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The Assembly of Civil Chambers of the Court of Appeals recently ruled that trademarks containing identical descriptive phrases give rise to a likelihood of confusion, thereby reversing the first-instance court's decision that there is no likelihood of confusion between such trademarks. The assembly's approach grants exclusive rights over descriptive and generic phrases found in trademarks which could legitimise unfair competition between rights holders and render notions such as 'dilution' and 'generic' meaningless.

A trademark should be distinctive in order to distinguish the goods and services of one entity from those of others. In respect of trademark protection, the legal strength of a mark is directly proportionate to its distinguishing nature. In other words, the more distinctive a trademark is, the stronger its protection.

Descriptive trademarks describe the ingredients, qualities, features, purposes or characteristics of a product or service. A descriptive mark cannot be registered and protected on its own, unless it acquires secondary meaning and becomes distinctive by use. However, generic phrases which describe products and services as a category are the weakest trademarks.

It is necessary to determine which phrases are generic or descriptive in order to carry out a proper evaluation, since a likelihood of confusion evaluation should be based only on the main elements of a trademark. In this respect, it is clear that evaluating the likelihood of confusion between trademarks involving descriptive or generic phrases requires a more detailed examination than that carried out for trademarks involving distinctive phrases.

In Decision 2013/11-52E the Assembly of Civil Chambers of the Court of Appeals accepted that the word 'diamond' used in trademarks covering services relating to jewellery increased the likelihood of confusion between trademarks. The court held that the word 'diamond' in



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the trademarks was subject to comparison as a fundamental element, even though it was descriptive of the goods and services for which the trademarks were registered and used.

Facts

The plaintiff was the holder of the trademarks DIAMOND, DIAMOND MUCEVHERAT ('*mücevherat*' means 'jewellery') and NACI DIAMOND registered in Classes 14, 35 and 42. It filed a cancellation action against the defendant's trademark BLUEDIAMOND, which was registered for goods and services in Classes 8, 14 and 42. The plaintiff requested cancellation of the BLUEDIAMOND trademark in Classes 14 and 42 on the grounds of a likelihood of confusion between the trademarks pursuant to Articles 7/1(b) and 8/1(b) of Decree-Law 556 on the Protection of Trademarks. Article 7 regulates the absolute grounds for trademark refusal which are examined *ex officio* by the Turkish Patent Institute (TPI). Article 7/1(b) provides that a trademark that is identical or indistinguishably similar to an earlier registered trademark or a trademark application cannot be registered, and Article 7/1(c) prohibits the registration of descriptive phrases as trademarks.

Article 8 sets down the relative grounds for refusal of trademark registration. Article 8/1(b) states that if a trademark application is identical or similar to an earlier registered trademark or trademark application, such trademark application will be refused if opposed by a third party, as is the case under EU law.

The defendant claimed that its BLUEDIAMOND registration was valid as no party could be granted absolute rights to the word 'diamond', particularly for Class 14 goods, and that there was no likelihood of confusion between the trademarks.

The first-instance court dismissed the case by stating that the word 'diamond' is a descriptive term in English which is widely used in the jewellery sector; thus, it was not possible to register the term 'diamond' on its own. It also considered that there was no likelihood of confusion between the trademarks when they were perceived as a whole, since they included additional words and devices.

In Decision 2008/105K the 11th Civil Chamber of the Court of Appeals reversed the first-instance decision on the grounds that the plaintiff's trademarks and the defendant's trademark were similar pursuant to Article 8/1(b) of the decree-law. The court stated that the trademarks were similar since they both used the word 'diamond' as their main element and the goods and services covered by the marks were the same or similar.

The court also held that the trademarks' similarity must be evaluated separately in each case since the the decree-law was unclear on the issue of similarity. In order to deem two trademarks similar pursuant to Article 8/1(b), they must be similar when evaluated as a

whole and the similarity should be serious enough to create a likelihood of confusion among consumers.

Decision

The Assembly of Civil Chambers of the Court of Appeals upheld the 11th Civil Chamber's decision and stated that the legal protection provided by a trademark is gained through registration. Thus, a trademark grants all legal rights to its owner independent of its descriptive nature, unless and until it is cancelled by a final cancellation decision.

The assembly noted that the rights holder can use all legal rights arising from registration of its trademark and cannot be stopped from using these rights on the grounds that the trademark is descriptive or weak. If the defendant believed that the plaintiff's trademark was descriptive, then it should have filed a cancellation action.

The assembly evaluated the plaintiff's and defendant's trademarks to determine whether the marks were identical or similar enough to be cancelled in a cancellation action. It held that there was a likelihood of confusion between the trademarks, since they both covered Classes 14 and 42 and the word 'diamond' was the main element in the marks; thus, there was a likelihood of confusion.

Comment

The assembly's straightforward approach to the likelihood of confusion evaluation will not be applicable to all cases. Rather, the approach to the evaluation should be determined based on the *sui generis* nature of each case.

In a likelihood of confusion analysis, the dominant and distinctive elements of the trademarks should first be identified and descriptive and generic elements should be considered secondary. Even if descriptive and generic elements are registered on their own, the other elements of the trademarks that are subject to comparison should also be carefully considered. This is a fundamental principle which has also been accepted by the European Court of Justice (ECJ) (Bently-Sherman, p 817; Bainbridge, p 634; Tritton, p 241; ECJ *Puma-Sabel*, paragraph 23).

In order to determine which elements of a trademark are secondary, the goods and services covered by the trademarks should also be considered. In this respect, the word 'diamond' can be considered a descriptive term for jewellery-related goods under Class 14.

On the other hand, it is incorrect to evaluate the likelihood of confusion only comparing the wording of the trademarks, since the evaluation should also consider the trademarks as a whole (11th Civil Chamber of the Court of Appeals Decision 2001/1183). Consumers will

not evaluate a trademark's elements separately, but rather will perceive the trademark as a whole.

The assembly did not evaluate whether the term 'diamond' had been diluted for the relevant goods at the Trademarks Registry. However, the evaluation of dilution is important to determine the legal strength of a trademark: the more diluted a term, the narrower the protection granted to it will be. In this respect, if a trademark that is subject to evaluation involves weak descriptive elements, the evaluation of dilution will have greater importance in establishing the protection granted to the trademark.

Through a simple search, the assembly would have seen that the TPI has dozens of trademark registrations involving the term 'diamond', clearly signifying that the term is highly diluted by being registered in combination with other word or device elements. Thus, granting the plaintiff exclusive rights over such term would be unfair and unlawful.

Examining the likelihood of confusion between trademarks requires a detailed evaluation with reference to many different aspects. Even more care must be taken over an evaluation involving descriptive words. The assembly's approach towards the likelihood of confusion in cases involving descriptive or generic words is a narrow one that presents significant practical challenges. It leaves no room for third parties to adopt, register or use trademarks consisting of a descriptive element identical to one that has already been registered, without such registration first being challenged in court.

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