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## SAMSONITE v SAMS: Higher Board issues exemplary decision on similarity, taking into account well-known status of earlier mark

Turkey - [Gün + Partners](#)

- The Higher Board of the Patent and Trademark Office found that the marks SAMS and SAMSONITE were similar
- The letter 'O' in some of the SAMSONITE marks was a device highlighting the terms 'Sams' and 'nite' as separable elements
- The well-known status of the SAMSONITE mark in Class 18 increased the likelihood of confusion

The Re-examination and Evaluation Board ('Higher Board') of the Turkish Patent and Trademark Office has found that the trademarks SAMS and SAMSONITE were similar due to the coincidence of the first four letters and the existence of the 'swirl' device in the SAMSONITE trademark (depicted below), which separated and emphasised the first part of the trademark.



### Background

On 19 November 2018 a Turkish company filed an application for the registration of the word mark SAMS in all classes (Classes 1 to 45).

Following the publication of the application in the *Official Trademarks Bulletin*, the owner of the well-known SAMSONITE trademarks filed a partial opposition against the application based on a likelihood of confusion for some of the goods in Classes 6, 9 and 18.

In its decision dated 1 October 2019, the Trademarks Department of the Patent and Trademark Office rejected the opposition due to a lack of similarity of the trademarks and a lack of likelihood of confusion, including a likelihood of association.

The opponent appealed, requesting the re-examination of the opposition by the Higher Board.

### Higher Board decision

On 13 April 2021 the Higher Board accepted the appeal and found that the application for SAMS was visually and phonetically similar to the opponent's SAMSONITE trademarks, considering that:

- the first four letters of the trademarks were the same; and
- the letter 'O' in some of the opponent's trademarks (see the mark depicted above) was a device element which highlighted the terms 'Sams' and 'nite' as separable elements.

The Higher Board also considered that the well-known status of the SAMSONITE trademarks in Class 18 increased the likelihood of confusion, and rejected the registration of the contested application for the opposed goods in Classes 6, 9 and 18.

### Comment

The first letters or syllables play an important role in the visual and phonetic comparison of word trademarks or trademarks with verbal elements, as they catch the consumers' attention first. Although the Patent and Trademark Office sometimes finds trademarks containing the same first letters or syllables to be similar, the outcome varies depending on the circumstances of each case.

The Higher Board's decision in the present case is noteworthy as, in the visual and phonetic comparison of the trademarks, it considered not only the coincidence of the first letters, but also the general impression of the SAMSONITE device trademark. In particular, in that mark the letter 'O' had been replaced by a 'swirl' device which made the terms 'Sams' and 'nite' appear as separable elements, and thus put emphasis on the first part of the trademark. In addition, the decision shows how important it is to introduce a 'well-known trademark' argument as a factor to be considered when assessing confusing similarity, if and when the conditions are present.

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