

IAR CASE SUMMARY TEMPLATE

Jurisdiction : Republic of TURKEY / Kartal Civil Court of Intellectual and Industrial Property Rights

Subject Heading : I.D.1. 1. Similarity of Marks

Case Name and Citation : FIBROBETON v. FIBROFLEX
Docket No: 2009/54
Decision No: 2010/44

Plaintiff: FIBROBETON YAPI ELEMANLARI SAN.INS.LTD.STI.

Defendant: MAVI BETAON INS. SAN.VE TIC.LTD.STI

Marks Associated

with Goods/Services: The Plaintiff's trademark FIBROBETON¹ 94/000538 fibro FOMBETON , 88/104575 FIBROBETON , 2006/20551 FIBROBETON DEVICE , 97/016276 FIBROCK , 97/016278 FIBROCON, 97/006802 FIBRON,97/016274 FIBRONET ,97/016277 FIBRONET 97/016275 FIBROSET registered in classes 17 and 19. The defendant's trademark "FIBROFLEX"² registered in class 19 and 37.

Nature of Case: The Plaintiff claims the invalidity of the Defendant's registered trademark which is almost identical with its well-known trademark in Turkey and its trade name according to the articles 8/1 (b)³, 8/4⁴ of the Decree–Law No: 556.

Overview of Decision

¹ Registration No: 1994 000538

² Registration No: 2008 29461

³ **Article 8: Upon** opposition by the proprietor of an application for registration of a trademark or of a registered trademark, the trademark applied for shall not be registered subject to the following conditions:

b) Where the trademark applied for is identical or similar to a registered trademark or to a trademark applied for registration under a prior date of filing and the registration is sought for identical or similar goods or services in that the likelihood of confusion includes the likelihood of association with the registered trademark or with the trademark applied for registration under a prior date of filing.

⁴ 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.

and Ruling:

The plaintiff claims that its Company is one of the world leaders in the sector and its registered trademark FIBROBETON, which is the essential part of its Trade Name, filed before the Turkish Patent Institute is a well-known trademark in Turkey due to intense advertisement and promotion activities and the Defendant's trademark "FIBROFLEX" registered with bad –faith in class 19 and 37 benefits from the reputation of the Plaintiff's trademark which is almost identical as visual and phonetic terms.

The defendants asserted that, that there is no similarity between trademarks in terms of production and that the denomination "FIBRO" cannot be considered as distinctive element of the trademark and that "FIBRO" is a technical word in construction sector.

The Court decision states that, in light of the submitted declarations and evidences it is understood that; the Plaintiff's trademark is a well-known trademark regarding well-known trademarks, application of the Court of Appeal⁵ will benefit from protection in the scope of the Decree Law number 556.

Thus, the Plaintiff is qualified to enjoy the right provided under Article 8/4 which refers to well know trademark and the Defendant could not use "FIBROFLEX" trademark, which is almost identical with the Plaintiff's trademark.

Consequently, the Court accepted the action and ruled that the defendant's FIBROFLEX is registered with bad-faith and infringes the well-known Trademark and Trade Name rights of the Plaintiff and the invalidity of the FIBROFLEX trademark.

Importance of Case: This decision is important because it establishes that the regulation provides protection to well-known trademarks against the use of identical or similar marks to distinguish dissimilar goods or services and that the denomination "FIBRO" cannot be considered as a technical/generic term in the sense of the article 12 of the Decree Law number 556.

Images/Description:

Contributor Firm: Deris Patents and Trademarks Agency

⁵The decision of the 11.Chamber of the Court of Appeal dated 19.04.2002, Docket No: 2001/9903 – Decision No: 2002/3699

