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Victory for Versace as design is rejected on the ground that it constitutes “unauthorised use of an IP right”

Turkey - [Gün + Partners](#)

- **The Intellectual Property Code No 6769 introduced the “unauthorised use of an IP right” as a relative ground for refusal of a design application under Article 67/2**
- **The Patent and Trademark Office recently rejected a design on the ground that it constituted an unauthorised use of Versace’s figurative marks**
- **The decision serves as a good example of the implementation of Article 67/2**

The Turkish Patent and Trademark Office has recently rejected a design application that included an IP right upon opposition by the owner of that right. Since the entry into force of the Intellectual Property Code No 6769 in January 2017, the “unauthorised use of an intellectual property right” is one of the relative grounds for refusal of design applications under Article 67/2.

Background

The Intellectual Property Code brought some major changes when it entered into force in January 2017. Article 67/2 provides as follows:

Third parties may submit a written opposition to the issuance of a registration certificate within three months of the publication date of the design registration by asserting... that it constitutes an unauthorised use of an intellectual property right.

By using the term ‘intellectual property right’, the legislator ensured that the provision encompassed wider rights - that is, not only trademarks.

Before the entry into force of the Intellectual Property Code, the law did not include any specific provision on this issue. Therefore, when a design constituted the unauthorised use of an IP right, the IP owner had to allege bad faith (which is a relative ground for refusal under the Intellectual Property Code). However, the Turkish Patent and Trademark Office has now started to implement these changes

and recently rejected a design upon opposition on the ground that it constituted an unauthorised use of an IP right (here, a registered trademark).

Facts of the case

The applicant filed an application for the following design:



Gianni Versace SRL filed an opposition, alleging that:

- the design lacked distinctiveness and novelty;
- the design included Versace's well-known registered trademarks, depicted below; and



- the design had been filed in bad faith.

Decision

The Patent and Trademark Office found that the design constituted an unauthorised use of Versace's trademarks and rejected the application under Article 67/2 of the Intellectual Property Code. The decision thus serves as a good example of the implementation of Article 67/2.

However, the office did not accept the claim that the opposed design lacked novelty and distinctive character, even though it found that the design included Versace's trademarks. **Comment**

Arguably, these two grounds are interconnected because, if a design includes an IP right, it automatically loses its novelty. Therefore, one may argue that the office should also have upheld the opposition on the ground that the design lacked novelty.

As a matter of fact, the claim that a design constitutes an “unauthorised use of an IP right” is more objective compared to a claim that a design lacks “novelty and distinctive quality”. Therefore, IP owners may be more likely to obtain a favourable decision by claiming that a design includes an IP right. Indeed, a design may be found distinctive and new even if it includes some elements of an IP right or a product which has been presented to the market, since the examination in this respect is more subjective.

Overall, since the entry into force of the Intellectual Property Code, the unauthorised use of an IP right has been recognised as one of the relative grounds for refusal under Article 67/2 and seems more favourable for IP right owners, which is a very positive development. It is also hoped that, in the future, the office will assess that ground along with the lack of novelty and distinctive character, as these grounds are naturally linked.

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