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Registrability – Likelihood Of Confusion (Similarity Of Trademarks)

"SARAY MILKINS, VILKINS/MILKA MILKINIS" Trademarks

SARAY BISKUVI VE GIDA SAN. A.S. vs. TURKİSH PATENT INSTITUTE (T.P.I.)
vs.
KRAFT JACOBS SUCHARD S.A.

(*) Court of Ankara on Intellectual and Industrial Rights
Case no. 2003/42 – Decision no.2005/256 (April 28, 2005)

An action (*) was instituted for the withdrawal of the Turkish Patent Institute's final decision refusing the opposition filed against the trademark application MILKA MILKINIS and for the cancellation of the said trademark application on grounds of similarity to the plaintiff's registered trademarks SARAY MİLKİNS and VİLKİNS.

A counter action (*) was instituted by KRAFT JACOB SUCHARD for the cancellation of the plaintiff's trademark registrations SARAY MİLKİNS and VİLKİNS on grounds of unfair competition and infringement of its well-known trademarks "MİLKA", "MİLKA MİLKİNİS" and "MİLKİNİS".

The plaintiff/counter-defendant claimed that the trademarks SARAY MİLKİNS/VİLKİNS and MILKA MILKINIS are almost identical and that although the opposition filed against the trademark MILKA MILKINIS has been accepted, the Higher Council of Re-Examination and Re-Evaluation has overturned the initial decision of the Trademarks Department and accepted the trademark MILKA MILKINIS for registration. On such grounds the plaintiff requested the withdrawal of the administrative decision refusing the opposition against the trademark application for MILKA MILKINIS and the cancellation of the registration for said trademark for similar goods.

The defendant T.P.I. objected by asserting that the subject action is not well-grounded and that the decision of the Higher Council of Re-Examination and Re-Evaluation is in conformity with the law and procedure.

The defendant/counter-plaintiff asserted that the trademarks MILKA MILKINIS, MILKA and MILKINIS are well-known trademarks throughout the world, that the trademark MILKA had been registered initially in Switzerland on 16.03.1901, and thereafter registered in many countries and internationally MILKINIS has been firstly used on 17.02.1989 and MILKA MILKINIS has been firstly used on 17.12.1992, that the trademarks MILKA MILKINIS and MILKINIS has been derived from the trademark MILKA, that these trademarks have been registered in 55 countries nationally and internationally, that the trademark MILKA and its derivatives have been used in Turkey since 1914, that although its trademark has become a well-known trademark in a very short period of time in scope of Article 6bis of the Paris Agreement, the registration of the trademarks VILKINS and SARAY MILKINS in the name of plaintiff/counter-defendant without the consent of the well-known trademarks owner should be considered in bad faith and abusive and therefore cannot confer trademark rights to plaintiff/counter-defendant. On such grounds, the defendant/counter-plaintiff claimed rejection of the cancellation action instituted by plaintiff/counter-defendant, determination, preventing and stopping of the trademark infringement and unfair competition caused by the registration of the trademarks VILKINS and SARAY MILKINS in the name of plaintiff/counter-defendant and cancellation of the plaintiff's trademark registrations including the words VILKINS and MILKINS.

The Court held that according to Article 53 of the Decree-Law no. 556 on Trade/Service Marks reading "Actions may be instituted, within two months of the notification of the decision, before the Competent court against the final decisions of the Re-examination and Evaluation Board in respect of the appeals/objections provisioned in Articles 47 through 52 inclusive", the action for the withdrawal of the decision of the Higher Council has been instituted after the expiration of the inextensible deadline for filing a court action and therefore rejected the plaintiff/counter-defendant's action against the T.P.I..

Furthermore, the Court has rejected the plaintiff/counter-defendant's cancellation action that has been instituted on August 21, 2000; on grounds that the action has not been timely instituted since on the date of the institution date of the action the trademark MILKA MILKINIS had not matured into registration.

As to the counter-action by KRAFT JACOB SUCHARD, in respect of the claims of defendant /counter-plaintiff, the Court ruled that:
According to the information and the evidences submitted to the file, the trademarks MILKA, MILKINIS and MILKA MILKINIS are well-known in scope of Article 6bis of the Paris Agreement; and of Article 7 parag. 1(i) of the Decree-Law No. 556.

The trademarks MILKA, MILKINIS and MILKA MILKINIS are confusingly similar to the trademarks VILKINS and SARAY MILKINS;
The goods covered by said trademarks are confusingly similar as well;
Continuance of the registration for the trademarks VILKINS and SARAY MILKINS will constitute trademark infringement, unfair competition and unjust gain in favor of the plaintiff/counter-defendant,
The registrations for the trademark VILKINS and SARAY MILKINS are to be cancelled.

The Court rejected the claims of the defendant/counter-plaintiff that the **use** of the trademarks VILKINS and SARAY MILKINS constitute an act of unfair competition by asserting that use of a right originating from a registration obtained in accordance with the law is not deemed to constitute unfair competition or trademark infringement.