

Registrability – Likelihood Of Confusion (Similarity Of Trademarks)

DEBENHAMS-DEBENHAMS

DEBENHAMS RETAIL PLC vs. EMINE REZAN SAGLAM

(*) 1st Court of Istanbul on Intellectual and Industrial Rights

Case no. 2001/1460– Decision no. 2006/159, decision of May 23, 2006), notified on September 14, 2006 (unpublished)

An action(*) was instituted against the registrant Emine Rezan Sağlam for the cancellation of trademark registrations nos.195362 DEBENHAMS, 97/15841 DEBENHAMS and 97/15842 DEBENHAMS on grounds of similarity to the plaintiff's well-known and registered trademark DEBENHAMS and the bad faith of the defendant.

The plaintiff's attorney claimed that his client's trademark DEBENHAMS is a well-known trademark; that the defendant has registered DEBENHAMS trademarks for different goods and that the denomination DEBENHAMS is the name of its founding partner and the essential element of its trade name. The plaintiff further requested the cancellation of the trademark registrations no. 195362 DEBENHAMS, 97/15841 DEBENHAMS and 97/15842 DEBENHAMS and the compensation due to the trademark and the trade name infringement.

The defendant's attorney claimed that the action was not instituted in due time; that the plaintiff did not prove his claim as to the well-known status of DEBENHAMS and that the founding partner did not have any relationship with the plaintiff as from 1927.

The Court ruled that although the plaintiff's trademarks have been registered in several countries as from 1994, most of the evidences have been attesting the well-known status and the use of plaintiff's trademark after 1999 which is not prior to the registration date of the defendant's trademark, that accordingly the well-known status of the plaintiff's trademark was not proved as of the application date (1997) of the defendant's trademarks.

The Court however held that the denomination DEBENHAMS is the distinctive element of the plaintiff's trade name in the view of the fact that the plaintiff's had changed his trade name as Debenhams Plc before December 4, 1997 and accordingly that the denomination DEBENHAMS is protected according to the Article 8 of the Paris Convention and Article 8/5 of the Decree Law no.556 on the trademark. The Court finally ruled that the defendant's registrations were obtained in bad faith for an intention to block the registration of the plaintiff's trademarks.

As a result the Court partially accepted the action and ruled to the:

cancellation of the defendant's trademark registrations no.195362 DEBENHAMS, 97/15841 DEBENHAMS and 97/15842 DEBENHAMS

publication of the verdict in a newspaper.