

Does the 'part included in the whole' principle apply to services under Class 35?

Examination/opposition  
Confusion

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The Court of Appeal recently issued a decision stating that although a trademark application for retail services of certain goods in Class 35 was similar to a senior trademark – the scope of which was indicated with general phrases such as “retail services of all/various goods” in Class 35 – the application could not be rejected on the grounds of confusing similarity unless the owner of the senior trademark proved that it was genuinely used (or at the very least, serious initiatives were being taken to use it) on retail services for the concerned goods. Thus, the appeal court overturned the decision of the Ankara First Civil IP Court on the grounds that the lower court did not examine the issue in terms of whether the mark was used or serious initiatives were being taken to use it for retail services for the goods covered by the application.

## Facts

The applicant filed a trademark application for “Ulucanlar Sirketler Grubu” on December 22 2011 for retail services of particular goods in Class 35. On publication in the *Official Trademark Bulletin*, the opponent, which owned the ULUCAN trademarks (2004 36099 and 2000 15521, registered in Classes 19, 16, 35, 40, 41 and 42), opposed the application pursuant to Article 8/1(b) of Decree-Law 556 on the Protection of Trademarks – that is, on the grounds of a likelihood of confusion.

Upon examining the opposition, the Trademarks Department Directorate of the Turkish Patent and Trademark Office (TPTO) refused the trademark application due to confusing similarity between the trademarks. Although the plaintiff appealed this decision, the application was also rejected by the TPTO Re-examination and Evaluation Board.

The plaintiff filed a court action, requesting cancellation of the board’s decision based mainly on the differences between both the trademarks and their scope of protection. However, the Ankara First Civil IP Court dismissed the case. The court stated that since the original trademarks covered retail services for all goods and the application related to retail services for certain goods, in accordance with the principle of *in toto et pars continetur* (a part is included in the whole) the scope of the applied-for trademark was already covered by the original mark. Therefore, considering the similarity of the trademarks and services covered, the court held that there existed a likelihood of confusion between the trademarks.

The plaintiff appealed to the 11th Civil Chamber of the Court of Appeal, which is competent to review IP law matters at appeal stage. The appeal court examined the file and overturned the first-instance decision, finding that there was no confusing similarity between the trademarks due to lack of similarity of the services. The appeal court clarified its reasoning behind this decision, by stating that as trademarks are protected for the goods and services for which they are registered, if the scope of a mark is vaguely defined, the scope of the protection conferred must be interpreted narrowly in order to limit the scope of protection of the marks. In that vein, the appeal court further stated that in order to be considered an obstacle for the registration of a trademark for retail services in Class 35, the owner of the trademark whose scope is defined generally must prove genuine use or that serious initiatives are being taken to use the mark on the relevant retail services of specific goods covered by the application. In other words, if the trademark owner cannot prove genuine use or that serious initiatives are being taken to use the trademark on retail services related to the retail services covered by the trademark application, the application cannot be rejected. Further, according to the appeal court, designating the scope of the trademark for retail services with general and vague expressions so as to cover all goods in commercial trade is not in line with the requirements of commercial life.

## Comment

Before the entry into force of the Trademarks Directive on January 19 2011, trademarks were allowed to involve general phrases such as “Services for bringing together various commodities for customers to view and purchase”, particularly for retail services in Class 35. However, since the directive entered into force general phrases indicating the scope of applications are no longer acceptable. In other words, following entry into force of the directive, applicants must indicate the goods and services that they wish to cover with sufficient specificity in their applications.

However, trademark applications which were registered before the directive entered into force maintain their validity even though they define the scope of retail services with general expressions, allowing them to cover retail services for all goods. Therefore, the question arises of whether these registrations can form the basis

for the rejection of trademark applications for retail services for particular goods if they are used as original trademarks in oppositions. In the case at hand, the appeal court stated that trademarks where the scope of retail services is determined generally to cover all goods are still valid despite the directive now being in force. However, considering that trademarks are protected for the particular goods and services for which they are registered, the scope of protection of trademark applications must be interpreted narrowly so as not to extend protection. The appeal court further shed light on how to determine the scope of protection of these applications. Accordingly, unless the mark owner proves that its trademark is genuinely used or serious initiatives are being taken to use it on the relevant retail services for specified goods, it should not be considered when determining the similarity of goods and services. In addition, if the use or serious initiatives can be proved only for retail services for some goods, the determination of the similarity of the goods and services will be based on this part of the original trademark.

Thus, with this decision the appeal court has shed new light on the legal position of trademarks whose scope is defined generally in regard to the covered retail services. It remains to be seen how this decision will affect Turkish trademark law practice and whether the appeal court will pursue this principle in future decisions.

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