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Use of earlier mark in later mark does not always result in confusing similarity

Examination/opposition

National procedures

Turkey - Mehmet Gün & Partners

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The Turkish Court of Appeals has reiterated its established precedent that the examination of confusing similarity must take into account the overall impression conveyed by the trademarks to the relevant public.

In December 2007 **Ital Food Industry AD** filed a trademark application with the **Turkish Patent Institute** (TPI) for the sign reproduced below in Class 30 of the **Nice Classification**. The mark consisted of words in both Latin and Cyrillic characters.

КУБЕТИ Turkish company **Eti Gıda San ve Tic AŞ** filed an opposition against the trademark application before the TPI on the grounds that the trademark applied for was confusingly similar to its registered trademarks, which are reproduced below. Eti also based its opposition on the well-known status of its marks, which was undisputed.



In particular, Eti claimed that the trademark applied for would

be perceived as 'kub' and 'eti' by Turkish consumers, which would clearly make a reference to Eti's well-known trademarks and create confusion. In its defence, Ital Food argued that its trademark was composed not only of the 'kubeti' "element (which in fact would be read as 'ku-be-ti' following the Turkish spelling rules), but also of the element in Cyrillic characters, which could not be read by Turkish consumers and would be perceived as a relatively strong device element. Ital Food thus claimed that there was no possibility of confusion between the trademarks for the relevant consumers.

The TPI, having reviewed Eti's opposition grounds and Ital Food's arguments, rejected the opposition on the grounds that the trademark application and Eti's trademarks were not similar in terms of their general impression and that there was no possibility of confusion between the marks.

Eti filed a cancellation action against the TPI's decision before the Ankara IP courts. The first instance court referred the dispute to a panel of experts for examination and the panel concluded that Eti's claims were groundless.

However, the first instance court unexpectedly decided to uphold the action and ruled that the decision of the TPI and the trademark registration of Ital Food should be cancelled. The court stated that there was a possibility of confusion between the trademarks due to the identity of the 'eti' element

and of the goods covered by the marks.

The court's decision was surprising, not only because the court totally overlooked the expert report in the file, but also because it disregarded the established precedent of the Court of Appeals that trademarks should be compared as a whole. The first instance court compared only the elements 'kubeti' and 'eti' (by dividing the element 'kubeti' in a wrongful manner), and disregarded the Cyrillic word in Ital Food's trademark, even though it could be considered as a highly distinctive device mark by Turkish consumers and prevent the possibility of confusion.

Ital Food appealed against the decision of the first instance court, and the Court of Appeals overturned the decision. The Court of Appeals confirmed that:

- there was no visual, aural, conceptual or semantic similarity between the trademarks;
- Ital Food's trademark should be evaluated as a whole (ie, its Latin and Cyrillic elements should be examined together); and
- the first instance court's findings, which were reached by dividing one element of Ital Food's trademark into two parts, could not lead to a reasonable conclusion in terms of confusing similarity.

Following the decision, the case was returned to the first instance court, which complied with the Court of Appeals' opinion and rejected Eti's action based on the above grounds.

The decision of the Court of Appeals is important in that it reiterates its established precedent as to the necessity of examining trademarks as a whole when evaluating the possibility of confusion.

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