

Registrability – Likelihood Of Confusion (Similarity Of Trademarks)

“Device+ bolamae/ Wing device (sablier ailé)+ Longines” Trademarks

**COMPAGNIE DES MONTRES LONGINES FRANCILLON S.A. vs. THE TURKISH
PATENT INSTITUTE**

(*) 6th Commercial Court of Ankara.

Decision No.1999/446-2000/503 (October 11, 2000)

(Notified January 25, 2001)

An action (*) was instituted against the Turkish Patent Institute upon the refusal of the T.P.I. to favorably consider the opposition lodged by the plaintiff to the registration of the mark “Device + Bolamae” on grounds of notoriety of the plaintiff’s trademark “Wing device (sablier ailé) + Longines”.

The defendant has objected that the action is not well-grounded in that the essential component of the opposed trademark is the verbal element “Bolamae” whereby the “device” as graphical element is ancillary, that the goods are in different classes and that the protection on the basis of notoriety is conditioned by and requires similarity between the trademarks.

The plaintiff has asserted that the “device” as graphical element is indeed an essential component which is used as a logo showing the direct connection to the plaintiff, that the opposed application covers goods in class 14 as the his registration, that his trademark is registered in Switzerland, the country of origin since 1942 as well as in many other countries.

The court held that when trademarks are composed of verbal and “device” as graphical components, the general rule is to compare the verbal element in the assessment of the similarity. However, while assessing such similarity the trademark is to be considered as a whole and the distinctive character of the “device” component is to be evaluated as of the trademark in its entirety. Finally, where the device component is distinguishes over the verbal element and appears therefore as the essential component of the trademark the assessment is to be made by putting the emphasis on the graphical element and from thereon by comparing the “devices”. On such grounds, the court ruled that in the present case

where the “device” is used as a logo since 1942, the assessment of the similarity is to be made primarily in consideration of the “device” component rather than the verbal element, further considering that the defendant has chosen this particular “device” that has acquired notoriety for the general public thanks to the plaintiff’s extensive and longstanding promotion activities, despite the multitude of choices, clearly implies the defendant’s intention to procure unfair advantages from such notoriety.

The experts having examined both trademarks concluded in their report that the wings devices are confusingly similar in their width and length ratio and shape and their borderline with whereby the same borderline and character has been used in the opposed trademark application as well. The court adopting the conclusions of the expert’s report ruled for the withdrawal T.P.I.’s decision refusing to favorably consider the opposition lodged by the plaintiff recognizing the worldwide notoriety of the plaintiff’s trademark and the protection conferred by the Decree-Law No. 556 on Trademarks to such well-known trademarks pursuant to Articles 7 parag. 1(i) and 8.

According to the Court’s decision (*) the T.P.I. is to favourably consider the opposition lodged by the plaintiff and to refuse the registration of the opposed trademark application.