

Infringement & Defenses- Counterfeiting

“MARLBORO“ vs. (not known)

This case has been cited in the Journal of Ankara Bar Association on Intellectual Property and Competition Law (Issue No. 2004/4) where the names of the parties concerned are not cited.

(*) Court of Istanbul on Intellectual and Industrial Rights

Case No. 2001/988 - Decision No. 2002/851 - (26.12.2002)

(**) 11th Civil Chamber of Supreme Court

Case No. 2003/4347 - Decision No. 2003/10776 - (11.11.2003)

An action (*) was instituted for stopping the trademark infringement and unfair competition due to the counterfeit cigarettes bearing the trademark MARLBORO that have been seized by Ambarlı Customs Authorities in the containers upon the declaration made by the shipping Agent against whom the action instituted.

Defendant claimed that he has no interest in the goods coming from Egypt and transiting from Istanbul to their destination in Bulgaria, that he is only the skipping agent of the container transporter, that the containers have been loaded and stacked by the sender in the custom's transitory/transit warehouse and that content of the containers cannot be known by the transporter or its agent and that therefore the Article 61/e of the Decree-Law No.556 on trademarks reading “**participating in acts foreseen in subparagraphs (a) to (c) or assisting or inducing/encouraging them or facilitating in any way and under any circumstances their occurrence/perpetration constitutes trademark infringement**” cannot be applied in this case.

The First Instance Court (*) ruled that there is no trademark infringement and unfair competition, since the goods have been brought in the Turkish Customs in transit in order for foreign markets and the defendant acts as the agent of transporter and is stated as transporter on the bill of lading. The Court further held that the defendant not being the transporter itself but only his shipping agent according to Article 119 of the Turkish Commercial Code, he could not be indicated as defendant in this case.

Upon the appeal of the plaintiff, the Supreme Court (**) overturned the initial decision of the first instance Court by asserting that although it is correct that it is not possible to indicate the agent as defendant according to Article 119 of Turkish Commercial Court, it is possible to take action against the agent for acts constituting a criminal offense.

The Supreme Court further held that even when it would not be possible to order the destruction of the goods, which have been already cleared from the Customs, as the plaintiff has the right to claim compensation for moral and material damages in case of the existence of trademark infringement and unfair competition, the case shall have to be evaluated on its merits as rejecting the action on grounds that it has been filed against the shipping agent will result in denying compensation on ground of unfair competition.

The Supreme Court ruled that as the bill of lading representing the goods has been issued to the order and name of the defendant, who also acting as the consignee has the right to receive the goods according to Article 110/1 and 2 of the Turkish Commercial Code, the action can be directed against the defendant acting as the agent and recipient of goods on the basis of the bill of lading.