

New Trademark and Industrial Design Guidelines Promise Much in Turkey

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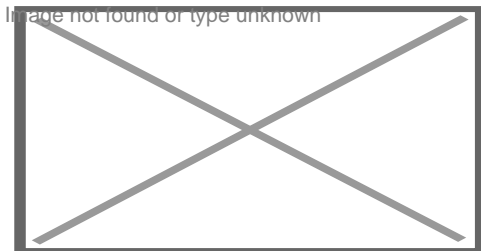
In November 2011 the Turkish Patent Institute published Trademark and Industrial Design Examination Guidelines. The guidelines were prepared with the collaboration of the Office for Harmonization in the Internal Market (OHIM) and German Federal Patent Court judges within the scope of the EU twinning project titled "Supporting Turkey for Enhancing Implementation and Enforcement of Industrial Property Rights", which has been carried out by TPI and the German Foundation for International Legal Cooperation (IRZ).

In introductory meetings the TPI stated that although the guidelines were prepared based on OHIM's Examination Guidelines the existing implementations, proceedings and precedents of Turkish Trademark Law were also considered.

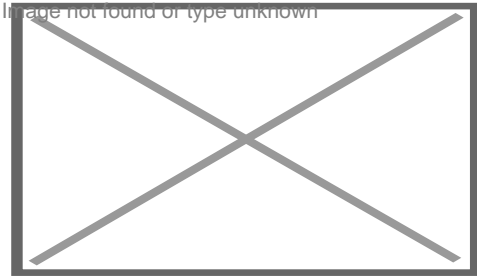
The Trademark Examination Guidelines do not bring a fundamental change to trademark application and opposition examination proceedings. They merely bring together all previous uncodified criteria. One of the criteria that can be considered as new for Turkish practice concerns the application requirements for single color or color-combination trademarks. As of the guidelines' publication the TPI will also require a reference to the internationally-accepted color code (RAL, Pantone, etc) of the subject color or colors.

The guidelines also provide criteria for use in similarity examinations by way of examples. Specifically:

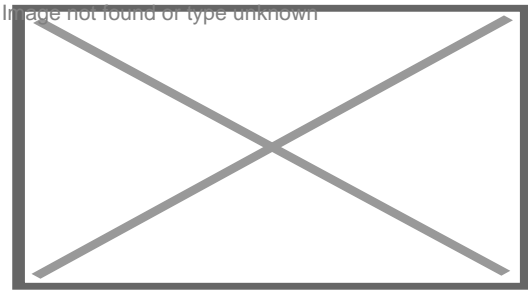
- Trademarks consisting of one identical letter or number will be considered as different if they are stylized differently or contain different figurative elements.
- Trademarks consisting of two or three identical letters or numbers in the same sequence will be deemed confusingly similar. However, the symbol '&' can eliminate the confusion unless the prior trademark is a well-known trademark.
- Trademarks consisting of two or three identical letters or numbers in the same sequence will be considered as different if they are stylized differently or contain different figurative elements. For example, the following two "GD" trademarks are considered to be different.



- Trademarks forming a meaningful phrase through the combination of a possessive suffix and a noun will not be deemed confusingly similar. However, if the addition of the possessive suffix results in a word with no meaning the trademarks will be considered similar.
- Conceptual similarity will not be enough to deem two figurative elements confusingly similar. In addition to conceptual similarity the "figurative element should also be visually similar. In the following example the eagle figures do not display sufficient similarity to constitute confusing similarity.



The criterion to consider the "word element" initially in trademarks as consisting of a word and a figurative element will remain unchanged. However, the new guidelines stipulate that if the earlier trademark's figurative element displays a high level of distinctiveness and the trademark in question contains a direct copy of the earlier trademark's figurative element the trademarks will be deemed confusingly similar even if the word elements are completely different.



The TPI also enumerated in the guidelines some points that will be considered in determination of a bad faith application:

- Copying a unique, distinctive trademark that is registered within Turkey or abroad in a way that cannot be considered a coincidence;
- Trademark applications made with the purpose of taking unfair advantage of well-known and distinctive trademarks in the same or related market;
- Similar trademark applications filed by a related person/company of the earlier trademark owner (such as employment, contractual or any other commercial relation);
- Systematically applying to register reputable foreign trademarks that are not registered in Turkey; and
- Applications exclusively made with the intent of preventing the real rights owner's entrance into the Turkish market or with the intent to sell the trademark to the real rights owner.

Apart from the above points, the guidelines introduce many other criteria that have not been aggregated until now. The decisions of TPI and their implementation will be more transparent and predictable from now on.

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