

Similarity Of Marks

“MOBIL/MOBIL LIG” Trademarks

Exxonmobil Oil Corporation vs.Turkish Patent Institute and vs. Avea İletisim Hizmetleri,

Ankara Court on Intellectual and Industrial Rights,

Case No.2005/168, Decision No.2006/1401, (December 5, 2007)

Exxonmobil Oil Corporation instituted an action against the Turkish Patent Institute and Avea İletisim Hizmetleri A.S. requesting the withdrawal of Turkish Patent Institute’s decision rejecting the plaintiff’s opposition and the cancellation of the other defendant’s trademark registration for MOBIL LIG¹ in classes 9 and 38 on ground of similarity with the plaintiff’s well-known MOBIL² trademark and on ground that the word MOBIL was the essential part of the their trade name.

The Turkish Patent Institute asserted that their listing of goods were not similar and that even though the plaintiff’s trademark was acknowledged as well-known, the conditions set in the Article 8/4 of the Decree Law no.5563 have not been met.³

Avea asserted that the action was not timely instituted, that the denomination MOBIL referred to “mobility” in its semantic meaning, that MOBIL LIG was intended to be used for mobile telephone services with regard to Turkish Football League, that the trademark was made of two descriptive word components “MOBIL” and “LIG” which have been combined in a characterizing way, that the essential element of such combination was the word “LIG”, that there was no similarity between the marks and that the plaintiff’s trademark was not well-known.

¹ Registration No.2001 15671.

² Registration No.103965

³ Article 8/4 of the Deree Law no.556: “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”.

The defendant requested the rejection of the case. The Court held that the trademarks MOBIL and MOBIL LIG are similar as the denomination MOBIL was the common element of both trademarks, as the defendant's trademark would deceive the public as to the origin of trademarks and as the denomination LIG, apart being descriptive, was publicly used and therefore unfit for being considered as sufficiently distinctive as a trademark. Furthermore the Court acknowledged that the plaintiff's trademark is well-known.

The Court therefore decided the withdrawal of the Turkish Patent Institute's decision and the cancellation of the defendant's trademark