

## Registrability – Device And Design Marks

“Tube shaped packaging with the picture of the colored chocolates”

**SOCIETE DES PRODUITS NESTLE S.A. vs. TURKISH PATENT INSTITUTE**

(\*) **9th Commercial Court of Ankara**

**Case no. 2000/783 – Decision no.2001/382 (May 9, 2001)**

An action (\*) was instituted against the Turkish Patent Institute for the withdrawal of the administrative decision refusing the registration of the trademark consisting of a chocolate packaging on ground of absence of distinctiveness and on ground that the packaging 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 Trade/Service Marks.

The plaintiff claimed that the applied trademark consisting of a tube shaped packaging with the picture of the colored chocolates on it, is widely used and for long on a special kind of chocolate sold under the famous SMARTIES trademark and that since it has acquired distinctiveness due to such longstanding and extensive use and consequent reputation around the world including in Turkey, the decision of rejection is contrary to the Decree Law no.556, the International Agreements, the Paris Agreement and the jurisprudence of the Supreme Court in this regard.

The Turkish Patent Institute objected that the said trademarks consist of “two tubes leaning back and three tubes leaning forward” only and that therefore they are not to be considered as distinctive in the sense of Article 5 of the Decree Law no.556.

The court based on the expert’s report examining the trademark in the sense of Article 5 has decided that the subject trademark consist of a shape of the packaging, capable of being represented graphically or by similarly descriptive means and capable of being published and reproduced by printing, that color combinations shall be registered as such according to the international agreements and the current practice, that the packaging does present the characteristics of distinctiveness whereby since it has been duly registered in the Country of

Origin, it has to be granted protection on the basis of the Article 6quinquies of the Paris Convention as well.