

III.A.3. Determination and Prohibition of Infringement and Unfair Competition

Nestle Waters instituted an action against “Buran Tüm Gıda Mamulleri Sanayi Ve Ticaret Ltd.Sti” and “Grup Soda Ve Mesrubat Pazarlama Sanayi Ve Tic. A.S.” on grounds of determination and prohibition of infringement and unfair competition of registered trademarks PERRIER DEVICE¹ and PERRIER DEVICE².

The plaintiff claimed that his client has been known worldwide for its mineral waters, carbonated drinks and soda water products, has been holding the trademark registrations No. 105587 and 105621 before the Turkish Patent Institute since 1988, is also in possession of the trademark registration No. 458798 before the World Intellectual Property Organization, has had its products on the market in Turkey for over 17 years, that the trademark PERRIER and the shape trademark are quite well-known, that the bottle design has been protected in Turkey since 1988, that this bottle has acquired a distinctive characteristic on the basis of its composition of color, shape and label, that the defendants are operating in the same sector as his client’s, that the defendants are marketing the in-house produced and sold mineral waters and carbonated drinks with the trademark SIRMA in bottles with the same shape and appearance with those of the shape trademark owned by his client, that the defendants are using his client’s bottle shape and dimensions, the slightly convex and bulged body part of the bottle, the bottle color and the phrases and labels located on the bottle and the layout of these labels on the bottle, thus leading to the confusion of products by the mid-level consumer, that the assumption is out of the question that the defendants who are in service in the same sector are not aware of the existence of the bottle and packaging characteristics and trademark of his client and that this action of the defendants constitute trademark infringement and unfair competition” and the attorney requested and claimed the prevention, rectification, termination of the existing infringement of the packaging, bottle, shape and composition of his client’s shape trademark and the unfair competition committed by the defendants, the confiscation, seizure, disposal and removal from the Web site of the media employed in the manufacturing of the products subject to infringement and unfair competition, the bottles and packages, all promotional tools, advertisements and brochures and the publication of the abstract of judgment in Hurriyet and Sabah newspapers with expenses to be covered by the defendants.

The defendant stated that “Buran Tüm Gıda Sirketi” is a manufacturer of mineral waters and carbonated drinks and the other defendant is the seller of these products, that his client filed the



¹ PERRIER BOTTLE DEVICE registration no. 105587 i.e.



² PERRIER BOTTLE DEVICE registration no. 105621 i.e.

application No. 2003/02262³ for a design registration, which has not yet been concluded, that the defendant's application for a design registration carries the attributes of innovation and distinctiveness, that the design of his client and the design of the plaintiff are different from each other, that the curved segments of the bottle are at different locations and in different shapes, that the green color of the bottle is the preference of many other companies in the sector of mineral water and the green color cannot be solely left to the monopoly of the plaintiff in this sector, that the volume of the bottle is the result of necessities, that mineral water bottling is also impossible with a rectangular or similar design, that trademark infringement and unfair competition are out of the question, that the registration of the commodity or the package cannot confer on the trademark owner an exclusive right pertaining to the commodity if the trademark is registered along with its package" and demanded that a judgment of dismissal be given.

The single-signature expert report included in the file and issued by Güven Çalık represents the opinion that "the prominent element of the plaintiff's trademark is the phrase 'Perrier', that this phrase is not included in the products of the defendant in any way or with an infringing quality, that even though the trademark of the plaintiff must be addressed as a whole, each of the elements constituting it may not individually fall under the scope of protection, that even though it is possible to register the product package as a trademark, if it is deemed necessary for product use, the appearance and package of the product shall not confer protection on its owner by reason of its functionality, that the product package (the bottle) which is one of the elements of the plaintiff's trademark is not of a distinctive character on its own or without the Perrier phrase, that numerous companies involved in the market in the sector of mineral water present their products in similar bottles, that it had been found out that the bulged and slightly convex shape of the middle segment of the package of the plaintiff's product constitutes a difference and yet it does not constitute a significant difference on the basis of the similarity in bottle dimensions and colors and the simplicity of this difference, that the bottle and its dimensions are functionally utilized in the relevant segment of the market and that there is no room for confusion".

The 2-signature expert report included in the file and submitted by Prof. İlhan Erhan and Prof. Selçuk Öztekin, on the other hand, represented the opinion that "the Perrier trademark of the plaintiff is well-known around the world, that this product is being sold at all major hotels and famous restaurants, that this product is offered on mineral water shelves at numerous hypermarkets, that the shape, color and overlying package composition of the bottle, out of the elements of the shape trademark of the plaintiff, must be considered not individually but as a whole, that the essential criterion employed by unfair competition law is the general impression retained in the perceptions of the eyes, the ears or the mind as a whole, that the plaintiff's bottle constitutes an identity in respect of shape and general appearance, that no other similar bottle is being used by anyone except for the defendant in the Turkish market, that the important issue in the present case is whether the shape of the bottles and the elements on the bottles are in such a similar composition on the basis of their general appearance as to lead to the creation of confusion or a risk of confusion, that the implication in the Sub-clause 2 of the Article 5 of the Decree Law No. 556 requires the type or package of the commodity to bear no distinctive characteristics, that there is no room for the enforcement of the Sub-clause 2 of the Article 5 of the Decree Law No. 556 due to the fact that the shape of the bottle registered in the plaintiff's name is distinctive, that on the basis of the fact that the light green-colored attribute of the bottle, the slightly convex and bulged body formed at the middle segment and its characteristic of being easily



³ BOTTLE design registration no. 2003/02262 i.e.

grasped by the palm contribute to the better perception by the consumer of the degrees of hardness and coldness of the liquid inside the bottle, the visual composition of the bottle as a whole constitutes the trademark, which constitutes an identity, that the defendant's bottle, on the other hand, contains all elements of this identity of the bottle owned by the plaintiff, that the bottle shape composition of the defendant can lead to confusion in the eye of a consumer with a medium level of attention, intelligence and knowledge by reason of the general impression which it creates in the perceptions of the eyes and the mind, that it is of a characteristic that may lead to the purchase of the defendant's product on the assumption that it is, in fact, the plaintiff's product, that the defendant's product is also convenient for the creation of the impression that it is a product that can replace the plaintiff's product, that this was the reason why the design registration application filed by Buron A.S., one of the defendants, had been refused by the Turkish Patent Institute Commission for Review and Reevaluation, that the bottle shape used by the defendants in the case in dispute constitutes trademark infringement and thus unfair competition".

The issue implied by the Sub-clause 2 of the Article 5 of the Decree Law No. 556 is relevant to elements with no distinctiveness in terms of the type and package of the product. This is the case for an ordinary cigarette package, an ordinary chewing gum box package or similarly a teabag package. However, if the product bears a distinctive characteristic, then the trademark protection will obviously be provided. In the present case, as stated in the report that forms the basis of the judgment and as mentioned in the page 9 of the single-signature report, the slightly bulged and convex characteristic of the middle segment of the plaintiff's product package bears a distinctive feature in terms of the package of this commodity. As explained in the report dated 31/12/2007, which forms the basis of the judgment, no company involved in the manufacturing and sale of mineral water and carbonated drinks in the market uses bottles of this appearance except for the defendant. Therefore, it must be agreed that the plaintiff is covered by the scope of protection due to the provision of distinctiveness by the slightly convex and bulged characteristic of the bottle used within both trademarks No. 105587 and 105621 and that there is no room in the present case for the enforcement of the Sub-clause 2 of the Article 5 of the Decree Law No. 556.

The court decided that the bottle package in the plaintiff's trademark is distinctive by reason of this characteristic and shall thus provide protection, it should be assessed whether there is a possibility of confusion between this trademark of the plaintiff's and the defendant's product. In the expert report dated 31/12/2007, which forms the basis of the judgment, it is observed that the identity created by the whole visual composition, including the slightly convex and bulged middle segment of the bottle, the narrowing pattern of this body towards the neck section and the bottom of the bottle, taking the shape of a drop of water, the phrase 'Perrier' placed like a medallion towards the narrowing neck section and the band placed at a spot close again to the bottom section of the bottom, is almost exactly used in the composition of the product owned by the defendant. When the photograph of the plaintiff's product and the photograph of the defendant's product and the two trademark registrations of the defendant included in the annex of the decision are compared, it is observed that nearly all visual and distinctive elements of the plaintiff's trademark are used for the product owned by the defendant including the shape of bottles, the clips or the slightly oblate circular base bearing the phrases 'Perrier' and 'Sirma' at the middle top of the bottle and the ribbon-shaped figures extending from each side of these bases towards the back and the dark green base bearing the phrase 'Perrier' and the label resembling a wrist watch placed at the bottom of the bottle. This action of the defendants also constitutes unfair competition pursuant to the Articles 56 and 57/5 of the Code of Commerce. Holding the opinion that this action of the defendant constitutes trademark infringement in accordance with Articles 9/1b, 2a and 61/1a-b-c of the Decree Law no. 556 and unfair competition in the context of the Code of Commerce and having agreed that the distributor and reseller companies are responsible for these actions of infringement and unfair competition taking into consideration the Article 61/1-e of the Decree Law, that it can be demanded under the Articles 62-1a and 62/1b of the Decree Law and pursuant to the Articles 58/1a-b-c of the Code of Commerce that this infringement and unfair competition be prevented, rectified, terminated and their consequences removed, that pursuant to the Articles 62/1c and 62/1e of the Decree Law, it can be demanded that the products in question of infringement be confiscated and destructed, that a demand for the notification of the judgment is also

appropriate due to the fact that the plaintiff has an interest in being justified and having other companies and consumers within the sector know that the action of the defendants has constituted trademark infringement and unfair competition and the following judgment has been established as regards the acceptance of the case⁴.

As a result the Court ruled that:

1 – The case shall be accepted, the infringement and unfair competition prevailing in connection with the plaintiff's trademark, bottle package and design shall be prevented, rectified, terminated, advertisement and promotion materials and brochures pertaining to the sale by the defendants of the commodity of carbonated drink and mineral water with the shape presented on the photograph attached to the decision shall be confiscated, collected and disposed of, the advertisements of these products shall be removed from the Web sites of the defendants,

2 – Taking into consideration the request of the plaintiff, once the decision has been finalized, the abstract of judgment shall be published in Hürriyet and Sabah newspapers once in an area of 1/8 newspaper page with the expenses covered by the defendants.

⁴ Nestle Waters vs Buron Tum Gida Mamulleri Sanayi Ve Ticaret Ltd.Sti and Grup Soda Ve Mesrubat Pazarlama Sanayi Ve Tic. A.S., Case no.2006/163, Decision no.2008/120, (4th Istanbul Court of Intellectual and Industrial Rights), (May 7, 2008)