



PTO issues important decision on distinctiveness of trademarks consisting of device element and descriptive words

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TURKEY

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- The Trademarks Directorate refused an application for a mark consisting of a device and the phrase 'Clinical Trial Center' due to a lack of distinctiveness
- The REEB upheld the applicant's appeal, concluding that the phrase was not the main element of the mark
- The device element was sufficient to render the mark distinctive

The Re-examination and Evaluation Board (REEB) of the Turkish Patent and Trademark Office (PTO) has overturned a first-instance decision issued by the Trademarks Directorate and allowed registration of a composite mark consisting of a device element followed by descriptive words.

Background

Clinical Trial Center Srl applied for the registration of the mark depicted below for services in Classes 42 and 44:



At first instance, the Trademarks Directorate of the PTO rejected the application due to a lack of distinctiveness under Articles 5/1-b and 5/1-c of the [IP Law \(No 6769\)](#), which stipulates the absolute grounds for refusal.

On appeal, the applicant argued that its mark was inherently distinctive and produced evidence of registrations for the mark obtained in other countries that are members of the [Paris Convention for the Protection of Industrial Property](#) and the [Agreement on Trade-Related Aspects of Intellectual Property Rights](#). The applicant stated that, pursuant to established precedent of the courts, this provided concrete evidence that its mark was registrable.

With reference to inherent distinctiveness, the applicant argued that the device element should be considered sufficient to provide distinctiveness to the mark when evaluated as a whole. Therefore, it was not right to disregard the device element and approach the mark as if its main element was the phrase 'Clinical Trial Center'. In addition, the applicant argued that Turkish consumers should not be expected to perceive 'Clinical Trial Center' as descriptive.

Decision

Applying the general examination criteria to the case, the REEB upheld the applicant's appeal. In particular, with regard to the examination criteria applied to composite marks consisting of device and word elements, the REEB stated as follows:

“ *In determining the distinctiveness of trademark applications containing both word and device elements, the criteria taken as a basis for other types of trademarks should be taken into consideration. If the device and word elements are combined in an extraordinary way and in a way that makes the trademark distinctive, the application gains distinctive character. If a figurative element with exclusive distinctive characteristics is used in the foreground in the trademark or in a way that can be noticed at first glance, the trademark as a whole will gain distinctive character. However, the registration of a trademark in this situation does not provide the applicant with an exclusive right to use the non-distinctive word element.* ”

Based on the above, the REEB concluded that, even though the phrase 'Clinical Trial Center' was descriptive of the services covered by the mark, that phrase was not the main element of the mark. The device element provided distinctiveness to the mark and, therefore, the application could not be rejected under Articles 5/1-b and 5/1-c of the IP Law.

Comment

The REEB's decision sheds light on the criteria for the examination of composite trademarks in terms of inherent distinctiveness. It shows that the size and position of the elements constituting the trademark are important factors in concluding that a distinctive device element is the dominant and main element of the mark and that, therefore, the application would not be considered descriptive based on its word element. The decision also recognises that registration would not provide exclusive rights to the trademark owner over the descriptive word element.



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