

## Infringement And Defenses – Famous Marks

### “PRINCE/ PRENS, SARAY PRENS, HEDİYELİK SARAY PRENS, SARAY PRENSES”

#### GENERAL BISCUITS BELGIE vs. SARAY BISKUVI GIDA SAN. A.S.

#### **(\*) 1<sup>st</sup> Court of Istanbul on Intellectual and Industrial Rights** **Case no.2002/80-Decision no.2004/548 (September 28, 2004)**

An action (\*) was instituted for trademark infringement claiming the cancellation of the defendant’s trademark registrations “PRENS, SARAY PRENS, SARAY SARAY PRENS, HEDİYELİK SARAY PRENS” on grounds of similarity to the plaintiff’s well-known trademark PRINCE and for the determination of the notoriety of the trademark PRINCE and stopping of unfair competition and its effects.

The plaintiff claimed that the registrations in the defendant’s name of the trademark “PRENS, SARAY PRENS, SARAY SARAY PRENS, HEDİYELİK SARAY PRENS” are confusingly similar to his well-known trademark PRINCE, which is used as registered since 1955 throughout the world and is registered since 1976 in Turkey, constitutes an infringement to his well-known trademark and an act of to unfair competition and requested determination of the notoriety of the trademark PRINCE and infringement of its trademark rights.

The defendant claimed that its registrations for the trademarks including the word PRENS are registered for more than 10 years, therefore the lime limit for instituting the cancellation action has already been expired, that its trademarks are distinctive enough and well-known in Turkey whereas the plaintiff’s trademark is not well-known.

The panel of experts stated in its report that plaintiff’s trademarks are registered all over the world, that they should be considered as well-known, that the defendant’s trademarks “SARAY” and “SARAY PRENS” are registered various countries and in Turkey, said trademarks have been registered in 1989, 1990 and 1991 and are well-known in Turkey as well, that the plaintiff is not ill-willed, the plaintiff has not instituted its court action in 5 years according to the Article 42 on Decree-Law no. 556, that the indications PRENS and PRENSES are not used alone but together with the indication SARAY and

that therefore the trademarks have acquired distinctiveness from the plaintiff's trademarks as to their essential components and furthermore as of the use of the trademarks.

Following the conclusions of the experts' report, the Court ruled that as the defendant uses the trademarks as "SARAY PRENS" and "SARAY PRENSES", the trademarks are distinguishable and distinctive from the plaintiff's trademark, that defendant's trademarks have been used in Turkey since 1989, that said trademarks acquired distinctiveness through endeavors of the defendant and that therefore the requirements for the cancellation of the trademarks are not met.

The Court has rejected plaintiff's claim as to the determination of the notoriety of its trademark, on grounds that as the Turkish Patents Institute, which enforces the decision issued with regard to notoriety, has not been cited as defendant, such decision would not be enforceable.