

Turkey: Turkish Patent Office Rejects A Trademark Application Due To Incorporating The Phrase "Cubano" Amongst Other Reasons

Last Updated: 3 June 2014

Article by **Uğur Aktekin**, **Ali Bozođlu** and **İpek Oğuz**

Gun & Partners

In August 2010, **PC DESIGN SARL** filed an application no. 2010/52790 for "cubano original eau de toilette natural spray + device" before the TPI for the goods specified in classes 03 and 33.

HAVANA CLUB HOLDING S.A. ("HAVANA CLUB") filed an opposition against the application on the grounds that the application is not registrable in accordance with Article 7/1(c) of Decree Law, given that *"it was not distinctive in the commercial industry, designated geographical origin and contained phrases which will deceive consumers,"* since it includes the phrase **"CUBANO"**, referring to the country of "CUBA" as a principal element; as well as in accordance with Article 7/1(f) of Decree Law, given that *"it was misleading for the public with respect to the nature, quality or place of production, geographical origin of the goods."* since the scope of application covered the goods of alcoholic beverages under classification 33 and it comprises the phrase "EAU DE TOILETTE" which is deceptive for the public. As it is seen from the below visual, the main element of the application which attracts the attention of consumers is the phrase "CUBANO" which is known at an international scale with its meaning "CUBAN" in Spanish and Italian languages.



The trademark application numbered 2010/52790

As known to all "Cuban Rum" is a type of an alcohol called RUM, produced uniquely in Cuba Island for more than four centuries¹, and has become distinguished in the world as one of the best due to the unique climate conditions and fermentation, distillation and aging proceedings applied in Cuba². In consequence of its reputation, and given that its distinguishing features make it deserving of effective protection of its image and prestige, which at the same time protects consumers in international markets against confusions arising from false statements about the origin of overseas products of a similar nature, Cuba has built up a legal body dedicated to the prevention of dilution of the geographical indication Cuba, notably by creating a seal of warranty for certain products, to be affixed on a compulsory basis on these Cuban products being exported³. Third party countries, such as Germany and Spain, have also signed

bilateral agreements with Cuba to protect this indication of origin. In addition to its worldwide reputation in the commercial market, the geographically indicated character of Cuba and the association between Cuba and Rum has also become legally acknowledged in the territory of Cuba. Following to this protection, Corporation Cuba Ron S.A., as one of the biggest Cuban rum producer companies and partner company of the client HAVANA CLUB, has applied to the Cuban Industrial Property Office for the exclusive rights of use of the denomination of origin CUBA on March 27, 2009 and the Cuban Industrial Property Office has granted this right to the client's partner on 2010⁴. Within this framework, in the opposition filed against the above mentioned application, **HAVANA CLUB** expressed that the phrase "CUBANO" establishes a direct association with CUBA, denoting a geographical origin particularly with respect to the goods covered by the trademark application, alcoholic beverages.

Further to the rejection of the opposition in first instance, **HAVANA CLUB** claimed in appeal that the Trademarks Department's decision was not well grounded and emphasized that the phrases such as CUBA and CUBANO, shall be considered as appellations of origin with regard to the goods of alcoholic beverages and it was argued that any consumer, who saw the subject trademark CUBANO on the bottle of the drink, would associate it directly with Cuba and rum. As a result of the examination the appeal board of TPI determined that the "CUBANO" element on the trademark application lacked the distinctive character as it meant "Cuban, from Cuba" and indicated the origin of goods, and rightfully concluded that the subject trademark application was not distinctive for the goods covered by the application. Furthermore, the TPI added in its decision that, the device element which could be observed from the above visual and the portrait of an old president of the U.S., Benjamin Franklin lacked distinctiveness as a trademark and along with phrases such as "eau de toilette", "natural spray", "80 % vol." and "35 ml 1.17 Fl oz" could be misleading for the public.

The decision has become final as the applicant has not filed a cancellation action against the decision before the Courts within due time.

The decision of TPI is significant due to the reason that the phrase "CUBANO" is considered to indicate the origin of goods to Turkish consumers despite the fact that it is not a Turkish word. Additionally the decision sets a very good precedent in combating with trademark applications that incorporate geographical signs as an element that could make the public think that the goods covered by the application are associated with the relevant geography.

Footnotes

1. *Cuban Rum History Tour Guide Service Havana*. Document. 13 02 2014. (www.havanadiscoverytours.com).
2. Cuban Coffee Tobacco & Rum. tarih yok. 13 02 2014. (www.cubaluxuryhotels.com).
3. Cuban Government's Warranty Cuban Rum . No. 6206. 28 04 1999.
4. CONCLUSIVE EXAMINATION REPORT. No. 0714 / 2010. Cuban Industrial Property Office. 05 05 2010.