

Patent Institute accepts right to stage name as sole ground for refusal
Turkey - Gün + Partners

Examination/opposition
Registration
National procedures

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Facts

In the first of two recent Turkish Patent Institute (TPI) decisions, the applicant filed a trademark application for the phrase 'Iana del rey', seeking registration in Classes 25 and 35. The opponent – who had been using this phrase as her stage name for years and had become a world-renowned singer and songwriter under that name, and also had trademark registrations abroad for this phrase – filed an opposition against the application. The opposition was based on:

- the opponent's genuine right to ownership pursuant to Article 8/3;
- the opponent's right to her stage name pursuant to Article 8/5; and
- the applicant's bad faith pursuant to Article 35 of Decree Law 556 on the Protection of Trademarks (Decree Law).

In the second TPI decision, the applicant filed a trademark application for the phrase 'Dr. Dre', seeking registration in Class 25. The opponent – who had also been using this phrase as his stage name for years and had become a famous singer, producer and entrepreneur under that name, and had trademark registrations abroad for this phrase – filed an opposition against the application. The opposition was based on:

- the opponent's genuine right of ownership pursuant to Article 8/3;
- the well-known status of the trademark pursuant to Article 8/4;
- the opponent's right to his stage name pursuant to Article 8/5; and
- the applicant's bad faith pursuant to Article 35 of the Decree Law.

Upon examination of both oppositions, the TPI accepted the argument based on the opponents' rights to their stage names pursuant to Article 8/5 and refused the applications on this ground. The TPI refused all other grounds of the oppositions.

Analysis

Article 8/5 of the Decree Law states that:

"upon opposition by the holder of the relevant right, the trademark applied for shall not be registered if it contains the name, photograph, copyright, or any industrial property rights of any third parties."

The article stipulates third parties' intellectual or industrial property rights, apart from registered trademarks protected under Article 8/1(b) and non-registered trademarks protected under Article 8/3, as a relative ground for refusal of a trademark application which contains that right.

The TPI usually adopts a narrow approach in implementing Article 8/5 and is hesitant about invoking this article as a relative ground for refusal of a trademark application. Indeed, in a number of decisions, the TPI has refused arguments based on opponents' rights to their trade names or logos, whereas it has accepted other grounds of opposition.

Contrary to this narrow approach, in the aforementioned two decisions the TPI adopted a broad interpretation of Article 8/5 in respect of third parties' rights to their names. Even though the article mentions only third parties' rights to their 'names' as a relative ground for refusal, the TPI construed this term widely to include the opponents' stage names in scope of the term 'name' and refused the applications on that basis. This shows that the TPI confers protection not only to the actual names of the individuals but also on their stage names due to their association with those individuals.

There was no mention in the TPI's decisions about the requirements for accepting the argument based on opponents' rights to their stage names. However, the TPI's Trademark Examination Guidelines of 2015 refer to the general requirements for the right to be used before the application date of the opposed application and to belong exclusively to the opponent for the implementation of Article 8/5. Indeed, evidence – including webpages and articles, images from the opponents' social media accounts and trademark registrations abroad showing prior dated use of the stage names and the opponents' exclusive rights to those names – was submitted by both oppositions, which arguably led the TPI to accept the argument based on the stage

names.

The guidelines also refer to the “last names and nicknames of *famous* persons”, later referring to those persons as “having recognition at national or international level”. Therefore, it appears that the TPI requires a stage name to have a certain degree of recognition so as to be associated with the opponent, even though it apparently does not require the stage name to be well known, for example the TPI refused the well-known status argument of the trademark in the ‘Dr. Dre’ opposition.

Article 8/5 of the Decree Code is also preserved in its current form in the Draft Code, which has recently been sent to the Grand National Assembly to be enacted and is expected to enter into force in June or July. Article 6/6 of the Draft Code, which has similar wording to the present Article 8/5, reads:

“upon opposition by the holder of the relevant right, the trademark applied for shall not be registered if it contains the name, trade name, photograph, copyright, or any industrial property rights of any third parties.”

Therefore, the protection conferred on the individuals’ rights to their names, including their stage names, is expected to be maintained after the Draft Code enters into force.

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