

Registrability- First To Apply Versus First To Use

“BARİŞ” Trademark

(*) 5th Commercial Court of Istanbul (Beyoğlu), Decision no. 938-866 (October 8, 1997)

() 11th Civil Chamber of the Supreme Court, Decision no. 1998/359- 1998/5121 (July 6, 1998)**

An action (*) for trademark infringement and unfair competition was instituted claiming the cancellation of the trademark “BARİŞ” abusively registered in the name of the defendant in Turkey as well as compensation for material and moral damages. The plaintiff further claimed that the defendant’s abusive registration infringes his the trade name and constitutes an act of unfair competition in this regard, therefore should be cancelled.

The plaintiff asserted that as he has been using the trademark “BARİŞ” on spring beds since 1992, the use of the trademark “BARİŞ” by the defendant, which is abusively registered in the name of the defendant, leads to unfair competition.

The defendant objected by asserting that the trademark has been registered in his name on 08.11.1994 and that the deadline of 6 months for instituting an action has lapsed (according to Article 15 of the former Decree Law No.551 on Trademarks in Turkey) and that he has been using the trade name “BARİŞ SUNGER YATAK” since 1983.

Considering the submitted evidences and the experts’ report, the Court (*) ruled that the use of registered trade name and trademark by the defendant does not constitute unfair competition and trademark infringement against the plaintiff’s non-registered trademark and trade name according to the Article 61 of the Decree Law no.556 on Trademarks and Paragraph 5 of Article 57 of Turkish Commercial Code.

Upon plaintiff’s appeal the Supreme Court (**) has overturned the decision of the first instance court on ground that Article 8 parag. 3 of Decree Law no.556 on Trademarks provides that an opposition against a trademark application can be lodged even if the opponent does not have a trademark registration of his own provided he uses said trademark or sign in the course of his business prior to

the filing of the application. As Article 42 parag. 1 (b) of said Decree-Law, provides that it is possible to institute an invalidity action when the prerequisites cited in Article 8 are met, any person suffering damage from a subsequent trademark registration can request before the Court the cancellation of such registration. Under such circumstances, the Supreme Court held that it is unjustified to reject the plaintiff's requests only considering that the use of a registered trademark does not constitute trademark infringement against a non-registered trademark without evaluating the merits of the case requesting the cancellation of the registration in view of the aforementioned legal provisions.

N.B.:

This case has been cited in the Journal of Intellectual Property and Competition Law of Ankara Bar Association (Issue No. 2001/2) where the names of the parties concerned are not cited.

ANKARA BAROSU FIKRI MULKIYET VE REKABET HUKUKU DERGISI (JOURNAL OF INTELLECTUAL PROPERTY AND COMPETITION LAW OF ANKARA BAR ASSOCIATION)
FMR VOL. I – No. 2001/2 – PAGES 183 TO 185