

Court of Cassation issues controversial decision on likelihood of confusion in dispute over pharma marks

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Legal updates: case law analysis and intelligence

- The owner of the marks BATIKAR and BATISOL in Class 5 sued the defendant for selling antiseptic disinfectants under the mark MIRADERM BATIMER
- While the IP Court ruled in favour of the defendant, the Regional Court – and subsequently the Court of Cassation – found that the shared element ‘bati’ created a likelihood of confusion
- Arguably, the courts did not take into account the specifics of the relevant sector and the global appreciation principle in the examination of confusing similarity

The Court of Cassation has upheld a decision of the Regional Court, confirming that the use of the trademark MIRADERM BATIMER infringed the plaintiff’s trademarks BATIKAR and BATISOL and constituted unfair competition.

Background

A Turkish company operating in the pharmaceutical sector, which owns the registered trademarks BATIKAR and BATISOL in Class 5, filed an infringement action against a pharmaceutical company selling antiseptic disinfectants under the trademark MIRADERM BATIMER.

The plaintiff argued that the element ‘batimer’ was similar to the plaintiff’s trademarks BATIKAR and BATISOL, particularly due to the shared ‘bati’ element, and that there was a likelihood of confusion.

Decisions

In the initial trial, the IP Court ruled in favour of the defendant, concluding that the trademarks were sufficiently distinct, as the defendant’s trademark consisted of two words and there was no other similarity besides the shared ‘bati’ element.

On appeal, the Regional Court reversed this decision, determining that the similarity between the marks, particularly the shared 'bati' element, created a likelihood of confusion. In particular, it emphasised that:

- the products for which the parties' trademarks were used were antiseptic disinfectants which can be purchased without prescription and appeal to the average consumers; and
- the common element 'bati' is not the name of the active ingredient of the product.

The Regional Court also stated that 'bati' did not have a meaning in the Turkish language and that the defendant was not obligated to use that element. Accordingly, the court ruled that the defendant's use of MIRADERM BATIMER constituted trademark infringement and unfair competition, and issued injunctions against the defendant.

The defendant appealed to the Court of Cassation, which upheld the Regional Court's ruling and confirmed that the defendant's use of MIRADERM BATIMER constituted trademark infringement and unfair competition.

Comment

In terms of the similarity and likelihood of confusion of trademarks in Class 5, the Turkish courts often consider whether the common element of the marks refer to the active ingredient of the products at issue and whether the relevant products are sold on prescription, so that they appeal to a specific consumer group whose degree of attention is high.

In the case at hand, it seems that both the Regional Court and the Court of Cassation followed this examination pattern. However, arguably the courts did not take into account the specifics of the relevant sector and the principle of global appreciation in the examination of confusing similarity.

Although 'bati' does not refer to the active ingredient of antiseptic disinfectants, it is frequently used in trademarks for the same type of product, as can easily be determined by looking at the database of the Turkish Patent and Trademark Office or by making a brief internet search (eg, Batiodin, Baticonol, Batikadin, Batiderm and Batticon). In addition, Batticon has become a well-known antiseptic solution brand (which is recorded as a well-known trademark before the office), which is associated with the same type of product and almost has a generic use. Therefore, especially in infringement cases, the courts should take a broader approach when assessing the likelihood of confusion, and should examine the level of distinctiveness of the trademarks by also considering their common use in the relevant sector, where applicable.

In the present case, considering the above-mentioned facts regarding BATTICON, and the fact that there is another distinctive element before 'batimer' (the last syllable of which is different from the endings of the plaintiff's trademarks), a more thorough examination of confusing similarity should arguably have been conducted by the appeal courts.



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