

# Implementation of the limitation of goods and services by the Turkish Patent and Trademark Office

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## TURKEY

Legal updates: case law analysis and intelligence

- The office provides an opportunity to limit the list of goods/services in terms of international trademark applications filed via WIPO
- However, it does not allow applicants to limit goods and services when it comes to national trademark applications
- This controversial approach eliminates a method commonly used by applicants to avoid potential disputes

### Limitation of goods/services

The Turkish Patent and Trademark Office ('office') [applies the Nice Classification](#) for the classification of goods and services in the registration process of national and international trademarks.

Undertakings try to avoid possible conflicts by, for example, restricting their trademarks to the area in which they operate and/or differentiating the goods and services within the scope of their trademark from those covered by earlier similar trademarks. In other words, undertakings aim to circumvent the trademark rights and fields of activity of others by 'limiting' the scope of their trademarks, so that they can prevent a likelihood of confusion and co-exist in the market, even if the signs are similar.

### A different approach for national and international applications

In terms of international trademark applications filed via WIPO, the office provides an opportunity to limit the classes of goods/services for which registration is sought and register trademarks for very specific goods/services; however, it may not grant the same opportunity for national trademark applications.

For example, in a decision rendered in February 2022, the office stated:

“

*[I]t has been requested to add 'all of the aforesaid goods for school or curriculum-based training purposes only' at the end of the commodities. The main purpose of the limitation of the goods, which indicates a limitation on the goods and services that may cause confusion, is to prevent a likelihood of confusion between two trademarks due to similarity and agreement. ... [T]he above-mentioned phrase is not in the form of a limitation on the list of goods in the trademark application, but in the form of an **explanation**. In addition, it has been determined that how the goods will be used is at the initiative of the buyer, not the producer, so the referred limitation request does not result in a limitation on the trademark. By adding general expressions to the trademarked goods, no limitation can be made on the goods as a whole.*

”

With this decision, the office rejected the applicant's limitation request, stating that the aim of the request was not to prevent a likelihood of confusion between the two trademarks. An appeal has been filed, emphasising the settlement agreement signed by the parties and the will of the parties - especially that of the trademark owner, who requested the limitation. The appeal is still pending before the board.

In a decision issued in 2021, the office stated as follows:

“

*[I]t has been determined that the phrase '**none of the above-mentioned services in relation to access control products, video intercom products, audio intercom products, surveillance products, cameras including but not limited to digital cameras, network cameras, web cameras and IP cameras, video encoders, video decoders, network document servers, print servers, network video products, radars, speakers, microphones, software and accessories for the above-mentioned products**' has been requested to be added at the end of the list of goods and services. The main purpose of the limitation of goods is either to reach an agreement or to prevent a likelihood of confusion between two trademarks due to similarity. ... [T]he above-mentioned phrase is not related to the entire list of goods and services covered by the trademark application and does not restrict all of the requested list. Therefore, no limitation can be made by **adding general terms** to the trademarked goods.*

”

The applicant's limitation request was rejected on the ground that the request did not seek to prevent a likelihood of confusion between two trademarks and that the applicant could not apply for a limitation by adding general terms.

As exemplified by the above decisions, the office does not allow applicants to limit goods and services when it comes to national trademark applications, while goods and services can be limited for international trademark applications. This creates a disparity between these two types of registration.

For instance, contrary to the aforementioned decisions, when the scope of international applications is reviewed, one may see that they have been published in the *Official Trademark Bulletin* without being rejected *ex officio* by the office and/or encountering any obstacles with regard to the list of goods and services, as below:

- “Pharmaceutical preparations; pharmaceutical preparations **in the field of dermatology**; pharmaceutical preparations **for use with skincare**; pharmaceutical preparations **for the treatment of immune-related inflammatory diseases**; pharmaceutical preparations **for the treatment of atopic dermatitis and prurigo nodularis**” in Class 5.
- “...remote controls for wireless controlling, and/or programming wireless charger apparatus for wireless energising and control stations for wireless controlling, programming and/or energising to and from active implants; apparatus, instruments and devices for collecting, receiving, sending, storing, preparing, controlling, analysing and processing of data and/or energy to and from patients and/or to or from remote controls, wireless loading apparatus and control stations, **other than for medical use**; software, **in particular for active medical implants**, for measuring, receiving, sending, checking, transferring, calculating, processing, controlling, presenting and analysing data, electricity and/or energy; software, **in particular for measuring, receiving, sending, checking, transferring, calculating, processing, controlling, presenting and analysing data, electricity and/or energy**; data processing equipment and computers” in Class 9, and services “... **in particular intended for persons having a medical-related condition and/or candidates for, or being operated with, an active or a non-active implant**” in Class 44.
- “Adhesives (for commercial purposes), **in particular for fixing, sealing and support mats made of plastic material**” in Class 1 and “paper, cardboard and goods made from these materials, namely, printed matter; bookbinding material, photographs, stationery, adhesives **for stationery or household purposes**” in Class 16.

In examining the requests for limitation of goods and services in international applications, in parallel with the limitation requests subject to the abovementioned office decisions, it is determined that the requests for limitation of goods and services are accepted for:

- "Printed matter; books; booklets; bookmarks; calendars; stationery; handbooks; paperweights; pencil cases; pencil and pen holders; pliers; periodicals; printed publications; writing instruments, writing materials; **all aforementioned goods unrelated to the travel, transport and hospitality industries**" in Class 16.
- **"Computer software for use in financial affairs and electronic transactions in the fields of banking and financial services, except software for vehicle insurance services related to the recording and collection of various data on vehicles and vehicle travel; manuals in electronic form in connection with computer software and peripherals in the fields of banking, insurance and other financial services, except manuals for vehicle insurance services related to the recording and collection of various data on vehicles and vehicle travel"** in Class 9 and **"advertising, marketing and sales promotion, in the fields of software and digital banking and financial services, business management services, business administration services, office functions, all the aforementioned services in the fields of banking, insurance and other financial services, except services for vehicle insurance services related to the recording and collection of various data on vehicles and vehicle travel"** in Class 35.

Again, without any request by the parties, the office amended *ex officio* the list of goods of a given application in a specific case, "except for the goods produced in the relevant X origin". In other words, the office limited the goods on its own initiative and decided to conclude the dispute in that way - whether the office has the authority to do so would be the subject of another discussion.

### Comment

In summary, the office allows international applications to be limited to specific goods/services and, in some cases, limits the list of goods/services *ex officio* - even though it is not within its authority. Nonetheless, the office does not allow goods/services to be restricted in national applications, even where there is an explicit request by one of the parties, particularly the applicant. This approach creates controversial situations and also blocks a method for preventing possible disputes that undertakings frequently resort to. Further, it eliminates the possibility of agreement/reconciliation and co-existence between the parties; this contradicts the obligation of mediation in both civil and criminal actions, as well as Article 19/4 of the IP Code, which states that "the office, if it considers it necessary, may encourage the parties to reconciliation".

In addition, the will of the parties, which is one of the basic principles of private law, is ignored in such decisions. Arguably, the acceptance of limitations allows applicants to register their trademarks only for the goods and services that they will actually use, and ensures that the registry is cleaner and more reliable. By interpreting limitation requests more broadly, the office could light the way for undertakings seeking to avoid potential disputes.

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