

Court of Cassation decision shows importance of trademark use to enjoy protection based on ‘vested rights’ principle

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- The applicant for the mark MONTENT argued that he had a vested right in an earlier registration for MONTENT, covering the same services
- The Court of Cassation confirmed that there was a likelihood of confusion with the earlier mark CONTENTMONTENT and that the earlier MONTENT mark did not constitute a vested right
- The court examined whether the earlier MONTENT mark fulfilled the five-year use requirement – and not only whether it had been registered for five years

In its decision dated 13 February 2024 (No 2022/4962 E (Merits), No 2024/1005 K (Decision)), the 11th Civil Chamber of the Court of Cassation has upheld a Regional Court of Appeal decision confirming a ruling of the Court of First Instance that rejected the plaintiff’s vested rights claims.

Background

On 11 January 2018 an application was filed for registration of the trademark MONTENT in Classes 35, 38 and 41 by the applicant, who also owned a prior registration for MONTENT in the same classes (valid from 2016).

The opponent argued that the application should be refused on the basis that it created a likelihood of confusion with its earlier trademark registration for CONTENTMONTENT (and design), dating from 10 October 2018 and covering Classes 35, 38 and 41.

REEB decision

The Re-examination and Evaluation Board (REEB) of the Turkish Patent and Trademark Office partially refused the application for MONTENT for some services in Classes 35, 38 and 41, on the ground that it created a likelihood of confusion with the CONTENTMONTENT trademark.

The applicant filed a cancellation action against this decision, arguing that he was the owner of a trademark registration for MONTENT, which covered the same services in Classes 35, 38 and 41 and had seniority over the trademark on which the opponent relied on in the opposition. As this earlier registration entitled him to a vested right over the trademark, the later application for the same trademark should be registered as well. In response, both the opponent and the Patent and Trademark Office argued that there was a likelihood of confusion between the marks and that the REEB's partial rejection decision was justified.

Court of First Instance decision

The Court of First Instance rejected the action on the ground that there was a likelihood of confusion between the trademark application and the prior trademark registration. Further, the court concluded that the earlier trademark registration for MONTENT did not properly establish a vested right that would allow the registration of the application at issue.

The applicant/plaintiff filed an appeal against the decision of the Court of First Instance.

Regional Court of Appeal decision

The Regional Court of Appeal upheld the decision, emphasising that there was a likelihood of confusion between the marks and that the earlier MONTENT trademark did not constitute a vested right, as it did not meet the condition of five-year use. Consequently, the plaintiff's appeal was dismissed.

The plaintiff appealed, but the 11th Civil Chamber of the Court of Cassation upheld the decision.

Key points

The Court of Cassation's decision is important in two aspects. First, it addresses whether the use of a trademark that allegedly constitutes a vested right should be considered in the assessment of a vested rights claim. The court rightly examined whether the earlier trademark fulfilled the five-year use requirement – and not just whether it had been registered for five years – to decide whether there was a vested right in favour of its owner.

Second, by not opposing the trademark application for CONTENTMONTENT based on its earlier trademark MONTENT in due time, the applicant/plaintiff had allowed the registration of CONTENTMONTENT, thereby jeopardising its rights in future trademark applications for MONTENT.

Comment

The decision highlights the importance of opposing confusingly similar trademark applications. As a matter of fact, by allowing the registration of a confusingly similar trademark, a trademark owner could face difficulties later on when seeking to register new versions of its mark, and even potentially endanger its rights over the mark.



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