accepted that the ETI BENIMO trade marks have a high degree of recognition, this fact would not change the outcome, since registration of the applicant's sign would not harm the reputation of the plaintiff's trade mark, nor would it gain unfair benefit from its well-known status.

The approach of the CoA differs from its previous approach regarding the assessment of likelihood of confusion of weak trade marks, an example being precedent the *Bluediamond* decision (see U. Aktekin, G. Doğan Alkan and Z. Çağla Özcebe, 'Evaluation of the likelihood of confusion between weak trademarks' (2015) 10(4) JIPLP 237–8). In that case, the plaintiff was the holder of registered trade marks for DIAMOND, DIAMOND MUCEVHERAT ('mücevherat' means jewellery) and NACI DIAMOND for goods and services relating to jewellery. It filed an invalidity action against the trade mark registration for BLUEDIAMOND, which had been registered for goods and services also relating to jewellery. The plaintiff requested the invalidation of the defendant's BLUEDIAMOND trade mark for goods in Classes 14 and 42 on grounds of likelihood of confusion between trade marks pursuant to Articles 7/1(b) and 8/1(b) of the Decree Law. Having assessed the allegations of the defendant and finding that 'Diamond' has a low level of distinctiveness for goods and services relating to jewellery, the CoA accepted that the trade marks were not sufficiently different from each other and ruled that the legal protection provided by a trade mark is obtained with registration pursuant to Article 6 of the Decree Law. A trade mark will grant all legal rights to its owner unless it is cancelled with a finalized cancellation decision rendered as a result of a cancellation action. According to this previous approach of the CoA, the trade mark holder would be entitled to use all legal rights arising from the registration of their trade mark and could not be retained from such use for the descriptiveness or weakness of the sign. On the other hand, the defendant should not infringe the plaintiff's trade mark rights by attempting to register a confusingly similar sign only because the plaintiff's trade mark has a descriptive nature. As a possible remedy, the CoA stated that if the defendant wished to prevent the trade mark holder from using their rights, then he should file a cancellation action pursuant to first paragraph of Article 42 of the Decree Law.

Practical significance

It is clear that the CoA's new approach in its *BUDA BENİM* decision is more sensible than its previous position. The earlier approach failed to raise the possibility of severe practical problems in the enforcement of trade mark rights in Turkey. The CoA's latest approach should remove such concerns since the scope of protection which shall be conferred to a trade mark should now be determined by considering the strength and distinctiveness of the registered sign in the first place.

[Skip to Main Content](#)

© The Author(s) 2017. Published by Oxford University Press. All rights reserved.

Comments

0 Comments

[View Metrics](#)

Email alerts

[New issue alert](#)

[New advance articles alert](#)

[Article activity alert](#)

[Receive exclusive offers and updates
from Oxford Academic](#)

Citing articles via

[Google Scholar](#)

[CrossRef](#)

Latest | **Most Read** | **Most Cited**

Delhi High Court provides broad interpretation
of education exception in Indian copyright law

EU trade mark round-up 2016

Trade marks, country names and
misappropriation of national identity

Czech court finds that linking to unlicensed
content does not infringe copyright if the
website is not operated for profit

[Skip to Main Content](#)

Turkish Court of Appeal revisits the assessment
of likelihood of confusion in case of weak trade
marks ... changing its approach



[About Journal of Intellectual Property Law & Practice](#)

[Editorial Board](#)

[Author Guidelines](#)

[JIPLP Weblog](#)

[Facebook](#)

[Twitter](#)

[LinkedIn](#)

[Purchase](#)

[Recommend to your Library](#)

[Advertising and Corporate Services](#)

[Journals Career Network](#)



Online ISSN 1747-1540

Print ISSN 1747-1532

Copyright © 2017 Oxford University Press

[About Us](#)

[Contact Us](#)

[Careers](#)

[Help](#)

[Access & Purchase](#)

[Rights & Permissions](#)

[Open Access](#)

Connect

[Join Our Mailing List](#)

[OUPblog](#)

[Twitter](#)

[Facebook](#)

[YouTube](#)

[Tumblr](#)

Resources

[Authors](#)

[Librarians](#)

[Societies](#)

[Sponsors & Advertisers](#)

[Press & Media](#)

[Agents](#)

Explore

[Shop OUP Academic](#)

[Oxford Dictionaries](#)

[Oxford Index](#)

[Epigeum](#)

[OUP Worldwide](#)

[University of Oxford](#)

Oxford University Press is a department of the University of

Oxford. It furthers the University's objective of excellence in research, scholarship, and education by publishing worldwide

OXFORD
UNIVERSITY PRESS

Copyright © 2017 Oxford University Press

[Privacy Policy](#)

[Cookie Policy](#)

[Legal Notices](#)

[Site Map](#)

[Accessibility](#)

[Get Adobe Reader](#)

