

KAPPA CASE SUMMARY

- Jurisdiction:** TURKEY
- Subject Heading:** I.F Famous and Well-Known Marks
I.D.1. Similarity of Marks
- Case Name and Citation:** KAPPA v. KEPPA SPORTSWEAR K DEVICE, 3rd Ankara Civil Court of Intellectual and Industrial Rights
Case No: 2008/297, Decision No: 2010 /09
- Plaintiff:** KEPPA TEKSTIL SAN. TİC. LTD. ŞTİ.
- Defendant:** 1- KAPPA BASIC TRADEMARKS SA
2- TURKISH PATENT INSTITUTE
- Marks Associated with Goods/Services:** The Plaintiff's trademark application KEPPA Sportswear K Device¹ has been applied for the goods in classes 24, 25 and 26.
- The defendant's trademarks "KAPPA"² is registered in classes 03, 09, 18, 25 and 28 – "ROBE DI KAPPA"³ is registered in classes 09, 18, 25 and 28 - "ROBE DI KAPPA"⁴ is registered in class 25 – "KAPPA"⁵ is registered in class 25.
- Nature of Case:** The Plaintiff claims the cancellation of the refusal decision of the Higher Board of Turkish Patent Institute regarding the trademark application KEPPA Sportswear K Device thereof motivates the following points:
- he has acquired rights on the trademark KEPPA on the basis of the prior trademark registration thereof and the same has been in use for 4 years. Now the present trademark application has been created as a version of the prior one without changing any main character of the same.
 - even if the cited prior trademarks are well-known trademarks, there is not any similarity between trademarks and the covered

¹ Application No: 2004/34012

² Registration No: 169895

³ Registration No: 169896

⁴ Registration No: 130625

⁵ Registration No: 130638

goods by thereof as per the articles 7/1 (b)⁶, 8/1 (b)⁷, 8/4⁸ and 35⁹, of the Decree–Law No: 556 thanks to the additional “sportswear” indication.

Overview of Decision and Ruling:

The First Defendant requested the rejection of the action asserting that;

- the Client’s trademarks are well-known trademarks in Turkey as well as all over the world.
- the Client’s trademarks and the present trademark application are indistinguishably similar and there is likelihood of confusion between the same as well.
- The trademark application may damage the distinguishing character and reputation of the Client’s famous trademarks and Unfair benefit will be obtained from this registration by taking advantage of the notoriety of the trademark

The second defendant asserted that the refusal decision of the Higher Board is justified motivating the following points:

- the cited trademarks and the present trademark application are indistinguishably similar and there is only one letter between the main components of them.
- The additional “sportswear” indication, which is a descriptive word for the covered identical goods, is not enough to distinguish such trademarks.

Consequently, the Court rejected the action (for all goods) and ruled that there was a risk of substantial confusion between the trademarks due to the strong similarity of the main word indications KAPPA – KEPPA and the identity / similarity of the covered goods on the basis of the notoriety of the cited KAPPA trademarks thereof.

⁶ **Article 7:** Following signs shall not be registered as a trademark::

b) trademarks identical or (almost) identical to the point of being indistinguishably similar to a prior trademark registration or application in respect of good(s) or service(s) whether identical or of identical nature/type,”

⁷ **Article 8:** Upon opposition by the proprietor of an application for registration of a trademark or of a registered trademark, the trademark applied for shall not be registered subject to the following conditions:

b) Where the trademark applied for is identical or similar to a registered trademark or to a trademark applied for registration under a prior date of filing and the registration is sought for identical or similar goods or services in that the likelihood of confusion includes the likelihood of association with the registered trademark or with the trademark applied for registration under a prior date of filing.

⁸ **Article 8/4 :**A trademark applied for which is identical or similar to a registered trademark or to a trademark application with a prior date of filing may be used for different goods and services. However, where in the case of a registered trademark or of a trademark application with a prior date of filing, the trademark has a reputation and where the use without due cause of trademark applied for would take unfair advantage of, or be detrimental to, the distinctive character or repute of the registered trademark or of the trademark application with a prior date of filing, upon opposition by the proprietor of the prior trademark registration or application, the trademark applied for shall be refused even if it is to be used in respect of differing goods and services.

⁹ **Article 35:** Notices of opposition to the registration of trademark on the grounds that it may not be registered under the provisions of Articles 7 and 8, and notices of opposition on the ground that there exists bad faith in the application shall be submitted within three months of the publication of the application.

The opposition made under the last paragraph of Article 8 shall be refused if the opposing party does not use his trademark during this period.

Oppositions must be submitted in writing and contain the arguments. Institute may request further facts, evidence and documents to be complied within the period prescribed in the Implementing Regulation.

Where the additional facts, evidence and documents requested are not submitted within the period prescribed by the Implementing Regulation the opposition shall be deemed to have not been made.

Importance of Case: This decision is important because it establishes that the regulation provides protection to well-known trademarks against the use of identical or similar marks to distinguish dissimilar goods or services.



Images/Description:

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