

Infringement & Defenses- Likelihood Of Confusion

“CHOCO PRINCE, PRINCE FOURRE/ BİFA SÜPER PRENS, BİFA PENBE PRENS, BİFA SÜTLÜ PRENS” Trademarks

GENERAL BISCUITS BELGIE vs BİFA BİSKÜVİ VE GIDA SANAYİ A.Ş.

(*) Istanbul Court of Intellectual and Industrial Rights

Case No. 2002/82 - Decision No. 2003/215 - (06.05.2003)

(**) 11 the Civil Chamber of Supreme Court

Case No. 2003/9301 - Decision No. 2004/4298 - (20.04.2004)

An action (*) was instituted for the cancellation of the trademarks “BİFA SUPER PRENS”, “BİFA PENBE PRENS” and “BİFA SÜTLÜ PRENS” on grounds of similarity with the plaintiff’s well-known trademarks “CHOCO PRINCE” and “PRINCE FOURRE” and for stopping trademark infringement and unfair Competition.

The plaintiff claimed that his “Prince”, “Choco Prince” and “Prince Fourre” trademarks are registered before WIPO since 1955, in their home countries and the latter two trademarks are registered in Turkey since 1976; that his trademarks have been marketed throughout world since 1926; and are well-known and enjoy protection as such as per the Articles 7/1(i), 42(a) of Decree-Law no. 556 and Article 6bis of Paris Agreement, whereby the defendant operating in the same field registered in bad faith his trademarks including the word PRENS as essential component in respect of goods which are identical with the goods covered by plaintiff’s well-known trademarks PRINCE.

The defendant objected by asserting that he has registered his trademark in 1984 in bona-fide, that even if the reputation of plaintiff’s trademark is accepted, according to the Article 42/a of Decree-Law no. 556 the court action on such basis should be filed within 5 years as of the registration date of his trademark, that the plaintiff should have known his trademark since 16 years, that therefore the time period for instituting such action has lapsed. The defendant further claimed that the essential and distinguishing element of his trademarks is not “PRENS” but “BİFA”, that the plaintiff’s trademarks

do not consist of the word “PRINCE” solely, that a trademark cannot be considered as well-known without a decision of the TPE in this regard, that the plaintiff had not opposed his trademark application although the plaintiff has a prior registration and that on such grounds the plaintiff’s claims should be rejected.

The Court ruled that in the light of the evidences gathered and referring the expert’s report, it has ordered the reputation of the plaintiff PRINCE trademarks has not been sufficiently evidenced, the word “PRENS” in the defendant’s marks is phonetically similar to plaintiff’s trademarks “PRINCE” and such similarity leads to confusion between the trademarks, that since the infringement continues, the objections regarding deadline of 5 years for instituting the court action are not justified. The Court further held that due to the fact that the Turkish Patent Institute is not a party of the action as filed the plaintiff’s claims regarding notoriety have not taken into consideration. The Court favorably receiving on such grounds the plaintiff’s claims ordered to partially cancel the defendant’s registrations by excluding therefrom the word “PRENS” while refusing to recognize the notoriety of the plaintiff’s trademark and the unfair competition.

The Supreme Court (**) has rejected the defendant’s appeal (*) on grounds that such appeal is not justified according to the content of the file, evidences and the evaluation thereof.