

Patent Institute can't spoil FERRERO ROCHER 3D application

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WTR, 04.06.2007

The Turkish Court of Appeals has dismissed an appeal filed by the Turkish Patent Institute (TPI) against a decision of the Ankara IP Court to allow the registration of the three-dimensional shape for chocolate packaging (Case 2007/1444 E. 2007/4132, March 8 2007).

Ferrero SpA filed an application to register the packaging of its FERRERO ROCHER chocolates as a three-dimensional mark for goods in Class 30 of the Nice Classification.

The TPI Trademarks Department Directorate rejected the application on the grounds that the packaging is descriptive of the goods in the application list and should be open for use by the public.

On appeal, Ferrero contended that:

- the packaging is distinctive enough to be registered as a trademark, even for goods in Class 30;
- the packaging's distinctiveness has been strengthened through years of effective use in the market; and
- the packaging has already been registered in Italy, Ferrero's country of origin, as well as some other members of the Paris Convention for the Protection of Industrial Property, Article 6*quinquies*(A) of which states that such trademarks cannot be rejected on the basis of descriptiveness.

However, the TPI Re-examination and Evaluation Board upheld the directorate's decision. Since all board decisions are final and binding for the parties, Ferrero decided to challenge the TPI's original decision through a cancellation action before the Ankara IP Court.

Following the advice of an expert panel, the court ordered the cancellation of the TPI decision to reject Ferrero's application. The court reasoned that:

- the shape applied for consists of an original design - not one that can be found everywhere;
- there is no connection between the box and the goods it contains; and
- the box's three-dimensional shape should be accepted for registration in consideration of its registration in Ferrero's country of origin, Italy, pursuant to Article 6*quinquies*(A) of the Paris Convention and relevant articles of the Turkish Trademark Law.

The TPI's appeal to the Court of Appeals failed, rendering the Ankara court's decision final and binding.

The appellate court's decision confirms that the three-dimensional shape of product packaging that does not feature any word elements may be registrable as a trademark in Turkey. It also shows that

the Turkish courts take the registration of a device mark in the applicant's country of origin as *prima facie* evidence of the registrability of the sign.