

**TPI recognises well-known status of JAVA marks
Turkey - Gün + Partners**

**Examination/opposition
National procedures**

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In a decision rendered in January 2015, the [Turkish Patent Institute](#) (TPI) has recognised that the JAVA marks are well known in the software sector, and concluded that there was a risk that the application for JAXA (No 2013/97550) could take unfair advantage of, or be detrimental to, the reputation or distinctive character of the JAVA marks.

The application for JAXA, which covered all the services in Class 42 of the [Nice Classification](#), was published in the *Official Trademark Bulletin* of the TPI on February 12 2014. An opposition was filed against the application before the TPI on the basis that there was a likelihood of confusion between the application and the JAVA marks, registered in Class 42, pursuant to Article 8 of [Decree-Law No 556 on the Protection of Trademarks](#).

Along with the main argument that there was a likelihood of confusion between the trademarks based on the confusing similarity of the signs and the identity of the services, the opponent also alleged as supporting arguments that the JAVA marks had well-known status and that the application had been filed in bad faith.

The TPI determined that there was a likelihood of confusion for the following services covered by the application for JAXA: “computer services, computer programming, computer virus protection, computer system design, creating, maintaining and updating websites for others; software design, rental and updating, provision of internet search engines, hosting, consulting and rental of computer hardware services”.

Further, the TPI surprisingly upheld the argument relating to the well-known status of the JAVA marks, holding:

“As a result of the examination of the opposition as per Article 8/4, since the trademark cited in the opposition is well known by the public in the software sector, it has been concluded that there is a possibility that the trademark application could take unfair advantage of, or be detrimental to, the reputation or distinctive character of the trademark, for the services mentioned [above], and the opposition has been found to be partially well founded.” (Trademark Department Directorate’s decision No 2015-OE-26378, January 21 2015)

Generally, the TPI requires the submission of comprehensive evidence in order to recognise the well-known status of a trademark. Moreover, in cases where the TPI accepts such argument, it does not elaborate on its reasons and briefly mentions that the opposition has been accepted on the basis of the well-known status of the mark. However, in the decision at hand, the TPI specifically stated that the JAVA marks are well known in the software sector, accepting that the well-known status of certain trademarks in their sectors could be acknowledged even if such argument has been asserted only as a supportive argument.

The decision is significant in light of a ruling of the Court of Appeals (Merit No 2005/4005; Decision No 2006/6569), in which the court had held:

“...considering as a fact that well-known trademarks benefit from a wider protection that does not apply only in relation to the same or similar classes, that the plaintiff’s trademark ZIK ZAK covers the same goods as the well-known trademark TIK TAC, [where the marks are] read and presented on the market in their English pronunciation, the trademark of the defendant creates a likelihood of confusion with the plaintiff’s trademark and, therefore, there is a likelihood of association between the trademarks”.

The court had thus declared that well-known trademarks benefit from a wider scope of protection.

Accordingly, in the present case, the examiner accepted the ‘well-known status’ argument, which had been submitted as a supportive argument in the opposition (along with the main argument of a likelihood of confusion between the marks), in line with the decision of the Court of Appeals, and made reference to the awareness of the mark in the relevant sector.

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