

## Shape mark registration decision may be start of new trend

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In what may turn out to be a landmark decision, the Re-examination and Evaluation Board of the Turkish Patent Institute (TPI) has overturned a first instance decision and has allowed the registration of a three-dimensional device mark in the shape of an open book (Case 2006/05170, May 23 2007). Previously, the TPI has been very reluctant to allow the registration of three-dimensional marks.

Société des Produits Nestlé SA (Nestlé) applied for the registration of the mark for goods in Classes 29 and 30 of the Nice Classification. At first instance, the TPI rejected the application due to lack of distinctiveness in line with Article 7/1-a of the Trademark Decree Law 556 regarding absolute grounds for refusal.

On appeal, Nestlé argued that its mark was inherently distinctive and produced evidence of registrations for the mark obtained in other countries that are members of the Paris Convention for the Protection of Industrial Property and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). Nestlé stated that, pursuant to established precedent of the courts, this provided concrete evidence that its mark was registrable.

With reference to inherent distinctiveness, Nestlé argued that the claimed goods were ready-to-eat goods, which were unrelated to the shape set out in its application. It further argued that its device mark had acquired distinctive character through use before the application date.

Taking case law into consideration, the appellate board of the TPI upheld Nestlé's claims. Prior court rulings indicated that if a trademark contains a unique shape, then it is within reason to determine that this shape is capable of distinguishing one company's goods or services from another. The appellate board also noted that the Turkish Court of Appeals has also interpreted Article 6*bis* of the Paris Convention to mean that where a mark is registered in one member company, it is not possible to reject a subsequent application in another member country.

This is a landmark decision since the TPI's prior practice was to reject device trademarks in almost all circumstances. Device mark registration has typically required lengthy court action against a refusal decision of the TPI. The chances of obtaining a three-dimensional trademark at administrative level may now have increased, particularly where the applicant can prove that the mark has been registered in other Paris Convention or TRIPs member countries.