

SKF CASE SUMMARY

Jurisdiction: TURKEY

Subject Heading: I.D.1.Likelihood of Confusion & I.F.Famous and Well-Known Marks

Case Name and Citation: SKF v. F.S.K (SKF CASE) Beyoğlu Civil Court of Intellectual and Industrial Rights, Case No: 2008/69 Decision No: 2009/48

Plaintiff: AKTIEBOLAGET SKF

Defendant: FISEK HIRDAVAT TIC. SAN. A.S.

Marks Associated with Goods/Services: The Plaintiff's trademark SKF¹ registered in classes 04, 06, 07, 08, 09, 11, 12, 16, 17, 35, 37, 38, 39, 40, 41 and 42 - SKF² registered in classes 04, 06, 07, 08, 09, 11, 12 - SKF³ registered in classes 16, 35, 37, 39, 40, 41, 42, SKF⁴ in classes 04, 06, 07, 08, 09, 10, 12, 17, SKF⁵ in classes 07, 12. The defendant's trademark FKS⁶ registered in class 07.

Nature of Case: The Plaintiff claimed the invalidity of the Defendant's registered trademark which is almost identical with its well-known trademark in Turkey according to the articles 7/1 (b)⁷, 8/1 (b)⁸, 8/4⁹ of the Decree-Law No: 556, dupl. Article 6¹⁰ of the Paris Convention and article 8 of the same Convention¹¹.

¹ Registration No: 2005 48200 (int'l reg. no. 863961)

² Registration No: 87 096505

³ Registration No: 2000 26385 (int'l reg. no. 743876)

⁴ Registration No: 118384

⁵ Registration No: 2006 15416 (int'l reg. no. 877467)

⁶ Registration No: 2005 52873

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

b) trademarks identical or confusingly similar with a trademark registered earlier or with an earlier filing date for registration in respect of an identical or same type of product or services,

⁸ **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.

⁹ 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.

¹⁰ 1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

¹¹ A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark.

Overview of Decision and Ruling:

The Court decided that the conditions exist for the cancellation of the defendants' trademark considering the identity between the SKF trademarks of the plaintiff and F.S.K. trademark of the defendant, which would give rise to a "likelihood of confusion" as per their overall appearance.

In this regard, the Court has stated that the overall view of the trademark shall be considered when assessing the possibility to cause "likelihood of confusion". Therefore, in case the trademarks bear an indistinguishable similarity at first sight as an overall appearance, this shall be accepted as an objective criteria to deem the trademarks as likely to give rise to a "likelihood of confusion" before public.

Moreover, in accordance with ongoing decisions of Supreme Court, the likelihood of confusion shall be assessed in accordance with visual, phonetic, conceptual similarity between the trademarks, the overall appearance of the trademarks including their dominant and secondary elements, whether the trademarks are reminiscent of each other or not, the educational and social position of the intended population, the value of the good on which the trademark is used and the time wasted to buy the respective good by the consumer. Additionally, "the average consumer" shall be taken into account when considering the aforementioned criterias.

Furthermore, the Court has referred to the term of "likelihood of association" which shall also be taken into account in the "likelihood of confusion" evaluation. The court has also indicated the fact that the term "likelihood of association" is a notion used to determine the existence of the likelihood of confusion rather than an alternative concept, even though the existence of "likelihood of association" is not enough to deem the presence of "likelihood of confusion".

In the light of all, the Court has stated that the trademarks has deemed to be indistinguishable which are likely to give rise to a "likelihood of confusion" including a "likelihood of association" and the trademarks would leave the impression of tail-series trademarks owned by the same company.

Moreover, the Court has presented that the defendant has no possibility not to know the SKF trademarks as an actor in the same sector and is under the burden to act as a prudent businessman. Thereby, the defendant shall be deemed to register the trademark in bad-faith in the view of the respective liability in accordance with Article 20 of Turkish Commercial Code and shall be deemed to act with the intention of taking unfair advantage from the notoriety of the SKF trademarks.

The Court also held that the plaintiff's SKF trademarks are well-known according to the Paris Convention on the basis of the evidences submitted to Court since the company has numerous registration all over the world and has been operating for many years.

Thus, on grounds of likelihood of confusion, notoriety, bad-faith basis of Article 7/1 (b), Article 8/1 (b) of Decree Law No. 556, Article 6 bis of Paris Convention, Article 7/1 (i), 8/IV and Article 42 of Decree-Law No. 556, the court ruled for the invalidation of defendant's F.S.K. trademark reg. no. 2005/52873 for goods in class 07.

Importance of Case: This decision is important because it establishes the criterias to determine "likelihood of confusion" and provides protection to well-known trademarks

F.S.K



Images/Description:

Contributor Firm: Deris Law Office