

GENTLEMAN CASE SUMMARY

Jurisdiction	:	Turkey
Subject Heading	:	III.A.4.Unfair, Unauthorized or Improper Use, Infringement of Trademark Rights
Case Name and Citation	:	Ankara Court of Intellectual and Industrial Rights, Case No.2009/238, Decision No.2010/100
Plaintiff/Counter defendant:		Basari Musavirlik Ticaret Ltd. Sti.
Defendants/Counter plaintiffs:		DUNYA AKTUEL DAGITIM AS DUNYA SUPER DAGITIM AS DUNYA YAYINCILIK AS
Main action	:	The prevention of the trademark infringement and unfair competition
Counter action	:	Cancellation of the trademark
Date of Main action	:	September 29, 2009
Date of the counter action	:	December 10, 2009

The plaintiff/Counter defendant claimed that;

- they own the trademark “GENTLEMAN” numbered 31.12.2003/36956 and registered for the classes 3, 4, and 16.
- the defendants publish a magazine using the trademark, “gentleman” as advertising material, the mentioned magazine has been also distributed in Ankara and
- they cause trademark infringement and leads to confusion with their products in this regard. trademarks and the denomination which leads to confusion with these trademarks on the material they are producing, advertising and commercial materials thereof and on their commercial correspondences jointly.

And requested from the Court,

- the determination of defendant’s use of the denomination “GENTLEMAN” on the magazine they are publishing and related commercial materials thereof and the prevention of such actions constitute trademark infringement and unfair competition
- the announcement of the decision in the newspaper.

The defendants rejected all of these claims and stated that;

- The plaintiff has not granted the right to file claim due to the fact that the plaintiff is not the real trademark right holder,
- the real right owner is a non-party company, namely ‘MILANO FINANZA EDITORI SPA’ and the defendant has been the licensee of the mentioned non-party company and using the trademark MF GENTLEMAN in terms of the license contract, which has been registered for the classes 16,18, 25, 35, 38 and 42,

-the plaintiff filed the action in bad faith according to the Article 2 of Turkish Civil Law,
-the plaintiff has registered the subject trademark GENTLEMAN incidentally and misusing such rights in this regard,
and therefore there does not exist trademark infringement or unfair competition and requested from the Court the rejection of the court action.

Furthermore the defendant has filed a counter cancellation action on the basis of non-use and claimed that the plaintiff has not used the trademark GENTLEMAN sufficiently in the grace period of five years before the date of the main action and requested from the court; the cancellation of the plaintiff's trademark GENTLEMAN on the basis of non-use as per the Articles 14 and 42 of the Turkish Trademark Decree Law.

Overview of Final

Decision and Ruling:

In the light of the explanations and evidences the court has rejected the counter action and declared that;

The necessary usage period of the trademark which is required as per the Articles 14 and 42 of the Decree Law shall begin from the registration date of the trademark. In the subject matter the trademark GENTLEMAN has been registered on 05.04.2005 and the grace period of 5 years will expire on 05.04.2010 however the counter action has been filed on 29.09.2009. Therefore the counter action should be rejected due to the untimely filing and all of the litigation costs shall be charged from the (counter) plaintiff.

Importance of Case: This decision is important because it establishes that the required use of the trademark as per the decree law should be counted from the actual registration date.

Overview of Final

Decision and Ruling:

With regard to the main action the court has rejected the action and declared that;

It has been proved with the evidences that the defendant has been the licensee of the mentioned non-party company and using the trademark MF GENTLEMAN in terms of the license contract and therefore the defendant's use of the denomination "GENTLEMAN" does not constitute trademark infringement.

Furthermore the cancellation action has been filed in bad faith due to the fact that the plaintiff has not filed the action within a reasonable period of time considering that the defendant has been using the trademark for many years before the action and all of the litigation costs shall be charged from the plaintiff.

Importance of Case: This decision is important because it establishes that the cancellation action should be filed within a reasonable period of time and in the contrary would constitute bad faith.

Images/Description:

Contributor Firm: Deris Law Office