

Registrability – Likelihood Of Confusion (Similarity Of Trademarks)

“MAGI / MAGGI” Trademarks

SOCIETE DES PRODUITS NESTLE S.A. vs. TURKISH PATENT INSTITUTE and HAYAT KIMYA SAN. A.S.

**(*) 9th Commercial Court of Ankara
Decision no.1999/826-2001/946 (06.12.2001)**

An action (*) was instituted against the Turkish Patent Institute and HAYAT KIMYA VE MENSUCAT SAN. A.S. respectively for the withdrawal of the decision rejecting the opposition raised by the plaintiff against the trademark application MAGI on grounds of the identity with the plaintiff’s well-known trademark MAGGI and for the invalidation and cancellation of the defendant’s registrations nos. 98065 and 200460 (former application no.96/15020) MAGI on grounds of trademark infringement.

The plaintiff asserted that an opposition has been lodged against the application no.96/15020 (meanwhile registered under no.200460) for the trademark MAGI on grounds that the subject trademark is identical with its worldwide notorious trademark MAGGI, that upon the acceptance of this opposition the applicant has objected this decision and the Higher Council Of Examination and Evaluation of the T.P.I. has partially accepted the applicant’s objection by allowing to mature the trademark MAGI into registration for the goods in international classes 3 and 5 with exception of the goods “disinfectants”. The plaintiff further claimed that the notoriety of its trademark MAGGI has been determined by the Commercial Court of Izmir in another case and that thus its trademark is under protection according to the Article 6bis of Paris Agreement and Articles 7/1(i) and 42 (a) of the Decree-Law no.556 and that therefore the registration of a similar/identical mark necessitates the authorization of the owner of the notorious trademark and that on such grounds the decision of partial acceptance/refusal of the Higher Council is to be withdrawn and the registrations no.98065 and 200460 (former application no.96/15020) MAGI in the name of defendant firm HAYAT KIMYA should be invalidated and cancelled.

The first defendant T.P.I. objected by asserting that the applicant of the application no.96/15020 has acquired rights owing to their prior registration no.98065 for the goods other than “disinfectants” therefore the objection of the applicant had been partially accepted and that as the trademarks registered

in the name of plaintiff are not to be found in the list of notorious trademarks kept by the T.P.I. the plaintiff's claim to the notoriety of its trademarks is to be disregarded.

The other defendant HAYAT KIMYA objected by asserting that the claims regarding the cancellation of the registration no.98065 should be rejected due to lapse of time, that the trademarks in question are not to be considered as confusingly similar since the goods/services covered by the specification of the trademarks are totally different and that the plaintiff's trademark MAGGI is not notorious.

The Court decided that it has been determined by the Commercial Court of Izmir in a court action instituted against the plaintiff that the plaintiff's trademark MAGGI is worldwide notorious; that the defendant may take the unfair advantage of the notoriety of the trademark MAGGI in case of the registration of the trademark MAGI in the name of the defendant, since the trademarks in question are almost identical in their visual and phonetical aspects, that the prior registration no.98065 in the name of the defendant firm could not constitute a legal ground for the registration of the trademark MAGI for other goods, therefore the refusal decision of the defendant administration is in contradiction with the fundamentals/spirit of the abovementioned Decree-Law; consequently in its decision the court accepted the claims of the plaintiff and ordered the cancellation of the defendant's registrations, which are considered confusingly similar to the plaintiff's notorious trademark.