

Court clarifies meaning of 'identical' and 'indistinguishably similar' under Article 7/1(b) Turkey - Gün + Partners

June 19 2015

In a recent decision (merit number 2014/15516, decision number 2015/327, January 14 2015), the 11th Chamber of the Court of Appeal has upheld a decision of the court of first instance (Ankara Fourth Civil Court of Intellectual and Industrial Property Rights, merit number 2014/17, decision number 2014/136, June 11 2014) in which the court had cancelled a decision of the Re-Examination and Evaluation Board of the [Turkish Patent Institute](#) (TPI). The board had rejected the plaintiff's trademark *ex officio* based on Article 7/1 (b) of the [Decree Law No 556 on the Protection of Trademarks](#), which states that "a trademark that is identical, or indistinguishably similar, to an earlier registered trademark or a trademark with an earlier filing date in respect of identical or similar products or services shall not be registered".

The plaintiff's trademark application for the figurative mark BOGGI was rejected by the TPI based on absolute grounds due to its indistinguishable similarity to the cited trademark BAGGI:



Upon dismissal of the applicant's appeal by the Re-Examination and Evaluation Board, the applicant filed an action for the cancellation of the board's decision.

In its decision, the first instance court held that the word 'identical' in Article 7/1(b) should be interpreted as meaning an exact copy of an earlier trademark, while the expression 'indistinguishably similar' in the same article should be interpreted as meaning a strong similarity between the trademarks such that consumers cannot separate them from each other at first glance. The court found that there was no such similarity between the trademark application and the cited trademark - when the trademarks were compared, it could easily be seen that the application includes various word and device elements. The fact that only one word in the marks contained identical letters - the words 'Baggi' and 'Boggi' were not even identical - did not result in the conclusion that these marks were indistinguishably similar within the meaning of Article 7/1(b) of the Decree Law.

Upon appeal by the TPI, the Court of Appeal upheld the decision of the first instance court, stating that it was not in contradiction with the law. The TPI did not file a review application against the Court of Appeal's decision, so the decision in favour of the plaintiff is now final.

Arguably, it is an important decision which can guide the TPI when interpreting Article 7/1(b) of the Decree Law at the *ex officio* examination stage. The scope of this article should be considered to be very narrow, and a trademark application should be rejected under Article 7/1(b) only if it is an exact copy of an earlier trademark or where the trademarks cannot be separated from each other at first glance - which was not the case for the trademarks in the present case. This decision can thus be used as guidance by the TPI in its implementation of Article 7/1(b), which is usually broader than what the article foresees in reality.

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