

Class 46

Class 99

CLASS 46

Now in its twelfth year, Class 46 is dedicated to European trade mark law and practice. This weblog is written by a team of enthusiasts who want to spread the word and share their thoughts with others.

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TUESDAY, 14 APRIL 2020

Turkish Court of Appeal rules on likelihood of confusion

The Turkish Court of Appeal has overturned lower court decisions in a case concerning likelihood of confusion between trade marks sharing a common weak element. Güldeniz Doğan Alkan and Ayşenur Çıtak explain.

Origins of the dispute

Türkiye İş Bankası A.Ş., which is a popular bank and holder of the well-known trade mark Türkiye İş Bankası in Turkey, filed an application for the mark shown on the right in classes 9 and 36.



An opposition was filed against the application relying on the prior registered trade mark CEPMATİK in class 9. The Turkish Patent and Trademark Office partially accepted the opposition for goods in class 9. İş Bankası filed an action for the cancellation of the Office's final decision, arguing that the trade marks are not similar and there is no likelihood of confusion.

Before passing to the details of the case, it should be noted that CEPMATİK can be directly translated to English as MOBILEMATIC. As explained on the website of İş Bankası, İşCepMatik is a new generation ATM allowing cardless cash withdrawal & cash deposit using a smartphone (detailed information can be seen [here](#)).

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The first instance IP Court determined that the main and distinctive element of the parties' trade marks is the CEPMATİK phrase. It stated that the average consumer of goods in class 9 would inevitably associate the trade marks due to the indistinguishable similarity between their main elements and they would perceive them as serial trade marks. As a result, the IP Court decided to dismiss the case (*Ankara 2nd IP Court, Merit No: 2916/284 E., Decision No: 2017/202 K., Decision Date: May 11, 2017*).

İş Bankası appealed the decision before the District Court and the appeal was rejected (*20th Civil Chamber of Ankara District Court, Merit No: 2018/299 E., Decision No: 2018/995 K., Decision Date: October 04, 2018*). The matter was finally reviewed by the Court of Appeal upon further appeal.

Decision of the Court of Appeal

The Court of Appeal considered the mark Cepmatik to be a weak trade mark. Also, it pointed out that the subject application includes the well-known Türkiye İş Bankası and İş trademarks. Considering the existence of these well-known trade marks, the Court considered that the application is sufficiently differentiated from the prior trade mark CEPMATİK.

The Court of Appeal further explained that it is not possible for average consumers of goods in class 9 to incline to goods bearing the disputed trade mark even if their aim is to buy goods bearing the prior CEPMATİK trade mark.

Therefore, the Court of Appeals concluded that there is no likelihood of confusion between the marks (*11th Civil Chamber of Court Of Appeals, Merit No: 2018/5860 E., Decision No: 2019/7003 K., Decision Date: November 11, 2019*).

As a result of this assessment, the Court of Appeal overturned the lower courts' decisions and the case was sent back to the IP Court. As to the next steps, a trial will be opened for the case and the IP Court will decide whether to comply with the Court of Appeal's ruling or not.

Comprehensive evaluation

The decision of the Court of Appeal shows that likelihood of confusion between trade marks should be evaluated comprehensively, especially if the contested phrase includes additional well-known trade marks as an element. Therefore, one common phrase is not sufficient for trade marks to be confused, even if it is the main element in the mark.

However, in another earlier dispute, the Court of Appeal's Assembly of Civil Chambers ruled that there the application Blue diamond & device is similar to earlier trade mark DIAMOND & device, disregarding the weakness of the prior registered trade mark. In this decision, the Court of Appeal ignored other additional elements. But we can assume that, based on its recent decision, the Court of Appeal takes into consideration the weakness or descriptiveness of the main element of the earlier trade mark.

Güldeniz Doğan Alkan and Ayşenur Çıtak of Gün + Partners, a MARQUES member

Posted by: Blog Administrator @ 09.46

Tags: [Türkiye İş Bankası](#), [LoC](#), [CEPMATIK](#),

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TUESDAY, 7 APRIL 2020

New misleading invoice alert from EUIPO

EUIPO has circulated details of a new scam that is



11/01/2020

circulating.

The scam

involves a fake EUIPO decision notification, and demand for payment of a registration fee (sample pictured right).

The scam has been reported by users over the past fortnight. It uses EUIPO's logo, name, acronym and letterhead.

EUIPO is urging anyone who receives this scam email to report it to information@euipo.europa.eu. It also wants to hear from IP offices that have experienced this type of scam (some national offices have already reported similar misleading invoices).

EUIPO has posted details of the scam on its social media pages, and encourages people to share and repost to warn as many users as possible.

The Office has contacted the relevant banks in Poland and has lodged a criminal complaint with the Office of the Public Prosecutor in Warsaw. A criminal investigation is pending.

EUIPO advises users to protect themselves against scams. In particular note that: (1) EUIPO never sends invoices or demands for payment to users; (2) statutory fees are published online and EUIPO only uses two Spanish bank accounts; (3) if there is any doubt about an invoice, contact EUIPO; and (4) users should consider registering for the User Area on the EUIPO website.

For more information, read "[New misleading invoice alert – fake EUIPO decisions](#)" on the EUIPO website.

Posted by: Blog Administrator @ 09:10

Tags: [misleading invoices](#), [scam](#), [EUIPO](#),

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Changes in Russia due to COVID-19

In order to prevent the spread of



Rospatent
Federal Service
for Intellectual Property

COVID-19 virus on the territory of the Russian Federation, on 26 March 2020 the Russian Government made a decision to minimize communication between people and announced days off from 30 March to 3 April. There is a high probability that the days off will be extended.

For this reason, Rospatent was closed from 30 March 30 to 3 April. All deadlines that fell between 30 March and 3 April are moved forward a week. During this time, the Patent Office received electronic documents related to the daily operations: filing applications, responding to the requests for examination, extending the periods relating to patents, trade marks and industrial designs, but all orders will be fulfilled after the termination of the weekends and the work resumption.

Information on the further Rospatent operating mode will be available subsequently.

Law firms are also forced to stop operating in a standard mode. Fortunately, modern technologies allow us to carry out the activities by working remotely and staying in touch with the world via email, phone and video conference.

Sergey Zuykov, Zuykov and Partners, member of the MARQUES Dispute Resolution Team

Posted by: Blog Administrator @ 15.46

Tags: [COVID-19](#), [Rospatent](#),

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THURSDAY, 2 APRIL 2020

Latest COVID-19 news from WIPO

WIPO has published updated information on the impact of the COVID-19 pandemic on the Madrid

System.

The information is available to read on WIPO's website [here](#). The page will be updated by WIPO as more instructions become available:

It covers:

- Remedies and extensions of time limits
- Suspension of postal communications
- Temporary measures concerning certified documents and extracts services
- Measures implemented by IP Offices
- Madrid System online services

In addition, readers might like to note:

[Information Notice 12/2020 on Temporary Measures Concerning Certified Documents and Extracts Services](#)

[Information Notice 11/2020 on Suspension of Postal Communication with the International Bureau](#)

[Information Notice 10/2020 on Closure of the Office in Colombia](#)

[Information Notice 7/2020 on Remedies Available Against Failure to Meet a Time Limit and Extension of Time Limits in Case of Closure](#)

Posted by: Blog Administrator @ 17.00

Tags: COVID-19, WIPO, Madrid System,

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WEDNESDAY, 1 APRIL 2020

Relief for missing deadlines in China

According to an official notification issued by CNIPA on 27 March 2020, the remedy for missing deadlines



due to COVID-19 under [Announcement No. 350 of 28 January 2020](#) applies to all foreign parties

[20 January 2020](#) applies to all foreign parties, including trade mark applicants, trade mark right holders and agents (see announcement [here](#)).

Announcement No. 350 suspends the relevant time limit given in Law, or the deadline specified by the CNIPA, from the date when the obstacle to the exercise of the rights arises until the date when the obstacle for exercise of the right is removed, except as otherwise stipulated by law.

The applicant may claim for continued protection within two months from the date when the obstacle to the exercise of rights is removed, with supporting evidentiary material for the restoration of rights.

We would like to take this opportunity to report to you that our colleagues and our families are all safe and healthy now. The overall situation in China is basically under control and the recovery of economic and social life is being expedited.

We do hope the international community works with solidarity to overcome the pandemic soon.

By Chuanhong Long, Vice President of CCPIT Patent and Trademark Law Offices. Reproduced with permission

Posted by: Blog Administrator @ 14.59

Tags: [COVID-19](#), [China](#), [CNIPA](#),

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MONDAY, 30 MARCH 2020

GREECE: New trademark law

Perhaps not the most fortunate timing, but on 20 March 2020, Greece's new - and long awaited - TM law was

enacted. Law No. 4679/2020 represents the country's transposition instrument of Directive 2015/2436 and a further effort of alignment with the system of rule of



HELLENIC PARLIAMENT

the European Trademark. The new trademark law brings about significant changes, which include:

Relative grounds for refusal are no longer examined ex-officio

So it's EUIPO-style for the GR TM Office as well, with notifications sent to proprietors of TMs cited in the automated report upon filing

Civil courts have dual competence in trademark invalidity proceedings

The competence to rule upon the validity of trademarks has been transferred from administrative to civil courts. A cancellation action before the Trademarks Administrative Committee is always available, but the Committee's decision are now subject to appeal before the single-Member First Instance Court of Athens and not before the administrative courts.

This change goes hand-in-hand with the introduction of invalidity / cancellation counter-claims in infringement proceedings before the civil courts.

Rules have been set in place to avoid parallel proceedings (e.g. a cancellation action before the Trademarks Administrative Committee) and the risk of conflicting judgments. The invalidity counter-claim is also available to the defendant in temporary relief proceedings, but cannot lead to definitive invalidity

Non-use as defense in infringement proceedings, both in the context of a main action and in temporary relief proceedings

The defendant in infringement proceedings can raise non-use of the trademark as a defense, rather

than having to file separate cancellation action before the Trademarks' Committee, as was the case under the previous legal regime. Art. 40 of the new law sets up a particular procedure for such proof of use request, essentially 'cracking' the general rules of civil procedure.

Remedies for infringement

Damages are awarded to the trademark owner only in the event of willful infringement or gross negligence on the part of the infringer (Art. 38 para. 5), while, under the previous legal regime, any type of negligence would suffice for damages purposes. The wording employed is based on the Greek text of Art. 13 para. 2 of the IPR Enforcement Directive, which translates, perhaps unsuccessfully, "reasonable grounds to know" as "gross negligence". This provision may be problematic, particularly as such type of (higher) culpability standard for damages is not required for damages over copyright or patent infringement.

Voluntary Mediation before the Trademark Office

Its success remains to be seen.

Other notable provisions include

- Changes in the renewal procedure to reflect Art. 49 of Directive 2015/2436 (Art. 36), but, now late renewal will not *"overturn rights of third parties which were acquired in the meantime"*.
- The transposition of Art. 8 of Directive 2015/2436 (art. 53) where lack of distinctive character or of reputation of an earlier trademark prevents the cancellation of a later trademark.
- The transposition of Art. 18 of Directive 2015/2436 (Art. 40) which provides that

2015/2436 (Art. 48) establishing the "intervening right" defense of the owner of a later trademark in infringement proceedings.

- A slight change in the Greek Trademark Office's fees structure to favour online filing and renewal.

Posted by: Nikos Prentoulis @ 07.44

Tags: [Greece](#), [new law](#), [trademarks](#), [Directive 2015/2436](#),

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SUNDAY, 29 MARCH 2020

Time limits extended in Turkey

In connection with the COVID-19 pandemic, the Turkish Parliament has approved Law No. 2/2633 adapting measures to suspend time limits for various



administrative and legal proceedings including those concerning IP rights. It came into force upon its publication in the Turkish Official Gazette on 26 March.

The Turkish PTO and the legal authorities will remain open and these measures in the Law are aimed to extend deadlines just in case:

- Time limits for administrative proceedings, including ones before the Turkish PTO, expiring between 13 March 2020 and 30 April 2020 have been suspended until 1 May 2020. This suspension includes all procedural deadlines from payment of any official fees for obtaining or maintaining any IP rights to filing responses to office actions and from submission of oppositions and appeals to submission of evidence to prove use of opponent's marks and claiming priority.
- Time limits for civil legal proceedings expiring between 13 March 2020 and 30 April 2020 have been suspended until 1 May 2020. This suspension includes all deadlines irrespective of whether they have been set by the courts or are statutory in nature from filing civil court actions with infringement, nullification and unfair competition claims to filing court actions for cancellation of Turkish PTO decisions, from responding to court actions and preliminary injunction requests to submission of evidence, from submission objections/statements on expert reports to filing appeals to the decisions of First Instance Courts, Regional Courts of Justice or Court of Appeals or responding appeals, from payment of ordered legal fees to starting or maintaining mediation proceedings. On the other hand, time limits for proceedings required to conduct preliminary

proceedings required to conduct preliminary injunction orders are kept out of this suspension measure and will keep running as usual.

- Time limits for filing criminal complaints and for conducting search and seizure orders due to infringement and unfair competition actions which are subject to jail and fines will keep running, but all other time limits for subsequent proceedings in criminal legal actions expiring between 13 March 2020 and 30 April 2020 have been suspended until 1

May 2020 regardless of whether they have been set by the courts or are statutory in nature.

- Hearings of civil and criminal court actions falling into this suspension term can be postponed by the courts to any date later than 30 April 2020 (in practice 4 May since 1 May is a public holiday, followed by a weekend).
- The suspended time limits for administrative and legal procedures will start running again after 30 April 2020. And there will be another 15 days extension for the deadlines which would have ended in less than 15 days to 13 March. If the pandemic continues, this suspension term may be extended for once up to six months by the President without prejudice to change its scope and terms.

Contributed by Yasemin Aktas of OFO VENTURA in Istanbul

Posted by: Blog Administrator @ 12.06

Tags: [COVID-19](#), [Turkey](#),

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