

**IP Court: foreign registrations should be taken into account during examination**  
**Turkey - Gün + Partners**

**Examination/opposition  
National procedures**

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In a recent decision, the Third Civil IP Court of Ankara has made a detailed examination of the distinctiveness and descriptiveness of a trademark, and cancelled the refusal of the Turkish Patent Institute (TPI) based on a strong reasoning. Arguably, the decision - in which the court also interpreted the impact of foreign registrations for the same trademark - sets an important precedent for similar cases.

The applicant's trademark application for AIRCRUISE BIONICS, which is registered in various jurisdictions including the United States and the European Union, was refused by the TPI on the grounds that it was not distinctive and was descriptive for goods in Class 12. The TPI came to this conclusion simply by stating that the word 'aircruise' means some kind of vehicle that enables transport via air, while the word 'bionics' is the name of a science field that examines living organisms and applies its findings to man-made systems. Arguably, such examination was insufficient, as the TPI did not actually take into consideration the overall perception of the trademark and the impact of foreign registrations for the same trademark.

The applicant appealed against the decision, arguing that its trademark should not be deemed to be non-distinctive and descriptive, especially as it owned several foreign registrations for the same trademark, even in English-speaking countries. The appeal was also rejected by the TPI, and a civil cancellation action was initiated against the TPI.

In its decision, the Civil IP Court first interpreted the meaning of both of the words making up the trademark; it also divided the first word into two parts and considered whether the meaning of these English words would be understood by the average consumer. While accepting the possibility that the average consumer may understand the meanings of these words separately, and even accepting that there was a slight possibility that the trademark could directly mean "bionics for air vehicles" for some consumers (although this could barely leave an actual image in the minds of the average consumers), the court found that the trademark could not be deemed to be directly descriptive of goods in Class 12.

Further, the court rightly interpreted the impact of the foreign registrations submitted to the file, emphasising that these registrations should be taken into consideration since foreign authorities had also evaluated the trademark's distinctiveness and descriptiveness in countries where English is more commonly used or is the native language.

During the examination process conducted by the TPI, the foreign registrations for the subject trademark were also brought forward by the applicant in order to support its application. Unsurprisingly, the TPI used its usual argument that these foreign registrations were not binding and that it was entitled to make its own evaluation. The TPI also insisted on this point during the court trial; however, the court accurately considered the impact of the foreign registrations and confirmed that, while these were not directly binding on the TPI, the latter should have acknowledged that descriptiveness and distinctiveness are facts that do not change depending on the jurisdiction. Thus, the evaluation of descriptiveness and distinctiveness in English-speaking jurisdictions should have been taken into account.

In addition, although the TPI did not mention Article 7/1(d) of the [Trademark Decree Law](#) (which states that signs that are commonly used in an area of trade cannot be registered as trademarks), the court examined *ex officio* the trademark application in light of that article and concluded that the application could not be refused based on Article 7/1(d) either. The court stated in its reasoned decision that the absolute grounds for refusal under Article 7 shall be examined *ex officio* not only by the TPI, but also by the IP courts. The court thus ruled on another possible absolute ground for refusal of the applicant's trademark, and potentially avoided not only additional workload both for the TPI and for itself, but also delays and additional costs for the applicant.

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Gün + Partners acted for the applicant in this case

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