

Turkish Higher Board takes different approaches to same device element in separate decisions Examination/opposition
Registration
Turkey - Gün + Partners National procedures

March 12 2018

- Higher Board upheld oppositions against PELOTON ISTANBUL and CLUB PELOTONIST based on earlier PELOTON mark
- In both cases board considered device present in opponent's mark as actually used
- However, board followed different approaches to bad-faith claim

The Re-examination and Evaluation Board (the 'Higher Board') of the Turkish Patent and Trademark Office has found that, in addition to the similarity of the word elements in the trademarks under comparison, the presence of a device element similar to the opponent's trademark as actually used increased the likelihood of confusion.

Facts

On November 28 2016 and November 30 2016 two individuals applied to register the signs depicted below, both in Class 41.



Following publication in the *Official Trademark Bulletin* of the Patent and Trademark Office, the owner of an earlier registration for the word mark PELOTON in Classes 28, 38 and 41 in Turkey opposed both applications pursuant to Article 8/1(b) (likelihood of confusion), Article 8/4 (likelihood of damaging the well-known status of a trademark) and Article 35 (bad-faith filing) of the [Decree-Law 556 on the Protection of Trademarks](#).

The Trademarks Department of the Patent and Trademark Office accepted both oppositions in part. In both decisions, the Trademarks Department found that there was a likelihood of confusion between the trademarks, but rejected the other grounds of opposition.

As a result of the Trademarks Department's decision, the application for the PELOTON ISTANBUL mark was partially refused for "training and educational services; services for arranging and conducting symposiums, conferences, congresses and seminars; sport, culture and entertainment services (including services for the reservation and provision of tickets for cultural and entertainment activities such as cinema, sport competitions, theatre, museums and concerts); making publications such as magazines, books and newspapers ready for publication, and providing them to the readers (including providing those services via global communication networks)" in Class 41.

On the other hand, the second decision refused the application for CLUB PELOTONIST only for "training and educational services; services for arranging and conducting symposiums, conferences, congresses and seminars; sport, culture and entertainment services (including services for the reservation and provision of tickets for cultural and entertainment activities such as cinema, sport competitions, theatre, museums and concerts)" in Class 41, although the initial coverage of both trademarks was identical.

The opponent appealed both decisions of the Trademarks Department, arguing that the applications should be rejected in their entirety for all services, and that the other grounds of opposition (damage to the well-known status of its mark and bad-faith filing) should also be upheld.


Decisions of the Higher Board

In its first decision, the Higher Board, commenting on the principle of interdependence, stated as follows:

"In respect of the likelihood of confusion, there is an interaction between the relevant factors, particularly between the trademarks, the goods and the services, at a certain level. Accordingly, a lower level of similarity between the goods and services can be counterbalanced with a higher level of similarity between the elements forming the trademarks, or vice versa. A likelihood of confusion may not arise due to a weak similarity between the trademarks, despite the strong similarity between

the goods and services.”

The Higher Board also mentioned that the word 'peloton', which is found in both trademarks, has an actual meaning, but the originality of this word was relatively low. Furthermore, the Higher Board paid attention to

the fact that the device , which is present in the opponent's trademark, as it is actually used and in its other trademarks registered abroad, was similar to the device element in the application at issue; it even included samples of the signs in its decision.


Consequently, the Higher Board accepted the opponent's appeal and decided to refuse the trademark application for PELOTON ISTANBUL for all services.

In its second decision, the Higher Board agreed that the trademarks were confusingly similar; even if the services remaining within the scope of the application were not identical to the services covered by the PELOTON word mark, the appeal should be allowed and the application for CLUB PELOTONIST should be refused in its entirety. It was not possible to accept that the applicant had applied for such a similar trademark (containing both the word 'peloton' and the device element present in the opponent's trademark as actually used and in other trademarks registered abroad) without being aware of the opponent and its trademark. The Higher Board concluded that the application had been filed in bad faith and decided to reject it for all the services at issue.

Comment

Two similar trademark applications were at stake here, and they were both challenged based on the same opposition grounds by the owner of the PELOTON trademark. In one of the decisions, the Higher Board interpreted the presence of a similar device as an element that increased the likelihood of confusion. The principle of interdependence was discussed and taken into account, while the possibility of bad-faith filing was not mentioned at all.

On the other hand, in the second decision, the Higher Board assessed the presence of a similar device element as a sign of bad faith and found that it was not possible to accept that the applicant had filed the application without being aware of the opponent or its trademark.

It is highly valuable that the Higher Board came to this conclusion, even if the  device is not used or registered in Turkey. Although the office could have accepted the appeals by comparing only the word elements in the trademarks (as the ground trademark is registered only as a word mark in Turkey) when evaluating the likelihood of confusion, it took a further step and considered the device element present in the opponent's trademark as used and in other trademarks registered abroad.

Even though both decisions reached the same conclusion, their reasoning is quite different. The Higher Board adopted two different approaches to two similar matters. Arguably the second approach should be supported, as it allowed the bad-faith claim; it is hoped that the Higher Board (as well as the Trademarks Department) will change its attitude to bad-faith filings in future similar cases.

Güldeniz Doğan Alkan and Dilan Sıla Kayalica, Gün + Partners, Istanbul

World Trademark Review (www.worldtrademarkreview.com) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.