

### III.A.2 LIKELIHOOD OF CONFUSION

Eti Gıda Sanayi ve Tic. A.Ş. brought an action against the Turkish Patent Institute for the withdrawal of its final decision accepting the defendants' trademark application for "SAKA FIT"<sup>1</sup> in class 32 on the grounds of bad faith of the applicant and of indistinguishably similar trademark "FIT"<sup>2</sup> in classes 29, 30 and 32 in accordance with Article 8, paragraph 1, subparagraph (b) of the Decree-Law on the Protection of Trademarks (Decree-Law No. 556) and against Gıda Sabancı Gıda San. ve Tic. A.Ş. for the cancellation of the Institute's decision and for invalidity and cancellation of defendants' trademark registration "SAKA FIT" registered in the name of the defendant from the registry.

The defendant Institute asserted that its decision was consistent with the provisions of Decree-Law No. 556. In this scope the opposition and the objection filed by the plaintiff against the subject trademark application SAKA FIT filed in the name of the defendant has been rejected since the applied trademark has not been considered as confusingly similar to the opponent's trademark.

The defendant, Gıda Sabancı Gıda San. ve Tic. A.Ş., asserted that where the trademark "SAKA FIT" which consist of two word elements is evaluated in its entirety, the denomination "FIT" is used as an additional word element and therefore it can not be considered as similar to the plaintiffs' trademark "FIT" which consists of only one word element. In this scope the assertion of the plaintiff with regard to the bad faith of the defendant is not based on any legal ground. The plaintiff is attempting to monopolize a descriptive sign which does not have any distinctive character. The aim by using the denomination "FIT" is to give the message to the consumers that the food product sold under that trademark is healthy and keeps people in good fettle and fit. Therefore and since the subject denomination refers and shows the aim of use of the product, the use of the subject denomination shall be open to everyone in the sector, in fact similar registrations in respect of food products have been filed in the name of different companies.

The Court, in accordance with the evidences submitted as well as the expert report, held that

- (1) The defendant's trademark consists of the words "SAKA FIT" and covers all the goods in class 32 whereas the plaintiff's trademark registration consists of the word "FIT" and covers besides the goods in class 32 which are identical with the specification of the application subject to the action, also the goods related to food sector in classes 29 and 30. Therefore the goods covered in the specifications of the plaintiff's and defendant's trademarks are identical or similar/related.
- (2) As to the evaluation of the similarity between the trademarks in respect of their denominations, it has been decided that the plaintiff's trademark "FIT" has been preferred because of its English meaning of "in good fettle, healthy". With the said meaning although the denomination "FIT" cannot be considered as directly descriptive and to the variety referring word in respect of the food stuff, it is obvious that it indirect explains that the food and beverage stuff are healthy and keep in good fettle.

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<sup>1</sup>Application no.2006/22683

<sup>2</sup>Registration no.2000 04524

Considering the aim of the parties by using the subject denomination for food products, there is no need of discussion of the meaning of the subject denomination in Arabic or in other languages.

- (3) The first word of the defendant's application "SAKA" is the leading or serial trademark already registered in the name of the defendant company. The leading trademarks/umbrella brands are used for almost all products of the company and therefore there is an emphasis to the company rather than to the company's products and these leading/umbrella trademarks are less distinctive in respect of the products and in respect of the impression appearing in consumers minds. The acceptance of the contrary would lead to allow the holders of the umbrella trademarks to use all of the trademarks registered in the name of other companies with their umbrella trademarks, which cannot be legally accepted.
- (4) Where the defendants' trademark is evaluated in its entirety, the denomination "FIT" which is the origin word and the essential part gives the emphasis to the trademark. On the other hand this origin word is the single essential part of plaintiff's trademark. Therefore the essential part of defendant's and plaintiff's trademarks is the denomination "FIT" and the trademarks are confusingly similar to each other in respect of the phonetic, visual and semantic aspects.
- (5) In case the denominations "FIT" and "SAKA FIT" would be used for identical goods simultaneously, it is obvious that at least the wrong impression will be created in consumers mind that there is a relation between the holder companies of these trademarks. Especially considering that the goods in class 32 covered in both of the trademarks are purchased by consumers during daily shopping with minimum time sparing, are marketed through identical markets and even in identical shelves; goods such as mineral waters, fruit aromatic carbonated and non-carbonated drinks, soda waters, cola etc. are mostly purchased by children, there is a high possibility of confusion between the trademarks and therefore the additional denomination "SAKA" covered in defendant's trademark is not sufficient enough to avoid the risk of confusion.

In the light of above mentioned the Court has ruled to

-Accepting the plaintiff's request, cancellation of the Higher Council's decision no.2006/M-4400, dated 19.12.2006 with regard to the subject trademark registered in the name of the defendant.

-Invalidity and cancellation of the trademark "SAKA FIT" registered in the name of the defendant from the registry shall be accepted<sup>3</sup>.

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<sup>3</sup> *ETI GIDA SANAYİ VE TİCARET A.S. vs GİDASA SABANCI GIDA SAN. Ve TIC. A.S. .and the Turkish Patent Institute ., Case no. 2007/19, Decision no. 2008/210, (3rd Ankara Court of Intellectual and Industrial Rights) , (08.07. 2008).*