

Repealing Of The Trademark- Non Use During An Uninterrupted Period Of Five Years

“ALCATEL- ACOTEL” Trademarks

ALCATEL vs. ACOTEL S.P.A and TURKISH PATENT INSTITUTE

(*) Court of Ankara on Intellectual and Industrial Rights, Case no. 2004/561- Decision no: 2006/198 (April 14, 2006)

An action (*) was instituted by Alcatel against the Turkish Patent Institute and Acotel S.p.A. for the withdrawal of the Turkish Patent Institute’s decision which rejects their opposition against the trademark application no.2002/2315 ACOTEL and for the cancellation of the trademark ACOTEL on grounds of similarity to the plaintiff’s trademark registrations no.1997/186440, 1987/103392 and no.1988/105361 for ALCATEL.

The plaintiff’s attorney claimed that the essential element of the client’s trademarks ALCATEL is a well-known trademark in several countries, that the denomination ALCATEL is the trade name of the plaintiff and therefore is protected according to the Article 8 of Paris Convention and that the defendant’s trademark ACOTEL is almost identical to the client’s trademark ALCATEL. The plaintiff further asserted that they have filed an opposition against the trademark application no.2002/2315 ACOTEL on grounds of similarity, notoriety and unfair competition and that their opposition was rejected by the Turkish Patent Institute. The plaintiff requested the withdrawal of the administrative decision refusing the opposition against the trademark application ACOTEL and the cancellation of the registration obtained for ACOTEL.

The attorney of the Turkish Patent Institute claimed that the decision of the Turkish Patent Institute is justified and accordingly requested the rejection of the action.

The attorney of Acotel S.p.A. claimed that the trademark ACOTEL is not similar to the plaintiff’s trademark ALCATEL, that the denomination ACOTEL is comprising their trade name at the same time and has been protected in Italy as its trade name as from 1992, that both companies were operating in telecommunication industry and therefore the attention level of consumers in this sector is higher than the attention level of average consumers

The court first appointed a panel of experts for the determination of whether there was a similarity between the plaintiff's trademark and the defendant's trademark. The experts have concluded that the plaintiff's trademark is a well known trademark and that "ACOTEL" is confusingly similar to the defendant's trademark "ALCATEL." Upon the objection of Acotel S.p.A, the Court appointed a second panel of experts.

The second panel of experts decided by the majority that the defendant's trademark ACOTEL is not similar to the plaintiff's trademark ALCATEL and that since the defendant's trademark has been used in telecommunication business, the attention level of consumers will be higher than the attention level of the average consumers and therefore there is no risk of confusion.

The Court having upheld the second experts' report held that the wording "TEL" covered in the plaintiff's and the defendant's trademark is the abbreviation of wording "telecommunication" and therefore the essential elements of the trademarks are the prefixes "ALCA" and "ACO" and that the trademarks shall be considered in respect of their visual overall. Accordingly the Court ruled that the trademark ALCATEL is not similar to the defendant's trademark ACOTEL, that both parties -Alcatel and Acotel S.p.A is involved in telecommunication and accordingly the consumers are generally investor companies which would carefully ascertain the service providers and that the consumers would not confuse the trademarks ACOTEL and ALCATEL.

As a result, the Court decided to reject the action.