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An Overview of Turkish Case-Law on Trademark Disputes with Special Consideration Regarding the Rules of the European Court of Justice**

Introduction

The Turkish Decree Law No. 556 concerning the Protection of Trademarks (hereinafter Decree Law/TDL), which entered into force on June, 27, 1995¹ aims at harmonising Turkish trademark law with the related international agreements and European regulations. In this regard, provisions of the Decree Law, which are to a very large extent in line with the regulations of the First Council Directive No. 89/104/EEC of December, 21, 1988² and the Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community Trademark³ as well as with the standards foreseen by the TRIPS Agreement, have achieved the intended aim. The few regulations of the Decree Law deviating from the European regulations shall be amended by the Turkish Draft Law on Trademarks in order to provide full harmonisation with European standards. Thus, Turkish trademark legislation can be considered compatible with European regulations. However, the coherence of regulations does not always guarantee that they are also applied uniformly. Since Turkey is a candidate member of the European Union, it is of considerable importance that a practice which is in conformity with that of the European Court of Justice (ECJ) is developed by Turkish courts.

The goal of this study is to give a precise overview of the case law of the Turkish Supreme Court of Appeals (hereinafter SCA) on trademark issues and to compare this with the case law of the ECJ in this field. Special regard will be given to the approach and evaluation of the SCA with respect to the absolute and relative grounds of refusal of a trademark.

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1 Official Journal of Turkey (Resmi Gazete) No. 22326. This Decree Law has replaced the Turkish Trademark Act No. 551 of 1965.

2 First Council Directive 89/104/EEC of December 1988 to approximate the laws of the Member States relating to trademarks; O.J. L 040, 11.02.1989, at 0001–0007.

3 O.J. L 11, 14.01.1994.



I. Signs of Which a Trademark May Consist

Signs of which a trademark may consist are regulated in Art. 5 of the Decree Law, which fundamentally corresponds with Art. 2 of Directive No. 89/104/EEC. According to this provision, a trademark, provided that it is capable of distinguishing the goods and services of one undertaking from the goods and services of other undertakings, may consist of all kinds of signs being represented graphically or in a similar form, such as words, including personal names, designs, letters, numerals, the shape of goods or their packaging, which are capable of being published and reproduced by printing. Signs which do not conform to this provision shall, pursuant to Art. 7(1)(a) TDL, not be registered as a trademark.

A. Distinctive Character

The first fundamental condition for a sign to be a trademark is its capability of distinguishing the goods or services of one undertaking from those of other undertakings. In contrast to Art. 3(1) of Directive 89/104/EEC and Art. 7(1) of the Community Trademark Regulation, where signs which can not constitute a trademark and trademarks which are devoid of distinctive character are regulated as individual absolute grounds for refusal, and it is thereby differentiated between *abstract* and *concrete* distinctiveness,⁴ Art. 7(1)(a) TDL refers only to Art. 5 TDL without expressly mentioning the lack of distinctiveness as an absolute ground for refusal of the registration of a trademark. Therefore, in Turkish law the distinction between *abstract* and *concrete* distinctive character is unclear.⁵

This confusion, caused by the current trademark legislation, also seems to be reflected in Turkish case law, which hardly draws a line between the two kinds of distinctiveness and usually examines the question of *concrete* distinctiveness, namely the distinctiveness in respect of the goods or services for which the trademark is applied within the context of Art. 5 TDL. In some cases the SCA applies the provisions of Art. 7(1)(c) and (d) TDL, which exclude descriptive and generic signs from registration, cumulatively with Art. 5 TDL. The cases relating to the question of registrability of slogans “Become what you are”⁶ and “Get connected to the flavour”⁷ are some

⁴ See MÜHLEND AHL & OHLGART, “Die Gemeinschaftsmarke” 23, 26 (Stämpfli Verlag AG Bern/C. H. Beck Verlag, Munich 1998).

⁵ For criticism of this regulation see DOĞAN, “Türk, Alman ve Avrupa Birliği Hukukuna Göre Marka Olamayacak İşaretlerin Kullanım Sonucu Ayırt Edici Nitelik Kazanarak Tescil Edilebilirliği Sorunu”, 2006 Batider 17 *et seq.*

⁶ Decision of Turkish Supreme Court of Appeals, 11th Civil Chamber (hereinafter SCA), November 20, 2000, Case No. 2000/7674, Decision No. 2000/9346 – *Become what you are*; YASAMAN, “Marka Hukuku I” 97–99 (Istanbul 2004). In this case it was disputed whether the slogan “Become what you are” applied for registration for goods in the classes 3, 9, 14, 18, 25 and 35 in accordance with the Nice Agreement was capable of being a sign which can constitute a trademark according to Art. 5 TDL. The SCA held that the slogan in dispute met the requirements of Art. 5 TDL of a trademark. Additionally, the SCA emphasised

earlier examples of cumulative examination of *abstract* and *concrete* distinctiveness. In its more recent decisions,⁸ the SCA still continues this trend of cumulative examination.

As a general rule, the SCA rejects any condition of “originality” or “imaginativeness” for a sign to constitute a trademark. In this context, it stated in the *Bizim Toptancı* decision⁹ that such an additional requirement might not be inferred from the wording of Art. 5 TDL. The SCA also applied this rule in cases “*Become what you are*”¹⁰ and “*Get connected to the flavour*”.¹¹ Turkish case law is consequently in conformity with the ECJ practice, which laid down in the decision *Erpo Möbelwerk v. OHIM*¹² that a slogan must neither display “imaginativeness” nor “conceptual tension which would create surprise and so make striking impression so as not to lack the minimal level of distinctiveness required by Art. 7(1)(b) of Regulation No. 40/90”.

In conformity with the ECJ practice, the SCA assesses the distinctive character, by considering the sign applied for registration as a whole and taking into account the overall impression of it. The principle that the distinctive character of signs composed of different elements should be examined not only in relation to each element taken separately but also as an entirety, which the ECJ underlined in a number of cases such as *Procter & Gamble v. OHIM (Baby-Dry)*,¹³ *DKV v. OHIM (Companyline)*,¹⁴ *SAT 1 v. OHIM*

that it also possessed distinctive character with respect to goods for which trademark protection was sought due to the fact that the sign was not descriptive in respect of the goods for which the sign was applied for registration.

7 SCA, March 17, 2003, Case No. 2002/10068, Decision No. 2003/2475 – *Get connected to the flavour*; YASAMAN, *supra* note 6, at 122. In the decision, the slogan “Get connected to the flavour” was considered capable of constituting a trademark under Art. 5 TDL. The court examined both the *abstract* and *concrete* distinctiveness in the light of the provisions of Art. 7(1)(a) and (c) TDL.

8 Examples of such cases are: SCA, October 26, 2004, Case No. 2005/857, Decision No. 2006/3245 – *Aç-İç*; SCA, December 30, 2004, Case No. 2005/9336, Decision No. 2006/10025 – *Visible Results*; SCA, February 24, 2005, Case No. 2005/7686, Decision No. 2006/7878 – *Biracı*; SCA, October 12, 2004, Case No. 2005/2144, Decision No. 2006/2033 – *Intercity*; SCA, February 1, 2005, Case No. 2005/5932, Decision No. 2006/5940 – *LPG 1*; SCA, April 18, Case No. 2006/8119, Decision No. 2007/10476 – *Ekmeğinizi Elletmeyin*; SCA, February 23, Case No. 2007/3967, Decision No. 2007/7284 – *Uykudan Önce*.

9 SCA, January 15, 2004, Case No. 2003/6068, Decision No. 2004/229 – *Bizim Toptancı*; YASAMAN, *supra* note 6, at 93.

10 SCA, November 20, 2000, Case No. 2000/7674, Decision No. 2000/9346 – *Become what you are*.

11 SCA, March 17, 2003, Case No. 2002/10068, Decision No. 2003/2475 – *Get connected to the flavour*.

12 ECJ, October 21, 2004, Case C-64/02 P – *Das Prinzip der Bequemlichkeit*.

13 ECJ, September 20, 2001, Case C-383/99 – *Baby Dry*.

14 ECJ, September 19, 2002, Case C-104/00 – *Companyline*.

(SAT 2),¹⁵ *Campina Melkunie BV v. BTMO (Biomild)*,¹⁶ has been recognised in Turkish case law.

The *Interport*¹⁷ and *Computer Bild*¹⁸ cases are some examples in which the SCA assessed the distinctive character of the disputed trademarks by taking into account their overall impression.

B. Graphical Representation

As a second condition, the sign must fulfil the requirements of representation in graphical or similar form as well as the capability of being published and reproduced by printing. As regards this requirement, the scope of Art. 5 TDL departs from that of Art. 4 of the Directive 89/104/EEC since it includes the additional possibility of representation “in a similar form” as well as the condition of “capability of being published and reproduced by printing”. The additional condition of “capability of being published and reproduced by printing” is commented on the ground that such a condition might complicate the registrations of new trademark mark forms – in particular sound marks.¹⁹ Such problems have not been faced yet, but taking into account potential problems which may arise through the application of this provision, the condition of “capability of being published and reproduced by printing” is removed in the wording of Art. 5 of Turkish Draft Law on Trademarks.

Since there has not been any dispute arising from the requirement of graphical representation, this condition has played an insignificant role in Turkish trademark case law to date.

C. Non-Conventional Trademarks

Emphasised by the use of the expression “such as” in Art. 5 TDL, the list of signs of which a trademark may consist is non-exhaustive. The SCA has confirmed a broad interpretation of Art. 5 TDL by recognising different types of signs, *inter alia*, three-dimensional marks, as signs of which a trademark may consist, provided that they possess distinctive character. Up to date, there have been no disputes relating to the new trademark forms, such as odour, taste or sound marks, as no such trademark form has been regis-

15 ECJ, September 16, 2004, Case C-329/02 – *Sat 2*.

16 ECJ, February 12, 2004, Case C-265/00 – *Biomild*; 35 IIC 564 (2004).

17 SCA, May 5, 2003, Case No. 2002/12018, Decision No. 2003/4432 – *Interport*. The SCA stated that the distinctive character of a mark consisting of several elements had to be seen in the overall impression and image it reveals. It confirmed the distinctive character.

18 SCA, December 1, 2000, Case No. 2000/7590, Decision No. 2000/9528 – *Computer Bild*. The SCA emphasised that the disputed trademark, which was composed not only of word elements but also of color and figurative elements had to be examined as a whole. It concluded that the trademark possessed distinctive character.

19 OKUTAN NILSSON, “Sesler, Renkler ve Kokular Marka Olarak Tescil Edilebilir mi? – Avrupa Toplulukları Mahkemesi’nin Üç Kararı” 23 MHB Milletlerarası Hukuk ve Milletlerarası Özel Hukuk Bülteni 596 (2003).

tered yet. There is only one pending application regarding a sound mark. Thus the approach of the SCA towards these new kinds of marks still remains unknown.

However, there are some indications reflecting the SCA' approach to colour marks. In some of its decisions²⁰ the SCA interpreted the wording of Art. 5 TDL as to cover colour combinations but not colours per se. Although the question of registrability of abstract colours was not the subject matter of these lawsuits, these decisions are of considerable importance as they convey the general approach of the SCA towards trademark protection for colours. In these decisions, examining the likelihood of confusion between word, composite, figurative²¹ or three-dimensional marks²² with coloured elements, the SCA defined its position with regard to abstract colour marks by

20 For example SCA, March 10, 1997, Case No. 1996/8650, Decision No. 1997/1586 – *Aygaz*.

21 A number of decisions of the SCA relate to the trademark “Aygaz” of the Aygaz Company, registered in different forms for goods in class 6 of the Nice Agreement. One of the trademarks of the Aygaz Company contained the word elements “Aygaz, Gümüş Rengi Alüminyum Boya” (Aygaz, Silver Coloured Aluminium Dye) and the colour element silver as background colour. In this case of 1997 (SCA, March 10, 1997, Case No. 1996/8650, Decision No. 1997/1586 – *Aygaz Gri Renk*; YASAMAN, *supra* note 6, at 91), the plaintiff (Aygaz Company) sought to restrain the defendant from using the expression “Alüminyum beyazı” (aluminium white) and the element of silver-grey colour in his trademark. The SCA pointed out in its decision that in the disputed matter the colour element was registered as a part of the trademark, which also contained word elements and emphasised that in such a type of registration it was allowed to use the colour element together with other word elements in another context. The SCA viewed similarly in another case involving *Aygaz* (SCA, June 25 1998, Case No. 1997/8873, Decision No. 1998/4815 – *Aygaz/Petgaz*; YASAMAN, *supra* note 6, at 90). The SCA held that the application of registration filed by the defendant consisting of the colour silver-grey in a different context than the plaintiff's trademark was also capable of being registered as a trademark, provided that adequate measures were taken to prevent any risk of confusion. The SCA based its decision on the ground that the registration of the colour silver-grey with other elements could not be interpreted to afford the trademark owner an exclusive right to the colour silver-grey. In this decision it was further stated that abstract colours, i.e. colours which have not become concrete through their representation with lines or figures, were not able to be registered as a trademark. In both of the decisions referred to, the SCA confirmed the capability of the registration of colours with other elements and emphasised that abstract colours could not be protected under trademark law. The Court showed the same approach in the *İpragaz* case (SCA, March, 4, 1999, Case No. 1998/6550, Decision No. 1999/1816 – *İpragaz*; YASAMAN, *supra* note 6, at 123).

22 Examples of such cases are the *Davidoff Cool Water* (SCA, November, 12, 1999, Case No. 1999/6866, Decision No. 1999/9075 – *Davidoff*; YASAMAN, *supra* note 6, at 103), in which the shape of a cigarette box with a colour element was sought to be registered, and some cases in which the shape of bottles in colours were applied for, such as the bottle of “Malibu Drink” in a matt white colour (SCA, July 2, 2001, Case No. 2000/3835, Decision No. 2001/6089 – *Malibu*; KARAN & KILIÇ, “Markaların Korunması Hakkında 556 sayılı KHK ve Şerhi” 52 (Ankara 2004), or perfume bottles (SCA, June, 3, 2002, Case No. 2002/1759, Decision No. 2002/5684 – *Parfume Bottle*; KARAN & KILIÇ, *id.*, at 57).

emphasising that abstract colours cannot enjoy protection under trademark law.²³ The denial of trademark protection for colours was primarily justified with the lack of distinctive character of abstract single colours and the general interest in allowing colours to be available for all, as the total number of colours is limited.

The approach of the SCA with respect to combinations of colours seems to be less strict. In the *Nivea* case²⁴ of 2001, the Court regarded, with reference to Art. 15 of the TRIPS Agreement, a combination of grey, white and dark blue colours in a square shape as a sign capable of constituting a trademark.²⁵ It is worth noting, that the disputed trademarks in the decisions referred to, were not abstract colour marks but coloured figurative marks since colour combinations were tied to a particular contour and hence limited on all sides. The SCA emphasised again that, as a matter of principle, signs consisting of a single colour may not be registered as a trademark.

In the related cases, the question of graphical presentation was not discussed, since the subject matter of these cases was the likelihood of confusion rather than the registrability of abstract colours. Such restrictive interpretation of the SCA seems to be far behind that of the ECJ. The ECJ explicitly recognised in the *Libertel* decision²⁶ the distinctive character of colours per se, provided that, *inter alia*, they may be represented graphically in a way that is clear, precise, self-contained, easily accessible, intelligible, durable and objective.

The SCA takes a more liberal approach towards three-dimensional marks. Different types of three-dimensional shapes, such as the shape of a chocolate bar,²⁷ of a cigarette lighter,²⁸ of a washing machine or dishwasher tablet,²⁹ packaging of juices,³⁰ a glass jar of coffee,³¹ cigarette boxes³² and perfume

23 For criticism of these decisions see ŞENOCAK, “Soyut Renk Markaları” 78 *et seq.* Prof. Dr. Turgut Kalpsüz’e Armağan (Ankara 2003); YASAMAN, *supra* note 6, at 85 *et seq.*

24 SCA, December 13, 2001, Case No. 2001/7583, Decision No. 2001/9840 – *Nivea*.

25 This view was confirmed in subsequent cases. In the *Smarties* case (SCA, February 11, 2002, Case No. 2002/872, Decision No. 2002/1060 – *Smarties*; YASAMAN, *supra* note 6, at 107), the disputed sign was a figurative mark in which coloured chocolate pieces were illustrated on the whole package of the product in the form of a pipe. The further two cases (SCA, Case No. 2005/9358, Decision No. 2006/9912 and SCA, February 18, 2005, Case No. 2005/9360, Decision No. 2006/9986) dealt with the registrability of the combination of three colours.

26 ECJ, May 6, 2003, Case C-104/01 – *Libertel*; 35 IIC 56 (2004).

27 SCA, April 4, 2005, Case No. 2004/6797, Decision No. 2005/3545 – *Ferrero*.

28 SCA, May 18, 2004, Case No. 2004/9317, Decision No. 2005/5762 – *Zippo*.

29 SCA, January 28, 2002, Case No. 2001/8261, Decision No. 2002/510; KARAN & KILIÇ, *supra* note 22, at 54.

30 SCA, May 17, 2006, Case No. 2005/1041, Decision No. 2006/3247 – *Capri*.

31 SCA, March 16, 2006, Case No. 2005/2149, Decision No. 2006/1947 – *Nescafe*.

32 SCA, November, 12, 1999, Case No. 1999/6866, Decision No. 1999/9075; SCA, February 9, 2005, Case No. 2005/4000, Decision No. 3604.

bottles³³ were considered to possess distinctive character and therefore to be capable of constituting a trademark. In conformity with the practice of ECJ in the cases of *Henkel v. OHIM*,³⁴ *Mag Instrument v. OHIM*³⁵ and *Linde Wimward v. Rado*,³⁶ the SCA imposed no different criteria for assessing the distinctiveness of three-dimensional marks from those to be applied to other categories of trademark.

It should be noted that in most cases the SCA examined the question of *abstract* distinctiveness in the light of Art. 5 TDL and therefore did not apply any criteria regarding the *concrete* distinctive character of the trademarks, such as by reference to the products or services in respect of which registration was sought or by reference to the perception of the relevant public. In some of these cases,³⁷ the confirmation of the registrability of the three-dimensional marks was based on the “*telle quelle*” rule of Art. 6^{quinquies} of the Paris Convention.

II. Absolute Grounds for Refusal

Article 7 TDL regulates the absolute grounds for refusal of registration. The SCA ruled that all of the absolute grounds of refusal which are related to the individual case should be examined *ex officio* by the competent court.³⁸ This means, the court may decide on each ground of refusal and even on those which were not considered by the TPI during the registration process.

A. Signs Which Do Not Conform to the Provisions of Art. 5

Article 7(a) TDL provides that signs which do not conform with the provisions of Art. 5 shall not be registered as a trademark. Therefore, the TPI examines, *ex officio*, whether the sign applied for is capable of being graphically represented and possesses distinctive character.

B. Trademarks Identical to or Confusingly Similar with Earlier Registered Trademarks

The Turkish regulation on the grounds justifying refusal in the event of a conflict with earlier rights is rather interesting, since the existence of such earlier rights leads to both absolute and relative grounds of refusal. On this point, the Turkish trademark law departs fundamentally from European

33 SCA, June 3, 2002, Case No. 2002/1759, Decision No. 2002/5684; KARAN & KILIÇ, *supra* note 22, at 57.

34 ECJ, April 29, 2004, joined Cases C-456/01 and C-457/01 – *Henkel*.

35 ECJ, October 7, 2004, Case C-136/02 – *Maglite*; 36 IIC 855 (2005).

36 ECJ, April 8, 2003, joined Cases C-53/01 to C-55/01 – *Linde Wimward/Rado*; 34 IIC 803 (2003).

37 See for example SCA, January 28, 2002, Case No. 2001/8261, Decision No. 2002/510; KARAN & KILIÇ, *supra* note 22, at 54; SCA July 2, 2001, Case No. 2000/3835, Decision No. 2001/6089 – *Malibu*; KARAN & KILIÇ, *supra* note 22, at 52.

38 See for example SCA, January 1, 2004, Case No. 2004/4734, Decision No. 2005/2590 – *Ararat*; SCA, October 26, 2004, Case No. 2005/857, Decision No. 2006/3245 – *Aç-İç*.

trademark law, where the existence of earlier trademarks constitutes only a relative ground for refusal of registration. The scope of Art. 8(1)(a) and (b) TDL, the Turkish regulation relating to the relative grounds of refusal in case of conflicting earlier trademarks identical to or similar with the trademark applied for, corresponds literally to Art. 4(1)(a) and (b) of the Directive 89/104/EEC. However, in addition to these provisions, Art. 7(1)(b) TDL provides that trademarks *identical* to or *confusingly similar (almost identical)* with earlier trademarks concerning *identical* or the *same type of goods or services* shall not be registered. This is an absolute ground for refusal which should be investigated *ex officio* by TPI. This clear overlap between the provisions³⁹ makes it necessary to determine the conditions for the application of each of the grounds of refusal. It is easier to determine the distinction between Art. 7(1)(b) and Art. 8(1)(b) TDL, since the latter requires the existence of a likelihood of confusion and furthermore covers similar goods and services. In this respect, the scope of Art. 7(1)(b) is obviously narrower than that of Art. 8(1)(b). However, it is broader than the scope of Art. 8(1)(a) TDL which covers only earlier *identical* trademarks concerning *identical* goods or services. Therefore, *confusingly similar (almost identical)* trademarks with respect to *identical* or the *same type of goods or services* as well as *identical* trademarks concerning goods or services, that are *not identical* but of the *same type*, are excluded from Art. 8(1)(a) TDL.

The application of both provisions, Art. 7(1)(b) and Art. 8(1)(a) TDL, is not dependent on the condition of likelihood of confusion. As regards the role of Art. 7(1)(b) TDL, it is submitted that the provision is designed to cover cases in which the identity or similarity between the trademarks is beyond doubt⁴⁰ and so strong that the risk of confusion that would be caused by a registration is absolute.⁴¹

Despite the foregoing theoretical considerations, the distinction between these provisions remains difficult in the evaluation of individual cases. For this reason, the approach of the SCA relating to the application of Art. 7(1)(b) and 8(1)(a) TDL is of importance. A brief glance at the decisions concerning the application of Art. 7(1)(b) makes clear that the SCA does not interpret the condition of identity of the trademarks very strictly. Decisions which show the application of Art. 7(1)(b) concern the trademarks “Champion/Çebi Champion”,⁴² “Baby Born/Baby Clup”,⁴³ “Dormeuil/Domeks”, “Dormes”, “Dorneks”, “Doreks”,⁴⁴ “Caviar House-Husoviar/House of Ca-

39 For criticism of such overlapping regulation see ARKAN, “Marka Hukuku C. I” 75 (Ankara 1997); TEKINALP, “Fikri Mülkiyet Hukuku” 374 (İstanbul 2004).

40 YASAMAN, *supra* note 6, at 227.

41 ARKAN, *supra* note 42, at 97.

42 SCA, December 13, 1999, Case No. 1999/84/95, Decision No. 1999/10179 – *Champion*; YASAMAN *supra* note 6, at 294.

43 SCA, June 26, 2002, Case No. 2002/23/82, Decision No. 2002/6369 – *Baby Born*; YASAMAN *supra* note 6, at 296.

viar”,⁴⁵ “Bak-kal/Süper Bakkal”,⁴⁶ “Marlene/Marlin”,⁴⁷ “Zara/Zahra”,⁴⁸ “Gucci/Guji”,⁴⁹ “Beymen/Beynem”,⁵⁰ and “Rodi/Roda”.⁵¹

The SCA rejected the identity of the trademarks “Al Hayat” and “Foto Hayat”⁵² as well as of “Doğadan” and “Tikveşli Doğadan”⁵³ and “Haster Foods/Master”.⁵⁴ In the rest of the above-mentioned cases the application of Art. 7(1)(b) was affirmed. In particular the cases *Champion/Çebi Champion* and *Caviar House-Husoviar/House of Caviar* are examples of cases in which the SCA interprets the concept of “identity” broadly. The practice of the SCA in these cases seems to contradict the ECJ principle laid down in the *LTJ Diffusion* decision.⁵⁵ In this decision, the ECJ held that the criterion of identity of a sign and a trademark must be interpreted strictly and that the very definition of identity implies that the two elements compared should be the same in all respects. An exception to this rule was made in cases in which there were insignificant differences between the sign and the trademark that may remain unnoticed by an average consumer. In some examples of Turkish case law it is not undisputable that the differences between the trademarks are so insignificant that they may remain unnoticed by an average consumer. Therefore, it would be appropriate to examine the registration in the light of relative grounds of refusal rather than of absolute grounds for refusal, in cases in which the identity of trademarks at issue is not beyond doubt.

For a better understanding of the regulation of Art. 7(1)(b) TDL it is also necessary to consider what is meant by the expression “same type of goods or services”. This question should be answered in the light of the provisions of the regulations of the TPI concerning the classification of goods and services.⁵⁶ According to these regulations, goods or services in the same *subclass* shall be considered being of the same type of goods or services.

44 SCA, September 29, Case No. 2000/3984, Decision No. 2000/7180 – *Dormeul*; YASAMAN *supra* note 6, at 305.

45 SCA, May 8, Case No. 2000/2917, Decision No. 2000/3975 – *Caviar House*; YASAMAN *supra* note 6, at 284.

46 SCA, April 15, 2004, Case No. 2003/9022, Decision No. 2004/4042 – *Bakkal/Süper Bakkal*; NOYAN, “Marka Hukuku” 298 (Ankara 2006).

47 SCA, May 18, 2005, Case No. 9059, Decision No. 2006/10185 – *Marlene*.

48 SCA, March 31, 2005, Case No. 2005/7656, Decision No. 2006/7581 – *Zara/Zahra*.

49 SCA, March 17, 2005, Case No. 2005/6885, Decision No. 2006/7478 – *Gucci/Guji*.

50 SCA, November 29, 2005, Case No. 2006/4339, Decision No. 2007/7101 – *Beymen/Beynem*.

51 SCA, September 27, 2005, Case No. 2005/14865, Decision No. 2004/3078 – *Rodi/Roda*.

52 SCA, November 4, 2002, Case No. 2002/5298, Decision No. 2002/9908 – *Hayat*; YASAMAN *supra* note 6, at 290.

53 SCA, October 31, 2002, Case No. 2002/9729, Decision No. 2002/9711 – *Doğadan*; YASAMAN *supra* note 6, at 293.

54 SCA, May 10, Case No. 2003/11211, Decision No. 2004/228 – *Haster Food/Master*; NOYAN *supra* note 49, at 290.

55 ECJ, March 20, 2003, Case C-291/00 – *LTJ Diffusion*; 34 IIC 651 (2003).

The SCA determined the purpose of the Turkish Regulation Concerning the Classification of Goods and Services as to classify the *identical* goods or services in the *same subclass* or *class*.⁵⁷ Following this principle, in some of its earlier decisions the SCA restricted the concept of the “same type of goods or services” to those goods or services which belong to the *same subclass* or *class*. For example, in a decision of 2000,⁵⁸ the SCA interpreted the term “identical” in Art. 7(1)(b) as “goods or services of the same class” whereas in a decision of 2002⁵⁹ it rejected an identity of goods since the goods did not belong to the same *subclass* of the regulation concerning the classification of goods and services. However, the SCA has shown a less strict approach in its recent decisions. This trend can particularly be observed in cases where goods or services belong to different classes. In such cases, the SCA affirms the similarity of the goods or services at issue by taking into consideration the circumstances of each case, *inter alia*, the perception of the average consumers, the substitutability of the goods or services, as well as their intended purpose of use.⁶⁰ This judicial approach gained a legal basis by the enactment of the Regulation No. 2007/2,⁶¹ Concerning the Classification of Goods and Services Regarding the Applications for Trademark Registrations which replaced the former Regulation No. 2002/3. Article 5 of the new Regulation provides that in determining “goods and services of the same type” as referred to in Art. 7(1)(b) TDL, the groups⁶² mentioned in the

56 TPI Regulation Nos. 2000/2, 2001/2, 2002/2 and 2002/3. These regulations have been revoked and replaced by the new Regulation No. 2007/2.

57 SCA, May 30, 2003, Case No. 2003/5473, Decision No. 2003/5733 – *Alpilop/Alptop*; KARAN & KILIÇ, *supra* note 22, at 234. In this case, it was disputed whether there was a likelihood of confusion between the trademark “Alpilop” registered in respect of goods of classes 29 (*inter alia* meats, milk and milk products, eggs, industrially made soups, dried fruits) and 30 (*inter alia* coffee, cacao, biscuits, chocolates, sugar, flour, candies) and the trademark “Alptop” applied for registration in respect of goods of class 32 (*inter alia* beers, mineral waters, fruit juices, colas, soft drinks). The SCA rejected the similarity between the goods at issue on the ground that they belonged to different classes. Although the case dealt with the question of similarity of the respective goods or services rather than the interpretation of “goods of the same type”, it demonstrates that the SCA considers the regulation concerning the classification of goods and services an important basis for the evaluation of identity or similarity of goods or services.

58 SCA, May 14, 2001, Case No. 2000/5465, Decision No. 2001/4230 – *Power Color*; KARAN & KILIÇ, *supra* note 22, at 148.

59 SCA, November 11, 2002, Case No. 2002/5298, Decision No. 2002/9908 – *Foto Hayat/Al Hayat*; YASAMAN *supra* note 6, at 292.

60 See for example IP Court of Ankara, March 31, 2005, Case No. 2004/4, Decision No. 2005/202 – *Zara/Zabra*; IP Court of Ankara, April 19, 2005, Case No. 2005/9357, Decision No. 2006/10026 – *44/4x4*; IP Court of Ankara, December 2, 2004, Case No. 2004/386, Decision No. 327 – *Arçelik/Karçelik*.

61 Published in the Turkish Official Journal, 08.01.2007, No. 26397. Available at: <http://www.tpe.gov.tr/portal/default2.jsp?sayfa=280>.

62 In the new regulation, the goods and services are classified into 45 groups which mainly correspond to the classes of the former regulation. The subclasses of the former regulation have been abolished.

Annex of the Regulation should be taken as the basis. However, the TPI should be entitled to interpret “goods and services of the same type” broadly, such as to include “goods and services of different groups”.

C. Descriptive or Generic Signs

Article 7(1)(c) and (d) TDL which corresponds to Art. 3(1)(c) Directive No. 89/104/EEC excludes descriptive signs from the scope of protection. Thus, trademarks consisting exclusively of signs or indications which serve in trade to indicate the kind, characteristics, quality, intended purpose, value, geographical origin, or to designate the time of production of the goods or the time of rendering of a service or other characteristics of goods or services shall not be registered as a trademark. Similarly, subparagraph (d) provides that trademarks which consist exclusively of signs and names used to distinguish specific groups of craftsmen, professionals or tradesmen, or signs which have become customary in the current and established practices of trade, shall not be registered as a trademark either.

In most of the cases touching on the question of descriptiveness, the descriptive character of English words, which might fall under the provisions of Art. 7(1)(c) and (d) TDL,⁶³ was examined. Unfortunately, contrary to the practice of the ECJ in the *Baby-Dry* case,⁶⁴ the SCA paid little attention to the perception of the relevant public in the assessment of descriptive character of trademarks composed of English words. There have been contradictory decisions on this issue.

In some cases such as *Pinar Labne*,⁶⁵ *Pet hospital*⁶⁶ and *Casa-Beymen Casa Club*⁶⁷ the question of descriptiveness was examined without any reference to the perception by the average consumers of the related goods and services. In the *Pinar Labne* case the SCA pointed out that the word “*labne*” was a sort of yogurt cheese especially known and eaten in Middle Eastern countries, and concluded that it was descriptive in respect of cheese products. Accordingly, the question of descriptiveness was not discussed with reference to the relevant Turkish public’s perception.

On the other hand, the cases *chiffon*⁶⁸ and *florist*⁶⁹ are clear examples of cases in which the issue of descriptiveness was examined with a focus on the

63 For example “chiffon”, “pet hospital”, “servicemaster”, “multicanal”, “autocar”, “media vision, florist”, “browni”, “streetball”, “expo channel”, “T-Motion” and “pool”.

64 ECJ, September 20, 2001, Case C-383/99 – *Baby-Dry*; 33 IIC 318 (2002).

65 SCA, September 20, 2000, Case No. 2001/4623, Decision No. 2001/6954 – *Pinar Labne*; YASAMAN, *supra* note 6, at 323.

66 SCA, February 7, 2000, Case No. 1999/9814, Decision No. 2000/829 – *Pet Hospital*; YASAMAN, *supra* note 6, at 328.

67 SCA, June 8, 1999, Case No. 1999/136, Decision No. 1999/5033 – *Casa Beymen*; YASAMAN, *supra* note 6, at 497.

68 SCA, February, 17, 2000, Case No. 2000/236, Decision No. 2000/114 – *Chiffon*; KARAN & KILIÇ, *supra* note 22, at 112.

perception of the relevant consumers. In the *chiffon* case, the SCA emphasised that the word “chiffon” of French origin had widespread use in the Turkish language and is thus descriptive in the eyes of Turkish people. Similarly it was held in the *florist* case that the English word “florist” was known to the relevant Turkish public and hence is descriptive with respect to services of organising exhibitions in the field of floriculture. In the recent *Browni* case⁷⁰ of 2007, the specialised IP Court of Ankara held that the word “browni” had not been perceived as a sort of cake by the average consumer at the date of the registration of the composite trademark at issue, which included the word “browni”. However, this determination of the IP Court of Ankara was not discussed in the decision of the SCA because the risk of confusion between the trademarks “Eti Browni” and “Ülker Çikolata Brownie Chocolate Cake” was the prior issue of discussion and not the descriptive character of the word “browni”. The *Visible Results*⁷¹ case is another example in which the decision was based on the perception of the average consumers of the goods which bear the trademark “Visible Results”. In this decision, the SCA recognised the fact that the average consumers of cosmetic products have passable knowledge of English and consequently held that the trademark was descriptive in respect of these goods. These examples show that the SCA tends to pay more attention to the perception of the average consumers of the goods or services.

A number of cases have dealt with the registrability of trademarks consisting of composite words. In the cases *multicanal*,⁷² *steelcase*,⁷³ *streetball*⁷⁴, *neocare*⁷⁵ and *neobant*,⁷⁶ for example, the SCA assessed the trademarks as a whole. It emphasised that the composition of individual components which are, on their own, devoid of distinctive character, may have distinctive character. In the *multicanal* case, the SCA found that the combination of the words “multi” and “canal” was not distinctive with respect to services of television and radio broadcasting for which protection was sought. As stated in the *Companyline* decision of the ECJ, it was emphasised in the *multicanal* decision that the coupling of two descriptive terms without any modification would not confer distinctive character upon the combination. The cases *neocare* and *neobant* are further examples in which the distinctive character of the composite words were denied. Contrarily, the signs “steelcase” and

69 SCA, November, 22, 2002, Case No. 2002/5352, Decision No. 2002/1729 – *Florist*; YASAMAN, *supra* note 6, at 331.

70 SCA, October 27, 2005, Case No. 2005/23, Decision No. 2005/557 – *Browni*.

71 SCA, December 30, 2004, Case No. 2005/9336, Decision No. 2006/10025 – *Visible Results*.

72 SCA, November 9, 2000, Case No. 2000/6135, Decision No. 2000/8767 – *Multicanal*; KARAN & KILIÇ, *supra* note 22, at 129.

73 SCA, December 12, 1997, Case No. 1997/7901, Decision No. 1997/9168 – *Steelcase*.

74 SCA, February 22, 2005, Case No. 2005/5602, Decision No. 2006/5706 – *Streetball*.

75 SCA, October 27, 2004, Case No. 2005/1037, Decision No. 2006/1191 – *Neocare*.

76 SCA, April 3, 2005, Case No. 2005/7414, Decision No. 7479 – *Neobant*.

“streetball” were found to be distinctive in respect of the goods and services they were applied for.

The SCA showed a similar approach in some cases touching on the assessment of descriptiveness in respect of trademarks which are combinations of several words, such as “Auto Car”,⁷⁷ “Media Vision”,⁷⁸ “Service Master”⁷⁹ and “Expo Channel”.⁸⁰ In most of these cases, the SCA examined the descriptive character of the trademarks by viewing them in their entirety and confirmed the existence of distinctive character. In the *Auto Car* case the SCA emphasised that such a word combination had no meaning in any language. It concluded that the trademark “Auto Car” was not descriptive in respect of publications, newspapers, magazines and brochures. Similarly, in the *Media Vision* case the court found that the descriptive character of the words “media” and “vision” should be examined as a combination of terms. The same approach was shown in the subsequent case *expo channel* in which the SCA considered the trademark not descriptive in respect of fair and exposition services. The practice of the SCA in these cases corresponds to that of the ECJ. The *Baby dry*, *Biomild*, *Doublemint* and *Postkantoor* cases, in which the question of descriptiveness was examined by considering the combination of words as a whole, are examples of such case law of the ECJ. On the other hand, an example of Turkish case law which departs from the practice of the ECJ can be found in the *Service Master* case. In this case, the trademark was broken down into its elements, and the descriptive character of the term “master” was evaluated separately.

In the *Interactive* case,⁸¹ a controversial decision regarding the registrability of descriptive signs, the SCA ruled that any descriptive sign was capable of being registered as a trademark with other elements. In this case the word “interactive” was sought for registration as a trademark in respect of marketing, advertising and promotional services. The SCA overruled the decision of the Court of First Instance (CFI) and held that the word “interactive” as such was not capable of being registered as a trademark, but that it might be registered together with the terms “advertising”, “marketing” or “communication”. Since the CFI had insisted on its decision, the case was referred to the Enlarged Board of Appeals of the SAC. In spite of the dissenting opinion its decision included, the Board upheld the view of the SCA. In the dissenting opinion, which has been supported by some scholars,⁸² it was argued that

77 SCA, April 24, 2001, Case No. 2001/1400, Decision No. 2001/3499 – *Auto Car*; KARAN & KILIÇ, *supra* note 22, at 146.

78 SCA, May 16, 2002, Case No. 1990, Decision No. 4808 – *Media Vision*; YASAMAN, *supra* note 6, at 355.

79 SCA, January 20, 2000, Case No. 1999/6661, Decision No. 2000/158 – *Servicemaster*; YASAMAN, *supra* note 6, at 371.

80 SCA, November 29, 2005, Case No. 2006/2781, Decision No. 5819 – *Expo Channel*.

81 SCA, December 20, 2000, Case No. 2000/11-1804, Decision No. 2000/1814 – *Interactive*; YASAMAN, *supra* note 6, at 108.

82 For example YASAMAN, *supra* note 6, at 235.

the word “interactive” would still be descriptive in respect of the services at hand when the terms “advertising”, “marketing” or “communication” are added.

With respect to the capability of registration of geographical names, the SCA has laid down different principles in a number of cases. In the *Pendik* case,⁸³ the trademark in dispute consisted exclusively of the word “Pendik” (a district of Istanbul) and was used for certain starch goods. The CFI stated that since the goods had not been produced in the district of Pendik the word “Pendik” was capable of being registered as a trademark. The SCA overruled this decision on the ground that the registration of trademarks consisting exclusively of geographical names leads to their monopolisation for the benefit of individuals or entities. And this contradicts the simple principle that geographical names *as such* should be left free for all to use. To overcome this problem, the SCA ruled that geographical names might be registered together with the goods or services applied for registration, e.g. “Istanbul Wines” or “Ankara Bazaars”.⁸⁴ In this decision, the SCA applied the general rule of “the need to leave free for all” in respect of geographical names without any reference to the characteristics of the place designated by the name “Pendik” and to the category of goods concerned. Such practice seems to contradict the principles laid down by ECJ case law. In the *Chiemsee* case,⁸⁵ the ECJ found that the registration of geographical names as trademarks is prohibited when firstly the names designate places which are in the mind of the relevant class of persons currently associated with the category of goods at question, and secondly the geographical names are liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods.

In a case decided in 2004,⁸⁶ the SCA applied principles different from those applied in the *Pendik* case. The said case dealt with the registration of the geographical names “Akdeniz (Mediterranean)”, “Granada” and “Valensiya (Valencia)” in respect of tile products. Based on an expert opinion according to which the word “Akdeniz” indicates a sort of tile, the SCA held that such term was descriptive in respect of tile goods. As regards the registrability of the geographical names “Granada” and “Valensiya”, it stated that the mere fact that such names indicate geographical places did not lead to a ground for refusal of registration. It was furthermore emphasised that there was no connection between the category of goods concerned and the geographical places designated by the trademarks at hand. In this case, the SCA acknowledged the connection between the geographical places and the goods named accordingly but failed to examine whether the class of relevant persons

83 SCA, November 26, 1999, Case No. 1999/5790, Decision No. 1999/9590 – *Pendik*; YASAMAN, *supra* note 6, at 118.

84 For criticism of this decision see YASAMAN, *supra* note 6, at 67, 68.

85 ECJ in joined Cases C-108/97 and C-109/97 – *Chiemsee*.

86 SCA, February 20, 2004, Case No. 2003/6901, Decision No. 2004/1531 – *Akdeniz*; KARAN & KILIÇ, *supra* note 22, at 187.

associate the geographical names with the category of goods. This approach is more consistent with the practice of the ECJ.

D. Deceptive Signs

Article 7(1)(f) TDL, which corresponds to Art. 3(g) of Directive 89/104/EEC, prohibits the registration of trademarks which are of such a nature as to deceive the public, such as to the nature, quality, place of production or geographical origin of the goods and services.

In the cases *Doctor Renaud Paris*,⁸⁷ *Italiana*⁸⁸ and *Ararat*⁸⁹ the SCA discussed whether the relevant public might be mistaken as to the geographical origin of the goods bearing the mentioned trademarks. In the *Doctor Renaud Paris* decision, the applications for registration of the trademarks “Doctor Renaud Paris Pürel Junior” and “Doctor Renaud Paris Pürel Junior” were refused by the TPI on the ground that the signs might be deceptive on the part of the relevant public in respect of the goods in the classes 3 (*inter alia* perfumery, soups, products of dental care) and 5 (*inter alia* medicines, dietetic products, disinfectants). The SCA considered the disputed trademarks not to be deceptive.

In the *Italiana* decision, the trademark “Italiana” with a figurative element was sought for registration in respect of stockings. The SCA upheld the decision of the CFI, which denied a deceptive character of the trademark due to the fact that Italy is not famous for its stocking industry.

Also the *Ararat* case is an example in which the question of deceptiveness as to the geographical origin of the goods was discussed. The case dealt with the registration of the trademark “Ararat” in respect of spirits produced in Armenia. The SCA held that the relevant public might associate the word “Ararat” with Mount Ararat (*Ağrı Dağı*) in Turkey. And this might mislead the public as to the geographical origin of the goods which were not produced in Turkey.

In some further cases, the question of deceptiveness was examined in relation to the characteristics of the goods and services for which the trademark was applied. For example, in the *Granit Center* case⁹⁰ it was discussed whether the trademark “Granit Center” applied for registration in respect of goods, *inter alia* wall tiles, ceramics, products for kitchen and bathroom, might lead to a deception on the part of relevant public. The decision of the CFI confirming the deceptive character of the trademark was upheld by the SCA

87 SCA, January 2004, Case No. 2003/606, Decision No. 2004/429 – *Doctor Renaud Paris*; KARAN & KILIÇ *supra* note 22, at 185.

88 SCA, April 15, 2004, Case No. 2003/9024, Decision No. 2004/4061 – *Italiana*; NOYAN, *supra* note at 49, at 297.

89 SCA, January, 17, 2004, Case No. 2004/4734, Decision No. 2005/2590 – *Ararat*.

90 SCA, July 1, 2004, Case No. 2003/11400, Decision No. 2004/7346 – *Granit Center*; NOYAN, *supra* note 49, at 286.

due to the fact that the use of the term “granit” in the trademark suggests that goods bearing the trademark are made of granite.

E. Well-Known Trademarks Under Art. 6^{bis} of the Paris Convention

According to Art. 7(1)(i) TDL, well-known marks under Art. 6^{bis} of the Paris Convention constitute an absolute ground for refusal. Trademarks with a reputation within the meaning of Art. 8(4) TDL constitute, on the contrary, a relative ground for refusal. Therefore, the registration of trademarks with a reputation may only be refused if the proprietor of such trademark opposes the registration.⁹¹

The border between the concepts of “well-known trademarks” and “trademarks with a reputation”, particularly the degree of recognition, has remained unclear. In some recent cases⁹² the SCA drew a conceptual border between well-known trademarks and trademarks with a reputation. In these decisions, following the view of some scholars,⁹³ the SCA clarified that the degree of recognition of trademarks with reputation is lower than that of well-known trademarks. It also emphasised that a well-known trademark should in any case be considered as a trademark with a reputation, whilst, on the contrary, a trademark with reputation need not always be a well-known trademark.

In examining the question, whether a trademark qualifies as well-known, the SCA has always taken into consideration the number of registrations of the trademark throughout the world.⁹⁴ In some earlier decisions⁹⁵ this criterion was deemed to be sufficient to consider a trademark well-known. In some other decisions,⁹⁶ it was emphasised that the number of registrations throughout the world constitutes a rebuttable presumption that a trademark is well known. After a short period of time, already in 2002,⁹⁷ the SCA

91 See below at 24.

92 For example SCA, April 28, 2003, Case No. 11715, Decision No. 4181 – *Win/Dorwin*; YASAMAN, *supra* note 6, at 505; SCA, June 28, 2004, Case No. 2003/13167, Decision No. 2004/7103 – *Vestino*, *Kazançı İçtihat Bankası*.

93 TEKINALP, *supra* note 42, at 395.

94 For example SCA, June 23, 2000, Case No. 2000/5459, Decision No. 2000/5902 – *Cockpit*; YASAMAN, *supra* note 6, at 342; SCA, February 12, 2001, Case No. 2000/101333, Decision No. 2001/1142 – *Oxxo*; KARAN & KILIÇ, *supra* note 22, at 142.; SCA, May 20, 2002, Case No. 2002/4699, Decision No. 2002/48/71 – *IKEA*; KARAN & KILIÇ, *supra* note 22, at 162; SCA, July 6, 2004, Case No. 2003/13329, Decision No. 2004/7553 – *Tommy Hilfiger*; NOYAN, *supra* note 49, at 283.

95 For example SCA, June 23, 2000, Case No. 2000/5459, Decision No. 2000/5902 – *Cockpit*.

96 For example SCA, February 12, 2001, Case No. 2000/101333, Decision No. 2001/1142 – *Oxxo*.

97 See SCA, March 24, 2003, Case No. 2002/10575, Decision No. 2003/2752 – *Mas*; YASAMAN, *supra* note 6, at 346. In this case the SCA overruled the decision of the CFI on the ground of insufficient examination of the evidence submitted by the plaintiff and disregard of the WIPO Recommendations.

acknowledged that the WIPO Recommendations for the Protection of Well-Known Marks⁹⁸ should be taken into consideration in the examination of the well-known character of a trademark. This approach was confirmed in subsequent decisions of the SCA.⁹⁹ Consequently, the SCA has clarified that registrations of a trademark may only be one of several criteria to determine the well-known character of a trademark. The criteria for the recognition of a trademark as well-known are summarised in these decisions as the degree of recognition in the related public sectors, the duration, extent and geographical area of the use of the trademark, area, duration and extent of trademark promotions, the geographic area of registrations or applications of registration of the trademark, the record of successful enforcement of rights in the trademark, the extent to which the trademark was recognised as well known by related official authorities and the economic value of the trademark.¹⁰⁰ Some trademarks which were considered as being well known under the application of these criteria are “Wal-Mart”,¹⁰¹ “Mango”,¹⁰² “Bacardi”,¹⁰³ “Rado”,¹⁰⁴ “Tissot”,¹⁰⁵ “Rafaello”,¹⁰⁶ and “Real”.¹⁰⁷

Having these criteria as reference, the Turkish IP courts take into consideration all the circumstances from which it may be inferred that a trademark is well known. The TPI is also entitled to decide whether a trademark can be considered as well known.¹⁰⁸ This authority was granted to TPI by Art. 13(d) of the Law No. 5000 Concerning the Establishment and Duties of the Turkish Patent Institute.¹⁰⁹ The decisions of the TPI are subject to judicial review and therefore may be annulled by the courts. On the basis of Law No. 5000, the TPI published eighteen criteria for the determination of well-known trademarks¹¹⁰ which are taken into consideration in the assessment of the well-known character of trademarks.

98 For a commentary on these recommendations see KUR, “The WIPO Recommendations for the Protection of Well-known Marks”, 31 IIC 824 *et seq.* (2000).

99 See for example SCA, June 28, 2004, Case No. 2003/13167, Decision No. 2004/7103 – *Vestino*; SCA, December 9, 2004, Case No. 2004/1146, Decision No. 2004/12103 – *Black & Decker*; Kazancı İctihat Bankası.

100 See SCA, March 10, 2005, Case No. 2004/4268, Decision No. 2005/2362 – *Ülker/Ülker*, Kazancı İctihat Bankası.

101 SCA, February 24, Case No. 2004/5167, Decision No. 2005/1790 – *Wal-Mart*.

102 SCA, May 26, 2005, Case No. 2005/9895, Decision No. 2006/10747 – *Mango*.

103 SCA, January 27, 2005, Case No. 2005/3418, Decision No. 2006/3370 – *Bacardi*.

104 SCA, September 29, 2005, Case No. 2005/15011, Decision No. 2007/3530 – *Rado*.

105 SCA, April 6, 2005, Case No. 2005/9439, Decision No. 2006/10562 – *Tissot*.

106 SCA, March 22, 2005, Case No. 2005/6234, Decision No. 2006/5942 – *Rafaello*.

107 SCA, November 23, Case No. 2005/7493, Decision No. 2006/7197 – *Real*.

108 This authority is also mentioned in a case of 2004 (SCA, June 24, 2004, Case No. 2003/12431, Decision No. 2004/7020 – *Marriot*; KARAN & KILIÇ, *supra* note 22, at 191).

109 Published in the Turkish Official Journal (RG), 19.11.2003, No. 24294.

110 These criteria are available on the internet at: <http://www.tpe.gov.tr/portal/default2.jsp?sayfa=280>.

As regards the scope of protection of well-known trademarks under Art. 6^{bis} of the Paris Convention, it may be pointed out that they are protected against conflicting trademarks constituting a reproduction, imitation or translation of the well-known trademark which could cause confusion.¹¹¹

F. Acquiring Distinctiveness through Use

According to the second subparagraph of Art. 7 TDL, a sign which is not inherently distinctive, or which is descriptive or generic, might be protected as a trademark if the sign has become distinctive through use. According to the said subparagraph, the provisions of (a), (c) and (d) of Art. 7(1) TDL can not be invoked to refuse the registration of a trademark which has been used before the registration and has acquired distinctive character through this use in respect of the goods and services for which it is sought to be registered.

The issue of distinctiveness acquired through use has been examined by the SCA in a number of cases such as *Premier*,¹¹² *Plus*,¹¹³ *Balsüt*,¹¹⁴ *Vitaleyes*,¹¹⁵ *Florist*,¹¹⁶ *Ayakkabı Dünyası*,¹¹⁷ *Solid Clear Dry*,¹¹⁸ and *Beyti*.¹¹⁹ In these decisions, the SCA confirmed that a descriptive sign might acquire distinctiveness through use within the meaning of the provision of the second subparagraph of Art. 7 TDL. However, the question of how a sign can acquire distinctive character is not clear. In the *Premier*, *Plus* and *Vitaleyes* cases, it was merely emphasised that the sign had been used before the date of registration without a discussion of the reasons behind the acquired distinctiveness.

In the *Florist* case, the SCA stated that in assessing whether a sign has acquired distinctive character through use, the perception of the relevant classes of persons including sellers and buyers of the goods and services should be considered. Here, the SCA declared that the distinctive character was insufficient since it only relied on the seller's point of view. This view corresponds to the decisions of the ECJ in the *Chiemsee* and *Nestlé v. Mars*

111 SCA, July 6, 2004, Case No. 2003/13329, Decision No. 2004/7553 – *Tommy Hilfiger*.

112 SCA, May 10, 2004, Case No. 2003/11424, Decision No. 2004/5146 – *Premier*; NOYAN, *supra* note 49, at 292.

113 SCA, April 26, 2004, Case No. 2003/10426, Decision No. 2004/4494 – *Plus*; NOYAN, *supra* note 49, at 294.

114 SCA, October 31, 2002, Case No. 2002/9506, Decision No. 2002/9693 – *Balsüt*; YASAMAN, *supra* note 6, at 351.

115 SCA, March 19, 2002, Case No. 2001/10734, Decision No. 2002/2516 – *Vitaleyes*; KARAN & KILIÇ, *supra* note 22, at 158.

116 SCA, November 22, 2002, Case No. 2002/5352, Decision No. 2002/1729 – *Florist*.

117 SCA, April 2004, Case No. 2003/9027, Decision No. 2004/3569 – *Ayakkabı Dünyası*; NOYAN, *supra* note 49, at 302.

118 SCA, June 22, 2004, Case No. 2004/688, Decision No. 2004/6933 – *Solid Clear Dry*; NOYAN, *supra* note 49, at 288.

119 SCA, December 15, 2004, Case No. 2005/4383, Decision No. 2006/5799 – *Beyti*.

cases.¹²⁰ In these, the ECJ found that the distinctive character acquired through use should be examined in relation to the relevant class of persons and to the presumed expectations of an average consumer of the category of the goods and services.

One of the most important questions regarding the issue of acquired distinctiveness is to determine under which conditions a sign can acquire distinctive character through use. In a decision of 2004¹²¹ the specialised IP Court of Ankara correctly stated that a distinctive character of the sign has to be assumed in cases where the sign is perceived by the consumers as an identification of the origin of the goods and services for which registration is sought. This decision by the Ankara court corresponds to that of the ECJ in its *Chiemsee* decision, according to which “a trademark acquires distinctive character following the use which has been made of it where the mark has come to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings”.

The criteria applied by the SCA in the assessment of the capability of a sign to be perceived by the consumers as an indication to the origin of the goods and services are not uniform. Each case has been evaluated according to its circumstances and thus no common criteria for the assessment have been developed. Still, the courts have generally taken into consideration how intensive, geographically widespread and long standing a sign has been used. This corresponds basically to the principle laid down by the ECJ in the *Chiemsee* and *Nestlé v. Mars* cases, according to which the matters capable of demonstrating that the mark has come to identify the product or service concerned must be assessed globally. However, it is worth noting that the criteria for the assessment of acquired distinctiveness have not always been applied cumulatively, and the case law on acquired distinctiveness has been based on different individual criteria.

The *Balsüt* case is an example of those cases in which the acquired distinctive character was based only on the duration of use of the mark. No reference was made to the geographical extent of such use. The question of geographical extent, however, was discussed in some of the decisions of the specialised IP Court of Ankara. In a case dated 2005,¹²² the court emphasised that to acquire distinctive character a sign must have been used throughout Turkey or in a substantial part of it. In a subsequent decision,¹²³ it was emphasised that the products bearing the mark had been sold in several cities of Turkey, and it was hence held that the mark had acquired distinctive character through such widespread use. In another case from 2005,¹²⁴ the IP court of

120 ECJ, July 7, 2005, Case C-353/03 – *Nestle/Mars*; 37 IIC 88 (2006).

121 Case No. 2004/956, Decision No. 2005/96.

122 IP Court of Ankara, Case No. 2004/167, Decision No. 2005/1888.

123 IP Court of Ankara, Case No. 2004/284, Decision No. 2005/296.

124 IP Court of Ankara, Case No. 2004/1111, Decision No. 2005/86.

Ankara found the use of the disputed mark in a few large cities like Ankara, Istanbul and Izmir sufficient for the acquirement of distinctive character.¹²⁵

III. Relative Grounds for Refusal

A. Similarity of Trademarks Involving a Risk of Confusion

According to Art. 8(1)(b) TDL a sign shall not be registered as a trademark if, because of its identity or similarity to an earlier trademark and the identity or similarity of the goods and services covered by the trademarks, there is a risk of confusion on the part of the public, which includes the likelihood of association with the earlier trademark.

The SCA has ruled on several cases relating to the likelihood of confusion between trademarks and has developed some criteria for the assessment of a likelihood of confusion. In conformity with the principles laid down by the ECJ¹²⁶ in the *Canon*¹²⁷ and *Lloyd* cases¹²⁸ the SCA evaluates the cases concerning the likelihood of confusion globally by taking into account all relevant factors, *inter alia*, the degree of similarity between the trademarks and between the goods or services concerned and the reputation of the earlier mark.

In conformity with the practice of the ECJ, the SCA examines the similarity between trademarks by taking into consideration the different kinds of similarity, namely aural, visual and conceptual similarity, and assumes a likelihood of confusion in cases in which at least one of these kinds of similarity exists.

A brief glance at the decisions of the SCA shows that the concept of likelihood of confusion is interpreted in a very broad sense, and in the overwhelming majority of cases, a likelihood of confusion was confirmed. Such practice can be explained with the tendency of the SCA to evaluate the likelihood of confusion by placing priority on the common components of the marks rather than the overall impression conveyed by them. Although in some of its decisions the SCA emphasised that the likelihood of confusion should be considered in light of the overall impression conveyed by the respective sign, it has reduced the role of the overall impression criterion by breaking down the marks into their components in most of the cases. Examples of cases in which the SCA applied the overall impression rule in conformity with the case law of the ECJ are *Playboy/Playback*¹²⁹ and *Aygaz/Kaygaz*.¹³⁰ In *Playboy/Playback* the SCA overruled the decision of the CFI,

125 For criticism of this decision see DOĞAN, "Marka Hukukunda Kullanım Sonucu Ayırt Edici Güç Kazanma" 231 *Batider* 2007.

126 For ECJ principles regarding the determination of likelihood of confusion see KNAAK in SCHRICKER, BASTIAN & KNAAK (eds.), "Gemeinschaftsmarke und Recht der EU-Mitgliedstaaten" 79 *et seq.* (Munich 2006).

127 ECJ, September 29, 1998, Case C-39/97 – *Canon*; 30 IIC 72 (1999).

128 ECJ, June 22, 1999, Case C-342/97 – *Lloyd*; 31 IIC 420 (2000).

which confirmed the likelihood of confusion between the marks *Playboy* and *Playback*. In the decision, the SCA characterised the words *Playboy* and *Playback* as composite words. It stated that the CFI erred in law by finding that there is a likelihood of confusion between the marks by breaking down the marks into their components. The SCA showed a similar approach in the *Aygaz/Kaygaz* case, where the criterion of overall impression was explicitly mentioned.

The dominating practice, according to which the risk of confusion is assessed on the basis of the common elements of the trademarks that are compared, is applied regardless of whether the trademark is a single (word or figurative) or a composite mark with several word or figurative elements. Examples of cases touching on the likelihood of confusion between two word marks consisting both of one word element only are *Real/Realwar*,¹³¹ *Scotch/Scotchcare*,¹³² *Pınar/Üçpınar*,¹³³ *Duman/Özduman*¹³⁴ and *State/Stateline*.¹³⁵ In these cases, the SCA confirmed the likelihood of confusion because of the similarity between the trademarks caused by the use of substantial elements, i.e. the words “real”, “scotch”, “pınar”, “duman” and “state” within the later trademarks. What all of the above-mentioned cases have in common is that the elements which were used within the later trademarks were qualified as *substantial* or *distinctive* elements of the earlier marks. But it is not clear how the SCA evaluated the position of the said elements in the later trademarks. On this point, the practice of the SCA seems rather differentiated. In the *Real/Realwear* case the word “real” was qualified as the *substantial* and *identifying* element of both trademarks, whilst in the *Pınar/Üçpınar* case the SCA found that the addition of the word element “üç” would not exclude the likelihood of confusion.

The assessment of likelihood of confusion by focusing on the common elements of the trademarks is also applied in cases concerning the likelihood of confusion between single word trademarks and composite marks with word and figurative elements. The decision of SCA in the *Diamo* case¹³⁶ dealt with such a dispute. In this case it was disputed that there was a

129 SCA, November 2, 1999, Case No. 1999/4005, Decision No. 1999/8651 – *Playboy/Playback*; YASAMAN, *supra* note 6, at 501.

130 SCA, May 14, 2002, Case No. 2002/1890, Decision No. 2002/4750 – *Aygaz/Kaygaz*.

131 SCA, June 2, 2003, Case No. 2003/139, Decision No. 2003/5760 – *Real/Realwar*.

132 SCA, April 26, 2004, Case No. 2003/10261, Decision No. 2004/4410 – *Scotch/Scotchcare*; KARAN & KILIÇ, *supra* note 22, at 253.

133 SCA, September 29, 2003, Case No. 2514, Decision No. 8366 – *Pınar/Üçpınar*; YASAMAN, *supra* note 6, at 450.

134 SCA, May 3, 2004, Case No. 2003/10923, Decision No. 2004/4781 – *Duman/Özduman*; KARAN & KILIÇ, *supra* note 22, at 255.

135 SCA, October 4, 1999, Case No. 1999/5327, Decision No. 1999/7505 – *State/Stateline*; YASAMAN, *supra* note 6, at 451.

136 SCA, May 12, 2003, Case No. 2002/12399, Decision No. 2003/4710 – *Diamo*; Kazanci Datenbank of Case Law.

likelihood of confusion between the earlier composite trademark consisting of the word “Dia” and an additional figurative element and the later single-word trademark “Diamo”. Registration was sought for identical goods. The SCA ruled, firstly, that the substantial element of a trademark should be considered as the element enabling the trademark to be distinguished from other signs and, in case of composite trademarks, as the element dominating in the overall impression conveyed by the trademark. Secondly, the SCA qualified the word “Dia” as the substantial element of both trademarks and found that its use within the later trademark might lead to a risk of confusion for the average consumers of the goods because of the aural and visual similarities between the signs. The SCA emphasised thirdly that the additional element used in the later trademark (“mo”) did not possess any distinctive character. This approach was repeated in a recent case of 2006¹³⁷ where the likelihood of confusion between the earlier trademarks “Form” and “Eti Form”, which were registered with an additional figurative element, namely the Hittite sun figure, and the word trademark “Reform”. In this case, the SCA confirmed the risk of confusion including the risk of association between the signs due to the similarity between them and the identity of the goods. These cases make it clear that in evaluating the likelihood of confusion the SCA gives special consideration to the so-called *substantial* or *dominating* elements of the trademark and thereby reduces the role of the criterion of the overall impression.

The prevailing consideration of common elements of the disputed trademarks is particularly of great importance in cases in which the only, or one, of the substantial elements of the earlier trademark is used within the second trademark consisting of several word elements. According to Turkish case law the likelihood of confusion is assumed in cases in which the single or one of the substantial elements of a trademark is used in a composite trademark consisting of several word elements. *Ülker Çizi/Şimşek Chest*,¹³⁸ *Mavi Jeans/Mavi Show*,¹³⁹ *Doğan Nostalji/Nostalji*,¹⁴⁰ *Paşatur Turizm Hizmetleri A.Ş./Hillside Pascha Beach*,¹⁴¹ *Kinder/Kinder Koala*,¹⁴² *Form/Uno Form*,¹⁴³ *Papatya/Giz Papatya*,¹⁴⁴ *Browni/Ülker Çikolatalı Browni Chocolate Cake*,¹⁴⁵

137 SCA, June 23, 2006, Case No. 2005/4814, Decision No. 2006/7247 – *Form/Eti Form*.

138 SCA, July 5, 2001, Case No. 2001/4502, Decision No. 2001/6197 – *Ülker Çizi/Şimşek Chest*.

139 SCA, March 19, 2002, Case No. 2001/19685, Decision No. 2002/2514 – *Mavi Jeans/Mavi Show*.

140 SCA, January 21, 2003, Case No. 2002/9254, Decision No. 2003/505 – *Doğan Nostalji/Nostalji*; KARAN & KILIÇ, *supra* note 22, at 232.

141 SCA, December 15, 2003, Case No. 2003/4710, Decision No. 2003/11877 – *Paşatur/Pascha Beach*; KARAN & KILIÇ, *supra* note 22, at 247.

142 SCA, April 27, 2004, Case No. 2003/10588, Decision No. 2004/4556 – *Kinder/Kinder Koala*; KARAN & KILIÇ, *supra* note 22, at 254.

143 SCA, October 21, 2005, Case No. 2004/11195, Decision No. 10016 – *Form/Uno Form*.

144 SCA, Enlarged Board of Appeals, June 7, 2006, Case No. 2006/11-338, Decision No. 2006/338 – *Papatya/Giz Papatya*.

İçim Quick/Pınar Quick,¹⁴⁶ *Nina Ricci/Marco Ricci*¹⁴⁷ serve as examples of such disputes. In these cases, the SCA ruled that the use of *substantial* elements of the earlier trademarks within the later trademarks might lead to a likelihood of confusion for the average consumers of the goods and services.

The question, how the substantial element of an earlier trademark should have been used in the later trademark so that there might be a likelihood of confusion between the composite trademarks was clarified in a recent decision of 2006 relating to the case *Papatya/Giz Papatya*. Here, the Enlarged Board of Appeals of the SCA ruled on the conflicting decisions of the CFI (Specialised IP Court of Ankara) and the 11th Chamber of the SCA. The Board found that the word “*papatya*”, the only and the dominating element of the earlier trademarks “Papatya” and “Eti Papatya”, was used in the later trademark “Giz Papatya”. In spite of the fact that the word “papatya” was not dominating within the later trademark due to its smaller depiction, the Enlarged Board of Appeals confirmed the likelihood of confusion between the trademarks. This decision was based on the fact that the disputed component of the trademarks, namely the word “*papatya*”, was used as a *substantial* element of the later trademark “Giz Papatya”. In so holding, the SCA explicitly differentiated between *dominating* and *substantial* elements of a trademark. The court held that the use of a substantial component of an earlier trademark within a later trademark as a substantial component may cause a likelihood of confusion, even if it does not constitute the dominating element of the later trademark. This corresponds to the *Thomson Life*¹⁴⁸ decision of the ECJ. In this case, the ECJ examined the likelihood of confusion between the trademarks “Life” and “Thomson Life” and held that “there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein”. However, the SCA applies this rule not only in cases where the company name of the trademark owner is added in the later trademark,¹⁴⁹ but extends its application to all cases in which the essential component of the earlier trademark is reproduced within the later trademark, on the condition that it still maintains its role as a substantial element.

145 SCA, June 18, 2007, Case No. 2006/467, Decision No. 2007/7837 – *Browni*.

146 SCA, July 7, 2005, Case No. 2005/11887, Decision No. 2007/3301 – *İçim Quick/Pınar Quick*.

147 SCA, November 25, 2004, Case No.2005/2627, Decision No. 2006/2642 – *Nina Ricci/Marco Ricci*.

148 ECJ, October 6, 2005, Case C-120/04 – *Thomson Life*.

149 See for example SCA, March 19, 2002, Case No. 2001/19685, Decision No. 2002/2514 – *Ülker Çizi/Şimşek Chest*; SCA, October 21, 2005, Case No. 2004/11195, Decision No. 10016 – *Form/Uno Form*.

In conformity with the principle of the ECJ laid down in the *Puma/Sabèl*¹⁵⁰ decision and repeated in the subsequent cases *Canon*,¹⁵¹ *Lloyd*,¹⁵² *Marca/Adidas*¹⁵³ and in the cases *Shark/Hai*,¹⁵⁴ *Vitakraft/Vitacoat*¹⁵⁵ of the CFI of the European Communities, the SCA evaluated the cases involving a likelihood of confusion globally, by taking into account several factors relevant to the case. In this context, account is given particularly to the distinctive character and the recognition of the earlier trademark in the market as well as the degree of similarity between the trademarks and the goods or services. The distinctive character of the trademark is evaluated in the light of the descriptive elements of the trademark in most cases. Trademarks including descriptive elements are usually considered to be “weak” trademarks and this reduces the likelihood of confusion between them. For example, the SCA rejected the likelihood of confusion between the trademarks “Aqua” and “Selpak Aqua”.¹⁵⁶ Here, it based its decision *inter alia* on the anonymous and descriptive character of the word “aqua” and also emphasised that this word was not used as a substantial element of the later trademark “Selpak Aqua”. Similarly, the likelihood of confusion between the trademarks “Browni” and “Ülker Çikolatalı Browni Chocolate Cake” was confirmed, based on the fact that the common word “browni” constituted the substantial element of both trademarks. The descriptive character of the word “browni” was, however, not discussed.

A further factor which has been taken into consideration in the assessment of the likelihood of confusion is the recognition of the earlier trademark in the market, the existence of which is deemed to increase the likelihood of confusion. In several cases such as *Pinar/Pinar*, *Scotch/Scotchcare*, *Mavi Jeans/Mavi Show* and *Eti Form/Uno Form* the reputation of the earlier trademarks was considered an important factor in the assessment of likelihood of confusion. It was acknowledged as a factor raising the likelihood of confusion.

As clarified by the wording of Art. 8(1)(b) TDL, the likelihood of confusion includes the likelihood of association with the earlier mark. Based on this provision, there is a differentiation between likelihood of confusion in a strict and in a broader sense. In the strict sense, it means that the public might confuse the two signs because of their similarity. The concept of likelihood of association is usually considered as likelihood of confusion in the broader sense and is interpreted as the risk that the relevant public might believe that the relevant goods or services originate from the same undertaking or economically linked undertakings. Accordingly, the likelihood of

150 ECJ, November 11, 1997, Case C-251/95 – *Puma/Sabèl*; 29 IIC 54 (1998).

151 ECJ, September 29, 1998, Case C-39/97 – *Canon*; 30 IIC 72 (1999).

152 ECJ, June 22, 1999, Case C-342/97 – *Lloyd*; 31 IIC 420 (2000).

153 ECJ, June 22, 2000, Case C-425/98 – *Marca/Adidas*.

154 ECJ, March 9, 2005, Case T-33/03 – *Shark/Hai*; 37 IIC 223 (2006).

155 ECJ, July 12, 2006, Case T-277/04 – *Vitakraft*; 38 IIC 234 (2007).

156 SCA, October 1, 2001, Case No. 2001/4487, Decision No. 2001/7272 – *Selpak Aqua*.

confusion in the broader sense relates to the cases in which the public does not confuse the signs but might make a connection between their proprietors.

Generally, the SCA interprets the likelihood of association in a broad sense. As a general practice, the SCA refers to the likelihood of association in almost all cases, however, without precisely defining this concept. In the *Tic Tac* case before SCA in 2003¹⁵⁷ a likelihood of association between two signs for any reason whatsoever was deemed to be sufficient to assume a likelihood of confusion, even if the signs were not similar in any sense. A recent decision of the SCA, *Lacoste/Crocodile*,¹⁵⁸ serves as a clear example of the approach of the SCA in evaluating the likelihood of association. In this case it was disputed that there was a likelihood of confusion between the composite trademark “Lacoste” with the pictorial element of a crocodile and the word mark “Crocodile”. The SCA evaluated the case globally, by taking into consideration the reputation of the earlier trademark “Lacoste”, the identity of the goods and the recognition of the English word “crocodile” throughout Turkey. All these elements were considered as factors increasing the likelihood of association between the trademarks. Thereby the SCA recognised the interdependence between different factors related to the case at hand. This corresponds to the case law of the ECJ. However, it is questionable whether the interpretation of the SCA as to the concept of likelihood of association corresponds to that of the ECJ. In the *Lacoste* case the SCA found that there was a likelihood of association between the two trademarks. Nevertheless, it did not discuss whether this might lead to a likelihood of confusion. As the ECJ stated in the *Puma/Sabel* and *Marca/Adidas* cases, the mere association which the public might have between two trademarks as a result of their analogous semantic content is not as such a sufficient ground for concluding that there is a likelihood of confusion. The SCA seems to evaluate the likelihood of association more broadly than the ECJ, since it considers the existence of a likelihood of association between the trademarks as being sufficient to constitute a likelihood of confusion. It fails to examine whether, due to the likelihood of association, the relevant public might be confused as to the origin of the related goods.

In all of the cases, major consideration in the determination of similarities, and thereby the likelihood of confusion, was given to the perception of the *average consumer* of the related goods or services. This general approach is consistent with the practice of the ECJ, which ruled in the *Lloyd* case that for the purposes of the global appreciation of the likelihood of confusion, the average consumer of the category of products concerned has to be taken into consideration. Unlike the ECJ, which stated in the said decision that the average consumer is deemed to be reasonably well-informed and reasonably

157 SCA, November 13, 2003, Case No. 2003/4003, Decision No. 2003/10839 – *Tic Tac/Zic Zac*.

158 SCA, March 20, 2007, Case No. 2006/1246, Decision No. 2007/4266 – *Lacoste*.

observant and circumspect, the SCA has not given any definition of the concept of the average consumer. However, it clarified¹⁵⁹ that the concept of the average consumer should not be understood as meaning expert of the related products. This shows that the SCA requires no special level of attention in order to assess the perception of the average consumer.

This approach has become clearer in the *Pool* case.¹⁶⁰ In this recent case, the SCA held that in the assessment of similarity between signs consisting of English words, the perception of the average consumers should be taken into consideration. Disregarding the view of the CFI,¹⁶¹ the SCA emphasised that it can not be expected from average consumers to have knowledge of English and to distinguish between the trademarks “Pool” and “Pol”.

A higher level of attention is expected in cases in which the relevant public consists of well-informed users of the concerned goods or services, such as with medicines or security transaction services.¹⁶² The SCA rejected any likelihood of confusion between the signs “Lipidil” and “Lipidol”¹⁶³ in respect of medicines on the ground that the well-informed consumers of the goods, namely doctors and pharmacists, should not confuse the two trademarks. This view was confirmed in subsequent cases.¹⁶⁴ In conformity with the practice of the ECJ,¹⁶⁵ the SCA ruled that the average consumer rarely has a chance to make a direct comparison between the different marks but has only an imperfect picture of them in his memory.¹⁶⁶

B. Earlier Trademarks with a High Reputation

Article 8(4) TDL lays down the general rule that a trademark which is identical with or similar to a registered trademark or a trademark with an earlier date of application may be used in respect of different goods or services. In line with Art. 5(2) of Directive 89/104/EEC, there is an exception to this rule, as extended protection is provided to trademarks with a reputation. According to this provision, upon opposition by the proprietor of an

159 SCA, November 13, 2003, Case No. 2003/4003, Decision No. 2003/10839 – *Tic Tac/Zic Zac*.

160 SCA, March 3, 2005, Case No. 2007/5057, Decision No. 2007/7634 – *Pool/Pol*.

161 The CFI, IP Court of Ankara, found the signs “pool” and “pol” confusingly similar within the meaning of Art. 7(1)(b) TDL. However, it assumed that the average consumer might distinguish the two marks due to their different pronunciation.

162 SCA, October 26, 2004, Case No. 2005/1039, Decision No. 2006/3310 – *Global Menkul Değerler*.

163 SCA, January 13, 2003, Case No. 2002/7864, Decision No. 2003/48 – *Lipidil/Lipidrol*.

164 See for example SCA, September 9, 2005, Case No. 2006/408, Decision No. 2007/3827 – *Lipidex/Lipitax*; SCA, May 27, 2005, Case No. 2006/471, Decision No. 3826 – *Dolgit/Dorlid*; SCA, March 8, 2005, Case No. 2005/9355, Decision No. 2006/9933 – *Actos/Atoks*.

165 See ECJ, June 22, 1999, Case C-342/97 – *Lloyd*; 31 IIC 420 (2000).

166 See for example SCA Enlarged Board of Appeals, June 7, 2006, Case No. 2006/11-338, Decision No. 2006/338 – *Papatya/Giz Papatya*.

earlier trademark with a reputation, the trademark applied for shall not be registered, even in respect of different goods or services, if the use without due cause of the trademark applied for would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trademark.

An evaluation of the cases regarding earlier trademarks with a reputation shows that the main problem faced is undoubtedly the determination of the reputation of the earlier trademark. The question whether an earlier trademark can be considered to have a reputation within the meaning of Art. 8(4) TDL should, according to the SCA,¹⁶⁷ be examined in the light of the WIPO Recommendations for the Protection of Well-Known Marks. The registrations of the trademark throughout the world, the market share of the trademark, advertising costs, the duration and geographical extent of the use of the trademark and the extent of channels of distribution of goods in respect of which the trademark is registered are some criteria taken into account in the evaluation of the reputation of the earlier trademark.¹⁶⁸ This approach corresponds to the ECJ principles concerning the assessment of reputation of a trademark laid down in the *Chevy*¹⁶⁹ case. In this decision, the ECJ held that in the assessment of the reputation of the earlier trademark “the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trademark, the intensity, geographical extent and duration of its use, and size of the investment made by the undertaking in promoting it”.

For the application of Art. 8(4) TDL the trademark which has been applied for must without due cause detrimentally affect the earlier trademark with a reputation. Regarding the evaluation of this condition, the SCA practice seems to be problematic. In almost all cases¹⁷⁰ in which the trademark applied for is identical or similar to the earlier trademark with a reputation, the SCA recognises the existence of such a detrimental effect without any need for further examination. The recognition of the reputation of the earlier trademark, therefore, usually leads to the conclusion that the use without due cause of a trademark applied for takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the earlier trademark. This view is based on the acknowledgement that by using the trademark with a reputation, the later trademark might achieve growth in sales.¹⁷¹ And this is considered as an unfair advantage within the meaning of

167 SCA, March 10, 2005, Case No. 2004/4268, Decision No. 2005/2362 – *Ülker/Ülkem*.

168 See SCA, January 12, 2004, Case No. 2003/5292, Decision No. 2004/26 – *Sun Tasarım*; NOYAN, *ibid.* 308.

169 ECJ, September 14, 1999, Case C-375/97 – *Chevy*.

170 For example SCA, July, 2000, Case No. 2000/5331, Decision No. 2000/6265 – *Glasurit/Glasserit*; YASAMAN, *supra* note 6, at 503; SCA, December 9, 2002, Case No. 2002/6723, Decision No. 2002/11376 – *Panda*; KARAN & KILIÇ, *supra* note 22, at 230; SCA, April 27, 2004, Case No. 2003/10588, Decision No. 2004/4556 – *Kinder/Kinder Koala*.

171 See SCA, July 3, 2000, Case No. 2000/5331, Decision No. 2000/6265 – *Glasurit/Glasserit*.

Art. 8(4) TDL. However, this practice of the Court tends to change. In the *Le Meridien* case¹⁷² of 2007, the SCA overruled the decision of the CFI, which failed to examine the condition of detrimental effect by the application of Art. 8(4) TDL.

In some cases,¹⁷³ the detrimental effect on the earlier trademark with a reputation is linked to the likelihood of confusion between the two trademarks, although the application of Art. 8(4) TDL does not depend on the existence of a likelihood of confusion. This matter was already clarified by the ECJ in its *Adidas/Fitnessworld* decision¹⁷⁴ with respect to the equivalent European regulation in Art. 5(2) of Directive 89/104/EEC. In this decision, the ECJ held that the protection conferred by Art. 5(2) of the Directive is not conditional on a finding of such a degree of similarity between the trademark with a reputation and the sign that there exists a likelihood of confusion between them. The ECJ considered it as satisfactory that there is such a degree of similarity between the trademark with a reputation and the sign that the relevant section of the public establishes a link between them.

The principle laid down by the ECJ in the *Davidoff* decision¹⁷⁵ that the specific protection for trademarks with a reputation may also be provided in cases in which a later mark or sign, which is identical with or similar to the registered trademark, is intended to be used for goods or services *identical* with or *similar* to those covered by the registered trademark, has also been recognised by the SCA. This issue was handled in the *Mavi Jeans* case¹⁷⁶ where the proprietor of the trademark with a reputation “Mavi Jeans” registered for clothing, brought a lawsuit for the invalidation of the trademark “Mavi Show”, which was registered for identical goods. In the decision, the SCA referred to Art. 8(4) TDL which provides extended protection for earlier trademarks with a reputation and acknowledged its application a fortiori in cases where the later trademark is registered or registration is sought in respect of identical goods or services.

Conclusion

In conclusion, this study has shown that Turkish case law on trademark disputes is basically consistent with the practice of the ECJ. But there are still some fields in which the Turkish courts take little account of the European

172 SCA, February 1, 2007, Case No. 2007/5927, Decision No. 2007/9302 – *Le Meridien*.

173 See SCA, May 7, ■■■■, Case No. 2002/1758, Decision No. 2002/4486 – *Alpella/Alpelsa*; KARAN & KILIÇ, *supra* note 22, at 220; SCA, April 19, 2004, Case No. 2003/10124, Decision No. 2004/4199 – *Ülker/Ülker Sucukları*; NOYAN, *supra* note 49, at 372; SCA, December 22, 2004, Case No. 2005/3310, Decision No. 2006/4537 – *Barbie/Barby*.

174 ECJ, October 23, 2003, Case C-408/01 – *Adidas/Fitnessworld*; 35 IIC 65 (2004).

175 ECJ, January 9, 2003, Case C-292/00 – *Davidoff*; 34 IIC 285 (2003).

176 SCA, March 19, 2002, Case No. 2001/10685, Decision No. 2002/2514 – *Mavi Jeans/Mavi Show*.

practices. The conservative approach towards abstract colour marks, the cumulative evaluation of abstract and concrete distinctiveness, and the broad interpretation of the likelihood of confusion are striking examples of the different approach shown by the Turkish courts. It is undoubtedly disappointing that Turkish case law is partially not consistent in itself. But it can not be ignored that the Turkish practice has reached a certain stage. This is reflected in the recent decisions of the courts in which uniform criteria have been applied that are consistent with the European principles laid down in the case law of the ECJ.

