

## Higher Board corrects implementation of goods and services limitations in landmark decision

Güldeniz Doğan Alkan and Cansu Evren

Gün + Partners

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### TURKEY

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- The Higher Board recognised that stricter conditions apply to the limitation of goods and services for national applications compared to international applications filed via WIPO
- The limitation applications rejected by the Trademarks Department were in accordance with the law and should have been accepted
- The decision emphasises that parties should be encouraged to resolve disputes through amicable agreements

### Background

The Trademarks Department of the Patent and Trademark Office [tends to reject requests to limit the scope of goods and services](#) covered by a trademark either by finding that such limitation is too vague, or by interpreting it as aiming to limit the purpose of use by consumers, which is not possible to restrict.

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

“ It 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. ... The 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 to the trademarked goods. ”

Although both the applicant (which had filed the above limitation) and the opponent (which had agreed to end the dispute in exchange for such limitation) approached the examiner, the latter explained that the limitation was too vague, did not cover all the goods and services covered by the application and was not in the form of a limitation. The applicant and the opponent, aiming to resolve the dispute amicably, co-drafted an appeal petition explaining as follows:

- The limitation was not vague and sought to differentiate the applicant's activity field from that of the opponent.
- Various international applications filed via WIPO, which included similar limitations, were not found problematic by the Trademarks Department and proceeded to registration.
- The present limitation was necessary due to the settlement agreement between the parties and ended the dispute between them.

## Higher Board decision

The Higher Board, in a decision issued on 20 January 2025, stated as follows:

“ It is understood that the request for limitation of goods and services made by the applicant can be considered as narrowing the scope of the initial list of goods and services and as a voluntary limitation ... [I]t is considered that the list of goods and services subject to the limitation request does not contain general expressions and terms, and that the scope of the list of goods and services to be registered with this limitation is not vague; on the contrary, it is unambiguous, clearer and understandable by third parties and the office. Furthermore, it is considered that the request does not expand the scope of the initial list of goods and services. Therefore, it is clear that, if the trademark is registered with these limitations, the scope of protection of the trademark will not be extended. In this context, it is concluded that the list of goods and services subject to the request for limitation is appropriate in terms of the procedures and principles of classification. ”

Indeed, the applicant states that the [limitation request]... was made within the framework of the agreement made with the company opposing the publication of the trademark to amicably settle the dispute. Considering the provisions of Articles 19(4) and 21(3) of the IP Code, in inter partes proceedings, the office encourages the parties to resolve the disputes through amicable agreements. Thus, here, the parties' own rights and interests are the priority, not the public interest. In cases where the parties are unable to amicably resolve the dispute, the office will resolve the dispute with a decision on the merits.

On the other hand, the Trademarks Department considers international trademark applications under the Madrid Protocol, which are filed for very specific goods/services and do not contain general expressions and terms, and which are organised in accordance with the Nice Classification, to be appropriate...; however, for applications filed nationally, it often rejects post-application limitation requests by subjecting them to stricter conditions...

In view of the above considerations, the board is of the opinion that the application does not extend the scope of the initial list of goods and services, does not lead to a change in the existing class codes or number of classes, does not contain general expressions or terms, and is not vague in scope; on the contrary, its scope is clear and understandable for the competent authorities and third parties... [Therefore,] the decision of the Trademarks Department to reject the voluntary request for limitation of goods and services, which was not related to the complete exclusion of certain goods or services from the list (partial withdrawal of the application), but only limited the scope of the existing goods or services by restricting them to certain sectors or areas of activity, or by excluding certain sectors or areas of activity, was not issued appropriately. ”

## Comment

The appeal filed against the Trademarks Department's decision was unique, which is why the Higher Board took almost 10 months to issue a decision. However, as the outcome of the case was groundbreaking, it was worth the wait. Indeed, the Higher Board's decision constitutes a milestone in various respects.

First, the fact that the limitation request was not vague and did not seek to expand the scope of the goods and services – but, on the contrary, sought to restrict it – was established. Therefore, the Higher Board's decision, if adopted by the Trademarks Department in future cases, is a pioneering ruling.

Second, the Higher Board's recognition of the differences in implementation in terms of national and international trademark applications bears great importance, providing hope that such discrimination will come to an end.

Third, the Higher Board emphasised that the office encourages parties to resolve disputes through amicable agreements, which is also promoted by law, and that the office should act accordingly. As alternative dispute resolution is currently a hot topic and a preferred legal remedy around the world, the office's emphasis on this matter shows its progressive approach.

Following this decision, it is expected that the Trademarks Department will change its implementation of limitation requests. Even if the Trademarks Department unjustifiably rejects a limitation request by applying stricter conditions, it may be possible to overturn the decision before the Higher Board. It will be interesting to see whether the present decision is adopted within the office and whether the Trademarks Department will apply it *ex officio*.

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## Güldeniz Doğan Alkan

Partner

Gün + Partners

[Guldeniz.Dogan@gun.av.tr](mailto:Guldeniz.Dogan@gun.av.tr)

[View full biography](#)

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## Cansu Evren

Associate

Gün + Partners

[cansu.evren@gun.av.tr](mailto:cansu.evren@gun.av.tr)

[View full biography](#)