

Turkish Patent and Trademark Office issues guidelines for proof of use in opposition proceedings
Turkey - Gün + Partners

National procedures
Policy

May 18 2017

Following the entry into force of the Industrial Property Code (6769) on January 10 2017 and the Regulation on the Implementation of the Industrial Property Code on April 24 2017 (see [“New IP Code enters into force: 2017 will be the year of IP rights”](#) and [“Entry into force of new Regulation on the Implementation of the Industrial Property Code”](#)), on April 28 2017 the Turkish Patent and Trademark Office (TPTO) published the Proof of Use Guidelines, which regulate the submission of evidence of genuine trademark use.

One of the major changes introduced by the Industrial Property Code in relation to trademarks is that the non-use defence/proof of use request can now be availed of at the opposition phase as well as cancellation and infringement actions. According to Article 19 of the code, if the trademark on which the opposition is based has been registered for more than five years as of the application or priority date of the opposed trademark application, on request by the owner of the trademark application, the TPTO must ask the opponent to prove the effective use of its trademark in relation to the relevant goods or services in Turkey. As per Article 29 of the implementing regulation, the TPTO will grant the opponent one month to submit its evidence of genuine use.

The Proof of Use Guidelines were prepared in light of EU Intellectual Property Office and European Court of Justice precedents. They regulate the submission of evidence of trademark use and the TPTO's interpretation of such evidence. In this regard, the TPTO has stated that the effective use of trademarks can be proven by submission of invoices, catalogues, price lists, product codes, products, packaging, signboard visuals, advertisements, promotions and their invoices, marketing surveys, opinion research, information regarding the trademark owner's commercial activity and any other documents or statements relevant to Turkey. These documents must contain sufficient information on the characteristics, place and time of use of the trademark.

According to the guidelines, evidence should be submitted along with an evidence list in the form stipulated by the TPTO – in particular, the evidence should sufficiently classified and designated and the list should be in A4 format. Further, the relevant trademark should be stipulated at the top of each page of the evidence document, the information showing the effective use of the trademark should be highlighted and the total page count of the evidence document should be indicated. It is advised that the evidence document not exceed 100 pages.

The guidelines clearly consider invoices to be the best evidence of trademark use in Turkey. Invoices must contain sufficient information on the nature, location, time and scope of use of the trademark in relation to the goods or services for which it was registered. If the invoice includes information on more than one trademark, good or service, the relevant trademark and goods or services should be highlighted and the trademark registration number should be written on the relevant invoices, so that the examiner can clearly discern which evidence is related to which trademark and goods or services.

The guidelines mention that catalogues, price lists and product codes are ancillary evidence of effective trademark use. If the goods or services relate to a product code in the invoices, explanatory information must be submitted regarding the link between the product code and the relevant trademark. Otherwise, if an invoice cannot be associated with the goods or services and the trademark during the examination, the TPTO may not accept it as evidence.

The guidelines expand on the evidence specified under Article 30 of the implementing regulation, indicating that products, packaging, loose issue stock and signboard visuals are accepted as sufficient evidence of trademark use (if they stipulate the date). The TPTO requests that samples of such evidence be submitted to facilitate the examination process.

As per the guidelines, advertisements, promotions and their invoices, marketing surveys and opinion research demonstrate that the trademark owner has invested in the trademark and are thus accepted as proof of use. The TPTO has stated that relevant videos may be submitted in CD format, but this must be indicated on the evidence list. Since advertisements and promotions demonstrate investment in trademarks, advertising budgets should also be submitted to prove sustained use of the relevant trademark.

The guidelines stipulate that information on the trademark owner's commercial activity can be submitted as evidence of use, provided that such information is associated with the effective use of the relevant trademark (eg, prizes, awards and quality certificates).

With regard to online sales, website visuals may be used as evidence of effective trademark use in Turkey. If the relevant trademark is used as a domain name, such visuals and visitor statistics for the website can also be submitted as evidence.

Detailed and tangible statements may also be submitted as evidence. However, under Turkish law such statements are merely discretionary evidence and are not binding on the TPTO.

Submitted evidence must contain sufficient information on the nature, location, time, scope and use of the trademark in relation to the goods and services for which it was registered. The guidelines clarify the types of evidence that the TPTO will consider during the opposition examination. The timeframe for examination of the opposition action will be shortened if the submitted evidence complies with the criteria set out in the guidelines.

In order to submit evidence that complies with the guidelines, trademark owners opposing a subsequent trademark application should first use their trademark seriously and continuously in Turkey. If they fail to do so, they should submit justified reasons for non-use (eg, financial difficulties or the occurrence of a natural disaster).

The Industrial Property Code sets out timeframes for requesting proof of use and submitting evidence in this respect. According to Article 29 of the implementing regulation, the applicant must notify the TPTO of its request for proof of use within the one-month period provided for it to submit its response to the opposition. The opponent will then have one month to submit evidence of genuine use of its trademark in Turkey. If the TPTO deems the submitted evidence to be insufficient, it will grant the opponent one additional month to submit further evidence. Therefore, when filing an opposition against a trademark application in Turkey, trademark owners should be mindful of the non-use defence/proof of use request available to the applicant and should be ready to submit evidence of serious use of their trademarks.

In this respect, preparing a file including invoices, customs certificates and similar evidence of use before filing the opposition will speed up the process. If the evidence includes sufficient information on the nature, location, time and scope of use of the trademark in relation to the goods or services subject to opposition as per the guidelines, the timeframe for the TPTO's examination of the opposition will be shortened considerably.

If the opponent fails to prove use of its trademark or the evidence submitted is unrelated to the trademark's use and no other claims are made, the TPTO will refuse the opposition.

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