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## The Criterion of Genuine Use for the Recognition of Vested Right Claims based on a Prior Trademark

In its decision dated 21.12.2022 and numbered 2021/5302 E.(Merits), 2022/9311 K.(Decision), the 11th Civil Chamber of the Court of Cassation upheld the Regional Court of Appeal's decision regarding a refiled trademark application that because the plaintiff could not prove genuine use in class 44, a vested right in the plaintiff's favor over the "M..." trademark was not constituted.

On June 07, 2013, a trademark application was filed for the registration of the trademark "M..." in all classes from 01 to 45.

Following the publication of the trademark application in the Official Trademark Bulletin, the plaintiff, who is the owner of several trademarks with the "M..." phrase, requested the refusal of the entirety of the trademark application on the basis that they had relied on these trademarks.

In its decision, the Turkish Patent and Trademark Office ("the Office") Re-examination and Evaluation Board ("REEB") partially refused the trademark application for class 44 "Medical services. Beauty care services. Veterinary and animal husbandry services. Agriculture, horticulture and forestry services" on the grounds that the trademark application creates a likelihood of confusion with one of the "M..." formative trademarks.

In filing a cancellation action against this decision, the applicant claimed, among other arguments, that he is the owner of a prior trademark registration for "M..." which covers the services in class 44, and that prior trademark registration constituted a vested right in his favor concerning subject trademark application, and requested the cancellation of the Office's decision.

In defense, the defendant claimed that the conditions of Article 8/1(b) of the Decree Law No. 556 were met and since the plaintiff had not been using the "M..." trademark, a vested right had not been constituted for the plaintiff, and requested the dismissal of the court action.

The Court of First Instance determined, that the trademark application was for a serial trademark in class 44 that corresponded to the plaintiff's "M..." trademark which included class 44; that the plaintiff's earlier trademark incorporated the phrase "M..." in its entirety, and that the plaintiff's latest trademark application included the same services in class 44 as those covered by the earlier trademark to which the case also pertained.



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The Court accepted the plaintiff's vested rights claim and ordered the cancellation of the Office's related decision on the grounds that it was no longer appropriate to accept the claims and defenses raised by the defendant that "the plaintiff [had] not been using the trademark "M...". Following the decision, the defendant filed for the cancellation of the "M..." trademark due to non-use upon the annulment of Article 14 of the Decree Law No. 556 by the Constitutional Court.

The attorneys for the defendant Office and company filed an appeal against the decision of the Court of First Instance.

Having evaluated that there is a likelihood of confusion between the "M..." trademark application subject to the case and the "M..." formative trademark, which was the grounds for partial refusal in class 44, and that the plaintiff could not prove the use of the "M..." trademark for services in class 44, the Regional Court of Appeal reversed the decision of the Court of First Instance on the grounds that the trademark "M..." did not constitute vested rights for the plaintiff. The 11th Civil Chamber of the Court of Cassation upheld this decision with its decision dated 21.12.2022 and numbered 2021/5302 E.(Merits), 2022/9311 K.(Decision).

The decision of the Court of Cassation shows that one of the elements to be taken into account in the assessment of the existence of a vested right should be the use of the trademark on which the vested right is grounded, and sheds light on the importance of not only having a trademark registration but also the use of the trademark for trademark owners.

This decision provides guidance for trademark owners in assessing which trademark(s) could serve as a basis for vested rights arguments to avoid adverse consequences in opposition or litigation proceedings.