

Registrability – Device And Design Marks

“Rectangular biscuit shape with TUC written with points / holes”

GENERAL BISCUITS BELGIE vs. DOĞAN GIDA SAN. VE TİC. A.Ş.

(*) **7th Commercial Court of Ankara**

Decision no. 2001/76 –2001/828 (Decision date: December 27, 2001)

An action (*) was instituted against the Turkish Patent Institute for the withdrawal of the administrative decision refusing the registration of a trademark consisting of a rectangular biscuit shape on which is written TUC with points/holes on ground of absence of distinctiveness and on ground that the “biscuit shape” sought for registration does not have the characteristic of distinctiveness of a trademark as specified in Article 7I(a) of the Decree-Law No. 556 on Trade/Service Marks.

The plaintiff claimed that the applied trademark is used worldwide and in Turkey, the device trademark and specially the TUC word written with holes is of nature to distinguish the plaintiff’s products from the products of the same kind and provides a distinctive character to the trademark and moreover, the plaintiff has already acquired rights on the word “TUC” due to the Turkish trademark registrations nos.136909 and 183036.

The Turkish Patent Institute objected that the device consisting of the essential component of the applied trademark is not to be considered as distinctive enough for the goods covered and that it is not in the nature of a trademark in the sense of Article 5 of the Decree Law no.556 and is to be rejected on such grounds.

The experts’ report examining the registrability of the trademark as of the provision of Article 7 parag 1(c) regarding descriptive trademarks instead of Article 7 parag 1 (a) as retained by the Turkish Patent Institute concluded that the subject trademark in addition to the biscuit shape consist of the widely written TUC thereon, that therefore the trademark does not only consist of the shape of the product on which it is to be used, that this second word component of the trademark is visually distinctive and

constitutes the essential component of the mark all the more so that this word alone or with the device is already registered and used worldwide and in Turkey.

The court adopting the conclusions of the experts in their entirety and accepting the registration of the trademark decided the withdrawal of the final administrative decision of refusal.

The Turkish Patent Institute has appealed the decision (*) before the Supreme Court, which has not yet rendered its decision, Therefore the decision (*) has not been finalized as yet.