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## Court of Appeals finds likelihood of confusion between short marks in surprising decision

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- **Koton's application for a mark including a 'cotton flower device' between the letters 'C' and 'M' was rejected based on the earlier mark COM**
- **The first-instance court, the District Court and the Court of Appeals all upheld the decision**
- **The decision shows that the prevailing approach to the similarity of short trademarks is quite narrow, even where the earlier mark is weakly distinctive**

In a somewhat controversial decision (Case 2019/5262 E, 2020/3449 K, 2 July 2020, recently published), the Court of Appeals (11<sup>th</sup> Chamber) has considered the likelihood of confusion between short trademarks.

### Background

The case was filed before the Ankara Second IP Court (Merits No 2017/139 E, 2017/411 K) by a famous clothing company, Koton Mağazacılık Tekstil Sanayi ve Ticaret Anonim Şirketi ('Koton'), the owner of the distinctive logo depicted below:



Koton requested the cancellation of a decision rendered by the Re-Examination and Evaluation Board of the Turkish Patent and Trademark Office refusing to register the trademark depicted below for goods and services in Classes 18, 25 and 35:



The application had been rejected upon opposition by a third party based on its confusing similarity with the word mark COM, registered for goods in Class 25 and services in Class 35, among others.

Koton's trademark application covered goods and services in Classes 3, 9, 14, 18, 25 and 35, but the Trademarks Department Directorate upheld the opposition for some of the goods and services in Classes 3, 9, 14, 18, 25 and 35. The decision was appealed by Koton, which resulted in the refusal of the application for goods and services in Classes 18, 25 and 35.

Koton challenged the decision, claiming that the trademarks differed visually, aurally and semantically, since the application included the 'cotton flower device', which has been registered and used by Koton for many years, and that the company also used the trademark applied for. The defendant claimed in its petition that the signs were similar visually, aurally and semantically, and that the presence of the cotton flower device did not make any difference in this regard.

### Court decisions

Upon completion of the exchange of petitions, the first-instance court decided that Koton's trademark application consisted of the word element 'com' and a device, while the marks on which the opposition was based were the word marks COM. The parties' marks would be pronounced in the same way and the presence of the cotton flower device would not change this. Therefore, the court rejected the action filed by Koton.

This decision was upheld by the District Court on appeal, and by the Court of Appeals on final appeal based on the conclusion that there was no justified reason to annul the first-instance decision.

### Comment

This surprising decision shows that the approach of the Patent and Trademark Office and the courts to the similarity of short trademarks is quite narrow, even where the senior trademark is weakly distinctive. The contested trademark application consisted of the cotton flower device within the '@' sign between the letters 'C' and 'M', while at least one of the earlier trademarks consisted solely the word 'com' without a dot. '.com', the abbreviation used for top-level domains, is obviously generic and descriptive and, even without the use of the dot before it, individuals would still perceive COM as '.com' due to its widespread use.

Arguably, the courts should have considered the low inherent distinctive character of the earlier trademark and the fact that the parties' marks contained only two identical letters. In addition, the presence of the cotton flower device, which has been used by Koton for a long time, should have been found sufficient to prevent a likelihood of confusion. The authors thus believe that the Court of Appeals should have overturned the first-instance decision and found that the trademarks were not confusingly similar.

Further, the decision does not provide any guidance regarding the change to the Court of Appeals' prevailing approach to the role of weak trademarks in the assessment of confusing similarity, which may be found in *CHESTERFIELD BLUE LINE v BLUE LINE* and *BENIMO v BUDA BENIM*). Therefore, it should not serve as a strong precedent for future cases.

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