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## Patent and Trademark Office issues new guidelines for examination of trademark applications

Turkey - [Gün + Partners](#)

- **On 30 September 2019 the Patent and Trademark Office announced the issuance of new guidelines for the examination of trademark applications**
- **The new guidelines are limited to examination on absolute grounds**
- **The guidelines include a number of examples from Turkish and EU decisions**

Following the entry into force of the Turkish Industrial Property Code, which replaced the relevant decree laws, on 10 January 2017, new guidelines had long been needed and awaited. The Turkish Patent and Trademark Office announced the issuance of new guidelines on its official website on 30 September 2019.

While the previous guidelines covered the examination principles for trademark applications in terms of both absolute and relative grounds, the new guidelines are limited to absolute grounds only.

The guidelines cover the sub-articles of Article 5 of the Industrial Property Code, as follows:

- (a) signs which do not conform to the requirements of Article 4;
- (b) signs which do not have any distinctive character;
- (c) signs which consist, exclusively or mainly, of indications or names which refer to the type, variety, nature, quality, quantity, purpose, value, geographical source, time of production of the goods or of rendering of the services, or other characteristics of the goods or services;
- (ç) signs which are the same as, or indistinguishably similar to, a trademark which is registered in relation to the same goods or services or goods or services of the same type, or a trademark for which an application for registration has been previously filed;
- (d) signs which contain, exclusively or mainly, indications or names used by everyone in the relevant field of trade, or which serve to distinguish those belonging to a specific professional, artistic or

commercial group;

(e) signs which consist exclusively of the shape or another characteristic resulting from the nature of the goods, the shape or another characteristic which is necessary to obtain a technical result, or the shape or another characteristic which gives substantial value to the goods;

(f) signs which may mislead the public as to the nature, quality or geographic origin of the goods or services;

(g) signs which are to be refused under Article 6 *ter* of the Paris Convention;

(ğ) other signs which are not included within the scope of Article 6 *ter* of the Paris Convention, but are of particular public interest or have become public property in terms of their historical and cultural values, as well as coat of arms, signs or names which have not been granted registration permits by the competent authorities;

(h) signs comprising religious values or symbols;

(i) signs which are contrary to public order or to accepted principles of morality; and

(j) signs consisting of, or containing, registered geographic indications.

The guidelines consist of 378 pages and include a number of examples from Patent and Trademark Office, Re-examination and Evaluation Board and court decisions, as well as decisions of the European Union Intellectual Property Office and the Court of Justice of the European Union. In particular, Article 5(1)(c) (descriptiveness) and Article 5(1)(ç) (indistinguishable similarity to an earlier trademark or trademark application) are discussed in detail by providing various examples.

The concept of rejection of a trademark application *ex officio* due to its indistinguishable similarity to an earlier trademark or trademark application (Article 5(1)(ç)) is somewhat particular to Turkish law and its implementation has been widely criticised in practice. A lot of examples are provided in the guidelines regarding this rule. For instance, the indistinguishable similarity of trademarks containing the words 'tech', 'my', 'max', 'smart', 'ultra', 'soft', 'life' or 'collection' is discussed in separate headings.

The former guidelines had a positive effect on the decisions of the office and, therefore, it is hoped that this detailed work shall further improve the quality of the office's decisions. As stated by the office when announcing the issuance of the guidelines, this is a living document which should be updated occasionally according to changes in practice and evaluation. In this respect, one might argue that the principles for substantive examination should also be covered in the next update.

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