



GÜN+PARTNERS
AVUKATLIK BÜROSU

TRADEMARK LAW IN TURKEY

KEY DEVELOPMENTS AND PREDICTIONS

2023

TRADEMARKS AND DESIGNS

We provide wide ranging and comprehensive legal services in relation to trademarks and designs. Our comprehensive services include advisory, prosecution, watch, opposition, appeals, enforcement, litigation and transactional services on all aspects of trademarks and designs including registration and enforcement strategies, IP due diligences as well as availability searches and clearance opinions.

We are authorised to represent clients before civil and criminal courts, and court of cassation as well as all administrative authorities such as Turkish Patent and Trademark Office ("TURKPATENT"), customs, domain name authorities. Some of our lawyers are also qualified as trademark and patent attorneys authorised to act before TURKPATENT.

We regularly handle nullity and invalidity, cancellation, well-known trademark protection, anti-dilution, passing off, unfair competition and trade dress actions and large scale damages claims before courts as well as customs seizure applications and criminal and civil searches and seizures.

Combining our litigation, transaction and industry knowledge we draft, negotiate trademark and design related agreements and transactions including, manufacturing, toll-manufacturing, co-existence, co-promotion settlement and licensing agreements.

Trademark Law in Turkey: Key Developments and Predictions for 2023

2022 saw the effects of the pandemic on trademark law largely fade away.

Delays in litigation processes due to the excessive workload of the Courts of Intellectual and Industrial Property Rights continued to be the most critical problem for the protection of rights, particularly in infringement cases. This further highlighted the importance of administrative processes before the Turkish Patent and Trademark Office ("TURKPATENT").

Consequently, combating infringing or potentially infringing trademark applications effectively supervising the prosecution and opposition procedures before TURKPATENT from the very beginning has become critical to protecting brand owners' rights. As of 2024, the procedures before TURKPATENT will become even more important as trademark revocation procedures, including revocation due to non-use, will begin to be carried out before TURKPATENT. It is obvious that this development will significantly increase the workload burden on TURKPATENT.

With regards to technological developments, the impact of NFTs on trademark law, over which discussions were started in 2021, became even more critical in 2022.

The recent amendments to the Electronic Commerce Law are also important in combating trademark infringement on online platforms.

This study analyses the following issues in trademark law, which we consider to be important for brand owners:

- Recent Developments in TURKPATENT's Practice on Recording of Well-known Trademarks
- The Revocation Procedure of Trademarks to be Handled by TURKPATENT
- Is Partial Victory a Real Victory?
- A Precedent on 3D Trademarks' Enforcement
- Can the counterfeiters be acquitted solely on the grounds that the number of seized counterfeits is very low?
- Changes in the Amended E-Commerce Law for IP
- Non-Fungible Tokens (NFTs) and Trademarks
- A New Era in .tr Extended Domain Names - and a New Issue Waiting for a Solution

Recent Developments in TURKPATENT's Practice on Recording of Well-known Trademarks

We have previously reported on the Turkish Court of Cassation's decision concluding that the Turkish Patent and Trademark Office (hereinafter will be referred to as "TURKPATENT" or "the Office") has no authority to create and maintain a registry for well-known trademarks and discussed possible repercussions of this decision for trademark owners. (Please see <https://www.worldtrademarkreview.com/article/court-of-cassation-reopens-debate-recording-of-well-known-trademarks>)

The Turkish Court of Cassation's decision no. M. 2019/2980 D.2020/991 of February 5, 2020 has been finalized with the court of first instance's assenting decision. Although the plaintiff appealed the decision of the first instance court, the plaintiff's appeal was dismissed since the Court of Cassation had already examined the case.

In this article, we will examine how the practice has been shaped by this decision and make predictions for the future.

The latest developments since finalization of the decision signal a new regulation

The First Instance Courts and Regional Courts of Appeals have adopted the decision of the Court of Cassation and given dismissal decisions in equivalent pending court actions. In these dismissal decisions, they made reference to the decision of the Court of

Cassation and the reasoning was the same: TURKPATENT has no authority under the law to keep an official registry of well-known trademarks, and there is no legal benefit in initiating a cancellation action against the Office due to the rejection of an application to record trademarks as well-known since the status of such a trademark should be proven in a case where it is argued in accordance with established precedents.

Nonetheless, TURKPATENT has continued to maintain its registry of well-known trademarks and has accepted and processed applications for, and even recorded new trademarks on the well-known trademark registry. As in previous years, the Office has also updated its official fee for the recording service in its 2023 tariff, which is another indication that it will continue its practice.

The newly appointed president of TURKPATENT made a statement regarding the Office's decision in relation to the well-known trademark register at a consultation meeting with trademark attorneys in Ankara. The President stated that the Office will not abandon the well-known trademark registry and has no plans to do so. He stated that they are planning to amend the relevant legislation to including "holding a specific registry for well-known trademarks" among the duties of the Office. It is hoped this would be sufficient to overcome the reasoning of the Court of Cassation in its decisions, where

it found the practice of maintaining a well-known trademark register by the Office was without legal basis. He also emphasized that they had continued to receive applications to the registry, even after the decisions of the Court of Cassation, and that they had recently started to process the applications.

There is currently a schism in the interpretation and implementation of the above decision. It is expected that this difference between the Courts and the Office shall be resolved with a new regulation that will explicitly give the Office authority to maintain the well-known trademark registry.

As such, it is still sensible for right-holders to apply for recordal of their trademark as well-known if there is evidence that it is well-known and they believe their chances of success are high. However, if their application is rejected they will find no benefit in applying to the courts as per the Court of Cassation's decision.

*Authors: Uğur Aktekin, Begüm Soydan
Sayılkan*

The Revocation Procedure of Trademarks to be Handled by TURKPATENT

Prior to the Industrial Property Law (No. 6769 ("IPL")) entry into force: 10 January 2017), procedures regarding trademark rights were carried out under the now abolished Decree-Law (No. 556 on the Protection of Trademarks ("Decree Law")). The concept of "revocation", a basis for termination of a trademark, was defined under Article 14 of the Decree-Law. However, Article 14 was cancelled by the Constitutional Court with the decision 2016/148 (Merit Number), 2016/189 (Decision Number) on 14 December 2016. It was replaced by Article 26 of the IPL that regulates the conditions and requests for revocation. It states that a trademark may be revoked if:

- within a period of 5 years as of the date of registration, the trademark has not been put to genuine use in Turkey by the trademark owner in connection with the goods or services covered, or if such use has been suspended for an uninterrupted period of 5 years without proper reasons for non-use,
- the trademark becomes generic for the registered goods or services due to the trademark owner's actions or as a consequence of necessary measures not taken by the trademark owner,
- the trademark misleads the public concerning the nature, quality, or geographic origin of the goods or services for which it is registered, as a result of use by the trademark owner himself or with the trademark owner's consent.

- a guarantee mark or a collective trademark is used contrary to technical specifications.

Interested persons can request revocation of a trademark from the Turkish Patent and Trademark Office ("the Office") for which any of these reasons exist. However, the dispensation of this authority given to the Office has been postponed for seven years with Article 192/1(a) of the IPL. Within this period, the authority of revocation has been wielded by the courts under Provisional Article 4 – as was the case under the Decree-Law. This regulation parallels regulation in the European Union ("EU") (EU Directive No 2015/2436).

With less than one year remaining until the effective date of Article 26 of the IPL, the Office has worked to accelerate the timeline. As a result, revocation requests and review processes will be heard before the Turkish Office as an administrative office, similar to EU legislation and practice. For example, on 29 December 2022 the Italian Patent and Trademark Office became authorized for the revocation of trademarks after a seven year preparation and suspension period.

EU legislation has given courts and IP offices joint authority for the revocation of trademarks. In contrast Article 26 of the IPL only gives authority to the Office. This raises the question of whether the revocation of trademarks will be directly justiciable in the courts.

It is also unclear whether legal processes typically followed in court such as discovery, appointment of expert witnesses, etc. will be followed by the Office. As is common knowledge, invoices and sales figures are the most valued evidence in the examination of revocation requests, and commercial books are examined by the courts in order to confirm the accuracy of this evidence. However, due to sheer quantity of this type of evidence and impossibility of submitting the original commercial books to the court file, the courts frequently resort to discovery and on-site examination procedures. In order to implement this procedure, they appoint experts both from the relevant sector alongside financial experts. It is still unclear whether the Office will take on these roles.

In connection with this, if examination is made by the Office without appointment of an expert, then the competence of the examiners should be revealed, especially where financial data is concerned.

A final issue that needs clarification is whether the revocation of a trademark with an administrative act of the Office could be considered a violation of a property right?

Many outstanding questions remain. However, we believe that they will all be clarified within the one remaining year, particularly because the Office is already aware of them. All these questions aside, we believe that new

procedure for the revocation of trademarks will bring a significant improvement to time and cost-effectiveness. It is clear that the Office will be able to handle requests for revocation much faster than the 2-4 years it takes to finalise a lawsuit in the courts. It follows that the more efficient procedure will also be much more cost-effective than what the courts could offer.

On the other hand, since cancellation of the Office's decisions can be requested from the Ankara Civil IP Courts, the Office's final decisions on revocation requests may still be brought to the courts. As the review against the Office's decisions can only be carried out by Ankara Civil IP Courts, their workload will increase. It is a given that Ankara Civil IP Courts will specialize in the field of revocation of trademarks, and it is possible to say that it will set a great number of precedents. We may therefore expect it to set precedents for and lead the Office in its handling of requests.

All things considered it may be strategic to delay the filing of revocation requests until 10 January 2024 when the new regime enters into force.

Authors: Güldeniz Doğan Alkan, Cansu Evren

Is Partial Victory a Real Victory?

Upon reviewing two decisions rendered by the Ankara Regional Court of Appeal (“the RCA”) in 2021 and 2023 in independent cases (the cases will be referred as “the 1st case” and “the 2nd case”), it is concluded that if an argument is rejected during the opposition proceedings before the IP Office and no appeal is filed against the non-acceptance of this argument before the Higher Board of the IP Office (even though the decision is in favour of the opponent), the IP Court should not consider that argument for cancellation claim of the Office decision.

In both cases subject to the RCA’s decisions, the discussion is that an opposition against publication before the IP Office was partially accepted by the Trademarks Department (“the TD”) based on one of the arguments alleged and no further appeal was filed by the opponent against refusal of other arguments before the Higher Board of the IP Office. However, upon the applicant’s appeal, the Higher Board reversed TD’s decision. The opponent filed an action against the IP Office’s decision and requested (i) cancellation of the Office’s decision, (ii) invalidation of the contested trademark relying upon all the arguments. The developments were provided in the table below in both cases:

1 st case	2 nd case
Arguments	
Likelihood of confusion Well-known status	Likelihood of confusion Well-known status Bad-faith
Claims	
Partial invalidation of the trademark Cancellation of the Office’s decision	Invalidation of the trademark Cancellation of the Office’s decision
The IP Court’s decision	
Accepted the case for both arguments for both claims	Accepted the case for well-known status and bad-faith grounds for both claims
The RCA’s decision	
IP Court’s decision was incorrect as no appeal was filed by the plaintiff/opponent before the IP Office against the non-acceptance of the well-known status argument by the TD, so the IP Court should have considered that argument only for invalidation claim instead of the cancellation claim of the IP Office’s decision. Date: November 17, 2021	IP Court’s decision was incorrect as no appeal was filed by the plaintiff/opponent before the IP Office against the non-acceptance of the bad-faith argument by the TD, so the IP Court should have considered that argument only for invalidation claim instead of the cancellation claim of the IP Office’s decision. Date: April 25, 2023

It is understood from these two decisions that the RCA keeps its stands as the same for the question “whether an argument can still be raised for cancellation claim even though no appeal was filed against rejection of such argument during the administrative proceedings before the IP Office”. Since the answer is “No” from the RCA’s standpoint, it can be interpreted that the opponent will have to appeal anyway if one of its arguments has not been accepted in order to secure that it will be taken into consideration at the (probable/possible) Court action stage,

even if the decision given by the IP Office is favourable (so the goods/services are removed). In other words, this assessment reveals that if one of the arguments has not been accepted, the opponent would have to appeal if the argument is crucial for possible cancellation claim or if the opponent aims to have total victory in a possible action.

Despite the RCA's steady decisions, it worths to underline that the IP Office's implementation is contradictory. If one of the opposing arguments is accepted, the IP Office rejects appeals filed before the Higher Board against rejection of other arguments due to lack of interest – since obviously the application is already rejected. In fact, even in cases where the opposition of a third party is accepted and the application is rejected upon this, the Higher Board stands that there is no need to review the appeal of an opponent – whose opposition was rejected – in its essences, since the application is already and ultimately rejected. So it is generally pointless to appeal a decision if the application has been rejected based on one of the arguments. In this context, if the point of view that an argument will not be taken into consideration at the trial since it was not brought before the Higher Board will take roots -which seems likely-, the IP Office would be expected to change its implementation. Indeed, in view of the current implementation, the opponent stays together between appealing the decision just for the refused arguments (even if the application

is rejected) and facing the refusal of that argument in a possible court action against the Office decision.

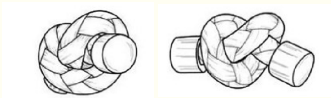
If the RCA's approach becomes steadier in the upcoming period, it is expected to create unnecessary appeals and court proceedings, which have an adverse impact on enforceability and consistency between administrative and court decisions while seriously increasing the workload in each step.

Despite such adverse impacts, every case should be examined in its own conditions. Indeed, the parties may abstain from having a negative valid administrative IP Office decision. Therefore, a strong strategy must be built to decide on the importance of entering into appeal/court proceedings for rejection of one (crucial) argument – even if the opposition was successful.

Authors: Güldeniz Doğan Alkan, Ayşenur Çıtak Bozdağ

A Precedent for 3D Trademarks' Enforcement

In 2022, the Turkish Court of Cassation ("TCoC") rendered a decision declaring that the use of a 3D trademark (shown below) as bag-locks on counterfeit goods infringed the trademark holder's rights and the accused should have known that this 3D shape is a trademark.



The decision concerned the submission of a criminal complaint by the 3D trademark owner arguing that their 3D trademark was being used on counterfeit products. After the case turned into a criminal court action, the Criminal First Instance Intellectual Property Court ("the Criminal IP Court"), the Regional Court of Appeal ("RCoA") and TCoC had different opinions on whether the use of this 3D trademark on bag-locks infringed the complainant's rights and whether the accused should know this 3D shape is a trademark or not. The Criminal IP Court evaluated that the seized counterfeit goods bore a bag-lock shape identical to the complainant's registered trademark, and that this constituted a trademark infringement crime. It also stated that as an expert trader and a shop owner, the accused should have known that this 3D shape was a trademark. On the other hand, the RCoA ruled that there was no printed or labelled trademark on the counterfeit bags (so no word/written trademark on the goods) and 3D use of the opening-closing buckle of the counterfeit bags similar to the complainant's registered trademark, did not constitute a

trademark infringement crime. It reasoned that this bag-lock shape does not have a trademark function and that the accused may not know that the design of the bag-lock is a registered trademark.

The case was brought before the TCoC and it was decided by a majority vote that a trademark infringement crime had occurred in the present file. It reasoned that the shape did have a trademark function, and that the counterfeit bags bore a bag-lock shape that was identical to the complainant's trademark. It also stated that as a bag seller and a shop owner, the accused had to know the counterfeit nature of the seized goods. However, a dissenting opinion in the TCoC's decision stated that this bag-lock shape has no trademark function and that the accused could not have known that this shape was a trademark.

In conclusion, the TCoC's majority decision became final, binding and a ground-breaking precedent for the enforcement of 3D trademarks. In fact, we believe that this decision of the TCoC contains extremely positive evaluations in terms of 3D trademarks' enforcement. Indeed, the TCoC's assessments regarding the bag-lock shape within the complainant's trademark and its features indicate that we may expect to receive positive and comprehensive decisions regarding 3D trademarks' enforcement. In particular, the decision is promising as it shows that the enforcement authorities have the same approach to protecting non-traditional

trademarks as traditional ones. We opine that this decision may contribute to the protection of non-traditional trademarks and facilitate and promote their use and enforcement.

Authors: Güldeniz Doğan Alkan, Ahmet Kürşat Yıldız, Bengü Şen Gürakan

Can the counterfeiters be acquitted solely on the grounds that the number of seized counterfeits is very low?

Acts considered infringements of trademark rights are regulated under Article 29 of Industrial Property Law no. 6769 ("IPL"). Article 29/1(c) states that *"To imitate the trademark upon using the trademark or its indistinguishably similar version without the permission of the holder; to sell, distribute, to trade in any other way, to import, export, keep for commercial purposes the products bearing the trademark used by means of violation..."* constitutes trademark infringement. Since this article uses "products" in the wording of the law, and since the criminal provision of the IPL, Article 30, defines the offense by referring to the provision on "trademark infringement" by saying *"one who produces goods or services upon infringement of a trademark of someone else via adaptation or excerption"*, it has been debated whether the accused could be acquitted in cases where the number of seized products was one or very low.

A very recent decision of the Court of Cassation has clarified this debate. In the decision no. M. 2022/8035 D. 2022/18214, the 7th Criminal Chamber ruled that:

"Although the Local Court rendered a verdict of acquittal on the ground that only one counterfeit product was seized in the workplace of the defendant and therefore no conclusive evidence could be obtained to prove that the defendant acted with a criminal intent; it was established that the defendant sells toys and stationery in the workplace

operated by the defendant, the intervening party first purchased counterfeit products from the defendant's workplace to follow up the crime of trademark infringement which is the subject of the complaint for investigation, and then presented the product purchased and the cash register receipt documenting the purchase of this product from the defendant's workplace to the relevant Chief Public Prosecutor's Office as evidence, which led to reasonable suspicion to obtain a search warrant at the workplace, thus evidence was obtained, a search was conducted at the workplace of the defendant with the search warrant issued by the criminal court of peace upon this evidence, another counterfeit branded product seized at this workplace was found to be offered for sale according to the "search and seizure" report of 14/04/2015, and moreover, there was no barcode and hologram on the counterfeit product seized at the workplace of the defendant, although there should be a barcode and hologram on a product legally offered for sale, and this issue was recognized at first glance, in this case (. ...) constitutes the act of "selling,..., placing on the commercial field in another way, ..., keeping for commercial purposes the products bearing the trademark used by means of violation, despite the knowledge or the obligation to know that the trademark is imitated, upon using the trademark or its non-distinctively similar version", and that the defendant – due to his business- is in a position

to know and should know that the products bearing the trademark registered on behalf of the intervening company are counterfeit; [...] Accordingly, without considering the existence of the elements of the offense of infringement of the trademark right charged against the defendant, who is beyond doubt sold one product subject to the crime in his workplace and offered the second product for sale, the court of first instance ruled the acquittal of the defendant in writing instead of his conviction with a justification that was not deemed appropriate"

and quashed the decision of the court of first instance by finding it unlawful.

Moreover, as is clear from the dissenting opinion of the same decision, the fact that this decision was rendered despite the fact that the defendant "was active in the sale of stationery and toys for a short period, such as one and a half months" shows that the Court of Cassation unquestionably took into account the fact that the defendant knew and should have known that the seized product was counterfeit simply because he was a merchant, though only for a brief period, and also how vital it is to purchase counterfeit products from the defendant's workplace for use as evidence before filing a complaint based on trademark infringement, and to present all kinds of evidence such as receipts, invoices, notary approvals etc. regarding this purchase.

In light of the above, it has been demonstrated that in cases where the right of complaint is exercised as a result of a purchase made upon receipt, a search and seizure decision is issued according to the complaint, and the product subject to the crime is obtained through the enforcement of the decision, the fact that a small amount of counterfeit products were seized cannot alone justify an acquittal decision. In other words, the seizure of even only one product in cases where procedures are duly executed is sufficient for establishing the offence of infringement of trademark rights and the sentencing of the accused for this offence.

Authors: Barış Kalaycı, Zeynep Seda Alhas, Kübra Tantu

Changes in the Amended E-Commerce Law for IP

Law No. 7416, amending the E-Commerce Law, came into effect on 1 January 2023. A comprehensive change has been made to Article 9, titled “obligations of intermediary service providers”, including the title of the provision. Following this change, the title of Article 9 was changed to “illegal content”. According to this article, unless there is a contrary provision in other laws, the general principle is that an intermediary service provider is not responsible for the illegality of the content. Nevertheless, the intermediary service provider is obliged to remove the content and to report the illegal issue to the relevant public institutions and organisations without delay if it becomes aware of the illegality of the content.

In the paragraph 3 of Article 9, violation of IP rights is specifically regulated; the intermediary service provider is obliged to take down the product subject to the complaint upon the right owner’s complaint based on information and documents regarding the violation of IP rights. If an objection is made contrary to the complaint, then the intermediary service provider must republish the product subject to the complaint.

If the illegal content is not removed upon complaint, or if the content is republished despite being proven illegal, the intermediary service provider can be subjected to an administrative fine between 10,000TL to 100,000TL for each violation.

A new regulation complementing Law No. 7416 and explaining the takedown procedure upon receipt of a legitimate complaint by IP rights holders came into effect as of 1 January 2023 as well. According to this regulation:

- The complaints alleging IP rights infringement shall be made to the platforms through their internal communication system as established by the platforms, or by Notary Public or Registered Electronic Mail.
- The platforms shall remove the relevant product within 48 hours and inform the complainant and the service provider.
- The service provider is entitled to file an objection against the complaint.
- If the objection is rightfully based on the information and evidence provided, the platforms must republish the complained product within 24 hours.

The new regulation clarifies many details of the procedure, as well as the counter-objection by e-commerce service providers to the related complaint, and aims to provide a balanced, foreseeable and fastmoving way to protect IP rights against infringement on e-commerce platforms. However, there remain ambiguities that may create problems in practice. For instance, while the internal communication system to be established by the intermediary service provider would create a simple and functional tool to file complaints and objections, it raises the question whether it would satisfy the burden of proof.

On the other hand, it is seen that the intermediary service providers are given a very limited period to act upon complaints and objections. Although these limits are determined to ensure a quick response, it may be very challenging for the intermediary service providers and give rise to speculation around the depth and accuracy of the platforms' analysis of the issues' merits.

It seems that the complaint procedure will enable a fast-track solution and help the right holder take down the infringing products very quickly, and it is envisaged that the specified administrative fine will be an effective deterrent. The regulation will motivate e-commerce sites to bring their activities into compliance with the law. Therefore, we consider this change in the E-Commerce Law a very positive development for IP rights holders.

*This article first appeared in WTR Daily, part of the World Trademark Review, in January 2023. For further information, please go to www.worldtrademarkreview.com.

Authors: Mutlu Yıldırım Köse, Dilan Sıla Kayalica

Non-Fungible Tokens (NFTs) and Trademarks

In 2022 NFTs became a very popular topic of discussion from a trademark law perspective. As more businesses in various industries have carried their trademarks to the Metaverse and launched NFT collections in 2022, the number of trademark applications covering NFTs has significantly and proportionally increased.¹

To satisfy the demand created by this trend, the European Union Intellectual Property Office ("EUIPO") published a guideline that sets out the main principles regarding goods/service classification for trademark applications covering NFTs ("the Guideline")². According to EUIPO's approach set out in the Guideline, NFTs and virtual goods are proper to class 9 as digital content or digital visuals. However, since the sole term "NFT" or "virtual goods" does not suffice to clarify the subject of the registration, the content to which NFTs and virtual goods relate must be further specified in the application. For instance, a trademark application covering "downloadable music files authenticated by NFTs" could be filed in class 9. Trademark applications for services related to NFTs will also be subject to general principles governing the classification of services. In this respect, trademark applications covering NFTs are mostly filed in classes 35, 36, 41 and 42. In this regard, trademark applications for "online platform providing services for trading NFTs" in class 35, "entertainment

services provided by the use of virtual goods authenticated by NFTs" in class 41, "providing software as a service for transactions such as buying and selling NFTs" in class 42 would be considered properly filed.

Accordingly, the 12th Edition of the Nice Classification, the goods/services list published by the World Intellectual Property Organization, has been updated by adding "downloadable digital files authenticated by NFTs" as a sub-class under class 9.³

We expect that principles regarding the evaluation of the similarity of goods/services and the likelihood of confusion between trademarks covering NFTs will be established by Trademark Offices through later decisions.

Two separate exemplary decisions have already been rendered on this topic by the United States Patent and Trademark Office ("USPTO") in 2022. The trademark application consisted of "Gucci" as the word element covering "downloadable virtual goods" in class 9 and "related digital services" in classes 35 and 42 filed by Fenesha Amana Holmes, and the trademark application consisted of "Prada" as the word element covering the same classes with Gucci application filed by Reath Mohammed have been directly rejected by USPTO after the preliminary examination. USPTO, in both decisions, took

¹ <https://www.geekmetaverse.com/rolex-filed-a-trademark-application-for-services-related-to-cryptocurrencies-and-nfts/>
<https://www.nftgators.com/nike-files-three-new-nft-and-metaverse-trademarks-for-its-swoosh-web3-platform/>

² https://euipo.europa.eu/ohimportal/en/news-newsflash/-/asset_publisher/JLOyNNwVxGDF/content/pt-virtual-goods-non-fungible-tokens-and-the-metaverse

³ https://www.wipo.int/classifications/nice/nclpub/en/fr/?class_number=9&explanatory_

into consideration that Gucci and Prada are well-known trademarks and evaluated that companies in the fashion industry started to carry out business in the virtual world as well; therefore, consumers perceive physical world's goods/services as associated with the virtual world's goods/services.

A very recent development can be seen, in the case filed by Hermes against Mason Rothschild alleging that Rothschild converted globally-known Birkin bags to NFTs and traded them on the Opensea platform with no authorisation, the jury concluded that Hermes's trademark rights had been infringed as these NFTs cause a likelihood of confusion in the part of consumers⁴.

It is important to note that the well-known status of trademarks subject to the decisions affected the evaluation of the likelihood of confusion, but the most vital takeaway from these decisions is NFTs could be deemed similar to real-world goods and services. We are of the opinion that these decisions establish that trademark owners are entitled to protect their trademarks against similar trademarks covering virtual goods and NFTs.

In line with global developments, Turkey as also seen developments related to NFTs, as the Digital Transformation Office of

the Presidency of Turkey defined NFTs as "qualified intellectual property deed".

There have also been many trademark applications covering NFTs filed before the Turkish Patent and Trademark Office ("Office"). We see that the Office has a positive attitude to trademark applications covering NFTs and handles such applications like any other trademark application with no reservation or objection against the included goods/services list thereunder and applies the general trademark registration procedure if such applications meet the legal requirements.

Results of disputes arising from trademark infringement claims caused by NFTs and practices of courts and IP offices around the world will enable us to better observe how NFTs will be evaluated under trademark law in the long term.

Authors: Mutlu Yıldırım Köse, Havva Yıldız, Göksu Ayçıl Altınok

⁴ <https://www.thefashionlaw.com/hermes-names-metabirkins-creator-in-trademark-lawsuit/>

A New Era in .tr Extended Domain Names - and a New Issue Waiting for a Solution

Nic.tr (".tr" Domain Name Management), established under the auspices of Middle East Technical University ("ODTU"), has been managing ".tr" domain names and dispute resolution processes related to these domain names since 1991. According to Article 35 of the Electronic Communications Law No. 5809 and the Internet Domain Names Regulation, TRABIS (".tr" Network Information System), established by the Information and Communication Technologies Authority ("BTK"), became operational on 14 September 2022 and has undertaken the management of ".tr" domain names.

TRABIS serves as the system that manages the registration, renewal and operation of ".tr" domain names. Within the scope of TRABIS, the Registry and Registrar model, which is implemented worldwide in accordance with ICANN, has started to be fully implemented in Turkey. Within this framework, services are provided by Registrars approved by TRABIS, which mediate the transactions related to domain names, such as domain name application, renewal and cancellation. Upon the introduction of TRABIS, the "first come, first served" principle has been implemented for the allocation of domain names such as com.tr, org.tr, net.tr, gen.tr, biz.tr, tv.tr, web.tr, info.tr, bbs.tr, tel.tr, name.tr. The obligation for the submission of documents proving the rights of the applicant has been abolished. This new situation is expected to result in third

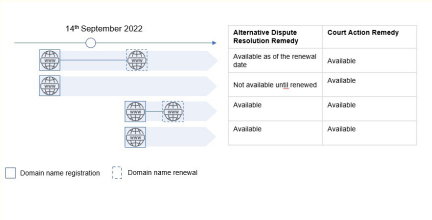
parties' registration of domain names before the trademark holders register their domain names.

Dispute Resolution Service Providers, which are granted an activity certificate by TRABIS, have begun handling the alternative dispute resolution process regarding domain names. Dispute Resolution Service Providers evaluate disputes regarding a domain name by taking into consideration the relevant legislation, case law and judicial decisions through their arbitrators or arbitral tribunals and may decide upon the cancellation of domain names, their transfer to the complainant or the rejection of the complainant's request. In addition, it is still possible to file a civil court action before the courts for the cancellation of ".tr" domain names.

The Internet Domain Names Regulation has introduced a different scheme regarding the alternative dispute resolution mechanism for domain names registered before the enforcement of TRABIS. Under paragraph 9 of Provisional Article 1 of the Internet Domain Names Regulation and Provisional Article 3 of the Communiqué on Dispute Resolution Mechanism for Internet Domain Names, no application can be filed to the alternative dispute resolution mechanism for domain names that were allocated before TRABIS became operational. However, applications can be filed to the dispute resolution

mechanism for these domain names that were renewed after TRABIS became operational.

There is no doubt that it is possible to apply to Dispute Resolution Service Providers against domain names with “.tr” extension registered after September 14, 2022, when TRABIS launched its activities. However, it is possible to apply to Dispute Resolution Service Providers against domain names with “.tr” extension registered before September 14, 2022, only after their renewal date. In other words, applying to Dispute Resolution Service Providers will not be possible until the domain names with the “.tr” extension registered before September 14, 2022 are renewed at a later date. Therefore, under current legislation disputes related to such domain names can only be brought to court.



Given that “.tr” domain names can be registered and allocated for up to five years, it can be considered that the unavailability of an alternative dispute resolution method against a domain name that was registered or renewed for five years right before September 14, 2022, creates a significant loss of rights

during this period. This dual regulation may be considered as contradicting the principle of equality set forth in the Constitution and the freedom to seek the upholding of rights. Indeed, the alternative dispute resolution methods envisaged for domain names are finalized within a few months, whereas the finalisation of the process before the courts may take up to several years. Court proceedings are also less cost-effective. Furthermore, while the cancellation or transfer of the disputed domain name can be claimed in the alternative dispute resolution method, only the cancellation of the disputed domain name can be claimed before the courts. This shows that litigation is less advantageous than the alternative dispute resolution method for domain name disputes. This system, which creates an unequal situation in domain name disputes, should be addressed promptly and the alternative dispute resolution method should be made accessible for domain names allocated and/or renewed before September 14, 2022.

Authors: Zeynep Seda Alhas, Pınar Arıkan, Baran Güney

KEY CONTACTS



MEHMET GÜN
SENIOR PARTNER

Intellectual Property
Dispute Management
Life Sciences
Corporate and M&A
Competition
Finance

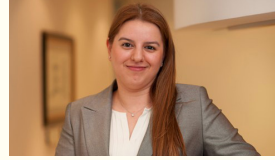
mehmet.gun@gun.av.tr



BARIŞ KALAYCI
PARTNER

Intellectual Property
Anti-Counterfeiting
Business Crimes and Anti-Corruption
Trademarks and Designs
Copyrights

baris.kalayci@gun.av.tr



GÜLDENİZ DOĞAN ALKAN
PARTNER

Intellectual Property
Trademarks and Designs
Copyrights

guldeniz.dogan@gun.av.tr



HANDE HANÇAR
PARTNER

Intellectual Property
Trademarks and Designs
Copyrights
IP Prosecution
Life Sciences
Technology, Media and Telecom

hande.hancer@gun.av.tr



MUTLU YILDIRIM KÖSE
PARTNER

Intellectual Property
Trademarks and Designs
Copyrights
IP Prosecution

mutlu.kose@gun.av.tr



UĞUR AKTEKİN
PARTNER

Intellectual Property
Trademarks and Designs
Copyrights
IP Prosecution
Technology, Media and Telecom

ugur.aktekin@gun.av.tr



ZEYNEP SEDA ALHAS
PARTNER

Intellectual Property
Trademarks and Designs
Anti-Counterfeiting
IP Prosecution
Copyrights

zeynep.alhas@gun.av.tr



PINAR ARIKAN
DIRECTOR

Intellectual Property
IP Prosecution

pinar.arikan@gun.av.tr

KEY CONTACTS



BARAN GÜNEY
MANAGING ASSOCIATE

Intellectual Property
Trademarks and Designs
Copyrights
IP Prosecution
Anti-Counterfeiting
Technology, Media and Telecom
baran.guney@gun.av.tr



DİCLE DOĞAN
MANAGING ASSOCIATE

Intellectual Property
Trademarks and Designs
Life Sciences
dicle.dogan@gun.av.tr



DİRENÇ BADA
MANAGING ASSOCIATE

Intellectual Property
Dispute Management
Trademarks and Designs
Anti-Counterfeiting
Data Protection and Privacy
direnc.bada@gun.av.tr



AHMET KÜRŞAT YILDIZ
SENIOR ASSOCIATE

Intellectual Property
Anti-Counterfeiting
Trademarks and Designs
ahmetkursat.yildiz@gun.av.tr



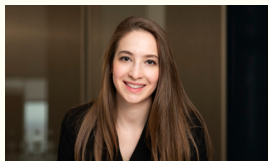
ATAHAN ERKUL
SENIOR ASSOCIATE

Intellectual Property
Anti-Counterfeiting
Trademarks and Designs
atahan.erkul@gun.av.tr



BEGÜM SOYDAN
SENIOR ASSOCIATE

Intellectual Property
Trademarks and Designs
Copyrights
Anti-Counterfeiting
begum.soydan@gun.av.tr



CANSU EVREN
SENIOR ASSOCIATE

Intellectual Property
Trademarks and Designs
Copyrights
Life Sciences
Employment
cansu.evren@gun.av.tr



DİLAN SILA KAYALICA
SENIOR ASSOCIATE

Intellectual Property
Trademarks and Designs
IP Prosecution
Copyrights
dilan.aslan@gun.av.tr



İREM GİRENES YÜCESOY
SENIOR ASSOCIATE

Intellectual Property
Trademarks and Designs
Copyrights
irem.girenese@gun.av.tr

KEY CONTACTS



MARAL BÜYÜKKÜRKÇÜ
SENIOR ASSOCIATE

Intellectual Property
Patent and Utility Models
Life Sciences
Trademarks and Designs

maral.sayan@gun.av.tr



MERVE ÇİMEN SEVİNE
SENIOR ASSOCIATE

Intellectual Property
Trademarks and Designs
Copyrights

merve.cimen@gun.av.tr



ZEYNEP ÇAĞLA ÜSTÜN
SENIOR ASSOCIATE

Intellectual Property
Trademarks and Designs
Patent and Utility Models
Life Sciences
zeynep.ozcebe@gun.av.tr



CANAN TINAZ
SENIOR ATTORNEY

Intellectual Property
IP Prosecution

canan.tinaz@gun.av.tr

FIRM OVERVIEW

We are one of the oldest and largest business law firms in Turkey and are ranked among the top tier legal service providers. We are widely regarded as one of the world’s leading IP law firms.

Based in Istanbul, we also have working and correspondent office in Ankara, Izmir and all other major commercial centers in Turkey.

We advise a large portfolio of clients across diverse fields including life sciences, energy, construction & real estate, logistics, technology media and telecom, automotive, FMCG, chemicals and the defence industries

We provide legal services mainly in Turkish and English and also work in German and French.

We invest to accumulate industry specific knowledge, closely monitor business sector developments and share our insight with our clients and the community We actively participate in various professional and business organisations.

The information and opinions provided in this content do not and are not intended to constitute legal consultancy or legal advice. This content does not constitute legal or advisory service proposal. All works and other intellectual products subject to intellectual property rights contained in this content belong to Gün + Partners and they are protected under Law No. 5846 Intellectual and Artistic Works as well as Industrial Property Code No. 6769. Unauthorized use of the content, without proper credit, would be subject to legal and/criminal sanctions as per Law No. 5846 Intellectual and Artistic Works and Industrial Property Code No. 6769.

