

I.B.8.a. Similarity of Marks

SANY GROUP CO. LTD has instituted an action¹ against the Turkish Patent Institute (TPI) and DAIMLER CHRYSLER AG before the Civil Court Specialized on Intellectual and Industrial Rights for the withdrawal of the Turkish Patent Institute's decision refusing the registration of the DEVICE trademark application² upon opposition of the owner of the earlier registrations for a similar DEVICE³ trademark.

The plaintiff has claimed in its writ of summons that it is a company, which is active in the field of producing, importing and international trading of high-tech machinery and construction equipments for a long time, that its international trademark application for "DEVICE" has been refused by the defendant Turkish Patent Institute upon opposition of the other defendant company, although the trademarks in question are not confusingly similar and that there is no risk of confusion. The plaintiff has requested cancellation of the defendant TPI's decision.

The defendant TPI has put forward in its petition that the trademark of the plaintiff is confusingly similar to defendant company's trademarks; that the differences between the DEVICE trademarks are not distinctive enough to avoid the risk of confusion; that the decision of the TPI is in line with the procedure and law and therefore requested dismissal of the action.

The defendant company has argued in its petition that the trademark subject to the court action is similar to its "star shaped" trademarks, which are identified with its well-known trademark "MERCEDES", that its trademarks are well-known trademarks and therefore requested dismissal of the action.

The Court has determined that the subject of the conflict is whether the trademark applied for registration by the plaintiff is identical or similar with the trademarks, on which the defendant company has based its opposition; whether the defendant company's trademarks are well-known and whether the plaintiff may take unfair advantage of the well-known character of the defendant company's trademarks.

¹ *SANY GROUP CO. LTD vs. Turkish Patent Institute and DAIMLER CHRYSLER AG*
Case No.: 2007/355 E. Decision No. 2009/78 K.

(4th Civil Court of Ankara of Intellectual and Industrial Property Rights April 1,2009)

² Application no. 2006/27393

³ Registration nos. 101798, 2004 05891 and 126507

In such case, the first point to be analyzed is determination of similarity between the plaintiff's trademark and defendant company's trademarks, on which the opposition has been based or possibility of risk of confusion for the public.

Both plaintiff's and defendant company's trademarks are composed of "device" components, which are not identical. In that case, it should be examined whether the trademarks are similar or there is a risk of confusion for the public.

While evaluating the similarity of the trademarks, the criteria to be considered as a principle is to determine whether the average consumers would not distinguish the trademark applied for registration from the trademark, which is known by the consumers and which has an older registration date, in their visual, phonetically and semantically (mistaken with the older trademark), whether the average consumers confuse or think/believe that the trademarks are connected with each other.

In the present matter, the trademarks of the parties are not original as to their esthetic and geometric aspects; they both are bearing static (passive) elements and are not containing enough dynamic (active) elements. Still, the trademark subject to the case numbered 2006/27393 is similar to the plaintiff company's registrations no.101798, 2004 05891 and 126507, it can be perceived as one of the serial trademarks of the plaintiff or the target consumers may think that there is a connection between the companies. Although the dynamic elements of the defendant company's trademarks are not sufficient, it is known that the "star shaped" device trademarks are being used on the goods with the defendant company's well-know trademarks and are identified with such goods.

In view of the fact that the goods covered by both trademarks are identical and similar, the Court has decided that there is a risk of confusion between the trademark subject to the case and defendant company's trademarks in the sense of Article 8/1-b and that therefore there is a bar for registration of the plaintiff's trademark.

Furthermore, the Court has decided that defendant company's "star shaped" trademarks, on which the opposition has been based, are well-known in scope of the Article 8/4 and 7/1-I of the Decree-Law no.556 and that in case the plaintiff's trademark is registered the plaintiff may take the unfair advantage of the reputation of defendant's well-known trademarks, that this may harm the distinguishing character of the defendant company's trademarks, that it is not possible not to know defendant company's trademarks, which are registered and used in the trade for many years.

In view of the evaluations mentioned here above and adopting the experts' report, the Court has ruled that there is a bar for registration of the plaintiff's trademark application in scope of the Articles 8/1

and 8/4 due to the defendant company's earlier registrations and that the decision of the defendant Turkish Patent Institute, cancellation of which has been requested, is not against law and rejected all claims of the defendant.