

Procedural Matters - Appellate Procedure - Jurisdiction/Authority

“MADO” Trademark

YAŞAR DONDURMA VE GIDA MADDELERİ A.Ş. vs. TURKISH PATENT INSTITUTE

(*) Court of Ankara on Intellectual and Industrial Rights

Case No. 2004/529 Decision No. 2004/250 (20.10.2004)

An action (*) was instituted against the Turkish Patent Institute for the determination/acknowledgement of the notoriety of the trademark MADO.

The plaintiff claimed that the history of the trademark MADO goes back to 150 years, that 6.000-ton ice cream is produced under MADO trademark per year, that there are many branches in Turkey and abroad reaching a very large target customer, that he has gained several awards owing to the activities under the trademark MADO, that he has a very big market share as a leading company in Turkey as to its paid-in capital, turnover, profit and paid company taxes, that he owns 8 registrations for the trademark MADO in Turkey since 1994 and also his trademark is registered in many countries according to the provisions of Madrid Protocol, consequently, the plaintiff claimed that its trademark has become a well-known trademark in the sense of Article 7/1-i of Decree-Law no. 556.

The defendant pointing out that according to the established Supreme Court decisions on well-known trademarks it is mandatory to cite the T.P.I. as defendant held that the concept of well-known trademarks in the sense of Article 7/1-i of Decree-Law no. 556 includes the trademarks that are known in the concerned field of trade in Turkey and abroad, that are owned by a citizen of the Paris Convention countries or by someone who has an enterprise in these countries and thus do not cover the trademarks known only in one country or a few regions of a country. The defendant further held that in order to be considered as well known, the plaintiff's trademark should fulfill the criteria determined by the WIPO Committee of experts on well-known trademarks.

The plaintiff affirmed that he has filed no application with the T.P.I. for the determination/acknowledgement of the notoriety of its trademark.

The Court has rejected the plaintiff's claims on grounds that although the competent authority deciding on the notoriety of a trademark has not been clearly determined in the legislation and/or international treaties at the time when the action has been instituted, according to the Article 1 of advisory "Co-Decision" that has been issued at the 34. Administrative Union/Council of WIPO, the competent authority to decide on the notoriety of the trademark would be the authorized institutions that are providing the protection of the trademarks and the courts. According to the Decree-Laws no. 554 and 556 and to the international treaties of which Turkey is a signatory; the Courts and the Turkish Patent Institute are the competent authorities to determine/acknowledge the notoriety of trademarks. In fact, according to the Article 13/b of the Law of the Establishment and Duties of the Turkish Patent Institute published in the Official Gazette dated 19.11.2003 under no.5000 the duty to determine the criteria regarding the notoriety of trademarks and to enforce and apply of such criteria has been given to the Turkish Patent Institute. The plaintiff has instituted the action without applying to the Competent Authority, that is the T.P.I., for the determination/acknowledgement of the notoriety of his trademark, which is contrary to the registration system of the Decree-Law no. 556 on Trademarks. Under such circumstances, as it is not possible to directly institute a court action without firstly following the legal procedure, i.e. without an unfavorable and finalized decision of the Competent Authority, the Court rejected the plaintiff's claims on grounds that the requirements for filing the Court action are not met without pronouncing itself on the issue of the notoriety of the trademark.