

Registrability of Abbreviation Marks in Turkey

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The registrability of abbreviation marks in Turkey, especially where there is the likelihood of confusion between a prior registration and a subsequent application, has been looked at in several situations by the Turkish Patent Institute (TPI). Under the TPI's Trademark Examination Guidelines, the likelihood of confusion between two abbreviation marks in the context of registrability is assessed according to the "Absolute Grounds for Refusal" criteria in Article 7 of the Turkish Trademark Law (Decree-Law No. 556, June 27, 1995). As in many other jurisdictions, if the mark of a subsequently filed application (the junior mark) is confusingly similar to an existing registered trademark (the senior mark), registration will be refused. The question becomes, then, when will the TPI view two abbreviation marks as confusingly similar?

Abbreviation Using the First Letters of a Senior Mark

The first situation that the TPI addresses in its Guidelines is whether an abbreviation can be registered if it is identical to an existing registered trademark, with the only difference being the addition of an abbreviation consisting of the first letters of the mark in question.

Registered Mark	Goods	Mark Applied For	Goods	Decision
MARVIN SILVER	T-shirts	MS MARVIN SILVER	T-shirts	Confusingly similar
AKSOY GIDA (AKSOY FOOD)	Milk, milk products	AG AKSOY GIDA	Milk, milk products	Confusingly similar

As noted the table at right, in these situations, the TPI typically has refused registration, on the ground that the junior mark is confusingly similar to the senior mark. The TPI bases these decisions on the rationale that the first letter is generally the most dominant letter of a word. As such, the addition of the abbreviation has been held insufficient to distinguish the junior mark from the senior mark.

Abbreviation Using Letters That Differ from the First Letters of a Senior Mark

In a similar situation, the TPI has looked at cases where the only difference between the marks is that the junior mark contains an abbreviation that is not the first letters of the senior mark—for example, if the marks were MARVIN SILVER (the senior mark) and OP MARVIN SILVER (the junior mark).

In these situations, the TPI looks at a variety of factors, including the length of the abbreviation and whether the abbreviation has any meaning itself and/or whether it is commonly known. If the abbreviation is commonly known and short, there is a risk that the application for the junior mark will be denied on the ground that the mark is confusingly similar to the senior mark. Additionally, if the non-abbreviation elements of the junior mark are not distinctive enough or are too similar to the senior mark, the application could similarly be rejected by the examiner. So, in our example, it is likely that an

examiner at the TPI would reject a trademark application for OP MARVIN SILVER on the ground that the mark would be likely to cause confusion with the existing MARVIN SILVER trademark registration.

Abbreviations Composed of Nondistinctive Letters

The TPI also provides direction in its Guidelines for situations where (1) a junior mark consists of an abbreviation that is not in itself distinctive, (2) the junior mark and the senior mark differ and (3) the senior mark consists of highly distinctive elements. In these situations, the TPI will look at the overall similarity—or lack thereof—of the two marks. According to the Guidelines:

[i]f the abbreviation is considered as the primary distinctive element due to its positioning and the common word element possesses a low distinctive character, no confusing similarity exists between the marks. The overall distinctive value of the trademarks must be considered.

Guidelines, Article 4.2.3.8.2.1. For example, in the two applications listed in the table, the TPI considered the main elements to be more important than the descriptive ones:

Registered Mark	Goods/ Services	Mark Applied For	Goods	Decision
ACACIA GOLD	Watches	M ACACIA JEWEL- LERY	Jewelry	Confusingly similar
KAR SHOP	Retail services	MLT KAR MARKET	Retail services	Not confusingly similar

As a result, the marks ACACIA GOLD and M ACACIA JEWELLERY were viewed as confusingly similar, because the dominant element, ACACIA (a word with no meaning in Turkish), was identical. On the other hand, the marks KAR SHOP and MLT KAR MARKET were not viewed as confusingly similar because the junior mark contained a distinctive abbreviation and the other elements of each mark were both common words (KAR means “snow” in Turkish).

Registered Mark	Goods	Mark Applied For	Goods	Decision
EMMIÖGLU	Marbles	ME EMMIÖGLU	Marbles	Confusingly similar
BERK	Shoes	TE BERK	Shoes	Not confusingly similar

In addition to the above analysis, the TPI also places weight on the length of the common word accompanying the abbreviation. It is the TPI’s position that longer words (i.e., those with more letters) are more distinctive than shorter words. As seen in the table to the left, the word “EMMIÖGLU” (“cousin”) consists of more letters than the word “BERK” (“strong”). As a result, the TPI found confusion between the marks EMMIÖGLU and ME EMMIÖGLU, but not between the marks BERK and TE BERK:

While there are some exceptions to this rule, there is usually a direct correlation between the number of the letters in the word accompanying the abbreviation and the finding of distinctiveness. As a result, companies may have difficulty obtaining a registration where they file an application for a mark that consists of an abbreviation and a short, common word and there is already a registration on file for the same short, common word.

Abbreviations That Are the Consonants of the Mark

In Turkey, applications to register marks that appear to be abbreviations but are actually just words with the vowels removed are increasing in frequency. The word VWL, instead of VOWEL, is an example. When there is a prior registration for a similar mark—but with the vowels still in place—the issue of registrability has been hotly debated by the TPI. Typically, there are two groups of marks that fall in this category: (1) marks consisting of only a word’s consonant abbreviation (e.g., VWL) and (2) marks consisting of a verbal element and its equivalent consonant abbreviation.

Registered Mark	Goods/ Services	Mark Applied For	Goods	Decision
UTKU	Restaurants	UTK UTKU	Restaurants	Not confusingly similar
DESTINY	Socks	DSTNY	Socks	Not confusingly similar
MYWORLD	Agencies	MYWRLD	Agencies	Confusingly similar
OZKAYNAK	Waters	OZKYNK	Waters	Confusingly similar

For marks in the first group, the TPI usually will look at the number of consonants and the general effect of the mark on consumers. As a result, while the marks DSTNY and DESTINY may not be confusingly similar, the mark MYWRLD is confusingly similar to the mark MYWORLD.

Registered Mark	Goods	Mark Applied For	Goods	Decision
AKIN	Windows	AKINPEN	Windows	Not confusingly similar
KAR	Electronic devices	KARTECH	Electronic devices	Not confusingly similar
OZTURK	Electronic devices	OZTURKTECH	Electronic devices	Confusingly similar
KARDESLER	Printing	KARDESLERSAN	Printing	Confusingly similar

For marks in the second group, the TPI often will look to whether the abbreviated word is itself descriptive, as well as examining the other elements of the marks. Thus, in the below examples, the mark AKINPEN (where PEN is the first three letters of the Turkish word meaning “window” and this abbreviation is commonly used to refer to companies that produce windows) was not seen as confusingly similar to the mark AKIN. Similarly, the abbreviation TECH generally is used by technology companies; the abbreviation SAN, the first three letters of the Turkish word for “industry,” generally is used by industrial companies; and the abbreviation MAK, the first three letters of the Turkish word for “machine,” generally is used by companies that produce machines.

Conclusion

As outlined above, the TPI has provided applicants with an overview of when an application for a mark that contains an abbreviation might be refused, based on an existing registration for a similar mark. The decisions reached by the TPI might not always be what those who are not familiar with Turkish trademark practice might expect. And, in some cases, the TPI has reached decisions that might be seen as differing from the Guidelines, or the Guidelines may not provide clear direction. Registrants in Turkey are therefore advised to monitor the Turkish registry and look for applications to register potentially similar marks containing abbreviations. These applications could be for marks that are identical or similar to their own registered trademarks, and the applied-for marks could be used in connection with similar goods or services.

If a registrant finds that such an application has been filed, it can file an opposition during the publication period, and if the opposition is rejected, the rejection can be appealed. On appeal, the application will be reexamined by an evaluation board of the TPI, which will result in the final decision of the Institute. After that decision, cancellation is possible through the courts.

Although every effort has been made to verify the accuracy of items in the INTA Bulletin, readers are urged to check independently on matters of specific concern or interest.