

Position Mark Protection in Turkey

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Under today's economic conditions and competitive market system, companies should think outside the box and create original brands, to distinguish their goods and services from others.

Rapidly changing consumer behavior has integrated different elements to the concept of trademark. Thus, the scope of non-traditional brands has expanded, and we have recently started discussing the registrability of the taste, position, and hologram marks in addition to single color/color combination trademarks.

In line with these developments, under the Turkish trademark law practice, "non-traditional trademarks" that are making the most of technological opportunities and appealing to multiple senses are formed.

The position mark is a type of non-traditional trademark and consists of a specific placement or affixation of mark on a product. The most famous position mark examples are Adidas' three parallel stripes, Louboutin's red-bottomed shoes, and "flying lady" shape in Rolls Royce cars.

Within this context, [the new Trademark Examination Guideline \("Guideline"\), published on September 2019](#), explains the criteria, necessary information and documents for position mark applications that were explicitly regulated for the first time under the Industrial Property Law numbered 6769 ("IPL").

Under the Turkish trademark law practice, requirements for position mark applications are as follows:

- It must have a distinctive character.
- It should be perceived as a mark, not a purely decorative or functional element, nor a design.
- The application should specify that the sign is in fact a position mark.
- The non-claimed parts should be depicted in dashed line,
- Optionally, details showing how the sign is placed on the good can be included.
- The sign should be uniformized (**should be used in the same size and place, for example.**).
- The protection provided by the owner should not constitute unfair competition.

In case a trademark application depicts a position mark on a shoe, the application will only be accepted for the footwear and rejected for the rest—clothing, for example.

The Guideline clearly sets forth that while assessing the distinctiveness in the position marks, the impression made by the sign should be questioned: Is it placed as a decorative and aesthetic element or perceived as a brand?










In this regard, the sign will be protected as a position mark if:

- It significantly differs from the common uses in the sector,
- Its use on the product is accepted as an extraordinary practice,
- Its appearance is perceived as a commercial resource of the product.

Although IPL and Guideline allow the registration of position marks, the practice has not unified or become widespread yet. The general approach is that although position marks are allowed to be filed, in most cases TPTO does not make an assessment in terms of distinctiveness and usually rejects the applications based on the reason they are not distinctive in most cases. When the decision is appealed before the Appeal Board, the Board rejects the

appeal with the same short decision which does not include detailed reasoning. Therefore, the applicant needs to start a cancellation action against the TPTO's final decision. The TPTO leave it to the Turkish court's discretion to decide about the registrability of the position marks. This shows that although position marks are allowed in TPTO, the distinctiveness is not still examined as much as the Courts

The followings are notable among TPTO records:

- The application filed to register the red sole of Louboutin  (2009/68709) was rejected in TPTO's examination on absolute grounds.
- The TPTO refused the applications filed to register the trademarks  (2013/36184) and  (2015/80296) owned by Camper. However, the trademark  (2013/15164) filed by Camper. However, the trademark  (2015/80296) owned by Camper is registered.
- The application filed to register the trademark  (2012/70652) filed by Adidas was granted registration without f  jection.
- Another application  (2010/77147) filed by Adidas was rejected by the TPTO. The decision of the TPTO was challenged before the Ankara IP Courts and the court concluded that the "Shell toe" has provided the distinguishing character by means of use.
- PRADA's trademark application  numbered 2003/29614 for footwear was also refused by the TPTO but registered after appeal before the TPTO Appeal Board.

Within this context, considering that challenging the TPTO's final decision before the courts may take years, it is possible to say obtaining registration for a position mark still requires extra time and effort in Turkey, although it is allowed by the law.

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