

CARLSBERG CASE SUMMARY

Jurisdiction: Republic of TURKEY / Beyoglu Court of Intellectual and Industrial Property rights

Subject Heading: [I.F Famous and Well-Known Marks](#)

Case Name and

Citation:

CARLSBERG v. CASBERG (CARLSBERG CASE)

Docket No: 2008-40

Decision No: 2009 -03

Plaintiff: CARLSBERG A/S

Defendant: Kerem KURTULUS

Marks Associated

with Goods/Services:

The Plaintiff's trademark CARLSBERG¹ (essential part of the trade name of the Plaintiff) registered in class 32, 33 and 34 – CARLSBERG BEER² registered in classes 32 - CARLSBERG PROBABLY THE BEST BEER IN THE WORLD³ registered in class 32 - CALSBERG PROBABLY THE BEST RITUAL IN THE WORLD⁴ registered in class 32 and 41 – CARLSBERG PART OF THE GAME⁵ 25 / 28 / 32 / 36 / 41 / and CARLSBERG NON-ALCOHOLIC BEER⁶ registered in class 32. The defendant's trademark "CASBERG"⁷ registered in class 24,25 and 35.

Nature of Case:

The Plaintiff claims the invalidity of the Defendant's registered trademark which is almost identical with its well-known trademark in Turkey and its trade name according to the articles 8/1 (b)⁸, 8/4⁹ of the Decree–Law No: 556, dupl. Article 6¹⁰ of the Paris Convention and article 8 of the same Convention¹¹.

¹ Registration No: 2004 43722

² Registration No: 2006 33842 / Reg.No: 2006 33843 / Reg.No: 2006 33844

³ Registration No: 2003 32443

⁴ Registration No: 2004 28143

⁵ Registration No: 2006 56870

⁶ Registration No: 2005 08587

⁷ Registration No: 2004 35609

⁸ **Article 8: Upon** opposition by the proprietor of an application for registration of a trademark or of a registered trademark, the trademark applied for shall not be registered subject to the following conditions:

b) Where the trademark applied for is identical or similar to a registered trademark or to a trademark applied for registration under a prior date of filing and the registration is sought for identical or similar goods or services in that the likelihood of confusion includes the likelihood of association with the registered trademark or with the trademark applied for registration under a prior date of filing.

⁹ A trademark applied for which is identical or similar to a registered trademark or to a trademark application with a prior date of filing may be used for different goods and services. However, where in the case of a registered trademark or of a trademark application with a prior date of filing, the trademark has a reputation and where the use without due cause of trademark applied for would take unfair advantage of, or be detrimental to, the distinctive character or repute of the registered trademark or of the trademark application with a prior date of filing, upon opposition by the proprietor of the prior trademark registration or application, the trademark applied for shall be refused even if it is to be used in respect of differing goods and services.

¹⁰ 1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

¹¹ A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark.

Overview of Decision and Ruling:

The plaintiff claims that its Company is one of the world leaders in the sector and its registered trademark CARLSBERG, which is the essential part of its Trade Name, filed before the Turkish Patent Institute is a well-known trademark in Turkey due to intense advertisement and promotion activities and its rank in the list of spontaneous remembering rate among all the beer trademarks in Turkey, and the Defendant's trademark "CARSBERG" registered with bad –faith in class 24,25 and 32 benefits from the reputation of the Plaintiff's trademark which is almost identical as visual and phonetic terms.

The defendants asserted that, the component court is Istanbul Civil Court of Intellectual and Industrial Property Rights, and that the defendant became a well-known producer of suits on the market, that there is no similarity between trademarks in terms of production and name that although the Plaintiff produces beer, it filed a suit on another good, which shows its lack of sincerity and requested the rejection of the case.

The Court decision states that, in light of the submitted declarations and evidences it is understood that; the Plaintiff's trademark is a well-known trademark in the frame of the WIPO criteria¹² regarding well-known trademarks, application of the Court of Appeal¹³ will benefit from protection in the scope of the Paris Convention.

Thus, the Plaintiff is qualified to enjoy the right provided under Article 7/1(i)¹⁴, which refers to the dupl. Article 6 of the Paris Convention, and the Defendant could not use "CARSBERG" trademark, which is almost identical with the Plaintiff's trademark despite the difference of the goods and services. In this scope, the court determines that the regulation provides protection to well-known trademarks against the use of identical or similar marks to distinguish dissimilar goods or services.

Consequently, the Court accepted the action and ruled that the defendant's CASBERG is registered with bad-faith and infringes the well-known Trademark and Trade Name rights of the Plaintiff and the invalidity of the CASBERG trademark.

Importance of Case: This decision is important because it establishes that the regulation provides protection to well-known trademarks against the use of identical or similar marks to distinguish dissimilar goods or services.

Images/Description:

Contributor Firm: Deris Patents and Trademarks Agency

¹² Recommendation no: A/34 –13 OF WIPO

¹³ The decision of the 11.Chamber of the Court of Appeal dated 19.04.2002, Docket No: 2001/9903 – Decision No: 2002/3699

¹⁴ Article 7: Following signs shall not be registered as a trademark:

i) trademarks, well known in the sense of the Article 6bis of the Paris Convention, which have not been authorized by their owners,