

Filling the Gaps in Turkish Trademark Law

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Although Turkey has followed international developments and harmonized its Trademark Law with EU legislation, the registration of non-traditional marks such as product packaging and product shape has not fallen into place.

The Turkish Appeal Court has recently approved the First Instance Court's cancellation decision of the Turkish Patent Institute's (TPI's) refusal of BP's application to register green service station trade dress.

The TPI's Decision

BP filed an application to expand the protection of the green service station appearance registered before WIPO in class 37. The TPI refused the application on the grounds that the sign does not conform to the provision of Article 5 of Decree Law No. 556, which defines what constitutes a registrable trademark.

A trademark can be registered if it is capable of distinguishing the goods and services of one undertaking from the goods and services of other undertakings and may consist of all kinds of graphic signs capable of being published within the scope of Article 5.

Although BP appealed against the refusal decision, it was upheld by the TPI's re-examination and evaluation board. BP initiated a cancellation action in response to the decision.

The First Instance Court's Decision

In its cancellation judgment, the First Instance Court first discussed whether the refused sign can be considered within the scope of Article 5. The court stated that, unlike the Design Law, the Trademark Law does not require a sign to be genuine nor does it consider the creativity of a sign.

Therefore, a sign should be distinctive in order to be protected by registration. Within the scope of this information, the court found that green service station as a whole could be registered, as its color composition was capable of distinguishing the services in class 37 from other services offered by other undertakings because the sign depicts contours and does not indicate or prominently display the features of the services in class 37.

Although the TPI refused the subject application only on the grounds that it cannot be registered as a trademark, the court also examined the TPI's decision according to the absolute grounds for refusal specified in Articles 7/1-c, d and e of the Decree Law No. 556, covering marks that serve to indicate the necessary elements to the trade.

The court stated that the green service station trademark is not recognized by consumers and has a genuine look with its color composition and configuration. The sign does more than just indicate the services covered

in class 37, and consumers would not be able to imagine the services that will be served under this trademark. The court also discussed whether the subject sign has a special configuration or shape that has to be used in the sector. If the subject sign has to be used in the sector, its registration would affect competition.

However, the court stated that the green service station trademark does not contain the shape of the product that results from the nature of the good or that gives substantial value to the good as there is no existing trademark in class 37 with this configuration and color composition. The court also found that there are lots of signs available as trademarks in class 37.

The court further noted that the trademark would not be likely to cause confusion for the average consumer. The average consumer would not prefer the applicant's services over a rival's merely because its service station appearance is covered by its trademark.

Moreover, it noted that the registration of the subject application in the UK, at WIPO and in most of the designated countries constitutes a presumption that the green service station is distinctive.

Consequently, the First Instance Court canceled the TPI's refusal decision. The First Instance Court's decision was approved by the Appeals Court and the decision was finalized in December 2009.

Review of the Decision

As stated above, the TPI accepts trademark applications consisting of packages, package labels and three-dimensional shapes. With the decision of the Appeals Court, the practice regarding the registration of trademarks including the exterior appearance of buildings seems to be settled too.

Therefore, we are of the opinion that the TPI will accept trademark applications consisting of fuel filling stations' exterior appearance applications in different colors/color combinations if they do not have exactly the same appearance as BP's filling station.

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