

Court clarifies differences in scope between Articles 7/1(b) and 8/1(b) of Decree Law

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The Court of Appeal has established and clarified the differences in scope and implementation between Article 7/1(b) and Article 8/1(b) of the Turkish Decree Law 556 pertaining to the Protection of Trademarks (Decision 2010/10214E). Article 7/1(b) provides that the Turkish Patent Institute (TPI) can reject *ex officio* trademark applications that are identical, or indistinguishably similar, to earlier trademarks or trademark applications. In contrast, Article 8/1(b) provides that confusingly similar trademark applications can be rejected upon the opposition of prior rights owners.

The 11th Civil Chamber of the Court of Appeal concluded that the trademark application for SELEX could not be rejected under Article 7/1(b) of the Decree Law based on the trademarks SSSS+SSSSELEKSSSS and SELEKS KARGO, SELEKS LOJİSTİK – SELX CARGO SELX LOGISTICS, and dismissed the IP Court's decision. The Court of Appeal stated that the term 'identical' in the sense of Article 7/1(b) means that the compared marks are the same, without any differences, or that one mark is a reproduction of the other; the expression 'indistinguishably similar' means that the marks are perceived as identical, since the differences between the marks are so insignificant that the general impression left on the average consumer of the relevant goods or services will be the same.

Where the marks under comparison are 'identical' or 'indistinguishably similar', it is not necessary under Article 7/1(b) to determine whether there is likelihood of confusion, since it is already accepted that the similarities between the marks are strong and clear, and a further examination is thus unnecessary. As a result, within the context of an examination under Article 7, where the similarities between the marks are such that the TPI must assess whether there is a likelihood of confusion among consumers (ie, where the TPI must use its discretion), it will be impossible to reject the application *ex officio* on the grounds that the marks are "indistinguishably similar".

The Court of Appeal strengthened its conclusion by stating that if, during the *ex officio* examination, the TPI must determine whether there is a likelihood of confusion among consumers, then one cannot argue that the marks are indistinguishably similar.

The court also highlighted that the issue of whether the similarities between the marks should be considered under Article 7/1(b) or Article 8/1(b) should be determined on a case-by-case basis, taking into consideration the relevant circumstances of the case.

Based on the above, the court concluded that, in light of the similarities between the trademarks SELEX on the one hand, and SSSS+SSSSELEKSSSS and SELEKS KARGO, SELEKS LOJİSTİK – SELX CARGO SELX LOGISTICS on the other, it was necessary to assess whether there was a likelihood of confusion between the marks among consumers. Indeed, it could not be accepted in advance that the marks were indistinguishably similar. Therefore, the court established that this comparison fell within the scope of Article 8/1(b); it thus dismissed the IP Court's decision, which had upheld the TPI's decision to reject the application under Article 7/1(b).

In this landmark judgment, the Court of Appeal solidified the principles for the rejection of a trademark application under Article 7/1(b) of the Decree Law. The decision also suggests that the scope of Article 7/1(b) should be as narrow as possible. It is expected that the decision will have an impact on the strict

practice of the TPI, and that the number of trademark applications rejected under Article 7/1(b) will gradually decrease - as long as the TPI follows the decision.