

# Turkey: Protection of "Well Known" Trademarks Which are not Registered in Turkey Within the Context Of Article 7/1(I) of the Decree Law No. 556

Last Updated: 4 November 2010

Article by Uğur Aktekin and Hande Hançer  
Gun & Partners

The widely accepted principle in respect to the legal status of Trademark Rights is the "territoriality principle" as is also the case for other Intellectual Property Rights. The territoriality principle is also in effect under Turkish Trademark Law and it is regulated under the Decree Law Pertaining to the Protection of Trademarks numbered 556 ("Decree Law No. 556"). Accordingly, with Article 6 of the Decree Law No. 556 which states that "*Protection for a trademark under this Decree-Law is obtained by registration,*" it is explicitly set forth that in order for a trademark to be protected in Turkey, it must acquire its legal status by registration in Turkey.

The basic principle is that foreign real or legal persons cannot introduce claims in Turkey based on trademarks that are not registered in Turkey, however this principle is subject to exceptions. The most explicit exception to this rule is granted to the "well known trademarks as per Article 6 bis 1 of the Paris Convention" in pursuance of Article 7/1(i) of the Decree Law No. 556.<sup>1</sup> Article 7/1(i) of the Decree Law No. 556 sets forth that "*well known marks according to 6bis of the Paris Convention, use of which are not permitted by their owners*" cannot be registered as a trademark and accepts this situation as an absolute ground of refusal. Article 6 bis 1 of the Paris Convention for the Protection of Industrial Property<sup>2</sup> dated March 20, 1983 is as follows: "*The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.*"

Accordingly, when a "Well Known" trademark is not registered in a foreign country and the same or confusingly similar version of this trademark is registered or applied to be registered in Turkey in the name of third persons without the authorization of the owner of this trademark, the owner of the well known trademark is entitled to demand the cancellation of the trademark as per Article 7/1(i) according to Article 42 of the Decree Law No. 556. The "Well Known" trademark owner may also oppose the mentioned trademark application based on the same article. In this regard, the owner of the "Well Known" Trademark, within the framework of the Paris Convention, is entitled to appeal, by the appropriate legal means, on the basis of its well known status against trademark registrations or applications to be registered in the name of another person without the owner's authorization.

Within the framework of Article 6 bis 1 of the Paris Convention and Article 7/1(i) of the Decree Law No. 556 with reference to the latter, it is possible to declare the necessity to protect the "Well Known" Trademarks within the context of the Paris Convention on the same or similar goods and services even if they are not registered in Turkey as this has been regulated as an absolute ground of refusal under Decree Law No. 556. However it is not clear how the well known trademark within the context of the Paris Convention will be protected with regards to different goods and services.

In this study we will first explain the concept of the "Well Known Trademark within the context of the Paris Convention" and then we will discuss the scope of the protection granted to "Well Known" Trademarks even if they are not registered in Turkey.

## A. The Concept of the "Well Known Trademark within the context of the Paris Convention"

In accordance with the leading doctrine, it is accepted that the concept of the "Well Known Trademark within the meaning of [the] Paris Convention" is different from the notion of a "Trademark Known Worldwide" or a "Famous Trademark." Although a firm definition does not exist in this regard, some authors define the "Well Known Trademark within the meaning of [the] Paris Convention" as the "trademark known by the related parts of [the] public in the country and abroad, belonging to citizens or habitants or the owners of commercial or industrial enterprises of one of the member states of the Paris Convention<sup>3</sup>." However other authors mention that it is sufficient that the trademark is known by the part of the public related to the good(s)/service(s) in question in the country where the protection is sought, in order for the Trademark to be accepted as "Well Known" in the course of implementation of the Paris Convention<sup>4</sup>.

The public that is to be considered regarding the implementation of the related provision of the Paris Convention vis-à-vis the protection of well known trademarks is *"not the government authority to which the registration demand is directed to be acquainted with the well known status of the trademark, but the related part of the public to know the trademark in question"*<sup>5</sup>. As a matter of fact, as is accepted by some authors, in granting protection in Turkey to a well known trademark within the meaning of the Paris Convention, its use in Turkey is not required<sup>6</sup>. In other words, it is sufficient that a trademark "is known in the sector related to the good/service" for it to be accepted as a "Well Known Trademark within the meaning of [the] Paris Convention"<sup>7</sup>.

In point of fact the related precedents of the High Court confirm this approach. For instance, in the COCPIT-KOKPIT decision<sup>8</sup> of the 11th Chamber of the High Court it was ruled that: *"It is sufficient for these types of trademarks to benefit from Article 1 bis 6 of the Paris Convention that the trademark for which the protection is demanded [is] (publicly known) in Turkey. Even in cases where the publicly known good is not produced in Turkey nor [] imported, since it is always possible that this publicly known good [will] be brought into our country and be sold, it is thought to be against the principles of good faith that this trademark is put on the same kind of goods with the purpose of being associated with a well known trademark and gaining advantage from its reputation and it is protected."*<sup>9</sup> Along the same line, in the ROCCO BAROCCO decision<sup>10</sup>, the following principle was explicitly stated: *"Even if the well known trademark registered in one of the countries being party to the Paris Convention of which Turkey is also a party and the goods bearing this trademark have never been brought to Turkey, they will be regarded under protection in our country in pursuance of Article 6 bis of the mentioned Convention."*<sup>11</sup>

The BLACK&DECKER decision<sup>12</sup> of the 11th Chamber of the High Court clearly stated that *"...Our Chamber, all along the line, adopted decisions envisaging that the well known trademark registered in one country being party to the Paris Convention and the goods bearing this trademark shall be protected by our national laws as per Article 6 bis of the Convention even if they are not known in our country. On the other hand, with Article 16/2 of the TRIPS Agreement of which our country is a party, more precise criteria is determined with regard to the well known state and it is emphasized that the recognition by everyone in the related sector of the trademark is an important parameter in the determination of a well known trademark"* and it is underlined that the recognition in the related sector is sufficient for the trademark to be accepted as well known. Finally, in a recent decision numbered 2007/7160 E. and 2009/12579 K. which was not published, it was also clearly stated that *"...the condition of being used in Turkey is not sought for the foreign trademark to be accepted as well known..."*.

As shown, the concept of a "well known trademark within the meaning of [the] Paris Convention" is used to refer to the known trademarks in the related sector regardless of their use in Turkey and there is consensus on this in the TCA decisions.

## B. Scope of the Protection

It became established in Doctrine and in court decisions that if the trademark of the "Well Known" Trademark owner, who does not have any registered rights in Turkey, has been registered or applied to be registered in the name of a third person for the same and/or similar goods without authorization, this well known trademark shall have priority protection against the trademark that is registered or pending registration in Turkey.

In fact the "Vitrablok" decision of the 11<sup>th</sup> Chamber of the High Court dated 13.3.1998 and numbered E.1997/8665 and K. 1998/1705 stated that *"In accordance with the Paris Convention accepted by the Turkish Republic as well, the citizens of the states included in the union formed with the convention, benefit from the rights with regard to industrial property which are granted to its own citizens by the mentioned state even if they do not have residence or business in that state. As is adopted in the established practice of the High Court, the well known trademark is protected even if it is not registered in Turkey. On the other hand since it is understood that the trademark of the plaintiff falls [with]in the scope of the 11<sup>th</sup> Class while the product manufactured by the defendant falls within the 17<sup>th</sup> Class, that they take part in different classes and they are not in the same group and that the defendant uses its trademark as it is registered and no likelihood of confusion is created, the ruling regarding the refusal of the action shall be approved."*

In the same manner it was ruled in the "Dolce Vita" decision of the 11<sup>th</sup> Chamber of the High Court numbered 6.7.1998 and dated and 1998/1734 E. and 1998/5146 K that *"In that case as per the explicit provision of Article 6 bis of the Paris Convention, the production and the use of the trademark is not a definitive condition in order to protect the trademark which is registered in the country of one of the contracting parties and which is evidently known, it is sufficient that it becomes known to the consumers and to the related part of the public through registration. The production of a trademark shall not be sought additionally if it is registered in 22 countries and known by the consumers and related part of [the] public of these countries."* It was also ruled that the "Dolce Vita" trademark which is not registered in Turkey shall be preferably protected.

In line with this in the 18.12.2000 dated and 2000/8992 E and 2000/10212 K numbered decision of the 11<sup>th</sup> Chamber of the High Court it was accepted that *"taking into account the claims, defenses and the scope of the file" that "[because] the Killer Loop trademark of the plaintiff company is not registered as [a] trademark in Turkey, the defendant company registered the trademark of the plaintiff in the same writing style in 1993 and uses it since then in similar countries, the catalogues, introductory documents, evidence with regard to registrations in different countries submitted by the attorney of the plaintiff is a material parameter of the well known status of the plaintiff's trademark, the fact that the defendant company adopted the plaintiff's trademark exactly and completely and registered it in the same writing style is the most precise ad material evidence that these two English words were chosen especially in order to gain benefit from its reputation."*

On the other hand, the High Court in its recent "KEUNE" decision, dated 17.05.2005 dated and numbered E. 2004/7142 and K. 2005/5233, emphasized that this principle is still adopted by stating that *"the plaintiff's trademark is a 'well known trademark' within the context of Article 6 bis 1 of the Paris Convention with the reference of Article 7/1 of the Decree Law No. 556, on the ground that the KEUNE trademark shall be accepted to be known in Turkey taking into consideration the number, date and date ranges of the international registrations and the correspondence and documents in the file, the action shall be partially accepted and the KEUNE phrased device trademark registered in the name of the defendant before the TPI shall be cancelled as per Article 42(a) of the 556 numbered Decree Law and it shall be deleted from the registry..."*

The issue of protection for different goods and services of the "Well Known" Trademarks within the context of the Paris Convention which are not registered in Turkey is not clear. However we are of the opinion that the protection of the "Well Known" trademarks for different goods and services is not disallowed because Article 7/1(i) of the Decree Law No. 556 rules that the *"well known marks according to 6bis of the Paris Convention, use of which are not permitted by their owners"* cannot be registered as a trademark without making a distinction between the same, similar and different goods and/or services.

In addition Article 16/3 of TRIPS (the World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property Rights) rules that Article 6 bis 1 of the Paris Convention, mentioned above, will be implemented for different goods and services as well.

Since the discussion in this respect still continues, the High Court of Justice does not have an established precedent. However in the 24.10.2005 dated and E. 2004/12807 and K. 2005/10230 numbered "ALDI" decision of the 11<sup>th</sup> Chamber of the High Court of Justice this principle is confirmed. In this case the subject to the decision, the plaintiff, based on the "ALDI" phrase which is not registered in Turkey but is registered in some countries in Classes 9 and 16 and bearing the well known status and constituting the distinctive core of its trade name, demanded the cancellation of the defendant's trademark registered in Classes 35 and 36. In its decision the High Court stated that *"with Article 16/3 of the mentioned Agreement the implementation area of Article 6 bis 1 of the Paris Convention is expanded, the protection for different goods and services of well known trademarks is maintained. 'The relevant sector' can be defined as real or potential buyers, business environment in this field and people on the distribution channels sellers in Turkey of the goods and services on which the trademark is used"* and consequently decided on the reversal of the Regional Court on the ground that it had to decide *"as per the result of the determination whether the trademark of the plaintiff is known by the relevant sector of public by way of a report prepared by experts taking into consideration the mentioned regulations."*

## Footnotes

1. 19.11.2003 dated and 2003/11-578 E. and 2003/703 K. numbered "LECCE PEN" decision of the General Assembly of the High Court of Appeals.
2. Turkey became party to the Paris Convention in 1925, adopted the La Haye text of the Paris Convention in 1930, approved the London text in 1957, accepted the Stockholm text of the Agreement in 1975 by reserving Articles 1-12, and in 1994 abrogated these reservations with the 94/5093 numbered Council of Ministers decision and accepted the Stockholm text totally.
3. TEKİNALP, Ünal; Intellectual Property Law, İstanbul 1999, p. 379.
4. ARKAN, Sabih; Trademark Law, V.I, Ankara 1997, In the same direction DİRİKKAN, Hanife; Protection of the Well Known Trademark, Ankara 2003, p.53-54.
5. Sabih ARKAN, "Protection of the Foreign Trademarks in Turkey", Batider 1999, V. XX, Issue 1, p. 8.
6. TEKİNALP, Ünal; The Registration Principle in the Recent Trademark Law and the Legal Status of the Non-Registered Signs, In Honour of Kenan Tunçomağ, İstanbul 1997, p. 473; In the same opinion: ARKAN, Sabih; mentioned work, p.8; In fact in its 2007/227 E. and 2008/82 K. numbered decision, the 2nd Intellectual and Industrial Property Rights Court of Ankara explicitly puts forth this matter by stating that *"in order to attribute well known status to a trademark, since it is not necessary that it is used within the country and since the important matter is that the existence of the trademark being known in the related sector(retailing) is sufficient."*
7. DİRİKKAN, Hanife; Protection of the Well Known Trademark, Ankara 2003, p. 51 *"The objective of the Paris Convention is to prohibit that unfair advantage [] gained from a trademark well known in one country [] or in others (...) It is not acceptable in international commerce that the person who registered a trademark well known in one country or in more without any requirement for it to be protected."*
8. 23.6.2000 dated and 2000/5902 E. and 2000/5459 K. numbered decision of the 11th Chamber of the High Court of Justice.
9. In the same direction, the 13.3.1998 dated and 1997/8665E. and 1998/1705 K. numbered "Vitra" decision of the 11th Chamber of the High Court stating that *"In pursuance of the Paris Convention signed by the Turkish Republic, the citizens of the states being party to the union formed by the treaty in question, even if they do not reside or operate in trade in another country, benefit from the rights granted to [] citizens of the mentioned country with regard to intellectual property rights. As is adopted in the consistent practice of the High Court of Justice the well known trademark is protected in Turkey even if it is not registered in Turkey."*
10. 13.4.2000 dated and 1999/9678 E. and 2000/3001 K. numbered decision of the 11th Chamber of the High Court of Justice.
11. Along the same line the 24.03.2003 dated and 2002/10575 E. and 2003/2752 K. numbered "MAS" decision of the 11th Chamber of the High Court of Justice: *"The trademarks known at least within the country and abroad by the related part of [the] public, even if they are not known worldwide and which belongs to citizens of the countries being party to the Paris Convention or their residents or to the people owning commercial or industrial enterprises, are meant with the notion of Well Known Trademark, not the trademarks which are known in one part or several parts of a region."*

12. 09.12.2004 dated and 2004/1146 E. and 2004/12103 K. numbered decision of the 11th Chamber of the High Court of Justice.

13. Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) is the 1C Annex of the WTO Foundation Agreement signed on 15.04.1994 and came into effect on 01.01.1995. Turkey approved the WTO Foundation Agreement on 26.01.1995 with the 4067 numbered Law. Turkey has become party to TRIPS by approving this Agreement. Agreement text and other supplementary agreements with TRIPS are published in the Council of Ministers decision.

*The content of this article is intended to provide a general guide to the subject matter. Specialist advice should be sought about your specific circumstances.*