

International report - Is 4X4 equal to 8X4 under trademark law?

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The Ankara Third Civil Court of Intellectual and Industrial Property Rights recently ruled on the confusing similarity between the well-known trademark 8X4 and the trademark FASHION 4X4. The court cancelled the decision issued by the Turkish Patent Institute (TPI), which concluded that the trademarks 8X4 and FASHION 4X4 were not confusingly similar under Article 8/1(b) of Decree-Law 556 on the Protection of Trademarks.

Facts

A company operating in the cosmetics sector applied for the registration of the trademark FASHION 4X4 for “Bleaching and cleaning preparations. Perfumery; cosmetics; deodorants for personal use (including deodorants for human and animals). Soaps. Dentifrices. Abrasive preparations; emery cloth, sandpaper, pumice stones, abrasive pastes. Polishing preparations for leather, vinyl, metal and wood” in Class 3. The opponent opposed the application based on the likelihood of confusion with its 8X4 trademarks, which were also registered in Class 3. At first instance the TPI Trademarks Department Directorate refused the opposition on the grounds that the trademarks were not confusingly similar. The opponent appealed and the Re-Examination and Evaluation Board confirmed the decision, also based on the lack of overall similarity between the trademarks 8X4 and FASHION 4X4.

Decision

The opponent then brought the matter before the specialist IP courts. The Ankara Third Civil Court of Intellectual and Industrial Property Rights heard the matter and ordered the cancellation of the trademark FASHION 4X4 for “Bleaching and cleaning preparations. Perfumery; cosmetics; deodorants for personal use (including deodorants for human and animals). Soaps. Dentifrices. Pumice stones” in Class 3. However, it concluded that goods falling under “Polishing preparations for leather, vinyl, metal and wood” in the same class would not be subject to a likelihood of confusion.

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The court stated that the element '8X4' was the main and dominant element of several 8X4 trademarks shown as grounds of opposition (eg, 8X4 HAPPINESS and 8X4 DISCOVERY) and is an original sign for personal care products. Further, the court confirmed that the 8X4 trademark is well known, especially for deodorants. It then held that the '4X4' element in the trademark FASHION 4X4 stood out because the word 'fashion' is not a highly distinctive word in terms of the relevant goods and the relevant sector. In addition, it argued that the '4X4' element in the contested trademark was composed in a similar way to 8X4, as both trademarks contain the formulation '?x4'.

Thus, the court concluded that the trademarks 8X4 and FASHION 4X4 were confusingly similar pursuant to Article 8/1(b) of Decree-Law 556, and that consumers were likely to confuse the trademarks when they saw them on the same goods, considering the originality of the element '8X4' for personal care products.

The owner of the FASHION 4X4 mark had filed another similar trademark application for AMORE 4X4, and the IP courts have also considered the invalidity of this mark. Recently, the Ankara Fourth IP Court concluded that the trademark AMORE 4X4 was also confusingly similar to the 8X4 trademarks and ordered the partial invalidation of AMORE 4X4 in parallel with FASHION 4X4 decision.

These decisions make it clear that numbers cannot be monopolised by trademark registrations. However, in the case at hand, the use of the element 'X4' in both trademarks and the adoption of the same style led the court to conclude that the compared trademarks were confusingly similar.

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