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Turkish appeals court finds for applicants by overturning longstanding *ex officio* refusal practice

Turkey - [Kenaroğlu Intellectual Property](#)

- The Court of Appeals has held that the Re-examination and Evaluation Board cannot expand the scope of an *ex officio* refusal to the detriment of the applicant
- The decision overturns established practice at the Patent and Trademark Office
- Applicants can now appeal *ex officio* refusals safe in the knowledge that they can no longer receive a less favourable decision

A decision by the Turkish Court of Appeals has overturned longstanding practice and provided fresh confidence for trademark applicants trying to challenge *ex officio* refusals by the Turkish Patent and Trademark Office (TPO).

Background

Applications filed before the TPO are subject to *ex officio* examination based on absolute grounds of refusal (eg, lack of distinctiveness, identity or indistinguishable similarity to a senior trademark, misleading features or having immoral meaning) set out in Article 5 of Industrial Property Law.

Partial or total *ex officio* refusals can be appealed before the office's Re-examination and Evaluation Board. Before this latest decision, the board held that it was entitled to do any of the following when evaluating the grounds for an appeal:

- reverse *ex officio* decisions in favour of the applicants;
- reject appeals; or
- expand the scope or the grounds of the refusal, thus turning the original *ex officio* refusal into a less favourable decision.

Decision

In the case at hand, an application for the EUROPATENT mark was *ex officio* and partially rejected by the TPO based on lack of distinctiveness with regard to some of the goods and services applied for. Upon the applicant's appeal against this partial refusal, the board not only rejected the grounds for the appeal, but in fact changed the partial refusal into a total refusal by adding two more *ex officio* refusal grounds, namely:

- the mark contained a non-monopolised word, which should remain open to public use; and
- the mark had a misleading feature.

The applicant launched a cancellation action before the Civil IP Court, but this was also rejected in favour of the TPO. The applicant appealed again, this time before the Turkish Court of Appeals, which had the final say in the matter. However, this court held that the board could not expand the scope or the grounds of the first *ex officio* refusal decision to the detriment of the applicant and should thus examine the case within the limits of the applicant's appeal grounds. The appeal court emphasised that enlarging the refusals' scope could lead to applicants facing worse scenarios at the end of appeal process which, in turn, has a chilling effect on applicants challenging *ex officio* refusals.

Comment

The appeal court's decision signals an entirely new approach and sets a significant precedent in Turkish practice, as it removes authority from the Re-examination and Evaluation Board for expanding the scope or the grounds of the first *ex officio* refusals and enables right holders to use their appeal rights before the board free of fear that they might receive a less favourable decision at the end of the appeal process.

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