

NEW TYPES OF MARKS AT THE TURKISH PATENT INSTITUTE (TPI)

According to the trademark legislation (*Decree Law No. 556 Pertaining to the Protection of Trademarks*) in Turkey, a trademark may consist of **all kinds of signs being represented graphically**; such as words, including personal names, designs, letters, numerals, shape of the goods or their packaging provided that it is capable of distinguishing the goods and services of one undertaking from the goods and services of other undertakings. Since the list of signs that a trademark may consist is not exhaustive, both visible and non-visible signs can be registrable as trademarks provided that they are graphically represented on the application form and that they have distinctive character in respect of the goods/services for which the registration is sought.

A) VISIBLE SIGNS:

1) Three-dimensional marks:

3-D marks are registrable in Turkey. In the Trademark Examination Guidelines of TPI, three-dimensional marks are separated into following categories:

- (a) 3-D shapes of goods containing figures, emblems, embellishments, words, etc that relates to the producer of the goods,
- (b) 3-D shape of a product package,
- (c) 3-D shape of the product itself

3-D shapes included in the first item apparently have a distinctive character and registrable unless they fall within the scope of other grounds for refusal. (absolute and relative grounds)

The main focus in terms of distinctiveness is on the items (b) and (c). In assessing distinctiveness, shape of goods (or their packaging) which have general and common use in the related sector are considered to be devoid of distinctive character and refused.

However, the shape of goods or their packaging are considered to be distinctive if they have unique and unusual shapes, as a result of which, they are perceived by consumers as signs indicating the trade source of the goods, that is, they function as trademarks.

Examples:

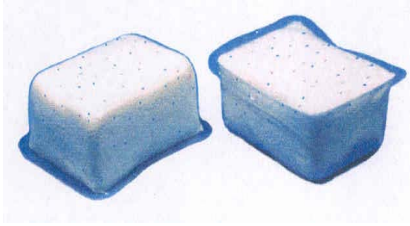


Application number: 2006/55450

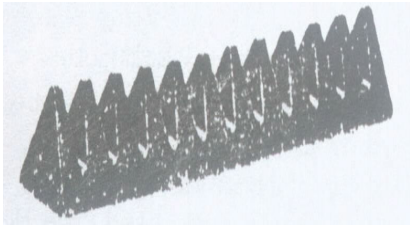
Nice class: 33

Status: application refused (lack of distinctiveness) , time limit for appeal against Office decision has not expired yet

Comments: a standard shape having a general and common use in the related sector



Application number: 2003/02678
Nice classes: 03, 05
Status: final refusal (lack of distinctiveness)
Comments: standard shape in the related sector



Application number: 2000/14288
Nice class: 30
Status: registration granted
Comments: unique and unusual shape for the goods applied for, distinctive function as a trademark



Application number: 2005/52102
Nice class: 03
Status: registration granted

Comments: The figurative part placed on the shape together with colors give distinctiveness overall

Moreover, according to the legislation, the following shall not be registered:
“signs containing the shape of the product which results from the nature of the good, which is necessary to obtain a technical result or which gives substantial value to the good” (Decree Law No. 556 Pertaining to the Protection of Trademarks, Article 7/1-(e))

Formal requirements:

In the applications filed for 3-D marks, graphic representation of the mark must be provided in the area named as “reproduction of the mark” in the application form. Graphic representation can be provided in the form of a picture, drawing, photograph or any other means which clearly represents the mark. Perspective views and a verbal description of the mark are not required. Examination is carried out upon the representation provided in the application form. If the representation is not clear enough to make the distinctive parts (if any) visible and intelligible, the application can be refused. No indication that the mark is a 3-D mark is required. In the database of the Institute, there is no separation between 3-D marks, figurative marks, shape marks, etc.. All types of marks without having a verbal element are recorded in the database as **“figurative”** marks and examination is carried out upon what is submitted in the “reproduction of mark” area.

2) Color marks:

In Turkey, color per se is not found distinctive and therefore not registrable as trademarks. On the other hand, combination of colors are accepted to have distinctiveness and found registrable unless they fall under the scope of other absolute grounds for refusal such as descriptiveness, customary colors that can be used by every trader in the related sector or of relative grounds.

Examples:



Application number: 2004/36350
Nice classes: 01, 03, 05
Status: final refusal



Application number: 2004/40402
Nice classes: 18, 25
Status: registration granted



Application number: 2004/40403
Nice classes: 18, 25
Status: registration granted

Formal requirements:

In applications filed for registering color marks, graphic representation of the mark must be supplied in the “reproduction of the mark” area in the application forms. Verbal description of the color is not required. Indication of the color codes in a universally accepted color code system is not required as well.

3) Slogans:

Slogans are registrable as trademarks in Turkey, provided that they are distinctive and non-descriptive in respect of goods/services for which the registration is sought. Other absolute grounds and relative grounds for refusal are also applicable in case of slogans. For instance, the slogans involving phrases of superiority, quality like “the most delicious food” (for goods in classes 29, 30) ; “the best call in wireless” (goods in classes 09, 38) are not registrable since they are non-distinctive and descriptive.

Examples:

WE NEVER FORGET
WHO WE'RE
WORKING FOR

Application number: 2003/09575
Nice classes: 09, 38, 42
Status: registration granted

"BİZDE HERŞEY
İYİDİR & UCUZDUR"

Application number: 2005/26157
Nice classes: 21, 35
Meaning: "everything is good and cheap in ours"
Status: final refusal (lack of distinctiveness,
descriptiveness)

Türkiye'nin teknoloji perakendecisi

Application number: 2005/46442
Nice classes: 09, 16, 20, 21, 35
Meaning: "Technology retailer of Turkey"
Status: final refusal (lack of distinctiveness)

B) NON-VISIBLE SIGNS:

1) Sound marks:

Since there is no exclusion for non-visible signs in the legislation, sound marks are also eligible for registration provided that they are capable of being represented graphically and that they distinguish the good/services of one undertaking from those of others, in other words, that they are distinctive.

Only two sound mark applications have been received by the TPI so far. Both applications were rejected on the ground that they were lacking distinctive character. Both decisions were appealed and now they are in the agenda of "Re-examination and Evaluation Board", the final decision body of the Institute, for the final decisions. Hence, sound marks is one of most controversial issues in TPI. For this reason, a group of examiners have been working to determine the criteria for registrability and guidelines for the examination procedure of sound marks. Below are the main subject matters that have been discussed so far: (please note that the following are not finalized and accepted criteria to be applied)

Graphic representation:

For musical sounds: We follow ECJ “Shield Mark” decision, and would require a musical notation by a stave divided into bars and showing all possible details like a clef, musical notes, rests, accidentals, etc of the sound.

For non-musical sounds: In this respect, we would require sonogram or sound spectrogram showing the signal’s frequency content versus frequency and time (and other possible details depicting the sound) for the graphic representation of non-musical sounds.

Description:

Description would also be required, since there may be some other details which are not possible to be shown on the graphic representation, such as the musical instrument. Verbal description of the should clearly describe the sound in detail. Moreover, an indication that the sign claimed is a sound mark must be stated in the application form. Otherwise, the application is deemed to be filed for a figurative mark and treated as such.

Sample/recording of the sound:

Assessing the distinctiveness of the sound (or a possible assessment for the similarity of sound marks) and examination of the application for other absolute grounds merely by depending on the graphic representation is thought to be difficult. Moreover, the scope of protection can still be ambiguous. For these reasons, sample of the sound claimed should also be submitted in mp3 format by a data carrier. Only one sample/recording must be submitted for a single application. Different sound samples having the same graphic representation cannot be the subject of a single sound mark application.

Electronic form of graphic representation:

In order to make the examination and the publication procedures easier, graphic representation should also be submitted in jpeg format by a data carrier.

Examination:

No stricter criteria than traditional marks in assessing the distinctive character of sound marks should be applied. However, if the examiner decides that the sound is so long that it can be perceived by average consumer much like a song rather than as a trademark, he/she will refuse the application on the ground of non-distinctiveness. Other grounds for refusal are also taken into account. Customary or generic sounds in the related sector, descriptive sounds, technically functional sounds, etc.. should be rejected.

Publication:

There is no online publication for visual marks by the TPI. But in case of sound marks, it is thought to be useful for third parties to publish the sound sample as well in the website of TPI, since it is not possible for everyone referring to the Official Trademark Bulletin to understand the exact “sign” claimed. Therefore, besides the publication in the Bulletin, online publication of sound marks will be provided.

Conflicts with copyrights:

If the sound mark is conflicting with another person's copyright, the sound mark application can be refused upon the opposition of the copyright owner. In other words, this situation is examined during the opposition procedures.

2) Smell marks:

No application for registration of a smell/scent has been received by the TPI so far. But, considering the ECJ Sieckmann decision as a guidance, it is thought that the standards set by ECJ will make it almost unlikely to fulfill the requirement of the graphic representation of odors.

C) OTHER NEW TYPES OF MARKS:

Until now, TPI has not received any application regarding the following new types of marks as well;

holograms, motion marks, position marks, gesture marks, taste marks, texture/feel marks