

Bad-faith MAINETTI registration hung out to

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In a landmark decision, the Re-examination and Evaluation Board (the administrative appeal board) of the Turkish Patent Institute (TPI) has upheld an opposition to the registration of the trademark MAINETTI in the name of a local company (Case 2006-M-598, May 4 2006).

Local company Hidropres Aski Sanayi Ticaret Limited Sirketi (Hidropres) applied to register the trademark MAINETTI for all goods in Classes 20 and 21 of the Nice Classification, and for services in Class 35. Clothes hanger manufacturer Mainetti Limited and its Turkish affiliate, Mainetti Aski Sanayi ve Ticaret Anonim Sirketi (Mainetti Turkey), filed separate oppositions with the Trademarks Department Directorate of the TPI. Mainetti Limited based its opposition on:

- its earlier rights deriving from senior registrations in other countries for the same trademark;
- earlier and continued use of its MAINETTI mark in the Turkish market; and
- bad faith on the part of Hidropres.

Mainetti Turkey opposed on the basis that the cited trademark was confusingly similar to its senior registration with the TPI for the device mark MAINETTI MORE THAN JUST A HANGER for clothes hangers and cases in Classes 20 and 21.

The Trademarks Department Directorate partially accepted Mainetti Turkey's opposition and rejected the application for clothes hangers and cases. However, the opposition filed by Mainetti Limited was rejected on the grounds that it had not supplied sufficient evidence of use of the trademark in Turkey.

Both Mainetti Limited and Mainetti Turkey appealed to the Re-examination and Evaluation Board. The board upheld the appeal and rejected the subject application in full. In coming to this conclusion, the board took into consideration Mainetti Limited's foreign registrations and extensive advertising and promotion (in foreign countries), and decided that Hidropres, which trades in the same market as Mainetti Limited, had filed its application in bad faith. The board also ruled that Hidropres should have known of Mainetti Limited's senior trademarks and trade name when it applied to register the mark since both companies operate in the same field of business.

This is a landmark decision as the board recognized the rights of mark owners in foreign registrations and accepted evidence of extensive advertising and promotion outside of Turkey.