

Change in Turkey Trademark Practice

Mohammed Ali - Senior Associate - Intellectual Property
m.ali@tamimi.com - Dubai International Financial Centre

In a recent development, the Turkish Trademark Registry has revised its practice in terms of prosecuting trademark application in class 35 covering 'sales services'. In light of this change, a trademark which is identical or closely similar to an already registered trademark for 'sales service' under class 35, may be available to a third party for use and registration in class 35 for 'sales services' if the product group is made specific.

To clarify further, the specification of service namely,

"the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods",

included in class 35 of the Nice International Classification of Goods and Services for Trademark Registration, is broad enough to cover the sales services related to any products group. So, under the existing practice, if a trademark is registered for 'sales services' covering the above specification of service (which is general in terms of product group) in class 35, a subsequent trademark identical or closely similar to the prior one by a third party will be refused. Based on the newly introduced change in practice however, such a subsequent trademark (identical or confusingly similar to the prior trademark) by a third party will be accepted for registration, if the specification of service depicted above specifies the product group. All such subsequent identical or closely similar trademarks will also be accepted for registration, as long as the specification of sales services for each trademark specifies different product group.

For example, if a trademark is registered in class 35 covering the services "the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods", an identical or closely similar trademark will still be registered for the above sales services, if the product group is specified namely, "the bringing together, for the benefit of others, of confectionery products, enabling customers to conveniently view and purchase those goods". Likewise, other identical or confusingly trademark will also be registered for sales services pertaining to another product group namely, health care products, and so on.

In light of this changed practice, we strongly advise the trademark owners those who have trademark protection in Turkey in class 35 for 'sales services' in general terms to file new application for their trademarks specifying the product group they are interested or trading in. This will help the trademark owners to protect their marks from being registered in the name of third parties for 'sales services' of their specific product group, even if the trademark owners hold a registration for the mark in class 35 (for sales services in general terms).

It has been made clear by the authorities that in the new practice, application for amendment of the specification of services of the previous applications in view of this change will not be accepted.