



ICLG

The International Comparative Legal Guide to:

Trade Marks 2018

7th Edition

A practical cross-border insight into trade mark work

Published by Global Legal Group, with contributions from:

Acapo AS

Arent Fox LLP

Baptista, Monteverde & Associados,
Sociedade de Advogados, SP, RL

BarentsKrans

Bolet & Terrero

Borenus Attorneys Ltd

Bouwers Inc.

BSA Ahmad Bin Hezeem
& Associates LLP

Camilleri Preziosi Advocates

Daniel Legal & IP Strategy

DelosLegal

DunnCox

East & Concord Partners

Ehrlich, Neubauer & Melzer (EN&M),
The Ehrlich Group

Fukami Patent Office, P.C.

Gorodissky & Partners (Ukraine)

Gowling WLG

Grupo Gispert

Gün + Partners

HSM IP Ltd.

Hule Bachmayr-Heyda Nordberg
Rechtsanwälte GmbH

International Trademark Association
(INTA)

J.D. Sellier + Co.

JurisAsia LLC

Kadasa Intellectual Property

KOREJZOVA LEGAL v.o.s.

Koushos Korfiotis

Papacharalambous LLC

Law Offices of Patrinos & Kilimiris

LCA Studio Legale

Lee International IP & Law Group

LLC "Card Patent"

Lydian

McCullough Robertson

Miller Thomson LLP

Nater Dallafior Rechtsanwälte AG

OLIVARES

Patentna pisarna d.o.o.

Pham & Associates

PORZIO · RIOS · GARCIA

S. P. A. Ajibade & Co.

Shearn Delamore & Co.

Sołtysiński Kawecki & Szlęzak

Subramaniam & Associates (SNA)

SyCip Salazar Hernandez

& Gatmaitan

Synch Advokat AB

TIPLO Attorneys-at-Law



Consulting Editor
Kate Swaine,
Gowling WLG

Sales Director
Florjan Osmani

Account Director
Oliver Smith

Sales Support Manager
Toni Hayward

Editor
Nicholas Catlin

Senior Editors
Suzie Levy
Caroline Collingwood

Chief Operating Officer
Dror Levy

Group Consulting Editor
Alan Falach

Publisher
Rory Smith

Published by
Global Legal Group Ltd.
59 Tanner Street
London SE1 3PL, UK
Tel: +44 20 7367 0720
Fax: +44 20 7407 5255
Email: info@glgroup.co.uk
URL: www.glgroup.co.uk

GLG Cover Design
F&F Studio Design

GLG Cover Image Source
iStockphoto

Printed by
Ashford Colour Press Ltd
May 2018

Copyright © 2018
Global Legal Group Ltd.
All rights reserved
No photocopying

ISBN 978-1-912509-06-5
ISSN 2049-3118

Strategic Partners



General Chapters:

1	Embracing Evolving Opportunities for Brand Owners and the Trade Mark Community – Tish Berard, International Trademark Association (INTA)	1
2	Brands and the Digital Age – Kate Swaine & George Sevier, Gowling WLG	6

Country Question and Answer Chapters:

3	Albania	DelosLegal: Ardit Loloci	10
4	Australia	McCullough Robertson: Belinda Breakspear & Peter Stokes	18
5	Austria	Hule Bachmayr-Heyda Nordberg Rechtsanwälte GmbH: Emanuel Boesch	25
6	Belgium	Lydian: Annick Mottet Haugaard & Maroussia Verhulst	35
7	Bolivia	Bolet & Terrero: Juan Ignacio Zapata	44
8	Brazil	Daniel Legal & IP Strategy: Robert Daniel-Shores & Roberta Arantes	53
9	Canada	Miller Thomson LLP: Catherine M. Dennis Brooks & David Reive	64
10	Cayman Islands	HSM IP Ltd.: Sophie Davies & Huw Moses	73
11	Chile	PORZIO · RIOS · GARCIA: Cristóbal Porzio & Marcelo Correa	81
12	China	East & Concord Partners: Charles (Chao) Feng	90
13	Cyprus	Koushos Korfiotis Papacharalambous LLC: Eleni Papacharalambous & Georgia Charalambous	99
14	Czech Republic	KOREJZOVA LEGAL v.o.s.: Dr. Petra de Brantes	108
15	Finland	Borenus Attorneys Ltd: Åsa Krook & Ben Rapinoja	115
16	France	Gowling WLG: Céline Bey & Clémence Lapôtre	122
17	Germany	Gowling WLG: Manuela Finger & Ines Lin	134
18	Greece	Law Offices of Patrinos & Kilimiris: Maria Kilimiris & Manolis Metaxakis	145
19	India	Subramaniam & Associates (SNA): Hari Subramaniam & Aditi Subramaniam	153
20	Israel	Ehrlich, Neubauer & Melzer (EN&M), The Ehrlich Group: Yehuda Neubauer & Keren Rubinstein	162
21	Italy	LCA Studio Legale: Monia Baccarelli & Federica Furlan	172
22	Jamaica	DunnCox: Joanne Wood Rattray & Kelly Akin	181
23	Japan	Fukami Patent Office, P.C.: Yoshitake Kihara & Miki Tomii	191
24	Korea	Lee International IP & Law Group: Mi-Cheong Lee & Robert M. Kim	198
25	Malaysia	Shearn Delamore & Co.: Karen Abraham & Janet Toh	205
26	Malta	Camilleri Preziosi Advocates: Henri Mizzi & Sharon Xuereb	216
27	Mexico	OLIVARES: Alonso Camargo & Daniel Sanchez	223
28	Netherlands	BarentsKrans: Jaap Bremer & Jos Klaus	232
29	Nigeria	S. P. A. Ajibade & Co.: John Chike Onyido & Yetunde Okojie	240
30	Norway	Acapo AS: Kjersti Rogne & Kjersti Staven-Garberg	248
31	Philippines	SyCip Salazar Hernandez & Gatmaitan: Vida M. Panganiban-Alindogan & Enrique T. Manuel	255
32	Poland	Sołtyński Kawecki & Szlęzak: Dr. Ewa Skrzydło-Tefelska & Karol Gajek	264
33	Portugal	Baptista, Monteverde & Associados, Sociedade de Advogados, SP, RL: Filipe Teixeira Baptista	272
34	Russia	LLC “Card Patent”: Olga Krivelskaya & Svetlana Obida	279
35	Saudi Arabia	Kadasa Intellectual Property: Mohammad Jomoa & Asif Iqbal	286
36	Singapore	JurisAsia LLC: Sheena Jacob & Li-Ming Goh	296
37	Slovenia	Patentna pisarna d.o.o.: Irena Kadunc & Vesna Kovič	304
38	South Africa	Bouwers Inc.: Deon Bouwer & Adele Els	312
39	Spain	Grupo Gispert: Sönke Lund & Eric Jordi	319
40	Sweden	Synch Advokat AB: David Leffler & My Byström	328

Continued Overleaf ➔

Further copies of this book and others in the series can be ordered from the publisher. Please call +44 20 7367 0720

Disclaimer

This publication is for general information purposes only. It does not purport to provide comprehensive full legal or other advice. Global Legal Group Ltd. and the contributors accept no responsibility for losses that may arise from reliance upon information contained in this publication. This publication is intended to give an indication of legal issues upon which you may need advice. Full legal advice should be taken from a qualified professional when dealing with specific situations.



Country Question and Answer Chapters:

41	Switzerland	Nater Dallafior Rechtsanwälte AG: Dr. Mathis Berger & Dr. Martin Rauber	336
42	Taiwan	TIPLo Attorneys-at-Law: J. K. Lin & H. G. Chen	344
43	Trinidad & Tobago	J.D. Sellier + Co.: Ariane Ramnath & Kimberleigh Peterson	355
44	Turkey	Gün + Partners: Uğur Aktekin & Güldeniz Doğan Alkan	362
45	Ukraine	Gorodissky & Partners (Ukraine): Nina Moshynska	371
46	United Arab Emirates	BSA Ahmad Bin Hezeem & Associates LLP: Nadim Bardawil	382
47	United Kingdom	Gowling WLG: Kate Swaine	389
48	USA	Arent Fox LLP: Michael A. Grow & James R. Davis, II	400
49	Vietnam	Pham & Associates: Pham Vu Khanh Toan	408

Turkey

Uğur Aktekin



Güldeniz Doğan Alkan



Gün + Partners

1 Relevant Authorities and Legislation

1.1 What is the relevant trade mark authority in your jurisdiction?

Trade marks have to be registered before the Turkish Patent and Trade Mark Office (“TURKPATENT”) according to Article 3/1(a) of the Law Pertaining to Establishment and Duty Principles of the Turkish Patent and Trade Mark Office.

1.2 What is the relevant trade mark legislation in your jurisdiction?

The Industrial Property Code numbered 6769 (“IPC”), which unites all IP rights – i.e. trade marks, patents, industrial designs, utility models and geographical indications – entered into force on January 10, 2017. However, pursuant to Provisional Article 1 of the IPC, whereas trade mark applications filed before January 10, 2017 are subject to the provisions of the Decree-Law until the finalisation of their registration procedure, trade mark applications filed after January 10, 2017 are subject to the provisions of the IPC. Thus, all responses to the below questions are as per the IPC provisions.

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

According to Article 4 of the IPC, signs such as words including personal names, shapes, colours, letters, numbers, sounds and the form of goods and packaging (if it is of a distinctive character which differentiates its goods or services) can be registered as trade marks.

2.2 What cannot be registered as a trade mark?

If a trade mark does not meet the conditions stated under Article 5 of the IPC (see question 3.1) and the definition stated under Article 4 (see question 2.1), it cannot be registered.

2.3 What information is needed to register a trade mark?

The applicant may apply for registration via the online system of TURKPATENT and should include the following, according to Article 5/2 of Regulation on the Implementation of the IPC:

- if the applicant is a real person, the first name and surname, and if he/she is a Turkish citizen, his/her Turkish ID number;
- if the applicant is a legal person, the identification information which includes the tax identification number (if Turkish) and the applicant’s address and other contact information;
- if the application is filed by a trade mark agent, the registration number, address and other contact information of the agent;
- information, if any, regarding the request of the right of priority;
- a sample of the trade mark which is suitable for reproduction by printing and publishing;
- if the letters used in the trade mark are not in the Latin alphabet, their equivalent in the Latin alphabet;
- the class numbers of the goods/services covered by the trade mark application according to the Nice Classification, and their list in accordance with these numbers;
- the e-signature of the authorised person(s), since applications are filed online;
- information regarding payment; and
- information, if any, on additional page numbers and attachments.

In addition to the abovementioned requirements, the following must be submitted with the application:

- information showing that the application fee has been paid;
- information, if any, showing that the fee regarding the request of priority has been paid; and
- technical regulation, if filed for a common trade mark or guarantee trade mark.

2.4 What is the general procedure for trade mark registration?

An application is subject to an *ex officio* examination by TURKPATENT on whether the application has any element mentioned in Article 5 of the IPC. Accordingly, upon the examination, it is published in the Official Trade Mark Bulletin, pending any third-party opposition, for a period of two months. If no opposition is filed, it is granted registration in the Trade Mark Registry and will be published in the Official Trade Mark Gazette. A decision rendered by the Trade Mark Department upon opposition can be appealed before the Re-examination and Evaluation Department (“the Board”) within two months as from the notification date. The decision of the Board can be subject to a cancellation action before the Civil IP Courts of Ankara. The IP Courts’ decision can be challenged before the District Court and, if the conditions stated in the Code of Civil Procedure are fulfilled, the decision of the District Court can be further appealed before the Court of Appeal.

2.5 How is a trade mark adequately represented?

The trade mark should be represented within 7cm × 7cm, in JPEG format (300 dpi).

A 3D mark should be represented from different angles within a maximum of six visual depictions, and it should be clearly stated that the application is for a 3D mark.

A sound mark should be represented as a recording available to be listened to on an electronic platform, and it also must be clearly stated within the application that the trade mark is a sound mark.

Similarly, a colour mark must be clearly stated within the application, must be claimed with an internationally recognised colour code, and the application must contain a sample of the colour which is the subject of the application.

Likewise, if the application is for an action mark, this must be clearly stated. The action mark should be represented by a visual description of the action, or a series of visual illustrations of its still or moving aspects.

2.6 How are goods and services described?

As per Article 11/3 of the IPC, goods and services are described under the Nice Classification.

2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

The protection of trade mark registration applies across Turkey.

2.8 Who can own a trade mark in your jurisdiction?

According to Article 3 of the IPC, citizens of the Republic of Turkey, i.e. both real and legal persons who are domiciled or who have industrial or commercial establishments within Turkey, and persons who have application rights resulting from the terms of the Paris Convention or the Agreement Establishing the World Trade Organization, can own a trade mark. Other than these, as per the reciprocity principle, real and legal persons who are entitled to trade mark protection by law or *de facto* within Turkey can own a trade mark.

2.9 Can a trade mark acquire distinctive character through use?

Article 5/2 of the IPC allows a trade mark to acquire distinctive character through its usage before registration.

2.10 How long on average does registration take?

The registration phase takes around six to eight months and it takes 10 months for the applicant to receive the trade mark certificate as of the application date, depending on the workload of TURKPATENT.

2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The official filing fee is around €60 per class and €175 for the issuance of the registration certificate, regardless of the number of

classes. Additionally, attorneys' fees should be considered, and may differ based on the market conditions.

2.12 Is there more than one route to obtaining a registration in your jurisdiction?

A trade mark application can be filed directly before TURKPATENT. Also, TURKPATENT is obliged to examine the international trade mark applications sent by WIPO according to the Madrid Convention on International Registration of Trade Marks.

2.13 Is a Power of Attorney needed?

No, this is not required.

2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

This is not applicable; please see question 2.13 above.

2.15 How is priority claimed?

Persons who are entitled to a right of priority can claim priority in Turkey by providing the relevant document showing that they have made a trade mark application in another Paris Convention member country or that they have displayed the goods/services at exhibitions. The priority should be claimed during the application and the related official fees should be paid. The relevant document showing the right of priority provided by the competent authority, translated by a sworn translator and notarised, should be submitted within three months as of the filing date.

2.16 Does your jurisdiction recognise Collective or Certification marks?

Article 32 of the IPC pertains to Collective and Certification (guarantee) marks.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

As per Article 5 of the IPC:

- (1) The following marks shall not be registered as a trade mark:
 - a. Marks which cannot be a mark within the scope of Article 4.
 - b. Marks which do not hold any distinctive qualification.
 - c. Marks which contain, exclusively or mainly, the marks or names which refer to a type, variety, qualification, quality, amount, purpose, value, geographic source or which show the time at which the goods are produced or the services are presented or indicate the other characteristics of the goods or services.
 - c. Marks which are the same as or non-distinctively similar to a trade mark which has been registered in relation to the same goods or services or goods or services of the same type or a trade mark for which a registration application has been filed on a previous date.
 - d. Marks which contain, exclusively or mainly, the marks or names used by everyone in the field of trade, or

which serve to distinguish those that belong to a specific professional, artistic or commercial group.

- e. Marks which are mandatory in order to obtain the form or another characteristic arising due to the nature of the merchandise or to obtain a technical result or exclusively comprise the form which gives the real value to the merchandise or another characteristic.
 - f. Marks which may mislead the public in topics such as the qualification, quality or the geographic source of the goods or services.
 - g. Marks to be refused as per Article 6ter of the Paris Convention.
 - ğ. Other marks which are not included into the scope of Article 6ter of the Paris Convention, but which are relevant to the public or have become public property in terms of historical and cultural values, and coats of arms, signs or names not granted a registration permit by competent authorities.
 - h. Marks comprising religious values or symbols.
 1. Marks violating public order or morality.
 - i. Marks composed of registered geographical indications or containing registered geographical indications.
- (2) If a trade mark has been used prior to the application date, and has been granted a distinctive qualification as a result of this use in relation to the goods or services constituting the subject matter of the application, it shall not be refused as per items (b), (c) and (d) of clause one.
 - (3) In the event that the notary-public-approved permit, indicating that the former proprietor explicitly consents to the registration of the application, is submitted to TURKPATENT, the application for trade mark registration shall not be refused as per item (ç) of clause one. The procedures and principles relating to the permit shall be designated by regulation.

3.2 What are the ways to overcome an absolute grounds objection?

If the trade mark is identical or highly similar to the senior registered trade mark, the applicant may obtain a letter of consent from the owner of the senior trade mark. The letter of consent must be issued as a signed form (sample form provided by TURKPATENT) and it must be notarised.

Secondly, if the trade mark earned a distinctive character through its use before its registration, it can be registered without getting rejected based on the conditions stipulated at (a), (c) and (d) of question 3.1.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Anyone affected by the decision can appeal the decision before the Re-Examination and Evaluation Department.

3.4 What is the route of appeal?

As per Article 20 of the IPC, the applicant may appeal the refusal decision of the Trade Mark Department's Directorate within two months as from the notification of the decision to the Board.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

The relative grounds for refusal are stipulated in Article 6 of the IPC. Accordingly, the owner of a trade mark registration/application can oppose a trade mark application if:

- The application is identical/similar to and covers the same/similar goods/services with the senior mark and this similarity causes the likelihood of confusion among the consumers.
- The application was filed by the commercial agent without the consent of the trade mark owner or a justified reason.
- The trade mark is well-known as per the Paris Convention, and covers the same/similar goods/services.
- The senior application/registration has a well-known status and use without due cause to believe that the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or well-known status of the senior registration/application in Turkey, even if the goods/services are different.
- The application consists of another right-holder's IP right, name, trade name, photograph, copyright, etc.
- The application is identical/similar to a collective or a guarantee mark and filed within three years from the date of expiry of the collective or guarantee mark.
- The application is filed within two years from the expiry date of the registration of a trade mark which is identical/similar.
- The applicant is acting in bad faith by filing its application.

4.2 Are there ways to overcome a relative grounds objection?

Counter-arguments (e.g. that trade marks are not similar; the owner of the trade mark application has an acquired right, etc.) can be claimed against relative grounds objections. Besides that, if the applicant gets in contact with the owner of the senior registration/application and settles in a limitation, the applicant may request for the partial withdrawal of the goods/services from the application and inform TURKPATENT in this regard. Additionally, invalidating the senior trade mark is an option.

Lastly, Article 19/2 of the IPC introduced another defence to overcome a relative grounds objection: upon a challenge by an applicant regarding a senior trade mark, i.e. one which is at least five years old as of its application, the senior trade mark owner must prove that the trade mark has been effectively used during the last five years in Turkey or submit evidence illustrating that non-use of the trade mark is caused by justifiable reasons. In case of failure to prove the abovementioned grounds, TURKPATENT will not take into account this trade mark when deciding on the opposition. If the senior trade mark owner proves the use just for a few classes, the remaining classes will not be taken into account by TURKPATENT.

4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Please refer to question 3.3.

4.4 What is the route of appeal?

Please refer to question 3.4.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

There are two basic grounds while opposing an application: absolute grounds (see question 3.1), which are examined *ex officio* by TURKPATENT, but can be claimed by third parties as well; and relative grounds (see question 4.1), which should be claimed by third parties.

5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Article 17 of the IPC states that anyone can file an opposition to the publication of an application.

5.3 What is the procedure for opposition?

Article 18 of the IPC states that oppositions can be filed within two months as of the publication of an application, in writing and including their reasons. Paying the fee for opposition in time and submitting the document which shows the payment is obligatory. The IPC states that the opposition will not be considered, unless the grounds of opposition are not submitted in time.

6 Registration

6.1 What happens when a trade mark is granted registration?

When a trade mark is granted registration, it is recorded and published in the Official Trade Mark Gazette.

6.2 From which date following application do an applicant's trade mark rights commence?

Article 23 of the IPC states that the protection of a registered trade mark starts on the application date. However, according to Article 12/6 of the IPC, if the application has a right of priority, the protection starts on the date when the ground (i.e. date of the exhibition) of the right of priority occurs.

6.3 What is the term of a trade mark?

The IPC determines that the term of a trade mark is 10 years from the date of application.

6.4 How is a trade mark renewed?

Registration can be renewed every 10 years. A trade mark can be renewed upon the request of the owner of the trade mark or the trade mark agent by paying the renewal fee. The renewal request shall be made up to six months before the expiration date and the information regarding the payment of the renewal fee must be deposited. The renewal can be made within six months from expiration by paying an additional fee.

7 Registrable Transactions

7.1 Can an individual register the assignment of a trade mark?

Individuals entitled to file a request before TURKPATENT can also register the assignment of a trade mark.

7.2 Are there different types of assignment?

There are no different types of assignment.

7.3 Can an individual register the licensing of a trade mark?

Individuals entitled to file a request before TURKPATENT can also register the licensing of a trade mark.

7.4 Are there different types of licence?

The IPC determines two types of licensing: exclusive licence; and non-exclusive licence (Article 24 IPC).

7.5 Can a trade mark licensee sue for infringement?

Pursuant to Article 158 of the IPC, exclusive licensees can sue for infringement unless otherwise stated in the agreement. The non-exclusive licensee, unless otherwise stated in the agreement, can sue for infringement as well, but with a notification to the trade mark owner.

7.6 Are quality control clauses necessary in a licence?

The IPC states that the licensor shall take the relevant precautions to guarantee the quality of the goods/services which will be provided by the licensee (Article 24 IPC). With reference to this Article, it is better for a quality control clause to be stated in a licence; however, even if it is not, the licensee still has to fulfil the quality requirements in accordance with the abovementioned provision.

7.7 Can an individual register a security interest under a trade mark?

Individuals entitled to file a request before TURKPATENT can also register a security interest under a trade mark.

7.8 Are there different types of security interest?

Article 148/1 of the IPC stipulates that trade marks can be given as security, pledged as security and distrained.

8 Revocation

8.1 What are the grounds for revocation of a trade mark?

According to Article 26/1 of the IPC, a trade mark can be revoked if:

- without any justifiable reason, it has not been genuinely used for five years after the registration or the use was suspended for an uninterrupted period of five years;

- the sign has become generic in terms of the goods/services covered by the trade mark, by the acts of the owner of the trade mark;
- the sign has become deceptive in the eyes of the relevant public in respect of the goods/services covered by the trade mark; or
- the collective or guarantee mark is disregarded by its owner for use contrary to the technical regulations, and the trade mark owner does not stop such violation within the period determined by Court as a result of an action brought by a party.

8.2 What is the procedure for revocation of a trade mark?

Until the entry into force of Article 26 of the IPC, which has been postponed by Article 192 until January 10, 2024, each revocation action initiated before January 10, 2024 has to be brought before the Turkish IP Courts. However, upon the entry into force of Article 26, TURKPATENT will have the jurisdiction to hear revocation actions. Additionally, a revocation action based on the non-use of a trade mark can only be commenced five years after the registration of the relevant trade mark.

8.3 Who can commence revocation proceedings?

Pursuant to Article 26/2 of the IPC, any party who has a legitimate interest may initiate the revocation action – not only the aggrieved party, but also relevant institutions which have a legitimate interest.

8.4 What grounds of defence can be raised to a revocation action?

The following defences can be raised to a revocation action:

- If an action is initiated on the basis of non-use, the defendant must demonstrate that the trade mark has been used during the five-year period concerned, or that there are justified reasons for non-use. If use is made in order to circumvent a non-use action, such use within three months preceding the filing of the action is disregarded.
- If an action is initiated on the basis that the trade mark is deceptive or generic, the defendant must demonstrate that the necessary steps were taken to prevent the trade mark from becoming deceptive or generic.

If an action is initiated on the basis that the usage of collective and guarantee trade marks is contrary to technical regulations, the defendant must demonstrate either that the usage is not contrary to technical regulations, or that such violation stopped within the period determined by the Court.

8.5 What is the route of appeal from a decision of revocation?

A party not pleased with the decision of revocation may appeal the decision within a two-week period as of the date of notification, before the District Court. The District Court has the authority to examine the decision on both procedural grounds and the merits of the case. After the District Court renders its decision, if a party is still not pleased with the decision and if the conditions of the Code of Civil Procedure are fulfilled, this decision may be appealed before the Court of Appeal, which is the third and final judicial authority. The Court of Appeal has the authority to examine the decision merely on procedural grounds.

9 Invalidity

9.1 What are the grounds for invalidity of a trade mark?

According to Article 25 of the IPC, invalidity grounds are absolute and relative grounds for refusal.

9.2 What is the procedure for invalidation of a trade mark?

An invalidation action should be filed before the IP Courts. Pursuant to Article 25/6 of the IPC, if the trade mark proprietor remained silent for five consecutive years even though he knew or should have known that the trade mark was used in a trade mark with a later date, he cannot claim his trade mark as a ground for invalidity unless the registration of the trade mark with the later date has been made in bad faith.

9.3 Who can commence invalidation proceedings?

Pursuant to Article 26/2 of the IPC, aggrieved persons, public prosecutors and other relevant official authorities have the power to initiate an invalidation action.

9.4 What grounds of defence can be raised to an invalidation action?

If the invalidation action is initiated on the basis of absolute or relative grounds of refusal, the defendant may try to illustrate that arguments and evidence provided by the claimant in order to prove the existence of absolute and/or relative grounds of refusal, are insufficient or unfounded.

If the invalidation action is initiated on the basis of bad faith, the defendant may try to illustrate that he was not in bad faith at the time of the application, or that evidence and arguments provided by the claimant in order to prove the bad faith are insufficient or unfounded.

9.5 What is the route of appeal from a decision of invalidity?

Please refer to question 8.5.

10 Trade Mark Enforcement

10.1 How and before what tribunals can a trade mark be enforced against an infringer?

According to Article 156 of the IPC, for civil law matters Civil IP Courts, and for criminal matters Criminal IP Courts, have jurisdiction to hear the dispute. If the proceedings are initiated by the owner of the right against third parties, the competent Court will be:

- where the plaintiff is domiciled;
- where the infringement is committed; or
- where the effects of the infringement are felt.

If the proceedings are initiated by third parties against the owner of the right, the competent Court will be where the defendant is domiciled. If the proceedings are initiated against TURKPATENT, the competent Courts will be the Courts of Ankara.

If the owner of the trade mark does not have a domicile in Turkey, the competent Courts will be at the place of business of the trade mark agent, as registered in TURKPATENT's records for that trade mark. If the record of the trade mark agent has been deleted, the competent Courts will be the Ankara Courts.

10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The legal action is essentially divided into three stages:

- The written stage (during which petitions are presented respectively by the claimant and the respondent, as follows: plaint petition; response petition; rejoinder; and reply to rejoinder).
- The preliminary hearing (the Court hearing at which procedural issues are discussed and the facts at issue are established).
 - During the preliminary hearing phase, the Judge guides the parties towards conciliation or mediation. If the dispute is resolved between the parties through one of these ways, the trial does not take place.
- The trial (at which the parties, witnesses and experts are heard and closing statements are given).
 - The trial cannot be commenced before the preliminary hearing is completed.

The proceedings take around one-and-a-half to two years before the first instance Court, and the decision is expected to be followed by an appeal of the losing party and a possible Court of Appeals phase, which may further extend the finalisation of the decision by around one-and-a-half to two years.

10.3 Are (i) preliminary and (ii) final injunctions available and if so on what basis in each case?

Although final injunctions are not available under Turkish law, interim injunctions are available and used quite often under Turkish law. A party is entitled to request an interim measure (either along with the main claim or, if there is urgency and the necessity for a rapid decision, separately) before the Court in order to ensure the effectiveness of the judicial decision.

10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

As per Articles 219 and 220 of the Code of Civil Procedure, upon the request for the disclosure of the relevant documents, if the Court determines that the document production request is legal and the document is in the counterparty's possession, the Court grants peremptory time for the counterparty to present the relevant documents. If the counterparty does not present the documents without any reasonable excuse, the Court – depending on the case – may draw adverse inferences against the counterparty because of non-production of the document.

10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

In both civil and criminal proceedings, submissions and evidence are generally presented in writing. Although cross-examination of witnesses is theoretically possible under Turkish law, considering

that the procedure is predominantly carried out via documents rather than oral hearings, it is very rare for the Court to decide to hear witnesses and conduct cross-examination.

10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

The Court before which the infringement action is brought has authority to decide whether to stay the proceedings until the other Court renders its decision regarding the validity of the trade mark. However, it should be stated that higher Courts almost never wait for the decisions of the first instance Courts regarding the invalidation. Finally, since Turkish Courts are not bound by the decisions of foreign Courts, they do not stay the proceedings even if a foreign Court has ruled that the trade mark is invalid.

10.7 After what period is a claim for trade mark infringement time-barred?

As per Article 72 of the Law of Obligations, a civil claim emanating from trade mark infringement must be time-barred two years from the day on which the action constituting infringement is learnt. Even if the infringing action is not learnt, in any event it is time-barred 10 years after the date on which the infringing action took place.

10.8 Are there criminal liabilities for trade mark infringement?

Pursuant to Article 30 of the IPC, any person who:

- manufactures, supplies, sells, offers for sale, exports, imports or purchases commercially, goods or services which infringe trade mark rights;
- removes a trade mark on any object subject to trade mark protection; or
- assigns, transfers or provides security on a trade mark without authorisation,

has criminal liability under Turkish law. If these actions are committed by legal persons, security measures specific to such legal entities will apply.

10.9 If so, who can pursue a criminal prosecution?

Criminal offences can only be prosecuted on a complaint by the owner of the trade mark or its exclusive licensee, within six months of becoming aware of the act and its perpetrator.

10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There is no provision relating to unauthorised threats of trade mark infringement under Turkish law.

11 Defences to Infringement

11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Unless the trade marks in question are identical, a defendant may argue that there is no likelihood of confusion between the senior

trade mark and the allegedly infringing sign. In addition, the existence of the below circumstances allows the defendant to claim no infringement:

- Reproduction of the trade mark in a dictionary, encyclopaedia or similar reference work.
- Use of the trade mark in accordance with honest practices in industrial or commercial matters.
- Exhaustion of the rights conferred by the trade mark.
- Genuine right of ownership.

11.2 What grounds of defence can be raised in addition to non-infringement?

In addition to procedural defences such as lack of legal interest or lack of jurisdiction, the defendant may also argue the invalidity of the trade mark in question as a counterclaim in the infringement case. Furthermore, Article 25 explicitly provides that unless the subsequent registration is filed in bad faith, a party who is aware or should be aware of the usage of the trade mark and remained silent for five years, cannot argue the invalidity of the subsequent trade mark (see question 9.2).

12 Relief

12.1 What remedies are available for trade mark infringement?

A party whose trade marks have been infringed may ask the civil Courts to order:

- Cessation of the acts of infringement and prohibition of the infringer from continuing the infringing acts.
- Compensation for monetary damages, for spiritual damages or for reputational damages.
- Securing of evidence.
- Determination of the infringing activities.
- Confiscation of infringing goods or means for their production, to the benefit of the trade mark owner.
- Transfer of the ownership of the goods.
- Deletion of the infringing trade mark of the goods or, if that is not possible, destruction of the goods.
- Publication of the decision (in whole or in part) at the infringer's expense in newspapers and magazines.

A party whose trade marks have been infringed may ask the criminal Courts to order, in particular:

- Against individuals:
 - Imprisonment.
 - Punitive damages.
- Against legal entities:
 - Security measures for legal entities.

12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Courts order the losing party to bear the legal expenses and to reimburse the winning party's official minimum attorneys' fees set by the Bar and updated every year. If a case is partially won or lost, the Courts allocate the legal expenses, including attorneys' fees, up to the extent of rightfulness of the parties.

13 Appeal

13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

A party not pleased with the decision of revocation may appeal the decision within two weeks from the date of the notification of the decision before the District Court. The District Court has the authority to examine the decision on both procedural grounds and the merits of the case. After the District Court renders its decision, if a party is still not pleased with the decision and if the conditions of the Code of Civil Procedure are fulfilled, this decision may be appealed at the Court of Appeal, which is the third and final judicial authority in the new ternary system of civil procedure. The Court of Appeal has the authority to examine the decision merely on procedural grounds.

13.2 In what circumstances can new evidence be added at the appeal stage?

As a general rule, it is forbidden to present new evidence at the appeal stage. However, there are two exceptions to this rule: presentation of the evidence at a later stage is not aimed at delaying the proceedings; and failure of assertion of the evidence in due time is not caused by the party's fault.

14 Border Control Measures

14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

As per Article 159/2(b) of the IPC, the customs authorities, upon the request of the owner of the trade mark right, may withhold the infringing products as an interim measure during exportation and importation.

Furthermore, Article 57 of the Customs Law restates that infringing goods/services can be withheld by the customs authorities upon request, and adds that these goods/services can also be withheld for three days, or held up at customs by the relevant authorities on their own initiative, if there is clear evidence regarding the violation of IP rights.

15 Other Related Rights

15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Turkish law provides limited protection for unregistered trade marks. Pursuant to Article 6/3 of the IPC, if the owner of the unregistered trade mark can prove that the trade mark in question is genuinely owned by him before the priority or application date of the trade mark application in question, the trade mark application cannot be registered.

15.2 To what extent does a company name offer protection from use by a third party?

As per Article 6/6 of the IPC, if there is an application involving someone else's trade name, upon opposition this trade mark application must be rejected.

15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Book titles, film titles and any other related rights may enjoy copyright if they fulfil the necessary requirements stated in the law.

16 Domain Names

16.1 Who can own a domain name?

Any real or legal person or partnership with a legal capacity can own a domain name.

16.2 How is a domain name registered?

Country code top-level domain names (“ccTLD”) have to be registered before the [Nic.tr](https://www.nic.tr) (“[.tr](https://www.nic.tr)” Domain Names) Administration at <https://www.nic.tr>. Accordingly, applications for registration of a domain name can be made online. There are two main restrictions on the registration of the domain name:

- Technical restriction:
 - The application must comply with the Articles of the Domain Name Regulation.
 - The requested domain name must not be owned by others.
- Legal restriction:
 - The requested domain name must not be listed in the non-delegable list (Article 6/1(e) of the Domain Name Regulation).
 - A trade mark application or trade name is required.

16.3 What protection does a domain name afford per se?

Although there is no special provision for the protection of domain names under Turkish law, they can be protected under: tort law, unfair competition rules and protection of the name (Article 26 of the Civil Code), depending on the identification and distinctiveness of the domain name; protection of the business name (Articles 52 and 53 of the Turkish Civil Code); and by the IPC if the domain name is registered as a trade mark.

17 Current Developments

17.1 What have been the significant developments in relation to trade marks in the last year?

- TURKPATENT published the Proof of Use Guidelines on April 28, 2017, after the non-use defence was enacted by the IPC. In order to clarify the use and functions of this new procedure, TURKPATENT issued an updated version of the guidelines on September 30, 2017.
- The IPC enables the implementation of the co-existence principle (see question 3.2).
- According to Article 19/2 of the IPC, during the opposition proceedings, if the applicant so requests and the trade mark on which the opposition is based has been registered in Turkey for at least five years before the application date of the opposed application, TURKPATENT must require the opponent to prove the genuine use of its trade mark in Turkey for the five years preceding the application date of the opposed application, or justify the reasons for non-use. Therefore, TURKPATENT

may now refuse an opposition if genuine use in Turkey of the trade mark in question cannot be proved. This can also be used as a defence in invalidation and infringement actions.

- According to Article 26/1(a) of the IPC, TURKPATENT will decide on revocation requests based on non-use. However, the enforcement date of this provision is postponed for seven years under the provisional Article 4 of the IPC and, until then, the right to revoke a trade mark due to non-use belongs to the competent IP Courts.
- The IPC therefore adopts the principle of international exhaustion, unlike Decree-Law No 556, which adopted the principle of national exhaustion.
- Finally, according to Article 155 of the IPC, a trade mark, patent or industrial design holder cannot rely on its registered right as a defence in an infringement action filed by a prior right-holder. Unlike what was stated in the Court of Appeal’s precedents, possessing a registration will not necessarily mean that there is no infringement.

17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

Decisions of the Turkish Court Of Appeal Regarding the Annulment of Article 14 of Decree-Law No 556

The annulment of Article 14 (the requirement to put trade marks to use) of Decree-Law No 556 entered into force on January 6, 2017. Thereafter, on January 10, 2017, just four days after the publication of the annulment decision, the IPC entered into force. The IPC reintroduces into Turkish trade mark law a legal ground for requesting the revocation of non-used trade marks where the grace period has expired, with similar wording to Article 14. Therefore, it is currently possible to file a revocation action against an unused trade mark registered for more than five years, under the relevant provisions of the IPC.

However, since Article 14 was annulled by the Constitutional Court just four days before the IPC entered into force, decisions regarding the revocation of unused trade marks of the Courts based on Article 14 and dated earlier than the publication of the annulment decision of Turkish Constitutional Court are all reversed, to be examined in the scope of the annulment of Article 14. Yet, as those decisions of the Court of Appeal do not mention what decisions the Courts should render about those actions, there is not yet a *stare decisis* among the Courts upon this matter, although almost all IP Courts rejected revocation actions that were filed before the entry into force of the IPC, based on the annulment of Article 14 of the Decree-Law.

Decisions of First Instance Courts Regarding the Annulment of Article 14 of Decree-Law No 556

Referring to the annulment of the Article 14 of Decree-Law No 556, there were some dismissal decisions dated after the publication of the annulment and rendered by countrywide first instance Courts and, based on that, there is no legal basis left after the abovementioned annulment of Article 14. Since first instance Courts had just started to render their decisions on this matter, District Courts have not decided upon their appeals yet. However, the ones that have been rendered by District Courts state that cancellation of trade marks because of non-use claims is not possible since the base article was annulled.

17.3 Are there any significant developments expected in the next year?

The uncertainty pursuant to the non-settled case law of the Court of Appeal and/or occasional decisions rendered by the first instance Courts will be clarified by a precedent on the annulment of Article 14 of the Decree-Law.

As for the occasional decisions of first instance Courts on the necessity of waiting five years to be able to file a non-use revocation case, since those decisions can be appealed before the District Court, the interpretation of the relevant articles of the IPC will come to light in more detail after the District Court renders its decisions.

Lastly, the implementation of the Proof of Use Guidelines mentioned in question 17.1 is expected to be settled by TURKPATENT.

17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

It has become general practice, after the IPC entered into force, for applicants to request that opponents prove the genuine use of their

trade marks in Turkey, if those trade marks have been registered in Turkey for at least five years before the application date of the opposed application.

Acknowledgment

The authors wish to acknowledge the kind assistance of their colleagues Pınar Arıkan, Doruk Altın and Betül Bakır in the drafting of this chapter.



Uğur Aktekin

Gün + Partners
Kore Şehitleri Cad. No. 17
Zincirlikuyu, 34394
İstanbul
Turkey

Tel: +90 212 354 0000
Email: ugur.aktekin@gun.av.tr
URL: www.gun.av.tr

Uğur Aktekin has been a Partner at Gün + Partners since 2000. He co-chairs Gün + Partners' IP and technology, media and telecommunications practices, which are internationally recognised as leading practices in Turkey. Mr. Aktekin specialises in advising on trade mark, design, copyright, information technology, patent, unfair competition, advertising and media law.

Within the intellectual property field, he provides counsel to local and multinational companies on prosecution, enforcement and litigation strategies and represents clients before the administrative bodies and the Courts. He currently supervises the Trademark and Design and IP Prosecution practices. He also advises on software copyright, data protection, database protection, data privacy and domain names. He has been involved in numerous anti-piracy campaigns, civil and criminal litigation and raids involving copyright.

Mr. Aktekin's practice has been recognised by various independent guides to the legal profession, including *Who's Who Legal*, *Chambers and Partners*, *The Legal 500*, *Expert Guides* ('Euromoney'), the *WTR 1000* and *Best Lawyers*.



Güldeniz Doğan Alkan

Gün + Partners
Kore Şehitleri Cad. No. 17
Zincirlikuyu, 34394
İstanbul
Turkey

Tel: +90 212 354 0000
Email: guldeniz.dogan@gun.av.tr
URL: www.gun.av.tr

Güldeniz Doğan Alkan is a Partner at Gün + Partners, specialising in intellectual property law. Her practice concentrates on trade mark, design, copyright, unfair competition and domain names.

She has been representing and advising many hotel management, food and textile companies and global technology companies in Turkey for trade mark litigation and full IP portfolio matters for more than 10 years.

Ms. Alkan has been included in *WIPR Leaders 2018* for trade marks. She is an active member of the International Association for the Protection of Intellectual Property, Pharmaceutical Trade Marks Group and International Trademark Association, and is a Board Member of the Patent and Trademark Attorneys' Association of Turkey.

GÜN + PARTNERS

AVUKATLIK BÜROSU

Gün + Partners is a full-service institutional law firm with an international and strategic vision, providing transactional, advisory and dispute resolution services.

The firm is one of the oldest and largest practices in Turkey, with over 70 lawyers, and is ranked among the top-tier legal service providers.

The firm is based in Istanbul, with working offices in Ankara, Izmir and all other major commercial centres in Turkey. It provides services to local and international companies throughout Turkey and assists clients worldwide through its established network of correspondents and contacts. The firm's lawyers are fluent in Turkish and English, and the majority also work in German, French and Russian.

The firm's core areas of expertise are corporate and commercial, dispute resolution and IP. It represents clients in numerous sectors, with a particular focus on life sciences, insurance and reinsurance, energy and natural resources, and technology, media and telecommunications.

The firm is member of the International Bar Association, International Trademark Association, Legalink, Biolegis, European Communities Trade Mark Association, International Association for the Protection of Intellectual Property, International Association of Privacy Professionals and Global Advertising Lawyers Alliance.

Current titles in the ICLG series include:

- Alternative Investment Funds
- Anti-Money Laundering
- Aviation Law
- Business Crime
- Cartels & Leniency
- Class & Group Actions
- Competition Litigation
- Construction & Engineering Law
- Copyright
- Corporate Governance
- Corporate Immigration
- Corporate Investigations
- Corporate Recovery & Insolvency
- Corporate Tax
- Cybersecurity
- Data Protection
- Employment & Labour Law
- Enforcement of Foreign Judgments
- Environment & Climate Change Law
- Family Law
- Fintech
- Franchise
- Gambling
- Insurance & Reinsurance
- International Arbitration
- Lending & Secured Finance
- Litigation & Dispute Resolution
- Merger Control
- Mergers & Acquisitions
- Mining Law
- Oil & Gas Regulation
- Outsourcing
- Patents
- Pharmaceutical Advertising
- Private Client
- Private Equity
- Product Liability
- Project Finance
- Public Investment Funds
- Public Procurement
- Real Estate
- Securitisation
- Shipping Law
- Telecoms, Media & Internet
- Trade Marks
- Vertical Agreements and Dominant Firms



59 Tanner Street, London SE1 3PL, United Kingdom
Tel: +44 20 7367 0720 / Fax: +44 20 7407 5255
Email: info@glgroup.co.uk

www.iclg.com