

## **BEST BUY recognized as well known**

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The Ankara Court of Intellectual and Industrial Property Rights has reversed a decision of the Turkish Patent Institute (TPI) in which the latter had refused to register the trademark BEST BUY on absolute grounds (Case 2007/227, Decree 2008/82, March 27 2008).

Best Buy Enterprise Services Inc, a US company engaged in the business of selling consumer electronics, applied for the registration of the trademark BEST BUY (and design) with the TPI for services in Class 35 of the Nice Classification ("gathering various goods in order to enable consumers to examine and purchase them at their convenience"). The TPI rejected the application on absolute grounds under Article 7(1)(c) of the Trademark Decree Law. Article 7(1)(c) stipulates that the following signs shall not be registered:

*"trademarks which consist exclusively of signs or indications that serve in trade to indicate the kind, characteristics, quality, quantity, intended purpose, value or geographical origin, or to designate the time of production of the goods or rendering of the services or other characteristics of the goods or services."*

The TPI reasoned that the phrase 'best buy' indicates the characteristics of the services covered by the application.

Best Buy appealed to the Re-examination and Evaluation Board, arguing that the trademark should be assessed as a whole. Best Buy further argued that since the trademark was well known in the United States and had a reputation in Turkey within the relevant sector, it had acquired distinctiveness through use in Turkey. Therefore, the mark should be protected under Article 7, which reads as follows:

*"The provisions of Subparagraphs (b), (c) and (d) above may not be invoked to refuse the registration of a trademark that has been used before registration and, through such use, has acquired distinctive character in relation to the goods and services for which it is to be registered."*

Best Buy also relied on precedents of the Court of Appeals, under which trademarks that are well known under Article 6bis of the Paris Convention for the Protection of Intellectual Property are also protected under Article 7 of the Trademark Decree Law.

The Re-examination and Evaluation Board dismissed the appeal on the grounds that the phrase 'best buy' indicates the characteristics or purpose of the relevant services in Class 35. Moreover, the board held that although the trademark was used and had a reputation abroad, it lacked distinctive character in Turkey since no company conducted business in this country under the BEST BUY mark.

Best Buy appealed to the Ankara Court of Intellectual and Industrial Property Rights. The court determined that the phrase 'best buy' does not have a general use in the course of trade with respect to the relevant services in Class 35. Additionally, the court concluded that the average consumer would be able to distinguish the services provided by Best Buy from those of other service providers. Further, the court determined that although the trademark was not used in Turkey as of the application date, it was a well-known trademark within the meaning of Article 6*bis* of the Paris Convention. Therefore, the court concluded that the trademark was registrable for services in Class 35 under Article 7 of the Trademark Decree Law.

The decision demonstrates a new approach to the application of Article 7(1)(c): the court will examine whether the mark is generally used in the course of trade with respect to the relevant goods and services. Further, the decision confirmed that actual use in Turkey is not required for a mark to be recognized as well known if the trademark is well known within the relevant sector in Turkey.

The TPI has appealed the decision. It remains to be seen whether the Court of Appeals will agree with the lower court's interpretation of Article 7(1)(c).