

## **Registrability – Likelihood Of Confusion (Similarity Of Trademarks)**

**“ÇBS SATEN, SATEN/ ABS SATEN PERDAH ALÇISI” Trademarks**

**ÇBS BOYA KIMYA SANAYI ve TIC. A.S. vs. TURKİSH PATENT INSTITUTE**

**vs.**

**ABS ALCI VE BLOK SANAYI**

**(\* ) Court of Ankara on Intellectual and Industrial Rights**

**Case no. 2004/55 – Decision no.2004/213 (September 29, 2004)**

An action (\*) was instituted for the withdrawal of the Turkish Patent Institute’s final decision refusing the opposition filed against the trademark application ABS SATEN PERDAH ALCISI and for the cancellation of the said trademark on grounds of similarity to the plaintiff’s registered trademarks ÇBS SATEN and SATEN.

The plaintiff claimed that the trademark ABS SATEN PERDAH ALCISI would constitute confusion to its trademark SATEN and other series of trademarks including the word SATEN. The plaintiff further asserted that the defendant has applied for the registration of the same trademark and upon refusal of its application the defendant had instituted a court action against the T.P.I. for the withdrawal of the refusal decision of its trademark; that the Court had rejected its claims and that the decision had been finalized upon approval of the Supreme Court. The plaintiff also claimed that it has registered the trademark SATEN in 1985, which acquired distinctiveness owing to its efforts in this regard; that the term “SATEN (SATIN)” was not existing in painting trade field; that the defendant’s trademark covering similar goods with the goods covered by its registrations is confusingly similar to its trademarks.

The defendant T.P.I. objected by asserting that the indication “SATEN PERDAH ALÇISI (SATIN FINISHING/POLISHING GYPSUM)” is a kind of gypsum, which is used as a general term in the trade; that the plaintiff’s registrations do not cover “gypsum” and that therefore the opposition based on Article 8 of the Decree-Law no.556 was not well-grounded.

The defendant firm asserted that the action instituted against the T.P.I. upon rejection of its prior application has come to an end by its renunciation to pursue the action and that therefore it would not constitute definitive verdict. The defendant firm further claimed that the trademarks ABS SATEN PERDAH ALÇISI and SATEN are neither identical nor confusingly similar, that it has started in 1984 to produce the sheering kind of gypsum under the name SATEN ALÇISI, in order to distinguish sheering gypsum from others; that the plaintiff produces painting not gypsums; that the goods covered by the trademarks in question are included in different (international classes); that the goods are put to market in different packages.

The Court held that plaintiff's registrations on which the its opposition had been based do cover the goods "external coverings in liquid form" in international class 19, so that there is no doubt that the goods covered by the specification of defendant's trademark are already included in the listing of goods of plaintiff's prior registrations. According to Article 7/1(b) of the Decree-Law, trademarks identical or (almost) identical to the point of being indistinguishably similar to a prior trademark registration or application in respect of similar goods shall be rejected. Therefore, defendants' claims regarding non-similarity of the goods are not well grounded.

The Court further held that in order to mention that there is a finalized court decision regarding the same issue, the parties and the subject of the case should be the same, therefore, in this case the decision of the 2<sup>nd</sup> Commercial Court cannot be considered as a finalized decision since the subject and the parties of this case is different; however, the finalized ascertainments and descriptions regarding the claims and disputes in the prior case would be considered as influential evidences in this case. In the former case and current case the trademarks in dispute are almost identical, and both cover "gypsum". Therefore, the fact the defendant has renounced the case would not affect the consideration of the decision of the 2<sup>nd</sup> Commercial Court declaring that the trademarks are similar as evidence.

As to the defendant's claims regarding the genericness of the indication "SATEN ALÇI (SATIN GYPSUM)", the prior use of the trademark and the fact that the plaintiff does not produce gypsum, the Court ruled that in order to accept the claims regarding prior use in the trade they should have been used before the trademark has been made known before the registrant; that the word "saten (satin)" has not been defined as a kind of gypsum, that non-use of the trademark for the goods in class 19 could only be put forward in a cancellation action on the basis of Article 14 of Decree-Law no.556.

In view of the above facts, the Court accepted the plaintiff's claims by canceling the refusal decision of the T.P.I. and annulling the registration in the name of the defendant.