

TPTO Takes Helpful Approach to Classification

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Under Turkish law, identical or indistinguishably similar trademarks covering the same classes (or classes which cover the same kind of goods) cannot co-exist. This is an absolute ground for rejecting a later trademark application.

In this regard, when deciding whether to reject a trademark, the *Turkish Patent and Trademark Office ("TPTO")* considers:

- whether the application is identical or indistinguishably similar to an earlier trademark, and
- whether the goods and/or services covered by the application are identical or indistinguishably similar to those covered by the earlier trademark.

When examining whether the compared goods and/or services are identical or indistinguishably similar, the TPTO looks into their subclasses. The TPTO's examination is grounded in the classification list, prepared in accordance with the Nice Classification system.

For instance, if the earlier trademark covers headgear articles (a subclass under Class 25) and the applicant wishes to register their mark for caps (an article that falls into the "headgear" subclass), the earlier trademark will be cited for the latter application on absolute grounds. Class 25 is not a very large-scale class, as headgear does not refer to a wide of spectrum of items. Consequently, applications/registrations covering this class do not create problems in practice.

However, there are classes and subclasses that cover a wide range of items. For example, the first subclass of Class 1 covers "*Chemicals used in industry, science, photography, agriculture, horticulture, and forestry.*" The term industry includes agriculture (fishing, timber, tobacco), automotive, electronics, aerospace, chemical, pharmaceutical, defence, telecommunications, paper, steel, construction, food, textile, energy, and petroleum industries. Just because they are gathered under the same subclass does not necessarily mean that these goods are indistinguishably similar. On the contrary, there is a great difference between the chemicals used in the automotive and food sectors.

Considering this wide spectrum, the TPTO recently decided that even though these goods are classified under the same subclass, they cannot be considered as the same kind of goods. The case at hand related to a comparison of two trademarks that were almost identical: the only difference was the type of font used, and the fact that one had a minimal device element. However, it is also worth mentioning that these trademarks were not highly originally composed/created words."

In its decision, the TPTO clearly recognized the indistinguishable similarity of the compared trademarks. However, it further added that despite the fact that these goods and services fall into the same scope, the TPTO has the authority to re-evaluate their nature taking into account the specific features of each class and subclass.

Turkey's classification list has been prepared in accordance with the Nice Classification. The basis and practices regarding this system are regulated by Communiqué on Classification of the Goods and Services Covered by the Trademark Applications ("**Communiqué**"). Indeed, Articles 3 and 4 of the Communiqué give the TPTO the authority to re-evaluate the nature of goods and their classification in Turkey's classification system.

In accordance with the Communiqué, during the absolute grounds examination, the TPTO is primarily required to consider the goods and services groups in Turkey's classification list to decide whether they are indistinguishably similar. However, the TPTO is also authorized to keep the scope of these groups narrower and/or wider when evaluating their similarity.

As explained above, some classes cover goods from various industries. Therefore, the goods used in different industries might be regarded as indistinguishably similar. However, such an approach does not always comply with the methods for determining the similarity level between goods and services. When making comparisons, the following should also be taken into consideration:

- Economic significance of goods and services
- The ways consumers use goods and suppliers provide services
- Where the goods are generally manufactured/sold, and the services are provided
- The target consumer group

Answers may vary significantly for some goods that fall into the same subclass.

In this regard, the TPTO's decision is not surprising, yet, on the other hand it is not very usual. Overall, it is very promising to see the TPTO exercising its rights arising from the Communiqué and keeping the extend of its *ex officio* examination's scope in a narrowed approach. It is clear that the TPTO requires sharp, clear and direct similarity which does not leave any room to interpretation.

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