

Infringement And Defenses – Famous Marks

ICEBERG-ICEBERG

GILMAR S.p.A. vs. - THE TURKISH PATENT INSTITUTE - AS MADENİ EŞYA VE EMAYE SANAYİ LTD. ŞTİ.

(*) 8th Commercial Court of Ankara.

Decision No.1997/552-1998/1079 (December 16, 1998) (notified on February 8, 1999)

(**) 11th Civil Chamber of the Supreme Court

Decision No.1999/3271-1999/5256 (June 14, 1999) (notified on July 16, 1999)

An action (*) was instituted against the Turkish Patent Institute upon the refusal of the T.P.I. to favorably consider the opposition raised by the plaintiff to the registration of the mark “ICEBERG” on grounds of notoriety of the trademark.

The plaintiff has asserted that the registration of the trademark infringes the trademark “ICEBERG” and that such registration would damage the reputation of the trademark and cause an unfair advantage to the applicant and has claimed the cancellation of the decision together with the acknowledgement of the worldwide reputation of the subject trademark.

The T.P.I. objected that as the decision on the matter is to affect directly the trademark rights of the applicant “As Madeni Eşya ve Madeni Eşya Sanayi Ltd. Şti.” a trademark cancellation action is to be instituted against the concerned applicant.

The 8th Commercial Court of Ankara favourably considering the claims of the defendant has ruled (*) that the administrative decision is to be upheld. However, upon the plaintiff’s appeal the Supreme Court overturned the decision enjoining the 8th Commercial Court of Ankara to rule that a cancellation action is to be separately instituted against the applicant of the opposed trademark within a time period to be determined by the Court and that such cancellation action is to be further joined with the action instituted against the T.P.I. (**). The 8th Commercial Court upheld the decision of the Supreme Court and ordered that a further cancellation action is to be separately instituted against the applicant and that such action is to be joined with the current action against the T.P.I.

As the action depended principally on the notoriety of the trademark and its acknowledgment as such, the plaintiff requested that the matter be referred to a committee of experts to be nominated by the

court to this effect for the evaluation and assessment of the notoriety. The court refused the request of the plaintiff on grounds that famous and known facts need not to be further evidenced and assessed and motivated its decision (*) by referring to the Supreme Court's case-law (not specified in the decision) according to which "the notoriety of a trademark reflexively occurs in everyone's mind" and that the reputation of a trademark can be evaluated and assessed by the court without an expert examination.

In its decision (*) the court decided favorably on behalf of the defendant and rejected the plaintiff's claim on the notoriety of the trademark "ICEBERG".

Upon the plaintiff's appeal against this decision (*), the Supreme Court rendered its decision (**) by ruling that, the plaintiff's claim being notoriety, the determination thereof cannot be evaluated and assessed on the basis of the personal knowledge of the judge. Accordingly, the Supreme Court overturned the decision (*) on grounds of being rendered without having conducted an expert examination.