

DELPHI v DEPLHI: PTO's decision sheds light on interpretation of bad faith

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25 January 2023



TURKEY

Legal updates: case law analysis and intelligence

- Delphi Technologies opposed the registration of DEPLHI in Classes 1, 3 and 4 based on its earlier mark DELPHI
- The board found that the goods covered by the application were similar and related to the goods/services covered by the earlier mark, as they were all used in the auto spare parts sector

- ‘Delphi’ has no meaning in Turkish and it was unlikely that this word would have been chosen as a trademark as a coincidence

In a recent decision, the Re-examination and Evaluation Board (‘the board’) of the Turkish Patent and Trademark Office (PTO) has found that the trademarks DEPLHI and DELPHI were similar and covered similar goods and services, and that the application for DEPLHI had been filed in bad faith.

Background

On 27 August 2021 a Turkish individual filed an application for the registration of the word mark DEPLHI in Classes 1, 3 and 4.

Following the publication of the application in the *Official Trademarks Bulletin*, the owner of the DELPHI trademarks, Delphi Technologies IP Limited, opposed the application in its entirety on the grounds of likelihood of confusion and bad faith.

In its decision dated 17 May 2022 the Trademarks Department of the PTO rejected the opposition, concluding that there was no likelihood of confusion, including a likelihood of association, between the trademarks due to a lack of similarity between the goods and services covered by the trademarks, despite the similarity of the signs.

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

Appeal decision

On 13 October 2022 the board accepted the appeal in line with the legal grounds relied upon in the opposition.

The board first conducted an examination of the likelihood of confusion ground and agreed with the Trademarks Department that there were visual and aural similarities between the opposed mark DEPLHI and the opponent’s DELPHI mark. Further, the board determined that the goods “chemicals used in industry, science, photography, agriculture, horticulture and forestry” in Class 1 and “industrial oils, greases, cutting fluids, dust absorbing, wetting and binding compositions; liquid and gas fuels: petrol, diesel oil, liquified petroleum gas, natural gas, fuel oil and their non-chemical additives” in Class 4 were similar and related to the goods and services covered by the opponent’s registration in Classes 7, 9, 12, 35, 37 and 42, as they were all used in the automotive spare parts sector. Considering that the goods covered by the trademarks were similar, the board concluded that there was a likelihood of confusion between the marks under Article 6/1 of the IP Code (No 6769) as regards the above-mentioned goods.

The board then examined the opponent’s bad-faith claim. It determined that ‘Delphi’ has no meaning in Turkish and that it was unlikely that this word would have been chosen as a trademark coincidentally. This word is registered as a trademark abroad and in Turkey in the name of the opponent; the DELPHI trademark is used in Turkey by the opponent in the automotive spare parts sector and it is known in the relevant sector to a reasonable degree. Taking into account that the goods covered by the application were similar and related to the goods covered by the opponent’s trademarks, the board concluded that the subject application had not been filed in good faith.

Comment

The board’s decision is valuable in that it took all factors into account in assessing bad faith, namely:

- the similarity of the trademarks;
- the similarity of the goods;
- the specifics of the business sector at issue;
- the distinctive characteristics of the opponent’s trademark; and
- its reputation within the sector.

The scope of the examination and the detailed reasoning provided in the decision clearly demonstrate the quality of the assessment made by the board.

Further, the decision shows the importance of introducing all relevant material facts and conditions specific to the case, as they may support each other in reaching a bad-faith decision in a given case.

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