

NEW TOOLS FOR TMs

Turkey's revised trade mark law has been widely welcomed, says Mutlu Yıldırım Köse

Turkey's Industrial Property

Code No. 6769 (IPC) came into force on 10th January 2017 and brought in a number of new rules, with the major amendments relating to:

- letters of consent;
- non-use defence in opposition and litigation proceedings; and
- time limits for cancellation actions.

Importantly, the IPC introduces the principle of coexistence into Turkish trade mark law. Accordingly, letters of consent from the senior trade mark owner or trade mark application owner have become a new tool in overcoming the citations of earlier, senior and identical, or indistinguishably similar, trade marks by the Turkish Patent and Trademark Office as an *ex officio* refusal ground.

NON-USE DEFENCE

Another change that directly affects IP practice is the non-use defence. According to the IPC, if the ground trade mark was registered more than five years from the application date (or priority date) of an opposed trade mark application, on request by the owner of the trade mark application, the Office is obliged to ask the opponent to prove the effective usage of the ground trade mark on the relevant goods and/or services in Turkey. The mechanism of a non-use defence is applicable to invalidation and infringement actions as well.

On 28th April 2017, the Office published proof-of-use guidelines, taking into consideration the precedents of EUIPO and the CJEU. The Office stated that the effective use of ground trade marks can be proven with a range of evidence,

including: invoices; catalogues; price lists; product codes; products; packaging; signboard visuals; advertisements, promotions and their invoices; marketing surveys and research; and information about commercial activity in Turkey.

As this procedure is entirely new in Turkey, the evaluation of the

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evidence submitted has not been tested, but it seems that the most important documents for proving use of the trade mark will be invoices and documents that show the production and sale of the products bearing the trade mark.

TIME LIMITS

Further, the IPC introduced a new rule concerning the time limits for

filing a cancellation action and adopted the principle of “loss of right due to acquiescence”, which is the same in EU trade mark law. According to this new rule, there is no time limit for filing an application for a cancellation, but, if the owner of an earlier right acquiesces in the use of a later trade mark for a period of five successive years, the senior trade mark owner will no longer be entitled to file a cancellation action, except in cases where the later trade mark was filed in bad faith.

What's more, the graphical representation criteria for signs has changed to “signs capable of being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor” – and “colours” and “sounds” are explicitly stated under “signs” that can qualify as a trade mark. In addition, bad faith has been added as a separate ground for opposition.

Although settled precedents remain to be established, these changes have been widely welcomed by brand owners and Trade Mark Attorneys operating in Turkey.



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