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Ayça Pinar Eren and Gözde Çolak discuss the application of the Nice classification system in Turkey.

The Nice classification is based on the Nice Agreement (1957), which established a classification system of goods and services for the purposes of registering trademarks and service marks. Some 82 states and trademark offices of more than 147 countries are party to the Nice Agreement. The International Bureau of WIPO, the African Intellectual Property Organization (OAPI), the African Regional Intellectual Property Organization (ARIPO), the Benelux Office for Intellectual Property (BOIP), and the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) of the European Communities all use the Nice classification system. It enables trademark owners to file applications in various countries with reference to a single classification system.

Nice Agreement has been in force in Turkey since January 1, 1996, although it was first signed on December 18, 1958. However, progress in the area of intellectual property has been improving, resulting in a rise in public awareness. In addition, the Turkish Patent Institute has taken important steps in accordance with actions aimed at providing harmonisation with European Union legislation. In order to prevent misleading applications—especially regarding applications that are filed for all goods and services in a related class—the sub-classification system was repealed as of January 1, 2007, in order to limit the applications to goods and services that are directly related with the business interest of the applicant. However, some degree of limitation is still required for specification of goods and services. The Nice explanatory notes to each class provide the guidelines for this limitation.

There are some confusions and misleading applications, especially with respect to class 35, since class 35 covers all kinds of sales services. Unlike the WIPO application, class 35 is considered separately in Turkey and this leads to unfair consequences. The separate identity of this particular class not only creates unfair advantages but also misleads the consumer. There are further problems arising from the treatment of class 35 as a totally independent class with regard to the main interest of goods and services. In this respect, allowing the registration of a trademark solely in class 35 gives an exclusive right to the first applicant. It also causes the ignorance of the goods and services in the other classes that indicate the main business area. The previously registered mark in class 35 would not only bar the registration of a trademark facilitating use in another business area, but would also bar the ability to enjoy the protection and rights arising from registration. To give an example from the official records of the Turkish Patent Institute, the previously registered trademark 'anil' for underwear (classes 25 and 35) had been an obstacle for the trademark 'anil', which seeks registration for 'automotive spare parts' (classes 12 and 35), since they both mention class 35 in their list of goods. By contrast, in Japan, the application of class 35 is different since the sales services are detailed according to the different kinds of goods and services. Similarly, in the US, a specified and detailed form of list of goods is required for each class.

Another gap in this system arises from the trademarks that are directly related with class 35, since sales services are the main line of business of companies such as supermarkets.

Since their primary facilitating area is the sales service industry, it is certain that they need to be registered in class 35. However, according to this approach, the goods and services should be clearly specified. Moreover, it should be emphasised that this approach would not apply to well-known trademarks, since the protection provided for well-known trademarks should be evaluated in a broader sense.

In the light of the explanations given above, it is clearly not appropriate to translate the classification system word for word. Therefore, while evaluating the goods and services of a trademark, similar goods and services should be included within the evaluation as well as the identical goods and services. In accordance with this view, the Turkish Patent Institute has been issuing decisions in which the similarity of goods and services are strongly emphasised. Hence, it should be realised that the Turkish Patent Institute has been focusing just as closely on the criterion of 'similarity' as on the 'identical nature' of the goods and services regarding classification.

In addition to the evaluation of the identical nature and similarity criteria, it is important to rely on the specific goods and services while determining likelihood of confusion between the marks. Accordingly, evolutions based only on International Class numbers would be insufficient. At this point, it should be emphasised that limiting the goods and services and not applying for an entire class for registration is very important for raising public awareness of intellectual property rights. Additionally, the system makes it easier for trademark owners to obtain registrations and protect their rights.

**THEREFORE,
WHILE EVALUATING
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Therefore, it is recommended that Turkish Patent Institute should act in accordance with a certain limitation in the recitation of goods and services covered by the application rather than accepting the entire class for registration. Accordingly, the categories should be determined according to the minimum requirements and special circumstances of each case. For instance, in one case, the class heading may be sufficient; whereas in another, a specification, for example, 'leather goods' would be needed. In yet another case, the subclass might need to be determined as 'bags'. This restriction would also allow the acceptance of similar trademarks registered for the same class but for different goods and services. Obtaining broad registrations may also cause problems in terms of cancellation proceedings based on non-use. Within this aspect, it is also important to mention that there are no co-existence agreements, consent agreements or declarations of acceptance in Turkish law. In other words, even if the owner of the previously registered mark gives consent for another registration in the same class but for different goods, it would not be valid under Turkish law. Hence, the only way for an applicant to register their trademark under these circumstances would be in the event of a cancellation of the previously registered mark based on non-use or real ownership, assignment, or purchase of the previously registered trademark, depending on the case. As a result, even if two identical or similar trademarks are accepted as existing in the same/similar class for different goods and services, they are not allowed or recognisable according to Turkish law. The underlying idea within this approach is the protection of the consumer. Accordingly, even if the owners of the trademark agree on co-existing, it would not eliminate the risk of consumer confusion. However, this issue should be examined from

different point of views in order to reach the most efficient solution. On one hand, there is a lack of protection for consumers owing to a possible risk of confusion. On the other hand, the rights of the trademark holders are limited. Hence, hindering the ability to exercise the rights of the trademark owners may have unfair consequences and would hinder the awareness of intellectual property rights and their importance. Especially after the abolition of the sub-classification system, the need for recognition of co-existing agreements has grown. Although it is very difficult and complicated to keep the balance between the consumers and the trademark owners, both sides of the issue should be examined very carefully to encourage the healthy growth of competition in society. Accordingly, although the co-existence agreement should be recognised with an amendment to the Turkish law, such an agreement should occur without confusing the public.

The application of the classification system is very important regarding the registrability of marks and the scope of protection. Although, today, many countries apply the Nice classification system, there are differences in application of the system according to the legislation of the respective countries. Accordingly, despite differences in countries' legislations, it is very important to provide harmonisation regarding the applications of the classification system in order to protect the rights of the trademark owners and the consumers. In this regard, even though many important steps have been taken in terms of harmonisation, the Turkish system has some gaps, which may prove misleading to the public. Accordingly, at least some degree of limitation of goods and services is required instead of accepting an entire class for registration. Besides, the applications regarding class 35 should be clarified in order to prevent confusion in the public and to protect the rights of the trademark owners. It is also strongly recommended that the directly related goods and services with the main line of business of the applicant should be specified. Moreover, while determining the similarity of the marks, not only should the similarity of classes be considered but also that of specific goods and services, since International Class numbers are insufficient for an accurate evaluation. Furthermore, the co-existence agreements or consent agreements should exist within the Turkish legislation since the prior trademark owner may evaluate the conditions of the market and the risk, provided that there are no further grounds for refusal and that registration of the latter trademark would not confuse the public. With the recent developments, together with efforts to provide the compliance to European Union legislation, there has been significant

progress in the area of intellectual property in Turkey. More importantly, the public's awareness is rising rapidly and issues relating to intellectual property are rising up the agenda.

Ankara Patent Bureau can be found at
www.ankarapatent.com.



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Ayça Pinar Eren graduated from Ankara Law School in 1996 and was admitted to Ankara Bar Association in 1997. She is an expert in the area of intellectual property, having presented on this topic at several conferences in Turkey. Mrs. Eren, with 10 years of experience leads a group that provides advice on all IP topics especially infringement and counterfeiting. Besides her many memberships, she joined the local group of AIPPI Turkey.



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Gözde Çolak graduated from Bilkent University Law Faculty with an MBA degree. She finished her internship at White and Case LLP, Istanbul office. Ms. Çolak was admitted to Ankara Bar Association in 2008 and now she is one of a select group of attorneys in Turkey with experience of being an international arbitrator. She is also a member of several groups such as INTA committee related to Internet Use, AIPPI Turkey and The Harvard Model United Nations Human Rights Committee. She is also involved in several projects including "Franchise Contracts" and "Commercial Transactions".

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