

## **MOBIL FUTBOL and MOBIL VIZYON cancelled in surprising decision**

*By Uğur Aktekin and Hande Hançer*

**WTR, 15.05.2009**

The Turkish Court of Appeals has upheld a decision of the Ankara First IP Court in which the latter had ordered the cancellation of the trademarks MOBIL FUTBOL and MOBIL VIZYON (Case 2007/7896 E ve 2009/2456 K, March 3 2009). The case arose from a court action lodged by ExxonMobil based on its MOBIL trademark.

The applicant, one of the leading mobile phone companies in Turkey, had applied to the Turkish Patent Institute for trademark protection of the phrases 'mobil vizyon' and mobil futbol' for goods and services in Classes 9 and 38 of the Nice Classification. It intended to use the marks primarily for services targeting the users of mobile phones. The trademark applications passed the *ex officio* examination and were registered with no opposition from third parties.

Following the registration of the trademarks, ExxonMobil filed a court action and demanded cancellation of the marks due to their similarity to its well-known MOBIL trademark. The action was filed following ExxonMobil's success in another action demanding the cancellation of a decision of the Turkish Patent Institute, which had rejected ExxonMobil's opposition to the same applicant's request to register 'mobil lig' as a trademark.

ExxonMobil argued that MOBIL is a well-known trademark and that the applicant's marks should be cancelled as they were confusingly similar to its mark, even though the goods and services covered by the marks were dissimilar. The applicant argued that the use of the phrase 'mobil' could not be deemed to be taking unfair advantage of, or be detrimental to, the distinctive character or the repute of ExxonMobil's well-known registered trademark.

The Ankara court upheld the action and the applicant appealed to the Court of Appeals on the grounds that the requirements for protecting a well-known trademark against a similar trademark for dissimilar goods had not been examined during the first instance trial. The Court of Appeals has now upheld the lower court's decision without disclosing its reasoning.

Surprisingly, the lower court did not examine the criteria for assessing protection of a well-known trademark, and the appeal court upheld this decision. This goes against the recent *Le Meridian* decision (Case 2007/5927 E ve 2007/9302 K), in which the Court of Appeals ruled that:

- the conditions set forth in Article 8(4) of the Decree Law 556 on the Protection of Trademarks (which is in line with Article 8(5) of the Community Trademark Regulation (40/94)) should be clearly analyzed; and
- at least one of these conditions must be fulfilled in order to protect a well-known trademark for dissimilar goods or services.

This was a landmark decision, as it was viewed as providing guidance on the interpretation of Article 8(4) of the decree law, and the trademark community expected other courts to follow this ruling.

The *MOBIL* decision shows that Turkish trademark practice is far removed from that of the European Union, although the decree law is harmonized with the First Trademark Directive (89/104/EC) and the Community Trademark Regulation. In view of the decision of the European Court of Justice in *Intel Corp Inc v CPM United Kingdom Ltd* (Case C-252/07), which reduced the scope of protection for well-known trademarks, Turkish practice has not yet established whether the protection conditions for well-known trademarks should be applied in the case of dissimilar goods and services (for further details on the *Intel* decision please see "ECJ denies absolute trademark protection for superbrands").

If the Court of Appeal continues down the path followed in the *MOBIL Case*, owners of well-known trademarks will continue to enjoy broad protection and will be encouraged to take action against similar trademarks registered for dissimilar goods and services.