

FESTINA CASE SUMMARY

Jurisdiction: Republic of Turkey / 1st Ankara Specialized Court of Intellectual and Industrial Property rights

Subject Heading: *I.D.1. Similarity of Marks*

Case Name and Citation: J. ESTINA & DEVICE v. FESTİNA & DEVICE
Case No: 2008/107, Decision No: 2009/313

Plaintiff: ROMANSON CO. LTD.ŞTİ.

Defendant: 1- FESTINA LOTUS S.A.
2- TÜRK PATENT ENSTİTÜSÜ BAŞKANLIĞI

Marks Associated with Goods/Services: The plaintiff's trade mark J. ESTINA & Device ¹ has been applied for the goods in Class 14. The first defendant's trademark FESTINA & DEVICE² covers the identical goods with the Plaintiff's trademark in class 14.

Nature of Case: The plaintiff claims the refusal of the decision of the Higher Board of the Turkish Patent Institute regarding his trademark application J. ESTINA & Device based on the opposition of the first defendant, which have been filed on the basis of likelihood of confusion due to the similarity of the subjects trademarks according to the article 8/1-b of the Decree Law No: 556³.

Prior Decisions: The Turkish Patent Institute (TPI) and the Higher Board of TPI has decided to refuse the plaintiff's trademark application J. ESTINA & Device due to the similarity of the trademarks as well as the identity covered goods in class 14⁴ on the basis of likelihood of confusion based on the opposition of the first defendant.

¹ Application no. 2005/56046

² Registration no. 125501

³ **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.

⁴ Class 14: Jewelry goods (including their imitation): gold, jewels, precious stones and jewelry made from these, cuff-links, necktie brooches and statues, knickknacks, vases, cups given during sports competitions...Watches and time measuring devices; (chronometers, metronomes (pendulums) and their parts, watch cordons)...

Overview of Decision and Ruling:

The Plaintiff claims that the cancellation of refusal decision of the Higher Board of TPI motivates the following points;

- ROMANSON Co. Ltd. Şti. is a famous watch and jeweler producer over in 60 countries of the world,
- his trademark application has been created as acronym from the indication of JOVANNA ESTINA, which is a registered trademark before CTM;
- the trademarks are not similar in the sense of visual as well as phonetical aspects and the same are pronounced different especially in English language,
- his trademark has been registered in various countries and becomes a notorious trademark,
- since the watch and jewelry are luxury consumption goods and therefore are preferred by conscious consumers, the trademarks would not be evaluated as similar to be confused by the consumers.

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

- the Client's company is active in the market under FESTINA trade name over 100 years.
- the trademarks as well as the device components thereof are confusingly similar. Namely the only difference between the trademark is the essential J / F letters and considering the similarity of the device components, it is not sufficient to distinguish trademarks.
- The trademark J. ESTINA may probably be pronounced and perceived as the same with his trademark FESTINA by the Turkish consumers,

The second defendant asserted that the refusal decision of the Higher Board is justified.

Consequently, the Court rejected the action and ruled that there was a risk of substantial confusion between the trademarks due to the similarity of the word and device indications thereof.

Importance of Case: The subject decision is important, since the same establishes that the likelihood of confusion possibly created by the overall impression conveyed by word and device component of the trademarks.

Images/Description:



Contributor Firm: Deris Patents & Trademarks Agency A.S.