

## Infringement And Defenses – Famous Marks

### ROARING HORSE DEVICE

Ferrari S.p.A. - Turkish Patent Institute

(\*) 3<sup>rd</sup> Commercial Court of Ankara

Decision No. 1998/1070 – 1999/551 (November 11, 1999)

(\*\*) 11<sup>th</sup> Civil Chamber of the Supreme Court

Decision No. 2000/2762 – 2000/4717 (May 26, 2000)

An action (\*) was instituted for the withdrawal of the decision of refusal of the Turkish Patent Institute citing against the application filed by the plaintiff the prior registration in the name of an Austrian company the “roaring horse device” of which was held to be identical with the “roaring horse device” of the plaintiff’s application.

The plaintiff claimed that both the verbal element “FERRARI” and the design element “the ROARING HORSE DEVICE” of its trademark application subject to the decision of refusal are very well-known worldwide whether together or separately and that well-known trademarks should be accepted for registration in view of the fact that such marks enjoy protection even if they are not registered.

The defendant asserted that the “ROARING HORSE DEVICE” being identical in both marks, the registration of the plaintiff’s trademark will deceive the consumers, and claimed that the decision of refusal should be upheld.

Adopting the conclusions of the Experts’ Report, in its decision (\*) the court ruled that the “ROARING HORSE DEVICE” on both trademarks being identical and the prior trademark registration being under protection pursuant to Article 1 of the Decree-Law No. 556 on the protection of Trade/Service marks the decision of refusal is to be upheld as according to Article 8 parag. 3 of the Decree-Law No. 556 the registration of the plaintiff’s trademark would deceive the public in view of the protection the cited prior registration enjoys. The court further ruled that under such circumstances the plaintiff should request the cancellation of the cited prior registration against which no cancellation action has been filed.

Upon the plaintiff's appeal in its decision (\*\*) the Supreme Court overturned the decision of the first instance Court on grounds that the Article 7 last paragraph of the Decree-Law No. 556 allows the registration of the mark which has acquired distinctiveness through use in respect of goods applied for without having to request before hand the cancellation (through Court Action) of a prior similar registration and that this particularity recognized to marks having acquired distinctiveness is applicable in the first place, to well-known trademarks in the sense of Article 6bis of the Paris Convention, also considering the doctrine according to which "it is accepted that the acquired distinctiveness removes the risk of confusion in the market between identical or similar marks".

The Supreme Court further differentiating between the marks having acquired distinctiveness the well-known trademarks from those which are not well-known ruled that the owners of the well-known trademarks are not under the obligation to file beforehand a cancellation action against the priorly registered similar trademarks whereas the owners of such trademarks which are not well-known are, before they apply and request the registration of their marks.