

## Infringement And Defenses – Famous Marks

### “VIVA HOTELS & RESORTS+DEVICE / VIVA TOURS – VIVA DEVICE” Trademarks

#### Grup Otel Turizm Otelcilik ve Tic. A.Ş. and Temtur Turizm A.Ş. vs. Turkish Patent Institute & AGS Turizm Ve Dış Tic Ltd & Iberidlineas Aereas De Espane S.A.

#### (\*) 11<sup>th</sup> Civil Chamber of Supreme Court Case No. 2006/11717, Decision No. 2007/14157

Grup Otel Turizm Otelcilik ve Tic. A.Ş. and Temtur Turizm A.Ş. brought an action<sup>(\*)</sup> against the Turkish Patent Institute for the withdrawal of its final decision refusing the plaintiffs' trademark application for VIVA HOTELS&RESORTS+DEVICE in classes 39.01 and 42.08 on the grounds of indistinguishably similar trademarks VIVA TOURS and VIVA+DEVICE in accordance with Article 7, paragraph 1, subparagraph (b) of the Decree-Law on the Protection of Trademarks (Decree-Law No. 556) and against AGS Turizm Ve Dış Tic Ltd and Iberidlineas Aereas De Espane S.A. for the cancellation of their trademarks VIVA+DEVICE and VIVA TOURS respectively, cited against the plaintiffs' trademark application.

The defendant Institute asserted that its decision was consistent with the provisions of Decree-Law No. 556. The defendant, IBERIDLINEAS AEREAS DE ESPANE S.A., asserted that the trademarks in question are similar as to cause likelihood of confusion and that its trademark is a well-known mark and that the request of the plaintiffs for the cancellation of their trademark is groundless seeing that the plaintiffs have lodged an objection before the Higher Council of the Turkish Patent Institute by claiming that there is no similarity between the marks at issue. It therefore requested the rejection of the case. The third defendant, AGS TURIZM VE DIŞ TİC LTD has asserted that there is similarity between the marks as well as between their listing of the services at issue and that it would not be possible to mention well-known character of the name of a hotel operating in one city only, namely Nevşehir and thus requested the rejection of the case.

The Court, in accordance with the evidences submitted as well as the expert report, held that (1) the trademark applied for is indistinguishably similar with the essential VIVA element of the cited trademarks, (2) will cause confusion on the part of the average consumers due to identity of the kind of services in question, (3) the notoriety claim cannot be examined as the action brought for the withdrawal of the Higher Council's decision cannot overrun the scope of the objection claims and (4) finally the rejection of the trademark applied for is compulsory in accordance with Article 7, paragraph 1, subparagraph (b) of the Decree-Law on the Protection of Trademarks (Decree-Law No. 556). It has thus rejected the action brought against the Turkish Patent Institute.

The Court determined that the plaintiff uses the trademark applied for since 1991 with respect to temporary accommodation services thus have protectable acquired rights, in the virtue of the provisions of unfair competition, over the subject sign based on the prior use and for this reason the Court has further held that the registration of the defendant's trademark for temporary accommodation services in spite of the plaintiff's indistinguishably similar trademark would create unfair competition against the plaintiff. The Court therefore ruled that the defendant's trademark registration for VIVA+DEVICE is cancelled and the mark should be excluded from the Trademark Registry.

On the other hand, the Court held that the plaintiff does not have acquired rights for the transportation service in class 39.01 on the basis of a prior use and therefore ruled the rejection of the plaintiff's claim for the cancellation of VIVA TOURS trademark belonging to IBERIDLINEAS AEREAS DE ESPANE S.A