

## Registrability – Device And Design Marks

### “Bottle device”

#### (\*) TWELVE ISLANDS SHIPPING COMPANY LIMITED vs. TURKISH PATENT INSTITUTE

3<sup>rd</sup> Commercial Court of Ankara

Decision No. 1998/1004 - 2000/26 (January 27, 2000) (notified on February 16, 2000.)

#### (\*\*) REEMTSMA CIGARETTEN FABRIKEN GESELLSCHAFT MIT BESCHRANKTER HAFTUNG vs. TURKISH PATENT INSTITUTE

5<sup>th</sup> Commercial Court of Ankara

Decision No. 1998/777 - 1999/225 (April 22, 1999) (notified on July 2, 1999)

#### (\*\*\*) 11<sup>th</sup> Civil Chamber of the Supreme Court

Decision No. 2000/3866 – 2000/4995 (June 1, 2000)

The plaintiff appealed the decision (\*) rendered by the 3<sup>rd</sup> Commercial Court of Ankara, which rejected his claims for the registration of the trademark consisting of a “bottle device” on ground of absence of distinctiveness.

Upon the appeal of the plaintiff, the Supreme Court (\*\*) overturned the decision of the 1<sup>st</sup> instance Court on ground that the claim of the plaintiff regarding the registration of the mark in the Home Country – U.K. – and the documentary evidence in support thereof have not been considered when reaching the decision.

In its decision (\*\*\*) the 3<sup>rd</sup> Commercial Court of Ankara has conformed to the Supreme Court’s decision (\*\*) and ruled for the withdrawal of the administrative decision of refusal and for the registration of the plaintiff’s trademark application on grounds that

- “the plaintiff’s trademark is registered in the UK since January 25, 1995 and that according to Article 6 quinquies of the Paris Convention the countries signatory of the Convention are under the obligation to accept for registration in their country a trademark” as is “(tel quel) registered in the country of origin”.

- “the plaintiff’s trademark consisting of a mat white bottle shape has the characteristic of distinguishing the goods or services from those of other enterprises/business as provided in Article 5 of the Decree-Law No. 556 on Trademarks.”
- the plaintiff’s trademark is used in many countries and in Turkey.

The Court in its decision (\*\*\*) further ruled that the plaintiff’s trademark is a well-known trademark in the sense of the Article 6bis of the Paris Convention and of Article 7 parag. 1 (i) of the Decree-Law No. 556 and that it has “the characteristic of distinctiveness” in the sense of Article 5 of the Decree-Law No. 556 and has “also acquired distinctiveness” in respect of the goods and services applied for registration.

It is to be noted that this may be considered to be a landmark decision for the registrability of three-dimensional shapes such as containers/packagings etc, in view of the unclear not to say contradictory provisions of Article 5 of the Decree-Law No. 556 on Trademarks.