

Registrability – Merely Descriptive Term

“COMPUTER BILD & Device”

Axel Springer Verlag A.G. vs. Turkish Patent Institute

1st Commercial Court of Ankara, Case no. 2001/224- Decision no. 2001/702 (September 20, 2001)

11th Civil Chamber of Supreme Court, Decision no. 2001/1399-1778 (February 27, 2001)

1st Commercial Court of Ankara, Decision no. 1999/276- 2000/85 (March 23, 2000)

11th Civil Chamber of Supreme Court, Decision no. 2000/7595-9119

An action (*) was instituted against the Turkish Patent Institute for the withdrawal of the administrative decision refusing the registration of the plaintiff’s trademark consisting of the words COMPUTER BILD and a device element according to Articles 7 parag. 1 (c) and (f) of the Decree-Law No.556 on grounds that the verbal element “COMPUTER” indicates the kind, characteristics and quality of the goods “compact disks, CD-ROM, any kind of apparatus for recording, transmission or reproduction of sound and images, calculators, data processing apparatus and computers, computer games” which are covered by the specification of the plaintiff’s application, that it will deceive the public when it is used on the remaining goods and that the subject verbal element may be used by everyone in their trade.

The Plaintiff claimed that the trademark is to be assessed as a whole, that accordingly the elements “BILD” and “DEVICE” should be taken into consideration besides the verbal element “COMPUTER”, that the goods bearing the trademark “COMPUTER BILD+DEVICE” are sold worldwide through the internet whereas same are sold in Turkey by importation, that the trademark is registered in Germany and European Countries, that according to Article 6 quinquies/A-1 of the Paris Agreement every trademark duly registered in the country of origin shall be accepted for registration and protected in the other countries of the Union, subject to the reservations indicated therein, that the defendant has rejected to register the trademark without appropriate consideration of the legal provisions and that therefore the defendant’s decision of refusal is to be withdrawn by allowing the plaintiff’s trademark application for “COMPUTER BILD+DEVICE” to mature into registration.

The T.P.I. objected by asserting that as the word “bild” means “picture, image, depiction, photograph, portrait” and as the word “computer” indicates the kind, characteristics and quality of the goods upon which the trademark will be applied the application has been refused according to the Article 7 parag. 1 (c) of the Decree-Law No.556, that the objection against this decision has been also rejected by the Higher Council of Re-examination and Re-evaluation on grounds that the word COMPUTER written in bigger letters attracts more attention, has no distinctive character, may deceive the public, that as to the Paris Agreement, in paragraph B of the cited article reservations have been made in that the trademarks covered by this article may be denied registration when they are devoid of any distinctive character pursuant to the law of the concerned country that the action has no legal ground so that the T.P.I. claimed that the decision of refusal be upheld.

Adopting the conclusions of the experts’ report, in its decision the court ruled (*) that the trademark “COMPUTER BILD+DEVICE” may deceive the public when the word “COMPUTER” is used on goods other than “computer, CD-ROM, computer games, calculators, apparatus for recording, transmission or reproduction of sound and images” considering that the other goods of the specification consisting of “printed products (except printing devices), writing materials, educational and learning materials” are not directly related to computer techniques.

Upon such grounds the Court did not favorably consider the claims of the plaintiff and decided to uphold the decision of refusal.

AXEL SPRINGER VERLAG A.G. vs. TURKISH PATENT INSTITUTE

(*) 1st Commercial Court of Ankara
Decision No.1999/270-2000/84 (March 23, 2000)

An action (*) was instituted against the Turkish Patent Institute for the withdrawal of the administrative decision refusing the registration of the plaintiff’s trademark consisting of the words “COMPUTER BILD” and a device element according to Articles 7 parag. 1 (c) and (d) of the Decree-Law No.556 on grounds that the verbal element “COMPUTER” indicates the kind, characteristics and quality of the services which are covered by the specification of the plaintiff’s application and that the subject verbal element may be used by everyone in their trade.

The Plaintiff claimed that the trademark contains the elements “BILD” and “DEVICE” besides the verbal element “COMPUTER”, that the trademark is registered in Germany and European Countries, that according to Article 6 quinquies/A-1 of the Paris Agreement every trademark duly registered in the country of origin shall be accepted for registration and protected in the other countries of the Union, subject to the reservations indicated therein, that the defendant has to comply with this provision and that therefore the defendant decision of refusal is to be withdrawn by allowing the plaintiff’s trademark application for “COMPUTER BILD+DEVICE” to mature into registration.

The T.P.I. objected by asserting that since the word “COMPUTER” is written in bigger letters it attracts more attention and therefore it is the essential component of the trademark and that this word is used by everyone in their trade, accordingly the decision of refusal pursuant to Article 7 parag. 1 (d) is not in contradiction of legal and procedural provisions.

Adopting the conclusions of the experts’ report, in its decision (*) the court retained that although the trademark “COMPUTER BILD+DEVICE” consists of the word “BILD” besides the word “COMPUTER”, since the word “COMPUTER” is written in bigger and darker letters than the word “BILD”, the word “COMPUTER” is the essential component of the trademark. In its decision (*) the Court ruled to uphold the decision of refusal on grounds that the word “COMPUTER” being a generic name for an equipment, the subject word is not registrable as a trademark according to the Article 7 parag. 1 (c) of the Decree-Law No.556, and that this word being used by everyone (the consumers) and being a name used to distinguish specific groups of craftsmen, professions or tradesmen, it cannot be registered as a trademark according to the Article 7 parag. 1 (d) of the same Decree-Law.

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(*) **1st Commercial Court of Ankara**
Decision No.1999/276-2000/85 (March 23, 2000)

