

PTO decision sheds light on protection of well-known trademarks

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- The PTO partially upheld HP Hewlett Packard's opposition against a mark containing the element 'HP' based only on the likelihood of confusion ground
- On appeal, the board upheld the opponent's well-known trademark claim
- Notably, the opponent's evidence showed the HP marks used in a blue colour and the contested mark displayed the same colour

The Re-examination and Evaluation Board of the Turkish Patent and Trademark Office (PTO) has rejected a trademark application that consisted of the same word element, in the same colour, as the opponent's well-known trademark.

Background

On 21 October 2021 a Turkish individual filed an application to register the trademark below in Classes 35, 37 and 45:



Following the publication of the application in the *Official Trademarks Bulletin*, HP Hewlett Packard Group LLC, the owner of the well-known HP word mark and HP device mark (depicted below), filed an opposition against all the services covered by the application.



The opposition was based on the legal grounds of:

- likelihood of confusion;
- well-known status of the HP marks; and
- bad faith of the applicant.

The PTO 's Trademarks Department partially accepted the opposition on 18 August 2022, ruling that the application would cause a likelihood of confusion with the HP marks for the same and similar services; however, it did not consider the other grounds of opposition.

Seeking the recognition of the well-known status of the HP marks in this case and future cases, the opponent appealed and asked the board to re-examine the opposition.

Decision

On 5 January 2023 the board accepted the opponent's well-known trademark claim. In deciding in the opponent's favour, the board determined that the HP marks are well known for electronic goods, such as computers and data processing devices, in Turkey and abroad. Noting that the opponent's evidence showed the HP marks used in a blue colour and that the contested application used the same blue colour, the board concluded that the mark applied for might unfairly benefit from the reputation of the well-known HP marks and might harm the distinctive character of the marks. Therefore, the application should be rejected.

Comment

Notably, the board did not merely consider the similarity of the word elements of the conflicting trademarks. It also established a crucial link between the colour used in the application sample and the opponent's actual use of the HP marks in assessing the conditions for a well-known trademark claim. The ruling also shows how introducing all relevant material facts and conditions specific to both the trademark on which the opposition is based and the opposed trademark can help the PTO assess the legal grounds of a case.

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