

[Guest post] A trade mark or a song? Turkish Court of Cassation casts some light on this distinction

▲ Söğüt Atilla Friday, September 20, 2024 - Guest post, niloya, sound mark, trade marks, Turkey

The IPKat has received and is pleased to host the following guest contribution by Katfriends **Güldeniz Doğan Alkan** and **Hatice İnci Turan** (Gün + Partners Law Firm) on a recent decision of the Republic of Türkiye Court of Cassation concerning the registrability of sounds as trade marks. Here's what they write:

A trade mark or a song? Turkish Court of Cassation casts some light on this distinction

by *Güldeniz Doğan Alkan and Hatice İnci Turan*

Article 4 of the Law No. 6769 on Industrial Property indicates that sounds can be registered as trade marks if they are capable of being distinguishable for the goods or services of one undertaking from that of another:

*“Trademarks may consist of any signs like [...], **sounds** and the shape of goods or their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings and being represented on the register in a manner to determine the clear and precise subject matter of the protection afforded to its proprietor.”*

Apparently, the registrability requirements of a sign and a sound cannot be the same and the evaluation of a sign's trade mark eligibility differs from that of a sound's. According to the **Trademark Examination Guideline (Guideline)** of the Turkish Patent and Trade Mark Office (the Office), sound marks are categorized as non-conventional trade marks. The Guideline states that a sound must not be short or basic to indicate the commercial source of a good or a service of an undertaking, as previously discussed by the EUIPO [IPKat [here](#)]. It also must not be so long that it is perceived as a song. All other sounds not satisfying these criteria will be considered to lack distinctiveness.

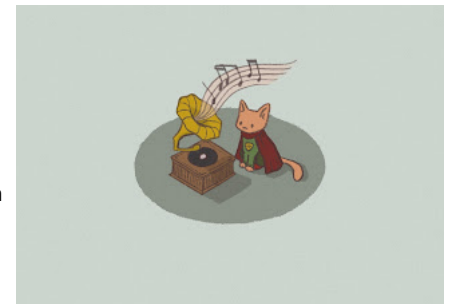


Image by Riana Harvey

In its recent decision, the Turkish Court of Cassation (the CoC), **upheld the decision** of the Court of Appeal (the CoA), which rejected the registration application for a sound of an animated cartoon. **Let's listen to it together** (only the first 32 seconds were applied for a registration)!

Background

The sound in question is the theme music from famous Turkish animated cartoon "NİLOYA", which also includes the name "NİLOYA", a registered trade mark of the applicant. The sound was applied for goods and services in classes 16, 18, 25, 28, 35, and 41. However, the Office rejected the application due to the sound's lack of distinctive character. Consequently, the applicant filed a cancellation action against the decision of the Office before the IP court.

Decision

In the action, the applicant, who is also the creator of the "NİLOYA" character, argued that the relevant average consumer perceives this sound as a trade mark, is able to distinguish her goods and services from other entities' goods and services, and the fact that the sound was listened more than 20 million times on YouTube is an indication that Turkish public is familiar with this arguably distinctive sound. It is further claimed that the words and the melody "İa İa İa Niloya, Niloya derler adıma" ["İa İa İa Niloya, they call me Niloya"] cannot be used by someone else in commerce; therefore, there should be no obstacle to the registration of the theme song as a sound mark.

However, the Office found that the sound does not refer to any commercial source and is perceived only as a children's song. Additionally, it stated that, even if the sound could be perceived as a trade mark, it could not have been registered due to being a non-distinctive one.

Further to the Office's findings, the IP Court stated that there is no direct or specific relation between the application and the goods and services covered, and that the sound lasting for 32 seconds is perceived as a song as it comprises introduction, development, and ending sections, without any catchy phrases and melodies. Eventually, the IP Court decided that the sound does not have a distinctive character, that it cannot be perceived as a trade mark, and that it fails to indicate the origin of the goods and services covered by the application. The Court emphasized that it is still a work of art that can be protected by copyright law, rather than trade mark law.

Although the applicant appealed the IP Court's decision, the CoA agreed with the IP Court's decision and assessments indicating that the sound cannot be registered as a trade mark due to its inability of indicating a commercial source, and hence the decision of the CoA was upheld by the CoC.

Comment

It is obvious that the registrability of a sound as a trade mark depends upon whether or not the sound is distinctive and if consumers associate the sound with the goods and services an undertaking provides. It should be highlighted that several sound trade mark applications were rejected by IP offices due to non-distinctiveness. For instance, the sound trade mark application filed before the EUIPO (**no. 018713855**, the sound can be found [here](#)) [IPKat [here](#)], which is highly similar to the application at issue, was rejected by the EUIPO, because the sound was a song for children and not sufficiently distinctive to be registered as a trade mark.

From our point of view, although the application discussed can be perceived as a song, it includes the phrase "NILOYA", which is the applicant's registered trade mark. There are only a few words in the sound that are harmonized and memorable, and one of them is the word mark of the applicant. Therefore, consumers may have been found to associate this sound with the applicant's cartoon, if the application was sought to be registered for only cartoons rather than all the classes 16, 18, 25, 28, 35 and 41. This broad coverage of the application may also have caused a negative impact in the assessment of distinctiveness.

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