

**TURKISH PATENT INSTITUTE
TRADEMARK DEPARTMENT**

**PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING
THE INTERNATIONAL REGISTRATION OF MARKS**

Notification of a refusal of pretection based on an opposition pursuant to Rule 17(3) of the Common Regulations.

Our Reference : 2015/12595 / EA

2015-OE-468728

23.10.2015

I- Name and address of the Office making the notification:

**TURKISH PATENT INSTITUTE
Trademarks Department
Hipodrom Caddesi No: 115
06330 Yenimahalle ANKARA
TURKEY**

Telephone:+90 312 3031000

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II- The international registration which is subject to refusal:

1132742 şekil

III- Name and address of the holder of the international registration which is subject to the refusal:

**BIRKENSTOCK SALES GMBH
Rheinstrasse 1053560 Vettelschoss, GERMANY**

IV- Name and address of the opponent:

**CHILI FOOTWEAR, S.L.
Calle De Barcelona, 5, 03158 Catral, Alicante SPAIN
The opposition has been filed on 19.06.2015**

V- Grounds for refusal based on an opposition:

☒ **Article 7 (a)** signs which do not conform with the provisions of Article 5,
(*Article 5 - A trademark , provided that it is capable of distinguishing the goods and services of one undertaking from the goods and services of other undertakings, may consist of all kinds of signs being represented graphically such as words, including personal names, designs, letters, numerals, **shape of the goods or their packaging** and similarly descriptive means capable of being published and reproduced by printing.*)

Evrak bilgisine <http://www.tpe.gov.tr> adresinden "xyqlgB8DA6B2" DYS No ve Evrak tarihinden erişebilirsiniz.

"e-imzalıdır"

VI- Provision of the Decree-Law No.556 pertaining to the Protection of Trademarks: **Article 8**

(The relevant provisions to the Turkish Trademarks Act are enclosed.)

VII- (i) ☒ **Refusal for all the goods and services.**

(ii) ☐ Refusal for some of the goods and services:

VIII- GENERAL INFORMATION:

Appeals may be lodged against the refusal of the Institute.

The holder of the international registration may lodge an appeal against this refusal. The appeal has to be lodged through the intermediary of a representative who must be registered as a trademark agent at TPI and who is domiciled in Turkey. The appeal must be received by the Turkish Patent Institute no later than 2 months after the notification date of this refusal by WIPO to the applicant or his representative. If no appeal is received within this time limit, the designation will be considered as refused protection in Turkey accordance with this refusal.

If the designation is accepted subsequent to appeal, the designation will be published in the Turkish Official Trademark Bulletin. This allows – 3 months from the date of publication – a party to file an opposition, which means that the designation may be the subject of a further refusal.

IX- Notification Date of Refusal (dd/mm/yyyy): 23.10.2015

X – Signature by the Office : TURKISH PATENT INSTITUTE
TRADEMARKS DEPARTMENT

Evrin
AKYÜREK DEMİRİZ
Trademark Examiner

Number of continuation sheets:

**RELEVANT SECTIONS OF THE
DECREE-LAW NO.556 PERTAINING TO
THE PROTECTION OF TRADEMARKS**

**Sign of Which a Trademark May Consist and Means Whereby a Trademark is
Obtained**

Signs of Which a Trademark May Consist

Article 5 - A trademark , provided that it is capable of distinguishing the goods and services of one undertaking from the goods and services of other undertakings, may consist of all kinds of signs being represented graphically such as words, including personal names, designs, letters, numerals, **shape of the goods or their packaging** and similarly descriptive means capable of being published and reproduced by printing.

Trademark may be registered along with the product or the packaging. However, the registration of the product or the packaging does not grant exclusive rights.

Absolute Grounds for Refusal for Registry of a Trademark

Article 7 - Following signs shall not be registered as a trademark:

- a) signs which do not conform with the provisions of Article 5,
- b) **trademarks identical or confusingly similar with a trademark registered earlier or with an earlier date of application for registration in respect of an identical or same type of product or services,**
- c) trademarks which consist exclusively of signs or indications which serve in trade to indicate the kind, **characteristics**, quality, intended purpose, value, geographical origin, or designate the time of production of the goods or of rendering of the service or other characteristics of goods or services,
- d) trademarks which consist exclusively of signs and names used to distinguish specific groups of craftsmen, professionals or tradesmen or have become customary in the current and established practices of the trade,
- e) signs containing the shape of the product which results from the nature of the good, which is necessary to obtain a technical result or which gives substantial value to the good,
- f) trademarks which are of such a nature as to deceive the public, such as to the nature, quality, place of production or geographical origin of the goods and services,
- g) trademarks which have not been authorised by the competent authorities and are to be refused pursuant to Article 6ter of the Paris Convention,
- h) trademarks containing badges, emblems or escutcheons other than those covered by Article 6ter of the Paris Convention which have not been authorised by the competent authorities and are of particular historical and cultural public interest,
- i) trademarks which have not been authorised by their owners, well known marks according to 6bis of the Paris Convention,

j) trademarks which contain religious symbols,

k) trademarks which contrary to public policy and to accepted principles of morality.

The provisions of (a), (c) & (d) can not be invoked to refuse the registration of a trademark which has been used before the registration and has acquired through this usage distinctive character in respect of the goods and services for which it is to be registered.

Relative Grounds for Refusal for Registration of a Trademark

Article 8 - Upon opposition by the proprietor of an application for registration of a trademark or of a registered trademark, the trademark applied for shall not be registered under following conditions:

a) If the trademark applied for is identical with a registered trademark or a trademark that has an earlier application date and the protection is sought for the identical goods and services,

b) If because of its identity with or similarity to a trademark which has an earlier application date or a registered trademark and because of the identity or similarity of the goods and services covered by the trademarks there exists a likelihood of confusion on the part of the public and the likelihood of confusion includes the likelihood of association with the registered trademark or with the trademark which has an earlier application date.

Upon opposition by the proprietor of a trademark, a trademark shall not be registered where an agent or representative of the proprietor of the trademark has applied for registration thereof his own name without the proprietor's consent and without a valid justification.

Upon opposition by the proprietor of a non-registered trademark or of another sign used in the course of trade, the trademark applied for shall not be registered provided that;

a) the rights to the sign were acquired prior to the date of filing for registration of the trademark, or the date of priority claimed for the application for registration,

b) the sign confers on its proprietor the right to prohibit the use of a subsequent trademark,

A trademark applied for which is identical or similar to a registered trademark or to a trademark with an earlier filing date may be used for different goods and services. However, where in the case of a registered trademark or of a trademark which has an earlier filing date for registration, the trademark has a reputation and where the use without due cause of trademark applied for would take unfair advantage of, or be detrimental to the distinctive character or repute of the registered trademark or of the trademark with an earlier application date, upon opposition by the proprietor of the earlier trademark, the trademark applied for shall not be registered even to be used for goods and services which are not similar to those for which the earlier trademark is registered.

Upon opposition by the holder of the relevant right, the trademark applied for shall not be registered if it contains the name, photograph, copyright, or any industrial property rights of the third parties.

Upon opposition, trademark applied for which is identical or similar to a collective or a guarantee mark shall not be registered within three years from the date of expiry of the collective or of the guarantee mark.

Trademark applied for which is identical or similar and which is to be registered for the identical or similar goods and services of a trademark which has not been renewed, upon opposition shall not be registered within two years of the expiry date.

Observations by Third Parties

Opposition

Article 35 - Notices of opposition to the registration of trademark on the grounds that it may not be registered under the provisions of Article 7 and 8, and notices of opposition on the ground that there exists bad faith in the application shall be submitted within three months of the publication of the application. -12- The opposition made under the last paragraph of Article 8 shall be refused if the opposing party does not use his trademark during this period. Oppositions must be submitted in writing and contain the arguments. Institute may request further facts, evidence and documents to be complied within the period prescribed in the Implementing Regulation. Where the additional facts, evidence and documents requested are not submitted within the period prescribed by the Implementing Regulation the opposition shall be deemed to have not been made.

Appeals Against the Decisions of the Institute

Appeals

Article 47 - Appeals may be placed against the decisions of the Institute. Where an appeal is made for an interim decision, a separate appeal shall be allowed upon decision becoming final.

Persons Entitled to Appeal

Article 48 - Any party adversely affected by a decision of the Institute may appeal. Others party to the procedures with respect to the decisions shall have natural right of appeal

Form of Appeal

Article 49 - Notice of appeal must be filed in writing at the Institute within two months after the date of notification of the decision. The fee for appeal has to be paid when filing of the notice for the appeal to be examined. The grounds for appeal must be filed in a written statement within two months of the notification of the decision. Where the statement of grounds for appeal has not been submitted within this period the appeal shall be deemed not to have been filed.

Rectifying a Decision

Article 50 - The related department of the Institute upon deciding that the appeal is true and right may rectify its decision. This shall not apply where the appellant is opposed by another party to the proceedings.

If the appeal is not found acceptable by the related department, the appeal shall be forwarded to the Re-examination and Evaluation Board by the department without comment as to its merits.

Examination of Appeals

Article 51 - The Re-examination and Evaluation Board shall consider the appeal if the appeal is admissible.

The Re-examination and Evaluation Board shall invite the parties to submit their observations within the period prescribed by the Implementing Regulation, on the observations of the other parties or those of itself.

Decision in Respect of Appeal

Article 52 - After the examination, the Re-examination and Evaluation Board shall deliver its decision.

Classification

Article 24 - The goods and services in the respect of the trademark to be registered shall be classified in conformity with the international classification of goods and services. The principles of classification shall be specified in the Implementing Regulation.

GUARANTEE MARKS AND COLLECTIVE MARKS

Guarantee Marks

Article 54 - A guarantee mark, under the control of the proprietor of the mark, serves the purpose of the guaranteeing the common characteristics of the undertakings, production methods, geographical sign and quality of those undertakings.

Collective Mark

Article 55 - Collective mark is a mark used by a group of undertakings of producers or traders or providers of services.

Collective mark serves the purpose of distinguishing the goods and services of the undertakings belonging to the group from the goods and services of the other undertakings.

Technical Regulations of the Guarantee and Collective Marks

Article 56 - When filing an application for registration of a guarantee or a collective mark, a regulation specifying the ways and means of using the mark must be filed.

The guarantee mark regulation shall contain provisions regarding the common characteristics of the goods and services under guarantee and supervision procedures as to the use of the mark and the penalties to be administered when necessary.

The collective mark regulation shall specify the undertakings authorised to use the mark. Proprietors of a collective mark shall act collectively for the registration of a collective mark.

Application by one of the parties shall be sufficient for the renewal of a collective mark.

Amending the Technical Regulations

Article 57 - Technical regulations cannot be altered unless approved by the Institute.

Any changes to be made in the technical regulations where they are in violation of the second and third paragraphs of Article 56 or contrary to public policy and principles of morality shall be rejected by the Institute.

Regulations in Violation of the Decree Having the Power of Law

Article 58 - Where a technical regulation does not conform to the requirements of Article 56, Institute shall notify the proprietor of the mark to undertake the necessary alterations. Where the proprietor of the mark does not make the changes requested and alter the regulation accordingly the request for the registration of the collective mark or the guarantee mark shall be rejected.

Use in Violation of the Technical Regulation

Article 59 - Where the proprietor of a mark disregards a use of a collective or a guarantee mark which constitutes a violation of the technical regulation, and neglects to remedy the infraction within the time determined by the court in respect of an action brought by one of the parties, the mark shall be repealed by the court.

Transfer and Licensing

Article 60 - The transfer or licensing of a guarantee mark or a collective mark shall become valid only after entry in the Trademark Register.

Persons Authorized to Act and Trademark Agents

Persons Authorized to Act

Article 80 - The following are authorised to act before the Institute with respect to trademarks:

- a) natural or legal persons who have filed the application. Legal persons may only be represented by those duly empowered by their respective authorised bodies.
- b) trademark agents.

Those who are domiciled outside the country can only be represented by trademark agents.

Where an agent has been appointed, all procedures are executed through the agent. All notices made to the agent shall be considered to have been made to the assignee.