

Similarity and the Likelihood of Confusion for Trademarks

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Turkey is one of the countries that examine the similarity of trademarks under absolute grounds for refusal.

Within this context, similarity is a ground for refusal both within the scope of Article 7 of Trademark Decree Law no 556, in which the absolute grounds for refusal are listed, and Article 8, which lists the relative grounds for refusal.

Undoubtedly, the level of similarity that should be taken into account during the examination on absolute grounds (Article 7) and relative grounds (Article 8) is not the same. According to Decree Law no 556, for the similarity test on absolute grounds under Article 7, the Turkish Patent Institute (TPI) should consider the "sameness" and "confusing similarity" of the trademarks.

Examinations based on relative grounds under Article 8, on the other hand, consider "confusing similarity" and "likelihood of confusion". In other words, as a rule, "likelihood of confusion" is not considered during the similarity test on absolute grounds under Article 7.

In practice however, in some cases the TPI considers the trademarks as "confusingly similar" according to absolute grounds although the trademarks should have been tested on relative grounds and the "likelihood of confusion" should also have been evaluated.

In other words, because the TPI follows the letter of Article 7 exactly, it rejects the later confusingly similar trademark without evaluating the likelihood of confusion. This practice surely causes unfair outcomes to occur since not all trademarks that are confusingly similar would necessarily create confusion between the trademarks in the consumer's mind.

Indeed, in some cases trademark applications are being rejected because of earlier non-identical trademarks and it is usually not possible to overcome this provisional refusal decision (because consent letters are not acceptable in Turkish practice).

Occasionally a trademark that would not meet opposition if published cannot obtain registration as it cannot pass the examination on absolute grounds. This ambiguity on the limit of the TPI's discretion on similarity examinations has led the Appeal Court to draw a line of demarcation for Article 7 examinations on absolute grounds.

In February 2012, the 11th Civil Chamber of the Turkish Appellate Court rendered a landmark decision (Gun Law Firm archive) with respect to examinations on absolute grounds. The trademarks subject to the decision were "SELEX", which was applied for the goods and services in classes 09, 36, 37 and 39 and the earlier trademarks "SSSS SSSSELEKSSS", "SELEKS KARGO", "SELEKS LOJISTIK", "SELX CARGO" and "SELX LOGISTICS" in the same classes.

The TPI rejected the trademark SELEX because of the earlier trademarks containing the phrases SELEKS and SELX. Once the First Instance Court had approved the TPI's decision the dispute was taken to the Appeal Court.

The Appeal Court upheld the First Instance Court decision with a very comprehensive justification based on the similarity test of Articles 7 and 8. Within this context the Appeal Court stated that the TPI should understand sameness as "identity", "alike", "exactly identical" or "copied". Identical trademarks stylized with different colors or

typed with a different character size should also be considered within this scope.

"Confusing similarity" as considered within the scope of an examination on absolute grounds means trademarks with little or no difference, i.e., marks that could not be distinguished by the average consumer. Therefore when the TPI accepts a trademark as similar to an earlier trademark it rejects the new application on the grounds of "confusing similarity" without assessing the "likelihood of confusion".

However, the Appeal Court is of the opinion that confusingly similar trademarks cannot be rejected without evaluating the likelihood of confusion. In other words, the Appeal Court states that if the TPI deems the trademark confusingly similar it should also look at the likelihood of confusion. As the likelihood of confusion cannot be assessed within the scope of Article 7 confusingly similar trademarks should not be rejected on absolute grounds.

Therefore the Appeal Court upheld the First Instance Court decision, based on the reason that even though the trademark SELEX is similar to the phrases SELEKS and SELX of the cited trademarks, the cited trademarks contain different elements with different letters and style. The Appeal Court is of the opinion that with these differences the trademarks cannot be deemed as identical and the TPI cannot ex officio accept the likelihood of confusion.

The decision of the Appeal Court is remarkable as it clearly accepts that the likelihood of confusion should be assessed upon a third party opposition, not during the examination on absolute grounds. In other words, a new trademark application that appears to be similar to an earlier trademark may be accepted, but it is up to the third party opposition to oppose it based on "confusing similarity".

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