

## Registrability- Three Dimensional Marks

### “BOTTLE” device packages

#### Beaute Prestige International vs. Turkish Patent Institute

(\* ) 2<sup>nd</sup> Court of Intellectual and Industrial Rights of Ankara,

Case no. 2006/159 Decision No: 2006/67

Beaute Prestige International instituted an action (\*) against the Turkish Patent Institute for the withdrawal of its decision refusing the extension to Turkey of two international trademark registrations No. 821.511 and 819.427 consisting of three dimensional “bottle” device packages, on the grounds that the bottle devices for which registration is sought do not have the characteristics of distinctiveness of a trademark and are not registrable as of Article 7 paragraph 1/a) of Decree Law No. 556 on the Trade / Service Marks.

The plaintiff claimed that the decision of refusal of their two 3D trademark applications filed with WIPO claiming priority of French trademark registrations in classes 3, 21 and 33 and extended under the Madrid Protocol to Turkey only for goods in class 3 and 21 and the further denial of their objections by the Higher Council of T.P.I. on grounds of lack of distinctiveness on basis of Article 7 paragraph a of Decree Law No. 556 is unjustified and requested the withdrawal of the final decision of refusal.

The court held that a trademark may consist of all kind of signs which distinguish the goods and services of one undertaking from the goods and services of other undertakings in accordance with Article 5 of the Decree Law, that the legal definition of a trademark consists of two elements: first the sign and secondly the distinctive character.

The court mentioned that lack of creativity or originality does not mean lack of distinctiveness. The sign may consist of words, including personal names, designs, letters, numerals, the shapes of the goods or (of) the packaging, capable of being represented graphically or by similarly descriptive means.

The court also asserted that signs, which are not close to the generic name of the notion / concept or do not generally remind the registered goods / services and do not bring forward the characteristic of

goods/services are deemed distinctive per se as of their nature. The court acknowledged that the plaintiff's bottle devices are three dimensional trademarks and are registered in their home country France and do have the distinctiveness of a trademark for goods in class 3 and 21, that they serve to distinguish the goods to be produced by the plaintiff from those of other companies, since it does not reflect or suggest any features of the goods covered and has been created far from any meaning or type of such goods. Moreover it has been determined by the court that the bottle device trademarks have been registered prior to the application date since May 21, 2003 as national trademark in its home country (France) as well as international trademarks under the provisions of the Madrid Protocol in many countries for identical goods, which clearly evidences that the designs have distinctive character over the goods in class 3 and 21.

The court also held that the devices can be represented by writing and drawing, are capable of being published and reproduced by printing, that while deciding on the registrability of a sign, one shall consider the general image of the sign as a whole rather than examining its separate elements. In order to determine whether the consumer will perceive this sign indicative of the source of the goods covered in class 3 and 21, the sign needs to be analyzed in its entirety.

The signs for which registration are sought are not of a shape generally used in the respective sector on goods in class 3 and 21. The court concluded that the averagely informed, moderately attentive and reasoned consumer may perceive the trademark as a whole and would directly and without any special effort distinguish the goods of the plaintiff from those of other producers. This means that the consumers may determine that the goods belong to the plaintiff.

The court followed that signs are the product of a creative effort, are protectable, unusual and carrying features that are far from the meaning and characteristics of the goods. The signs in their entirety do not carry any meaning of suggestive or descriptive nature of the goods to be covered by this registration. The goods marketed under these sign are far from the concept of the signs. They also do not reveal any feature of the goods. The court further asserted that although the defendant did not issue a decision on the matter, the matter of descriptiveness and generic character should also be examined since the bottle devices are original, uniquely created and unusual, and do not describe any features of the goods to be registered. On the other hand the court held that the bottle devices do not give substantial value and are not the result of the nature of the concerned product, since there are no goods on the market that are produced or are to be directed to be used for goods in class 3 and 21. As also asserted by the experts' report, the bottles' designs do not consist of shapes of general use in the sector. Indeed the designs have been designed as unique.

The court decided that the products consisting of the bottle design have not been presented by any other entity in the market, that the prior presentations of the plaintiff do not affect the result and that there is no requirement for novelty for the registration of a sign as a trademark, so that the designs are registrable in terms of Article 7 paragraphs 1/a, 1/c, 1/d and 1/e as well as on the basis of Article 6quinquies of the Paris Convention and Article 15 of TRIPS agreement and consequently accepted the claims of the plaintiff, by ordering the withdrawal of the defendant's decision of refusal.