

Repealing Of The Trademark- Non Use During An Uninterrupted Period Of Five Years

“ORGATREAT” Trademark

Ciba Speciality Chemicals Inc.vs. Organik Holding A.Ş.

4th Court of Istanbul on Intellectual and Industrial Rights,

Case no: 2006/198 Decision no: 2007/92

Ciba Specialty Chemicals Inc. instituted an action against Organik Holding A.S. for the partial cancellation of the trademark ORGATREAT1 for goods in international class 1 on grounds of non-use within the statutory period.

The plaintiff claimed that its international trademark registration no. 2003/17100 for IRGATREAT extended to Turkey has been rejected on grounds of similarity with the defendant’s trademark ORGATREAT, and that cited trademark has not been put to use by the defendant for goods in international class 1, also considering that there are no goods bearing this trademark in the market or in the Internet and requesting thereby the cancellation of the trademark ORGATREAT registration no. 166182 on grounds of non-use.

The defendant asserted that it has registered the trademark ORGATREAT in 1996 for goods in class 1 and 17, and that it has particularly used the trademark on “substances for anti-corrosion and against microbiologic dirt”, and that such use has never been interrupted for a period of more than 5 years, and that they have documentary evidence such as correspondences and invoices to evidence for such use.

The court has appointed a panel of experts, who established a report regarding the use of the trademark ORGATREAT wherein it is declared that the defendant uses the trademark ORGATREAT since 1997 on various products in class 1 and that the use has not been interrupted for a period of more than 5 years.

Considering that the defendant failed to submit any product bearing the ORGATREAT trademark, that no objective evidence has been furnished evidencing the sale of the product in the market and

extensive advertisement and promotion and that the defendant did only evidence the use of the ORGATREAT trademark through invoices, the Court held that invoices being weak evidences particularly in cancellation actions based on non-use, especially where no product package, no product advertisement, no promotion and no actual product exist, the fact that the trademark is only indicated on invoices never proves the effective use of the trademark.

The Court followed that within the 5 years statutory period, calculated as from the date the court action has been instituted namely December 14, 2004 there is only one invoice dated December 1999.

Despite the expert's report concluded that trademark is used, the Court found that not only the indication of the trademark on one single invoice is not sufficient to evidence the use, but also it does not constitute a serious use, as required by law.

Accordingly accepting the plaintiff's requests, the Court, by virtue of the Articles 14 and 42/1-c of Decree Law No. 556 ruled for the partial cancellation of the defendant's trademark in respect of goods in class 12.