

Registrability – Device And Design Marks

“Bottle device with two transparent parts and colored with orange, dark orange, grey and white”

BEAUTE PRESTIGE INTERNATIONAL vs. TURKISH PATENT INSTITUTE

(*) Ankara Court of Intellectual and Industrial Rights:

Case no- 2004/164 – Decision no. 2004/50 (March 23, 2002)

An action (*) was instituted against the Turkish Patent Institute for the withdrawal of the administrative decision refusing the registration of three dimensional International Trademark consisting of bottle device packaging on the ground that the bottle device sought for registration does not have the characteristic of distinctiveness of a trademark as specified in Article 5 of the Decree-Law No.556 on the Trade/Service Marks.

The plaintiff claimed that the bottle device applied for trademark registration has a distinctive character permitting its registration as a trademark since the bottle device is its original design consisting of two transparent parts gives the impression that there is a red object in it and since furthermore the spraying head of the bottle is located in the tap, which is on the top of the bottle in an original way.

The Turkish Patent Institute asserted that the trademark is not to be considered as distinctive in the sense of the article 5 and 7/1(a) of the Decree Law No. 556, since the bottle device shows no originality/distinctiveness, as it is an ordinary bottle.

The Court following the favorable conclusions of the expert’s report and considering the trademark in the sense of the Article 5 of the Decree Law No. 556 hold that the bottle device giving the impression that an object is hanging in the sphere, which has two transparent parts and on the top of the upper part of it, a cylinder shaped neck has been designed in light orange color, dark orange color, gray and white colors is a three-dimensional device. Furthermore, it has been determined by the Court that the bottle device trademark has been registered since 21.08.2000 as a national trademark in its home country,

since 20.02.2001 as a Community trademark and that furthermore it has been registered in Paris Convention signatory countries.

The Court ruled that the bottle device is not an ordinary design for a bottle as asserted by the defendant, that the trademarks has been registered and marketed in its home country and other European Countries and therefore it has gained distinctiveness through use. Furthermore, the Court has examined ex-officio the trademark in the sense of Article 7/1(e) reading “signs giving substantial value or its shape to the product which shape is a result of the nature of the concerned product or is conditioned by the necessity of obtaining a given technical result shall not be registered as trademark” and ruled that since the goods in international classes 3, 14 and 33, which will be marketed in the bottle are cosmetic products mostly for women such goods do not have any effect on the shape of the bottle or the shape of the bottle is not conditioned by the necessity of obtaining a given technical result in respect of the product contained in it, the three dimensional bottle device as applied for is registrable as a trademark in the sense of Article 5 of Decree-Law No. 556.

On such grounds the Court ruled for the withdrawal of the administrative decision of refusal to allow the application to proceed to registration.