

### **I.B.8.a. SIMILARITY OF MARKS**

Biotherm Group instituted an action against Biota Bitkisel Kozmetik Labaratuarları Ticaret Ltd. Şirleti for the cancellation of trademark BIO-TEM<sup>1</sup> on grounds of similarity with the plaintiff's BIOTHERM<sup>2</sup> trademark, notoriety and the bad faith of defendant.

The plaintiff claimed that BIO-TEM is similar to their BIOTHERM trademark, that BIO-TEM trademark will take unfair advantage from the well-known character of their BIOTHERM trademark and that there is risk of confusion between trademarks and products/services,

The defendant requested the rejection of the action on grounds that the trademarks are not similar and that the plaintiff's trademark is not a well-known trademark

The Court asserted that the plaintiff's trademark is well-known in many countries, that however the international registration criteria of the trademark is not sufficient for the well-known character of trademark all alone.

The Court also stated that when both trademarks are compared, the parties' trademarks are as follows:

**“BIOTHERM”**

(Plaintiff's trademark )

**“BIO-TEM”**

(Defendant's trademark nr.2003 26439)

In his motivated decision dated September 25, 2008 The Civil Court of Beyoglu held that in scope of the evidences submitted by the plaintiff, as the plaintiff's trademark is registered in Turkey and throughout the world, considering the net turnovers of the goods bearing the trademark, media (advertisement) expenditures, lists of dealers, promotional and adversarial activities, the photos and articles in press as well as the expert's report, the trademark of the plaintiff is a well-know trademark and enjoys the wider protection of the Paris Agreement in this regard.

The Court of Beyoglu confirmed that the trademark of the defendant is constituted of almost same letters with the plaintiff's trademark by only excluding the letters H and R. The Court confirms that both trademarks cover the goods in same classes. Accordingly, considering the facts that phonetically, the Court of Beyoglu confirm that the visual and conceptual similarities exist between the trademarks, that together with the essential and secondary elements of the trademarks, their all-over impression are almost identical, that defendant's trademark evokes plaintiff's trademark and in view of the educational and social status of the target consumer of the goods covered by both parties, the value of the goods and accordingly the time spent by the customers for buying the goods, the likelihood of confusion does exist between trademarks from the view of the average customer and this will mislead the public by constituting a global pressure-perception on the customers.

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<sup>1</sup> Registration no.2003 24439.

<sup>2</sup> Registration no.113132

In such case, as to the opinion of the Civil Court of Beyoglu the defendant would take unfair advantage of the notoriety of the plaintiff's trademark without paying any efforts or any costs by attracting attention of the society and by weakening the plaintiff's trademark's impact area, which was built by plaintiff due to its image and trust in the trade field. Therefore the plaintiff has a prior legal right worth to be protected and furthermore the absolute grounds for refusal according to Article 7/b and relative grounds for refusal according to Article 8/b has been realized in the subject matter, it is to be decided to accept the plaintiff's claims.

As a result the Court accepted the action<sup>3</sup>

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<sup>3</sup>*Biotherm .vs Biota Bitkisel Kozmetik Laboratuarlaii Ltd.Sti.*, Case no. 2007/18, Decision no. 2008/18 (Beyoglu Court of Intellectual and Industrial Rights), (September 25, 2008).