

Registrability – Likelihood Of Confusion (Similarity Of Trademarks)

“V VALENTINO/ MARIO VALENTINO“

VALENTINO GLOBE B.V. v.s. TURKISH PATENT INSTITUTE

(*) 1st Commercial Court of Ankara
Decision No.1998/805-2000/457 (October 12, 2000)
(Notified March 12, 2001)

An action (*) was instituted against the Turkish Patent Institute for the withdrawal of the administrative decision partially refusing the registration of the plaintiff's trademark V VALENTINO due to its similarity to the priorly registered/applied trademarks MARIO VALENTINO reg. no.103671, V. AURELIO VALENTINO reg.no.124710, ENYIL VALENTINO app. no.96/3209, VALENTINO reg. no. 155875 according to Article 7 parag. 1 (b) of the Decree-Law No.556 and for the recognition of the notoriety of plaintiff's trademark and of the bad faith of the applicants/registrants in obtaining the trademarks cited against the plaintiff's trademark by the Turkish Patent Institute.

The Plaintiff claimed that the decision of partial refusal in respect of certain goods is unjustified and that the trademark is to be registered for all the goods mentioned in the application petition for the trademark V VALENTINO, since the word VALENTINO is the trade name of the plaintiff as well as a personal name of a famous designer, such refusal of registration infringes also the rights originating from the trade name of the plaintiff and since the trademark acquired distinctiveness due to the stylized V LOGO of the trademark. The plaintiff further claimed that there is an agreement dated 11.05.1979 between Mario Valentino and the plaintiff allowing the registration of the trademark VALENTINO for the goods listed in the trademark application petition of the plaintiff, that the cancellation action against the trademark MARIO VALENTINO before the 1st Commercial Court of Beyoğlu is still pending, that it has been confirmed in the expert report established as of the action in determination of evidence before the 9th Commercial Court of İstanbul that the trademark VALENTINO and its LOGO are well known, that the similarity of the trademarks VALENTINO and ENYIL VALENTINO is not by coincidence since the trade name of this trademark's applicant is Valentina Tekstil Sanayi ve

Ticaret Limited Şirketi, that the trademark VALENTINO is under protection according to the Article 6bis of Paris Agreement due to its notoriety, that the defendant also has accepted the oppositions against third parties trademarks and refused to register those trademarks, that the trademark V VALENTINO has acquired distinctiveness owing to its longstanding and worldwide use for all the goods mentioned in its application, therefore it is not possible to refuse its registration according to the last paragraph of the Article 7 of Decree-Law No.556.

The T.P.I. objected by asserting that there is no provision reading that it is compulsory to register a trade name as a trademark or forbidding the registration of a trade name in the name of the third parties, that the administrative decision of refusal is well grounded according to Article 7 parag. 1(b) of Decree-Law no.556 and Supreme Court decisions, that the agreements between the parties for allowing registrations does not bind the T.P.I., that the pending court actions are not to be taken into consideration, the trademark V VALENTINO does not fulfill the requirements for notoriety, that the favorable consideration by the T.P.I. of the plaintiff's oppositions does not refer to or confirm such notoriety.

Adopting the conclusions of the experts' report, in its decision (*) the court held and recognized that the trademark V VALENTINO is well-known due to its worldwide registrations, to its extensive use without any limitation of geographical boundaries and disparity of cultures, to its effective advertisements to its wide spread distribution channels, and ruled that it is under protection in Turkey as of Article 7 parag. 1(i) of the Decree-Law No. 556 on Trademarks and that on such grounds and on ground that the trademark applied for has acquired distinctiveness due to its longstanding use the partial decision of refusal is unjustified and is to be withdrawn to allow the registration of the mark in respect of all goods applied for.

Upon such grounds the Court did favorably consider the claims of the plaintiff and decided to cancel the administrative decision of partial refusal.