

Court of Appeals Gives Unlimited Protection to Well-Known Trademarks

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Intellectual Property Turkey

The Turkish Court of Appeals has recently upheld a decision of Istanbul's second IP court involving the well-known trademark ROBERTO CAVALLI. In its decision of January 24 2006 (Cases 2004/650 E and 2006/7 K), the Istanbul Second IP Civil Court determined that the trademark ROBERTO CAVALLI, as well as being the name of a famous fashion designer, is a well-known trademark, and thus ordered the nullification of the trademark CAVALLI and other marks incorporating the word 'Cavalli' which had been registered by a Turkish third-party company without authorization from the genuine trademark owner.

The claimant, IGA Finance BV, the proprietor of ROBERTO CAVALLI trademarks worldwide, brought it to the court's attention that the goods, in particular clothing items bearing the trademark ROBERTO CAVALLI, had been introduced into the Turkish market four years prior to the application date of the defendant's senior trademark CAVALLI. The claimant also referred to the well-known status of the ROBERTO CAVALLI mark in Turkey and throughout the world by submitting evidence in line with the criteria determined by the World Intellectual Property Organization (WIPO), such as:

- worldwide trademark registrations;
- figures in relation to turnover and expenditure; and
- press clippings and news of the trademark ROBERTO CAVALLI.

The claimant further maintained that the registration of the CAVALLI trademark for goods and services for which the ROBERTO CAVALLI mark was not used or registered, would cause an unfair advantage or be detrimental to the repute or distinctiveness of the ROBERTO CAVALLI trademark.

The court, taking the evidence submitted by the claimant into consideration, determined that ROBERTO CAVALLI was a well-known trademark. In its reasoned judgment, the court pointed out the following facts:

- The trademark had been registered in over 100 countries;

- The first trademark registration was filed in 1996;
- International registrations within the WIPO International Bureau extended to 20 countries; and
- The trademark was widely promoted in various fashion magazines all over the world.

The court, in line with established precedents of the Turkish Court of Appeals, pointed out that registration of the CAVALLI trademark and other marks incorporating the word 'Cavalli' in different classes from those registered by ROBERTO CAVALLI could affect the well-known trademark ROBERTO CAVALLI in a negative way. The court, emphasizing the need to protect well-known trademarks to a broader extent in comparison to regular trademarks, ruled that permitting the existence of registrations bearing the CAVALLI mark in any classes would damage the reputation of the claimant's trademark and give the defendant an unfair advantage. Finally, the court deemed that the defendant had acted in bad faith when filing the application as the phrase 'Cavalli' is not a Turkish word. The court further emphasized that it was impossible that the defendant, whose scope of business was the same as the plaintiff's, was unaware of the ROBERTO CAVALLI trademarks. Thus, the court ruled for the nullification of the CAVALLI trademarks registered in the name of the defendant in all classes.

In its decision dated May 31 2007 (Cases 2006/5445 E and 2007/8293), the Turkish Court of Appeals confirmed the first instance court's findings. In terms of the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights, this decision sets a good example for the protection of well-known trademarks against confusingly similar trademarks, regardless of whether they are registered for similar or dissimilar goods and services classes. The decision is also important in showing that bad faith can still be proved in cases where the trademark at issue is an unfamiliar word that is registered by a third party within the same business as the proprietor of the well-known trademark.

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