REPUBLIC OF TURKEY
ANKARA UNIVERSITY
GRADUATE SCHOOL OF SOCIAL SCIENCES

INTELLECTUAL PROPERTY RIGHTS, TECHNOLOGY POLICIES AND INNOVATION MANAGEMENT DEPARTMENT

THE LIKELIHOOD OF CONFUSION ON TRADEMARK LAW IN THE LIGHT OF COURT DECISIONS

Master Thesis

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Ankara, 2019

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I hereby declare that all information in my master thesis named "The Likelihood of Confusion on Trademark Law in the Light of Court Decisions" which has been prepared by the supervision of Assistant Professor Selin ÖZDEN MERHACI has been gathered and submitted in compliance with academic rules and ethical conduct principles and all the data obtained from other sources has been indicated in the text and references precisely. I also declare that I have acted according to scientific research and ethical rules during the study process and if otherwise come forth, I will accept all legal consequences. (20./.12./.2019..)

Thesis prepared by
Serkan DALKIRAN

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LIST OF ABBREVIATIONS

CJEU **:** The Court of Justice of the European Union

EC **:** The European Community

EEC **:** The European Economic Community

EU **:** The European Union

IPC **:** The Turkish Intellectual Property Code Numbered 6769

LIAW **:** The Turkish Law on Intellectual and Artistic Works Numbered 5846

NO **:** Numbered

OHIM **:** The Office for Harmonization in the Internal Market

RIIPC **:** The Regulation on the Implementation of the Industrial Property Code

TCC **:** The Turkish Commercial Code Numbered 6102

TRIPS **:** The Agreement on Trade-Related Aspects of Intellectual Property Rights

UK **:** The United Kingdom

USA **:** The United States of America

WIPO **:** The World Intellectual Property Organisation

WTO **:** The World Trade Organisation

INTRODUCTION

Since the beginning of the 20th century, technological developments have brought along with economic developments and these developments in the world have also shown themselves in the field of law. Due to these developments, the branches of law such as intellectual property law, information law, space and aviation law have started to take place alongside the branches of classical law. As in the world, one of the most important areas of intellectual property law in our country is the trademark rights.

The trademark is of great importance for manufacturers as it is a means of distinguishing the goods and services of a business from the goods and services of other businesses. Due to the growing economic market, the trademark has become the main factor affecting the reputation of the businesses, the consumer environment it reaches, and hence the sales. This is because when consumers purchase a good or service, they tend to move towards trademarks that are highly known in the market, often used and trusted by them. Therefore, there is a serious competitive environment among the businesses.

In this serious competition between businesses, some businesses infringe on the trademark rights of other businesses in order to gain unfair benefit. The infringement of the trademark right may take many different forms. Because, the most common form of infringement of the trademark right is the likelihood of confusion, it is frequently encountered in practice due to reasons such as difficulty in detect and also it is easy to application. Therefore; it is necessary to examine the concept of likelihood of confusion in trademark law and to determine how the infringement of the trademark right occurs by means of confusion and which issues should be taken into consideration in determining the existence of confusion.

In this study, we tried to address what is the likelihood of confusion, how the confusion occurs, and how to proceed with the determination of confusion. By clarifying

the concept of likelihood of confusion, it is tried to explain how this concept takes place in different legal regulations. Throughout the study, a good number of high judicial decisions are also referred to, and the final section includes assessments on the issue in the light of various CJEU decisions. Within this framework, my work consists of three main chapters.

In the first chapter, the concept, types and functions of trademark, the legal nature of the trademark right, acquisition, protection and termination of the right are mentioned in both EU law and Turkish law by mentioning international law instruments also. In the second part, the concept of likelihood of confusion is discussed, the elements of likelihood of confusion, the evaluation of the confusion and the procedure in determination of the confusion are mentioned in the light of Turkish law with many decisions of the Court of Cassation. Finally, in the third part, a substantial part of the CJEU decision are served for readers to understand position of EU law. It should be noted that those decisions are not arbitrarily chosen, but are frequently referred to in domestic and foreign literature and adopted by the ECJ as the primary decisions. Thus, the approach of the practitioner to the subject was tried to be clarified.

CHAPTER ONE

CONCEPT OF TRADEMARK IN TURKISH, EUROPEAN AND INTERNATIONAL LAW

1. TRADEMARKS IN GENERAL

In commercial life, various indicators are used in order to distinguish the goods and services. Business names, trade names, protected geographical indications, sources of origin, trademarks and domain names are examples of these.[1]

According to Article 39 of *the New Turkish Commercial Code*[2] (TCC), *"the trade name is the name that each merchant has to indicate while performing transactions related to its business and while affixing her/his signature under deeds and other documents related to her/his business by registering and announcing the same.*" Thus, the trade name serves to distinguish businesses from each other. As it is understood from the provisions of Article 53 of the TCC, the business name is the name used to identify the business directly without being related to the business owner and used to identify and distinguish the business from similar businesses, and they must be registered as trade names. On the other hand, a trademark serves to distinguish the goods and services of one business from others and it is not mandatory to be registered.[3]

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[1] Yasaman, H. (2004). Marka hukuku. (Trademark Law) Istanbul: Vedat Kitapçılık. p.16; Çolak, U. (2014). Türk Marka Hukuku. (Turkish trademark law.) Istanbul: 12 Levha Yayıncılık, p.7.

[2] Turkish Commercial Code, (2011, 14 February). Official Bullettin (No: 27846). *available at:*http: //www.resmigazete.gov.tr/eskiler/2011/02/20110214-1-1.htm (visited at: 06.04.2019).

[3] Arkan, S. (1997). Marka Hukuku. (Trademark Law) Ankara: Ankara Üniversitesi Hukuk Fakültesi Yayınları, Cilt:1, p.1. (hereinafter: Arkan, 1997)

The origins of the trademark go long way to ancient times, when artists started to affix their signatures or various signs on artworks or craftworks that they produced.[4] Archeological finds that Greek vases with potter's signs from 6th and 5th centuries B.C. and signs that in case of a pirate attack or shipwreck occasion, serve to identify goods of merchants from middle-ages, also indicate their history dates back much earlier than patents and copyright.[5] Since the early ages, the trademark has already existed, when the function of distinguishing signs to identify businesses was limited, with the industrial revolution and the sale of goods to more distant places, the trademark started to come to the forefront as a sign for distinguishing goods independently from the business and the merchant.[6] The trademark protection in modern meaning started to evolve at very late of 18th century as *passing off* notion in common law countries. Passing off notion covers demanding by claimant to prevent use of defendant's trademark, due to defandant's trademark deceive consumers about origin of goods. Over the time, terms such as infringement, distinctive, nondinstictive or in other saying descriptive, started to mention in passing off cases and took part in legal literature. Legislative efforts are proceeded by the United States of America (USA) in 1879 and the United Kingdom (UK) in 1862 to provide registry system and extended protection for trademarks. However, in civil law countries like France or Germany where adjudication is depending on Codes, the process was slower, mostly trademarks were protected within frame of unfair competition provisions.[7] In 1883, with *Paris Convention for the Protection of Industrial Property*[8]

[4] Foster, F., & Shook, R. (1989). Patents, copyrights & trademarks. New York, Chichester: Wiley publication, p.18.

[5] Goldstein, P. (2008). International Intellectual Property Law, Cases and Materials. Minesota: Foundation Press, p.420.

[6] Kaya, A. (2006). Marka Hukuku. (Trademark Law) İstanbul: Arıkan Basım, p.1.

[7] Goldstein, p.420.

[8] Paris Convention for the Protection of Industrial Property, as last revised at the Stockholm Revision Conference, March 20, 1883, 21 U.S.T. 1583; 828 U.N.T.S. 305, *available at:* www.wipo.int (visited at: 09.04.2019).

reduced disharmony in trademarks among countries by setteling priorities, criterias and protection for well-known trademarks. Then, in 1891 *Madrid Agreement (Protocol) Concerning the International Registration of Marks*[9] is signed which aims for harmonizing registration in international level. It is followed by European Community Trademark system which aims for protecting trademark in all European Union member countries with single application and *Agreement on Trade Related Aspects of Intellectual Property Rights*[10] (TRIPS) which impose Paris Convention provisions to parties and added some more provisions concerning rights and trademark protection.[11] Nowadays, the importance of the trademark has increased much more with the fact that a significant part of the trade has become feasible outside the country of origin and through the internet, and for some businesses, the trademark has increased to a much more valuable position than that of the material values of the business.[12]

The trademark, in the most general definition, is a sign that serves to distinguish goods and services produced or traded by a business from produced or traded ones by others.[13] In this context, these are the identification and distinguishing signs that remark those products, on which these are labelled, belong to a particular business and serve to promote and distinguish them from the similars. The trademark may be the same with a

[9] The Madrid Agreement Concerning the International Registration of Marks, April 14, 1891, WIPO Document WOO I5EN, *available at:* www.wipo.int (visited at: 09.04.2019).

[10] Agreement on Trade-Related Aspects of Intellectual Property Rights, April 15, 1994 Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 3; 33 I.L.M. 1197, *available at:* www.wto.org (visited at: 10.04.2019).

[11] Goldstein, p.421.

[12] Çolak, p.8; Tekinalp, Ü. (2012). Fikri Mülkiyet Hukuku. (Intellectual Property Law) İstanbul: Vedat Kitapçılık, p.360

[13] Uzunallı, S. (2012). Markanın Korunmasının Kapsamı ve Tazminat Talebi. (Scope of Trademark Protection and Claim for Compensation) İstanbul: Adalet Yayınevi, p.6; Çağlar, H. (2013). Marka Hukuku Temel Esasları. (Main Principles of Trademark Law) Ankara: Adalet yayınevi, p.31; Çolak U. p.8.

trade name or business name. The function of trade name is to identify the business, while trademark's is to identify products.[14]

A more comprehensive definition of this notion is made under Article 4 of the Industrial Property Code numbered 6769[15] (IPC). According to this; "*trademarks may consist of any signs like words, including personal names, figures, colors, letters, numbers, sounds and the shape of goods or their packaging, provided that such signs are capable of distinguishing the goods or services of one business from those of other businesss and being represented on the register in a manner to determine the clear and precise subject matter of the protection afforded to the owner of the trademark*". In Turkish trademark law, signs that may be a trademark are specified in the Industrial Property Code numbered 6769, while in European Union Law Article 4 of the Council Regulation numbered 2017/1001 and it is partly determined by the Article 3 of the Trademark Directive numbered 2015/2436 on the Harmonisation of Trademark Laws of the Member States of the European Union. All three embodiments are very similar and contain the same elements. According to Article 4 of Regulation numbered 2007/1001; *"A trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings; and being represented on the Register, in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor."*. According to article 15/1 of TRIPS Agreement, a trademark is; *"Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a*

[14] Noyan, E. (2009). Marka Hukuku. (Trademark Law) İstanbul: Adalet Yayınevi, p.45

[15] Industrial Property Code, (2017, 10 January). Official Bullettin (No: 29944). *available at:* https://www.resmigazete.gov.tr/eskiler/2017/01/20170110-9.htm (visited at: 11.05.2019).

trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible." According to the TRIPS Agreement, all kinds of signs that are suitable to distinguish the goods and services of the businesses from those of others may be selected and registered as trademarks.[16] However, unlike others, it gave the parties freedom to decide whether to seek the criteria of to be expressed in a drawing or similar manner with the chosen sign.

The registration of a sign as a trademark in abolished Decree-Law numbered 556[17] depended on whether it could be expressed by drawing or similar. It is possible that words, letters, or numbers can be displayed by drawing, but it is unlikely that non-traditional trademark types such as color, sound, smell will meet this requirement. Although in Article 2 of the Council Directive 89/104 on the Harmonisation of Trademark Laws of the Member States of the European Union and Article 4 of the Council Regulation 40/94 on the Community Trademark, which are no longer in force, there was a requirement to "be displayed with a drawing", there were no statements as to could "be published and reproduced through print" in articles. Apart from that, the definitions coincided with Article 5 of the abolished Decree Law numbered 556. While the conditions such as being able to be viewed by drawing and being published by printing did not create problems in the trademark types that we are used to see such as words and figures, they could create question marks in terms of whether new signs such as sound,

[16] Kur, A. (2013). European Intellectual Property Law: Text, Cases and Materials. Edward Elgar, p.27.

[17] The Decree Law no. 556 Pertaining to Protection of Trademark, (1995, 27 June). Official Bullettin (No: 22326). *available at:*http: // https://www.resmigazete.gov.tr/arsiv/22326.pdf (visited at: 11.05.2019).

smell or three-dimensional shapes could be trademarks. For this reason, both the EU Directive numbered 2015/2436 and the EU Trademark Regulation numbered 2017/1001, the requirement to be displayed with the drawing limiting the marks that may be a trademark, has been removed and replaced with the condition to be displayed in the registry, as in the Industrial Property Law. As understood from the said provision of IPC, the scope of the trademark is kept wider in the IPC compared to the Decree Law, and non-traditional trademark types such as the color and sound are added to the signs that can be trademarks.[18] Therefore, in case of application for registry of a color or sound, if that color or sound meet ordinary criterias to be registered, there is no legal provision prevent a solely color from adopting as a trademark. Famous Metro-Goldwyn-Mayer's roaring lion sound which generally are heard at the beginning of movies of MGM, is a clear example to registered sound trademark.[19] In Article 6 of the Paris Convention, to which Turkey is a party, there is no restriction on the registration of sounds, smells and colours as trademarks. On the contrary, the convention leaves this preference to the signatory countries in accordance with the provisions of Article 6. In accordance with this regulation, the terms of application and registration of trademarks shall be determined by the national laws and regulations of each signatory country.[20]

According to Article 4 of Industrial Property Code, Article 3 of Directive numbered 2015/2436 and Article 4 of Regulation numbered 2017/1001, sounds are counted among the signs that may be trademarked. Sound trademarks consist of signs that can be heard audibly without speech language. These signals consist of sound waves that target the human hearing organ. In this way, sound trademarks can consist of notes, note

[18] Güneş, İ. (2018). Fikri ve Sınai Mülkiyet Hakları Haksız Rekabet Davaları. (Intellectual and Industrial Property Rights Unfair Competition Lawsuits) Seçkin Yayıncılık, p. 134.

[19] Merges, R. Menel, P. & Lamley, M. (2018). Intellectual Property in the New Technological Age. New York: Aspen Publishers, p.538.

[20] Gervais, D. (2015). International Intellectual Property Law: A Handbook of Contemporary Research. Massachusetts: Edward Elgar, p.346.

rankings, melodies, timbre and noise lying at high tones and frequencies with high specificity as a trademark, and animal sounds and human voices.[21]

According to Article 4 of Industrial Property Code, Article 3 of Directive numbered 2015/2436 and Article 4 of Regulation numbered 2017/1001, colours are counted among the signs that may be trademarked. TRIPS has added color combinations to the signs that may be trademarks in Article 15. Moreover, the issue has been addressed in different ways in national regulations. For example, in Article 3 of the German Trademark Law, it is stipulated that the colors may be registered as a trademark, but according to the Swiss law, the basic colors are freely available to the public due to their low number but the use of color combinations as trademarks is permitted. It is very important that the colors ensure the independence of the sign, in particular from the good. Due to the nature of the goods, it will not be possible to register the colors it possesses as trademarks. Otherwise, the condition of distinctiveness shall not be met.[22] Smell trademarks are one of the most controversial issues in trademark law. Doctrine advocates both that smells can be registered[23] and also they cannot[24]. The subject of smell trademarks are the odours that are considered to be sensory signs. The conditions for a sign to become a trademark are clear. First of all, a sign is required which is "suitable to distinguish the goods or services of a business from the goods and / or services of another business". It is possible to say that the smells are capable of distinctiveness. In addition, the sign must be integrity and independent of the goods or services, and these conditions

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[21] Er, T. (2011). Markanın Doğuşu, Kurumsallaşması ve Yeni Marka Formları (Emergence of Trademark, Its Institutionalization and New Trademark Forms), Fikri Mülkiyet Hukuku Yıllığı, Istanbul: 12 Levha Yayıncılık, p.272.

[22] Doğan, B. (2005). Soyut Renklerin Marka Olarak Tescil Edilebilirliği, Ankara: FMR, Vol: 5, Issue:4, p.39

[23] Öztürk, Ö. (2007). Koku Markası, Ankara: FMR, Vol: 2, Issue:3, p.61; Tekinalp, p.361.

[24] Er, p.276.

are also provided for in terms of smells. The point of discussion is the demonstrability in the registry. According to Article 4 of Industrial Property Code, Article 3 of Directive numbered 2015/2436 and Article 4 of Regulation numbered 2017/1001, trademarks consist of signs that are demonstrable in the registry. The registration of smells has been tried in a variety of ways, but there is no successful example.[25]

No restriction in terms of signs that may be selected as trademarks is stipulated under the IPC or, Article 4 of Regulation numbered 2017/1001, and partly Article 3 of Directive numbered 2015/2436 all signs be selected as trademark, provided that these are eligible to distinguish the goods and services of businesses. The ones listed in Article 4 of the IPC numbered 6769 are exemplary. Therefore, all kinds of signs, such as words, three-dimensional and two-dimensional figures, letters, numbers, colors, sound, melody, smell can form the trademark, provided that those identify products of the business. Thus, unlimited possibilities are provided for all formats of conceivable trademarks.[26]

The significant point in this context is that the sign used as a trademark shall be appropriate to distinguish the goods or services of the business. Herein, notion of business shall be broadly interpreted as to refer to any economic activity. Activities such as attorneyship and financial consultancy are also included in this notion. The business is not required to register the trademark, but it is required to refer the function of the trademark in terms of its distinctiveness, origin and ownership.[27]

[25] Tekinalp, p.361; Karahan, p.162.

[26] Uzunallı, p.4; Çağlar, p.20; Tekinalp, p.13.

[27] Kaya, A, p.16; Uzunallı, p.4; Karan H. & Kılıç, M. (2004). Markaların Korunması 556 Sayılı KHK Şerhi ve İlgili Mevzuat. (Protection of Trademark Commentary of Decree Law No.556 and Related Legislation) Ankara: Turhan Kitabevi, p.33.

2. ELEMENTS OF A TRADEMARK

As it is mentioned before, in the early times, trademarks were consist of basicly names and identifier simple signs, however, with developing economic life, even symbols and names remain as main elemtss of trademarks, they have been enriched with join of other elements.[28] In order to talk about a trademark, once the definition of the notion of trademark stated under the IPC no 6769 is examined, it has been understood that the existence of an eligible sign, being able to show the sign in the registry, and most importantly, having a distinctive nature are required as the elements of the trademark.

2.1. Sign

The TRIPS Agreement and Paris Convention imposes what qualifies can ben registered as trademarks. The Article 6(1) of Paris Convention states that *"The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation".* Article 6quinquies requires the parties to accept for protect any trademark registered in country of origin. Besides, Article 6quinquies(B) let parties to deny registration of the signs that non-distinctive, designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production and generic words.[29] Also, we can see TRIPS follow the same path with Paris Conveniton, as it is stated in Article 15/1;

> *" Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal*

[28] Merges, and others, p.536.

[29] Gervais, p.358.

names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible."

It can be seen that TRIPS gives parties a flexibility to register and protect the signs which acquired distinctiveness latter by use as descriptive words rather than inherent distinctiveness. Moreover, it lets parties to register signs that are not visual such as scents and sounds, but it does not impose states to register and protect such kind of signs also.

Prefering the sign to use as a trademark, needs to suit on goods and services and fulfill requirements under economic and legal examination.[30] Although it has been stated in Article 4 of IPC that trademarks may be composed of any kind of signs, it has been mentioned as to what the signs are.[31] Even in both European Union Law and Turkish Law, the relevant provisions regulating the signs that may be a trademark, although a count is made about which signs may be used as a trademark, the lists given under relevant articles are not restrictive, therefore all kinds of signs can be selected and used as a trademark, as long as it provides a distinctiveness.[32] The dictionary meaning of sign is defined as "*the thing to which a meaning is imposed, meaningful mark, symbol, indication, shape, mark*".[33]

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[30] Michaels, A. (2002). A Practical Guide to Trademark Law. London: Sweet & Maxwell, p.9.

[31] Çağlar, p.12.

[32] Jehoram Tobias Cohen/ van Nispen, Constant/ Huydecoper, Tony: European Trademark Law, Wolters Kluwer, 2010, s. 76.

[33] (online), www.tdk.gov.tr, (visited at: 13.05.2019).

It is a significant point that the trademark should be easily recognisable to consumers resulting from advertisement, recommendation, therefore it should have a distinctiveness regarding signs being used on competing products, in many ways.[34] More specifically; it is a symbol that reflects a good or service, which is used to identify it, to distinguish it from others.[35] The sign is not necessarily required to be tangible or visible. It is sufficient to be perceived by one of the five sense organs. A sign, which is the first element of the trademark, in addition to reflecting a symbol, expresses all kinds of indications in the nature of a text, shape, number, sound, smell, etc.[36]

The important issue is that the words "*trademark*" and "*sign*" stated under the text of the law are not words that have the same meaning and can be used interchangeably, and that these are different notions.[37] The word "*sign*" has a wider meaning, including trademark. Every trademark is also a sign, but not every sign is a trademark.[38] In that case, British Law sets difference very clearly by defining these two notions. British Act of 1938[39] defines sign as; "*A sign includes a device, brand, heading label, ticket, name, signature, word, letter, numeral or any combination thereof.*", while define trademark as "*a sign used or propsed to be used in relation o goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between goods and some person having the righto use the sign, whether with or without any indication of the identity of*

[34] Michaels, p.9.

[35] Tekinalp, p.367.

[36] Karahan, S. Suluk, C. Saraç, T. & Nal, T. (2015). Fikri Mülkiyet Hukukunun Esasları (Principles of Intellectual Property Law), Ankara: Seçkin Yayıncılık, p.158; Tekinalp, p.360.

[37] Maniatis, S. (2006). Trademark in Europe: A Practical Jurisprudence. London: Sweet & Maxwell, p.61; Bainbridge, D. (2010). Intellectual Property. London: Longman, p.597; Bently, L. & Sherman, B. (2008). Intellectual property law. Oxford: Oxford University Press, p.761; Tekinalp, p.361.

[38] Bainbridge, p.598.

[39] The Trade Mark Act of the United Kingdom of 1938. *available:* http://www.legislation.gov.uk/ukpga/1938/22/pdfs/ukpga_19380022_en.pdf (visited at: 22.05.2019).

that person".[40] DYSON decision of "*the Court of Justice of the European Union*" (CJEU) examines the issue, with regard to the trademark application consisting of a description of the appearance of the electric vacuum cleaner with a transparent box produced by the company and two representative pictures; it has been concluded that the bagless and transparent dust collecting box is a "*concept*", does not appeal to all five senses, cannot be perceived visually, and that since if applicant is granted with a trademark in form of a transparent box, this company may prevent competing companies from selling vacuum cleaners and can obtain an unfair advantage, thus, due to not fulfilling the conditions of the "*sign*", it could not obtain the trademark registration.[41]

2.2. Ability to Be Shown in the Registry

Under Article 4 of the IPC, it has been stipulated that "*…signs are capable of being represented on the register*", can be registered as a trademark. It is possible to state that, through mention of "*provided that such signs are capable of being represented on the registry*" by the legislator, the scope of the sign has been expanded.[42]

At this point, it has been reviewed that, with the entry into force of the IPC no 6769, there has been a major change in Article 5 of the abolished *Decree Law numbered 556, on Protection of Trademarks* (Decree Law). In text of the Decree Law, a certain obligation was sought by mentioning "*any kind of sign that can be displayed by drawing*

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[40] Ladas, S. (1975). Patents, Trademarks, and Related Rights. Vol:2. Massachusetts: Harvard University Press, p.978.

[41] Çolak, p.22.; *see:* CJEU, Judgment of the Court (Third Chamber) of 25 January 2007, *Dyson*, C-321/03, ECLI:EU:C:2007:51.

[42] Özmen, Ö. (2018). İktibas veya İltibas Suretiyle Marka Hakkının İhlalinden Doğan Cezai Sorumluluk. (Criminal Liability Arising from the Infringement of the Trademark Right by Means of Quotation or Confusion.) Istanbul: İstanbul Üniversitesi Sosyal Bilimler Enstitüsü Kamu Hukuku Ana Bilim Dalı Yüksek Lisans Tezi, (Master's Thesis) p.7.

or expressed in a similar way, published and reproduced by printing". The facts that the sign to be displayed by drawing and reproduced by printing arise from the condition of capacity of being represented graphically. The basis of this is that the European Union Trademark Directive numbered 89/104 EEC mentions that any sign shall can be capable of being represented "*graphically*".[43] Article 2 of Directive numbered 89/104 and Article 4 of Regulation Numbered 40/94, which are no longer in force, did not include the wording "which can be published and reproduced by printing", although there was a requirement for "display by drawing". Apart from this, the definitions were in line with Article 5 of Decree Law numbered 556. While the conditions such as being able to be display by drawing and being published and printing did not create problems in the trademark types that we are used to see such as word trademarks and shape trademarks, they could create question marks in terms of whether new signs such as sound, smell or three-dimensional shapes could be trademarks. This condition and the discussions on this issue were concluded once the IPC no 6769 entered into force. [44] The legislator no longer seeks the obligation of representing the trademarks graphically by removing the expression of "which can be published through printing". In both Directive no 2015/2436 and regulation no 2017/1001, the requirement to be displayed by drawing, which limits the signs that may be a trademark has been abolished and replaced by the condition to be displayed in the register, [45] as in the Industrial Property Code.

[43] European Court Reports 2003 I-14313, *available:* www.eur-lex.europa.eu, (visited at: 22.05.2019); Kaya, p.14; Çolak, p.57.

[44] Paslı, A. (2018). Marka Hukukunda Ürün Benzerliği. (Product Similarity in Trademark Law.) Istanbul: Vedat bookstore, p.15.

[45] EUIPO, Elimination of Graphical Representation Requirement, *available:* https://euipo.europa.eu/ohim portal /de/elimination-of-graphical-representation-requirement.

This is a convenient criteria that serves to provide transparency in register.[46] Herein, the purpose of stating "being represented on the registry" is to have the sign appear in the trademark registry in a manner that will allow the review of the registered trademark by the persons who will view the trademark registry. Thus, legal certainty and accuracy shall also be ensured.[47]

Signs such as a figure, word, letter, or a group of numbers have this attribute by nature. However, it should be discussed whether a smell, colour or sound trademark have these natures, due to it is not always possible for a smell, colour or a sound to be published, reproduced through printing, and graphically represented.[48] For instance, sound and musics notations can be represented successfully by notation or that can be described as a clear writing.[49] However, when the question is sounds that cannot be shown in the registery in that way, those sounds can be registered as audio files, without no longer being arranged in a graphical form, in accordance with the provisions of the IPC no 6769.[50] Another trademark may consist of solely a colour or combination of different colours, in that case with a sample of that colour or describing that with a standart colour code would be sufficient to meet the criteria. When the issue is a smell trademark, it becomes more complex. Even there are some registered smell trademarks examples like describing smell verbally or identifying it with electronic sensory analyses, mostly it is

[46] Michaels, p.12.

[47] Bainbridge, p.599; Bentley & Sherman, p.769.

[48] Nillson Okutan, G. (2003). *Sesler, Renkler ve Kokular Marka Olarak Tescil Edilebilir Mi?*. (Can sounds, colors and smells be registered as trademarks?) Milletlerarası Hukuk ve Milletlerarası Özel Hukuk Bülteni. Year: 23, Number: 1-2, p.594.

[49] Michaels, p.14.

[50] Özmen, p.8.

an unanswered question. However, there are several smell trademark examples in OHIM Register[51] based on verbal decription of the smell.[52]

2.3. Distinctive Element

The main requirement for a sign to be registered as a trademark is that sign should have distinctive element. It is not possible to register signs that are not convenient to distinguish product or service from others as trademarks.[53] In other words, signs, which may be registered as trademarks, must have the distinctive element. Everyone agrees on that the trademark must be distinctive, however, in case of appliying that principle, there is variety which sign is distinctive.[54] A restrictive listing has not been made under the IPC numbered 6769 in terms of the sign element, however, the condition of having the distinctive element for the sign to be selected as trademark has been sought necessarily. Similarly, in Article 4 of Directive 2015/2436 and in Article 7 of regulation 2017/1001, it is arranged that "signs with no distinctive charachter" shall not be registered as trademarks in general.[55] The distinctive nature is to submit the difference between goods and services of a business from those belongs to other business.[56]

The element of distinctiveness as a registration obstacle is a matter of debate in the doctrine. As generally accepted, according to *Uzunallı*, on behalf of a sign, which is

[51] OHIM Trademark Apllication, Registration No. UK00002000234, Dated: 1996-05-03; OHIM Trademark Apllication, Registration No. UK00002001416, Dated: 1996-04-09; *see:* https://www.tmdn.org/tmview/welcome (visited at: 07.06.2019).

[52] Michales, p.15.

[53] Kaya, p.14; Uzanallı, p.5; Çolak, p.22, Çağlar, p12.

[54] Ladas, p.974.

[55] Bently, L. (2008). The Making of Modern Trademark Law: the Construction of the Legal Concept of Trademark, TradeMarks and Brands, Cambridge Intellectual Property and Information Law, p.15.

[56] Arkan, 1997, p.36; Kaya, p.80; Tekinalp, p.365.

selected as a trademark and which is eligible to distinguish the goods or services of the businesses, to be registered, it must have also the distinctive element for concrete products subject to the registration. Therefore, the fact that the sign, selected as a trademark, not having the distinctive element for the concrete goods or services subject to registration, is a registration obstacle.[57] According to *Noyan*, as a contrary approach; the sign to be used as a trademark may also gain the distinctive element upon registration. Therefore, as to whether it has a distinctive element before the registration is not a condition for registration.[58] In other words, the integration of the goods or services or the connotation with the goods or services in which the sign is used as trademark at time of the registration shall not be sought, it may have the distinctiveness once it is introduced. Furthermore, by the use of the trademark, the distinctive character and introductory nature of trademark is increased, and it turns into apparent.[59]

Although there was no special provision in the abolished Decree Law no 556, with the entry into force of the IPC, there are no longer any question marks regarding the trademark availability of letters and numbers, it is clear from the relevant article texts that letters and numbers may be trademarks both in Europe and in Turkey. Under paragraph 1/b of Article 5 of the applicable IPC numbered 6769, "*signs which lack of any distinctive element*" is explicitly listed as an absolute ground for refusal. In the Directive numbered 2015/2436, the term "sign that cannot be a trademark" has been used in Article 4 (a) of the Directive as the absolute ground for refusal. In accordance with the IPC and foreign legislation, it has clearly stated that signs of no distinctive nature cannot be registered as trademarks. In addition, compliance with European Union Directive, to Article 5, in

[57] Uzunallı, p.5.

[58] Noyan, p.46.

[59] Yasaman, H. (2004). Marka Hukuku ile İlgili Makaleler Hukuki Mütalaalar Bilirkişi Raporları (mütalaalar) (Articles Related to Trademark Law Legal Opinions Expert Reports, Istanbul: E.2, p.33.

which absolute grounds for refusal are counted in IPC, clause (b) has been added. According to the regulation, "signs that do not have any distinctive qualities will not be registered as a trademark". The term of "trade marks which are devoid of any distinctive character" is used in Paragraph (b) of Article 4 in which the absolute grounds for refusal are considered in the Directive. In accordance with the New IPC and foreign legislation, it has clearly stated that signs which are not of distinctive character cannot be registered as a trademark. Accordingly, signs consisting of words to designate the kind, quantity, quality, origin, types are not distinctive.[60] However, if the sign, which does not have distinctiveness due to its characteristic, is made distinctive by additional side elements, then the sign may be registered as a trademark. For instance, while the letter "M" cannot be monopolized by anyone because it is a sign that can be used by everyone, as a result of its original given form and widespread use, it has become the reference of McDonalds hamburger company. The approach of the Court of Cassation in practice is also in this direction.[61] In trademarks that contain more than one element, even if each of these elements does not have distinctiveness individually, it can be accepted that the trademark also has a distinctive element if the trademark perception is formed due to the general impression of the trademark as a whole.[62] In the Decision[63] of 11th Civil Chamber of the Court of Cassation; "*If the trademark contains more than one element, the original element shall be reviewed in the impression of the trademark made as a whole, the appearance dominated to overall and the image emphasizing the distinctive nature*". Once the word "*Computer*", which designate the kind, has been removed from the

[60] Ozmen, p.18.

[61] The Verdict of the 11th C.C. of Court of Cassation dated 04.05.2006, case no. 2005/4782, decision no. 2006/5172, *available at:* www.kazancı.com (visited at: 17.06.2019).

[62] Çolak, p.24.

[63] The Verdict of the 11th C.C. of Court of Cassation dated 01.12.2000, case no. 2009/7590, decision no. 2010/5923, *available at:* www.kazancı.com (visited at: 17.06.2019).

original element and has appeared in the special and unique color and shape composition of the words, therefore it has become prominent and acquired the distinctive nature.[64]

When the trademark is considered as a shape, it consists of two elements. These are the main and auxiliary elements.[65] The main element absolutely provides the distinctive element of the trademark. In addition, the auxiliary element refers to the elements that are subject to the main element and that can be used by everyone since it is publicly available. The main and auxiliary elements do not need to have the distinctiveness separately. However, if there is a trademark consisting of one-word, the distinctiveness is only sought in the main element.[66] For instance, in the trademarks of Çağdaş Market, Sütaş Ayran and Starbucks Coffee, the distinctiveness is not sought in the auxiliary elements which are the second words. In fact, what is important here is the impression of the trademark made as a whole. A trademark, through its distinctive element, indicates to which business that the product or service belongs. The signs, which generate the trademark, create a difference through their symbolic features and enable the trademark to be distinguished from other signs.

It is also not possible to register solely the words such as *deluxe, extra, premium, original* which designate the characteristics, qualities and quantities of the goods.[67] These words may only be subject to registration with distinctive words or figures, and even if registered, these words are not taken cognizance of determination the scope of protection on trademark.[68]

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[64] Kaya, p.32.

[65] Karahan & others, p.141.

[66] Arıkan, Ö. (2016). Trade Mark Rights and Parallel Importation in the European Union. İstanbul: Oniki Levha Yayıncılık, p. 49.

[67] Ladas, p.982.

[68] The Verdict of the 11th C.C. of Court of Cassation dated 01.11.2010, case no. 2009/3978, decision no. 2010/11123, *available at:* www.kazancı.com (visited at: 20.06.2019).

Words that indicate geographical origin of a product are also not distinctive. Accordingly, the registrations of the words Gemlik or Ayvalık for olive oil commodities, Malatya for apricot commodities and Kars for kashar cheese commodities, solely and as the main element, are not possible.[69]

Furthermore, picture of real persons or their names, in another saying their personality or replicated names may do not have distinctiveness. For example, name of "AMY WINEHOUSE" which is the name of passed-away famous star cannot reference to solely a good or service. That means a name can give distinctiveness to a trademark, solely. On the other hand, name of a current personality, such as "TIGER WOODS" who is a famous golf player, may be registered as a trademark for sport equipments as well as there are many examples like that.[70] New regulations have been introduced in Article 14 of the European Union Trademark Regulation numbered 2017/1001 to ensure that the exclusive powers granted to the trademark holder do not prevent third parties from using certain signs in the field of trade. Accordingly, the use of the names of natural persons as trade names or if their business conflicts with a protected trademark right, the owner of the trademark will not be able to oppose the use of these names. since the protection will be provided, the element to be protected can only be the person name of the third party.[71]

As reviewed, the closer the meaning of a sign or the product group that it belongs to, the lower its distinctiveness. If a picture of a classic door lock is selected for the door lock commodity, such sign cannot be selected either as a trademark, or even if it is accepted as a sign due to the uniqueness of the picture, the picture of a lock may not be distinctive. A trademark becomes identifier as it gets close to the product or service on

[69] Çolak, p.29.

[70] Michaels, p.17.

[71] Dutfield, G./Suthersanen, U. (2015). Global Intellectual Property Law. London: Edwar Elgar Publishing, p.144.

which it will be used.[72] On the other hand, its distinctiveness will be strengthened to the extent that it gets distance from its characteristic features for products on which the trademark will be put. Such trademarks are trademarks with strong distinctive character.[73]

The words having the nature of distinctiveness such as "SONY" or "BEKO" are the most significant examples which do not have any meaning and are artificially invented. These words, which are created artificially, and which have no meaning on their own, draw great attention of the consumer and build the consumer perception.[74]

2.3.1. Signs Which Do Not Have Distinctiveness

2.3.1.1. Descriptive Signs

It is essential that a sign should suit to goods or services and reflect the product without being descriptive.[75] Due to language in Paris Convention Article 6(B)-2 and TRIPS Article 15/2, model trademarks law can give states to refuse register or protect trademark rights on signs that are lack of any distinctiveneness and in descriptive character.[76] The reason why the descriptive signs are inappropriate to be registered as trademark is that signs indicating the characteristics and main features of the goods or

[72] Küçükali, C. (2009). Marka Hukukunda Karıştırılma Tehlikesi. (Likelihood of Confusion inTrademark Law.) Ankara: Seçkin Yayıncılık, p.74; Tekinalp, p.366.

[73] Yasaman, p.18; Çolak, p.30.

[74] Güneş, p.162; Noyan, p.47; Bently/Sherman, p.780.

[75] Michaels, p.10.

[76] Gervais, p.361.

services, or geographical origins, that should be available to everyone in the relevant sector, are not given to the monopoly of individuals.[77]

Descriptive signs are the ones which directly describe the goods or service and/or clearly establish an association with class of goods or service, so the sign evolve to natural way of referring that goods or sercive for public in daily life.[78] In other saying, in order to mention that a trademark is not a descriptive, it should be possible for the relevant segment of the society to establish a sufficiently direct and special association between trademark and related goods or services without having to think much about it.[79] A sign having the distinctive nature shall be able to build a perception of the commercial origin of goods in the minds of the relevant segment of society. The British case of the *Perfection*[80] is a clear example for the issue. The case states that the word of "PERFECTION" is used to identify soap commodity among consumers comprehensively and for a long time. However, the House of Lords rules to refuse that word as a trademark since the word of "PERFECTION" refers to perfect with little grammatical difference, it is an unnecessary complimentary adjective. Therefore, the House of Lords indicated that giving a monopoy to a person on such a common adjective would not be fair.[81]

In addition, the fact that it does not directly indicate the qualities of the good or service does not solely mean that such sign is distinctive. The important thing is that the

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[77] Bentley & Sherman, p.791.

[78] Merges, and others, p.536.

[79] Tekinalp, p.365.

[80] Crosfield & Sons Ltd.'s Application, 26 R.P.C., 1909.

[81] Ladas, p.983.

sign which is choosen to be trademark shall indicate origin of product to average consumer in relevant segment of the society, and that it can be perceived as a trademark.[82]

2.3.1.2. Words with Multiple Meanings

In terms of words with more than one meaning, being a non-distinctive sign may be in question. For instance, the word "SWALLOW" means both to swallow as a verb and swallow as a bird. In the event that such trademark is made subject to the registration application for alcoholic beverages and if it is perceived in terms of swallowing as a verb, there may be a registration obstacle, and if it is considered in the meaning of a swallow as a bird, it may be registered.[83] As another example, the word "AYDIN" can be considered. The word Aydın in Turkish means both intellectual, cultural, contemporary and spacious, light and brightness. Aydın is also the name of a province in the Aegean region.[84] When this word is required to be registered as a fig commodity trademark, will it be evaluated as a province famous with fig or with its two other meanings? It is possible to give many examples such as these. Indeed, in case the word swallow mentioned in the first example is concluded to be perceived by the target group as a swallow in terms of bird, it will be accepted that the trademark has the distinctive nature, however, in case it is concluded that it will be perceived as to swallow as a verb, it will be accepted that the trademark descriptive. According to *Çolak*, such opinion is not very accurate. With the exception of slang words, one of the meanings of a multiple meaning word reflecting the name, quality and similar feature of product is sufficient to accept word as descriptive.[85]

[82] Çolak, p.24.

[83] Bentley & Sherman, p.793.

[84] Çolak, p.28.

[85] Çolak, p.28.

2.3.1.3. Grammatical Equivalences

There is a registration obstacle for the grammatical equivalences of the words. What is implied with the term of *grammatical equivalence*, is the words generated by repeating the descriptive word, exclamation point, question mark, or multiple sounds within the word, with the intention of entangling the consumer perception.[86] For instance, the word "KEBAP!" or "MEZZE" cannot be registered as a trademark. In other words, the word EUROLAMB will be considered as descriptive and will not be registered as it will be comprehended by average consumer as EUROPEAN LAMB.[87]

2.3.1.4. Phonetic Equivalences

Since consumers will perceive the signs both audibly and visually, the phonetic equivalences of words, which cannot be registered due to being the descriptive sign, cannot also be registered. For instance, the word "MECHANIX" will be perceived as the "MECHANICS" among consumers. Therefore, the registration of such word is not possible.[88]

2.3.2. Types of the Element of Distinctiveness

In the doctrine, the element of distinctiveness is subject to a dual distinction as the element of *intangible distinctiveness* and *tangible distinctiveness*.[89] Accordingly, the

[86] Çolak, p.31.

[87] Bently/Sherman, p.781.

[88] Bently/Sherman, p.781.

[89] Doğan, B. (2006). Türk, Alman ve Avrupa Birliği Hukukuna göre Marka Olamayacak İşaretlerin Kullanım Sonucu Ayırd Edicilik Kazanarak Tescil Edilebilirliği Sorunu. (Issues of Registerability of Signs, which cannot be a Trademark, by Acquiring the Dinstinctive Character upon Their Use According to

element of intangible distinctiveness is described as the capability of distinguishing goods or services of a business from ones of other business.[90] In other saying, it is necessary to determine as to whether a sign has the required element of distinctive in order to become a trademark without being relevant to any goods or sign.[91] For instance, since none of the words "trademark, perfect, ultra, super, extra" have the element of intangible distinctiveness, it is impossible to register these for any good or service.

The element of tangible distinctiveness is described as distinguishing of goods and services, which are under scope of the trademark requested to register, from those of other businesses.[92] In other words, the element of tangible distinctiveness means as to whether a sign is distinguishing in terms of a particular service or goods.[93] For instance, the apple sign has the nature of tangible distinctiveness for a technology company. However, when such sign is a matter of the registration for the apple commodity, the application for registration will be refused since it does not have the element of tangible disttictiveness. However, it should be noted that the concrete distinctive character can be acquired later. As per Article 5 paragraph 2 of the IPC, Article 7 paragraph 3 of Regulation numbered 2017/1001 and Article 4 paragraph 4 of Directive numbered 2015/2436, the registration of a trademark that has no tangible distinctiveness, which contains expressions that qualify goods and/or services, and which contain words that

Turkish, German and European Union Law.) Ankara: FMR, Vol: 6, Issue:3, p.19; Çolak, p.24; Çağlar, p.12; Noyan, p.47.

[90] Doğan, B. (2005). Soyut Renklerin Marka Olarak Tescil Edilebilirliği. (Registerability of Intangible Colors as a Trademark.) Ankara: FMR, Volume: 5, Issue: 4, p.41. (hereinafter: Doğan, 2005)

[91] Çağlar, p.12.

[92] Doğan, 2005, p.34.

[93] Çağlar, p.13.

should remain open to all shall not be rejected if they gain distinctiveness as a result of use.[94]

Finally, it shall be stated that, as frequently emphasized by the CJEU, the criteria to be applied for the evaluation of the element of distinctiveness are the same in all types of trademarks, however this issue shall be paid attention, since the perception of each trademark by the relevant segment of the society will not be the same.[95]

3. FUNCTIONS OF TRADEMARK

The intense competition in the market led to differences in the products offered to the market, diversification of the supply of goods and services and the development of new marketing strategies. One common point of these developments is the trademark as a means of reflecting the relevant features of the product. Therefore, protection of the trademark must be examined under commercial terms and the requirements of law. Those terms are highly depending on legal provisions of the country where it will be used and protected.[96] Economic terms on protection of trademark rely on the market size and competition. In a growth economy where mass production exist, products are competitive, and imitation is so common, enterprises have to advertise and protect their trademark. Due to same causes, consumers have to trust to trademarks, due to advertisements, recomandations and past experiences.[97] In that case, trademark has many functions for both the producer and the consumer, such as the quality assurance and

[94] Dutfield/Suthersanen, p.146.

[95] Arkan, p.77; Küçükali, p.42; Çolak, p.25.

[96] Michaels, p.1.

[97] Michaels, p.2.

advertisement, but particularly distinguishing and indicating the origin. These are referred as the functions of the trademark.[98]

3.1. Function of Indicating the Origin

One important function of the trademark is to indicate the origin of products to which they belong. Trademark's prominent function in the historical process has been the function of indicating the origin.[99] The trademark's function of indicating the origin specifies business by which product is produced and introduced to the market.[100] By this means, the persons purchasing the goods or using services can decide to which business/person that such goods or services belong. In fact, the function of indicating the origin is not just significant during the purchase of products, likewise during the production and advertising stages of the goods and services.[101]

Thus, before the Council Directive 89/104, which came into force on 21 December 1988, a trademark is regarded as an integral part of the business according to Article 1 and Article 8 of German Trademark Laws, and its transfer was only possible with the transfer of the business. Italy and the northern countries also adopted the understanding that the protection of trademark is only possible by providing the function of indicating the origin. Furthermore, in Switzerland and Austria, the function of indicating the origin was the only legally protected function of the trademark, as in Germany. In contrast, the Benelux States, Belgium, the Netherlands and Luxemburg,

[98] Çağlar, p. 12; Er, p.267; Tekinalp, p. 343.

[99] Arkan, p.38; Yasaman, p.18; Suluk, C. Karasu, R. Nal, T. (2017). Fikri Mülkiyet Hukuku. Ankara: Seçkin Yayıncılık, p.162.

[100] Güneş, İ. (2013). *Marka Tescilinde Kazanılmış Ayırt Edicilik Özelliğ*i (The Distinguishing Character Acquiring in the Trademark Registration), Adalet Akademisi Dergisi, Year: 4, Number: 15, p.329. (hereinafter: Güneş, 2013)

[101] Çağlar, p.33.

completely separated the trademark laws from the terms of the indicating of origin function and the likelihood of confusion with it.[102]

However, function of indicating the origin of is increasingly weakened due to the widespread use of systems, such as franchising, which cause changes in production relations.[103] Due to these changes, the trademark no longer reflects the origin of products, to put another way, location in where such goods and services are produced, but it reflects the person produces the goods and services.[104] As an illustration, the person, who wants to purchase a "VOLKSWAGEN" trademark car, is not interested in where such product is produced. Since these products are produced in various countries such as Germany, Mexico or Poland under license. However, by who the trademark is produced is important for the consumer, not where it is produced.

3.2. Function of Distinctiveness

Since the definition of the trademark includes *the condition of being capable of distinguishing the goods or services of one business from those of other business* [105], the distinctiveness function is the most essential function of the trademark. Therefore, nature of distinctiveness is both an essential element and a function for a trademark.[106]

[102] Kur, p.186.

[103] Ülgen, H. (2015). Ticari İşletme Hukuku (Law of Commercial Enterprise), Istanbul: On İki Levha Yayıncılık, p.456; Aydınalp, Y. (2018). Marka Hukukunda Tescil Engelleri (Registration Obstacles in Trademark Law), Samsun: 19 Mayıs Üniversitesi Sosyal Bilimler Enstitüsü, Yüksek Lisans Tezi (Master's Thesis), p.8.

[104] Suluk, and others. Fikri Mülkiyet Hukuku. (Intellectual Property Law) Ankara: Seçkin Yayıncılık, p.163.

[105] Yasaman, p.18; Suluk, and others, p.162.

[106] Tekinalp, 347.

The distinctive function of trademarks individualizes the goods and services that it covers and makes them identifiable on the market for the purchaser's environment. By this means, customers can distinguish the goods and services that they want to purchase from the goods and services of other businesses.[107] The distinctiveness of the trademark restricts the range of signs that the trademark owner can select. Because, trademark selected for a good or service, exclusionary grants rights for that good and service to trademark owner. Trademark selected for use on goods or services must be different from other trademarks selected for being used in that goods or services. Furthermore, it should also not specify features of the product on which selected sign will be used. There would be no distinctive element of trademarks which include product's itself in which the trademark will be used or the signs that state kind, qualification, quality, cost, geographical origin, explicit signs that are available to everyone in the field of trade.[108]

In the Court of Cassation decision, it is examined whether there was a likelihood of confusion between signs; it is evaluated as to whether there was a possibility of the consumer to engage in the idea that there was a connection between businesses, in other words, as to whether the distinctive function is impaired or not. In this decision, the Court of Cassation stated as follows;

> *" The likelihood of confusion relates to the origin of the trademark's goods and services, as well as the guarantee and advertising function. Therefore, the similarity between the signs may cause purchasers to buy other goods instead of the goods that they intend to buy, as well as the assumption to purchasers that, although they understand that they review two different trademarks or signs, these trademarks belong to the same person or may cause purchasers to engage in the idea that there is an administrative and economic affiliation between the businesses that produce these goods, therefore the similarity between the signs shall also be approached in means of likelihood of confusion. When examining whether there is a similarity between the signs, the goods/services list of which the trademark is requested to be registered or by which the*

[107] Suluk, and others, p.162.

[108] Yasaman, p.18.

registered figure covers is crucial. The risk of confusion between trademarks can appear in terms of pronunciation, form or meaning." [109]

In addition to this, the CJEU and WIPO which is the most prominent of the international organizations established in order to create and manage a balanced and accessible intellectual property system in the world, considers the distinctive function of the trademark as a fundamental function and accepts that other protected functions shall be built on the distinctiveness function.[110] In this context, for instance, the advertising function will not be damaged, in case the distinctive function of the trademark is not impaired upon the unauthorized use by third parties. Therefore, functions of trademark, such as guarantee and advertising, are therefore subject to the eligibility of the trademark to distinguish goods and services of a business.[111]

Since distinctive nature is both an element and a function for a trademark, the explanation with the heading distinctive element shall also be taken into consideration with regard to this issue.

3.3. Advertising Function

Increasing trademark recognition in the society and expanding the customer mass are desirable and aimed situations for the owner of the trademark and the business. Promotional activities or marketing strategies, which are required for a product or service to reach consumers, are carried out through the trademark. Therefore, the trademark has an advertising function.

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[109] The Verdict of the 11th C.C. of Court of Cassation dated 08.02.2003, case no. 2003/5034, decision no. 2004/127, *available at:* www.kazancı.com (visited at: 10.08.2019).

[110] Türk Patent ve Marka Kurumu. (Turkish Patent and Trademark Office.) (2015). Marka İnceleme Kılavuzu (Trademark Examination Guide), p.33; *see*: CJEU, Judgment of the Court of 29 September 1998, *Canon*, C-39/97, ECLI:EU:C:1998:442.

[111] Uzunallı, p.11.

For some trademarks, the advertising function includes the function of advertising those who purchase the goods or use the services.[112] For instance, it is obvious that a producer that advertises that the engine oil commodity that it produces is used in the automobile trademark, which has reached a certain level of recognition and is the symbol of quality, will gain an advantage among the producer who does not make such advertisement.

Original trademarks have higher advertising power and value. When selecting the sign to be a trademark, besides being original, it is also important for it to be easy to pronounce, understandable and memorable.[113] However, this function is not equally effective for all trademarks. In some goods and services, such as pharmaceutical trademarks, the advertising function is less by nature.[114]

In today's global market, where competition is increasing, consumer preferences are constantly changing, and in which even hidden advertisements are used, and where businesses appeal to the subconscious mind of the consumer through subliminal contents by social media to persuade the consumer, the importance of the advertising function of the trademark is ever increasing. When the consumer has many alternatives, s/he will be able to make choices by reviewing only the trademark and to the extent her/his previous knowledge and usage.[115]

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[112] Çağlar, p.34.

[113] İmirlioğlu, D. (2017). 6769 sayılı Sınai Mülkiyet Kanunu'na Göre Marka Hukukunda Ayırt Edicilik ve Markanın Ayırt Ediciliğinin Zedelenmesi. (Distinctive Nature and Impairing the Distinctive Nature of the Trademark in Trademark Law According to the Industrial Property Code Numbered 6769.) Ankara: Adalet Yayınevi, p.11.

[114] Öztek, S. (2005). İlaç Markaları ve OHIM Kararları Arasındaki İlişki (Relationship between Pharmaceutical Trademarks and the OHIM Decisions), Istanbul: Fikri ve Sınaî Mülkiyet Hakları ve Kültürü 1. Ulusal Sempozyumu, p.179.

[115] Mutluoğlu, T. (2010), Markanın Kullanım Sonucu Ayırt Edicilik Kazanması (Acquiring Distinguishing Character of a Trademark upon Its Use), Ankara: Ankara Üniversitesi Sosyal Bilimler Enstitüsü, Yüksek Lisans Tezi(Master'sThesis), p.9; Arkan, p.44.

3.4. Guarantee Function

Businesses, which offer its goods or services to sale under the same trademark all the time, constitute a feeling in consumers that they can rely on the quality of the product. Therefore, that trademark function is also called as trust function, since the purchaser is able to identify the business, which s/he relies on, in other words, s/he is confident of the quality of the products of such business, by the trademark.[116]

The general consumer expectation is that goods or services are of good quality and that s/he is provided with the expected benefit from such goods or services. In case a trademark has established the sufficient trust amongst consumers that its products are good quality, the consumer considers that other products of the same trademark are also good quality. Due to this function, the consumer is reluctant to purchase products with the same trademark again for a product or service with which s/he is satisfied with. However, this trust and guarantee established by the trademark among the consumer are completely economic and have no legal consequences.[117]

In fact, even though it is expressed that guarantee function ensures the quality of products, the trademark owner is not legally obligated to produce the products offered to the market under such trademark in a standard quality. Therefore, the trademark has no legally binding guarantee function regarding to nature and quality on goods.[118] However, the consumer's interest in a trademark arises from the fact that such trademark maintains its quality standard. The guarantee function is therefore of great economic importance.

[116] Tekinalp, p.356.

[117] Arkan, p.37; Tekinalp, p.378.

[118] Mutluoğlu, p.12; Yasaman, p.19.

4. TYPES OF TRADEMARKS

It is possible to classify trademarks in many ways. As generally accepted, trademarks are subject to differentiation according to the purpose of use, according to the right holder, whether these are registered or not and according to the environment in which they are recognized.

4.1. Trademarks According to the Purpose of Use

4.1.1. Trademarks of Goods

The trademark of goods, also called just the trademarks, was defined under Article 8 of *the Implementing Regulations under the Decree-law Numbered 556*[119] as a sign that serves the purpose of distinguishing the goods manufactured and/or traded by a business from the products of others. However, the definition of the trademark of goods is not stated under *the Regulation on the Implementation of the Industrial Property Code* (RIIPC)[120].

The basic rule contained in Article 15 of TRIPS Agreement is that any sign, or any combination of signs, capable of distinguishing the goods and services of one business from those of other businesses, must be eligible for registration as a trademark, provided that it is visually demonstrable.[121] A trademark of goods is a trademark that is associated with a product on which it is labelled or its packaging.[122] These trademarks are

[119] The Implementing Regulations under the Decree-law Numbered 556. (1995). T.C. Resmi Gazete, 22454, 05 November 1995.

[120] The Regulation on the Implementation of the Industrial Property Code. (2017). T.C. Resmi Gazete, 10705, 24 April 2017.

[121] Bainbridge, p.539.

[122] Tekinalp, p.341.

used to distinguish the goods produced and offered to the market by a business from those of other businesses.[123] In short, it can be called as signs which are used for the trading goods. The trademark protection was first provided to the trademarks of goods.[124] The subject matter of the that kind of trademark is mostly movable goods. However, money, negotiable instruments and ordinary notes are excluded from this scope.[125]

4.1.2. Service Marks

In the historical process, trademark of "goods" have emerged as the first in trademark law. The development of the service sector in the following periods and the intense competition experienced in this sector made it compulsory also for the businesses operating in the service sector to use the trademark for services that they provide.[126] Companies operating in the fields of banking, health, tourism and education do not have goods, but they have services to provide. The service they offer to the market is their product.[127] Applications related to any activity regarding the service made for the benefit of third parties such as these are considered as service marks. Services such as renting a car, arranging travel, transportation, insurance can be given examples of this trademark.[128] The TRIPS Agreement requires service marks to be protected in the same way as marks distinguishing goods, under Article 15 and Article 16. To put in a nutshell,

[123] Noyan, p.48.

[124] Yasaman p.41.

[125] Dilmaç, Ş. (2014). Uluslararası Metinlerde Tanınmış Marka ve Markanın Sulandırılması. (Recognized Trademark in International Texts and Dilution of Trademark.) Ankara: Seçkin Yayıncılık, p.23.

[126] Arkan, 1997, p.44.

[127] Tekinalp, p.371.

[128] Noyan, p.46.

service marks and trademarks in general answer the same need and same purpose, however, they serve to distinguish services, instead of goods.[129]

4.2. Trademarks According to the Right Holder

4.2.1. Individual Trademark

An individual trademark is meant to be the trademark which is registered in behalf of a person solely, or jointly in behalf of real persons or legal entities under the provisions of condominium-principled ownership or joint ownership.[130] The fact that the individual trademark being the subject of the collective ownership or joint ownership among more than one person does not affect type of trademark as individual trademark.[131] Concept of individual trademark is not referred under the IPC by that title; however, the system of the law is based on the individual trademark. In other words, all provisions of the IPC are with regards to individual trademarks.

Considering the provision in Article 148 of the IPC that the right to industrial property may be transferred *by inheritance*, it is obvious that upon the death of the real person trademark owner, trademark shall continue to be the individual trademark as being a subject of the collective ownership among her/his heirs. Likewise, it is regulated under Article 148/3 of the IPC that the trademark right shall be the subject of condominium-principled ownership in case there is more than one owner of the industrial property right, the joint-owners shall have the pre-emptive right, and method to use of pre-emptive right is also stated under such article. These regulations indicate that the owner of the

[129] Merges, and others, p.537.

[130] Çağlar, p.26; Kaya, p.54; Arkan, 1997, p.44.

[131] Tekinalp, p.371.

trademark does not need to be only one person and may be the subject to the ownership of more than one person by way of inheritance or consent. For whatever reason and by any means, having more than one right holder does not make the trademark to fall outside the scope of the individual trademark. “Pegasus flying horse figure”, “THY” or “SEK” can be given as examples to individual trademarks.[132]

It should be noted that; ordinary partnerships established by more than one real person or legal entity cannot be the owner of the trademarks. In case an individual trademark is used to distinguish the goods and services of a business, which are operated by such kind of a partnership, the partners of such partnership are the owner of such trademarks.[133] The trademark used by businesses, which are under the same control, regardless of their field of activity, to symbolize the group that they belong to in addition to their own trademarks, is titled as a trademark of holding companies.[134] According to *Arkan*, the trademark of holding companies are not joint trademarks. Since the owner of the trademark is directly the holding company. Therefore, the trademarks of holding companies are individual trademarks.[135]

4.2.2. Collective and Certification Marks

Mostly, origin of the goods and services implied by trademark is a real person or legal entitiy, however, in case of collective mark, it works different. The collective mark is included in the IPC. According to the definition given under paragraph 3 of Article 31 of the IPC, *“it is a sign used by a group consisting of businesses of producers or traders*

[132] Ülgen, p.453.

[133] Arkan, 1997, p.44.

[134] Yasaman, p.22.

[135] Arkan, 1997, p.46, Yasaman, p.23.

or providers of services".[136] Simillarly, the collective mark is described in Council Regulation numbered 2017/1001 as *"A European Union collective mark shall be an EU trade mark which is described as such when the mark is applied for and is capable of distinguishing the goods or services of the members of the association which is the proprietor of the mark from those of other businesses"*. The owner of the collective mark is not the group, but the persons who are the members of the group. In other words, the collective mark is a trademark which is registered in the name of more than one businesses, in a manner that each trademark owner is restricted by the rights of other right holders and has same rights as the other right holders on the entire trademark.[137] Furthermore, it is stated in Article 7(1) of Trademark Regulataion that collective marks may consist of descriptive words or designations, because of concerns on geographical indications since these are frequently registered as collective marks.[138]

The collective mark provides the uniformity of goods and services of businesses incorporated in a group as well as the savings in costs arising from trademarking separately. Businesses incorporated in a group in the collective mark allow each other to use the same trademark for same products, but they exercise protection provided by law against other businesses.[139] For instance, the "TARİŞ" trademark is a collective mark used on olives, figs, grapes, cotton and products made from these.[140] Another example, the trademark of "ROQUEFORT" is hold by the city of Roquefort for a specific kind of cheese that made of sheep's milk at a specific cave and in a spesific region in France.

[136] Yılmaz, L. (2017). Marka Olabilecek İşaretler ve Mutlak Tescil Engelleri. (Signs that can be a Trademark and Absolute Registration Obstacles.) İstanbul: Aristo Yayınevi, p.91.

[137] Noyan, p.49; Tekinalp, p.372; Çolak, p.16; Suluk, and others, p.171.

[138] Kur, p.194.

[139] Arkan, 1997, p.45.

[140] Suluk and others., p.171.

However, there is a difference in this example that "ROQUEFORT" trademark impies a production process which means it is a certification mark. It is regulated under Council regulation numbered 2017/2011 as " *An EU certification mark shall be an EU trade mark which is described as such when the mark is applied for and is capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics, with the exception of geographical origin, from goods and services which are not so certified"*.Certification marks, generally, are owned commercial chambers and other trade groups to describe a particular process or product. Moreover, certification marks can not be left to a single person, but it is open to everyone who meets certain criterias to be certificated.[141]

According to Article 32 of the IPC, it is mandatory to submit a technical regulation in case of filing an application to register a collective or certification mark. Technical regulations are prepared to indicate the procedures and forms of using the trademark.[142]

4.2.3. Guarantee Mark

As per Article 31 of IPC, *"guarantee mark is a sign that is used by several businesses under the control of the owner of the trademark and serves for guaranteeing the common features of the businesses, production techniques, geographical origin and quality of these businesses."* That trademark used to reflect the quality of the goods or services, the location of production, the material used in production, and the production methods of a person or persons other than the owner.[143] Accordingly, the guarantee mark

[141] Merges, and other, p.544.

[142] Suluk, and others, p.171; Karan/Kılıç, p.451.

[143] Noyan, p.50.

is the trademark that indicates that the products, bearing such trademark, have a specified quality or feature.[144] The person, who demands to use guarantee mark in her/his products and services that s/he produce, may be granted by providing that s/he obtains permission and her/his goods carries the predetermined quality or feature.[145] From this aspect, guarantee mark is a specialised type of the collective mark.[146]

The use of the guarantee mark on products of trademark owner or businesses that are economically dependend to that trademark owner, is prohibited.[147] The owner of the guarantee mark is a real person or legal entity who guarantees the features of goods or services. In practice, it is reviewed that the owners of the guarantee trademark are mostly official or private professional organizations.[148]

The trademark "WOOLMARK" registered in the name of the International Wool Association is a typical example of the guarantee mark. Persons, who are in demand to use this trademark, are permitted to use the trademark on products produced in accordance with the conditions set by the owner of trademark.[149] "TSE" is a clear example to a guarantee mark in Turkey.[150]

Finally, according to *Tekinalp*, the guarantee mark is not accurately defined under the Decree Law numbered 556. Once the definition of the same given under the Decree Law is reviewed, it is understood that the guarantee mark serves for guaranteeing the production methods, geographical origin and quality of business. However, the quality,

[144] Suluk, and others, p.172; Çağlar, p.30.

[145] Çolak, p.18; Çağlar, p.30.

[146] Noyan, p.50.

[147] Yasaman, p.23; Karan/Kılıç, p.445; Noyan, p.51.

[148] Karan/Kılıç, p.444.

[149] Tekinalp, p.372

[150] Yılmaz, p.98; Çağlar, p.30.

production method and geographical origin of products are guaranteed, not business. In addition, contrary to the definition, several businesses that use the guarantee trademark are not under the control of the trademark owner.[151]

4.3. As to Whether It Is Registered or Not

4.3.1. Registered Trademarks

Although states can provide protection for unregistered trademarks, Article 16/1 of TRIPS Agreement only imposes such protection when the trademark is registered. Therefore, parties of the Agreement can introduce registration of trademarks as an element of trademark.[152]

In Turkish law, trademark protection is mainly acquired by registration.[153] It is regulated under Article 7/1 of the IPC that trademark protection shall be acquired by registration as in accordance with EU legislation. According to the IPC, upon the completion of all procedures of an application, which has been made in full and of which deficiencies are remedied, which has been examined in accordance with Article 16 of the IPC, published, against which no objection has been made or the made objections were ultimately refused and of which all missing documents including the notice proving the payment of registration fee have been served to the Office within due time, shall be registered, shown in registry and declared in the Bulletin. Accordingly, a trademark, which has been registered in accordance with the law and regulation and on which a decision of nullity has not been rendered, may exercise the protection provided by the

[151] Tekinalp, p.372; Arkan, p.46.

[152] Gervais, p.370.

[153] Uzunallı, p.15.

law. The registration of a trademark constitutes the protection provided to the trademark in accordance with the IPC.[154]

4.3.2. Unregistered Trademarks

In addition to registered trademarks, the IPC also provides protection for unregistered trademarks. On behalf of calling a sign as a trademark, its registration is not a condition. To put in other way, although the registration of a trademark constitutes the protection provided under the IPC, registration is not essential.[155] In particular, trademarks that have gained distinctive element through its use can exercise the protection rights even if these are not registered. Similarly, it is indicated in Article 6 of Council Regulation numbered 2017/1001 trademarks that have acquired distinctiveness as a result of unregistered use or recognized trademarks are still considered among the reasons for relative grounds for refusal and termination. Other unregistered trademarks except these can only exercise the protection rights stipulated in the provisions with regard to the unfair competition, in Turkish law under the TCC.[156]

[154] Yasaman, p.54; Çağlar, p.25.

[155] İlkhan, S. (2018). Marka Hakkının Ceza Normları ile Korunması. (Protection of trademark rights with criminal norms.) İstanbul: Istanbul Ticaret Üniversitesi Sosyal Bilimler Enstitüsü, Yüksek Lisans Tezi (Master's Thesis), p.17.

[156] Çağlar, p.25.

4.4. Trademarks as per the Geographical Area Where the Impact of the Registration Appears

4.4.1. National Trademarks

Trademark rights are restricted within the country in which it is registered in accordance with the principle of territoriality.[157] In other words, the trademark, which will be registered according to the provisions of the IPC numbered 6769, can exercise the trademark protection only in Turkey. Therefore, the trademark protection is territoriality by its nature.[158]

4.4.2. Community Trademarks

The community trademark, also known as the European Union (EU) Trademark, is a type of trademark that provides regional protection.[159] The Community Trademark has gained legal status with the Council Regulation on Community Trademark Numbered 40/94 EC and dated 20.12.1993 under the EU legislation.[160] The trademark notion does not change in the community trademark, along the same line, the community trademark distinguishes the goods or services of the businesses from those of other businesses. Trademark law of the EU member states and the Community Law are in force at the same

[157] Yasaman, p.25.

[158] Çağlar, p.29.

[159] Çağlar, p.29.

[160] Yasaman, p.25; Çağlar, p.29.

time. However, these are two different trademark law systems subjects to different rules and different judicial systems.[161]

The width of community trademark's protection area is wider than national trademark protection scope. The national trademark provides protection only within the borders of the country in which it is registered, while the community trademark provides protection in all EU member states, which is more sufficient and more advantageous compared to apply for registration nationaly.[162] Community trademark law is an independent legal system different from that of member states. It has its own structure, operation, administration and organization.[163] In case The OHIM department was established to carry out the processes on the registration of Community trademark. The purpose of the system is obtaining a valid trademark protection throughout the entire EU with a single application. It is not required to be a citizen or legal entity of an EU member country in order to make an application for a community trademark.[164] For instance, citizens of the Republic of Turkey or the legal entity of which headquarter located in Turkey may make the application for the community trademark. The trademark protection is provided by fulfilling the necessary criteria and completing certain stages.

Moreover, Community trademark applicant can seek protection beyond the Community countries thanks to interface between Community trademark system and Madrid Protocol system, since EU is a contractor party to Madrid Protocol. However, if Community trademark application of trademark owner is refused, international protection application acoording to Madrid Protocol will be refused to. In that case, applicant have

[161] Yasaman, p.26.

[162] Kunze, G. (2007). European Community Trade Mark: Commentary to the European Community Regulations. Michigan: Kluwer Law International, p.243.

[163] Yasaman, p.26.

[164] Çağlar, p.29.

possibility to seek for protection in countries one by one according to those national systems.[165]

In short, the community trademark is a community-specific system in force at the same time as the national trademark legislations of the member states. The community trademark system not only provides the acquisition of a community trademark, but also provides protection on trademark all across EU Community, upon a single application.[166] In adition, if an interprise wants to gain protection in Community and a few countries outside the Community, combining the Community systemand Madrid system will be the most sufficient way.[167]

4.4.3. International Trademarks

In order to protect the trademark in one or a few countries, enterprises may prefer to apply national registration in such country or countries. However, if enterprise wants to protect its trademark in aother countries, since each country demands a different procedure and fees for registration, registration of a trademark separately in different countries will cause some difficulties and will result in significant waste of time and financial burden. In order to eliminate these inconveniences, an international registration system, which is more efficient and cheaper, is more suitable for trademark owner.[168]

Initiatives for international protection of trademarks first came to the fore in 1891 with the Madrid Protocol. Although it was not sufficiently supported at the beginning,

[165] Kunze, p.269.

[166] Tekinalp, p.377.

[167] Kunze, p.270.

[168] Kunze, p.243.

upon the acceptance of the Madrid Protocol, its field of application was enlarged.[169] According to the Madrid system, which provides international trademark protection, the person applying for trademark registration can register her/his trademark in all countries where s/he requests protection with a single registration application in her/his own country.[170] Unlike the community trademark, the Madrid Protocol provides convenience only for the application. By virtue of Madrid system, it is possible to register a trademark in more than one country using a single language with a single application. In another saying, applicant can extent protection area to contracting parties of the treaty.[171] The trademark protection is also performed within the framework of the law of the country concerned. After depositing trademark application to the Office of contracting part, if any refusal is notified or all refusals revoked from contrating parties, the trademark will be registered from the date of international registration of application [172]

Another important issue in the Madrid system is that, since EU is a contracting party of the Madrid Protocol, Community trademark system will be directly linked to the Madrid system. Therefore, it is possible to seek an international protection for a community trademark which is already under protection around EU countries. Consequently, the trademark protection as per geographical area can be examined under 4 layer of protection systems. First layer is national protection under national law ssytems, second layer is Community Trademark system, third one is international protection

[169] Çağlar, p.30.

[170] Meran, N. (2015). Marka Hakları ve Korunması. (Trademark Rights and Protection.) Ankara: Seçkin Publishing, p.24; Yasaman, p.29.

[171] Kunze, p.247.

[172] Suluk, and others. p.211; Kırca, İ. (2005). Markaların Milletlerarası Tescili. (International Registration of Trademarks.) Ankara: Bankacılık Enstitüsü Yayınları, p.8; Kunze, p.252.

system under Madrid Protocol and lastly fourt layer is a combination of Commmunity Trademark system amd Madrid system.[173]

4.5. As Per the Environment in Which Trademarks Are Known

4.5.1. Ordinary Trademarks

The ordinary trademark is an unknown or less-recognized trademark that obtains protection through registration. In principle, the IPC protects all trademarks.[174] The provisions of the law apply to all trademarks, either well-known or unknown.[175] The ordinary trademark provides protection to its owner in case of same or similar goods or services.[176]

4.5.2. Well-Known Trademark

The reason of not defining well-known trademarks in the law is that they differ according to each concrete event and do not meet the predetermined criteria. On account of considering a sign as a well-known trademark, various elements have been attempted to be determined in the doctrine and case-law, but a common ground could not have been met.[177] Therefore, it can be said that self guidelines which can assist courts or authorities to decide whether the trademark is well-known or not. To exemplify, the USA, Canada,

[173] Kunze, p.244

[174] Yılmaz, p.98.

[175] Poroy/Yasaman, p.435.

[176] Çolak, p.15.

[177] Poroy/Yasaman, p.436.

Brazil, Japan, the UK, France, Peru and other some countries set some criterias to serve guidelines. Those are can be listed as; recognition level of the trademark, amount of sales and market share on specific product, intensity of advertisement activities and familiarisation level among public, trademarks geographical access locally and glovally, distinctive vharachter of the trademark, the degree of similarity with third parties' signs, nature of the products under scope of the trademark protection, and lastly, commercial value put on the trademark.[178] For instance, English court decision of *Nike* case, it is ruled that use of globally well-known trademark of "NIKE", which is for sportswear, on cosmetic products of defendant would bring deceive in the mind of consumers as there is an association between well-known trademark and defendants sign, so likelihood of confusion is expected.[179]

In order for a trademark to be referred as a well-known trademark, it is sufficient for the products, put on market under the trademark, to be known by consumer segment or in relevant sector. A well-known trademark is basically type of trademark that carries elements of the statutory definition and fulfills the minimum duties expected from the trademark. In addition to this definition, the well-known trademark is a sign which successed to reach a certain recognition in the related environment in the country where it is registered and abroad, and of which awareness gradually exceeds these environments, and becomes a quality indicator and advertising medium all by itself by exceeding its distinguishing function, in time.[180]

A well-known trademark reputation does not only go beyond of the borders, but also it may extend to different fields of production which is unrelated to protected original

[178] Moster, F. (1997). Famous and Well-Known Marks: An International Analys. London: Butterworths, p.11.

[179] English High Court Decision of Nike Ireland Ltd. v. Network Management Ltd. numbered 12 EIPR D-319, dated 22 July 1994.

[180] Ülgen, p.454.

goods and services. That phanemon called “trademark extension” which is an evidence of big enterprise’s extending activities in different class of products by licensing, franchising or product placement. Puting well-known trademark on an unrelated product establish a connection with originally protected goods and services regarding to recognition, popularity, value and good faith linked to that.[181] Consequently, use of the well-known trademark by an infringer without consent of trademark owner created a main subject of likelihood of confusion with comprimising likelihood of association, due to deceiving consumers as establishing a connection between infringer’s products and goods or services which are under scope of well-known trademark. Also, it is not necessarily for the goods and services to be competing with infringer’s products, or not.

Although well-known trademarks are included in the IPC and the Paris Convention, no definitions have been made. In order for a trademark to be considered a well-known trademark, various elements have been tried to be determined in doctrine and case law, but no common denominator has been found. In the fourth paragraph of Article 6 of the IPC, the definition of well-known trademarks in the context of Article 1 and Article 6 of the Paris Convention" is not defined. In the fifth paragraph of Article 6 of the IPC, as saying "because of the reputation level reached in Turkey," registered well-known trademarks are regulated in Turkey. The definition of the well-known trademark is not regulated in the Paris Convention, too. In the Article 8 (c) of the EU Trademark Directive numbered 2015/2436 and Article 8/2(c) of Trademark Regulation numbered 2017/1001, to imply a well-known trademak in the sense of the Paris Convention, the notions of "trademarks with reputation" "well-known trademark" were used, but no definiton was made.[182] According to Court of Cassation a well-known trademark is defined as, “strict connotation arises as a reflex by the people who are in the same environment, that based

[181] Moster, p.5.

[182] Poroy/Yasaman, p.435.

upon a strict guarantee, quality, strong advertisement and connected to a widespread distribution system, without any distinction between customers, relatives, friends, enemies, and regardless of geographical boundary, culture, age, etc".[183]

In addition, when a trademark is well-known, Paris Convention and TRIPS Agreement provide a distinct type of protection for that trademark. Article 6bis/1of Paris Conventin states that,

> *" The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith."*

That Article provides protection for unregistered but still well-known trademarks in member country against third parties attempt to register or infringe the well-known trademark.[184] Article 16/2 of TRIPS Agreement extends that protection to well-known service marks, since Paris Convention Article 6bis only applies to trademark of goods. Article 16/3 of TRIPS Agreement states protection on well-known trademarks for unauthorised use on non-competing goods and services. Article 16/3 states that,

> *" Article 6bis of the Paris Convention (1967) shall apply, mutatis mutandis, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use."*

[183] The Verdict of the 11th C.C. of Court of Cassation dated 24.03.2003, case no. 2002/10575, decision no. 2003/2753, *available at:* www.kazancı.com (visited at: 13.09.2019).
[184] Gervais, p.376.

Therefore, it is clear that well-known trademarks enjoy broader scope of protection in case of unauthorised use of trademark on non-competing products.[185] According that member states need to protect trademark right used in association with dissimilar goods or services.

In such a world where distances become shorter and networks become more intensionally, trademark may be not known only in the country where it is registered but also known worldwide, since local markets rapidly extinct and world become more integrated to global markets.[186] The trademarks, which are globally known, are called "world-renowned trademarks". "BMW, COCA COLA, NETFLIX" can be given as examples of these trademarks.[187] There is no doubt that those trademarks are recognised in consumers' mind as reputation, quality and good faith sign on product, indepentedntly from national borders.[188]

5. TRADEMARK RIGHT

5.1. Definition and Legal Nature of Trademark Right

The right is defined as a legally protected benefit to which its owner is also granted with the right to exercise such protection, and it is classified in different aspects and in different figures.[189] As accepted in the doctrine, rights are divided into two groups' namely public and private rights. In this sense, the trademark right falls within the scope

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[185] Moster, p.51.

[186] Moster, p.4.

[187] Yasaman, p.25.

[188] Moster, p.2.

[189] Oğuzman, K. & Barlas, N. (2018). Medeni Hukuk. (Civil Law.) Istanbul: Vedat Kitapçılık, p.121.

of private rights.[190] In other saying, the right of trademark is based on the norms of private law. The legal rights can be divided into two groups, according to its impact area and as to whether it can be asserted against everyone, namely absolute and relative rights. The right on the trademark is recognized as the absolute right. As per such aspect, it is not possible to use the trademark without the owner's permission. The trademark right, as an absolute right, can be asserted against everyone.[191]

It is possible to separate intellectual property rights as "industrial rights" under protection of the IPC and "intellectual rights" under protection of the Law on Intellectual and Artistic Works (LIAW). Trademark rights are among the industrial rights such as patents, utility models, geographical indicators and design rights.[192] Since it is an industrial right, it does not arise with creation. Trademark rights arise through use of a sign upon selection or registration of the same.[193] Although a right on intellectual and artistic works is established upon creation, to refer a sign as a trademark, it is not required to be original and new and aesthetic. However, the criterion of distinctive nature is required for its registration.[194] Like other intellectual property rights, trademark right grants its owner the exclusive right to enjoy this right. This right has both positive and negative aspects. A positive right means that the right holder can make legal savings as s/he demands. The negative aspect is to grant the right holder with the authorization of

[190] Çağlar, p.35; Kaya, p.34; Özmen, p.34.

[191] Tekinalp, p.22; Yasaman, p.26. Çağlar, p.34.

[192] Ülgen, H. (2015). Ticari İşletme Hukuku. (Law of Commercial Enterprise) İstanbul: Oniki Levha Publications, p.447; Çolak, p.9

[193] Yasaman, p.175.

[194] Yasaman, p.173.

prevention and avoidance of using the trademark by third persons without her/his consent.[195]

Since the trademark right is an intellectual right and has an economic value, legal regulations have been made in our legislation that it may be subject to many legal transactions. According to Article 148/1 of IPC, industrial property rights may be hand on to a third party, transferred by inheritance, become subject to license, given as a pledge, collateralised, seised or put on other legal transactions. According to TCC, the right on trademark can be put as a capital contribution in kind in the establishment of the company, provided that it is not restricted with any right in kind, seizure and precaution.[196]

There is a consensus in the doctrine that the trademark right shall be considered as absolute rights in terms of its nature. However, the issue into which sub-title of the absolute right that the trademark right fall is discussed. Absolute rights can be also examined under two subgroups as, namely absolute personal rights and absolute property right.

The first approach advocates that the right on trademark shall be reviewed within the ftame of property right concept. Just as in other intellectual rights, on the grounds that the trademark right may be transferred independently of the commercial business, being subject to legal transactions and having a commercial value constitutes the reason for this approach.[197] According to *Paslı*, there is an idea when generating trademarks, and the right of the sign which is generated upon this idea shall be considered as the property

[195] Çağlar, p.35.

[196] Arkan, S. (1998). Marka Hukuku. (Trademark Law) Ankara: Ankara Üniversitesi Hukuk Fakültesi Yayınları, Cilt:2, p.207. (hereinafter: Arkan, 1998); Uzunallı, p.13.

[197] Kırıcı, B. (2009). Markanın İnternet Yoluyla Haksız Kullanımı. (Unfair Use of the Trademark via the Internet.) Ankara: Turhan Bookstore, p. 12.

right.[198] In result, trademark concept shifted a property concept rather than what it is.[199] According to another approach, since the concepts of owner and possession, which are the basis of the right to property, cannot be in question in terms of trademarks, the term "owner of trademark" is particularly is used in the law. Likewise, in regard to the Court of Cassation case-law, trademarks shall not be subject to possession.[200]

This right arises once a sign is chosen and used as a trademark, regardless of whether it is registered or not. In this respect, trademark right, like other intellectual and industrial rights, is a product of human idea. Although it is physically used on any product or commodity, when introducing such goods or services on the market, the trademark right falls under scope of the intangible property right. The use of the trademark on a physical item does not affect it being an intangible property right.[201]

According to the view that we also attended, the trademark right is one of the absolute property rights. However, the property may be tangible, in other words having a physical existence, but may be also intangible, having no physical substance. Although the trademark is labelled on a physical product, packaging and signboard, it does not have a physical substance.[202] A trademark is an asset that has no physical substance but having the material value, and therefore it is among the assets of its owner.[203] The trademark is different from the commodity on which it is embodied; is the subject of a separate right.

[198] Paslı, A. (2014). Uluslararası Antlaşmaların Türk Marka Hukukunun Esasına İlişkin Etkileri (Effects of International Conventions in the Basis of Turkish Trademark Law), Istanbul: Vedat Bookstore, p. 13.

[199] Ladas, p.967.

[200] Kaya, p.37.

[201] İlkhan, p.20.

[202] Yasaman, p.176.

[203] Kaya, p.36; Yasaman, p.174; Çağlar, p.34.

In this respect, the right on the trademark is one of the absolute intangible rights on the intangible property.[204]

5.2. Commencement of Trademark Right

It is important as to when the trademark right, which is an absolute right and can be asserted against everyone due to its nature, is acquired. This situation becomes even much more important in determining as to whether the trademark right is legally protected especially in the circumstance of the violation and infringement of the trademark right.[205]

Two different systems have been adopted in context of acquiring the right on trademark. The acquisition of the trademark right usually takes place in two systems, in the condition of being the first user of the trademark or in the condition of registering the trademark. According to registration system, acquiring of trademark right is determined due to moment of registration. According to the other system, acquisition of trademark right is subject to condition of use. To exemplify, to the Anglo-Saxon legal system, in order to register a trademark, condition of using the trademark is required primarily. In that sense, registration of the trademark has nature of explanatory.[206] One important point is that the Paris Convention of 1883 does not require solely registration as criteria for protection, so whether protection require registration of condition of use, clearly depends on contractor party country's decision. However, as per Article 2 and Article 3 of the Convention, citizens of a signatory country and people domiciled or having real commercial relations in a signatory country shall enjoy granted rights in signatory country as well. Therefore, by spirit of Convention, it is clear that if the member country seeks

[204] Karan/Kılıç, p.258.; Kaya, p.34.

[205] Ülgen, p.450.

[206] Yasaman, p.177; Suluk, and others. p.3.

use system for protection for its nationals then same protection will be enabled for him in another member country, even it requires registry system for protection. Furthermore, it can not make any discrimination between nationals and foreigners.[207]

In the first use system, the absolute right on the trademark occurs by the existence and use of a sign depending on an intellectual preference that does not necessarily include innovation.[208] Hence, the trademark owner shall choose a sign as trademark and give it a distinctive element prior to its registration. The United States of America can be given as an example as one of the countries that adopts this system.[209] However, an actual use of trademark should not be understood as a requirement on resgistry application, due to an application can not be rejected on merely reason of lack of usage.[210]

In the system of registration, trademark right is acquired by selecting and registering a sign as a trademark and using this registered sign in a manner specific to trademark law.[211] Article 7 of the IPC numbered 6769 states that "*trademark protection provided by this code shall be acquired by registration*". As explicitly stated in paragraph 4 of the same article that "*the rights granted by the trademark to its owner shall take effect against third parties as of the publication date of trademark registration*". The person who registers a trademark shall have the trademark right and proprietor of such trademark right is called as trademark owner. The trademark right is originally acquired by registration and is acquired by transfer through inheritance or other legal transactions.[212]

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[207] Ladas, p.970.

[208] Ülgen, p.450.

[209] Yasaman, p.181.

[210] Goldstein, p.422.

[211] Yasaman, p.181.

[212] Tekinalp, p.381.

The provision of Artice 7/1 of the IPC was also stated as quite same regulation in the former Decree-Law. The right to request the protection for trademark can be acquired only through registration in accordance with Article 6 of the Decree-Law numbered 556. However, in the period in which the Trademarks Code numbered 551[213] was in force, a mixed system, where protecting the unregistered trademarks could only be based on general provisions, was adopted. In the use system regulated under Article 15 of the Trademark Law numbered 551, the person who created and used a trademark for the first time, has priority against the person who registered the same or indistinguishably similar tramark for the same commodity, depending on certain conditions and duration. While the Trademarks Law numbered 551 contains the principle of rightful owner, the Decree-Law numbered 556 has changed this and adopted the registration system in absolute terms.[214] The principle of registration has been adopted under the IPC, but there are some exceptions to this principle. There is a provision under Article 6/3 of the IPC as follows: "*If a right to an unregistered trademark or to another sign used in the course of trade was acquired prior to the date of application or the date of the first refusal, the trademark application shall be refused upon objection of the owner of such sign*". This provision is stated under Article 6 which regulates the relative grounds for refusal and states the trademark right shall be acquired by use. By basing on such provision regulating the exception of the registration system, in the acquisition of the trademark right, it is possible to state that the principle of the acquisition of the trademark right upon selection and using the trademark is not disregarded, and therefore the mixed system has been enacted under the IPC.[215]

[213] Trademarks Code, (1965, 12 March). Official Bullettin (No: 11951). *available at:* https://www.resmigazete.gov.tr/arsiv/11951.pdf (visited at: 15.09.2019).

[214] Tekinalp, p.382.

[215] Karahan and others, p.181; Ülgen, p.481.

According to Article 6 of Regulation numbered 2017/1001, the European Union Trademark can only be obtained by registration. Registration shall be made to the register held there after the application to the European Union Intellectual Property Office (EUIPO, former OHIM). Although trademark protection, which can be obtained through use or recognition in trade, is accepted by some member states, such as in the Nordic countries and in German Trademark Law, and is permitted through the Directives, the protection of unregistered marks is not possible under European Union Trademark regulations. As an exception, trademarks recognized or gained distinctiveness as a result of unregistered use are considered among the relative grounds for refusal and termination, thus allowing for little protection.[216]

5.3. Registration and Protection of Trademark Right

Trademarks are of great importance for both producers and consumers in commercial life, since trademarks represent quality and trust on the goods or services in mind of society. As it mentioned in Chapter 3, trademark funtions directly depend on it's distinctive character. Therefore, in order for the owner of trademarks not to lose distinctiveness and not to suffer a material loss, trademark rights must be protected against infringer competitors.[217] Protection on trademark right means that the trademarks or its elements are not used and not made savings on by a third person without permission of trademark proprietor.[218]

The principle of territoriality is applied in our trademark legislation. According to principle, our trademark legislation applies in jurisdiction of Republic of Turkey and on

[216] Dutfield/Suthersanen, p.142.

[217] Michaels, p.104.

[218] Tekinalp, p.429.

trademarks that are registered or used in Turkey.[219] A trademark registration before Turkish Patent and Trademark Office has more than one result. After registration, the trademark right owner, besides entitling all kinds rights of disposal authority, shall have protection rights in the law. According to Article 7 of the IPC, the trademark rights commence with registration, similarly to EU legislation. Additionally, registration has a constituent effect in terms of entitlement and protection provided by the IPC for a trademark selected and registered for the first time. However, the registration has an explanatory effect if the subject of the application is a trademark which is previously selected and used.[220]

Thereunder Article 3 of IPC and Article 4/1 of the RIIPC, the trademark application can by made by;

> *"I) Citizens of the Republic of Turkey,*
> *II) Real person or legal entities domiciled or engaged in industrial or commercial activities within the borders of Republic of Turkey,*
> *III Persons who have the right of application according to the Paris Convention or the Agreement Establishing the World Trade Organization dated 15.4.1994,*
> *IV) According to reciprocity principle, persons whose citizenship are in states that provide Turkish citizens the protection of industrial property rights."*

The application is made before Turkish Patent and Trademark Office along with necessary information. Trademark registration application made is formally examined by the office in terms of Articles 4, 5 and 6 of the RIIPC. An application for a trademark, which application conditions have been fulfilled fully and has not been rejected on account of provisions Article 15 and 16 of IPC, shall be published in the bulletin which is published periodically.

Objections related to trademark application, which is published on Bulletin as per the provisions of Article 18 of the IPC, however should not be registered due to absolute

[219] Uzunallı, p.15.

[220] Tekinalp, p.397.

grounds for refusal stated under Article 5 of the IPC or due to relative grounds for refusal stated under Article 6 of the IPC, shall be brought by related persons within two months from the publication.

Upon completion of all procedures of an application, which has been made in full and of which deficiencies are remedied, which has been examined in accordance with Article 16, published, against which no objection has been made or the made objections were ultimately refused and of which all missing documents including the notice proving the payment of registration fee have been served to Office within due time, shall be registered, shown in Registry and published in Bulletin.

As stated in the provisions of Article 22 of the IPC, the trademark registration is accessible for the public. Upon request and if the fee is deposited, a registration copy may be given. The time period of protection for registered trademark is ten years, with effect from application date. This protection period may be renewed for period of ten years.

The trademark owner shall have priority as set out in paragraph 5 of Article 6 of the IPC. According to priority principle, the trademark owner has right to prevent, cease, to compensate pecuniary and non-pecuniary damage and to file a complaint against a trademark registered after her/him.[221]

In addition, as provided for in paragraph 4 of Article 7 of the IPC;

> *" The rights conferred by the trademark to its owner shall take effect against third parties as of the publication date of trademark registration. However, the trademark applicant shall be entitled to initiate a lawsuit for compensation in respect of acts that occurred after the date of publication of the trademark application in the Bulletin, where those acts would, after publication of the registration of the trade mark, be prohibited by virtue of that publication. The court may not decide upon the validity of claims raised before the registration has been published."*[222]

[221] Kaya, p.34; Karan/Kılıç, p.63.

[222] Ülgen, p.482.

5.4. Termination of Trademark Right

5.4.1. Non-Renewal of Trademark Right

As per provisions of Article 23/1 of IPC, time period for protection for registered trademark is valid for ten years from the date of application, which shall be renewed for periods of ten years. It is stated in the following paragraphs of such article that the request for renewal shall be made by the trademark owner within six months before the expiry date of protection, and notice proving payment of the fee needs to be served to Office within that time period. In the event of such request is not made or the notice regarding payment of the renewal fee is not served to Office within that time period, an additional renewal request may be made within six months after the expiry date of the protection, on condition that an additional fee is paid. At the end of the ten-year period specified in the law, the trademark, which is not renewed, shall be deemed null and void, also trademark right shall be terminated which have a prospective effect as of the expiry date.[223]

With the termination of the trademark right, the affiliation between the trademark and the person who appears to be the owner of the trademark ends and this person cannot make a request to protect the trademark in her/his own benefit unless s/he continues to use the trademark.[224] However, under Article 6/8 of the IPC an objection right is still granted to the trademark owner of which the protection period has been expired and not renewed. This right of objection is limited to two years. According to Article 6/8 of the IPC, *"an application for registration of a trademark identical to or similar to a registered trademark with identical or similar goods or services, that is filed within two years*

[223] Kaya, p.44.

[224] Ülgen, p.510.

following the expiration of the protection of the registered trademark due to non-renewal shall be refused upon the objection by previous trademark owner provided that the trademark has been used during such period." This right of objection is based on the priority right of trademark owner who is entitled with right on the trademark by the use of it, but who does not renew the registration process and is deprived of the protection provided by the provisions of the IPC.[225]

5.4.2. Invalidity of the Trademark

One of the reasons leading to termination of trademark right is "the invalidity of the trademark". In case of grounds foreseen under IPC exist, the result of the invalidity of the trademark is the removal of the trademark from the register upon the court decision, prior to expiration of protection period.[226]

The invalidity of trademark is regulated under Article 25 with the heading "Ground of Invalidity and Request for Invalidity" of the IPC. According to this provision, in case existence of one of conditions mentioned under Articles 5 and 6 of the IPC, the invalidity of trademark shall be determined by court judgement. In other words, existence of the absolute grounds for refusal or relative grounds for refusal is the reason of invalidity of a registered trademark. Indeed, a trademark application might have been registered despite an absolute ground for refusal specified under Article 5 of IPC exists. A trademark application, against which an objection has been made due to the grounds stated under Article 6 of the IPC and upon not accepting such objection, might have been also registered. In such circumstances, the law grants the persons concerned the right to initiate a lawsuit for the invalidity of the trademark. It has been stated in the following

[225] Yasaman, p.844.

[226] Tekinalp, p.472.

paragraphs of such related article that, *"persons who have interests, Public Prosecutors or relevant public institutions and organizations may request the court to decide on the invalidity of trademark; trademark invalidity lawsuit shall be initiated against persons who are registered in the register as trademark owner as of the date of initiation of such lawsuit or their successors in title and the Office shall not be designated as a party to trademark invalidity lawsuits."*

On the other hand, although the grounds specified under Article 5 of the IPC exist in the concrete circumstance, the decision of invalidity cannot be rendered, in case the trademark has gained distinctiveness. Indeed, it is stated in Article 25/4 of the IPC that *"in case a trademark has been registered contrary to sub-paragraphs (b), (c) and (d) of first paragraph of Article 5 of the IPC, but it has acquired distinctive nature as a result of use with regards to the registered goods or services before the invalidity request against the trademark, such trademark shall not be rendered invalid."* With such provision, in case a trademark application, which should be rejected due to the absolute grounds for refusal, has been registered by the Office and the trademark has also acquired the nature of distinctiveness by the acts of trademark owner, protection of such trademark has been ensured.[227]

Finalized judgements on invalidity of trademark shall be in force for everyone. Once the invalidity decision is finalized, the court sends that judgement to Turkish Patent and Trademark Office, ex officio. Therewith, the trademark shall be removed from the Registry and that status shall be published in Bulletin.

In parallel with Turkish law, the causes of invalidity in European Law have been examined under two headings. According to Council Regulation numbered 2017/1001, Absolute grounds for invalidity include the grounds for refusal that have been examined

[227] İlkhan, p.28.

ex officio during the registration procedure. Relative grounds for invalidity concern earlier rights that take precedence over the EU trade mark in accordance with the principle of priority. It is indicated that;

An EU trade mark may be declared invalid by invoking absolute grounds in the following cases.

> *"I) Where the EU trade mark was registered in spite of the existence of an absolute ground for refusal (in particular, if it was non-distinctive or descriptive).*
> *II) Where the applicant acted in bad faith when filing the application. This mainly concerns cases where the applicant was pursuing illicit aims in filing the application for the trade mark."*

An EU trade mark may be declared invalid by invoking relative grounds in the following cases.

> *"I) For the same reasons as those for which notice of opposition may be filed.*
> *II) Where another earlier right exists in a Member State that permits the use of the trade mark in question to be prohibited. These concerns, in particular, a right to a name, a right of personal portrayal, a copyright and an industrial property right such as an industrial design right."*

5.4.3. Revocation of the Trademark

One of the reasons for termination of trademark right is the "revocation of the trademark", as it is regulated under Article 26 with the heading "Grounds for revocation and revocation request" of the IPC. According to Article 26 of the IPC;

> *"I) in case, within a period of five years following the date of registration, the trademark has not been put to genuine use in Turkey by the trademark owner in connection with the goods or services in respect of which it is registered, or in case such use has been suspended without any interruption*
> *II) The trademark becomes generic for the goods or services for which it is registered as a consequence of trademark owner's actions or necessary measures not taken by the trademark owner.*
> *III) Trademark misleading the public concerning particularly the nature, quality or geographic origin of the goods or services for which it is registered, as a result of the use by the trademark owner her/himself or with the consent of the trademark owner.*
> *IV) Violation of provisions under Article 32 with the heading "Guarantee trademark or technical specifications for collective trademark" of the IPC."*

Council Regulation numbered 2017/1001, it is possible to say that the regulations in Directive 2015/2436 and IPC are parallel to each other. Grounds for revocation under Article 58;

> *"I) if, within a continuous period of five years, the trade mark has not been put to genuine use in the Union in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non- use; however, no person may claim that the proprietor's rights in an EU trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application or counterclaim, genuine use of the trade mark has been started or resumed; the commencement or resumption of use within a period of three months preceding the filing of the application or counterclaim which began at the earliest on expiry of the continuous period of five years of non-use shall, however, be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application or counterclaim may be filed;*
> *II) if, in consequence of acts or inactivity of the proprietor, the trade mark has become the common name in the trade for a product or service in respect of which it is registered;*
> *III) if, in consequence of the use made of the trade mark by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services."*

It is seen that the regulations in Turkish and EU law are compatible with each other. It should be indicated that the grounds for invalidity and grounds for revocation are not the same notions. In general, it would not be wrong to state that; the grounds for invalidity are the reasons that exist at the registration stage of the trademark, however, the grounds for revocation are those that do not exist at the registration stage but arise later on.[228]

Another important difference is; the persons who have interests, Public Prosecutors or relevant public institutions and organizations may request the invalidity of trademark, the revocation of the trademark can only be requested by "persons concerned" as stated under Article 26/2 of the IPC, while requests for revocation of trademark shall

[228] Tekinalp, p.473.

be claimed against persons who are claimed as trademark owner in the Registery as of the date of request or against their successors.

While the courts decide the invalidity of the trademark, the revocation of the trademark is decided by Turkish Patent and Trademark Office. In the event of putting the trademark into an actual use in respect of registered products within the period between expiry of the five-year period and the date when revocation request is submitted to the Office, revocation requests regarding not using it for five years shall be refused. In case a showpiece use has been carried out to get rid of that revocation request is made, the use performed within three months prior to the submission of request to Office shall not be taken into account.

In case the revocation relates to some product which is within the scope of registered trademark, then the decision for partial revocation shall be given for only those products however, that revocation decision cannot cause to changing in representation of the trademark in Registry. In case the trademark owner changes during the examination process of revocation, proceedings shall continue with regard to person who appears as the proprietor in Registry.

The Office puts owner of the trademark, for which the objection is risen, wise to revocation requests. The trademark owner shall submit her/his evidences and responses to the Office within one month. In case of a time extension reques within this one-month period, the Office shall grant an additional one month. The Office, if it considers necessary, may request additional information and documentation and shall give a decision with respect to the file within frame of claims and defenses as well as the presented evidences, without a hearing.

Finalized decision relating to revocation of trademark shall be effective for everyone in every case. Lastly, trademark shall be removed from Registery and the situation shall be published in Bulletin.

5.4.4. Surrender by The Trademark Owner

One of the grounds that terminate the trademark right is that the trademark owner surrenders her/his trademark right. Surrender means that the trademark owner has abandoned her/his trademark with her/his own consent, prior to expiration date of trademark use and made the trademark available to everyone's use.[229] The trademark owner may surrender her/his right on the products under scope of the trademark, entirety or partly. If a partial surrender is made, the right to trademark shall continue in respect of other products under registered trademark.

According to provisions under Article 28/3 of the IPC, *"surrender shall be notified in writing to the Office and the termination of trademark right due to surrender shall be published in the Bulletin; the surrender shall take effect at the date of record in the register"*. The surrender of the trademark right is a disruptive formative right. With exercise of that right, the absolute right of trademark shall be finalized, and s/he shall not be able to exercise the powers granted to her/him by this right.[230]

In accordance with Council Regulation and Trademark Directive, the subsequent paragraphs of this article states that *"the trademark owner shall not surrender her/his trademark right without the permission of the other right and license owners recorded in the register. If right ownership on trademark has been claimed by a third party and a precautionary decision taken in this matter has been recorded in the register, rights arising from the trademark cannot be surrendered without the permission of that party."*

[229] Tekinalp, p.489.

[230] Yasaman, p.852.

There is no obstacle for the former owner to use the trademark that s/he surrendered. For this reason, such trademark is similar to a trademark of which renewal period is expired but not renewed.[231]

[231] Tekinalp, p.489.

CHAPTER TWO

LIKELIHOOD OF CONFUSION ON TRADEMARK IN ACCORDANCE WITH TURKISH LAW

1. TRADEMARK RIGHT INFRINGEMENT

The trademark right infringement can occur in many different ways, as it is very common nowadays. However, in practice, the infringement of trademark right is mostly occurred through confusion. As a result of this, the notions of the confusion and infringement of trademark right are becoming increasingly significant. Due to reasons such as these, it is necessary to clarify the notion of confusion, as to how the infringement of the trademark right occurs through confusion and how to determine to them.[232]

The notion of an infringement means that an unauthorized person reaching out for someone else's right.[233] Actions mentioned as infringement of trademark right are listed under Article 29 of the IPC and particularly, under Article 7 of the IPC by referencing the same. According to this, the acts considered as infringement of the trademark right are follows:

I) To use any sign identical with the trademark at goods or services that are in the scope of the registration. (Article 7/2-a of the IPC upon the reference of Article 29/1-a of the IPC)

II) To use of any sign identical with or similar to a registered trademark and covering identical or similar goods or services with those of the registered trademark, and

[232] Yılmaz, D. (2016). Marka Hukukunda İltibas Kavramı ve Uygulaması. (The Notion of Confusion and Its Application in the Trademark Law.) İzmir: Dokuz Eylül Üniversitesi Sosyal Bilimler Enstitüsü Özel Hukuk Anabilim Dalı Yükseklisans Tezi (Master's Thesis), p.29.

[233] (online), www.tdk.gov.tr, (visited at: 17.09.2019).

is therefore a likelihood of confusion by the the public, including the likelihood of association between the sign and the trademark. (Article 7/2-b of the IPC upon the reference of Article 29/1-a of the IPC)

III) To use of any sign identical with, or similar to the registered trademark, regardless of being identical, similar or different goods or services, without due cause, in the nature to obtain an unfair advantage of the reputation, or to impair the reputation or the distinguishing nature of a trademark due to the reputation of such trademark has in Turkey. (Article 7/2-c of the IPC upon the reference of Article 29/2 of the IPC)

IV) To imitate the trademark by using the trademark or a similar to the trademark which is substantially indistinguishable from the trademark without the permission of the trademark owner. (Article 29/1-b of the IPC)

V) Even if s/he knows or has to know that the trademark is imitated by using the trademark or a similar to the trademark which is substantially indistinguishable from the trademark, to sell, distribute, put on the trade market in a different form, to make subject to import, export, possess for commercial purposes or offer to conclude agreements with regard to such product having the label of the trademark which was infringed. (Article 29/1-c of the IPC)

VI) To expand the rights granted by the trademark owner through license or to transfer the same to third parties, without consent. (Article 29/1-ç of the IPC)

Prior to the IPC, the actions considered as trademark right infringement were stated under Article 61 of abolished Decree-Law. The provision according that, brings infringement of trademark right by referencing to article 9 of the same law to the violation of circumstances stated under that article. Therefore, if conditions in Article 9 of Decree-Law existed, the infringement of trademark right would be occurred. The regulation in the IPC on the trademark infringement has almost the same provision as the abolished Decree Law. In second paragraph of Article 7 of IPC, it is stated that *"the rights arising*

from the trademark registration belong exclusively to the owner of the trademark and that the owner of the trademark has the right to request the prevention of the acts set out below, in case of execution without consent". In this article, unlike the abolished Decree-Law, the term "in case of execution without consent" is added. With this term, we review that the expression in the article text becomes more explicit.[234] The execution term in that article refers to not only graphical representations, but also it may include orally acts which means still an infringement.[235] Moreover, a distinctive element of trademark may be used in a domain name which may lead to a risk of infringement.[236]

2. THE LIKELIHOOD OF CONFUSION

In context of our study, the point to be approached in circumstance of trademark infringement is the infringement of trademark right through confusion. The confusion, as the definition of the word; is to confuse two very similar things to each other.[237] The likelihood (or the risk) of confusion is the risk of assuming that a sign or a registered trademark is same as a previously registered trademark or they originate from same source, since they are same or similar to each other, because of its figure, appearance, sound, general impression etc.[238] It shall be stated that in case of likelihood of confusion between a sign and previously registered trademark, it is not possible to register such sign for the same or similar goods, it shall be deemed to be an absolute or relative ground of

[234] Düzgün, Ü. A. (2018). *İltibas Suretiyle Markaya Tecavüz*. (Infringement to trademark through confusion.) Ankara: Türkiye Adalet Akademisi Dergisi, Year.9, Issue.36, p.177.

[235] Michales, p.108

[236] Michales, p.109.

[237] Başbüyük, İ. (2018). Marka Hakkının İhlalinden Doğan Cezai Sorumluluk (Criminal Liability Arising from the Infringement of Trademark Rights), Ankara: Adalet Yayınevi, p.106.

[238] Tekinalp, p.416.

refusal; even if it is registered as a trademark, the lawsuit of the invalidity of the trademark can be initiated or if such a sign is used unregistered, it will cause to infringement of the registered trademark. In other words, the likelihood confusion is both an obstacle for the registration and an act of an infringement of the trademark right.[239]

When the products of trademark owner and infringer's products are same and competitive, it is sufficient to expect confusion, however when products are similar but not competitive, some other factors have to be considered in calculation.[240] In such circumstances, first of all, the general impression of the trademark made among the consumer shall be evaluated as to whether these are similar by taking into consideration the "global impact".[241] The risk of confusion shall be evaluated from aspect of "public", in other words, there must be a confusion with the registered trademark and unregistered sign in the eye of the public. In broadly meaning, the likelihood of confusion by public is that the average consumers associate these two signs to each other.[242] The notion of the "public" shall be determined according to the characteristics of each event. Based on type of goods and services in concrete event, it is possible for the average consumer segment to consist the notion of the public, and sometimes the conscious consumer segment can consist the notion of the public.[243] In other words, the public is not all of those living in the world or in any country, but the "ordinary third persons (consumers)" who require the same or similar products in the market where these are put on that by labeling the trademark on. As a more explicit definition, the confusion concerning the trademark law

[239] Tekinalp, p.436.

[240] Merges, and others, p.615.

[241] Yasaman, p.623.

[242] Bahadır, Z. (2018). Ankara: Markaların Hükümsüzlüğü ve İptali (Invalidity and Revocation of Trademarks), Turhan Kitabevi, p. 87.

[243] Karan/Kılıç, p.199

is that a middle-level consumer purchases the goods or services of another business that s/he does not know at all, with the misconception that s/he purchased the goods or services which s/he wished and intended to.[244] In addition to this, strength of the trademark, similarity of signs and products, intention of defendant in selecting such sign and using such marketing channel and lastly, evidences for confusion are the factors to be considierd in determining to confusion.[245]

The likelihood of confusion is first found in the Benelux Trademark Law as Benelux Community was a prior economic union to EU economic community. In Benelux Trademark Law, it is indicated that trademark owner can oppose against to use another sign which is same or similar for same or similar products. This statement was the first raise of the likelihood of confusion on trademark notion. And also, in different Benelux court decisions[246], likelihood of association concept is mentioned while explaining "similar signs" notion as *"when taking into account the particular circumstances of the case such the distinctive power of the sign, the trademark and other sign each looked at as a whole and in correlation, show such a resemblance phonetically, visually or conceptually, that by resemblances alone associations between sign and the trademark are evoked."*[247] The criteria refers to conflict between trademarks to be examined whether there is a likelihood of confusion also covers *"the likelihood of association"*, is indicated in the first Trademark Directive numbered 89/104 EEC of 1988, followed by Council Regulation numbered 40/94 EC of 1993. Those can be seen under Article 4/1-b for refusal or invalidty and Article 5/1-b for infringement, of Trademark Directive. In addition, exclusively for Community trademark, those can be

[244] Tekinalp, p.442.

[245] Merges, 615.

[246] Netherlands Jurisprudence Decision of 1984-72, 20.05.1983.

[247] Kunze, p.337.

seen 8/1-b for relative ground for refusal, 9/1-b for infringement and 52/1-a for invalidty, of same Directive also.[248]

In case of Turkish Law, the scope of the notion of confusion is extended with regulations in Decree-Law numbered 556 and subsequently the IPC numbered 6769. In addition to the notion of likelihood of confusion, the notion of likelihood of association is included with Article 7/2-b of the IPC, as it is included in abolished Decree Law. Expectation on likelihood of confusion is essential in case of similarity. In case there is likelihood of association for a sign regarding to a registered trademark, even if such similarity does not exist under the classical dimensions, such situation is also a confusion since an association will be established between those two signs in the mind of consumers, and therefore the similarity exists.[249] For trademark, if there is a confusion, in other words a deceptive similarity, in terms of general appearance, aesthetics, graphics, color, composition, size and form, it shall be considered as an infringement.[250]

Trademarks are distinguished from each other by signs. As examined under the heading of "distinctive nature of the sign", the trademark may consist of more than one element, therefore, a trademark shall be evaluated as a whole in determining the confusion in terms of these elements. The impression made by the trademark shall be evaluated as a whole and then it shall be determined whether there is a confusion or not.[251] In case the trademark consists of color and words, logo, letter or number, an assessment shall be made according to the characteristics of the concrete event. In such circumstances, it is necessary to assess as to whether the original element or elements of the trademark are

[248] Kunze, p.336.

[249] Tekinalp, p.442.

[250] Düzgün, Arslan, Ü. (2010). Marka Hakkının Tükenmesi ve Paralel İthalat. (Exhaustion of Trademark Rights and Parallel Import.) Ankara: Yetkin Yayıncılık, p.24.

[251] Teoman, Ö. (1992), Yaşayan Ticaret Hukuku, Hukuki Mütalaalar (Living Commercial Law, Legal Opinions), Istanbul: Beta Basım Yayıncılık, p.120.

used and as to how the average consumer understands this use.[252] In the Decision[253] of the Court of Cassation, it has decided with regard to decision on trademarks "Hatay Kral (King) the Künefe Restaurant" and "Kral (King) from Antakya Esat the Künefe Chief Since 1970 + Figure" that the original and distinctive element in the two trademarks are the word "King", and the auxiliary elements were not in a nature to disappear the confusion.

The success in trademark depends on achieving uniqueness. Using a similar trademark weakens the trademark.[254] Once a trademark is used similarly without its owner's consent, it causes to an intellectual association between the two trademarks; and the latter trademark damages the distinctiveness power of the previous trademark. It occurs because when the consumer encounters the second trademark, s/he remembers the previous trademark involuntarily.[255] In other words, as the similarity decreases, the risk of confusion of the trademark decreases.

Last but not least, the confusion can occure in opposite way of ordinary, that is called "reverse confusion". Ordinary confusion occurs when infringer adopt a very similar sign to reputable trademark to raise confusion among public into make them think that infringer's goods are associated with those of trademark owner. However, in the reverse confusion case, senior and more reputable company imitate junior user's trademark. Therefore, people will associate the sign with not junior trademark owner, but with the infringer reputable senior. Even infringer is senior reputable company, it is made

[252] Tekinalp, p.437.

[253] The Verdict of the 11th C.C. of Court of Cassation dated 06.12.2010, case no. 2009/6405, decision no. 2010/12556, *available at:* www.kazancı.com (visited at: 17.09.2019).

[254] Noyan, p.386.

[255] Dirikkan, H. (2003). Tanınmış Markanın Korunması (The Protection of Well-Known Trademarks), Ankara: Seçkin Yayınları, p.167.

certain with court decisions that reverse confusion is a trademark confusion type too and size of parties do not change that.[256]

2.1. Types of Confusion

To examine the notion of confusion under three headings is possible, these are as follows; direct confusion, indirect confusion and confusion in broad terms.

2.1.1. Direct Confusion

Since it is directly associated to the indication of origin function of trademarks, it is likelihood of confusion referred to by this name that has the same meaning as the risk of classical confusion.[257] Here, the public fall in to mistake that goods and services originate from same business by confusing the trademark and sign due to the sameness or similarity between them.[258] While the relevant public segment thinks that, those products originate from the same business, the origin function of trademark is damaged. Without such confusion, the consumer would not purchase such goods or services, so once the target segment realizes that the businesses and the origin of the products are different, no risk of confusion is expected.[259]

[256] Merges, p.624.

[257] Küçükali, p.66; Dirikkan, p.164.

[258] Küçükali, p.67; Dirikkan, p.165.

[259] Karahan, S. (2008) Sınaı Haklarda Hükümsüzlük Davaları, Fikri ve Sınaı Haklar İhlaller & Davalar (Invalidity Lawsuits in Industrial Rights, Intellectual and Industrial Rights Violations & Lawsuits), Istanbul: Istanbul Barosu Yayınları, p.22; Dirikkan, p.164; Arkan, p.98; Tekinalp, p.410.

In case of such confusion, it is possible that the relevant public segment could misapprehend with regard to both signs and businesses.[260]

2.1.2. Indirect Confusion

In the risk of indirect confusion, the consumer distinguishes the signs from each other; however, due to the similarity between the signs, s/he assumes that the owner of the trademark makes restrictions in the trademark or uses serial trademarks and reaches to a conclusion that such goods or services are originated from the same business.[261] In the event where such risk of confusion occurs, oftenly a sign that incorporating other elements of the trademark or use of specific elements of the trademark exist. When the consumer reviews two different but similar signs, s/he assumes that the owner of the trademark shortened, made additions or partially modified the trademark.[262]

For instance, Sabancı Holding has hundreds of trademarks formed by the addition of SA suffix at the end of different phrases such as "LASSA, TEKNOSA and İKLİMSA". In addition, at the end of each trademark, Sabancı has a logo consisting of "S" and "A" letters stated in white, which is drawn into two blue circles. In case "YAĞSA" trademark application is made by another person without any connection with Sabancı Holding, even though the consumer distinguishes the signs from each other, since the "YAĞSA" trademark includes also the SA logo, which represents the Sabancı holding, therefore the consumer reaches to the conclusion that the "YAĞSA" trademark belongs to the same business and is one of the serial trademarks of the Sabancı Holding. In that case, the indirect confusion may be mentioned, because the common thing in each is the existence

[260] Dirikkan, p.165.

[261] Dirikkan, p.164.

[262] Küçükali, p.67.

of the "SA" logo. On the other hand, if the "YAĞSA" trademark is used solely, without the existence of the logo, it wold not be possible to interpret it as belonging to Sabancı Holding and therefore it would not be possible to mention the likelihood of confusion.[263]

Contrarily, especially in the circumstance where the sign is used on products other than goods or services for which a trademark is registered previously, even if relevant public segment knows that the sign is not the for the same group of goods in which the trademark is used, they might get the idea that owner of the trademark commences producing different types and qualities of goods and services due to the fact that the sign is identical or similar with the trademark. That case shall also be considered within the scope of likelihood of indirect confusion.[264] Furthermore, this is a highly possible ocassion in case of well-known trademarks, since if that type of trademark is used for different goods and services among the purchasers, this idea will arise automatically in minds of them.[265]

2.1.3. Confusion in Broad Terms

It is the risk of confusion occurs where the relevant segment can distinguish between signs and businesses, and they mistakenly believe that there are special economic ties or tight corporation relationships between businesses.[266] The likelihood of confusion in broad terms is a notion which has arisen especially in order to protect the well-known trademarks and herein, the consumer believes that the production is carried out under

[263] Yılmaz, H. (2018). Marka İle Alan Adı Arasindaki İltibas (Confusion Between Trademark and Domain Name), Kırıkkale: Kırıkkale Üniversitesi Sosyal Bilimler Enstitüsü Özel Hukuk Anabilim Dalı Yüksek Lisans tezi (Master'sThesis),p.41.

[264] Küçükali, p.67; Dirikkan, p.165.

[265] Arkan, 1997, p.98.

[266] Küçükali, p.67; Dirikkan, p.166.

control of trademark owner and the sale of the produced goods is conducted by her/him too. It occurs mostly with regard to licence agreements, the fact that even though there was not a conducted license agreement, with the assumption that there is a license agreement between the parties, a connection will be assumed by the consumer that there is a partnership agreement between the owner of the trademark and the business that serves the goods and service, this is a likelihood of confusion in broad term.[267]

For instance, "Zorlu Tekstil Company" has used the "HARRY POTER" trademark, without any license agreement between them, as an auxiliary element of the "LINENS" trademark. In this circumstance, the consumer will be able to distinguish between the "HARRY POTER" trademark and the "LINENS + HARRY POTER" trademark and even will be able to consider that these belong to different companies. However, the consumer, who reviews the "LINENS + HARRY POTER" trademark, will be of the opinion that there is a connection between these two companies, such as a partnership or license agreement. At this point, even if the consumer understands that the signs and businesses are different, s/he will be in the confusion that there is a connection between the companies. It is possible to interpret this situation as the confusion in broad terms.[268]

Although it has been alleged that the confusion in broad terms has arisen to ensure the protection of well-known trademarks, IPC accepts the confusion in broad terms by finding the connection adequate in all types of trademarks.

[267] Tekinalp, 410; Dirikkan, p166.

[268] Yılmaz, H., p.41.

2.2. Likelihood of Confusion as Absolute and Relative Grounds for Refusal

2.2.1. The Likelihood of Confusion as Absolute Ground for Refusal

According to IPC, the request for registration of a sign which is the same or indistinguishably similar to a trademark for the same or same type of goods and services, shall be absolutely refused in accordance with Article 5/1-ç of IPC. The reasons for absolute grounds for refusal are not because third parties have the right to sign the subject of registration; but since the sign is closed to all for reasons arising from the nature of the sign, the objection cannot be waived and is taken into consideration ex officio by the Turkish Trademark Office.[269]

According to Article 16, paragraph 1, second sentence of the TRIPS Agreement; if the same sign is used for the same goods or services, it is assumed that the likelihood of confusion is assumed to exist. In such a case, no further investigation is needed to determine whether there is a risk of confusion between the registered trademark and the second sign or trademark for which the registration is requested.[270] If the signs are the same, it is unnecessary to investigate whether there is a likelihood of confusion and in the first step the registration request of the trademark is denied. Trademark registration shall not be done. Because, since registration provides absolute protection to the registered trademark before, there is no need to prove the existence of the likelihood of confusion.[271]

When EU trademark law legislation is examined, it is seen that registering the same or indistinguishably simillar signs for the same kind of goods and services is not possible in both the Regulation and the Directive is regulated as a relative ground for

[269] Küçükali, p.29.

[270] Küçükali, p.32.

[271] Dirikkan, p.161.

refusal but not as an absolute ground for refusal. In addition, the term of indistinguishably similar sign is not included in both EU regulations. Under article 8/1 of the Regulations indicates the sameness and similarity of trademarkss separately as Paragraph (a) held that the same trademark that was previously registered or applied for registration could not be registered for the same goods and services, while Paragraph (b) held that the likelihood of confusion due to sameness or similarity. Turkish law differs from EU law in this regard.[272]

Therefore, signs which are same or indistinguishably similar with the earlier trademark and the goods or services for which registration is applied for are same or same kind with the goods or services for which the earlier trademark is protected is regulated as an absolute ground of refusal. However, if a similar trademark is requested to be registered by another person and is intended to be used for the same or the same kind of goods or services, and if there is a likelihood of confusion among the public, including the likelihood of association, previous trademark owner may prevent the registration by objecting to the registration.[273] If there is no possibility of confusion among the public, despite the similarity, there is no obstacle to the registration of the new sign.[274]

2.2.2. The Likelihood of Confusion as Relative Ground for Refusal

IPC Article 6/1 indicates that the registration of signs that are identical or similar to a trademark that has been registered or applied for registration and that may be

[272] Oğuz, A./Özkan, Z. (2018). Yargıtay Kararları Işığında Sınai Mülkiyet Kanunu'nun 5/1-ç Maddesi Anlamında Ayırt Edilemeyecek Kadar Benzer İşaretler. (Indistinguishably Similar Signs According to the Article 5/1-ç of Industrial Property Code in the Light of Cases of Turkish Cassation) Ankara: Terazi Hukuk Dergisi, Vol: 13, Issue:141, p.40.

[273] Tekinalp, p.438.

[274] Arkan, 1997, p.103; Dirikkan, p.161, Tekinalp, p.438.

confused by the public may be objected to.[275] Similar regulation exists in the German Law. The German Trademark Code states in the relative grounds for refusal under Paragraphs 1 and 2 of the Article 9 that;

> *" The registration of a trade mark may be cancelled, if it is identical to a trade mark applied for or registered which has older seniority and the goods or services for which it was registered are identical with the goods or services for which the trade mark with older seniority was filed or registered;*
>
> *if the likelihood of confusion exists, including the likelihood of association between the trade marks, for the public because of its identity with or similarity to a trade mark applied for or registered with older seniority and owing to the identity or similarity of the goods or services covered by both trade marks."* [276]

In a overall assessment of IPC, it can be seen that, the request for the registration of the same trademark for the same goods and services, which has been registered or applied for registration, is evaluated as both an absolute and a relative ground for refusal.[277] The grounds for absolute refusal are closely related to the trademark creation characteristic of a sign, which is mainly intended to prevent the registration of signs that do not have any distinctive charachter or should be kept open for use by all in the field of commerce or signs that are misleading the public, contrary to public order, religious values and general morality, and which are which are taken into consideration by Trademark Office ex officio, the public interest in the foreground. The relative grounds for refusal are not because of the qualifications and characteristics of the sign, but because the third parties have acquired a right to this sign before the registration application, the

[275] Epçeli, p.8.

[276] Dirikkan, p.172.

[277] Epçeli, p.8.

aim is to protect their rights.[278] The reasons for the relative rejection are not taken into consideration by Trademark Office ex officio.[279]

Unregistered signs used outside the scope of goods or services for which registration is requested are protected in accordance with the provisions of unfair competition. In the examination of the objection of registered trademark owner in terms of the similarity of the goods and services shall be limited with the goods and services covered by the registered trademark and the goods and services specified by the applicant in the request for registration. The goods and services actually used by the parties should not be taken into consideration.[280] In the case of infringement of the trademark, the similarity of goods and services in terms of protection of the registered trademark must be determined according to the list of goods and services in which the trademark of the plaintiff is registered and taking into account the goods or services used by the third party under her/his sign.[281]

2.3. Elements of Confusion

In order to mention about the trademark right infringement through confusion, a same sign should be used on similar goods or services, or a similar sign should be used on same/similar goods or services, and that use in question should cause to the likelihood of confusion.[282] The trademark owner may prohibit use of any sign which is the same or

[278] Arkan, 1997, p.71.

[279] Dirikkan, p.172; Küçükali, p.38.

[280] Küçükali, p.38.

[281] Dirikkan, p.182.

[282] Başbüyük, İ. (2017). Marka Hakkının İhlalinden Doğan Cezai Sorumluluk (Criminal Liability Arising from the Infringement of Trademark Rights), Ankara: Adalet Yayınevi, p.118.

indistinguishably similar to her/his registered trademark and may request the prevention the use for same or similar products within scope of the registration that may be confused with the registered trademark for the same or similar sign.[283]

2.3.1. The Same or Similar Sign

2.3.1.1. Same Signs

Under Articles 5 and 6 of the IPC, which regulate the absolute and relative ground for refusal, although the similarity between signs has not been described, "the same" or "indistinguishably similar" notions have been used. These two notions express different things. The term of the "same" is actually quite clear. The signs subject to the concrete event must be identical and must not contain any differences, must be copies[284] so that the term of "indistinguishably similar" is not as clear as sameness and has not been defined in the IPC.[285] According to *Tekinalp*; it means that when the signs are the same, those two signs are exactly the identical, there is no slight difference between them.[286] According to *Arkan*; the fact that the word that constitutes the essential element of the trademark is at different sizes or stated in different text forms or given in another colors in latter trademark does not remove the sameness of trademarks.[287] *Yasaman* further expanded the boundaries and stated that differences such as the writing style would not

[283] Çolak, p.234; Uzunallı, p.29.

[284] Çağlar, p.48; Karahan, p.45.

[285] Oğuz/Özkan, p.42.

[286] Tekinalp, p.441.

[287] Arkan, 1997, p.76.

remove the sameness of trademarks.[288] Although there are different evaluations with regard to the notion of sameness, the result will not change. In other words, if the signs are exactly the same, but includes as minor differences, such as the writing style, there is no need to make a further research as to whether there is likelihood of confusion.[289] For instance, once "BLACKBERRY" trademark is written with small letters as "Blackberry", it means that the same trademark is used. In the same direction, in a decision of the Court of Cassation, the previous trademark with the expression "Pover Pack" is registered by another with all its elements, i.e." Pover Pack "or" POVER pack " without adding or subtracting, is accepted the same sign as the previous trademark.[290]

In cases where there are changes in the signs, such as change of place of letters, color difference, using a different single letter or a number, which are difficult to distinguish the difference, the indistinguishably similarity shall be mentioned.[291] For instance, there are indistinguishable similarities between the trademarks such as "PİRİL and PRİL, LÜKS and LUX, CHANEL and ŞANEL". It is the same or indistinguishable signs that are meant in many parts of the IPC by the notion of "imitation".[292]

The sameness or indistinguishable similarity in trademarks is determined as a result of the impression made by the trademark as a whole. The fact that in case the signs of trademarks are the same, but different in sizes or colors or spelling formats indicate that they are similar, even if not the same, and no further research is needed to make in

[288] Yasaman, p.228.

[289] Karahan, p.49.

[290] The Verdict of the 11th C.C. of Court of Cassation dated 20.06.2011, case no. 2009/14409, decision no. 2011/7481, *available at:* www.kazancı.com (visited at: 20.09.2019).

[291] Tekinalp, p.441.

[292] Yasaman, p.396.

order to decide on risk of confusing.[293] The existence of the confusion between trademarks shall be considered absolute in the event that the sign, which is same as registered trademark, is registered for same or similar products of such registered trademark.[294]

2.3.1.2. Similar Signs

The notion of "similarity" is not defined in the IPC, and if there is a likelihood of confusion, including the likelihood of association which means the sign has a connection with the registered trademark, such sign is considered to be similar to the registered trademark. If changes made on a registered trademark causes even a little doubt about the confusion of the trademark with the sign, then it is not usage of the same sign, but usage of a "similar sign", and as to whether the consumer confuses the trademark with the sign shall be researched.[295]

In the research for the likelihood of confusion, it shall be commenced with as to whether there is a similarity between the trademarks and it shall be decided as to whether there is a similarity or not by taking into consideration the impression of the trademark made as a whole.[296] In the evaluation of the similarity of trademarks, the perspective of the average consumer shall be taken into consideration depending on the visual, auditory and semantic(conceptual) similarities.[297] Since the impression of the trademark made as a whole is essential, it shall not be convenient to examine by dividing into parts, the parts

[293] Arkan, 1997, p.75.

[294] Karahan, p.91; Küçükali, p.36; Bainbridge, p.630.

[295] Dirikkan, p.176.

[296] Arkan, 1997, p.99.

[297] Dirikkan, p.176; Çolak, p.234.

shall only be considered up to the extent of their effect to the general appearance of the trademark.[298]

In the decision[299] of the Court of Cassation regarding the use of a sign similar to a trademark; where confusion between the "VAKİT" ("TIME" in English) trademark used in the plaintiff's newspaper and the "BEKLENEN VAKİT" ("EXPECTED TIME" in English) trademark used in the defendant's newspaper was evaluated, it was stated that the defendant created a similar trademark by making small differences on the trademark by indicating the word "BEKLENEN" ("EXPECTED" in English) to the beginning of the word "VAKİT" ("TIME" in English) with small caps and it was indicated that such similarity shall cause confusion with the plaintiff's trademark in the consumer's mind who has a medium level of attention, intelligence and knowledge, particularly in her/his perspective, due to the general impression that it creates.[300]

Another issue to be considered in the evaluation of confusion is distinctive power of previous trademark. Supposing that distinctiveness of the previous trademark is low, it may be possible to prevent the occurrence of the confusion with small differences. In contrast, higher differences are required to prevent the confusion with trademarks having high degree of distinctiveness. In the evaluation as to whether there is a likelihood of confusion, particularly with regard to trademarks with multi-elements, the distinctive element of trademarks shall be taken into consideration, by setting aside the generic and descriptive elements, since the unique parts of the trademark draw more attention from the average consumer. Multi element sings having high degree of distinctiveness require

[298] Arkan, 1997, p.100.

[299] The Verdict of the 11th C.C. of Court of Cassation dated 29.06.1995, case no. 1995/4669, decision no. 1995/5580, *available at:* www.kazancı.com (visited at: 20.09.2019).

[300] Özkan, E. (2015). Avrupa Topluluğu Adalet Divanı Ve Yargıtay Kararları Işığında Markada İltibas (Confusion in Trademarks In the light of the Decisions of the Court of Justice of the European Communities and the Court of Cassation), Antalya: Akdeniz Üniversitesi Sosyal Bilimler Enstitüsü, Yüksek lisans tezi (Master's thesis), p.30.

a broader protection in the evaluation of confusion, while signs having low degree of distinctiveness require a narrower protection.[301]

The fact of being known of the previous trademark is an element that increases the confusion among the trademarks. A wider protection is required to be provided to well-known trademarks in this respect. Since the consumer, who reviews a sign, can assume an intellectual connection between those, even if the sign contains only one element of the well-known trademark. As the signs that generate the well-known trademark are embedded in mind of consumers, when the consumer reviews the latter trademark, s/he can ignore some differences in this trademark and assume a connection between the latter trademark and the well-known trademark.[302]

2.3.1.2.1. Visual Similarity

If there is a slightly visible similarity between the trademarks subject to the confusion comparison, in other words, if there is a figurative similarity, it is called the visual similarity. The most commonly used type of similarity and effective to the conclusion in determining the likelihood of confusion is visual similarity. If the letters, words or picture, logo, pattern, graphic or similar figure elements, which generate the trademarks, are the same or similar, the similarity may occur.[303] The similarity between the trademarks may happen in case there is a similarity in the figures of the signs, or in case the outer appearance or packaging of the product is made similar and thus the

[301] Suluk, and others, p.188.

[302] Dirikkan, p.167.

[303] Arkan, 1997, p.101; Çolak, p.234.

likelihood of confusion occurs.[304] Article 4 of the IPC states that "the trademark may consist of any signs like the shape of goods or their packaging and in case the goods or packaging has a unique shape", it provides the protection to those. The product "TOBLERON" in the form of a pyramid can be given as an example of the trademarks of which shape of the product is protected.[305]

The use of a similar packaging of a product in manner that causes to the confusion shall be deemed "unfair competition". The use of the same packaging and the use of more or less similar ones may be considered as the confusion. However, if it is registered as a trademark, it is obvious that it will exercise the protection of trademark right.[306] For instance, there are decisions of the General Assembly of Civil Chambers of the Court of Cassation, related to the packaging, stating that the act of selling halvah and Turkish fairy floss (pişmaniye in Turkish language) by imitating the signs exactly such as color, pattern and motif etc. in their boxes and the act of using the same size, figure and color of Nestle chocolates' packages by the defendant, shall constitute the unfair competition.[307]

Due to the similarities between the figures of trademarks, likelihood of confusion may occur as result of perceiving by consumers that those trademarks belong to the same master trademark or to the same business. In case of using same trademark by another business, confusion is expected, and it shall be researched on as to whether the target segment confuses the trademarks within the infringement of the trademarks.[308] The visual

[304] Epçeli, S. (2006). Marka Hukukunda Karıştırılma İhtimali. (Likelihood of Confusion in Trademark Law.) İstanbul: Legal Yayıncılık, p.65; Küçükali, p. 109.

[305] Küçükali, p.103.

[306] Doğanay, İ. (2004). Ticaret Kanunu Şerhi. (Commentary of the Commercial Code.) İstanbul: Beta Yayıncılık, p.402.

[307] Doğanay, p.403; *see:* The Verdict of the General Assembly of Court of Cassation dated 26.10.1994, case no. 1999/11-455, decision no. 1994/630, *available at:* www.kazancı.com (visited at: 20.09.2019).

[308] Arseven, p.143; Arkan, 1997, p.101.

similarity is very decisive in particular, clothing products appeal to all segments; convenience foods, such as chocolate wafers, appeal to children; products, such cleaning and detergent products, appeal to housewives.[309]

2.3.1.2.2. Audio Similarity

The similarities between the signs are of great importance in determining the risk of confusion. A similarity in sound, figure or meaning, which is the essential element of the trademark, has an effect on as to whether the trademark can be registered and on the protection of the trademark. The audio similarity is the kind of similarity that occurs as per the sound effect in the ear according to the pronunciation of trademarks and signs. Herein, it is naturally mentioned about a similarity arises in terms of trademarks consisting of words or sounds.[310] If two trademarks or signs are similar in terms of pronunciation, these are considered similar, even if these are not similar in spelling. While the audio similarity usually occurs with visual and meaning similarities in the languages where words are read as they are written, it, alone, is also important in languages where pronunciation and writing differ.[311]

There is no need for visual similarity or semantic similarity in addition to the audio similarity for the existence of the likelihood of confusion. In sound similarity, in case of a pronunciation similarity between a registered trademark or a trademark of which application for registration is recently made and a new trademark of which trademark application is made, even though there are differences in spelling, these trademarks are considered similar. If the spelling and reading are the same in the language used in

[309] Çolak, p.235.

[310] Çolak, p.237.

[311] Epçeli, p.114; Küçükali, p.102.

trademarks containing words, this similarity may bring along the semantic similarity, or in other saying similarity of meaning. However, in different languages and in circumstances where the pronunciation differs from the spelling, even if the words are not similar, the trademarks are considered similar in respect to sound. [312] The Court of Cassation's decisions regarding the trademarks of "CHANEL-ŞANEL",[313] "BOSCH-BOSH"[314] are also good examples stating that both trademarks are very similar in terms of pronunciation.

The first syllables and the first sounds of the words are also one of the points that shall be considered in the examination of the audio similarity. Because, average consumers pay more attention to the beginning of words.[315] For instance, the CJEU also rules to likelihood of confusion between trademarks of "OLLY GAN" and "HOOLIGAN" due to the audio similarity.[316] The Court of Cassation stated in a decision[317] that the products labeled "VAYLEYD" which are similar to the pronunciation of the brand "VILEDA" would create a likelihood of confusion.

The examination of likelihood of confusion shall be commenced with decide whether there is a similarity between the trademarks, and it shall be borne in mind that the decision as to whether there is a similarity will be made by considering the effect of

[312] Çolak, p.237.

[313] The Verdict of the 11th C.C. of Court of Cassation dated 11.06.1991, case no. 1991/8954, decision no. 1991/3909; Epçeli, p.115, *available at:* www.kazancı.com (visited at: 04.10.2019).

[314] The Verdict of the 11th C.C. of Court of Cassation dated 19. 02. 2001, case no. 2000/10455, decision no. 2001/1394; Çolak, p.237, *available at:* www.kazancı.com (visited at: 04.10.2019).

[315] Çolak, p.237.

[316] Bently/Sherman, p.818; *see:* CJEU, Judgment of the Court of First Instance (Second Chamber) of 1 February 2005, *Hooligan*, Case T-57/03, not published; Bently/Sherman, p.818.

[317] The Verdict of the 11th C.C. of Court of Cassation dated 30. 06. 1994, case no. 1999/3333, decision no. 1999/5642, *available at:* www.kazancı.com (visited at: 04.10.2019).

the trademark made as a whole.[318] The more similar the commodity is, the more the confusion of the sign by the assumption of the public regarding the association establishes. A determination shall be made by considering as to whether the trademarks are similar and the circumstance "to distinguish, to make an association" of the public segment who is the consumer of the commodity, the subject matter of case, due to nature of the commodity, and as a result of such determination, the legal status is required to be evaluated. In trademarks consisting of words, in case the meaning of the word is dominant, the risk of confusion of another sign to such trademark in terms of sound and figure shall be decreased. From this point of view, it was decided that there is no likelihood of confusion between the trademark consisting of the word "BOSS" which means the chief, patron and the trademark consisting of the word "BOX" which has a different meaning.[319] Therefore, it is also important to examine the semantic similarity in the existence of likelihood of confusion.

2.3.1.2.3. Semantic Similarity

If both signs, which are subject to examination, are similar in terms of the conceptual impression that they made in the public mind as per their meaning, in this case a similarity of meaning or "semantic similarity" shall be mentioned.[320] In case there is a similarity in meaning between the trademarks, registering the latter sign as a trademark is not possible. First of all, it is important to state that to use of a trademark which is similar to another one in terms of their meanings need examination only when there is a

[318] Küçükali, p.109; Arkan, 1997, p.99.

[319] Epçeli, p.115; Arkan, p.102.

[320] Epçeli, p.115.

difference between trademarks with different spelling and figures. Since if their spellings are identical, this shall be deemed to be the same or indistinguishably similar use, in anyway.[321]

The semantic similarity can be mentioned in terms of the conceptual effect of two trademarks made on the minds of the average consumer. In order to mention about the semantic similarity, trademarks do not have to consist of words with the same meaning. Although these have different meanings, some words can make the same conceptual effect in minds. For instance, the trademark "GORILA" in the 25th class and another trademark in the same class having the figure or photograph of gorilla animal are conceptually similar. Since the average consumer, who is the respondent of both trademarks, will imagine a kind of ape or gorilla in her/his mind. In this respect, the fact that one of the trademark consisting of a figure and the other consisting of a word shall not affect the result.[322]

The trademarks consisting of words having the same meaning in a foreign language and in Turkish are also similar trademarks. However, in some circumstances the average consumer can perceive very differently the spelling of the trademark in the Turkish language and the spelling of the trademark in the different language. In this circumstance, the existence of a similar trademark should be accepted, and likelihood of confusion should be researched.[323] The trademark shall be considered as a whole and the overall impression of the trademark made on the consumer shall be evaluated. Therefore, the Turkish Patent and Trademark Office does not set a certain criterion in the field of trademark similarity and evaluates each situation individually according to the

[321] Karahan, p.49.

[322] Çolak, p.246; Karahan, p.49.

[323] Küçükali, p.115.

situation.[324] The Turkish meaning of a word in foreign language changes by subject to concrete event and it shall be decided as to whether the consumer knows the meaning of that word. For instance, in case the word "LION" is requested to be registered for same products of another trademark consisting of the word "ASLAN" which is lion in Turkish, it shall be taken account that a likelihood of confusion may occur by considering that a large segment of society knows the meaning of the English word "LION" in Turkish.[325]

Likewise, if the trademark consisting of a word is expressed in figures and has the same meaning, there is also the risk of confusion. An example for this can be given as follows, the trademark Black Sister/Siyah Bacı, with a picture of a young black girl in its package, and the trademark Arab Aunt coffee, with an image of an old lady wearing glasses in its package, sold in the market are said to be that such signs might connotate each other.[326] In addition, the General Assembly of the Court of Cassation ruled that there was a likelihood of confusion between the trademark (Lacoste) consisting of crocodile shape and the word trademark "Crocodile". The Court of Cassation here ruled that the meaning of the word "CROCODILE", which means alligator in English, is known to the average consumer and that there is widespread use of the word "krokodil" in Turkish, which means crocodile skin in Turkish.[327]

2.3.2. Same or Similar Goods and Services

In order to mention about the trademark right infringement, the sign similar to previously registered trademark should be used in the same or similar goods and services

[324] Arkan, 1997, p.73; Dirikkan, p.171.

[325] Çolak, p.246.

[326] Tekinalp, p.415.

[327] The Verdict of the General Assembly of Court of Cassation dated 08.04.2015, case no. 2013/11-1885, decision no. 2015/1161, *available at:* www.kazancı.com (visited at: 05.10.2019).

of registered trademark. In other saying, to cause the confusion, a similar sign should be used for same or similar goods and services.[328] Different approachments exist in the doctrine about what should be understood from the notion of "similar goods or services".

According to Article 9 of the RIIPC, *"goods or services for which application is filed in shall be classified as per the procedures stipulated under The Nice Agreement in accordance with Article 11 of the IPC"*. However, the Nice Agreement should not be taken into consideration to determine as to whether products are similar or not.[329] In accordance with the provision under first paragraph of Article 2 of Nice Agreement, the classification made should not be binding on the evaluation of the protection limits provided for any registered trademark. Since the classification stated under this Agreement does not set out the limits of the protection of trademark rights, but only assists in the registration of trademarks.[330] Therefore, the determination as to whether there is a similarity on goods or services shall be based upon relevant consumer segment.[331]

2.3.2.1. The Same or Same Kind of Goods and Services

As mentioned previously, according to Article 11/3 of the IPC, during the trademark registration application; the trademark shall be classified in accordance with "Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks", which was ratified by the decision of the Council of Ministers dated 12/7/1995 and numbered 95/7094 for our participation. In this

[328] Özkan, p.32.

[329] Tekinalp, p.442.

[330] Dirikkan, p.180.

[331] Tekinalp, p.442.

context, the Turkish Patent and Trademark Office has issued "the Communiqué Concerning the Classification of Goods and Services Related to Trademark Registration Applications". In accordance with second paragraph of Article 3 of the Communiqué, the registration application for any goods or services stated under the general heading of any group shall be assumed to has been filed for other goods or services within the group and shall be assumed as to be the same type of goods or services.[332]

Regards to application for registration of goods of which the general definition is made, it is assumed that such application has been applied to all goods included in that heading (in other words general heading). However, there is no regulation in Turkish Trademark Law stating that in case that trademark is registered for a class, this registration will be applied all goods and services in related class.[333] The registration application for certain goods and services in any sub-group without using the heading shall be assumed to be the same type of proucts for other goods or services within this sub-group, whereas for the other sub-groups of the same class, it would be appropriate to consider it as similar goods and services.[334]

By phrase of "the same goods and services", principally, is meant that the goods and services included in the commodity lists of the trademarks are stated and expressed in the same way. However, it shall be considered as the same, even if it is not expressed by using synonyms of the same goods or services, or even if it is expressed in the foreign language where the name in the foreign language is used by the public internally.[335] In

[332] Küçükali, p.106.

[333] Öztek, S. (2007). *556 Sayılı KHK'da Benzer Mal ve Hizmetler* (Similar Goods and Services in the Decree-Law Numbered 556), Istanbul: İstanbul Barosu Dergisi, Fikri ve Sınai Haklar, Special Issue 4, July, p.220.

[334] Öztek, p.216; Küçükali, p.117.

[335] Sekmen, O. (2013). Markanın Hükümsüzlüğü ve Hukuku Sonuçları (Invalidity of Trademark and Its Legal Consequences), Ankara: Bilge Yayınevi, p.123; Çolak, p.253; Türk Patent ve Marka Kurumu. (Turkish Patent and Trademark Office.) (2015). Kılavuz, p.119.

addition, in the circumstances where the same goods or services have two or more name or the name in the market is different from the technical or scientific and literary name, even if they are expressed differently, those shall be considered the same.[336]

2.3.2.2. Similar Goods and Services

The trademark is not only protected against usurpation and infringements in the field of goods and services registered for, but also against usurpation and infringements in the field of similar goods or services.[337] The use of a similar trademark on same goods and the use of a same or similar trademark on "similar" goods or services shall cause to likelihood of confusion. The definition of "similar goods and services" has a broader scope than that of the definition of "the same or the same kind of goods and services" and includes the same kind of goods and services in absolute terms. In addition to this, the notion of similarity, which has a broad meaning, refers to the goods and services on which an opinion formed by the consumers that these have a connection and are originated from the same source.[338] In this context, Paragraph 4 of Article 3 of the Communiqué states that the numeration in the classification should not have certainty in the determination of "similar goods and services". As a matter of fact, Article 11/4 of the IPC states that *"goods or services shall not be presumed as being similar on the ground that they are in the same class, and goods or services shall not be regarded as being dissimilar on the ground that they are in different classes"*.[339]

[336] Kılavuz (Guide), p.119.

[337] Öztek, p.208.

[338] Kılavuz (Guide), p.119.

[339] Suluk, and others, p.185.

The similarity of products related to the likelihood of confusion may, as per understanding of relevant consumer segment, occur in goods that are economically close to each other or in services that are economically close to each other. For instance, it is possible to mention on similarities if there are common points such as the usage form of the goods, their features, their substitutability and complementation of each other.[340] In the circumstance where goods or services that are close enough to the extent that it is assumed by the relevant purchaser segment that there is a connection between the two businesses, the likelihood of confusion may be expected for those goods and services.[341]

In particular, in determining whether goods and services are similar, it should be examined whether those appeal to the similar purchaser segment and whether they are used to meet similar needs.[342] The market approach and the likelihood of confusion by public shall be taken account as basis with regard to the similar goods and services. The higher similarity ratio between goods means the higher confusion.

What similar goods and services are, and which of them are similar are not specified in a legal regulation. *Tekinalp* states that the determination of the notion of "similar" could be based on neither the international classification of trademarks nor the classes which are reflected by such international classifications to the national legislation[343]; *Yasaman* states that similar goods and services can be identified thereunder classes and subgroups identified during registration.[344] *Arkan* claims that the registered figure of trademark and the list of goods covered by that registration shall be based on,

[340] Tekinalp, p.442.

[341] Dirikkan, p.170.

[342] Arkan, 1997, p.102.

[343] Tekinalp, p.443.

[344] Yasaman, p.397.

since only the registered figure of the trademark is under the protection.[345] In a decision issued in 2006 about the "PAPATYA" trademark, the General Assembly of the Court of Cassation ruled that in examining the class similarity in terms of products in different sub-groups, a decision should be made by taking into consideration the market understanding of products, addressing similar buyer environments, being used to meet similar needs, end-users, being able to be substituted instead of each other, having competitive opportunities, usage purposes, having the possibility of completing one another, common distribution channels, usage methods and targeted public segments.[346]

With regard to the protection of the trademark, shall be subject to a one-stage examination since there is a connection among the notion of similarity between signs and goods or services, and notion of likelihood of confusion. Similarities shall be evaluated collectively without evaluating them separately and the problem shall be solved in one-stage. In the protection of the trademark, the risk of confusion is a stand-alone measure and its most important element is the similarity between signs and similarity between goods or services. The similarity examination of those separately will cause to an artificial distinction; the similarity between the sign and trademark and the similarity between the goods or services shall be evaluated within the boundaries of the principle of mutual exchange/inter-mutation and complementarity, to provide fair trademark protection according to the characteristics of the concrete event. Since the likelihood of confusing is closely connected to these two elements.[347]

The CJEU stated that, in the examination of the likelihood of confusing, initially it shall be determined as to whether the goods were similar to each other and if there were

[345] Arkan, 1997, p.102.

[346] The Verdict of the General Assembly of Court of Cassation dated 07.06.2006, case no. 2006/11-338, decision no. 2006/338, *available at:* www.kazancı.com (visited at: 08.10.2019).

[347] Kılavuz (Guide), p.119.

similarities, the similarity of the trademarks shall be researched on and then it shall be decided on the likelihood of confusing. The CJEU does not examine the similarity of trademarks and goods at the same time, initially it evaluates the similarity of the goods, and if there are similarities, it conducts a two-stage examination of the similarity of signs.[348]

2.3.2.3. Classification of Goods and Services Under Nice Agreement

As mentioned earlier, in the registration of the trademark, The Nice agreement on which class of goods or services the application is made for is of great importance. This agreement provides that the countries implementing the agreement shall establish a common classification system of goods and services for the purpose of registration of trademarks, and that the alphabetical listing of each goods or services shall be arranged by specifying the class in which they are included.[349]

Although the Nice Agreement is taken into consideration as a rule in determining the type or similarity of goods or services, goods or services are considered similar even in different classes when there is a likelihood of confusion among the public. If there is likelihood of confusion by the public, the first trademark owner must also have the right to objection for goods or services in different classes and groups due to likelihood of confusion.[350] Even if the classification is accepted as the essential system, the protection limit of the registered trademark must be determined according to the nature of the each concrete dispute.[351] The criteria to be considered here is whether the public is likely to be

[348] Dirikkan, p.191; *see:* CJEU, Judgment of the General Court (Second Chamber) of 15 January 2003, *Mystery*, T-99/01, ECLI:EU:T:2003:7.

[349] Tekinalp, p. 442.

[350] Arkan, 1997, p.102.

[351] Yasaman, p.779.

confused. Indeed, the 11th Civil Chamber of the Court of Cassation stated in the case of the request for the registration of "CASAMIA" for the use of products similar to the registered trademark "CASA", in determining likelihood of confusion while situation and data related to the concrete event should be evaluated together and the decision should be made according to the result of the evaluation, it is not sufficient to evaluate based on classification solely on the grounds that the trademarks are registered for different classes.[352]

The classes established under the Nice Agreement on the registration of goods and services are only an aid in determining the similarity of goods and services. Article 9, paragraph 2/a of the Trademark Law Treaty[353], which aims to standardize and regulate national and regional trademark procedures, states that it cannot be said that goods or services are similar to the reason that goods or services are in the same class according to the Nice classification in any registration or publication by the office; in the continuation of the same paragraph, it is indicated that it cannot be assumed that goods and services are in different classes and are not similar. Similar arrangements take place in Article 1 and 4 of the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks[354] which also Turkey is a signatory.[355]

As a matter of fact, the Court of Cassation abandoned the view, which have been established for a long time, that service marks and trademarks cannot raise likelihood of

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[352] *see:* The Verdict of the 11th C.C. of Court of Cassation dated 05.02.2007, case no. 2005/13645, decision no. 2007/1319, *available* at*:* www.kazancı.com (visited at: 08.10.2019).

[353] Trademark Law Treaty, adopted Oct. 27, 1994, *available:* http://www.wipo.int/cfdiplaw/en/laws_treaties/index.htm (visited at: 08.10.2019).

[354] Vienna Agreement Establishing an International Classification of the Figurative Ele- ments of Marks, June 12, 1973, as last revised Oct. 1, 1985, *available:* http://www.wipo.int/cfdiplaw/en/laws_treaties/index.htm (visited at: 08.10.2019).

[355] Küçükali, p.60.

confusion between each other. Although the previous opinion of the 11th Civil Chamber of Court of Cassation which is the same trademark can be registered as a trademark of goods and service mark on behalf of separate persons, there has been a change of opinion since the application of the same trademark may raise likelihood of confusion, especially in cases where certain goods and services within the trade and service classes are intertwined. In the "Çelebi" decision of the Court of Cassation in 2005, it is assumed that when the sign which is the same or similar to a trademark related to ready-to-eat products is used as a service mark for catering services by someone else, it will create likelihood of confusion.[356]

2.3.3. Evaluation of Confusion According Consumers

Consumers play a significant role in determination of the confusion. In order to determine the confusion, it is very important to which group of consumers that the goods appeal to, since the existence of the confusion shall be determined whether there is likelihood of confusion according to type of consumer to which it appeals. In the likelihood of confusion, only the similarity among signs or products is not sufficient, and this situation shall cause to the confusion of the average consumer, in other words, the consumer's preference due the similarity or the confusion must be affected.

In Article 7/2-b of the IPC, it is also stated that "there shall be a likelihood of confusion by the public, and the examination of what is to be understood from the notion of the public, who is the respondent of the risk of confusion, is required.". In both the doctrine and the judicial decisions, instead of using the notion of the public, the expression of the average consumer segment is used, although these differ in wording,

[356] Öztek, p.223; *see:* The Verdict of the 11th C.C. of Court of Cassation dated 22.09.2005, case no. 2005/8113, decision no. 2005/8579, *available at:* www.kazancı.com (visited at: 08.10.2019).

these have the same meaning legally.[357] The average consumer varies according to the segment that the product or service appeal to. If goods or services appeal to children, the average consumer is children; if it appeals to women, this segment is women, if it appeals to an expert consumer segment, then such segment is taken into consideration. This consumer segment shall be a conscious consumer segment.[358] If there is a misconception that there is a similarity or a connection between trademarks or signs to which appeal to the consumer segment, it shall be concluded that there is likelihood of confusion. Where the consumer's attention level is high, likelihood of confusion is considered to be decreased, where the consumer's attention level is low and it is one of goods and services appeal to the usage of every type of segment, the likelihood of confusion is considered to be increased.[359] For instance, it has been decided by the Court of Cassation with regard to the drug trademarks that; there is no confusion between the trademarks of Novartis and Novitas[360], with the justification that the consumer segment, whom these trademarks appeal, is conscious and diligent.[361]

Factors, such as culture, the socio-economic group to which the consumer belongs, personal ties and the intended use of the product, are effective to the decision of the consumer. Especially consumers at the age of fifty and older with high trademark loyalty in food products are more suspicious of product trademarks in retail sales.[362]

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[357] Bilge, M. (2015). *Marka ve Ticaret Unvanı Arasında İltibas*. (Confusion between Trademark and Trade Name.) Ankara: Ticaret ve Fikri Mülkiyet Hukuku Dergisi, Volume 1, Issue 2, p.74; Küçükali, p.118; Yasaman, p.399; Dirikkan, p.189.

[358] Dirikkan, p191.

[359] Bilge, p.74.

[360] The Verdict of the 11th C.C. of Court of Cassation dated 30. 06. 2014, case no. 2014/149, decision no. 2014/12540, *available at:* www.kazancı.com (visited at: 09.10.2019).

[361] Suluk, and others, p.188.

[362] Karahan, p.104.

However, the average consumer are under a greater confusion risk in such kind of products, unlike high-value goods, which are often not purchased.

The similarity of goods related to likelihood of confusion; might occur in goods which are economically close to each other. If the average purchaser cannot assume any economic connection between the parties and cannot make a comparison with the well-known trademark, such circumstance shall be taken in consideration and limit of confusion risk shall be determined. An evaluation shall be made with objective criteria with regard to the use of goods, their benefits, characteristics, competitiveness or substitutability of each other, complementary to each other, presence of goods of similar nature with respect to production and distribution sites; in the circumstances where there are common points to create the idea in the purchaser that it originates from the same business, and the trademarks shall be considered similar by taking into consideration of the changes in the economic life. The hollistic realization of all of these criteria is not a condition, but it is sufficient to have a common point to the extent to accept the existence of the likelihood of confusion. Goods or services do not necessarily belong to competing companies for the likelihood of confusion. The relevant environment to who the product or service appeal is also important in Court of Cassation and CJEU decisions.[363] In the case of "CAMSİL", the Court of Cassation ruled that the level of care of housewives, servants and responsible persons who will use both goods will be taken into account in determining the likelihood of confusion.[364]

The relevant consumer segment, mentioned in CJEU and OHIM decisions[365]; consists of moderately informed, observing reasonable and careful, average consumers.

[363] Dirikkan, p.179.

[364] The Verdict of the 11th C.C. of Court of Cassation dated 27. 09. 1979, case no. 1979/4091, decision no. 1979/4234, *available at:* www.kazancı.com (visited at: 09.10.2019).

[365] See: CJEU, Judgment of the Court of 11 November 1997, *Sabel*, C-251/95, ECLI:EU:C:1997:528; CJEU, Judgment of the General Court of 06 July 2012, *Royal Sheakspear*, T-60/10, ECLI:EU:T:2012:348;

It shall be considered that the average consumer is rarely able to make direct comparisons between different trademarks; however, the average consumer's trust in the trademark is based on the missing image of the trademark that s/he holds in her/his memory.[366]

However, while making an evaluation on the likelihood of confusion, it is not expected that the entire target consumer will fall into confusion. The fact that even a part of the consumer segment faces such a risk is sufficient for the existence of confusion.[367] Furthermore, it is not accurate to identify the consumer segment as the actual buyers. Since potential purchasers are also included in the consumer segment which is the respondent of the trademark or the sign, the potential purchasers shall be also taken in consideration while evaluating the likelihood of confusion.[368]

2.3.3.1. Goods or Services on Which Trademark Labelled Appeal to the Group of Consumers in Every Segment

If goods or services, which intended for cheap and daily consumption, such as in the examples of bottled water and tissue paper and toothpaste, appeal to a consumer group in every segment, the recognition and confusion among the wider public segment shall be sought.[369] In such circumstances, if a product or service appeals to all purchasers, not to a particular consumer segment, the segment to be considered in the evaluation of

Decision of the OHIM Grand Board of Appeal of 16 January 2016, R 3135/2014-2; Decision of the OHIM Grand Board of Appeal of 18 July 2013, R 233/2012-G, and others.

[366] Yasaman, p.155.

[367] Bilge, p.74; *see:* The Verdict of the General Assembly of Cassation dated 07. 06. 2006, case no. 2006/11-338, decision no. 2006/338, *available at:* www.kazancı.com (visited at: 10.10.2019).

[368] Dirikkan, p.180.

[369] Kılavuz (Guide), p.138.

confusion is the "average purchaser/consumer", "medium intelligence purchaser" or "medium consumer".[370]

As a result of the remaining traces and indications in the mind of consumer who has purchased product, s/he uses the remaining traces in her/his mind when s/he searches for that trademarked goods in the latter shoppings. Basing on such consumers, who are satisfied with the previous goods in their subsequent shopping and then review such goods or services, it is determined as to whether there is an audio, semantic, visual or formal similarity between the trademarks.[371]

Karahan states that since some of the average consumers are unconscious, it is necessary to distinguish between the average consumers and only the opinions of the conscious ones shall be taken as criteria. Since it is important for unconscious consumers to buy the goods, the trademark does not have any importance in their preferences. Not all of the average conscious consumers need to make a mistake or be deceived, but the existence of the likelihood of a part of them being deceived is sufficient. The characteristic of the average consumer is that s/he perceives the trademark as a whole and does not go into detailed examination. It is assumed that the average consumer is well-informed, careful and prudent in her/his evaluation of the trademark as a whole.[372] *Tekinalp*, on the other hand, stated that the hollistic impression obtained by the consumer with average attention, who will purchase the goods and services, during the purchase period, which diversified in regard to the quality of goods or services, shall be taken as basis herein.[373]

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[370] Poroy, R./Yasaman, H. (2001). Ticari İşletme Hukuku (Law of Commercial Enterprise), Istanbul: Vedat Kitabevi, p.355; Arkan, 1997, p.103; Epçeli, p.46; Küçükali, p.119.

[371] Karahan, p.102.

[372] Karahan, p.105.

[373] Tekinalp, p.448.

The average consumer profile is important in determining the actual behavior as well as determining the normative conditions for the attention required by the circumstances. The consumer does not act carefully in daily consumption goods. Such situation is different for specialties goods appeal to consumers and goods appeal to occupants. The determination of the likelihood of confusion in specialties goods such as high value machines, automobiles requires attention. Since these are researched by the respondents diligently, tested and then purchased. Herein, the approach of an ordinary person can not be based on.[374]

In Europe, the "consumer" type, developed by the CJEU, is normally informed, sufficiently cautious and is the reasonable average consumer type.[375] Such type of consumer, framed by the CJEU, is binding in terms of unfair competition and trademark law in the member states and should be used as a criterion to determine likelihood of confusion. What is decisive in relevant consumer segment is the impression and opinion of the non-trivial part of that segment. In addition, the registration of foreign trademarks should be on the basis of opinions and impressions of average consumer in the country where the trademark is registered.[376]

2.3.3.2. Goods or Services on Which Trademark Labelled Appeal to A Special Group of Consumers

The consumers of some products that are put on the market may be certain groups of people. In this circumstance, the impression of this special group of persons is

[374] Dirikkan, p.190.

[375] Uzunallı, p.96; *see:* CJEU, Judgment of the Court of 22 June 1999, Lloyd Schuhfabrik Meyer, C-342/97, ECLI:EU:C:1999:323.

[376] Uzunallı, p.96.

important in the likelihood of confusion on similar goods or services.[377] If a product or service appeals to a particular segment rather than to all consumers, then such consumer segment to which such goods or services appeal shall be considered while evaluating existence of the confusion.[378] For instance, if goods or services appeal to only children, then children shall be taken into consideration when evaluating the existence of the confusion among trademarks related to such goods or services.[379] The wheelchairs, which are used by disabled patients, and hearing aids, decisionh are produced for hearing-impaired people, are only related to these persons and their relatives, or paint brushes and paints are also of interest to painters.[380] In this context, the recognition of the trademark shall be determined by considering relevant group of concerned persons, not the whole society.[381] Since not everyone living in a country is interested in all kinds of goods and services, it is not appropriate to consider irrelevant groups in determining the recognition of trademark.[382]

Also in case the goods or services appeal to a certain segment, while determining the likelihood of confusion, a conclusion shall be made by considering the average knowledge and experience of consumers in such segment.[383] If the goods or services with similar signs appeal several special groups of consumers, such as age groups or in different educational levels, the confusion of the signs by one of these groups of

[377] Epçeli, p.47.

[378] Yasaman, p.399.

[379] Karahan, and others, p.197.

[380] Küçükali, p.123; Dirikkan, p.125.

[381] Yasaman, p.261.

[382] Küçükali, p.123.

[383] Karahan, p.106.

consumers shall be sufficient.[384] For instance, the confusion of the rope and hook equipment, used in both mountaineering and fishing, by the consumers in only one of these two special segments shall be sufficient.[385]

In the Decision[386] of the Court of Cassation, in which the evaluation was made with regarding likelihood of confusion between trademark of plaintiff "ÜLKER HOBİ" and trademark of defendant "ÜLFET LOBİ", a conclusion was made that there is no specific difference between the trademarks of the litigation parties, there is a likelihood of misapprehension and confusion of the plaintiff's product with the defendant's product by children who are special segment of consumers, and it was decided to cancel and remove the defendant's trademark "ÜLFET LOBİ" and the initiated lawsuit was accepted. In other words, the Court of Cassation considered that there was a likelihood of misapprehension of children who were the special consumers of products bearing the trademark which was subject matter of the case and likelihood of confusion of children between these two trademarks.[387]

In addition to this, if expensive goods such as automobiles are to be purchased, then it must be acknowledged that purchasers will show particular diligence. In the purchase of precious goods, the trademarks are examined more carefully by the customers and this situation should be taken into account while determining as to whether confusion occurs or not. For instance, when evaluating confusion risk between luxury British car

[384] Cengiz, D. (1995). Türk Hukukunda İktibas Veya İltibas Suretiyle Marka Hakkına Tecavüz (Infringement of the Trademark Rights by means of Quotation or Confusion in Turkish Law), Istanbul: Beta Publications, p.32; Arseven, p.146; Epçeli, p.47.

[385] Yaşar, A. (2016). Marka Hukukunda Karışırılma İhtimali. (Likelihood of Confusion in Trademark Law.) Istanbul: İstanbul Ticaret Üniversitesi Dış Ticaret Enstitüsü Uluslararası Ticaret Hukuku Ve Avrupa Birliği Anabilim Dalı Uluslararası Tıicaret Ve Avrupa Birliği Hukuku Programı, Doktora Tezi (PhD Thesis), p.131.

[386] The Verdict of the 11th C.C. of Court of Cassation dated 30.11.1999, case no. 1999/5356, decision no. 1199/9805, *available at:* www.kazancı.com (visited at: 10.10.2019).

[387] Karahan, p.106.

trademark "ROLLS-ROYCE" and another luxury car trademark, basing on the understanding of an ordinary purchaser shall not be accurate. Since such kind of goods are purchased after being diligently researched by the purchasers that these appeal to.[388]

2.3.3.3. Goods or Services on Which Trademark Labelled Appeal to A Group of Expert Consumers

If a trademark of goods or services appeals to an expert consumer segment rather than the average consumer segment, even small differences may be sufficient to avoid confusion, since these persons will be considered to pay more attention and care while selecting products bearing the trademark.[389] The goods and services bearing a sign which is similar to trademark of the goods or services on the market, sometimes have a consumer segment who has expertise. In this circumstance, the impression and response of this target segment who has expertise is important to detect the likelihood of confusion of the signs. This segment who has expertise has to be more attentive and selective in the purchase of goods and services than that of other groups of consumers.[390]

When determining the opinions and preferences of the expert consumer groups, the attention and care that should be given to the extent of their expertise when purchasing goods or services should be taken as a criterion. Since these persons have special knowledge about the goods and services related to their area of expertise and are obliged to pay attention and care required by their expertise when purchasing goods and services.[391] Such kind of special quality goods and services are being carefully

[388] Özkan, p.43.

[389] Karahan, p.107.

[390] Arseven, p.146.

[391] Cengiz, p.32.

researched, tested and subsequently purchased by their respondents; it is not accurate to take into consideration of the understanding and approach of an ordinary person in evaluating the likelihood of confusion between such kind of goods.[392]

In terms of goods that appeal to expert groups of consumers, it is particularly useful to examine pharmaceutical trademarks. In medicines, purchasers are more cautious and careful due to importance of human health and body integrity. Most of the medicines are sold by prescription, and some of these can be sold in supermarkets and pharmacies without a prescription. In prescription medicines, the likelihood of confusion might be reduced or even disappeared since pharmacists and doctors will be considered as the relevant social segment; for medicine trademarks that are not obligatory to be sold by prescription, the likelihood of misapprehension of medium-skilled consumers is taken into consideration, but not such expert group.[393]

In some of the earlier decisions[394] on this issue, the Court of Cassation did not take into account the possibility of mistaken of the expert group as many drugs that should be sold by prescription in practice are sold without prescription in our country. However, in the Decision[395] of the Court of Cassation, with regard to the evaluation of the existence of the confusion between the trademarks "LİPİDİL" and "LİPİDROL", it appears that the Court of Cassation changed its approach with regard to this. The Court of Cassation stated that likelihood of confusion does not exist between these pharmaceutical trademarks, that these products appeal to the conscious consumer environment and therefore the respondent environment can distinguish between the two trademarks. In this respect,

[392] Arseven, p.146; Arkan, 1997, p.103; Dirikkan, p.190.

[393] Dirikkan, p.190; Arkan, p.103; Cengiz, p.32.

[394] The Verdict of the Comercial C. of Court of Cassation dated 22.06.1954, case no. 53/3804, decision no. 4715, *available at:* www.kazancı.com (visited at: 10.10.2019).

[395] The Verdict of the 11th C.C. of Court of Cassation dated 13.01.2003, case no. 2002/7864, decision no. 2003/48, *available at:* www.kazancı.com (visited at: 10.10.2019).

Cengiz criticizes the decision; it stated that it was not accurate to conduct other legal evaluations by basing on an actual situation contrary to the law. What is accurate is to prevent the unlawful de facto situation which causes important health hazards. Therefore, in order to determine as to whether there is a confusion of the trademarks labelled on the medicines, which are required to be sold by prescription due to the legal regulations, an evaluation shall be made by basing on legal regulations and the affections of doctors and pharmacists shall be taken into consideration.[396]

3. CRITERIAS USED FOR DETERMINATION OF CONFUSION

3.1. Criterias in General

There is no obligation to research on existence of confusion among public in terms of signs that are same or indistinguishably similar. In other words, there is no need to prove existence of the confusion between identical trademarks and signs.[397] The research and determination of the existence of the likelihood of confusion will be conducted only in where a similarity exists between the registered trademark or the trademark of which registration application is made and the sign which is alleged to infringing the trademark right. Where the existence of similarity both between trademarks and signs, and goods and services are proved, no further examination is required for the existence of confusion in terms of commodities or signs.[398]

If there is not a complete harmony between the trademarks consisting of letters, words or numbers, between the related element and trademarks consisting of signs, and

[396] Cengiz, p.33.

[397] Epçeli, p.49; Arkan, p.75; Yasaman, p.777; Küçükali, p.124.

[398] Küçükali, p.125.

if the signs are not the same, the similarity aspect should be researched. In case the average consumer detects this difference, and in case there is a difference between the signs as sound, meaning or spelling format, and then the identity will disappear. When the typing style is not unique, even if the typing characters are different, the identity of the signs, which are trademarks, in terms of same meaning and sound, is accepted. The identity can also be created by decreasing the size of the trademark or contrary, by increasing the same. When the colors of the original trademark are used differently in the used sign, it is necessary to determine as to whether the average consumer will understand such difference. In case of similarity, as to whether there is any likelihood of confusion is examined by making a research on similarity.[399]

According to *Tekinalp*, the first condition for the likelihood of confusion by public is trademark of which application is made, is the same or similar to the trademark previously registered, and the other condition is that both two trademarks are used in the same goods and services. The public who is consumer shall be considered in the measure of confusion, but not the person interested or any expert.[400] What is important in the likelihood of confusion is that the public makes any connection between these two signs for any reason. Herein, an audio or visual similarity and even its connotation should be a sufficient measure for likelihood of confusion. If there is no identical sameness in terms of the auxiliary element of the trademark, if there is a difference in audio, visual and conceptual terms and if the average consumer can distinguish the signs from the overall impression, it should be decided that the trademarks are not similar.[401]

When the 11th Civil Chamber of the Court of Cassation evaluates the criteria for determining on likelihood of confusion, it considers hollistic (globally) impression.

[399] Arkan, p.101.

[400] Tekinalp, p.437.

[401] Küçükali, p.125.

Determination of the similarity between the trademarks is made by considering the effect of the trademark as a whole. There are trademarks, despite consisting of different elements, that may make an impression as a whole that causes the connotation of the previous trademark, but on the contrary, there are trademarks, despite consisting of similarity in terms of elements, that may make different impression entirely. What is essential in the confusion is the perception of average consumer.[402] In order to accept confusion possibility, that is sufficient if some of average consumer segment is at the risk of confusion, even if not all of such segment.[403]

Regarding to established case law of CJEU; the evaluation of the likelihood of confusion shall be made holistically, in other saying globally, shall be based on the evaluation of the similarity of one trademark to another, thus on the evaluation of the distinctive and introductory parts of the trademark generated in the mind by the sign in terms of visual, audial and conceptual. The essential function of the trademark is to distinguish the goods or services on which the trademark is labelled from goods and services generated from other different sources without any confusion and to indicate to the end consumer the origin of the goods or services. The criterion sought herein is that there is likelihood of confusion in the public with the assumption that goods or services are the products of the same business within the meaning of Article 8/1-b of Regulation on Community Trademark numbered 2017/1001 or that there is an economic connection between the businesses.[404]

Another important point is the circumstance where the person, who demands the registration of a trademark consisting of a sign in which elements of previous registered trademark or trademarks are used wholly or partially, without the purpose of causing the

[402] Arkan, p.99.

[403] Tekinalp, p.443, Karahan, p.93.

[404] Küçükali, p.127.

effect of confusion, without using such sign under that intention, but although s/he does not demand such result, the likelihood of confusion may arise in case of the risk is caused. Since in the occurrence of the likelihood of confusion, neither the intention nor the fault is required. Even if no fault is found, the removal of the latter sign which cause the confusion and the prevention of the infringement are required.[405]

In examining the likelihood of confusion, the followings may be determiner; what the impression of trademarks is as a whole, whether the goods and services are the same or similar, whether the trademarks are the same or similar, whether the similarity of goods and services are more or less, and how one's minority is compensated by the abundance of the other, to what extent the trademark has a distinctive element, what the target consumer segment is in terms of goods or services and accordingly who the average consumer is, the extent of the average consumer's attention in the concrete event, whether there is a recognition, if there is the likelihood of connotation whether such connotation cause the likelihood of confusion in the concrete event, whether there is an operational connection impression or serial trademark perception.[406]

3.2. Criteria of Distinctiveness

The distinctiveness regarding to signs to be registered as trademarks, which is sought according to the IPC, was aforementioned. It is irrelevant as to whether the distinctiveness, which is to be used as a criteria in evaluation of confusion, is obtained at the time of registration application or resultly after use. The trademark enables to distinguish origin of any goods or services on market from origin of any others. Such distinctiveness must be in the form of a distinctive element which does not allow for the

[405] Küçükali, p.129.

[406] Çolak, p.199.

likelihood of confusion in goods or services.[407] While a trademark indicates that the goods or services belong to a particular business, the perception of that trademark by the relevant consumer segment and the customary use of it as an origin sign in the relevant sector are important in determining this belonging.[408]

The distinctive nature of a trademark shall be evaluated by considering as to whether the persons, who are the consumers of the goods and services, will perceive this sign as the goods or services of a particular business, by such goods and services requested to be registered. As a result, these evaluations will lead us to the distinction of strong trademarks and weak trademarks, although these is no such distinction in the legal literature. That distinction is important in determining the scope of protection provided to the sign registered as a trademark, since the higher distinctiveness of a sign means more comprehensive protection will be provided to it.[409] In this context, signs with strong distinctive element are protected against the confusion in a wider scope; however, signs with weak distinctive element are protected against confusion in a narrower scope.[410]

3.3. Strong Trademark – Weak Trademark

The distinction between strong and weak trademark has no legal basis, but this distinction is decisive in terms of the scope of protection provided to the trademark.[411] In other words, the stronger distinctiveness of an identification sign, the more comprehensive protection is provided to it. It is observed that a distinction between "weak

[407] Tekinalp, p.343.

[408] Küçükali, p.129.

[409] Arkan, p.100.

[410] Bilge, M. (2014). Ticari Ad ve İşaretler Arasında Karıştırılma Tehlikesi. (Risk of Confusion between Trade Names and Signs.) Ankara: Yetkin Yayınları, p.65.

[411] Cengiz, p.22; Epçeli, p.51.

trademark" and "strong trademark" is applied in both the doctrine and the OHIM and CJEU practices. In this sense, the "weak trademark" is a trademark that has a low distinctiveness as per the goods and services that they have registered to. However, the "strong trademark" is a trademark that has a high distinctiveness as per the goods and services.[412]

Regarding to determination of the confusion in trademarks, in case the trademark has strong distinctiveness, a strong trademark can be mentioned. Strong and well-known trademarks have a wider range of protection than that of the weak trademarks. In other words, the higher distinctiveness of the trademark, i.e. the stronger the trademark, the greater the likelihood of confusing.[413] The distinctive element is usually, but not necessarily, determined by market research. Other criteria shall be taken into account, which are the usage intensity of sign, the geographical extent and duration of usage, amount of investment made for this purpose, and reports of chambers of commerce and industry or other tradesmen and professional companies.[414]

The distinctive character of latter trademark shall be further evaluated. If the previous trademark has a weak distinctiveness and the latter trademark is a strong trademark, it shall be accepted that the confusion risk may decreases where possibility of sign and product similarness is low.[415]

For composite trademarks consisting of more than one word, the weakness or absence of distinctiveness may also apply to any of the elements. In this case, it will only be considered that there is no likelihood of confusion only with respect to that element. For example, in the examination between "ULUDAĞ ZERO" and "COCA COLA

[412] Arkan, p.100; Çolak, p.232.

[413] Çolaj, p.232.

[414] Küçükali, p.131.

[415] Yaşar, p.143.

ZERO", the Court of Cassation ruled that "zero" is unlikely to be confused on the grounds that it is not distinctive for the class of liquid beverages.[416]

3.4. Acquisition and Loss of the Distinctiveness as A Result of Use

3.4.1. Acquisition of the Distinctiveness as a Result of Use

The distinctiveness can exist at the time of registration of the sign, or can be required distinctiveness acquired afterward use.[417] The Article 5/2 of IPC regulates with regard to the use of a trademark before the application date and the goods and services which are subject matters of application that in case trademark has acquired a distinctiveness through its use, that trademark shall be registered. Such mentioned provision protects the status of a trademark where it did not have a distinctive element at the beginning and as a result of its use, it has reached the level that can be perceived as a trademark by the relevant consumer segment.[418]

The registration of a sign which has acquired the distinctiveness through its use cannot be prevented by the previously registered trademark owner.[419] The acknowledgment that the sign has acquired a distinctiveness power in the market is possible by forming an opinion in all segments of the relevant market or in a significant

[416] The Verdict of the 11th C.C. of Court of Cassation dated 17.09.2013, case no. 2012/2652, decision no. 2013/15309, *available at:* www.kazancı.com (visited at: 11.10.2019).

[417] Goldstein, p.422.

[418] İmirlioğlu, D. (2017). Marka Hukukunda Ayırt Edicilik ve Markanın Ayırt Ediciliğinin Zedelenmesi (Distinguishing Nature and Impairing the Distinguishing Nature of the Trademark in Trademark Law), Ankara: Adalet Publishing House, p.28.

[419] Küçükali, p.133.

portion of these segments that the trademark indicates an origin. *Tekinalp* considers that acquiring the distinctiveness among the majority of the market concerned is sufficient.[420]

There is no provision in the IPC as to how the use shall be made for the subsequent acquisition of distinctiveness. Therefore, the conditions and determination of the distinctive character as result of use shall be determined in each concrete event according to the nature of the event. In this sense, while determining the distinctiveness, public opinion surveys shall be carried out and interpretation of the researches conducted in the environment with the expert opinion should be considered.[421] In order for a sign to acquire the distinctiveness, it must become distinctive in the relevant market as result of use such sign in a certain period and intensity, attracted the attention of the consumer and identified with goods and services in relevant sector.[422] In fact that even if such sign indicates the characteristic or quality or quantity of a commodity, it will evoke the perception that the product originates from a particular business among consumers.[423]

The more ordinary a word or sign is, the more difficult it will be to become a trademark and acquire distinctive decision through its use. Since it is not possible to set certain criteria as to the duration and intensity of the use that will provide the distinctiveness, the judicial authorities will make an evaluation by basing on the concrete event. However, the investment made in the trademark, the frequency of demand and the quality of goods and services are important factors affecting the duration.[424] The duration required for acquiring the distinctiveness though the use is the period required for forgetting the descriptive nature of the phrase in the relevant society and standing out the

[420] Doğan, (2006), p.227.

[421] Dirikkan, p.135; İmirlioğlu, p.189.

[422] Küçükali, p.130; Dirikkan, p.135; Tekinalp, p.367.

[423] Çolak, p.38.

[424] Tekinalp, p.368.

loyalty to a business.[425] *Tekinalp* states that this period is around five years as per the dominant approach in the doctrine.[426]

There is a disagreement in the doctrine about the fact that expressions, which are of the common noun, which are available to the use of everyone, acquire a distinctiveness through their use. In other words, can the phrase pants be distinguishable in pants commodity though its use, can the phrase honey be distinctive in honey commodity though its use? In one opinion, the acquisition of distinctiveness through the use shall not be applied to any descriptive phrase. It is not legal to give to a person the monopoly of these phrases, which are the common noun that identifies the goods used, even if these have been used for many years and related advertisements are made with regard to its trademarks.[427] According to another opinion, no exceptions were made in the provision of the article for acquiring the distinctiveness through the use of expressions that have the character of the common noun. Therefore, it is not possible to exclude common nouns from this rule. It is also possible for such kind of phrases to be distinctive by the use. However, in determining the distinctiveness, a more rigorous search should be carried out for such phrases and a wider range of distinctiveness should be sought.[428] The CJEU also concluded that a sign may be registered as a trademark if it acquires distinctiveness to distinguish goods of one business from those of another business, even if such sign is available to public. The CJEU states that acquiring a distinctive nature has two conditions which are the abstraction and the connection to a business, in other words function of origin.[429]

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[425] Arkan, 1997, p.84.

[426] Tekinalp, p.368.

[427] Çolak, p.35; Arkan, 1997, p.83.

[428] Tekinalp, p.366; Bilge, p.67.

[429] Epçeli, p.103; Tekinalp, p.375.

3.4.2. Loss of Distinctiveness as a Result of the Use (Free Sign)

It is possible that a trademark or a sign that initially has the distinctiveness and later becomes a descriptive sign by losing such element and is perceived as a common noun in particular.[430] The trademark may become identical to goods since the trademark owner abandons her/his work, the other persons uses this trademark or since the trademark owner neglects to protect her/his rights, s/he does not react or late intervenes against the use of her/his trademark by others or the trademark owner makes her/his trademark to the subject of many licence agreement or due to the intense advertisement campaigns conducted.[431] In such a circumstance, a trademark must have gone so far as to become a free sign that it should be accepted that this sign will not lose such character today and in the future and it shall not acquire its distinctiveness again, after conducting a consultation with all relevant public segment.[432]

In the determination of the likelihood of confusion, if a registered trademark has become a common name by losing its distinctiveness as a result of the negligence or misuse, the confusion cannot be a subject any more due to the sameness or similarity, and the invalidity of the registered trademark shall be carried out. However, in case the behaviors of the owner of a trademark has not been effective in turning such trademark into a free sign by becoming a common name, then the invalidity of the trademark shall not be possible. However, since the distinctive element disappears, it can be assumed that the likelihood of confusion will not be a subject or will be subject in very low ranges in case a similar sign is demanded to be registered for the same or similar goods. Since the

[430] Arseven, p.90; Cengiz, p.25; Arkan, 1997, p.81; Epçeli, p.92.

[431] Arseven, p.90; Cengiz, p.26; Arkan, 1997, p.81; Epçeli, p.92.

[432] Karahan, p.132.

trademark has lost its function of indicating the origin and the likelihood of confusion has largely disappeared.[433]

3.5. Integrity Criteria in The Confusion

The trademark is a whole consisting of a combination of essential elements and auxiliary elements, except for those with one element, and is protected as a whole.[434] Therefore, the evaluation of the similarity and the likelihood of confusion between trademarks shall not be made by considering the word or figure elements separately of each other, but by considering the whole impression of all of its elements that generate the trademark,[435] since the consumer perceives the trademark as a whole, not by separating it into each elements. As an example, the Court of Cassation ruled in the decision[436] of "EVKUR", in the "EVKUR shopping centers" and "EVSHOP shopping centers" trademarks of the parties' phrases of "shoping centers" are auxiliary elements which do not haveany distinctive character, while the distinctive elements are" EVKUR "and" EVSHOP "phrases. However, in some trademarks, the shape element may be more dominant and distinctive. In this case, the examination should be done with emphasis on the shape. For example, the General Assembly ruled in the "KOSKA" decision[437] that although the word element in the trademarks is different, the old man figure in both of them is the main and distinctive element. In order to accept that the shape element is the

[433] Çolak, p.268.

[434] Arseven, p.142; Teoman, p.120; Cengıiz, p.28; Arkan, 1997, p.99; Epçeli, p.121; Küçükali, p.139.

[435] Brainbridge, p.634.

[436] The Verdict of the 11th C.C. of Court of Cassation dated 17.02.2006, case no. 2004/14154, decision no. 2010/1555, *available at:* www.kazancı.com (visited at: 13.10.2019).

[437] The Verdict of the General Assembly of Court of Cassation dated 22.05.2013, case no. 2012/11-1569, decision no. 2013/750, *available at:* www.kazancı.com (visited at: 13.10.2019).

dominant element, it must make a more distinct impression of the shape than the word element in the relevant audience and the average consumer. In this respect, features such as size of the shape and colors used should be evaluated together.[438]

In the likelihood of confusion, the trace of the trademark as a whole in the consumer memory is also important. Since consumers will not be able to picture both signs at the same time, the whole impression of the trademark will remain in their memory, not the details of the same.[439]

While the auxiliary elements in the trademark affect the general appearance of the trademark, the essential elements ensure its distinctiveness and are effective in the risk of confusion. If the auxiliary element has an original figure, the original figure is also protected and evaluated in the detection of the likelihood of confusion.[440] The importance of the integrity requirement in the trademark is necessary to determine as to whether the signs are similar. A sign that has no integrity and whose borders cannot be determined will be difficult to be distinguished from other signs.[441] Depending on the nature of the concrete event, although sometimes there may be similarities between the independent or dominant elements of the trademarks, these may have a completely different effect as a whole.[442]. Sometimes, even though there is no complete similarity between the independent elements of the trademarks, the impression that these make as a whole may cause these to be similar.[443] On the other hand, in terms of intangible distinctiveness in the trademark, the integrity that should be found among the elements is slightly different

[438] Çolak, p.236.

[439] Dirikkan, p.176; Tekinalp, p.407.

[440] Doğan, p.25.

[441] Cengiz, p.28.

[442] Çolak, p.200.

[443] Arseven, p.143, Cengiz, p.34, Arkan, p.99; Epçeli, p.122.

in terms of function. If the trademark is not noticed as soon as it is reviewed by the consumer segment, but it is understood as a result of long examination or thinking, then the sign used as a trademark does not have an element of integrity in terms of distinctiveness.[444]

3.6. Criteria of Recognation

The recognition of the trademark is also important in terms of the scope of protection while determining the likelihood of confusion. Because, recognition is an element that increases the distinctivene character of the trademark. Well-known trademarks are strong trademarks that more quickly recalled by consumers. Due to their strong and easy-to-remember nature, it is possible that the public will make false connections between trademarks. The consumer, who encounters a different trademark having only one element of a well-known trademark, will establish an intellectual connection between the two trademarks. Therefore, well-known trademarks should be provided with more comprehensive protection against the likelihood of confusion.[445]

Moreover, it is also important as to how the level of recognition is evaluated in determining the confusion. CJEU stated that while evaluating the likelihood of confusion, it shall be also researched on as to whether the previous trademark is a well-known trademark.[446] Since the more previously registered trademark is recognized, the more confusion between previous trademark and the latter trademark will be increased.

[444] Doğan, p.26.

[445] Dirikkan, p.167.

[446] Çolak, p.237.

3.7. Criteria of The Connatation of Signs Each Other

Although there is no similarity between the signs, if there is a connotation between these trademarks, in other words, if one sign connotate another, then the existence of the likelihood of confusion shall be also accepted. In other words, the consumer is at risk that her/his preference being affected by the idea that, due to the similarity of trademarks and goods, the origins of both goods are the same and belong to associated businesss.[447] The hollistic impression, which the consumer with average attention obtains during the period that s/he can allocate for the purchase of the good or service, is essential. The margin of error is high when the purchase period is shortened, and purchase of the goods or services carries the quality of daily work. The goods or services bearing a sign, which recall another sign on the goods or services the consumer intents to purchase, may be purchased. That sign here is not the same or similar. However, the sign that s/he reviews reminds the consumer the goods or services that s/he wants to purchase.

Although the connotation is not explicitly mentioned in the IPC, in case there is a connection, a connotation shall be also understood.[448] If we review such issue on a same example as we examined before, once the coffee trademark having the phrase "black sister/siyah bacı", with a picture of a young black girl in its package, and the coffee trademark having the phrase "arab aunt" with a picture of an old lady wearing glasses in its package is compared, it is obvious that there is no audial or visual similarity among these two signs. However, these will lead to confusion since these connotate each other.[449]

[447] Tekinalp, p.444.

[448] Tekinalp, p.444.

[449] İmirlioğlu, p.166; Tekinalp, p.444.

3.8. The Likelihood of Association Between Trademarks

In the likelihood of association between trademarks, if the public assume that there is any connection between these two signs and that the goods they purchase for any reason belong to another business, even they assume that there is an economic connection between the business that they respected and the goods of the business that they purchased, there is a likelihood of confusion.[450] In the "TIC TAC" - "ZIK ZAK" decision, the Court of Cassation stated that there is a sufficient measure for the likelihood of association and establishing a connection between two trademarks in the eyes of the average consumer addressed by the products covered by the trademarks. It is said that the plaintiff's coverage of the same class of goods as the recognized TIC-TAC trademarks and the fact that these trademarks are read and introduced in English pronunciation and not in Turkish pronunciation, makes the possibility of the defendant's trademark reminds of the plaintiff's trademark and establishing the connection between them.[451] Although there is sometimes no similarity between signs of trademarks, there may be situations where, the packaging of goods evokes the previous trademark with the color, figure, design in terms of packaging of goods, and may cause confusion.[452] In this circumstance, if the shape of goods is registered in a unique form, then the confusion of the trademark exist. However, if a connection can be made among the sign used and the registered trademark, it should not be concluded that there is no longer a need to research on likelihood of confusion.

[450] Küçükali, p.142.

[451] The Verdict of the 11th C.C. of Court of Cassation dated 13.11.2003, case no. 2003/4003, decision no. 2003/10839, *available at:* www.kazancı.com (visited at: 14.10.2019).

[452] Yasaman, p.323.

Existence of the idea that there is a connection between the sign and the registered trademark shall be considered within the notion of the likelihood of confusion.[453] In well-known trademarks, there is a greater risk of confusion through making the intellectual connection. Since the strong and easy-to-remember trademarks are more convenient for the public in terms of establishing a connection between trademarks.[454]

The likelihood of association may occur between the trademarks or between the trademark and origin of goods or services. In that circumstance, likelihood association constitutes infringement on trademark rights for the reasons that business uses the trademark and the sign is the same, or these belong to the same companies or group of businesss, or the similarity between the registered trademark and sign for various aspects. The confusion can also be in the composition of the packages, such as trademark, name and trade name, which are directly put on the market. The deception is determined by whether the target segment can distinguish between the original trademark and counterfeit trademarks, whether there is deception or not. If there is no deception, there is no unfair competition circumstance caused by the infringement to the trademark.[455]

In the circumstance of serial trademarks, the likelihood of confusion arises from the possibility that the consumer is mistaken about the origin of goods and services, and that s/he mistakenly thinks that the trademark is part of trademark series of another business. Trademark series can be mentioned where trademarks characterized by adding different graphic elements with the same word or new words, or by adding the same prefix or suffix constantly to different words.[456]

[453] Uzunallı, p.86.

[454] Dirikkan, p.167.

[455] Çolak, p.256.

[456] Kılavuz (Guide), p.124.

CHAPTER THREE

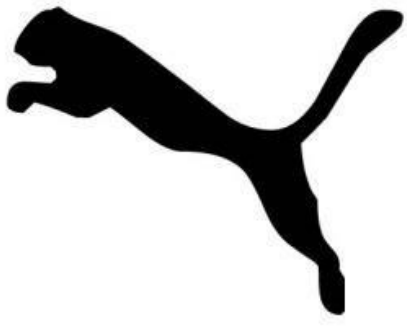
LIKELIHOOD OF CONFUSION IN DECISIONS OF COURT OF JUSTICE OF EUROPEAN UNION

1. PUMA-SABEL DECISION[457]

1.1. Summary of Background

The dispute initiated before the CJEU on the 20th of July 1995 arisen between the German company "PUMA AG, Rudolf Dassler Sport (PUMA)" and the Dutch company "Sabel BV (SABEL)"; due to the objection filed by PUMA company against the trademark application, belongs to SABEL company, for the sign of the bounding feline, which is given below.

PUMA has two previously registered trademarks consisting of bounding and leaping puma animal sign in the class of the jewelry and leather goods, as given below.



[457] CJEU, Judgment of the Court of 11 November 1997, *Sabel*, C-251/95, ECLI:EU:C:1997:528.

SABEL company; has applied for the registration of trademark that includes the bounding feline image along with the phase "SABEL" to be used in the products of 18th class which is leather and artificial leather products and bags and handbags not included in other classes, and the products of 25th class which is "tights, socks, belts, scarves, ties, trousers hangers, shoes and hats", in Germany, the PUMA company has claimed that the bounding feline image which is main element of the trademark belongs to itself and it filed an objection against the registration application of SABEL company.

Such dispute was initiated before the patent office and the first-instance court, and upon their decisions, it was initiated before the appeal courts. The German Federal Court underlines that while evaluating the likelihood of confusion among the trademarks which do not contain images having less creative content, strict criteria shall be applied; stated that the bouncing feline image is an imitation of the bounce movement of such kinds of animals. In addition, the Court of Cassation stated that essential features of the image used in PUMA trademark, the silhouette of the bouncing feline, were not imitated by the trademark of SABEL company, therefore there was no likelihood of confusion between those two trademarks, these may only cause the likelihood of association. Consequently, the Court of Cassation; has concluded that connection between these two trademarks with figure content cannot be asserted as the existence of the likelihood of confusion among these two trademarks.

The Court of Cassation applied to the CJEU in order to render a preliminary ruling regarding to determine the importance of the semantic content of trademarks in the evaluation of likelihood of confusion due to uncertainty of the expression stated under Article 4/1-b of the Trademark Directive numbered 89/104 EEC indicating that "in case

it contains the likelihood of association with the previous trademark".[458] Accordingly; the German Federal Court has inquired from CJEU as to whether the approach of the public that there is a likelihood of association among these two trademarks to each other justifies the refusal of the registration application for the trademark contains the phrase of "Image + SABEL" made by the SABEL company for the products similar to the products where the trademark used and previously registered by the PUMA company and includes only the image due to existence of likelihood of confusion.

1.2. The CJEU Decision

The CJEU, prior to rendering a decision for the preliminary ruling applied by German Federal Court, has underlined that notion of the "likelihood of association with the previous trademark", stated under Article 4/1-b of Trademark Directive numbered 89/104 EEC, occurs in three circumstances, as follows:

> *1) "The confusion of the sign and the registered trademark by the public (the likelihood of direct confusion),*
> *2) Establishing a connection between the owner of the sign and the owner of the registered trademark by the public (the indirect confusion or likelihood of association),*
> *3) The use of the sign, although the public do not confuse the sign and the registered trademark, connotate the registered trademark in mind (the likelihood of association in narrow approach)."*[459]

The CJEU stated that existence of confusion shall be widely taken into account by considering all of the factors related to circumstances of concrete event, and that likelihood of confusion depends on many factors, particularly recognition of the trademark in market, the connection established by public between two trademarks, and similarity level between signs and goods.

[458] Maniatis, p.309.

[459] Maniatis, p.310.

According to the CJEU, the overall evaluation of the visual, audial or semantic similarity of the trademarks, which are subjecst of dispute, should be based on the impression made by the trademarks as a whole by taking into account the distinctive and dominant elements of the trademarks. The average consumer generally perceives the trademark as a whole and does not attempt to analyze its various details. The higher the distinctiveness of the previous trademark, the greater likelihood of confusion. If previous trademark has a high distinctiveness, due to the reputation arisen either spontaneously or publicly, it is possible that the conceptual similarity may cause to the likelihood of confusion, as result of use figures having the similar semantic content in two trademarks. However, if the previous trademark is particularly unkown and its creative content consists of very few figures, only the conceptual similarity of the trademarks is not sufficient to cause likelihood of confusion.

Finally, CJEU indicated that notion of likelihood of association is not an alternative for the likelihood of confusion, however merely serves to determine scope of confusion. The fact that connection by the public to be made between two trademarks as a result of the semantic similarity solely shall not be a sufficient reason to reach the conclusion of the likelihood of confusion. In evaluation made by CJEU, it has reached to the opinion that provision of Article 4/1-b of Trademark Directive numbered 89/104 EEC shall not be applied to the circumstances where the likelihood of confusion has not arisen in the public, while evaluating the likelihood of confusion, there are many factors such as distinctiveness of products, where the trademark is used, in the market, or the similarity range between the used sign and the registered trademark, that all of these factors shall be taken into consideration, the average consumers review trademark as a whole and do not analyse it in detail, therefore, likelihood of confusion shall be evaluated as hollistic and finally, the existence of the semantic similarity of the trademarks which contain less

creative images shall not be sufficient in order to mention the existence of confusion in context of provision of Article 4/1-b of Trademark Directive numbered 89/104 EEC.

2. LLYOD-KLIJSEN DECISION[460]

2.1. Summary of Background

The dispute initiated before the CJEU on the 1st of January 1997 was between the German company "Lloyd Schuhfabrik Meyer & Co. GmbH (LLOYD)" and the Dutch trademark "Klijsen Handel BV (KLIJSEN)"; due to footwear produced by KLIJSEN company which demanded to use the LOINT'S trademark in Germany while conducting its trade. The following trademark was objected by LLOYD company for its use in Germany by KLIJSEN.

Since 1927, LLOYD has been a footwear producer that conducts marketing its products under the LLOYD trademark. As given below, it has also a number of trademarks that contain the word LLOYD.

[460] CJEU, Judgment of the Court of 22 June 1999, Lloyd Schuhfabrik Meyer, C-342/97, ECLI:EU:C:1999:323.

KLIJSEN has been producing footwear under the trademark LOINT'S in Germany since 1991 and in the Netherlands since 1970 and selling footwear under this trademark. These trademarked shoes are in daily wear style of which nearly all of it's sales are made up for ladies' footwear. On the 24th of August 1994, Klijsen applied for the international registration of the LOINT'S trademark and the extension of its protection to Germany. Thereupon, on the 26th of February 1996, it acquired the extended trademark protection of LOINT'S trademark up to Germany and the registered LOINT'S trademark right consisting of a word/picture.

LLOYD requested that the prevention of the use of the LOINT'S sign for the footwear and footwear products in Germany. LLOYD claimed the existence of likelihood of confusion of LOINT'S sign with LLOYD trademark due to audial similarity of LOINT'S sign, due to the lack of identifying elements and resulting from the high recognition of the LLOYD trademark, because of having the advanced distinctiveness in the sign. As a reference, it was stated in a consumer survey dated November 1995 that recognition rating of LLOYD trademark was 36% of the total population aged 14 to 64 years.

The local court refused the claim that the goods covered by these two signs were the same and these trademarks are different by basing on the use of KLIJSEN' sign of LOINT'S only in a daily footwear market in which LLOYD had no significant asset. However, the court was doubtful about the issue as to determine to likelihood of confusion on these signs under Article 5/1-b of the Directive which states that registered trademark owner has right to prevent usage by third persons as that may raise likelihood of confusion due to same or similar trademark or due to the same or similar goods and

services covered by such trademark and inquired from the CJEU for interpretation of Article 5/1-b of the Directive.

2.2. The CJEU Decision

The CJEU not only examined the similarity of signs in the decision, but also evaluated the similarity of products produced by the two trademarks and attention level of average consumer. It stated that attention level of average consumer, who is "reasonably well informed, reasonably observant and prudent", will vary depending on nature of the goods and services under research. However, it was considered by the CJEU that the average consumer does not have the opportunity to directly compare trademarks, but makes the comparison of trademarks according to the incomplete image that s/he keeps in mind.

According to the CJEU, when evaluating the distinctiveness of a trademark and as to whether such distinctiveness is in the high level or not; the sufficiency of the ability of the trademark to reflect that goods and services, subject to the registration, as the goods and services provided from a certain company shall be researched on as a whole. When making this evaluation, the characteristics of the trademark resulted from itself shall be taken into account such as; as to whether the trademark contains identifying elements in terms of the goods and services applied to be registered, market share of trademark, the intensity of trademark usage, extent and duration of the geographical area, the amount of investments made for the promotion of the trademark, proportion of consumers who perceive the trademark as a sign that indicates goods or services provided by a company, declarations obtained from chambers of commerce and other industrial or commercial organizations.

It is not possible to attribute the absolute conditions of the status of trademark having a strong distinctiveness, for instance, to express the percentage of public

recognition of the trademark in absolute percentages. When evaluating the degree of similarity in context of visual, audial or conceptual ways, it is befitting to evaluate by considering nature of products and methods of placing products on the market.

Finally, the CJEU decided that an audial similarity may be sufficient in itself to cause confusion within the meaning of Article 5 of the Directive; whether it occurred or not, it underlines that the whole picture, including other factors, shall be reviewed while determining the likelihood of confusion. These may be as to whether the sign result any other semantic connotation that may be caused by the sounds and whether the sign contains any descriptive element of the goods.

It is important to state that the CJEU underlined that each lawsuit shall be evaluated in its particular circumstance and that this could not be a definite evaluation.

3. CANON-MGM DECISION[461]

3.1. Summary of Background

The dispute initiated before the CJEU on the 28th of January 1997 arisen between the companies of Japanese "Canon Kabushiki Kaisha" (CANON) and the American "Metro-Goldwyn-Mayer" (MGM), upon the CANON's objection made against the MGM's trademark application of which trademark is given below.

[461] CJEU, Judgment of the Court of 29 September 1998, *Canon*, C-39/97, ECLI:EU:C:1998:442.

In 1986, MGM; applied for a trademark registration including the phrase of CANNON, which is given below, in order to be used in the "production and distribution of video tape cassettes, production distribution and projection of films for cinemas or TV programmes", in Germany, and CANON objected to the trademark application of MGM by alleging that this infringed the trademark CANON of which phrase was registered as CANON 's own trademark, previously registered in Germany to be used in "camera, projector, recording equipment and television receivers including tapes and discs for TV recording and reproduction".

Such dispute was initiated before the German Patent Office that firstly, application of MGM refused, due to similarity in respect of signs and goods covered by those, then the decision is dismissed because of there is no similarity. CANON applealed against

decision of the Patent Office before Federal Patent Court, and upon it's decision, the case was initiated before the German Federal Court. The Federal Court stated in its assessment that the CANNON and CANON trademarks were similar and read in the same way, that the previously registered CANON trademark had a certain reputation, however the products which were the subject matters of both trademarks were not similar and that the perception of the public about the products that they were not produced by the same producer.[462] However, the Federal Court, in spite of this perception among the public, applied to the CJEU in order to render a preliminary ruling as to whether it was sufficient and necessary to evaluate whether the previous trademark had distinctiveness and in particular had a certain recognition in the determination as to the similarity of two trademarks and products and services that these covered, in order words, in the determination as to the likelihood of confusion within the meaning of the provision of Article 4/1-b of the Trademark Directive numbered 89/104 EEC.

3.2. The CJEU Decision

The CJEU first considered whether it was necessary and sufficient to evaluate whether the previous trademark had distinctiveness and in particular had a certain recognition, in order to accept existence of confusion between these two trademarks and the products that these covered.

According to CJEU's settled case-law, trademarks with high distinctive character, either spontaneously or as a result of the reputation that it has in market, exercise the greater protection than that of the trademarks with low distinctiveness. If the trademarks are very similar and have a high distinctiveness due to reputation of previous trademark, application for trademark registration may be refused, although there is a relatively low

[462] Maniatis, p.312.

degree of similarity between goods or services. In determining whether the similarity between goods and services cause to the likelihood of confusion, the distinctiveness of the previous trademark and in particular its reputation and prestige shall be taken into account.

After these evaluations, the CJEU examined as to whether there was a confusion within the meaning of the provision of Article 4/1-b of the Trademark Directive numbered 89/104 EEC between the trademarks and products that covered by those, although the public perception was that the products subject to the trademarks were not produced by the same producer.

The CJEU expressed the possible risk of believing by the public that products subject matter of the dispute were from the same business, or by status, from economically associated businesss cause likelihood of confusion, contrarily, whereas consumers do not assume as products were from the same business or from economically associated businesss, there would not be the existence of the confusion. However, while evaluating the similarity of proucts, all relevant factors relating to those should be considered. These factors include, inter alia, the nature of products, intention in the use and forms of usage, and whether these are competing or have a complementary nature to each other.

The overall evaluation of the likelihood of confusion comes along with the interdependence of related factors, in particular the similarity in trademarks and the similarity in products. The lower similarity between products can be balanced with a higher similarity level between trademarks or opposite circumstance may also occur. Therefore, likelihood of confusion may be expected, even though consumers think that those goods have different producer origins.

Consequently, in the evaluation made by the CJEU, it stated that while evaluating the similarity of two trademarks and the goods and services that these covered, in other

words, in the determination as to whether these was a likelihood of confusion within the meaning of the provision of Article 4/1-b of the Trademark Directive numbered 89/104 EEC, it is required to evaluate whether the previous trademark had a distinctiveness and in particular had a certain recognition, and although the public perception was that the products subject matter of the trademarks belong to different businesss, it is required to the determine the existence of the confusion under Article 4/1-b of the Trademark Directive.[463] The CJEU purposes that according to Article 4/1-b of Directive, in case of lesser similarity between products, where trademarks are remarkably similar and former trademark is highly distinctive due to its reputation, the likelihood of confusion should be considered.[464]

4. COCA COLA-RIENERGY COLA DECISION[465]

4.1. Summary of Background

The dispute initiated before CJEU on the 6th of May 2013 arisen between the American company THE COCA COLA COMPANY (COCA COLA) and the Romanian company INTERMARK SRL (INTERMARK); upon the objection made by world leading beverage company COCA COLA against the INTERMARK's RIENERGY COLA's trademark application of which trademark is given below.

[463] Maniaris, p.312.

[464] Maniatis, p.320.

[465] CJEU, Judgment of the General Court (Sixth Chamber) of 18 March 2015, *Rienergy Cola*, ECLI:EU:T:2015:158, T-384/13.

INTERMARK applied to OHIM for the registration of the RIENERGY COLA community trademark which consist of word and figure, given below, in the goods stated under 32nd class of Nice Classification which includes "beers, mineral water, soda, soft drinks, fruit juice and extracts, preparations used in the preparation of syrup and beverages" and under the 35th class of the same including "advertising, business management and administration, office services". The application was published in the Bulletin. COCA COLA, by basing on the previously registered trademark and logo in its name, objected to the publication in accordance with Article 41 of the Community Regulation numbered 207/2009, which regulated the objection against the publication and required the refusal of the application. The COCA COLA Community trademark was registered in 2009.

OIHM accepted the objection and refused the RIENERGY COLA trademark application. Afterwards, INTERMARK filled for appeal, and Appeal Court dismissed the appeal, that there is likelihood of confusion between two trademarks within the scope of Article 8/1-b of Regulation numbered 207/2009 EEC, due to similarity between signs and reputation of earlier registered well-known trademark of COCA COLA, for the products in the 32nd class. Therefore, INTERMARK brought the dispute to the CJEU, claiming that the Appeal Board was wrong in its determination on likelihood of confusion exists between the trademarks.

4.2. The CJEU Decision

The CJEU commenced its evaluation of the likelihood of confusion by basing on its case-law. Regarding to its case-law, likelihood of confusion exists between trademarks in case there is an impression made that the goods and services are provided by the same businesss or by the businesss associated to each other. Again accordingly, in some circumstances the lower level of similarity between goods and services can make disappear the higher level of similarity between trademarks and opposite circumstance

may occur too. The court expressed that the evaluation of the likelihood of confusion shall be made by considering visual, audial and conceptual similarities and the impression made by the trademarks as a whole. It was stated that evaluations to be made by taking into consideration only the essential distinctive elements of the trademarks may sometimes be deceptive; since the consumers with average attention perceive the trademark as a whole instead of paying attention to these elements. Although the attention level of consumers varies regarding to type of products in each event, according to the general acceptance, consumers rarely have the opportunity to directly compare two different products and the sense of trust that they can remember when purchasing the related product plays a role.

According to the Court, the more distinctive the trademark is, the more likely it is to be confused. Therefore, trademarks with high distinctiveness, whether spontaneously or because of their market recognition, benefit from greater protection than that of trademarks with low distinctiveness. Therefore, while evaluating the likelihood of confusion, the distinctive element strength and recognition of a trademark must be taken into consideration.

After recalling the above determinations, the Court commenced examining the concrete dispute event. In the concrete event, the level of attention of consumers for daily consumables indicated in the 32nd class is stated to be average and the level of attention of consumers for services indicated in the 35th class is stated to be higher, since these appeal to professionals.

The court stated that the word “COLA”, which was at the center of the trademark subject matter of the registration and indicated in a big size, was the essential component, and that the word “RIENERGY” plays a secondary role in the integrity of the trademark due to its small size, although it was imaginary therefore distinctive, it was difficult to read, but also cannot be completely ignored. The Court stated that the word “COLA” was

perceived as descriptive for the 32nd class, but the same issue could not be mentioned for the 35th class, on the contrary, it was distinctive. However, CJEU continued that although the word "COLA" was considered to be descriptive for the 32nd class in the concrete case, since this word cannot be ignored within the integrity of the trademark due to its size and location and its impact. At this point the Court underlined an important situation; there may be circumstances where a word, with weak distinctive power in the integrity of a trademark, which does not mean that it is not the essential element of that trademark, since even though its distinctive power is weak, it can be imprinted and recognised as the essential element in the minds of consumers in terms of its size and position.

Beyond all similarities, the Court also pointed out that while evaluating likelihood of confusion, the classic well-known trademark of COCA COLA generated with white handwriting on a red background for the 32nd class shall be taken account. In fact, even if the color used on the ground is not a special color in terms of the determination of confusion, it is stated that in the event examined, even the color element shall be taken into consideration in the concrete event due to the objection reason which was the degree of distinctiveness power of the trademark, in other words, its high distinctiveness power in the minds of the consumers.

As a result, the Court determined that the common essential elements, which is COLA, for both trademarks, which were on the proceeding of the objection, were same and that such phrase has distinctiveness for the mentioned services. It was concluded that by taking into consideration of the above determinations, there was a likelihood of confusion in terms of similarity between the trademarks at audial and conceptual level.

5. BARBARA BECKER-HARMAN DECISION[466]

5.1. Summary of Background

The dispute initiated before the CJEU on the 3th of February 2019 includes the appeal request made by the person named Barbara Becker, the famous German fashion designer and tennis player, who wanted to register the trademark BARBARA BECKER, which consists of her name and surname, as given below, and arises the objection made by Harman International Industries Inc. Company (HARMAN) to prevent such registration application of Barbara Becker due to it's previously registered trademark and the acceptance of the objection by the local court.

Barbara Becker applied to the OHIM in 2002 in order to register her name as the trademark of BARBARA BECKER. The scope of the application was for the services stated under the 9th class includes "devices and instruments related to science, maritime, cartographic, photographic, cinematographic, optical, weighing and measuring, signaling, control (inspection), life-saving and educational devices and instruments; devices for recording, transmitting or reproducing audio or vision; magnetic data carriers, recording discs; mechanisms for vending machines and coin-operated devices; cash registers, calculators, data processing equipment, computers. "

[466] CJEU, Judgment of the Court (Fourth Chamber) of 24 June 2010, *Becker*, C-51/09, ECLI:EU:C:2010:368.

After following publication of the trademark by the OHIM, HARMAN objected against the publication with based on it's BECKER and BECKER ONLINE PRO trademarks, given below, which were previously registered for the same classification of goods in the OHIM in 2004. The OHIM accepted the objection and refused the Barbara Becker's application with the justification that likelihood of confusion exists, due to sameness of covered products and similarity between trademarks. Barbara Becker applied to the OHIM Appeal Board against this decision and the decision rendered for the refusal of the application was removed by the Board.

BECKER ONLINE PRO BECKER

HARMAN initiated a lawsuit against the decision of the OHIM Appeal Board and firstly, the case was heard by the General Court of CJEU. According to the General Court, the OHIM Appeal Board anulled the decision regarding that Appeal Board's evaluation that trademarks are distinctive and ignoring the relatively dominant character of the word "BECKER", compared to the other component "BARBARA", since a surname has a more distinctive character than a simple name. Furthermore, according to the General Court, the fact that applicant Barbara Becker was a celebrity does not mean that the trademarks were not conceptually similar, also the surname of Becker is highly common in EU zone.

In addition, the General Court stated that the word "BECKER" would be perceived as a surname, although such word was not visually dominant in the application, and as it has an independent distinctive character in the trademark. In addition to the aforementioned issues, considering the fact that the trademarks cover the same and similar goods, according to the General Court, there would be a likelihood of confusion

between the trademarks. Therefore, General Court annulled the decision of the OHIM Appeal Board.

Thereupon, the applicant, Barbara Becker, appealed the decision of the General Court before the CJEU.

5.2. The CJEU Decision

In the evaluation of CJEU regarding the case, it initially listed some determinations of the likelihood of confusion. According to the established case-law, the risk that the public will believe that the goods or services provided from the same business or from a commercially associated business shall cause the likelihood of confusion under Article 8/1-b of Council Regulation numbered 40/94 EC. The likelihood of confusion arises in a part of the public shall be considered globally, by taking into account all the factors related to the dispute subject matter of the examination.

The CJEU stated that while evaluating the likelihood of confusion holistically, the visual, audial or conceptual similarity of the trademarks subject matter of the dispute shall be examined on the basis of the impression made by such signs as a whole, but while conducting such examination, the distinctive and dominant elements of sign shall be taken in considering. Accordingly, in the overall evaluation of the likelihood of confusion, the perception of the average consumer of goods or services regarding the trademarks has a decisive effect. In this context, average consumers often perceive the trademark as a whole and do not engage in a comprehensive analysis of the various details of the trademark.

The CJEU continued its evaluation by stating that although in the ordinary circumstances the average consumers perceive the trademark as a whole, in some circumstances like *Medion* case, in case of a previously registered trademark is used in a composit trademark by a third party, even though such element does not constitute the

dominant element of the trademark, it may have the independent distinctive character in the composit trademark, in such circumstances, it shall be accepted that the global perception generated by the composit trademark may cause the public to believe that goods provided at least from businesses which are commercially associated, and thus the likelihood of confusion may occur.

According to the CJEU, although principally, in a part of the European Union, it is possible to accept that surnames are, more distinctive than names, each event shall be evaluated within its own specific circumstances and, in particular, when examining the distinctive character, it shall be considered as to whether the relevant surname is extraordinary or, in contrary, whether it is subject to a common use. In the examined case, the "BECKER" surname is a commonly used surname, especially in Germany. In addition to this, it shall also be considered as to whether the person, who demands to register her/his name and surname jointly, is a celebrity or not, since such issue shall explicitly affect the perception approach of the related segment of the public to the trademark.

Furthermore, it is not possible to accept that the surname independently plays a distinctive role in each event for a composit trademark, on the grounds that it is perceived only as a surname. The determination of the independent distinctive role may be based on an examination of the specific circumstances of each event. The opposite evaluation shall result to the conclusion that, even if the relevant surname is widely used or adding the forename to it may chance the conceptual perception of the relevant segment of the public, all of the objections made against applications consisting of the name and same surname, by basing on the previously registered surname, shall be accepted.

Consequently, in the BARBARA BECKER decision, it has been underlined that the objections, made against the applications consisting of name and surname by basing on the same surname which was previously registered, shall not be accepted without evaluating other conditions of the event subject matter of the objection. The CJEU states

that although, in some EU countries, principally, it is possible to accept that surnames are more distinctive than names, other circumstances of each event shall also be examined. What is referred by mentioning the other circumstances of the event is in particular to examine the fact that the relevant surname has a common or uncommon use and the name and surname as a whole is the name of a celebrity-known person. According to the CJEU, when the subject is the name and surname of a celebrity-known person, the perception of the relevant segment of the public shall be explicitly affected by this. In addition, whether the relevant surname is subject to a common use or has an extraordinary character shall also affect trademark's distinctive character. In this regard, CJEU uphold the decision of the General Court.

6. DISENOS MIREIA-DROGERIE MARKT GMBH DECISION[467]

6.1. Summary of Background

The dispute initiated before the CJEU on the 11th of September 2013 arisen between the German company Drogrtia Markt GmbH (DROGERIA) and the Spanish trademark Disenos Mireia (DISENOS); with regard to the objection of DROGERIA against the application for registration of figurative trademark of DISENOS, that is given below, as a community trademark, with the allegement that the likelihood of confusion will occur between these trademarks.

[467] CJEU, Judgment of the General Court (Sixth Chamber) of 25 June 2015, *Dm*, T-662/13, ECLI:EU:T:2015:434.

The Spanish-based DISENOS company applied to register that figurative trademark as a community trademark. The application was made for the 14th class of the Nice Agreement including "precious metals and alloys, objects made of precious metals and coatings, jewelry, precious stones, time-indicating instruments".

The application was published in the Official Trademark Bulletin. The DROGERIA objected against the application by basing on Article 8/1-b of the Directive numbered 207/2009 which regulates right to object of previous registered trademark owner in the circumstance where there is a likelihood of confusion to occur between the sameness or similarity between the trademark of which registration application made and the sameness or similarity of goods and services covered by the same with its trademark of "DM", which was previously registered in 14th class including "jewelry, time indicating instruments", as it is given below.

Thereupon, the OHIM Objection Division refused the objection and DROGERIA applied to the OHIM Appeal Board. The OHIM Appeals Board refused the appeal regarding to it's decision that, the goods contained by the trademarks subject matter of the objection are partially the same, partially similar, partially different, but the trademark of which application made is characterized by the letter "M", and the previous registered trademark is perceived only by the letters "D" and "M", therefore these trademarks, as they are, are not audibly and conceptually similar. Consequently, since there is no similarity between the trademarks, there is no likelihood of confusion within the meaning of Article 8/1-b of the Directive, so the Appeal Board found there is no need to decide on the high distinctive element of the previous registered trademark.

DROGERIA applied before the CJEU General Court with regard to this issue. According to DROGERIA, both trademarks, subject matter of the lawsuit, consisting of the letters "D" and "M" and are therefore visually and audibly similar. In addition to this, it stated that once it is taken into consideration that the goods contained in the trademarks are also the same and similar, and the high distinctiveness of the "DM" trademark, the likelihood of confusion shall be considered.

6.2. The CJEU Decision

The CJEU initially started with determining relevant public segment. According to CJEU, the products in scope of trademark are tend to be highly expensive and therefore, the average consumer of that category of products should be accounted as well-informed with high level of attention.

Afterwards, the Court continues with the analysis of figures as it is stated that, the main question in the concrete event is; indeed, as to whether the relevant consumer segment perceives the letter "D" together with the letter "M" which was characterized in the trademark of DISENOS. The court evaluated the issue in the same line with decision

of the OHIM and stated that the round part of the letter “D”, which was highly stylized in application of DISENOS, was not completed, that there was a gap, and thus, the consumers would not be perceived it as the letter “D”. Therefore, regards to the figure, the part claimed as the letter” D” is perceived as the other half of “M”.

And also, according to CJEU, the claim of the trademark of DISENOS constitutes the first letters of the words generating the trade name of the DROGERIA MARKT company is unacceptable. Since such claim was based on the fact that the trademark of DROGERIA MARKT has been used along with this trade name and would be perceived by consumers as such, but this fact could not be proved due to, in the light of case-law, the comparison is made by taking into account the figures as trademarks are registered or shown in the registry, without considering the trademark is used solely or with other elements in commercial life.

In the visual comparison, an absolution determination cannot be made as there can be no similarity between the word trademark and the figure trademark in context of case-law so far. In the concrete event, while the previous registered trademark is a word trademark consisting of the letters “D” and “M” in normal fonts which do not contain a figure, the DISENOS sign consists of a highly stylized figure of a “M” letter. Therefore, in parallel with the OHIM decision, the Court found the trademarks, subject matter of the case, are visually different as a whole.

Moreover, although in terms of audial character, the trademark of DISENOS, consists of the capital letter “M”, the relevant consumer will prefer to describe the trademark with its figure due to the very special stylized figure of the trademark, in other words, they will not prefer to describe such trademark with the letter M, as they perceived it. The CJEU therefore decided that the trademarks the subject matter of the lawsuit were also audibly different. In addition to this, the semantic similarity comparison will not be made, since the trademarks subject matter of the case have no meaning. As a result, the

finding of the OHIM, as it stated that the trademarks subject matter of the case as a whole were different, is found accurate by the CJEU.

While evaluating the likelihood of confusion in concrete event as a whole, the OHIM stated that the likelihood of confusion was also automatically fallen out the scope since the trademarks are remarkebly different from each other. According to the Court, as stated above, the precondition to apply Article 8/1 (b) of the Directive has not been fulfilled since the trademarks subject matter of the lawsuit were not similar, too.

Consequently, according to CJEU, in the concrete event, there is no likelihood of confusion, regardless of the determination on the distinctiveness level of the previous trademark and the sameness and similarity of the goods that these contain. Therefore, the CJEU dismissed the case by finding the OHIM decision convenient.

7. MEDION-THOMSON DECISION[468]

7.1. Summary of Background

The dispute initiated before the CJEU on the 5th of March 2004 arisen between the German "Medion AG company (MEDION)" and "Thomson Multimedia Sales Germany & Austria GmbH company (THOMSON)", which is one of the leading trademarks in the electronic entertainment products market, due to the objection made by MEDION against the use of it's egistered trademark in composit sign of THOMSON.

MEDION proprietor of the LIFE trademark which is registered at 1998 in Germany, expressed as "leisure electronic devices". THOMSON uses the word LIFE with affixed to its name, in some cases as a simple witting, and in some cases in different

[468] CJEU, Judgment of the Court (Second Chamber) of 6 October 2005, *Medion*, C-120/04, ECLI:EU:C:2005:594.

graphical designs, colors and sizes in the THOMSON LIFE composit sign, indicated below, that it uses for same purpose as MEDION. In 2002, MEDION bring a suit before Düsseldorf Regional Court and claimed that THOMSON's use of the LIFE word in THOMSON LIFE composit sign for "television sets, cassette players, CD players, hi-fi systems" constitutes an infringement of the rights arising from its own LIFE trademark, will cause likelihood of confusion and therefore, MEDION seeking to prevent its use by THOMSON.

The Court of First Instance refused the lawsuit, due to it's finding on likelihood of confusion is not existed between LIFE trademark and THOMSON LIFE composit sign. MEDION applied to the appeal against the decision and the dispute was initiated before the Court of Cassation of Dusseldorf.

The Supreme Regional Court of Dusseldorf started by opening German Federal Court's a previous case-law to discussion, since the case-law stated that to determine the similarity, signs shall be recognised as a whole and overall impression of the signs shall be considered. Where the part of the composit sign in dispute, is the common component with the previous trademark and has an independent distinctive role, other componenets become secondary for general impression. Since main component of the trademark does not have a significant role in overall impression of the trademark, likelihood of confusion will not be the issue, even if the main component has a distinctive character individually.

By applying mentioned case-law, The Court of Cassation of Dusseldorf evaluated issue as, THOMSON, name of the company, contributes as an essential element in overall

impression of the THOMSON LIFE composit sign. The affix of LIFE sign cannot play a significant role compared to THOMSON, also It is so common to see company's name and and indistinctive element together at the sector in scope of trademark. After, the Court of Cassation adds some examinations like audio similarity and semantic similarity, but it does not changethe result which likelihood of confusion is not existed.

However, the Court of Cassation continues its evaluation with implying that this case-law is mostly questioned in Germany, especially in similar cases, since it seems unfair that a rival company can use an earlier resigtered trademark by adding its company name. Therefore, according to opposition, in THOMSON LIFE composit sign, both componenets are independently distinctive and there are no association between those componenets. The products produced under THOMSON LIFE composit sign may give a rise to confusion that those products orginated from LIFE trademark owner MEDION.

Therefore, the Court of Cassation of Dusseldorf has inquired that a composit sign which includes its company name with an earlier registered trademark, which is a word that has individually normal distinctive role, as to whether the likelihood of confusion occurs efore relevant public segment within Article 5/1-b of Directive.

7.2. The CJEU Decision

The CJEU initially listed the basic principles that were initiated in its previous decisions on the likelihood of confusion, after outlined the general terms of the notion and its field of application. Accordingly, the risk that public may assume as subject products originate from same business or business associated economically raises likelihood of confusion within meaning of Article 5/1-b of Directive. The likelihood of confusion which may arise among a part of the public shall be examined globaly, by taking into account all factors related to the event concerned. The overall evaluation of the likelihood of confusion shall be conducted on the basis of the impression that

trademarks made as a whole, by basing on the distinctive and dominant elements of the trademarks, in terms of visual, audial or conceptual similarity of the trademarks. The recognational form of trademarks by the average consumers of the goods or services plays a decisive role in the overall evaluation of the likelihood of confusion. In this context, average consumers often perceive the trademark as a whole and do not engage in an analysis of the various details of the trademark. And also, avarege consumer's attention level differs regarding to product in case.

In the examination of the likelihood of confusion, the evaluation of the similarity of trademarks means more than taking one of the elements of a sign combination and comparing this to the other trademark. Instead, the comparison shall be conducted by examining each of the trademarks, subject matter of the examination, as a whole, but this does not eliminate the fact that the overall perception of the combination trademark made on the relevant segment of the public is carried out, in some circumstances, by one or more dominant elements of the combination trademark.

In addition to this, the CJEU stated that the overall perception is not determined by one or more dominant elements, the average consumers perceive the trademark holistically, and under normal conditions, even if a pre-registered trademark, which is used jointly with the company trade name of a third party in a combination sign, do not constitute the dominant element of the combination sign, it shall not have the independent distinctive role in the combination trademark. In such a circumstance, the overall impression of the combination trademark can cause the public to believe that the goods or services subject matter of the examination are at least from economically associated companies, which means the occurrence of the likelihood of confusion. The finding regarding the occurrence of the likelihood of confusion shall not be subject to the condition of being dominant of the part which is the same as the pre-registered trademark in the overall perception generated by the combination trademark. If such a condition was

enforced, the owner of the previous trademark would be deprived of the exclusive rights granted to her/him under Article 5/1 of the Directive, in the circumstances where the trademark has an independent distinguishing role, even if it is not dominant in the combination sign.

According to the CJEU, these may occur, for instance, in the circumstances where the owner of a broadly recognized trademark uses other pre-registered trademarks which belong to other persons and do not have the recognization level as the same of its own trademark, along with its own trademark, or where the combination trademark consists of a known trade name and another pre-registered trademark. Essentially, in such situations, the broadly recognized trademark or trade name stated in the composit sign will be the dominant element, often in the impression that the sign made as a whole.

In this situation, although the previous trademark has an independent distinctive role in the composit sign, reflecting the origin by the previous trademark cannot be guaranteed. Therefore, it shall be accepted that due to the independent distinctive role of the previous trademark, the connection made by the public that the origin of the goods or services of the composit sign are covered by the owner of the previous trademark, shall be sufficient for the occurrence of the likelihood of confusion.

As a result, the CJEU is in the opinion that in the circumstances where the goods or services are the same, even though the sign, subject matter of the dispute, does not constitute the overall impression made by composit sign including trade name of a company, but constitute the same by its use together with a registered trademark which has an independent distinctive power in a composit sign, it shall be considered that the likelihood of confusion may exist in part of the public within the scope of Article 5/1-b of the Directive.

This response to the CJEU does not mean that the likelihood of confusion between trademarks will not occur. The response stating that the likelihood of confusion between

trademarks may occur in such circumstances sets forth the conclusion of the existence of the likelihood of confusion that could be reached by the examination unit or the court in some circumstances.

CONCLUSION

In its most general and basic definition, the trademark is a sign that distinguishes goods or services of a business from goods or services of others. According to our national law, these signs must be registered to the Turkish Patent and Trademark Office in order to be used as trademarks. If there is not procedural deficiency in the form, The Office examines the incoming applications whether there is a reason that prevents the registration according to the IPC numbered 6769. If the Office detects one or more absolute grounds for refusal for the sign to be registered, it shall reject the application ex officio. In the following article of the same Code, the the relative grounds for refusal are counted and the likelihood of confusion including the likelihood of association which constitutes the main subject of our study is regulated. If one or more of such relative grounds for refusals are exist, the Office will reject the application upon appeal.

The absolute grounds for refusal are mentioned in Article 5 of the IPC and the relative grounds for refusal are mentioned in Article 6 were substantially revised in line with the former Decree Law no. 556 in line with EU legislations. The purpose of regulating absolute grounds for refusal; to prevent the registration of signs that are not distinctive, which should be open to everyone in commercial life, misleading the public about the quality, geographical source of the goods and services, including religious values and symbols, contrary to public order and general morality. The reason for existence of relative grounds for refusal, as stated in Article 6, is preventing ‘’the likelihood of confusion a sign with previously registered or applied trademark, including the existence of association by public due to identity or similarity of a sign with a registered or previously applied trademark and the identity or similarity of the goods and services covered…’’. Due to the relative grounds for refusal, the trademark right of trademark owner is protected. In the rule of law, the use, production, sale and similar use of things subject to rights by third parties without the consent of the trademark owner is

restricted by law. Intellectual property law, as in other areas of law, gives rights holders the right to a monopoly over the specified economic activities during a certain time period and to prevent third parties from performing such activities.

In the first chapter of our study, theoretical information about the trademark is given. The issue is discussed in scope of Turkish and EU law, with mentioning TRIPS Agreement and Paris Convention. Signs that may be trademarks are regulated in Article 4 of the IPC in Turkish Law and Article 4 of the Directive on Harmonization of Trademark Laws of Member States Numbered of 2017/1001 and Article 3 of Regulation Numbered 2015/2436 of European Union Law.In general terms, a trademark is required to existence of a sign and to have a distinctive character. These signs may be person names, words, shapes, letters and numbers, colors, sounds, melodies, smellss, the form or packaging of goods. In Article 5 of the IPC, which lists the reasons for absolute grounds for refusal, subparagraph b has been added. According to paragraph, "Signs which do not have any distinctive character" will not be registered as trademarks. According to this, intangible and tangible distinctiveness will be separated in Turkish Law as in EU Law.

During the period of Decree Law numbered 556, the trademark was laid out as "any kind of sign that can be displayed by drawing or expressed in a similar way, published by printing and reproduced". However, in IPC, without looking for these conditions the ability to be shown in Registry is deemed sufficient for the formation of the trademark. According to that determination, while it was obligatory to display a sound and smell trademark graphically during the Decree Law period, such a condition is not sought in terms of IPC and it is deemed sufficient to be shown in the Registery. In the same direction, the most effective amendment made in the Regulation numbered 2017/1001 regarding the scope of the Union Trademark right has been the abolition of the requirement to be shown by drawing. Here again, the condition of demonstrability in the registry has replaced that requirement. With the adoption of the IPC and the

innovations introduced by the EU Trademark Regulation numbered 2017/1001 which came into force soon after, it appears that the abolition of to be shown by drawing has facilitated and even made possible the registration of many types of signs.

The trademark has functions of distinctiveness, indicating of origin, guarantee and advertising. In other words, the trademarks that indicate which business produced or launched the goods or which service is served by, have distinctive characteristics in terms of businesses, goods and services, as well as the function of showing the source of goods and services. Thanks to those functions and technological developments, the wide expansion of the advertising market has made the protection of the trademark very important. According to the system adopted by Turkish trademark law, the birth of the trademark right is possible with the registration of the trademark in accordance with IPC. However, the registration system adopted in IPC has been softened and some exceptions have been amended to that system. It would not be wrong to say that a mixed system between the use system in which the trademark right is acquired by selecting a sign for the first time and using it in accordance with the law, and the registration system is accepted as a result of these exceptions. In European level unregistered trademarks are not protected, however under Regulation numbered 2017/1001 the trademarks that have acquired distinctiveness as a result of unregistered use or recognized trademarks are still considered among the reasons for relative grounds for refusal and termination, and also member countries may grant protection in national level.

In the second chapter, the danger of infringement of trademark rights and the likelihood of confusion in Turkish law among trademarks are examined in the light of case laws of the Court of Cassation, also with partly mentioning CJEU and OHIM decisions. A trademark that is of great importance in terms of distinguishing goods and services of a business from those of others; It has become an important tool for increasing the sales of businesses and enlarging the audience that the service they provide.

Infringement of the trademark right can be carried out in many ways, as is the common form of infringement which is the likelihood of confusion. Confusion means the mixing of two very similar things.

Producers can try several ways to increase demand for their trademarks. In order to sell their own product, they try to cause confusion and achieves their goal by taking advantage of the product range and diversity in the market. In such a case, consumers cannot be expected to be those with high-level consideration who can identify even small differences between trademarks. It is aimed to mislead consumers by trying to open the way to deception in the infringement of the trademark right by likelihood of confusion. The party that causes that confusion ensures for the sale of its goods or services and thus has obtained an unfair profit. Because, consumers can buy goods or services by seeing the same or similar trademark they use for a long time on the same or similar goods or services. When such a situation occurs, the right of the trademark owner is violated.

The first condition for the existence of the likelihood of confusion by the consumers shall be that the trademark requested to be registered is identical or similar to the one previously registered, while the other condition is that both trademarks are used in the same or similar goods and services. In case of confusion by consumers, the measure will be taken into account that the consumer segment is not the persons concerned or the experts, but the public. The important aspect of the likelihood of confusion is that the public establish connection between these two signs for any reason in any way.

In trademark law, confusion can occur frequently and for many reasons such as audio similarity, visiual similarity or semantic similarity. Therefore, when evaluating the likelihood of confusion, it should be acted in accordance with the main principles, and the characteristics of each concrete event should be taken into consideration as a whole. In addition, consumers play a very important role in determining confusion. If the goods or services bearing the trademark address to the group of consumers from all walks of

life, then the attention and care of the consumers in the medium intelligence and culture should be taken as a basis. However, if the goods or services that bear the trademark address to a particular group of consumers, for example children or housewives, then the possibility of this group of consumers being mistaken should be taken into account. There may be cases where the goods or services bearing the trademark address to the group of specialist consumers such as doctors, pharmacists. In such a case, since the probability of being mistaken is low, the existence of likelihood of confusin should be investigated very carefully and a detailed examination should be carried out according to each concrete event.

In the last section, the likelihood of confusion in EU trademark law is examined in the light of CJEU decisions. In the justification numbered 10 of the Trademark Directive numbered 89/104 EEC, which is one of the main sources of EU trademark law; it is stated that the protection provided to the trademarks is an absolute protection if there is identification between the trademark and goods or services, the protection also covers cases where the goods and services of the sign and the trademark are similar and that the concept of similarity must be interpreted in terms of the likelihood of confusion, the likelihood of confusion is a special condition for protection and decision to be made on whether the likelihood of confusion is present in concrete events depends on the existence and evaluation of many conditions. Similarly, the relevant articles of the Trademark Directive and the Council Regulation on Community Trademark contain regulations regarding the likelihood of confusion on trademark. In many decisions of CJEU, the issue of likelihood of confusion on trademark is mentioned, how the assessment regarding the confusion on trademark should be made, what issues should be considered and how to interpret the relevant articles of the Trademark Directive and the Council Regulation are also stated.

To conclude, in this thesis I have looked into the laws of Europe and Turkey and international agreements on protection of trademarks against likelihood of confusion. The major similarities are in the elements of trademark, especially ability to be shown in the Registry and distinctiveness, furthermore protection against same or similar signs, goods and services and role of the Nice classification in the protection against confusion. My opinion is that it is inevitable that the law of Turkey, which is on its way to becoming a member of the EU, is affected by EU trademark law regulations. The trademark provisions regulated in the Regulation and Directive issued by the EU have been tried to be adopted into Turkish law. As a result of this harmonization, it is seen that Turkish law is similar and also along the same lines with EU law. Regarding the likelihood of confusion, Turkish legislation has been quickly harmonized and aligned with international regulations, whether in the EU Trademark Regulation or in the Council Directive and in the light of all international agreements and directives.

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ABSTRACT

With the developments in commercial activity all over world, importance of trademark becomes more and more remarkable. Although trademarks are used for distinguishing certain goods and services from others' goods and services for preventing confusion among consumers, the most frequently seen type of trademark infringements are performed by the way of misleading consumers as giving raise to confusion. By this means, the party who gives raise to confusion intent to increase his/her profit thereby deceive consumer.

Theroritical background of this thesis study aims to explain the term of confusion in trademark law by considering the issue in a broad context in the light of decisions of Court of Cassation and CJEU. Trademark infringements by the way of likelihood of confusion is more difficult to ascertain and prevent than the other types of infringements. Therefore, it is necessary to clarify this concept and to determine how the trademark rights infringement by likelihood of confusion is carried out and how it can be determined.

In the first part, concept of trademark is explained under Turkish law and EU law, with mentioning different international law instruments. In the second part, the likelihood of confusion on Turkish trademark law is examined with providing many case-laws of the Court of Cassation of Turkey, and partly regulations on EU law and international instruments are also mentioned. In the last part, several decisions of CJEU are analysed to see the approach of EU law to likelihood of confusion.

It was concluded that, relations between European Union and Turkey makes the trademark laws against likelihood of confusion developed in similar way.

Key Words: Trademark, Similarity, Confusion, Europe, CJEU, Court

ÖZET

Dünya genelindeki ticari faaliyetlerde yaşanan gelişmeler, marka kavramının gittikçe daha fazla önem kazanmasını beraberinde getirmektedir. Markaların, temel olarak tüketiciler nezdindeki karıştırılmayı önlemek amacıyla belirli mal ve hizmetleri diğer mal ve hizmetlerden ayırt etmek için kullanılmasına rağmen, en sık görülen marka ihlali türü, iki marka arasında karışıklığa yol açlmaya çalışarak tüketicileri yanıltmak şeklinde gerçekleşmektedir. Böylelikle karıştırılmaya sebep olan taraf, tüketiciyi aldatarak kârını arttırma niyerindedir.

Bu tez çalışmasında, geniş bir çerçevede marka hukukunda karıştırılma ihtimali kavramı açıklanarak Türk hukukunun ve Avrupa hukukukunun konuya yaklaşımlarını uluslararası hukuk enstrümanları ile ele almak ve değerlendirmek amaçlanmaktadır. Belirtilmelidir ki karıştırılma ihtimaline yol açmak suretiyle marka ihlallerinin tespit edilmesi ve önlenmesi diğer ihlal türlerine kıyasla daha zordur. Bu nedenle, karıştırılma ihtimali kavramının açıklığa kavuşturulması ve marka hakkına karıştırılma ihtimali yoluyla tecavüzün nasıl gerçekleştirildiğinin ve nasıl tespit edilebileceğinin belirlenmesi gerekmektedir.

İlk bölümde, Türk Hukuku ve AB hukuku çerçevesinde, farklı uluslararası düzenlemelerden de bahsedilerek marka kavramı açıklanmıştır. İkinci bölümde, birçok Yargıtay içtihadı ile Türk marka hukuku çerçevesinde karıştırılma ihtimali incelenmiş ve kısmen ilgili AB hukuku ile uluslararası düzenlemeler de belirtilmiştir. Son bölümde, AB hukukunun karıştırılma ihtimali konusuna yaklaşımını inclemek için ABAD'ın çeşitli kararları analiz edilmiştir.

Son olarak, Avrupa Birliği ile Türkiye arasındaki ilişkilerin, marka kanunlarının karıştırılma ihtimali konusunda benzer şekilde gelişmesine neden olduğu sonucuna varılmıştır.

Anahtar Sözcükler: Marka, Benzerlik, Karıştırılma, Avrupa, ABAD, Mahkeme