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Court of Appeal grants protection to relatively weak mark in questionable decision

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- TURKPATENT found that there was no likelihood of confusion between AFİYETLE DİYET and AFİYET
- The IP Court, the District Court and Court of Appeal disagreed, concluding that there was a likelihood of confusion
- The case shows that there is no established approach to weak trademarks

Background

In 2014 the defendant applied to register the trademark AFİYETLE DİYET (which may be translated as 'diet with health, appetite') in Classes 5, 9, 29, 30, 31 and 32.

The plaintiff, the owner of the AFİYET mark ('health, appetite' in English) in Class 31, opposed the registration of AFİYETLE DİYET, arguing that the word '*diyet*' ('diet' in English) was devoid of distinctiveness for the relevant goods and that the goods bearing the defendant's mark could be perceived as dietary versions of the plaintiff's goods.

The Turkish Patent and Trademark Office (TURKPATENT) dismissed the opposition. The plaintiff initiated an action before the IP Court, requesting the cancellation of TURKPATENT's decision and the invalidation of the AFİYETLE DİYET mark in Class 31.

Decisions

In the court case, the plaintiff repeated the arguments put forth in the opposition proceedings. The defendant pleaded that it had been using the AFİYETLE DİYET mark since 2009 (since the publication of a book with the same title in 2009) and that it held another trademark registration for AFİYETLE DİYET (although for different classes) dating back to 2009; thus, its trademark would not be confused with the plaintiff's trademark. Further, the defendant argued that AFİYET is not distinctive for the concerned goods and is a weak mark; therefore, its AFİYETLE DİYET mark differed sufficiently from the plaintiff's trademark.

The First Instance IP Court accepted the plaintiff's case, finding that the parties' trademarks were confusingly similar and that they both covered Class 31 goods. Therefore, there was a likelihood of confusion between the trademarks.

Further to the defendant's appeal, the District Court confirmed the legitimacy of the first-instance decision.

Upon further appeal, the Court of Appeal upheld the lower courts' decisions, concluding that there was a likelihood of confusion between the parties' trademarks. As a result of the Court of Appeal's decision, the case was finalised and the judgment became binding.

Comment

Arguably, the plaintiff's trademark AFİYET has low distinctiveness and is weak for the relevant goods in Class 31. Generally, it is accepted that the owner of a weak trademark must tolerate the registration and use of similar trademarks. Even minor changes to weak trademarks are sufficient to eliminate confusing similarity and a likelihood of confusion. In the present case, although the defendant's AFİYETLE DİYET mark sufficiently differed from the plaintiff's earlier mark, the courts on all three levels ignored this fact and decided to accept the plaintiff's case.

The decision is also questionable because the defendant published a book named *Afiyetle Diyet* more than five years before the filing of its trademark and it also holds a registration for AFİYETLE DİYET in different classes, also dating back to more than five years. Therefore, one may consider that there was no actual risk of confusion or association in the eyes of the relevant consumers. However, the fact that the likelihood of confusion is a separate condition for refusal on relative grounds was overlooked.

These decisions show that there is no established approach to weak trademarks and that each case should be analysed based on its own facts, since every trademark has unique characteristics in respect of its degree of authenticity, design, properties of the claimed goods/services, target consumers and distinctiveness with regard to the claimed goods/services. A decision can be made only after assessing all these interdependent elements in combination.

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