

Infringement And Defenses – Famous Marks

“ZIPPO/ZIPP” Trademarks

Zippo Manufacturing Company vs. Turkish Patent Institute & Zipp Teknoloji Urunleri Servis Danismanlik Ticaret ve Limited Sirketi

(*) 1st Court of Ankara on Intellectual and Industrial Rights, Case No.2006/150, Decision No.2006/1381

Zippo Manufacturing Company instituted an action(*) against Zipp Teknoloji Urunleri Servis Danismanlik Ticaret ve Limited Sirketi and the Turkish Patent Institute for the withdrawal of the Institute’s decision, for the cancellation of the trademark ZIPP2 on grounds that the defendant’s trademark was similar to plaintiff’s well-known ZIPPO trademarks and “ZIPPO” was the trade name of the plaintiff. The plaintiff claimed that the Institute evaluated the opposition only on the basis of similarity, that the Institute did not consider the claim regarding the well-known trademark despite the fact that ZIPPO was accepted as a well-known trademark in the Institute’s Special Bulletin for well-known trademarks. The plaintiff also claimed that the ZIPPO was the essential part of the trade name of the plaintiff which should also be protected according to Article 8 of the Paris Convention. The Institute claimed the rejection of the case.

Zipp Teknoloji did not attend any of the hearings and did not submit any reply to the plaintiff’s claims.

The Court held that ZIPPO is the essential part of the plaintiff’s trade name and that the plaintiff has industrial rights on this denomination, that ZIPP is confusingly similar to ZIPPO trademarks due to only one letter of difference, that the defendant could not explain the reason of filing such a similar application, that ZIPPO trademarks are well-known and that the defendant filed the application in order to take unfair advantage of the reputation of ZIPPO trademarks.

The Court partially accepted the decision and ruled to the cancellation of the Institute’s decision. The Court rejected the cancellation of the trademark ZIPP as this trademark was not matured into registration at the date of the institution of the action.