

Infringement And Defenses - Famous Marks

(*) “ULFET ASIL PRENS, ASIL PRENS / PRINCE, CHOCO PRINCE, PRINCE FOURRÉ” trademarks.

(**) “DOGAN SISCO PRENS, DOGAN MILK PRENS / PRINCE, CHOCO PRINCE, PRINCE FOURRÉ”

(*) GENERAL BISCUITS BELGIE vs. ULFET BISKUVI VE GIDA SAN. A.S.

(**) GENERAL BISCUITS BELGIE vs. DOGAN GIDA SAN. VE TIC. A.S. &

(*) The Specialized Court of Istanbul for Intellectual and Industrial Rights

Decision no.2001/581 – 2001/253

(October 30, 2001), (notified on December 12, 2000)

(**) The Specialized Court of Istanbul for Intellectual and Industrial Rights

Decision no. 2001/582 – 2001/254

(October 30, 2001), (notified on December 12, 2000)

(**) General Biscuits Belgie vs. Karsa Biskuvi ve Gıda San. Tic. Ltd Sti.

11th Civil Chamber of the Supreme Court

Decision No.2000/9741 – 2001/888 (February 6, 2001),

(notified on March 15, 2001)

Two actions were instituted in parallel for the cancellation of ULFET ASIL PRENS, ASIL PRENS trademark registrations nos. 190727, 183042 (*) and DOGAN SISCO PRENS, DOGAN MILK PRENS trademark registration nos.133422 and 137675 (**) against their respective registrants ULFET BISKUVI (new company name: Melda Biskuvi) and DOGAN GIDA, on ground of trademark infringement and unfair competition.

The plaintiff which is a worldwide famous firm in the food industry specially for biscuits and chocolates, claimed that his “Prince” “Choco Prince” and “Prince Fourré” trademarks are well known, worldwide registered since 1955, registered in Turkey since 1976 and worldwide used since 1926 whereby the defendants’ trademark registrations including plaintiff’s PRINCE trademark covering identical goods are of nature to deceive the average consumer and constitute an act of trademark infringement and unfair competition and accordingly requested the recognition of the notoriety of his

PRINCE trademarks, the cancellation of the defendants' registrations with respect to the PRENS word and the seizure of the defendants' products.

ULFET BISKUVI counter claimed that the plaintiff has not opposed their trademarks during the registration procedure and that they are to be considered in their entirety for assessing the similarity between the concerned trademarks. The other defendant DOGAN GIDA counter claimed that their trademarks are registered since 1992 and that they are not to be confused with the plaintiff's trademarks considering that there are more than 30 products carrying the PRENS word in the local market and originating from different companies.

The experts' reports ordered by the court in both cases similarly concluded that the plaintiff's PRINCE trademarks and the defendants' trademarks are confusingly similar in their different aspects and therefore of nature to deceive the public and infringe plaintiff's trademark rights.

The Court adopting the experts' conclusions has in both cases decided to the invalidation and deletion of the words PRENS words from the defendants' trademark registrations, the seizure of the packages carrying these trademarks or if not possible the seizure of the goods whereby the plaintiff's requests for the recognition of the notoriety of the PRINCE trademarks have not been considered by the court on ground that the T.P.I. is not a party in the subject action.

The refusal to consider the matter of notoriety on ground that the T.P.I. is not a party to the action had no precedent in Turkey. In the scope of the plaintiff's court action against KARSA BISKUVI (***), the Supreme Court had refused the defendant's appeal ruling that the request for the recognition of the notoriety must be claimed in an action where the Turkish Patent Institute is party and the decision of the Court of first instance regarding the notoriety of the PRINCE trademarks were therefore not binding for the Turkish Patent Institute. Accordingly, although the current decisions of the Court do not explicitly refer to this specific ruling of the Supreme Court, they seem to have been motivated by if.

DOGAN GIDA has appealed the decision (*) before the Supreme Court on the same grounds as in his response to the writ of summons and the Supreme Court's decision is still outstanding. The other defendant ULFET BISKUVI has not appealed the decision (**) of the court, which has become definitive and enforceable against the defendant.