

Infringement And Defenses – Famous Marks

GENERAL BISCUITS BELGIE vs. KARSA BİSKÜVİ VE GIDA SANAYİ TİC. LTD. ŞTİ.

(*) **2nd Commercial Court of Beyoğlu**

Decision no.1999/148 – 2000/203 (June 7, 2000), (notified on June 23, 2000)

(**) **11th Civil Chamber of the Supreme Court**

Decision No.2000/9741 – 2001/888 (February 6, 2001), (notified on March 15, 2001)

An action (*) was instituted for trademark infringement and unfair competition against KARSA BİSKÜVİ to stop the use of the trademark KARSA PRENS.

The plaintiff which is a worldwide famous firm in the food industry specially for biscuits and chocolates, claimed that his “Choco Prince” and “Prince Fourré” trademarks are worldwide registered and well known including in Turkey, that the international registration of the “Choco Prince” trademark before WIPO and in the country of origin dates back to 1956 whereby its registration in Turkey is dated 1976, that accordingly the subject trademarks are protected as well-known trademarks whereby the defendant which is an important local firm operating in the same field uses the plaintiff’s PRINCE trademarks as PRENS on the packages of identical goods, that such use is of nature to deceive the average consumer and constitutes an act of trademark infringement and unfair competition committed in bad faith since it is evident that the defendant knows the plaintiff operating in the same field and his famous trademarks and moreover since he has not responded to the Cease and Desist Letter served by the plaintiff prior to instituting the court action.

The experts’ report ordered by the court concluded that the plaintiff’s PRINCE trademarks are well-known, that the acts of the defendant constitutes trademark infringement and unfair competition. The court following the conclusions of the Experts’ Report fully accepted the claims of the plaintiff concerning the notoriety of his PRINCE trademarks and confirmed that the word PRENS being the translation in Turkish of this trademark is identical in its visual, phonetic and semantic aspect.

On the other hand, although the plaintiff has instituted a second action for the cancellation of the trademark application for KARSA PRENS filed by the defendant after the action was instituted, the court has refused to suspend its decision until the issuance of the decision in the second action due to

the difference in the claims and finally, the court has refused the plaintiff's claim for compensation for moral damages for the absence of evidence in that the activities of the defendant did cause any moral damage.

The defendant has appealed this decision (*) before the Supreme Court (**) on ground that the plaintiff does not have any registration for the word PRINCE alone and that this word is not an essential component whereby the plaintiff partially appealed the decision claiming the payment of compensation for moral damages.

The Supreme Court refused an all accounts the appeal of the defendant whereby accepting the plaintiff's appeal on the matter of compensation for moral damages has overturned the decision (*) of the first instance court and concluded that the claim for compensation for moral damages should have been accepted by the court of first instance since the requested amount was fair and since the reputation and image of plaintiff's trademarks have been damaged by the acts of the defendant.