

CASADEI CASE SUMMARY

Jurisdiction: Republic of Turkey /1st Istanbul Court of Intellectual and Industrial Rights

Subject Heading: *I.A.I.Prior Use*

Case Name and

Citation : Calzaturificio Casadei v. Çiçek Kundura,
Case No. 2007/263, Decision No. 2009/46

Plaintiff: Calzaturificio Casadei S.P.A

Defendant: Çiçek Kundura San. Ve Tic. Ltd. Şti.

Marks Associated

with Goods/Services: The plaintiff's word trademark CASADEI, registered before WIPO in classes 3, 18 and 25, but not registered in Turkey at the time of the court action

Nature of Case: cancellation action based on prior use

Prior Decisions:

Overview of Decision and Ruling:

Upon the rejection of the Turkish trademark application for CASADEI¹ filed in the name of CALZUTURİFİCİO CASADEİ S.P.A due to the prior registration of the same trademark in the name of Çiçek Kundura San. Ve Tic. Ltd. Şti., CALZUTURİFİCİO CASADEİ S.P.A. brought an action² against Çiçek Kundura San. Ve Tic. Ltd. Şti. for the cancellation of its trademark registration for CASADEI³ on grounds of the prior rights and longstanding extensive prior use and on grounds of the bad faith of the defendant.

The plaintiff claimed that the trademark CASADEI was registered by their end in Italy years ago and is being used in the fashion sector, that their trademark CASADEI⁴ is registered before WIPO in many countries, the CASADEI branded products have being introduced to the market both in Turkey and abroad by their end before the registration of the same denomination in the name of the defendant, that they are the right holder of the trademark CASADEI and own the prior rights related to this trademark, that the defendant is acting in bad faith and therefore they requested the cancellation of defendant's trademark registration for CASADEI.

The defendant claimed that their trademark CASADEI has been duly registered. Therefore and also considering the principle of territoriality they are the right holder of the trademark

¹ Turkish Trademark Application no.2005 32563

² Calzaturificio Casadei S.P.A. v. Çiçek Kundura San. Ve Tic. Ltd. Şti., **Case No. 2007/263, Decision No. 2009/46 (1st Istanbul Court of Intellectual and Industrial Rights, March 03, 2009)**

³ Registration no.2000 24667

⁴ IR no.541448

CASADEI, that the plaintiff's trademark is not well-known, that the plaintiff do not use the trademark in Turkey and that the plaintiff is acting in bad faith.

The Court, in accordance with the evidences submitted to the file determined that the trademark CASADEI is created by the plaintiff in 1958, that CASADEI branded products are being regularly sold in Turkey since 1996, that the trademark is registered in many countries in the name of plaintiff, that plaintiff's trademark can be seen in many important fashion magazines such as Marie Claire, Elle and Vogue, that the plaintiff's trademark has reached to an considerable consumer potential before the defendant's application for the same denomination and that the denomination CASADEI constitutes the distinctive part of plaintiff company's trade name.

Although the plaintiff's trademark is not registered in Turkey, in the light of the evidences submitted to the court file, the Court has determined that;

-plaintiff's trademark has acquired a notable distinctiveness,

-the plaintiff has acquired rights in respect of the denomination CASADEI due to their use before the defendant's trademark application for the same denomination.

-according to the principle of equal treatment mentioned in the Paris Convention the plaintiff has the right to claim their non-registered rights

-according to the decisions of the Supreme Court, the trademark registrations applied in bad faith should not be protected.

Therefore the Court has ruled the cancellation of the trademark no.2000 24667 CASADEI registered in the name of the defendant and continuation of the injunction until the decision is finalized,

Importance of Case: This decision is important because it establishes that unregistered trademarks are being protected in Turkey on the basis of extensive and longstanding prior use

Images/Description:

Contributor Firm: Deris Patents and Trademarks Agency