

I.E. Bad Faith

DICKEY-JOHN CORPORATION has instituted an action against KEMAL KANTAR ÖLÇÜ KONTROL SİSTEMLERİ İTHALAT PAZARLAMA VE TİCARET LİMİTED ŞİRKETİ, ABP ÖLÇÜ KONTROL SİSTEMLERİ İTHALAT PAZARLAMA TURİZM VE TİCARET LİMİTED ŞİRKETİ and KEMAL KANTAR for;

- 1- The determination that the DICKY-JOHN+device trademark, genuinely belongs to the Plaintiff DICKY-JOHN CORPORATION,
- 2- The determination that the DICKY-JOHN+device¹ trademark registered in the name of the Defendant Company is registered in bad-faith and of which registration infringes the Trademark, Copyright and Trade Name rights of the Plaintiff and the prevention thereof,
- 3- The assignment of the trademark formed of the denomination DICKY-JOHN+device registered in the name of the Defendant Company, based on the assertion that the defendant parties are the authorized Turkish distributors of the plaintiff, (In case the Court should not decide the assignment, the cancellation of the DICKY-JOHN+device registered in the name of the Defendant Company) and
- 4- The Publication of the decision within one of the three most widely circulated Newspapers of Turkey.

The plaintiff claims that its International trademark application DICKY –JOHN² filed through the World Intellectual Property Organization (WIPO) also designating Turkey, has been rejected by the Turkish Patent Institute, based on the prior DICKY-JOHN+device registered in the name of the Defendant Company and that the DICKY-JOHN+device trademark genuinely belongs to the Plaintiff DICKY-JOHN CORPORATION, which also covers the presently used identical “logo” element and the Trade Name of the Plaintiff infringing the Copyright together with the Trade Name of the same. Furthermore, the Plaintiff claims that the Defendant Company has been the local Distributor of the Plaintiff for many years in Turkey and therefore requests the illegal registration of the DICKY-JOHN+device trademark to be assigned to their side.

The defendants asserted that, they are the supplier of the Plaintiff in Turkey and they had introduced and sold the subject DICKY-JOHN+device trademark in Turkey for many years. The Defendants further claims that, through the usage of the DICKY-JOHN+device trademark in Turkey, many imitative products has roused and despite all the warnings of the Defendants against the Plaintiff, the Plaintiff did not take action against such imitation, thus they have left to register the DICKY-JOHN+device trademark in Turkey on protection basis and therefore the bad-faith claim of the Plaintiff is groundless.

The Court decision states that, in light of the submitted declarations and evidences it is understood that; The plaintiff has been using the trademark DICKY-JOHN+device for the electronic machines concerning farming business and the respective machines has been sold around the world through 300 distributors, which the same has also been sold in the Turkish markets long before the registration of the DICKY-JOHN+device registered in the name of the Defendant Company and as the result of long standing and extensive use of the trademark DICKY-JOHN+device together with the quality thereof, the DICKY-JOHN+device trademark has become distinguished.

¹. Dickey-John device registration no. 2005/43975

². Dickey-John IR registration no. 908913, TR application no. 2005/43975

Thus, the Plaintiff is qualified to enjoy the right provided under Articles 8/3³ and 8/4⁴ of the 556 No. Decree Law.

The Court further accepts that that the “logo” element together with the original color and graphical elements (as given below) of the Plaintiffs trademark is subject to Copyrights as an Art product according to the Bern Agreement, 5846 No. FSEK(Turkish Law on Intellectual and Artistic Works) 556 No. Decree Law Article 8/5⁵.



Defendant's Mark



Plaintiff's Mark

Furthermore, within the scope of the submitted claims and supportive evidences thereof, the Court held that the Plaintiff is the Turkish distributor of the Plaintiff since 1988 -over 20 years- and the Defendants could not prove and submit any evidences showing a justified reason for the registration of the DICKEY-JOHN+device trademark

Consequently, the Court accepted the action and decided⁶ that the DICKEY-JOHN+device trademark belongs to the Plaintiff, the defendant's trademark DICKEY-JOHN+device is registered bad-faith and infringes the Trademark, Copyright and Trade Name rights of the Plaintiff and ruled for the assignment of the DICKEY-JOHN+device trademark to the Plaintiff together with the Publication of the decision in one of the three most widely circulated Newspapers of Turkey.

³Article 8/3, paragraph 3, Subparagraphs (a) and (b) provides: Upon opposition by the proprietor of a non-registered trademark or of another sign used in the course of trade, the trademark applied for shall not be registered provided that;

a) the rights to the sign were acquired prior to the date of filing of the application for registration of the trademark, or prior to the date of priority claimed for the application for registration,

b) the sign confers on its proprietor the right to prohibit the use of a subsequent trademark,

⁴.Article 8/4, paragraph 4, provides: “A trademark applied for which is identical or similar to a registered trademark or to a trademark application with a prior date of filing may be used for different goods and services. However, where in the case of a registered trademark or of a trademark application with a prior date of filing, the trademark has a reputation and where the use without due cause of trademark applied for would take unfair advantage of, or be detrimental to, the distinctive character or repute of the registered trademark or of the trademark application with a prior date of filing, upon opposition by the proprietor of the prior trademark registration or application, the trademark applied for shall be refused even if it is to be used in respect of differing goods and services.”

⁵. Article 8/5, paragraph 5, provides: Upon opposition by the holder of the relevant right, the trademark applied for shall not be registered if it contains the personal name, photograph, copyright, or any industrial property rights of third parties.

⁶. *Dickey-John Corporation v. Kemal Kantar Ölçü Kontrol Sistemleri İthalat Paz. ve Tic. Ltd. Şti., ABP Ölçü Kontrol Sistemleri İthalat Paz. Tur.ve Tic. Ltd. Şti. and Kemal Kantar* Case No. 2007/6, Decision No. 2008/23 (İstanbul Beyoğlu Court of Intellectual and Industrial Property Rights, December 14, 2008)

