

Turkish Court Considers Rights Arising from a Trademark Series

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A Turkish court recently held that a trademark application which simply drops the figurative element from an existing trademark (which combined both word and figurative elements) does not fall within the scope of the earlier trademark's rights. Therefore, the court held that unless both elements were used, the later trademark application does not violate the earlier trademark's rights. It clarified that a trademark cannot be considered part of a trademark series if it is confusingly similar to someone else's trademark.

In the case at hand, both parties owned trademarks with similar word elements, although they operate in different sectors. Company A's earlier trademark registration contained figurative and word elements. Company B's later trademark application involved a word element, excluding the figurative element.

Company A objected to the later trademark application, but this objection was rejected by the Re-evaluation and Examination Department of the Turkish Trademark and Patent Office.

Company A initiated a lawsuit seeking to overrule the rejection and expunge the disputed trademark application from the register, on the basis that it risked diluting the earlier trademark.

Company B argued that the visual aspect in the earlier registration was not a significant trademark element and the fundamental element of their trademark was actually the word, which is the similar aspect between the two marks.

The Court of First Instance ruled in Company B's favor, holding the trademark's visual element to be secondary.

The Plaintiff appealed the Court of First Instance's decision. The Court of Cassation overruled the lower court's decision, saying the right acquired by Company A's earlier trademark includes the registration's word and figurative elements. It held that any imperfect recollection left in memory of the average customer in this context is due to the trademark's figurative element. Therefore, as long as the same imperfect recollection is left, the application can be registered. In other words, the court said that to accept a serial trademark defence, the application should not be confusingly similar to someone else's trademark.

The case was sent back to the Court of First Instance for a re-examination. However, the Court of First Instance insisted that its former decision should stand, in favour of Company B. Therefore, the matter was escalated again, this time to the highest body within the Court of Cassation, the Assembly of Civil Chambers ("**Assembly**").

The Assembly agreed with the Court of Cassation's decision in favour of Company A. It held that the rights which the earlier trademark had acquired applied to the combination of word and figurative elements.

Therefore, unless both elements are used, Company B's later trademark application does not violate the earlier trademark's rights.

(Assembly of Civil Chambers, decision dated 14.06.2017, No. E. 2017/1729 K.2017/1186 -[link](#))

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