

Registering an Interior or Exterior Store Design in Turkey

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Companies wishing to obtain legal protection for their interior or exterior store designs in Turkey are faced with a choice: Whether to (1) Register the design as a trademark; or (2) Register it as an industrial design. Many jurisdictions around the world, including the United States, provide stronger trademark protection for store designs. In Turkey, however, trademark law as applied to store designs is unsettled, and greater protection may be found under the industrial design registration process. However, this option has some drawbacks as well, and companies should consider the relative merits of each alternative.

Turkish law regarding the registrability and protection of non-traditional trademarks is still in flux. According to Article 5 of Trademark Decree Law No. 556, *"A trademark, provided that it is capable of distinguishing the goods and services of one undertaking from the goods and services of other undertakings, may consist of all kinds of signs being represented graphically such as words, including personal names, designs, letters, numerals, shape of the goods or their packaging and similarly descriptive means capable of being published and reproduced by printing."* Based on this provision it appears that the interior or exterior design of a store can be registered as a trademark. However, in practice, many questions remain, including the level of distinctiveness required in order to obtain registration and the level of protection that needs to be provided.

The distinctiveness test for three-dimensional trademarks differs from the distinctiveness test for traditional trademarks. In principle, the Turkish Patent Institute ("TPI") takes the following principles into account:

- The shape of a three-dimensional trademark becomes more distinctive as it diverges from its natural shape, or what is standard in the relevant sector;
- The average consumer should be able to identify the origin of the three-dimensional trademark without any effort because of the unusual and extra features added to it.

Although both TPI and Turkish courts have started accepting the three-dimensional shape and visual identities as a sign which differentiates one company from another, in practice the TPI has rendered many contradictory decisions which prevented the settlement of practice in Turkey. Indeed, the record is replete with examples of conflicting decisions on essentially identical designs.

One rule, however, appears clear from the record: In cases where the three-dimensional device is filed together with a word element, the word element is taken into account and granted protection. So the chances of registering the store view in combination with a word mark are high. But this registration does not grant exclusive rights on the three-dimensional image as it is filed in combination with a word mark. Therefore, in cases where an interior or exterior design of a store needs to be protected, filing a trademark application in combination with a word mark will not provide the sufficient protection that is desired.

And when three-dimensional trademarks are filed without word elements, TPI rejects them. In such cases, applicants need to file an appeal and prove one of the following:

- The rejected trademark is presently in use and has acquired distinctiveness through its use;
- The rejected trademark's acquired distinctiveness relates to the same goods and/or services indicated in the application; or
- The rejected is perceived as a trademark in Turkey. (Proof of acquired distinctiveness abroad is not sufficient in this case).

Evidence submitted in support should prove the acquired distinctiveness at the date of filing. Consequently, the evidence should date back to the period before the filing date. This means an interior or exterior store design can be registered as a trademark only if it has acquired distinctiveness in relation to the relevant service which led the consumer to relate the store design with the trademark owner without seeing a word mark/company name.

However, while the bar of registrability is high in the trademark context, it is much easier to register an interior or exterior store concept as an industrial design in Turkey. According to Design Law No. 554, "a design shall be regarded as having individual character if the overall impression that it conveys to the informed user is significantly different from the overall impression conveyed to the same user by any design." Unlike trademark applications, the TPI does not examine an industrial design application on absolute grounds for refusal; it only examines for the correct application format and whether it complies with public policy and morality policies. The TPI is not responsible for evaluating a design's novelty or individual character. The TPI only examines these issues if a third party files an opposition. Therefore, where an applicant files an application for its newly designed interior or exterior store concept, the TPI will publish it and, unless challenged by third party opposition, it will be granted registration. Accordingly, most companies prefer registering their trade dress as an industrial design, unless the trade dress has already acquired distinctiveness by the application date.

However, although registering as an industrial design seems like the easier and therefore preferable option, the nature of industrial design protection includes a few disadvantages compared to trademark, such as a limited period of protection (maximum 25 years) and a difference in the test required for similarity. Companies seeking to introduce new designs to the public may therefore want to consider registering them as industrial designs first, to obtain the protections that registration provides, then register them as trademarks once the designs acquire distinctiveness.

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