

Ankara District Court: cancellation of several board decisions may be requested in single action
Turkey - Gün + Partners

**Examination/opposition
National procedures**

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In a recent action before the Ankara Second IP Court (Merits No 2015/414 E, 2016/283 K), the applicant had requested the cancellation of four decisions rendered by the Turkish Patent and Trademark Office's Re-Examination and Evaluation Board rejecting the registration of four trademark applications for the figurative marks PRIVAT KAFFEE, depicted below:



The applications had been opposed by a third party based on their confusing similarity with the word mark PRIVAT and the figurative mark depicted below:



Following the filing of the cancellation action, the board also rejected the applicant's trademark application for PRIVAT KAFFEE LATIN BIO, depicted below, based on the same grounds, even though the application was withdrawn by the applicant before the examination date of the appeal.



As the later decision of the board would run the risk of creating a negative precedent in the future, the applicant added a request to cancel this fifth decision to its pending cancellation action by amending its original request, which is a procedural right given to the parties in civil actions without the necessity of receiving the counterparty's approval.

After the exchange of petitions was completed, the court forwarded the matter to a panel of experts. The majority of the panel determined that the board's decisions were appropriate and that the applications should be refused on the ground of confusing similarity; however, one of the experts gave a counter-opinion in this matter.

Once the court had evaluated the statements, the evidence and the experts' report in the file, it decided to uphold the applicant's action, contrary to the determination of the majority of the panel and in line with the expert's opinion submitted in the counter-opinion. It briefly noted in its reasoned decision that the expression '*privat*' is rather descriptive for Turkish consumers, as its English translation - 'private' - is commonly used. Therefore, the trademarks on which the opposition was based were relatively weak. In addition, it noted that the applicant had differentiated its trademarks by adding the word elements 'AFRICAN BLUE', 'BRAZIL MILD', 'COLOMBIA FINO', 'GUATEMALA GRANDE' and 'LATIN BIO', respectively, combined with device elements. Last but not least, the applications contained the umbrella trademark

TCHIBO and would be used in the applicant's own coffee shops, which would remove any likelihood of confusion among the average consumers.

Both the Patent and Trademark Office and the defendant appealed the decision. It was argued in the appeals that:

- the applicant had no legal interest in adding the trademark application PRIVAT KAFFEE LATIN BIO to the action since it had already been withdrawn;
- it is not appropriate to file a single cancellation action against five board decisions;
- the trademarks are confusingly similar; and
- therefore, the first instance decision should be annulled.

The 20th Chamber of the District Court of Ankara examined the matter and rejected all of the defendants' claims with regard to the separation of the action. It noted that the parties and the conflict were the same for all applications and, thus, they could be reviewed in a single cancellation action, which is in compliance with the principle procedural economy. The chamber also determined that there would be no likelihood of confusion between the trademarks if they co-existed on the register due to the reasoning mentioned in the first instance decision.

Regarding the claim based on a lack of legal interest in adding the trademark PRIVAT KAFFEE LATIN BIO to the action despite its withdrawal, the chamber noted that the applicant had a legal interest in filing an action against the board's decision refusing its application, even if the application had been withdrawn. Such determination was based on the fact that the refusal decision of the board still remained even though the application had been withdrawn and, unless the decision was challenged, it could set a negative precedent for the applicant in future applications. However, the chamber decided to partially set aside the first instance decision insofar as it had upheld the action for this specific application, noting that it is not possible to add another request to an action by relying on the amendment process set forth by the Civil Procedural Code. The court determined that there was a legal interest in requesting the cancellation of the decision regarding the withdrawn application, but that this should have been done by filing a separate action, since the scope of the pending action could not be extended by adding a new request for cancellation of another decision.

Arguably, this decision is very satisfactory since it explicitly gives a chance to the parties to file a single action for the cancellation of board decisions where the parties and the grounds of the decisions are the same. It also shows that decisions with a well-grounded reasoning will be found appropriate by the higher court even if they are contrary to the majority's opinion submitted to the file in the experts' report.

The case is now before the Court of Appeals for a final examination and, if the decision is finalised, it will set a strong precedent for combining cancellation actions against board decisions involving the same parties and/or serial applications where the matters can be considered to be related. It is also significant with regard to the determination of the likelihood of confusion in cases involving different distribution channels for each trademark.

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