

## **Ferrari secures reverse in opposition case**

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The Turkish Patent Institute has overturned an earlier decision and has allowed Ferrari SpA's opposition against the registration of a word and device mark featuring a rearing horse design (Case 2005-M-3427, August 17 2005).

Turkish company Bisan Bisiklet Moped Otomotiv San ve Tic AS applied to register the mark, which is made up of the word BISAN inside a rectangle placed over a triangle bearing a rearing horse device, for goods in Class 12 of the Nice Classification and services in Class 35.

Ferrari opposed on the basis that the mark was confusingly similar to its world famous rearing horse device trademark also covering goods in Class 12, as well as various similar other national trademark registrations. The well-known status of the rearing horse device trademark has been formerly recognized by the Turkish courts.

The Trademarks Directorate of the Turkish Patent Institute rejected the opposition on the grounds that there was no similarity and likelihood of confusion between Ferrari's trademark and Bisan's sign. Ferrari appealed to the Re-examination and Evaluation Board of the Turkish Patent Institute.

The board allowed the appeal. It held that the mark in Bisan's application was confusingly similar to Ferrari's rearing horse device mark. In coming to this conclusion, it took into consideration the well-known status of Ferrari's trademark.

There are two points of note in this decision. First, the Patent Institute took into account the well-known status of the senior registered mark in determining whether the later trademark application was confusingly similar to the senior registered trademark. Second, it seems from this decision that confusing similarity between a device element of a trademark application, which also includes word elements and other device elements, and a device element in a prior registered mark can be sufficient to conclude that the trademark application as a whole is confusingly similar to the prior registered mark. This in turn suggests that the Patent Institute believes that a device element in a composite trademark can be considered as a dominant element or at least one of the dominant elements of a trademark application. Thus, it is not just word elements to which this privilege is extended.

The decision may yet be appealed to a specialized IP court.