

Applicant should have been aware of opponent's well-known mark, even if parties are engaged in different sectors Examination/opposition
National procedures
Turkey - Kenaroglu Intellectual Property

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In a recent decision, the Re-examination and Evaluation Board of the Turkish Trademark and Patent Association (TPA) has held that the owner of the opposed trademark should have been aware of the opponent's well-known trademark, even if the parties are engaged in different sectors.

The opponent, a leading eyewear company based in Italy, opposed a national application by a local company for a trademark which was indistinguishably similar to the opponent's earlier trademarks in Classes 9 and 28. As the opposed application covered goods in Classes 14 and 37, the main grounds of the opposition were the well-known status of the opponent's brands and the bad faith of the applicant.

The opponent claimed that it was impossible for the applicant to have filed an application for an indistinguishably similar trademark without having been aware of its eyewear brand, which is well known worldwide, despite the fact that the parties are engaged in different sectors.

The opposition was rejected by the Trademark Directorate of the TPA, and the opponent appealed the refusal decision before the Re-examination and Evaluation Board of the TPA.

The board held that the opponent's mark is well known worldwide in the eyewear industry, and that it was no coincidence that the applicant had filed an application for a trademark that was highly similar to the opponent's earlier trademarks. The board further stated that, as the applicant was obliged to act as a prudent merchant, it should have avoided to choose an indistinguishably similar trademark, even for different goods/services. The board thus found that the applicant had clearly acted in bad faith when filing the trademark application, and concluded that such bad faith was sufficient in itself to refuse the trademark application.

Although applicants/registrants have been required to act as prudent merchants by both the TPA and the IP courts, the obligation to consider well-known trademarks and refrain from filing applications for identical or similar trademarks had so far been limited to well-known trademarks within the same sector. This landmark decision by the board extends this obligation to well-known trademarks in different sectors; consequently, local companies must avoid applying for any trademark that is identical and/or similar to a well-known trademark in any sector.

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