

In-depth Decision on Likelihood of Dilution of a Well-Known Trademark

Abstract: Third party attempt to feminize the Johnnie Walker striding man logo and register the same to use it in fashion and textile sector may dilute the logo, rules the Turkish Patent and Trademark Office

In a very recent decision, the Re-examination and Evaluation Board (“Board”) of the Turkish Patent and Trademark Office (“Office”) has accepted that third party attempt to feminize the Johnnie Walker striding man logo and register the same to use it in fashion and textile sector may cause serial mark impression, and dilute the striding man logo and harm the distinctiveness and reputation of the same, even though it is only registered and well-known for alcoholic beverages.

Content

On February 28, 2018, the applicant company filed an application to register the trademark no.



2018/20205 for the goods and services in classes 18, 25, 26 and 35 before the Office, mainly to use this mark in fashion and textile sector. Diageo Brands B.V. opposed to this trademark application on the grounds that i) the application is a clear copy of the Johnnie Walker



striding man logos and , which are well-known and registered trademarks for alcoholic beverages in class 33 in many countries all around the world including



Turkey as well as the Jane Walker striding woman logo used on the limited editions of Johnnie Walker launched in March 2018 to celebrate Women’s History Month and to support the gender equality, ii) the application violates the copyright on the Johnnie Walker striding man logo and iii) the applicant tries to register this trademark application in bad faith.

Although the opposition was not accepted by the Trademarks Department Directorate (“TDD”) of the Office in the first place, the appeal filed against this decision of the TDD before the Board was successful and the Board decided for total refusal of this opposed trademark application with its decision dated January 30, 2019. As the applicant did not file a cancellation action against this decision of the Board in due time, the decision has been finalized.

In its decision, the Board firstly concluded that the figurative element of the application has an independent distinctiveness apart from the “maren moda” phrase and therefore shall be examined in evaluation of similarity by itself, and the logo of the application is confusingly similar to the registered and renowned striding man logo because minor differences such as gender of the logo, type of hat, shoes, glasses, hairs etc. do not bring the application distinctiveness and differentiate the trademarks from each other.

Secondly, the Board also implied that it could not be accepted that the applicant made this trademark application as a coincidence on the grounds that although there is no use of Jane Walker striding woman logo in Turkey, the evidence shows that the news regarding the Jane Walker striding woman logo were published in Turkish websites and the publication date of the same is close to the application date of this opposed mark.

Finally, the Board acknowledged the well-known status of the Johnnie Walker striding man logo once again and concluded that considering the reputation and intensive use of the striding man logo on alcoholic beverages, it is clear that the registration and use of the opposed mark, which is similar to this well-known striding man logo, for different goods and services may harm the distinctive character and reputation of this logo and also cause dilution of the same, even though the opposed mark does not cover any goods and services similar to the alcoholic beverages in class 33 for which the striding man logo is well-known.

Comment

This decision of the Board has a significant impact for the trademarks composed of both word and figurative elements because the Board concluded that the figurative elements of the trademarks shall be examined in evaluation of the similarity and likelihood of confusion by themselves apart from the word elements and also accepted the conceptual similarity and serial mark impression between the trademarks over gender difference of the human figures in the figurative elements of the trademarks.

In addition, this is also a landmark decision to determine the scope of the protection required for well-known trademarks and demonstrates that the Board releases its strict approach to well-known trademarks at least in terms of the ones having long-lasting and intensive use both in Turkey and also around the world.

As a matter of fact, despite recent decisions of the Board, in this case, it is accepted that even though the well-known status is dedicated to a certain sector (alcoholic beverages in this present case), well-known trademarks shall be protected for all the goods and services considering the possible dilution and also the possible harm of the reputation and distinctiveness of the same.

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