

Infringement And Defenses- Famous Marks

“COKOPRENS, ULKER PRENS, ULKER SUPERPRENS / ULKER COKORAL PRINCE, CHOCO PRINCE, PRINCE POURRE” Trademarks

General Biscuits Belgie vs. Ulker Gıda Sanayi ve Ticaret A.S.

(*) **1st Court of Istanbul on Intellectual and Industrial Rights
Case No. 2007/1, Decision No. 2007/240 (10 September 2007)**

General Biscuits Belgie commenced an action^(*) against Ulker Gıda Sanayi ve Ticaret A.S. for the cancellation of the trademarks COKOPRENS, ULKER PRENS, ULKER SUPERPRENS, ULKER COKORAL¹ based on its trademarks PRINCE, CHOCO PRINCE, PRINCE POURRE which are being used and registered since 1955 and registered in Turkey since 1976.

The defendant claimed that its trademark COKOPRENS is registered since 1975, their registration is prior and that the plaintiff's claim that its trademark is well known is not grounded.

The court partially accepted the action, however upon the appeal by the defendant the Supreme Court reversed the court decision. The court held that: The registration dates of the defendant's trademarks are very old and the action is commenced on 2001 i.e. consecutively 30, 20 and 5 years after the registration of the defendant's trademarks.

The case law of the Supreme Court states that the institution of an action after a long acquiescence period is accepted as an abuse of the right to institute an action. There is no specific period set in the Decree Law 556 concerning the trademark for the acquiescence period except for Article 42 concerning to the cancellation claims based on the well known trademarks which provides that: “the cancellation action regarding well-known trademarks shall be instituted within five (5) years as from the date of registration. If there is bad faith time no limit shall apply.”

The Supreme Court has applied the above-referred provision by analogy even in the trademarks actions, which are not based on a well-known trademark.

Considering that;

- the defendant's trademark firstly was registered on 1971 and the later trademarks contain similar denominations,
- the defendant is among the leading companies in the sector,
- the defendant has improved its activities under the subject trademarks and made serious investment and has built up an opinion on the public part as to the origin of the trademark, the filing of a cancellation action after such a period is an abuse of the right to do so.

¹. Registration Nos. 85203, 125300, 129456, 150196, 150197, 144819.

Besides, the plaintiff could not prove that its trademark is well-known as of 1971 and since the plaintiff is not acting in good faith, it is not possible to claim the bad faith of the defendant as well and consequently, the Court rejected the action.