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## TRADEMARK LAW IN TURKEY

KEY DEVELOPMENTS  
AND PREDICTIONS - 2020

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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.

## Key Developments and Predictions for Trademark Law in Turkey

Trademark law has continued to evolve at a slow pace within the course of the last year, while January, 2020, marks the completion of the third year of Industry Property Code No. 6769 (“the IP Code”).

The Turkish Patent and Trademark Office (“TÜRKPATENT” or “the Office”) issued guidelines in an aim to bring clarity on absolute grounds examination, and a new guideline is to be announced within the first half of 2020. The decisions of TÜRKPATENT in opposition and appeal phases are now more predictable in cases where a non-use defence has been introduced. A new software, EPATS, has been adopted very recently by TÜRKPATENT, which requires all transactions to be made electronically. It is hoped to provide assistance to practitioners in their prosecution of applications, and in reviewing the file histories of trademarks.

The guidance of the Court of Appeals for various new rules introduced by the IP Code has not been available, as most of the cases decided under the IP Code have yet to come before the Court of Appeals, due to the length of the court proceedings. However, the first instance courts thoroughly implement those new rules in which there is no ambiguity, including non-use defence, and register use defence in infringement actions.

This paper covers issues regarding implementation of some of the new rules introduced by the IP Code, such as loss of right due to acquiescence and registered use defence in infringements, as well as recent case law regarding the concepts that remain the same or similar under the IP Code, such as the scope of protection of weak trademarks and the genericide of trademarks.

### **This paper provides an overview on the following topics:**

- Loss of Right Due to Acquiescence in Infringement
- Protection Scope of Weak Trademarks
- Accuracy Assessment on Decisions of the Office
- Registered Use Defence in Infringement Actions
- Avoiding Genericide of Trademarks
- The Impact of Non-Use Defence in Criminal Cases
- Recent Practice on Colour Marks in Turkey
- The New Trademark Examination Guideline

## Loss of Right Due to Acquiescence in Infringement

The loss of right due to the acquiescence principle had not been regulated in Turkish Law prior to the implementation of the IP Code. However, the Court of Appeals has started to apply this principle based on the circumstances of each case within the scope of the good faith principle and prohibition on abuse of rights, which is regulated under Article 2 of the Turkish Civil Code ("TCC"), and these have become established case-law precedents.

In the decisions of the Court of Appeals, the loss of right due to acquiescence has been determined upon evaluation of the following criteria within the scope of the good faith principle and prohibition on abuse of rights, such as the attitude and reaction of the prior right holder after becoming aware of the infringement, the intensity of the investments by the infringing party on the trademark, the weight of the promotional activities for having introduced the trademark in the relevant sectors, and the possibility for the prior right owner having been made aware of the infringement. The Court of Appeals is of the opinion that it is not possible to set a definite limitation period for acknowledging loss of right due to acquiescence.

After the implementation of the IP Code, loss of right due to acquiescence has become an explicit rule for trademark invalidation actions. Article 25/6 of the IP Code regulates that where the trademark owner has known, or should have known, of the use of a subsequently dated infringing trademark, but

did not take action against such use for more than 5 uninterrupted years, the trademark owner will not be able to claim invalidation of the subsequently infringing trademark on the grounds of its prior trademark registration, unless the subsequent trademark had been registered in bad faith.

Although the IP Code only rules on the principle of loss of right due to acquiescence for trademark invalidation actions, it is commonly accepted in doctrine that implementation of loss of right due to the acquiescence principle should continue to be implemented for trademark infringement cases, as established under the previous law. Some argument exists concerning the doctrine that there is no definite period of time in which to admit loss of right due to acquiescence in trademark infringement cases, and the period of limitation may be more or less than five years, depending on the circumstances of the case. On the other hand, there are other arguments that the period of limitation should not be less than five years, and the duration should be determined depending on the circumstances of each case.

It has become increasingly important how the loss of right due to acquiescence will be interpreted in trademark infringement cases by the Court of Appeals, after entry into force of the IP Code and the above-mentioned developments. However, it is not yet known as to how the implementation by the Court of Appeals will shape the practice, since the

recent decisions are related to the lawsuits that have been filed prior to the implementation of the new IP Code, and whether abolished Decree Law No. 556 pertaining to Protection of Trademarks is applicable.

Considering the legal interest to be protected by loss of right due to the acquiescence principle, we believe that the previous practice by the Court of Appeals should continue, and the limitation period for loss of right due to acquiescence for trademark infringement cases should be determined depending on the circumstances of each case in light of the good faith principle. We further believe that the minimum five-year period required for invalidation cases should not be sought in infringement actions, and the duration may be more or less than five years depending on the specifics of each given case. Therefore, we urge trademark owners not to remain silent, to bring timely actions against alleged infringers and, in particular, in cases where they know about the infringement and their acquiescence may easily be proven.

## Protection Scope of Weak Trademarks

According to Article 4 of the IP Code a sign should be distinctive in order to benefit from trademark protection. Distinctiveness is an essential factor in determining the scope of protection of a trademark, and the protection scope of trademarks differs according to the distinctiveness level of the component(s) that form the trademark.

The trademarks composed of non-distinctive components, or components where the distinctiveness is weak, are called "weak trademarks." Although the distinction of "strong" or "weak" trademarks does not have a legal basis, it is considered as an essential distinction in determining the scope of protection to be given to the trademark in both the doctrine and judicial decisions.

The doctrines of the European Court of Justice (CJEU) and European Union Intellectual Property Office ("EUIPO") agree that the protection of weak trademarks is not extensive, unlike those with high distinctiveness traits. A person who registers a weak trademark must endure the use of similar signs by third parties, which may be expected to cause the likelihood of confusion with that trademark. Indeed, the addition of minor components is sufficient to distinguish the trademarks from each other. It is not possible for a person to have an absolute right on a low distinctive sign, even if it is registered as a trademark.

In respect thereof, the Court of Appeals (CoA), in an earlier decision dated 02.10.2013, decided that the BLUEDIAMOND trademark that had been registered for goods and services relating to jewelry should be invalidated, since it creates the likelihood of confusion with the earlier dated trademarks of DIAMOND, DIAMOND MUCEVHERAT ('mücevherat' means jewelry) and NACI DIAMOND, that cover goods and services relating to jewelry. Having assessed the allegations of the defendant, and determining that 'Diamond' has a low level of distinctiveness for goods and services relating to jewelry, the CoA accepted that the trademarks were not sufficiently different from each other, and ruled that a trademark will grant all legal rights to its owner, unless a finalized cancellation decision is rendered as a result of a cancellation action. According to this previous approach of the CoA, the trademark holder would be entitled to use all legal rights arising from the registration of their trademark, and may not be restrained from such use for the descriptiveness or weakness of the sign. This approach of the CoA was criticized on the grounds that it would lead to an absolute right on descriptive phrases and generic names if they were registered as a trademark, in any manner.

Upon examination of the recent decisions of the CoA, it is clear that the Court has a

different approach and, since the CoA has issued many decisions determining the fundamental principles of assessment of likelihood of confusion of trademarks that include descriptive phrases, these have become established precedents. In a decision rendered in 2015, the CoA stated that "The scope of the protection of weak trademarks had to be narrower... In short, the trademarks that are formed with inspiration from descriptive phrases, or phrases designating nature, are weak trademarks. The possibility of confusion between these trademarks may be eliminated with a minor change." In a decision from 2017, the Court of Appeals, once again, stated that "The trademarks, formed with inspiration from descriptive words that are not allowed to be monopolized, are weak trademarks."

In a similar way, in its recent decision dated December 18, 2019, regarding the "CHESTERFIELD BLUE LINE," and "BLUE LINE" trademarks that cover goods in class 34, the CoA upheld the decision of the District Court, which states that "Although the trademark that is the grounds of the action must be protected since it is registered, the person who registers a phrase with low distinctiveness has to bear the consequences of this. In this case, BLUE LINE has low distinctiveness for tobacco and tobacco products in class 34, and the addition

of CHESTERFIELD is sufficient to distinguish the trademarks. Therefore, the trademarks will not lead to a likelihood of confusion on the part of the public." In its decision, the CoA stated that "Considering that BLUE LINE has low distinctiveness for tobacco and tobacco products in class 34... it is required to uphold the decision of the District Court."

This approach of the CoA is in line with the decisions of the CJEU and EUIPO, and there must be clearer protection for weak trademarks. While evaluating the likelihood of confusion between two trademarks that include the same low distinctive phrase, the impact of non-common elements as to similarity should be evaluated depending on the circumstances of each case.

## Accuracy Assessment on Decisions of the Office

The assessment of accuracy of the Office's decisions has always been a controversial issue under Turkish trademark law. A recent decision issued by the 2nd IP Court of Ankara that opposed the Court of Appeal's ("CoA") decision, constitutes a remarkable precedent, illuminating the issue.

The owner of earlier trademarks, which are also recorded as a well-known trademark by TÜRKPATENT, filed a lawsuit in opposition against a later-dated, and confusingly similar application.

The Office ultimately refused the opposition and decided to register the application. The opponent filed a cancellation action against the Office's final decision. The 2nd IP Court of Ankara agreed with the Office's approach and rejected the action with the reasoning that the applicant has priority over the opponent, and that even if the applicant's earlier trademarks have been cancelled due to non-use (retrospectively), they were valid at the time the Office decided on the opposition; thus, they should be considered as vested rights enjoyed by the applicant.

The local IP Court's decision was appealed by the opponent. The CoA upheld the opponent's appeal by stating that although the opponent argued that the applicant's earlier registrations had been cancelled during the appeal examination before the Office, the Trademark Office did not request additional information and documentation from the parties regarding this invalidation

proceeding, and dismissed the opposition at the final administrative stage.

Further to the CoA's decision to overturn, the case was re-recorded before the local Court. As a result, the 2nd IP Court of Ankara decided to insist on its first decision (in favour of the applicant) not to abide by the dismissal decision of the CoA. The local Court explained that the applicant's earlier trademarks were valid at the time the Office decision had been issued and, therefore, the Office was correct to take those trademarks into consideration, as well, although they had been cancelled (even retrospectively – dating prior to the Office's decision) afterwards. The local Court added that the Office is not required to await the finalization of Court decisions, and/or request information from the parties in that regard.

Through this decision, the 2nd IP Court of Ankara established that the accuracy of the Office's decisions shall be assessed according, and strictly limited, to the circumstances of the date of decision in dispute. This means that the Office is not required to await the outcome, or to investigate the status, of pending lawsuits that may substantially affect the validity of the earlier trademarks cited as grounds for opposition.

This ruling of the local Court is not final, and the case will be examined by the General Assembly of the CoA so that a final verdict will be given.



The final ruling of the General Assembly of the CoA holds great importance as this unit serves to ensure unification of judgments and to eliminate nonconformities between the opinions of different chambers of the CoA, as the decisions issued by the local Court are not binding, so long as they have not yet been finalized.

Until a final ruling is given by the General Assembly, we expect that the Office's practices will remain the same, and it will continue to render its decisions pursuant to the circumstances of the dates of decision, without requesting information from the parties, in terms of the validity of the related trademarks.

Considering the approach of the CoA, it is advisable to submit the finalized Court decisions regarding invalidation of a trademark to the Office without delay, in an attempt to have the relevant trademark removed from the registry. Even though the concerned mark is no longer valid, the registry records of the Office may be of great importance in terms of the accuracy of the Office decisions, in cases where it maintains its presence in the trademark registry – such as in the present case.

## Registered Use Defense in Infringement Actions

As per the settled Court of Appeals (“the CoA”) precedents established during the Trademark Decree-Law era – which ended upon enactment of the new Intellectual Property Code No. 6769 (“IP Code”) on January 10, 2017, it was accepted that use, which was based on a registered trademark, cannot create infringement, regardless of whether this use creates confusion and infringement with a senior trademark registration.

As a result of these precedents, use based on a registered trademark right provided its owner with absolute protection; in other words, immunity and, accordingly, no preliminary injunctions were available against the use of registered rights, and infringement claims were rejected. The owners of the senior registrations whose rights were infringed had to have the other parties’ registrations cancelled or invalidated, first, and then an infringement claim could be filed against the use. Even in such case, the losses that occurred during the term that the mark was registered were off-limits and could not have been recompensed.

This “right” based on a registered trademark was seriously criticized, as it provoked the abuse of the registration system through bad-faith filings. Even though use clearly creates infringement, if it could somehow obtain a registration, it was “legally” protected.

With the enactment of the IP Code, “The use of a registered trademark does not constitute infringement” principle, which resulted from CoA precedents, has lost its validity. Article 155 of the IP Code rules that “A trademark, patent, or industrial design holder cannot rely on its registered right as a defense in an infringement action filed by a priority right holder,” and sets forth clearly that a registered trademark would not serve its owner as a valid defense in an infringement action filed by a senior right holder.

This regulation introduced by the IP Code was generally welcomed by the practitioners. In the early months, the first instance courts, even the specialized courts, abstained from the implementation of this new rule – yet in its decision dated March 14, 2018, the 16th Civil Chamber of the Istanbul District Court of Appeals, implemented the new ruling of the IP Code to a pending conflict, and granted preliminary injunction in favor of the claimant, simply confirming that the use of a registered trademark can be prevented. We have experienced that the first instance courts have followed this ruling more commonly since then and, especially, the implementation of the rule seems to not be an issue for the civil IP courts.

In short, with this regulation set forth by Article 155 of the IP Code, it is no longer possible to make use of a registered right as a defense in legal proceedings against senior marks, and its use can be prevented.

On the other hand, this new rule indeed means that the “absolute protection” that we believe was granted through trademark registration is no longer available. That is to say, even if a trademark is granted with registration – without any issues during the opposition term – and in good faith, the owner of a senior mark may claim that the use of this registered trademark creates infringement against theirs, and request a preliminary injunction and/or an infringement ruling against the use, without claiming cancellation or invalidation of the registered trademark.

Accordingly, while Article 155 of the IP Code introduced a valid solution to the infringing registrations, especially those made in bad-faith, it also invalidated the well-grounded sense of security that the registered trademark entitles its owner to that absolute protection and the use of a registered trademark are rightful. It is now much more important than before that one acts with due diligence while choosing a trademark, making use of registration searches that would reveal earlier similar marks, and request a legal evaluation before applying for registration and initiating use.

## Avoiding Genericide of a Trademark

Article 42/1(d) of the former Decree Law set forth that an invalidation action could be filed against a trademark if it becomes a common name of the goods or services it was registered for as a result of the trademark proprietor's behaviours.

The same rule was preserved in the IP Code under Article 26/1(b) as grounds for revocation, instead of invalidation, and with different wording. As per Article 26/1(b), the Office may revoke the trademark upon request, if the trademark becomes a common name for the goods or services for which it is registered, as a consequence of the failure of the trademark proprietor to perform its acts, or to take due precautions. The authority of the Office for revocation shall be used by the Courts until 10.01.2024 per Article 192 of the IP Code.

The IPC clarified the "behaviours" of the proprietor in such a way so as to include both the activity and inactivity of the proprietor, for which there is no clear wording in Decree Law No. 556.

In an invalidation action filed when the Decree Law was in force, the scope of the behaviours of the applicant was interpreted by the Court of Appeal ("CoA") in its decision of October 15, 2014 (E. 2014/5775, K. 2014/15593).

In its decision, the CoA, firstly, confirmed the general principle that even if a trademark becomes generic, the genericness of the trademark should be the result of activity or inactivity of the owner in order for the trademark to be invalidated due to its generic traits, and returned the file to the first instance Court for retrial.

The IP Court conducted a detailed re-examination by evaluating and discussing all evidence submitted by the owner of the trademark and by obtaining expert reports. In consequence thereof, the IP Court decided that the trademark was generic; however, the owner had taken the necessary measures to prevent its trademark from being invalidated for becoming generic.

The CoA's decision reinforces the principle that invalidation of a trademark due to its genericness should be possible only if the genericide of the trademark have resulted from the trademark owner's acts or failing to act. To determine this, the CoA sets forth that the Courts should firstly ensure that the evidence and information brought by both parties, and experts' reports obtained, are sufficient to make a determination, and should then profoundly evaluate and discuss the information, evidence and findings within the experts' reports.

The decision shows that a trademark owner should be very careful against the uses of its trademark as a name, should act against such uses when informed, and should keep the records of the actions that it takes to avoid revocation of its trademark due to becoming generic by a Court.

These decisions provide guidance for interpretation of Article 26/1(b) of the IP Code since this Article is very similar to the previous rule.

## The Impact of Non-Use Defence in Criminal Cases

As per the IP Code, trademark protection provided by this law is obtained through registration. However, although registration is necessary to protect the rights of trademark owners and to claim their rights against third parties, this may be insufficient.

Indeed, a trademark must be genuinely used in Turkey with respect to goods and services for which it is registered. However, if the trademark is not genuinely used within five years from registration, or if its use is interrupted for five consecutive years, it may face the risk of cancellation.

Depending on this condition of use, it is also established under Article 19/2 of the IP Code that proof of use of the trademark may be requested; i.e. a non-use defence may be asserted in oppositions that are based on the likelihood of confusion claims, if the trademark that is grounds for opposition, is registered in Turkey, for at least five years at the time of application or priority date of opposed trademark. Articles 25/7 and 29/2 regulate that if these conditions are met, a non-use defence may be asserted in invalidation and infringement actions, as well. The significance of these provisions is that a non-use defence may only be put forward in opposition proceedings, and also in invalidation and infringement actions, if the conditions are fulfilled. However, it is necessary to address a non-use defence by making a dual distinction for civil and criminal cases based on trademark infringement.

Article 29/2 of the IP Code reads, "The provision of Article 19/2 can be put forward as a plea in infringement actions. In that case, the date of the action shall be taken as the basis for determination of the five-year period regarding the use," where it is clearly accepted that in civil cases based on trademark infringements, a non-use defence may be asserted as a plea by the defendant. On the other hand, there is no such provision in Article 30 regulating criminal provisions.

For this reason, in practice, the question of "whether non-use of a trademark is one of the reasons for impunity, and whether it can be assessed by criminal courts, ex officio," is an issue that has come to the forefront, and different opinions have been put forward. According to one opinion, if there is a pending cancellation action filed against a violated trademark on the grounds that conditions of cancellation have been met, then the outcome of this action should be awaited by the criminal court. According to another opinion, if a trademark has not been used on the goods or services for five years, and if the offender makes such a defence and proves non-use of the trademark during prosecution or criminal proceedings, the offender's actions will be recognized as lawful. There is no need to give time to file a cancellation action and to await the outcome of the action.

In a recent case, it was established by the criminal court that since the trademark had been registered for more than five years, and

there was no consecutive use of the trademark in Turkey for the last five years for the disputed products, it should be taken into consideration by the criminal court, ex officio, and conditions of the trademark infringement crime have not been met, but unfair competition provisions should be applied, as the seized products were counterfeit.

At this point, it should be underlined that the non-use defence is clearly regulated as a "plea." However, in this case, the fact that the criminal court evaluated the use of trademark as if it were a civil court, considered the non-use defence to be an objection, instead of a plea, and concluded that conditions of the trademark infringement crime had not been met on the grounds that conditions of the cancellation of the trademark had been fulfilled, this is grounds for impunity without the need for a cancellation action, and is not in line with the law, in our opinion.

In respect of procedural law, a plea may only be asserted by the right holder, cannot be assessed by the judge ex officio, does not end a right, and only prevents its execution. While a non-use defence may be asserted in civil cases based on infringement of a trademark right under certain circumstances, as a result of the clear regulation of the IP Code, in terms of criminal cases, it cannot be asserted during prosecution or criminal proceedings, and it should not also be taken into account by the prosecution office or the criminal court, ex officio.

Counter-comments exceed the will of the legislator because a non-use defence may also be asserted in invalidation and infringement (civil) cases if conditions are met. As there is no reference made to criminal cases, a non-use defence cannot be taken into consideration in criminal cases.

However, if there is a pending cancellation action that may affect the criminal case, as the offender's acts may be excluded from a trademark infringement due to a cancellation verdict with retrospective effect, it would be the correct decision for the criminal court to await the outcome of the cancellation action.

## Recent Practice on Color Marks in Turkey

One of the major changes brought by the IP Code that came into force on 10 January 2017 is on non-traditional marks and, especially, on color marks. Although it was also possible to register color marks prior to the change of legislation, in practice, the use of an internationally recognized color code within the application form was not possible, hence color codes were mentioned by a separate petition, and the applications were considered as “device trademarks” within the records. Accordingly, trademarks were not particularly identified as having color marks in the records of the Turkish Patent and Trademarks Office (the Office), which caused uncertainties, in practice, while enforcing the trademarks.

After the IP Code came into force, implementations concerning non-traditional marks, the color marks changed, and it became possible to file applications using color marks by indicating the Pantone code. In the application form, it must be explicitly stated that the application is filed with a color mark. The Pantone code(s) must be specified within the name of the trademark section, and the color applied for registration must be displayed under the trademark sample section without any colorless part in the space reserved for this. The trademark sample also should not consist of any frames.

In terms of the evaluation regarding the distinctive character of the color marks, this must be conducted in two aspects, one being

the “marks consisting of a single color,” and the other being the “marks featuring a combination of colors.”

It is accepted that the marks consisting of a single color have a less distinctive character, as compared to those that feature a combination of colors. In this respect, similar to the prior implementation of the Office, it must be proved with adequate evidence that these types of marks have acquired distinctiveness by means of use. Furthermore, with a similar approach adopted in traditional marks, colors are often accepted to be descriptive for the specified goods/services, in the event where they are commonly used in the sector, or where they have a descriptive character of the goods/services for which the mark is used, e.g. “yellow,” suggesting lemon-flavored products, or “green,” suggesting mint-flavored products.

Furthermore, as stated in the Trademark Examination Guideline, it is accepted that the provision of a broad and exclusive right on colors does not comply with a balanced competition system, since it may lead to an unfair competitive advantage for a single enterprise. For this reason, the public benefit must be considered in order to ensure that other enterprises are not subject to unjust restrictions in terms of the use of color on the same kinds of goods/services with those that are subject to registration.

Accordingly, although filing an application for a single color is possible before the Office in

<sup>1</sup> Trademark Examination Guideline, 2019, page 72.



Turkey, similar to the previous practice, these types of applications are normally rejected during examination on absolute grounds and, unless their acquired distinctiveness is proven with sufficient evidence, it is also difficult to convince the examiners during the appeal phase.

Regarding the marks featuring a combination of colors, these types of marks are accepted to have a higher degree of distinctiveness, as compared to the marks that have a single color. When determining the distinctiveness of a mark featuring a combination of colors, the following criteria is taken into account: Whether the color combination is commonly used in the sector for the relevant goods or services; whether it has a functional quality for the relevant goods or services; whether the colors are only perceived as an ornamental element; and the impact and impression of the mark on the related consumer mass, in respect of its appellation of the origin of the product.

In addition, although not mandatory, it is recommended for the applicants to specify the location and distribution ratio of the colors comprising the color combination for the marks that feature a combination of colors.

In the event that a color combination is not formed on a previously determined and integrated order, it prevents the criteria of explicit and definite display of the subject of the protection in the registry from being

fulfilled, since there are numerous possible variations. The explanations must comply with the display, and must not expand the scope of the protection, since the scope of the protection is determined only by the display. Together with the above changes in respect of color marks, by which the borders of registration become more clear, company owners have begun to file new applications for the colors of their entities and/or brands in order to strengthen visual distinctiveness and memorability of their brand, products and services. Therefore, the number of applications filed with color marks before the Office increased after the IP Code entered into force.

## The New Trademark Examination Guideline

TÜRKATENT published The New Trademark Examination Guideline (“the Guideline”) on September 30, 2019. The Guideline defines the criteria regarding the examination of trademark applications on absolute grounds for refusal within the scope of the IP Code that came into force in 2017.

The Guideline updates the previous guideline that had been in force since 2011, clarify the principles of absolute grounds for refusal that are explained in the IP Code, and provides consistency in the Office’s decisions. The Guideline comprises a number of examples, which include the decisions of the Office and the Courts, as well as the recent developments in the EU. Especially, Article 5/1(c) regarding descriptiveness, and Article 5/1(ç) regarding indistinguishable similarity to a senior trademark or trademark application, are discussed, in detail, providing numerous examples.

While the Guideline includes details and a number of examples, the highlighted points are summarized, as follows:

- With regard to the representation of the trademark in the registry, it states that since graphical representation is not required, it is sufficient to upload videos and voice recordings for the applications of sound marks. Furthermore, it is highlighted that for color mark applications, the section for the color example must be filled in, fully, and the “Pantone” color code must be indicated;
- With regard to “distinctiveness” and “descriptiveness,” the main criteria that should be taken into consideration for the evaluation of the trademark applications are noted, and it is emphasized that i) the trademark to be registered should be evaluated, together with goods and services that are the subject of the application, ii) the application should be evaluated as a whole, and iii) the perception of the target consumers should be taken into consideration. Many examples are provided for word marks, slogans, device marks, color marks, color combination marks, voice marks, movement marks, and trademarks, including INNs, etc.; and
- With regard to an indistinguishable similarity to a senior trademark or trademark application, it is specified that there will be an ex officio similarity evaluation by the Office for the same, or indistinguishable, trademarks, and it is emphasized that i) if there are two composite marks under evaluation, the overall impression that the marks leave will be taken into consideration, ii) if there is one composite, and one non-composite, mark under evaluation, the evaluation will be made upon the distinctive elements, iii) the distinctiveness level of the trademarks, such as low-middle-high should be taken into consideration while the protection scope is determined. Many examples are

provided for indistinguishable similarities of trademarks, which include phrases such as OPTIMUM, GLOBAL, STAR, BY, THE, MY, GROUP, EURO, PLUS, SMART, EXTRA, PURE, SOFT, and LIFE, as well.

The Guideline has helped to shape practices, and has provided consistency of the Office's decisions, especially before the appeal board of the Office. The Office is currently working on the second part of the Guideline that will address the examination of trademark applications on relative grounds, the publication of which is expected within the second or third quarter of 2020. We predict that this second Guideline will continue to assist the practice, by providing guidance to both examiners and practitioners, which will hopefully lead to high quality decisions by the Office.

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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 Authority ("TÜRKPATENT"), customs, domain name authorities. Some of our lawyers are also qualified as trademark and patent attorneys authorised to act before the TÜRKPATENT.

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.

