

Similarity Of Marks

“PATAGONIA/PATAGONIA BY DEBA”

Patagonia Inc. vs. T.P.I and vs. Denizli Basma ve Boya San. A.S.

3rd Ankara Court of Intellectual and Industrial Rights, Case no. 2006/535, Decision no. 2007/56, (March 20, 2007).

Patagonia Inc. instituted an action against the Turkish Patent Institute for the withdrawal of its final decision, partially refusing the plaintiff’s trademark application PATAGONIA¹ and against Denizli Basma ve Boya San. A.S. for the cancellation of their trademark PATAGONIA BY DEBA² cited against the plaintiff’s trademark application.

The plaintiff claimed that since their trademark PATAGONIA has been held, by the previous Court decision, as a well-known trademark in the sense of the Article 7/I-i of Decree Law No. 556, the same should benefit from the provision of last paragraph of the Article 7 (with regard to the distinctiveness acquired through use).

The Court held that the Expert Report prepared in the case heard by the 1st Court of Istanbul on Intellectual and Industrial Rights for the recognition of the well-known character of the PATAGONIA trademark would be suitable (and adequate) for them to decide on the present case². In this respect; by also taking into consideration the Supreme Court’s established case law that, the fact that well-known status of the trademark has been proven would in itself presuppose that the trademark has acquired distinctiveness through use before the date of application in the sense of the of the last paragraph of the Article 7, the Court accepted the Plaintiff’s claims against the Turkish Patent Institute and ruled for the withdrawal of the final decision of the rejection of the T.P.I.³

The defendant having in the meantime voluntarily cancelled its registration, the plaintiff’s claims for trademark infringement and for compensation of material damages have not been accepted by the Court on grounds that the use of a registered trademark, until it is taken off the register, being lawful,

¹ Application No.2001/8097.

² 1st Istanbul Court of Intellectual and Industrial Rights, Case no. 2003/936E.

³ Registration No.2000 7895.

such use is not deemed to constitute infringement and from thereon no material damages would be of question because of such lawful use⁴.

⁴ *Patagonia Inc. vs. T.P.I and vs. Denizli Basma ve Boya San. A.S.*, Case no. 2006/535, Decision no. 2007/56 3rd (Ankara Court of Intellectual and Industrial Rights)