

Originality of foreign mark sufficient for invalidation of two local marks based on bad faith
Turkey - Kenaroglu Intellectual Property

**Cancellation
National procedures**

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In two recent invalidation actions before the Istanbul Civil IP Courts of First Instance, two local trademark registrations for OLIVER PEOPLES have been invalidated on the basis of the reputation of the mark OLIVER PEOPLES in other jurisdictions, the plaintiff's genuine rights in the trademark arising from extensive prior use in other countries, and the bad faith of the defendants.

In the actions (filed in late 2013), plaintiff [Oliver Peoples Inc](#) - part of the [Luxottica Group](#), the world leader in the design, production and distribution of premium eyewear - requested the invalidation of two local registrations for OLIVER PEOPLES in Classes 9 and 14 before the Civil IP Courts of First Instance in Istanbul. The claims for invalidation were based on:

- the plaintiff's genuine rights in the mark OLIVER PEOPLES, which had been used extensively by the plaintiff and had become known in foreign markets prior to the defendants' local registrations; and
- the bad faith of the defendants, as it was unlikely that they would have created such a unique trademark and intended to use or register it for "sunglasses" without being aware of the plaintiff and its trademark.

The plaintiff had not used the mark OLIVER PEOPLES locally and had no registration or reputation for the mark in the Turkish market before the filing dates of the contested trademark. Moreover, there was no specific evidence proving the bad faith of the defendants.

In order to successfully base an invalidation claim on genuine rights in the same trademark, extensive prior use of the plaintiff's trademark on the Turkish market is normally required. Similarly, a bad-faith claim must be supported by evidence proving the alleged facts. More importantly, the plaintiff is expected to prove the reputation of its trademark with solid evidence in order to claim protection on the basis of the well-known status of its mark under Article 6*bis* of the [Paris Convention](#).

However, the IP courts concluded that:

- the trademark OLIVER PEOPLES was unique and had a strong distinctive character for eyewear, for which it had been used and registered by the plaintiff in other countries; and
- it was unlikely that the defendants would have created the same trademark and applied to register it for "eyewear and accessories" without being aware of the plaintiff's trademark.

Accordingly, both courts recognised:

- the plaintiff's prior rights in, and the well-known status of, the trademark OLIVER PEOPLES, without requiring prior use or reputation of the mark on the Turkish market; and
- the bad faith of the defendants in filing applications to register the trademark OLIVER PEOPLES without the authorisation of the genuine owner.

The court thus ordered the invalidation of the local registrations.

Both cases are significant for Turkish trademark practice: they reveal that, where there is an original and highly distinctive trademark, the Turkish IP courts are willing to grant broad protection to a foreign trademark against bad-faith registrations without requiring local use/registration or specific evidence of the counterparty's bad faith.

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Kenaroglu Intellectual Property represented the plaintiff in this case

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