

“IDENTITY OR SIMILARITY OF GOODS OR SERVICES” UNDER THE INDUSTRIAL PROPERTY CODE NO. 6769

6769 SAYILI SİNAİ MÜLKİYET KANUNU KAPSAMINDA “MAL VEYA HİZMETLERİN AYNILIĞI YA DA BENZERLİĞİ”

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Abstract: A great majority of disputes arising from trademark law consist of infringement and invalidity cases of trademark rights. In both cases, it is examined whether the trademarks in dispute are identical or similar, the identity or similarity of the goods or services within the scope of the trademark and the likelihood of confusion. In terms of evaluating the similarity of the goods or services covered by the trademarks subject to comparison, there are no directly accepted criteria in the legal regulations regarding trademark law. For this reason, within the scope of this study, it has been attempted to explain the criteria by which the relevant evaluation can be made in line with the decisions of the Court of Cassation and the Court of Justice of the European Union, the views of the doctrine and the principles set forth in practice.

Keywords: Intellectual Property, Industrial Property, Trademark Law, Similar Product, Likelihood of Confusion

Özet: Marka hukukundan doğan uyuşmazlıkların büyük çoğunluğunu marka hakkına tecavüz ve hükümsüzlük davaları oluşturmaktadır. Her iki dava kapsamında da uyuşmazlığa konu markaların aynı ya da benzer olup olmadığı, markanın kapsamındaki mal veya hizmetlerin aynılığı ya da benzerliği ve karıştırılma ihtimalinin varlığı irdelenmektedir. Karşılaştırmaya konu markaların kapsadığı mal ya da hizmetlerin benzerliğinin değerlendirilmesi noktasında, marka hukukuna ilişkin hukuki düzenlemelerde doğrudan kabul edilen **ölçütler** söz konusu değildir. Bu nedenle, bu **çalışma** kapsamında ilgili değerlendirmenin hangi **ölçütlerle** gerçekleştirilebileceğine Yargıtay ve Avrupa Birliği Adalet Divanı kararları, doktrinin görüşleri ve uygulamada ortaya konulan ilkeler doğrultusunda açıklama getirilmeye **çalışılmıştır**.

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INTRODUCTION

In the Industrial Property Code No. 6769,¹ as² in the Decree-Law No. 556 on the Protection of Trademarks,³ provisions are introduced to protect the rights of prior holders who have applied for or registered their trademarks. Within this scope, if the registration of an identical or indistinguishably similar trademark for identical/similar goods/services is requested, the Turkish Patent and Trademark Office⁴ has the authority to reject the application *ex officio*.⁵ Additionally, if the registration of an identical/similar trademark for identical/similar goods/services is requested, the previous applicant/trademark holder is granted the opportunity to raise an objection.⁶

As the relative ground for refusal regulated in Article 6/1 of the IPC is also stated as a ground for invalidity in Article 25/1 of the same law, the concepts of "identical/similar trademark," "identical/similar goods/services," and "likelihood of confusion" are essential terms that need to be discussed due to the crucial role in shaping the practice.⁷ The subject of our study, "identity/similarity of goods/services," has frequently been interpreted in legal doctrine and court decisions. However, within the scope of legal regulations in the context of trademark law, how this concept will be precisely defined remains uncertain.

Within the scope of our study, we will primarily focus on the position and importance of goods/services identity/similarity in Turkish legal system, along with its connection to the likelihood of confusion. Following that, we will attempt to explain the method depending the degree of similarity and the role of the classification system in determining identity/similarity. Finally, the study will

¹ OJ, D. 10.01.2017, N. 29944. Throughout the remainder of the study, "IPC" will be used as a brief reference.

² OJ, D. 27.06.1995, N. 22326. Throughout the remainder of the study, "Decree-Law No. 556" will be used as a brief reference.

³ Decree-Law No. 556, Art. 8/1-a, Art. 8/1-b, and Art. 42/1-b.

⁴ Throughout the remainder of the study, "TURKPATENT" will be used as a brief reference.

⁵ IPC Art. 5/1-ç.

⁶ IPC Art 6/1.

⁷ The relevant concepts have been evaluated in both doctrine and judicial decisions during the period of Decree-Law No. 556; however, the topic still maintains its significance.

include discussions on the supplementary methods utilized by industrial property registration offices to determine the similarity of goods/services, along with the criteria set forth by judicial decisions and legal doctrine in this context.

I. IDENTITY/SIMILARITY OF GOODS/SERVICES UNDER THE TURKISH LAW

In accordance with Article 4 of IPC No. 6769, a trademark ensures the distinction of goods or services of one enterprise from those of another enterprise. This matter is closely related to the origin indicating function of the trademark. The origin indicating function of a trademark is legally protected as its fundamental role. Through this function, even if the consumer is not familiar with the enterprise, the relevant public relies on the enterprise and associates the product with it. Therefore, trademarks are assigned the duty to prevent the public from being misled about the origin of the product offered.⁸ In the *Copad/Dior* case, the Court of Justice of the European Union emphasized this point in its ruling, stating, “...it must be borne in mind that, according to settled case-law, the essential function of a trade mark is to guarantee the identity of the origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish those goods or services from others which have another origin.”⁹

The issue of similarity of goods/services within the scope of Article 6/1 of the IPC, which constitutes the subject of our study, is closely related to the likelihood of confusion by the relevant public to which the product is addressed. In this context, when the registration of a trademark for identical/similar goods/services that have previously been applied for or registered in the name of another party is prevented, it also serves the purpose of fulfilling the origin indicating function.

⁸ Sevilay Uzunalli, “Marka Hukukunda Malların ve/veya Hizmetlerin Benzerliğinin Tespiti Sorunu (Problem of Determining Similarity of Goods and/or Services in Trademark Law)”, *Prof. Dr. Hamdi Yasaman’a Armağan*, İstanbul, 2017, p. 680.

⁹ Court of Justice of the European Union (CJEU), D. 29.09.1998, C-39/97, Canon Kabushiki Kaisha v. Metro-Goldwyn Mayer Inc., para. 28 (curia.europa.eu, Last accessed: 06.06.2021).

A. Importance of Determining Identity or Similarity of Goods/ Services

Pursuant to the trademark legislation, significance is attributed to the situation where an application is filed for an identical/similar sign for identical/similar goods/services as a trademark that has previously been applied for or registered by someone else. This matter has been addressed within the scope of both Article 5/1-ç, which is an absolute ground for refusal, and Article 6/1, which is a relative ground for refusal, of the IPC.

In accordance with Article 5/1-ç of the IPC, trademarks that consist of *“identical or indistinguishably similar signs to trademarks that have been registered or applied for registration for the same or similar goods or services”* will be rejected ex-officio by TURKPATENT. The legislator has regulated the refusal of applications that contain signs identical or indistinguishably similar to trademarks owned by earlier applicants and covering identical or similar goods/services. In this case, when a trademark application is submitted to TURKPATENT, the examiner that is responsible for conducting the examination of absolute grounds for refusal will need to determine whether the goods or services are identical or of the same type.

The first paragraph of Article 6 of the IPC, which regulates the grounds for opposition against the publication of a trademark application, states that;

“If a trademark application is likely to be confused with a registered or previously applied-for trademark due to its identity or similarity to such trademark and identity or similarity of the goods or services covered, including the likelihood of association by the public with the registered or previously applied-for trademark, the application shall be refused upon opposition.” In accordance with this provision, the rejection of a trademark application will only occur if, upon opposition, it is determined that the goods or services are identical or similar provided that other conditions are also met.

The determination of similarity of goods/services is also significant for the fundamental aspects of trademark law, namely invalidity

and infringement actions.¹⁰ This is because, in cases of reasons of trademark invalidity as stipulated in Article 25/1 of the IPC, the presence of the grounds specified in Article 5 or 6 of the IPC is sought. Therefore, if a trademark has been registered despite the existence of a ground for refusal by TURKPATENT, an action for invalidation can be initiated, and within the scope of the case, the determination of identity/similarity of goods/services will be necessary. Similarly, the use of an unregistered trademark that may lead to confusion with a registered trademark constitutes an infringement of trademark rights under Article 29/1-a of the IPC (due to the reference to Article 7 of the IPC). Consequently, actions for declaratory judgment, prevention of infringement, cessation of infringing activities, prohibition of infringement, and claims for compensation can be filed as stipulated in Article 149/1 of the IPC.¹¹ In this case, undoubtedly, the determination of similarity of goods/services will also be necessary. However, making such determination, especially in terms of the “similarity” of goods/services, is quite challenging.¹² In the subsequent sections of the study, solutions developed by doctrine and practice on how to overcome this difficulty will be explained.

Relationship Between Similarity of Goods/Services and Likelihood of Confusion

Determination of whether goods and services are similar or not holds significance in the context of likelihood of confusion, as it plays a crucial role in determining the point at which similarity of goods and services might lead to confusion. The common consensus is that the presence of a likelihood of confusion depends on the prerequisite of the similarity of goods/services.¹³ This conclusion is also evident from the explicit provision of Article 6/1 of the IPC. Moreover, under the IPC, the registration of a trademark for goods/services different

¹⁰ Ali Paşlı, *Marka Hukukunda Ürün Benzerliği (Product Similarity in Trademark Law)*, Istanbul 2018, p. 2.

¹¹ Uzunallı, p. 676.

¹² Paşlı, p. 2; Uzunallı, p. 678.

¹³ Paşlı, p. 6; Uzunallı, p. 678; TURKPATENT 2021 Trademark Examination Guideline, p. 383 (<https://www.turkpatent.gov.tr/TURKPATENT/resources/temp/CFF1AE84-9563-42D6-BC18-1EF3597D01CC.pdf>, Last accessed: 17.10.2021). Throughout the remainder of the study, “2021 Guideline” will be used as a brief reference.

from those within the scope of a previously registered or an applied-for trademark has not been prohibited, with the exception of well-known trademarks. Therefore, in the assessment made regarding the existence of a likelihood of confusion under Article 6/1 of the IPC, it is essential to determine primarily whether the goods/services are similar. However, the presence of similarity of goods/services does not necessarily imply the presence of a likelihood of confusion in all cases.¹⁴

There are different views in doctrine regarding how the likelihood of confusion in the examination of similarity of goods and services will be addressed. According to one perspective, the likelihood of confusion should be analyzed in two stages.¹⁵ First, the determination of the similarity of goods/services should be made, and then the criteria of similarity between the signs and their distinctive character should be examined. Because if there is no similarity of goods/services, the likelihood of confusion will also be eliminated.¹⁶ According to authors with opposing views, it has been argued that the likelihood of confusion should be evaluated in a single stage, taking all elements into account collectively.¹⁷ According to Paslı, who supports this view, similarity of the signs and distinctive character of the trademarks should be considered to determine the likelihood of confusion. In this context, (as indirectly indicated in the *Sabel-Puma* decision¹⁸ by the European Court of Justice), the higher the distinctive character of a trademark is in terms of its signification, the broader the scope of evaluation should be for identifying similar goods and services within the scope of protection of the trademark.¹⁹ Similarly, the author states that as the degree of similarity between the elements constituting the trademarks increases, the likelihood of similarity between the products will also

¹⁴ Paslı, p. 6.

¹⁵ Uğur Çolak, *Türk Marka Hukuku (Turkish Trademark Law)*, 4th Edition, Istanbul 2018, p. 200; Uzunallı, p. 677.

¹⁶ Uzunallı, p. 677.

¹⁷ Hanife Dirikkan, *Tanınmış Markanın Korunması (Protection of Well-Known Trademarks)*, Ankara 2003, p. 191; Canan Küçükali, *Marka Hukukunda Karıştırma Tehlikesi (Likelihood of Confusion in Trademark Law)*, Ankara 2009, p. 107.

¹⁸ CJEU, D. 11.11.1997, C-251/95, *Sabel v. Puma, Rudolf Dassler Sport* (ipcuria.eu, Last accessed: 06.06.2021).

¹⁹ Paslı, p. 61.

increase.²⁰ According to Arkan, when different goods/services are involved in assessing the existence of a likelihood of confusion, the risk of confusion diminishes, and there is no need for a high degree of distinctiveness.²¹

In the 2021 Trademark Examination Guideline published by TURKPATENT, it is indicated that the examination of similarity of goods/services will be conducted independently of the degree of similarity between the trademarks and the distinctiveness of the earlier trademark.²²

In our view, while both the similarity of signs and the similarity of goods/services elements are necessary in terms of the presence of a likelihood of confusion²³, it is primarily essential to evaluate whether the goods/services are similar. As mentioned, with the exception of well-known trademarks, the registration of a previously registered trademark for different goods/services is possible under Turkish law. Therefore, we agree with the perspective that the similarity of goods/services and the similarity of the signs should be independently assessed. In the event of finding similarity between goods/services, we believe that the similarity of the sign and its high distinctiveness will increase the likelihood of confusion.

II. THE DEGREE OF SIMILARITY AND THE CLASSIFICATION SYSTEM

A. The Role of Nice Classification in Determining the Similarity of Goods/Services

In accordance with Article 11/3 of the IPC, the goods or services subject to trademark applications are classified according to the Nice Agreement concerning the International Classification of Goods and

²⁰ Paslı, p. 60.

²¹ Sabih Arkan, *Marka Hukuku (Trademark Law)*, Vol. 1, Ankara 1997, p. 98. See also. Dilek İmirlioğlu, *Marka Hukukunda Ayırt Edicilik ve Markanın Ayırt Ediciliğinin Zedelenmesi (Distinctiveness in Trademark Law and Dilution of Trademark Distinctiveness)*, 2nd Edition, Ankara 2018, p. 164.

²² 2021 Guideline, p. 384.

²³ Court of Cassation 11th Civil Chamber, D. 22.01.2015, Case No. 2014/15360, Judgment No. 2015/865 (Kazancı Case Law Database, Last Access Date: 06.06.2021).

Services for the Purposes of the Registration of Marks,²⁴ to which Türkiye is a party. The Nice classification has been prepared with the aim of preventing issues arising from the lack of classification of goods and services during the registration, examination, publication of trademarks, and other relevant stages, as well as implementing a standardized classification system on an international scale.²⁵

Nice classification consists of 34 classes for goods and 11 classes for services. Each class is organized to group similar goods or services under the same category.²⁶ TURKPATENT has published the Communiqué on Classification of Goods and Services for Trademark Applications²⁷ in accordance with the Nice Agreement. In the list established by the Communiqué on Classification, certain groups are organized under general headings, and it is accepted that the general heading covers all goods/services falling within its scope and within the relevant Nice class (Communiqué on Classification, Article 3/2). Since it is not possible for all goods/services to be included in the list determined by the said Communiqué, Article 3/3 of the Communiqué on Classification states that:

"If goods or services that do not fall within the scope of any general heading and are not mentioned in the list are included in a trademark registration application, then such goods or services will be evaluated within the same scope as the goods or services listed in the same Nice class that have similar nature, function, or purpose."

The sole obligation that the Nice Agreement imposes on the national offices of member countries is to include the Nice class to which the trademark pertains in the documents prepared and in the publications

²⁴ "Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks" (<https://wipolex.wipo.int/en/text/287437>, Last accessed: 06.06.2021). Throughout the remainder of the study, "Nice Agreement" will be used as a brief reference. The classification system accepted under the agreement will be referred to as the "Nice Classification."

²⁵ Önder Erol Ünsal, "Markaların Tescili Konusunda Uluslararası Nis ve Viyana Sınıflandırmaları: Amaç, İşleyiş ve Uygulamaya İlişkin Değerlendirmeler (International Nice and Vienna Classifications on Trademark Registration: Assessments Regarding Purpose, Functioning, and Implementation)", Turkish Patent Institute Expertise Thesis, Ankara 2001, p.5.

²⁶ Ünsal, p. 19.

²⁷ OJ, D. 30.12.2016, N. 29934. Throughout the remainder of the study, "Communiqué on Classification" will be used as a brief reference.

made for the trademark.²⁸ In accordance with the first paragraph of Article 2 of the said Agreement, the classification does not have a binding effect on the assessment of the scope of protection afforded to any registered trademark. The second paragraph of the same article specifies that each state has the right to use the classification system provided by the Nice Agreement as the main system or as an auxiliary system.

At this point, it is beneficial to evaluate the binding nature of the Nice classification system in relation to the issue of the similarity of goods/services. In this context, two questions come to mind. Firstly, what role will the classification system play in the assessment of similarity when an objection is raised upon the publication of a trademark application submitted to TURKPATENT for registration? Secondly, what role does the classification system play in the assessment of similarity of goods/services that courts will undertake in cases brought before them?

Article 11/4 of the IPC stipulates that *“The fact that goods or services are in the same classes shall not be inferred as indicating their similarity, and the fact that they are in different classes shall not be inferred as indicating their dissimilarity.”* Article 24 of Decree-Law No. 556 also specifies that the classification of goods and services was intended for the purpose of trademark registration. In this context, legal doctrine expresses that attributing a power to the classification system beyond the function of registration would not be accurate.²⁹

In its 2007 CASA decision, the Court of Cassation stated that the Nice classification is not binding.³⁰ In the light of these statements and precedents, it can be argued that in the evaluation of similarity of goods/services within the specific context of a court case, there is no obligation to interpret that the absence of the same Nice classes implies the absence of similar goods/services. In summary, although the Communiqué on Classification issued by TURKPATENT can be

²⁸ Ünsal, p. 5.

²⁹ Çolak, p. 212; Paşlı, p. 31; Ünal Tekinalp, *Fikri Mülkiyet Hukuku (Intellectual Property Law)*, 5th Edition, Istanbul 2012, p. 442; Uzunallı, p. 682, 683.

³⁰ Court of Cassation 11th Civil Chamber, D. 05.02.2007, Case No. 2005/13645, Judgment No. 2007/1319. See also. Court of Cassation 11th Civil Chamber, D. 27.04.2015, Case No. 2015/865, Judgment No. 2015/5841 (Kazancı Case Law Database, Last accessed: 06.06.2021).

taken into consideration by the court, it does not possess a binding authority.³¹

Answering the first question requires explaining the degree of similarity between goods/services within the scope of positive law regulations and establishing its connection with the Nice classification.

B. The Degree of Similarity Between Goods/Services

In the IPC, a registered trademark is protected not only for the goods/services it covers, but also for similar goods/services. The use of an identical or similar sign, even for similar goods/services, constitutes a ground for refusal of registration, invalidity, and infringement.³² In this regard, it would be beneficial to provide clarification in the relevant articles of the IPC regarding the terminology "identical/same type/similar goods or services."

1. The Concept of Identical Goods/Services

According to Article 5/1-ç of the IPC, the registration of a trademark that contains an identical or indistinguishably similar sign to a previously registered or an applied-for trademark for identical/same type goods or services must be refused ex officio. Under Article 6/1 of the IPC, the request for registration of an identical/similar trademark with an earlier trademark for identical/similar goods or services will be refused upon opposition if there is a likelihood of confusion. Based on these provisions, the registration of the identical trademark for identical/similar goods or services is envisaged as both an absolute and a relative ground for refusal.³³

In the case of identical goods/services, there will be no ambiguity, and it will be implied that the goods or services listed in the registration certificate are identical. However, determining what constitutes the "same type" of goods or services is not straightforward, as neither

³¹ Çolak, p. 211.

³² Paşlı, p. 23.

³³ Under the Decree-Law No. 556, the mentioned ground for refusal was regulated both in Article 7 concerning absolute grounds for refusal and in the subparagraph (a) of the first paragraph of Article 8 concerning relative grounds for refusal. It has been argued that considering the same reason as both an absolute and a relative ground for refusal is not accurate. See. Arkan, p. 75.

Decree-Law No. 556 nor the IPC No. 6769 defines it.³⁴ In Article 3/4 of the Communiqué on Classification, it is stipulated that for determining the same type of goods or services, the groups listed in the annex of the Communiqué will be taken into account. However, it is also mentioned that during the application for registration or objection stages, TURKPATENT can evaluate these groups in a narrower or broader manner to include different groups of goods or services when determining the same type of goods or services.

Although it may be stated that minor differences in the signs do not eliminate identity, this does not apply to goods or services.³⁵ The issue may only arise when the goods or services are not identical in wording.³⁶ According to Article 9/2 of the Regulation on the Implementation of the Industrial Property Code³⁷, it is required that the goods/services for which trademark registration is sought be presented by categorizing them into Nice classes and indicating the class numbers of the goods/services. However, in the following paragraph, it is stated that if the applicant uses general terms or expressions that need clarification by TURKPATENT, a two-month period will be granted. Therefore, as long as it is in accordance with the Nice classification, the person applying for a trademark can specify the goods and services using their own phrasing. As a result, identical goods/services can be expressed in different ways.³⁸ Furthermore, according to the 2021 Guideline, in cases where identical goods/services have multiple names or where the usage in the market is different from the technical/scientific/literary name or where the name in a foreign language has been adopted into Turkish, even if the goods/services are expressed differently, they will be considered as identical.³⁹

In some cases, even if products are expressed in the same manner, they might be considered different based on their intended use.⁴⁰ As

³⁴ Savaş Bozbel, *Fikri Mülkiyet Hukuku (Intellectual Property Law)*, İstanbul 2015, p. 383.

³⁵ Yasaman Hamdi/Altay Sıtkı Anlam/Ayoğlu Tolga/Yusufoğlu Fülürya/Yüksel Sinan, *Marka Hukuku 556 Sayılı KHK Şerhi (Commentary on Decree-Law No. 556 on Trademark Law)*, Vol. 1, İstanbul 2004, p. 228.

³⁶ Paslı, p. 50.

³⁷ OJ, D. 24.04.2017, N. 30047.

³⁸ Paslı, p. 51.

³⁹ 2021 Guideline, p. 392.

⁴⁰ Paslı, p. 52.

exemplified in the European Union Intellectual Property Office's⁴¹ Guidelines for Examination of the European Union Trademarks, in class 9, the application for "laser" is intended for industrial use, while the application for "laser" in class 10 is for medical purposes.⁴² In this scenario, the products would be considered different due to their distinct intended uses.

According to Part C, Section 2, Chapter 2, Paragraph 2.3.2 of the EUIPO Examination Guidelines, *"If the goods/services designated in the earlier mark are covered by a general indication or broad category used in the contested mark, these goods/services must be considered identical since the Office cannot dissect ex officio the broad category of the applicant's/holder's goods/services."* For example, if the earlier trademark pertains to marine vessel goods and the subsequent trademark application is for marine vehicles, the subsequent application will be considered as having been made for identical goods.⁴³ According to Part C, Section 2, Chapter 2, Paragraph 2.3.1 of the mentioned Guidelines, where the list of goods/services of the earlier right includes a general indication or a broad category that covers the goods/services of the subsequent application in their entirety, the goods/services will be considered as identical.⁴⁴

The 2021 Guideline published by TURKPATENT also contains provisions parallel to the EUIPO Examination Guidelines regarding the presence of explanatory and specific expressions related to the content. According to the 2021 Guideline, if a general expression is followed by the word "especially," it is accepted that this expression is not limited to the goods/services that follow it, but also encompasses the general expression.⁴⁵ However, when a general expression is followed by the

⁴¹ European Union Intellectual Property Office (EUIPO).

⁴² EUIPO, Guidelines for Examination of the European Union Trademarks, Part C, Section 2, Chapter 2, para. 2.2

(<https://guidelines.euipo.europa.eu/1922895/1923283/trade-mark-guidelines/1-introduction>, Last accessed: 06.06.2021). Throughout the remainder of the study, "EUIPO Examination Guidelines" will be used as a brief reference.

⁴³ Paslı, p. 53. According to the 2021 Guideline published by TURKPATENT, it has been indicated that in cases where a trademark is registered for specific goods or services, and a subsequent trademark application includes a general indication encompassing those goods or services, the said goods or services will be considered as identical. See. 2021 Guideline, p. 392.

⁴⁴ See also. 2021 Guideline, p. 392.

⁴⁵ The expressions "including," "particularly," and "mainly" are also phrases used

word “namely,” it is acknowledged that this expression is limited to the goods and services that follow it. For example, the phrase “Toys, especially toys in the form of model airplanes” encompasses all toys, while the phrase “Electronic devices, namely portable music players” does not cover all electronic devices.⁴⁶

In cases where the compared goods partially overlap, according to Part C, Section 2, Chapter 2, Paragraph 2.4 of the EUIPO Guidelines, if the separation of categories by the Office is not possible, they will be considered as the “identical goods/services.” For instance, online banking services and commercial banking services intersect in terms of “online commercial banking services,” and if it is not possible for the Office to separate them, they will be considered identical.

2. Concept of Same Type of Goods/Services

When the products under comparison are not identical, but categorizing them merely as “similar” is not sufficient due to the intensity of their degree of similarity, , then the term “same type” will be used.⁴⁷

As mentioned before, according to the Communiqué on Classification Article 3/4, the groups listed in the annex of the Communiqué will be taken into consideration for determining the same type of goods/services. The Court of Cassation also states that goods and services within the same sub-group should be considered as the same type.⁴⁸ Therefore, for instance, disinfectant soaps and antibacterial hand lotions within the same sub-group belonging to Class 5 could be characterized as the “same type.”

In trademark law, the core principle is to associate the sign with the product, and the classification system serves as a means to achieve this.⁴⁹ Therefore, automatically considering products within the same general category as “identical products” would not be accurate.

for illustrative purposes; therefore, in the evaluation of similarity of goods/services, the general wording should be taken as the basis. See. 2021 Guideline, p. 390

⁴⁶ 2021 Guideline, p. 220; EUIPO, Guidelines for Examination of European Union Trademarks, Part C, Section 2, Chapter 2, para. 2.3.2.

⁴⁷ Pash, p. 55, 56.

⁴⁸ Court of Cassation 11th Civil Chamber, D. 16.01.2015, Case No. 2014/15359 Judgment No. 2015/503 (Kazancı Case Law Database, Last accessed: 06.06.2021).

⁴⁹ Pash, p. 57.

For example, although both white cheese and butter fall under the category of "dairy products (including butter)," they are not identical; however, they will be considered as "same type of goods/services."⁵⁰ In short, classification is not absolute.⁵¹ As previously mentioned, Article 3/4 of the Communiqué on Classification states that TURKPATENT has the authority to interpret the groups more narrowly or more broadly during the examination of trademark applications or objections.⁵² In legal doctrine, it has been argued that the specific regulation refers only to the provision of Decree-Law No. 556 Article 7/1-b (IPC Article 5/1-ç) and thus emphasizes that the classification established through the Communiqué serves the purpose of registration and is not related to determining the scope of protection for a trademark.⁵³

3. The Concept of Similar Goods/Services

The concept of "similar goods/services" is not defined under the IPC, the Paris Convention for the Protection of Industrial Property,⁵⁴ or the Agreement on Trade-Related Aspects of Intellectual Property Rights.⁵⁵ The definition of "similar goods" is provided in Article 15/2-b of the Agreement on Implementation of Article VII of the General Agreement on Tariffs and Trade 1994,⁵⁶ which Türkiye is a party to⁵⁷

⁵⁰ Paslı, p. 56.

⁵¹ İmirlioğlu, p. 151.

⁵² Öztekin pointed out that according to the relevant regulation, goods or services falling within the same sub-group within a class would be considered as the "same type," and therefore, TURKPATENT should reserve the right to evaluate goods or services from different groups as "similar goods or services" rather than "the same type." See. Selçuk Öztekin, "Türk Marka Hukukunda Benzer Mal ve Hizmet Kavramı (The Concept of Similar Goods and Services in Turkish Trademark Law)", *Prof. Dr. Turgut Akıntürk'e Armağan*, Istanbul 2008, p. 289.

⁵³ Dirikkan, p. 183; Tekinalp, p. 442.

⁵⁴ "Paris Convention for the Protection of Industrial Property" (<https://wipolex.wipo.int/en/text/287556>, Last accessed: 06.06.2021).

⁵⁵ "Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs)" (https://www.wto.org/english/docs_e/legal_e/27-trips.pdf, Last accessed: 06.06.2021).

⁵⁶ OJ, D. 25.02.1994, N. 22213 (Bis).

⁵⁷ "Agreement on Implementation of Article VII of the General Agreement on Tariffs and Trade 1994", OJ, D. 26.05.1988, N. 19823. Throughout the remainder of the study, "GATT" will be used as a brief reference.

and has ratified.⁵⁸ In the relevant article, similar goods are defined as *“Goods that, while not identical in all respects, have similar characteristics and similar features that enable them to perform the same function and be commercially interchangeable.”*

In the 2015 TURKPATENT Trademark Examination Guideline, it was indicated that the term “similar goods and services” is referred to goods and services that could be subject to likelihood of confusion, assuming they come from the same/related origin by the relevant public. In this regard, related goods and services that can be assumed to originate from the same/related origin are also considered as similar goods and services.⁵⁹

In this context, it is important to address the role of the Nice classification in determining similar goods/services. As mentioned, the Nice classification is not binding in the assessment of similarity conducted by the courts. However, for offices/institutions responsible for trademark registration, the EUIPO Examination Guidelines state that the Nice classification is purely administrative and cannot constitute the sole basis for determining the similarity of goods/services.⁶⁰ However, even though the Nice Agreement does not impose such a constraint, trademark offices during the registration process assign a significance to the Nice Agreement’s classification system that goes beyond administrative and registration purposes.⁶¹ Offices also utilize auxiliary methods in search for similarity, such as cross-searching and cross-classification, , but fundamentally conduct it within the scope of the mentioned classes and sub-groups.⁶²

⁵⁸ Pahlı, p. 69

⁵⁹ 2015 TURKPATENT Trademark Examination Guideline, p. 119

(<https://www.turkpatent.gov.tr/TURKPATENT/resources/temp/F9E4CFAF-A7AE-4FEA-8BCC-DA8B5C7DAB00.pdf>, Son erişim tarihi: 17.10.2021). Throughout the remainder of the study, “2015 Guideline” will be used as a brief reference.

⁶⁰ EUIPO, Guidelines for Examination of European Union Trademarks, Part C, Section 2, Chapter 2, para. 1.2.1.

⁶¹ Pahlı, p. 36.

⁶² Ünsal, p. 6.

III. DETERMINATION OF SIMILARITY OF GOODS/SERVICES

A. Additional Methods Used by Registration Offices

1. Cross-Classification

In searches conducted for earlier trademarks, it is possible that similar trademarks protecting similar goods and services may not appear in the search report due to differences in Nice classes. Cross-classification is a method devised to tackle this issue.⁶³ In this method, the office responsible for registration identifies classes containing goods/services that are considered similar to each other and compiles them in a list. When examining a trademark application in a certain class for similar goods/services, the examination is not limited to that specific class only; it is also carried out in the cross-classified class that has been matched.⁶⁴ After the search is conducted, experts examine the trademark in terms of cross-classified similar trademarks as well, and then make their decisions.

During the publication and registration process of applications, only the classes in which the application has been filed are mentioned in the documents or official records. Cross-classifications are for examination purposes only and are not included in any official publications or documents.⁶⁵ In some countries, the relevant cross-classification list is considered binding for the examining expert, while in others, it is regarded as a guiding reference for the expert.⁶⁶

2. Similarity Tool

The second auxiliary method used by trademark offices to determine the similarity goods/services is the “Similarity Tool,”⁶⁷ which is a computer program developed by the EUIPO.

⁶³ Ünsal, p. 49.

⁶⁴ Pash, p. 36, 37.

⁶⁵ Ünsal, p. 51.

⁶⁶ For detailed information regarding the practices of trademark offices concerning cross-classification, see. Ünsal, p. 49 ff.

⁶⁷ Similarity Tool (<https://euipo.europa.eu/sim/searchList/search>, Last accessed: 17.10.2021).

This program compares goods/services within the scope of the Nice classes and provides users with decisions related to the selected goods/services from the trademark offices of the WIPO, as well as the United States and the EU member states.⁶⁸ According to the EUIPO Examination Guidelines, the similarity tool serves to ensure uniformity in the application of similarity assessment and guarantees consistency in decisions.⁶⁹

Within the scope of the EUIPO's Similarity Tool, the search conducted does not only produce results in terms of identity/similarity/difference, but also includes the reasoning behind these findings. The provided reasoning is based on the criteria outlined by the European Court of Justice in the *Canon* decision.⁷⁰ These criteria can be listed as follows:

1. Structure,
2. Purpose,
3. Method of use,
4. Complementarity of goods/services,
5. Competition between goods/services,
6. Distribution channels,
7. Relevant public,
8. Producer/supplier.

3. Applied Method of TURKPATENT

In the 2015 Guideline, it was stated that the following steps would be followed in the assessment of determining similar goods/services:⁷¹

Firstly, the signs contained in the trademarks would be considered "identical," and in this case, the question of whether the goods/services

⁶⁸ Pashi, p. 37.

⁶⁹ EUIPO, Guidelines for Examination of European Union Trademarks, Part C, Section 2, Chapter 2, para. 1.3.

⁷⁰ CJEU, *Canon Kabushiki Kaisha v. Metro-Goldwyn Mayer Inc.*, C-39/97, D. 29.09.1998 (ipcuria.eu, Last accessed: 06.06.2021).

⁷¹ 2015 Guideline, p. 121.

should be evaluated as similar/related goods and services would be addressed to determine the likelihood of confusion. In this case;

- a- If the answer is “definitely no,” without the need for further examination, the goods and services would be considered dissimilar/unrelated to each other.
- b- If the answer is “definitely yes,” without the need for further examination, the goods and services would be considered similar/related to each other.
- c- If the answer indicates that there is a low/moderate level of similarity or an indirect relationship between the goods and services, then the possibility of confusion would be assessed through additional tests. In applying these additional tests, the specific circumstances of each case would be taken into account, and all relevant factors affecting the dispute would be considered.

However, in the 2021 Guideline, there is no mention of such a step-by-step evaluation, and instead, the criteria set out by the European Court of Justice in the *Canon* case regarding the examination of similarity of goods/services are included. After listing these criteria, it is indicated that the criteria common to the goods/services will be identified, and based on this determination, a decision regarding the level of similarity will be made.⁷² According to the 2021 Guideline, the classification of the degree of similarity of goods/services will be done in five separate categories, which are as follows:

1. Different (goods/services that are not identical or similar),
2. Low level of similarity goods/services,
3. Similar (average level of similarity) goods/services,
4. High level of similarity goods/services,
5. Identical goods/services.⁷³

⁷² 2021 Guideline, p. 394.

⁷³ 2021 Guideline, p. 394.

B. Criteria Used in Determining the Similarity of Goods/ Services

The assessment of the similarity of goods/services should be carried out based on consistent, transparent, and predictable criteria.⁷⁴ It is evident that the definition of similar goods/services under the GATT can only serve as an indirect source in trademark law practice.⁷⁵ Therefore, it would be beneficial to address the various criteria presented in the 2021 Guidelines, as well as in legal doctrine and judicial decisions, regarding how the concept of similar goods/ services can be interpreted.

According to Uzunallı, the similarity of goods/services should be determined based on the perspective of the relevant public, regardless of other factors to be considered in assessing the likelihood of confusion. The relevant public refers to average consumers, and the level of attention and perception of an average consumer can vary based on the nature, type, and price of the goods or services in question.⁷⁶

According to principles in practice, doctrine, and general understandings, the similarity or associable nature of goods and services can arise in the following situations:

- Similarity in the nature of goods and services,
- Similarity in the purposes and fields of use of goods and services,
- Similarity in the relevant public of goods and services,
- Similarity in the physical appearance of goods,
- Similarity in the sales channels/places of goods and services,
- Similarity arising from the goods and services of the same origin,

⁷⁴ Uzunallı, p. 679. The Court of Cassation stated that the determination of similarity of goods/services is a matter that cannot be resolved solely by the judge's general and professional knowledge, and expert examination is necessary. See. Court of Cassation 11th Civil Chamber, D. 15.10.2009, Case No. 2008/5938, Judgment No. 2009/10605 (Çolak, p. 224). See also. Court of Cassation 11th Civil Chamber, D. 07.07.2011, Case No. 2009/8446, Judgment No. 2011/8433; Court of Cassation 11th Civil Chamber, D. 18.12.2017, Case No. 2016/5668, Judgment No. 2017/7320; Court of Cassation 11th Civil Chamber, D. 12.07.2018, Case No. 2016/11784, Judgment No. 2018/5059 (Kazancı Case Law Database, Last accessed: 06.06.2021).

⁷⁵ Paşlı, p. 70.

⁷⁶ Uzunallı, p. 684.

- Similarity arising from the competitive nature of goods and services,
- Similarity arising from the complementary nature of goods and services.

1. The Emergence of the Criteria

Following the tradition of case law, the United Kingdom is a pioneer in determining similarity criteria. The *Jellinek* test, developed in the *Jellinek* application in 1946 and subsequently applied with some modifications, is based on three fundamental questions:⁷⁷

- What is the structure and composition of the products?
- What are the relevant areas of use for the products?
- What are the trade channels for buying and selling the products?
- In the *British Sugar*⁷⁸ case, while these three questions are fundamental, answers to the following questions have also been sought:⁷⁹
- Are the products sold on the same shelves in supermarkets?
- Do the products compete? How are they commercially classified?

The questions mentioned above continue to remain pertinent in today’s context when determining similarity.

2. List of Applicable Criteria

a. Nature of Goods/Services

The nature of goods/services is determined by considering the fundamental characteristics and qualities of the goods/services. In this determination, elements such as the components of the good, its operational principles, and its physical form are taken into account.⁸⁰ The nature of services, on the other hand, is determined based on the type of action provided to third parties. For instance, cinema and

⁷⁷ Pasli, p. 70.

⁷⁸ British Sugar Plc. v. James Robertson & Sons Ltd. (1996) (http://www.peteryu.com/intip_msu/britishsugar.pdf, Last accessed: 05.06.2021).

⁷⁹ Pasli, p. 70.

⁸⁰ 2021 Guideline, p. 396.

theater services are both considered entertainment services within the scope of the 2021 Guideline due to their shared nature as forms of entertainment.⁸¹

b. Purpose/Field of Use

The concept of purpose or field of use pertains to the specific manner in which products are utilized, the domain in which they are employed, and the intended purposes they serve. It is worth noting that as the alignment between the intended purposes and fields of use of products becomes closer, the probability of similarity between these products also increases. The likelihood of such similarity does not necessarily mean that the products share same physical attributes or raw materials.⁸² What is significant is that the intended purposes of the products bear a substantial resemblance to one another.⁸³ The Court of Cassation has indicated that, in view of the protective nature of the provisions of the Decree-Law No. 556, the concept of identical or similar goods/services should be interpreted broadly, and the trademark's protective function should extend to all other goods or services *fulfilling a similar function* in the perception of customers.⁸⁴

Moreover, within this criterion, in order for two products to be deemed similar, aside from the similarity in their intended purpose of use, it will also be required that their methods of attaining such purpose do not substantially differ from one another. For instance, products such as "waterproof coat" and "umbrella," both designed to prevent users from getting wet, cannot be considered as similar. This is because the methods by which these products achieve their intended purpose are distinct, resulting in a low likelihood of association between the two.⁸⁵

⁸¹ 2021 Guideline, p. 397.

⁸² Paslı, p. 73.

⁸³ Paslı, p. 74.

⁸⁴ Court of Cassation 11th Civil Chamber, D. 27.04.2015, Case No. 2015/865, Judgment No. 2015/5841 (Kazancı Case Law Database, Last accessed: 06.06.2021). The use of the term "broad interpretation" in the decision is considered as problematic from a technical standpoint, see. Paslı, p. 74, fn. 180.

⁸⁵ Phillips Jeremy, Trademark Law: A Practical Anatomy, New York 2005, p. 336 (As cited in Paslı, p. 75.).

c. Relevant Public

The relevant public can encompass a broad range, including the general public, a specific segment of the public, or even a professional community.⁸⁶ The intended purpose of a product also plays a role in defining the relevant public it addresses, thus these two criteria are intertwined with each other.⁸⁷ On the other hand, despite functional differences, products can still be considered as similar due to catering to the same relevant public. For instance, even though products in Class 20, such as “fishing baskets”, and products in Class 22, such as “fishing nets,” as well as products in Class 28, such as “artificial fishing baits, traps for hunting and fishing”, may have distinct usage methods, they share the same relevant public due to their relevance to the field of fishing.⁸⁸

According to Article 6/1 of the IPC, the criterion used to determine the likelihood of confusion is the “public.” The term “public” refers to the relevant public to which the examined goods/services are addressed.⁸⁹ In cases where the relevant public is the “general public” in a broad sense, TURKPATENT acknowledges that the relevant criterion has no impact on the assessment of similarity.⁹⁰

d. Physical Appearance

It is unlikely that products would result in confusion solely based on their physical appearance. The primary consideration lies in the potential for the relevant public to establish a connection between the products due to their physical similarity.⁹¹ In the absence of other criteria, it becomes considerably challenging for similarity to arise solely due to the physical appearance.

⁸⁶ EUIPO, Guidelines for Examination of European Union Trademarks, Part C, Section 2, Chapter 2, para. 3.2.7.

⁸⁷ Paslı, p. 77.

⁸⁸ Paslı, p. 78. For other examples of goods/services that are similar despite being in different Nice classes, see. Ünsal, p. 48, 49.

⁸⁹ Uzunallı, p. 684.

⁹⁰ 2021 Guideline, p. 406.

⁹¹ Paslı, p. 79.

e. Sales Channels/Places

In the context of similarity of sales channels/places, the crucial aspect to emphasize is when the products are sold in the same type of shops, side by side or very closely, on the same shelf or display.⁹² Sales, advertising, and promotional methods, on the other hand, do not hold significant power for determination of similarity.⁹³ In the EUIPO Examination Guidelines, it is emphasized that the decisive factor is the presentation of products in the same section rather than their mere presence in the same store. The fact that products are sold in different places can indicate that the products are not similar. For example, even though both bicycles and wheelchairs are classified in the Class 12, they would not be considered as similar because they would not be sold in the same place.⁹⁴

In the 2021 Guideline, it is stated that if goods are delivered through the same distribution channel, it is presumed by the relevant public that they are produced by the same enterprise. Therefore, it is stated that this criterion affects the assessment of similarity.⁹⁵ However, as also indicated in the 2021 Guideline, in today's context, supermarkets sell a wide variety of goods, and therefore, the relevant public is aware that products sold in such places come from different enterprises.⁹⁶ We are of the opinion that the relevant criterion impacts similarity regardless of the impression that the goods emanate from the same origin.

⁹² Ünsal, p. 38.

⁹³ Paşlı, p. 84.

⁹⁴ EUIPO, Guidelines for Examination of European Union Trademarks, Part C, Section 2, Chapter 2, para. 3.2.6. Paşlı has indicated that the relevant goods are distinguished based on other factors such as function, relevant public, structure, substitutability; thus, even if they are sold in the same type of store, they will not be considered as similar. See. Paşlı, p. 84, fn. 217.

⁹⁵ 2021 Guideline, p. 404.

⁹⁶ 2021 Guideline, p. 405. The Guideline mentions that in cases where certain types of goods are exclusively (or predominantly) found and sold in specialized stores focusing on a particular area, it can be perceived that the goods originate from the same business, thus this criterion can be used in the assessment. In our opinion, in today's context, the perception has arisen that even in specialized stores that exclusively sell a particular type of goods, products from different origins can be sold. Therefore, it is necessary to separately evaluate the criteria of having a similar origin and the similarity of sales channels/places.

f. Origin of Goods/Services

The EUIPO Examination Guidelines indicate that the attribution of similarity may arise from the goods/services emanating from the same origin. The EUIPO bases its approach on the statement of the Court of Justice of the European Union in the *Canon* case, which indicates that there is a likelihood of confusion when there is a perception in the public that goods/services originate from the same undertaking or from economically connected undertakings. In this context, the relevant Guide specifies that this criterion should be evaluated in conjunction with all other criteria. It is emphasized that the term “source” does not solely refer to the producer, but rather whoever controls the production of the goods or the provision of the service. Furthermore, the criterion must be applied restrictively, and its significance diminishes in cases where all goods/services are provided under the control of a holding company or an international corporation.⁹⁷

In legal doctrine, Uzunalli has also contended that in cases where different goods are manufactured by the same enterprise, such goods should not be deemed as similar. It is underscored that relying solely on this criterion will not suffice to classify goods as similar.⁹⁸ Pashı also emphasizes that the similarity of goods should not solely be determined by the fact that they are produced by the same enterprise. Pashı indicates that the relevant criterion is associated with goods being manufactured from the same raw material or as a result of the same production process.⁹⁹

g. The Relationship Between Goods/Services

The fact that the compared goods/services complement each other, can be substituted for one another, or can compete with each other establishes a connection between the products and renders them similar.

If the goods/services under comparison can be substituted for each other and perform the same function, they are deemed “interchangeable,” consequently placing these goods/services “in

⁹⁷ EUIPO, Guidelines for Examination of European Union Trademarks, Part C, Section 2, Chapter 2, para. 3.2.8.

⁹⁸ Uzunalli, p. 687.

⁹⁹ Pashı, p. 80.

competition” with each other.¹⁰⁰ As an illustration, wall paint and wallpaper can be deemed substitutable and similar due to their shared purpose of wall decoration through coverage. Likewise, movie rental services and the cinematography offer comparable avenues of entertainment, rendering them substitutable and consequently engendering competition between the two.¹⁰¹ In its verdict dated January 14, 2015, the Court of Cassation ruled that the defendant company’s application, encompassing “production services for films, television, and radio programs” in Class 41, was potentially confusing with the plaintiff’s trademarks due to the similarity in the relevant public, production and distribution channels, as well as sales points of the goods within the scope of the plaintiff’s trademarks. Furthermore, it was stated that the likelihood of confusion, including the possibility of creating an association, existed because the signs were similar and *could be substituted for one another*.¹⁰²

Due to the complementary nature of goods/services that have different functions and usage patterns and are not in competition with each other, they can be considered as similar. For instance, due to the complementary nature of a suit and shoes designed for men, these goods could potentially share similar customer bases and sales channels.¹⁰³ In its decision¹⁰⁴ dated November 2, 2010, the Court of Cassation ruled that items such as bags, suitcases, wallets, and umbrellas in Class 18, which are complementary auxiliary accessories to the “clothing” covered by the plaintiff’s registered trademark in Classes 24 and 25, were considered as similar due to their complementary nature and being sold together with clothing in stores.

h. Evaluation of Similarity within Subgroup 35.05

Under the Communiqué on Classification published by TURKPATENT, sub-group 35.05 under Class 35 is as follows:

¹⁰⁰ Paslı, p. 87.

¹⁰¹ EUIPO, Guidelines for Examination of European Union Trademarks, Part C, Section 2, Chapter 2, para. 3.2.5.

¹⁰² Court of Cassation 11th Civil Chamber, D. 14.01.2015, Case No. 2014/14409, Judgment No. 2015/269 (Kazancı Case Law Database, Last accessed: 06.06.2021).

¹⁰³ Paslı, p. 90.

¹⁰⁴ Court of Cassation 11th Civil Chamber, D. 02.11.2010, Case No. 2009/825, Judgment No. 2010/11154 (Lexpera, Last accessed: 06.06.2021).

"Bringing together of goods* for customers to conveniently view and purchase (said services can be provided through retail, wholesale stores, electronic platforms, catalogs, and other similar methods).

*Specify the goods or group of goods in this section."

The relevant sub-group is designated as retail (merchandising) service and can be defined as services encompassing the sale of products as well as services broader than sales.¹⁰⁵

In this context, when evaluating the similarity of goods specified or to be specified within the scope of sub-group 5 of Class 35, the question arises whether there is a likelihood of similarity with an application/ registration made on behalf of another party for the same Nice class that the specified goods are included.

Prior to the amendment made in 2011, due to the absence of specification regarding the sale of which goods or services would fall under the scope of the application within the relevant sub-group, it was not clear in which good classes the registration of identical or similar trademark on behalf of another party could be prevented.¹⁰⁶

Besides, the absence of clarity regarding the scope of the sub-group led individuals who had registered a trademark for use on any goods to also seek registration within Class 35 for the purpose of their sales.¹⁰⁷ In this context, in the booklet titled "Information and Required Documents Regarding the Preparation of Trademark and Geographical Indication Applications" published by TURKPATENT in September 2004, it was stated that;

¹⁰⁵ Fülürya Yusufoglu, "Perakendecilik Hizmeti Sınıfı (35.05. Sınıf) ile Ürün Sınıfı Arasındaki İlişkilerin Marka Hukukundaki Etkisi [The Impact of the Relationship Between Retail Services Class (Class 35.05) and Product Classes in Trademark Law]", *GÜHFD*, 2018, Vol. 17, I. 1, p. 338.

¹⁰⁶ Deniz Topçu, "Marka Sınıflandırmasında 35. Sınıf İçeriğinin Perakende Satış Hizmetleri Alt Grubu Açısından Sağladığı Koruma (The Protection Provided by the Content of Class 35 in Trademark Classification for the Sub-group of Retail Services)", *IJOSPER*, 2020, C. 7, S. 4, p. 911.

¹⁰⁷ Ali Paslı/İsmail Cem Soykan, "Marka Tescilinde 35.08. Sınıfın Anlamı ve Kapsamı (The Meaning and Scope of Class 35.08 in Trademark Registration)", *Fikri Mülkiyet Hukuku Yıllığı*, C. 2, İstanbul 2010, p. 450.

“...businesses producing the goods defined in classes 01 to 34 are not required to register them separately in class 35.08 (currently 35.05), assuming that they naturally sell the goods they produce.”¹⁰⁸

Paslı/Soykan has also emphasized that the sale of goods produced is not considered a “service” falling within the scope of Class 35.05, as the sale of goods produced within a business is already a natural outcome of its operational activities.¹⁰⁹

TURKPATENT, referring to the decision of the Court of Justice of the European Union in the PRAKTIKER case,¹¹⁰ made a change in practice as of November 21, 2011, regarding the “Services for bringing together various goods to enable customers to conveniently view and purchase them.” TURKPATENT has concluded that “Services for bringing together various goods to enable customers to conveniently view and purchase them” in Class 35 will not be considered as a “sale of goods or services” and that the specified service should be regarded as “the service of presentation of goods in a retail sales environment”, and service descriptions specifying certain goods have become eligible for registration.¹¹¹

Following these explanations, it should be noted that there may arise a likelihood of confusion between trademarks¹¹² and service marks.¹¹³ Retail trade services, as a rule, are not similar to the goods subject to such retail trade.¹¹⁴ However, if the enterprise operates

¹⁰⁸ Topçu, p. 921.

¹⁰⁹ Paslı/Soykan, p. 453.

¹¹⁰ CJEU, T. 07.07.2005, C-418/02 (ipcuria.eu, Last accessed: 06.06.2021). The recognition of retail trade of goods as a distinct service and the acceptance of trademark registration within Class 35.05 for the trademarks used during this activity were initially established through the decision of the European Court of Justice in the PRAKTIKER case. The decision states that there is no need for detailed specification of the relevant services for the registration of any trademark related to such services; however, it is indicated that “details related to the goods or types of goods associated with these services” need to be explained (Paslı/Soykan, p. 459, 461.).

¹¹¹ Çolak, p. 223.

¹¹² Trademarks can be divided into two categories as trade marks and service marks depending on its use for specific goods or services. See. Arkan, p. 43.

¹¹³ Paslı/Soykan, p. 462; Uzunallı, p. 694.

¹¹⁴ Uzunallı, p. 694. On the contrary, see. 2021 Guideline, p. 445; Yusufoglu, p. 358. According to the 2021 Guidelines, it is accepted that there is a low level of similarity between the goods and the services of bringing together those goods.

within a narrow range of sales of goods, the impression that the goods subject to sale and the provision of services originate from the same enterprise can arise in the relevant public. Consequently, the similarity between the goods offered for sale and the services provided can be established.¹¹⁵

In this context, it is necessary to address the situation of trademarks that were not limited to the presentation of a specific product to customers under the scope of “Services for bringing together various goods to enable customers to conveniently view and purchase them” before the 2011 amendment. In this case, with regards to the possibility of confusion, it can be concluded that the application for registration in Class 35 may cover all goods.¹¹⁶ In a verdict dated May 6, 2013,¹¹⁷ the Court of Cassation stated that the plaintiff’s goods under the “KAYRA” trademark in Class 33 would be confused with the defendant’s “KYRA” trademark for retail services. This is because the defendant *did not limit the scope of registration to specific products* when making the disputed application for retail services in Class 35.07 (currently 35.05), excluding retail services related to goods in Class 33. Therefore, the Court of Cassation pointed out that the similarity and likelihood of confusion between the mentioned goods and Class 35.07 (retail) services are inevitable.

In the case that is the subject of the Court of Cassation’s verdict dated April 19, 2010,¹¹⁸ the defendant aimed to register the term “AMBER” under the sub-group of “Services for bringing together various goods to enable customers to conveniently view and purchase them.” On behalf of the plaintiff, trademark registrations with the wording “AMBER” have previously been obtained in classes 3, 5, 8, 26, and 29. Within the scope of the case, the Court of Cassation has established that trademarks/service marks that are likely to cause

¹¹⁵ Uzunalli, p. 694. See also. Beşir Fatih Doğan, “Perakende Satış Hizmeti (35.08) İçin Marka Tescilinde Ortaya Çıkan Sorunlar ve Çözüm Önerileri [Challenges Arising in Trademark Registration for Retail Sales Service (Class 35.08) and Proposed Solutions]”, *IPC Journal*, 2009, Vol. 9, I. 1, p. 24; Pashı, p. 462, 463.

¹¹⁶ Çolak, p. 223.

¹¹⁷ Court of Cassation 11th Civil Chamber, D. 06.05.2013, Case No. 2012/10264, Judgment No. 2013/9052 (Kazancı Case Law Database, Last accessed: 06.06.2021).

¹¹⁸ Court of Cassation 11th Civil Chamber, D. 19.04.2010, Case No. 2010/2036, Judgment No. 2010/4235 (Kazancı Case Law Database, Last accessed: 06.06.2021).

confusion among the public, even if they are in different classes, can be deemed as “similar” in terms of the goods/services they cover. The court pointed out that the defendant did not restrict the trademark to the presentation of specific goods within the relevant sub-group, thus the application would also cover the bringing together of goods specified under the plaintiff’s registered trademarks. Therefore, the Court of Cassation concluded that there is a possibility of confusion.¹¹⁹

Finally, it is necessary to address how the similarity between services bringing together identical/similar goods should be assessed.

In the 2021 Guideline, it is stated that the retailing service of identical goods will be considered as identical services, whereas the assessment of similarity between retailing services of non-identical goods will take into consideration factors such as the degree of similarity between the assembled goods, whether these goods are frequently offered for sale together in the industry, and the relevant public, among other criteria.¹²⁰ In this context, the service of “bringing together clothes” and the service of “bringing together bags” are considered as similar services, as the relevant goods are frequently offered for sale together and address the same relevant public.¹²¹ However, when comparing services for bringing together different goods, the assessment will need to be made on a case-by-case basis.¹²²

CONCLUSION

The determination of similarity of goods/services is not only significant in the examination conducted by TURKPATENT, but also holds great importance in terms of the fundamental aspects of trademark law, namely invalidity and infringement cases. Likewise, as per the provisions of Article 25 of the IPC, the grounds for declaring

¹¹⁹ However, in some decisions rendered by the Court of Cassation, it is emphasized that the registered trademark for retail services can only establish rights if the services are actually used (or there is a serious effort towards such usage) within the sector where the goods subject to the services are present. See. Court of Cassation 11th Civil Chamber, D. 30.03.2016, Case No. 2015/8504, Judgment No. 2016/3492; Court of Cassation 11th Civil Chamber, D. 27.02.2017, Case No. 2015/12715, Judgment No. 2017/1112 (Kazancı Case Law Database, Last accessed: 06.06.2021).

¹²⁰ 2021 Guideline, p. 447.

¹²¹ 2021 Guideline, p. 447.

¹²² 2021 Guideline, p. 448.

a trademark invalid also include the reasons stipulated in Articles 5 and 6 of the IPC. Therefore, if a trademark has been registered by TURKPATENT despite the existence of the grounds for refusal, an action for invalidity will be initiated, and it will be necessary to determine similarity or identity of goods/services.

The determination of whether goods and services are similar or not holds significance in relation to the likelihood of confusion, as it plays a crucial role in identifying at which point the similarity of goods and services may lead to confusion. It is widely accepted that the presence of similarity between goods/services is a prerequisite for the possibility of confusion. This conclusion also emerges from the explicit provision of Article 6/1 of the IPC.

It would be beneficial to assess the binding nature of the Nice classification in terms of similarity of goods/services. In the light of the decisions of the Court of Cassation, it can be argued that in the evaluation of similarity of goods/services to be conducted by the court within the scope of a specific case, there is no obligation to interpret that there is no similar goods/services if the Nice classifications are different. Pursuant to Article 3/4 of the Communiqué on Classification published by TURKPATENT, it is mentioned that during the examination of trademark applications or objections, groups can be interpreted more narrowly or more broadly. In this context, while the Nice classes can serve as a reference point for the examining expert, they will not be binding.

In determining the similarity of goods/services, in addition to the Nice Classification, trademark offices aim to achieve uniformity in practice by using methods such as cross-classification and similarity tool provided by the EUIPO. Furthermore, TURKPATENT is developing application principles and issuing guidelines in relation to these matters.

In the context of similarity of goods/services, various criteria have been envisaged in the light of doctrine and judicial decisions, and these criteria serve as guiding principles in the assessment of similarity.

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