

Registrability – Merely Descriptive Term

“**INTERAKTIF**”

(unknown) vs. TPE

(*) **5th Commercial Court of Ankara**

Decision No. 1999/178 - 1999/528 (September 30, 1999)

(**) **11th Civil Chamber of the Supreme Court**

Decision No. 1999/9575 - 2000/2998 (April 13, 2000)

(***) **General Assembly of the Civil Chambers of the Supreme Court**

Decision No. 2000/11 - 2000/1814 (December 20, 2000)

N.B.:

This case has been cited in the Journal of Intellectual Property and Competition Law of Ankara Bar Association (Issue No. 2001/2) where the names of the parties concerned are not cited.

An action (*) was instituted against the Turkish Patent Institute for the withdrawal of the administrative decision refusing the registration of the trademark consisting of the verbal element “INTERAKTIF” (INTERACTIVE) on ground of being descriptive in respect of kind, characteristic and quality over the service specified in the specification of goods and services in accordance of in Article 7 parag. 1(c) of the Decree-Law No. 556 on Trade/Service Marks.

The plaintiff claimed that it is engaged in marketing, advertising and promotion of all kind of goods and services and that has promoted this trademark which is being used alone and with additional verbal or device elements for years so that the applied trademark became a well-known trademark and that the trademark application was unfairly refused by the defendant. The plaintiff claimed the withdrawal of the refusal decision and requested its trademark be registered.

The Turkish Patent Institute objected on the basis that the verbal element “INTERACTIVE” meant co-effective, communicative, information exchange, and concerns to the information exchange between

the computer and the user during the operation of the computer programs or concerns to the concept which provides such information exchange and therefore such trademark cannot be registered as a trademark since it will be descriptive in respect of services.

The court (*) ordered to the rejection of the court action on grounds that the plaintiff's trademark "INTERAKTIF" means co-effective, that the trademarks indicating the kind, characteristics quality, quantity purpose and value of the services according to Article 7 parag. 1(c) of the Decree Law no.556 and that the previous registrations cited by the plaintiff in support of his claims cannot be considered since an incorrect precedent cannot be considered as a precedent for the court

Upon the plaintiff's appeal the Supreme Court (***) overturned the initial decision (*) on grounds that the words which cannot be registered as a trademark alone can be registered by addition of distinctive verbal elements and components in the scope of the Article 5 of the Decree Law no.556 where the definition of the registrable trademarks is stated. The court referring to its previous decisions ruled that such principle was also applied to the trademarks comprising (the name of) a color or the geographical names and that although the registration of "INTERACTIVE" or "INTERAKTIF" cannot be effected alone, such words can be registered with additional words such as "advertising, marketing, promotion, communications."

Having refused to conform to the overturned decision, the first instance court persisted upon its initial decision where the plaintiff appealed against the persisting decision before the General Assembly of the Supreme Court (***). The General Assembly of the Supreme Court uphold the grounds asserted by the Supreme Court and overturned the persisting decision on grounds that persisting on the initial decision is contrary to the procedure and law.

A dissenting opinion was put by one of the members of the General Assembly of the Supreme Court on grounds that the trademark "INTERAKTIF" is a descriptive trademark in accordance with Article 7 parag. 1(c), that the verbal element "INTERAKTIF" constitutes the distinctive part of the trademark and that the decision of the court should be uphold. The dissenting opinion was motivated in that Article 5 of the Decree Law no. 556 is a general Article for indicating the registrable signs whereas Article 7 specifically states the absolute grounds for refusal of the trademarks. Under these circumstances, it is not possible to grant the registration of non-registrable trademark in sense of article 7 according to a general article namely according to Article 5.