

Registrability- Three Dimensional Marks

“Rectangular prisms with a blue top and white bottom carrying a red ball in the middle”

BENCKISER N.V. vs. TURKISH PATENT INSTITUTE

(*) 3rd Commercial Court of Ankara

Decision no. 2000/231 /2001/243 (March 1, 2001)

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

Decision No. 2001/8261-2002/510 (January 28, 2002)

(*) 5th Commercial Court of Ankara**

Case No. 1998/777-1999-225 (April 22, 1999)

Upheld by the decision of the Supreme Court (11th Chamber)

No. 2000/3866-4995 (June 1, 2000)

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

The plaintiff claimed that the distinctiveness of the trademark applied for is conferred by the device/figurative elements of which it is composed and consisting of two rectangular prisms with a blue top and white bottom carrying a red ball in the middle and that due these characteristics the plaintiff's products distinguish over other similar products. The plaintiff further claimed that the trademark applied for has been registered in many countries and before WIPO as an international registration as well as in the country of origin and that on ground of Article 6 quinquies of the Paris Convention it is to be accepted “telle quel” for registration also in Turkey.

The Turkish Patent Institute repeated his grounds of refusal by claiming that these characteristics are not sufficient to confer distinctiveness to the trademark applied for and further alleged that according

to Article 6, parag. 3 of the Paris Convention the Turkish Patent Institute is under no obligation to accept such application to registration as the refusal is based on Article 7, parag. 1(a).

After assessing the parties' claims, allegations and evidences and without referring, as is usual, the matter to the panel of experts for opinion as to whether or not the trademark applied for meets the characteristic to distinguish as a trademark in the sense of Article 5 of the Decree-Law No. 556 on Trade/Service Marks, the Court following the jurisprudence (***) has concluded and ruled that the three dimensional trademarks and their color combinations are registrable as trademarks according to Article 5 of the Decree Law no.556 and that the concerned device trademark in its color arrangement having acquired notoriety and distinctiveness and also having been registered in many countries has a distinguishing character under the scope of said provision. Moreover, on the basis the case law the first instance court held that since this trademark has been duly registered in the Country of Origin, it has to be granted protection by member countries on the basis of the Article 6quinquies of the Paris Convention as well of first instance.

In this action it is particularly noteworthy that the first instance Court, on the basis of its discretionary competence on the issue, has reached its decision without referring, to the contrary of the usual procedural judiciary practice, the case to the panel of experts for preliminary opinion.

The plaintiff's appeal was not favorably received and the Supreme Court (**) upheld the decision of the first instance Court on grounds that it is justified as to the procedural and positive law.