

Supreme Court affirms extensive protection for well-known marks

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In a case published in March 2006 the Turkish Supreme Court confirmed that trademarks that are well known under Article 6*bis* of the Paris Convention for the Protection of Industrial Property are protected against confusingly similar third-party applications that cover different goods and services. The decision also confirmed that in the case of bad-faith applications, revocation actions are not subject to time limitation (Case 2005/11-476 E, 2005/483 K, September 21 2005).

The decision stemmed from an application to revoke a trademark on the grounds that it was identical to a well-known mark. (The decision does not disclose the name of the parties or the marks involved.) The plaintiff claimed that:

- its trademark was registered on January 1 1992 in relation to clothing and footwear, and became known in the relevant sector;
- it incurred extensive promotional and advertisement expenses;
- the defendant registered an identical trademark on March 23 1995 for similar goods; and
- the defendant's application was made in bad faith in order to ride on the reputation of the earlier, well-known mark.

The plaintiff asked the court to order the defendant's trademark to be revoked from the registry. The defendant counter-claimed that:

- the court action had not been filed within the time limit;
- the goods covered by the two trademarks were neither identical nor similar; and
- the plaintiff's mark was not a well-known mark.

The first instance court held that the plaintiff's mark was well known and, therefore, the claim of time limitation was inappropriate. Accordingly, the court ordered that the defendant's mark be revoked on these grounds.

The Court of Appeals reversed the first instance decision. The case eventually came to the General Assembly of the Court of Appeals (ie, the Supreme Court).

The Supreme Court first considered the issue of time limitation. Pursuant to the Turkish Trademark Decree-Law, revocation actions must be filed within five years of the date of registration. The court, however, held that in the case of bad-faith registrations, revocation actions relating to well-known marks are not subject to any time limit.

Next, the court held that since criteria to assess whether a mark is well known are defined neither under Turkish law nor in international agreements, renown should be evaluated according to precedents, World Intellectual Property Organization criteria and doctrine. The court further affirmed that well-known marks are subject to protection for all goods and services, even those for which they

are not registered. The court had the opportunity to review Article 8/IV of the Trademark Decree-Law, which deals with dilution. The court defined the trademarks that are protected by Article 8/IV (ie, for goods and/or services for which they are not registered) as trademarks having reached well-known status within society; however, the court did not explicitly refer to the concept of dilution nor to the scope of the statute's protection. Nonetheless, the court found that, in the case at hand, no expert examination had been conducted as to the well-known status of the plaintiff's trademark and, accordingly, the junior mark could not be revoked.