

New communiqué on classification of retail services in Class 35 enters into force

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The Turkish Patent Institute (TPI) has introduced an amendment to the Communiqué Concerning the Classification of Trademark Applications (BIK/TPE 2007/2). The new communiqué entered into force on October 19 2011 upon its publication in the *Official Gazette*.

Since 1999, the TPI had not accepted sector-specific identifications in Class 35. Even if the applicant limited the description of the services to a certain sector, the TPI changed the wording to “bringing together a variety of goods in various sectors”. However, international registrations designating Turkey constituted an exception, as the TPI accepted them even if they covered specific goods, groups of goods or sectors. This resulted in problems in the registration of identical or similar national trademarks in different sectors and inconsistencies in the examination of national and international trademarks. For example, if a textile company applied to register a national trademark in Classes 25 and 35, and another company engaged in the food sector owned the same national mark in Classes 30 and 35, the mark could not be registered in Class 35 even if the sectors were different.

The landmark decision of the European Court of Justice (ECJ) in *Praktiker* (Case C-418/02) caused the Office for Harmonisation in the Internal Market to change its practice with respect to the classification of retail services in Class 35. The ECJ stated that the objective of the retail trade is to sell goods to customers and that this trade includes, in addition to sales transactions, all activity carried out to encourage the customers to buy. The ECJ also stated that, for the purposes of registering a trademark for retail services, it is not necessary to specify in detail the services in question; however, details must be provided with regard to the goods or types of goods to which the services relate.

The *Praktiker* decision and the dynamics of the retail trade have led the TPI to change its rules regarding retail services in Class 35. The TPI held a meeting immediately after the entry into force of the communiqué and informed the public about the changes. During the meeting, it was stated that, with respect to the absolute grounds for refusal under Article 7(1)(b) of the Turkish Trademark Decree-Law, a trademark application covering the "service of bringing together a variety of goods, enabling customers to conveniently view and purchase those goods" will not be considered to be similar to a trademark which covers the same services in a different sector. In addition, it was stated that a trademark application covering a specific sector (eg, textile) in Class 35 will not be considered to be similar to an identical trademark covering another sector in Class 35 (eg, cosmetics).

With respect to Article 8(1)(b) of the regulation (which prevents the registration of confusingly similar trademarks), if two trademarks cover services within specific sectors, the similarity of these specific sectors will be examined separately.

Consequently, following the adoption of the communiqué, identical or similar trademarks can be registered in Class 35 if they cover different sectors and the specifications are different. It is believed that, pursuant to the amendment, the number of refusals based on identical or indistinguishably similar earlier trademarks or trademark applications for identical or similar goods will decrease as far as Class 35 services are concerned. Similarly, the number of oppositions is expected to decrease in cases where the applicant specifies the particular goods and sector for its Class 35 services - provided that the owner of an identical or similar earlier mark covering services in Class 35 in a different sector makes a wise decision and does not oppose the application.

The downside is that trademark owners and applicants who had registered/filed a trademark for Class 35 services before the entry into force of the communiqué will not be allowed to make changes to the specification of their registrations/trademark applications.