



Debate on well-known trademark registry expected to be resolved soon

Uğur Aktekin and Begüm Soydan Sayılkan

Gün + Partners

31 October 2022



TURKEY

Legal updates: case law analysis and intelligence

- The PTO is determined to maintain its well-known trademark registry, even though the Court of Cassation held that it has no authority to do so
- Rights owners may continue to file applications for the recognition and recordation of their trademarks as well known before the PTO
- New regulation is expected to give the PTO explicit authority to keep the well-known trademark registry

Background

In 2020 the Court of Cassation concluded that the Patent and Trademark Office (PTO) had no authority to create and maintain a registry for well-known trademarks (see [here](#) for a discussion of the possible repercussions of this decision for trademark owners).

The Court of Cassation's decision (No 2019/2980 E-2020/991 K, 5 February 2020) was then finalised, as the Court of First Instance complied with the decision. Although the plaintiff appealed the decision of the first-instance court, the same chamber of the Court of Cassation examined the case and the appeal was dismissed. Therefore, the decision of the Court of First Instance rendered in accordance with the Court of Cassation's decision became final.

This update examines how practice has been shaped in light of this decision, and predicts what to expect in the future.

Latest developments since finalisation of decision

On the one hand, the first-instance courts and Regional Courts of Appeals have adopted the decision of the Court of Cassation and given dismissal decisions in pending court actions of the same nature. In these dismissal decisions, the courts made reference to the decision of the Court of Cassation and the reasoning was the same: the PTO has no authority under the law to keep an official registry of well-known trademarks, and there is no legal benefit in initiating a cancellation action against a PTO decision rejecting an application to record a trademark as well known, since the well-known status of a trademark should be proven on a case-by-case basis and argued in accordance with established precedents.

On the other hand, the PTO has continued to maintain its registry of well-known trademarks, and has accepted, processed and even recorded new trademarks. The PTO has also listed the official fee for filing for the recognition of a trademark as well known in its updated 2022 tariff - another indication that it will continue its practice.

Further, the newly appointed president of the PTO made a statement regarding the office's decision in relation to the well-known trademark register at a consultation meeting with trademark attorneys in Ankara. The president stated that the PTO has no intention to abandon its practice in the future, as this would be a very burdensome task. He also stated that there is a plan to amend the relevant provisions of the legislation by adding "holding a specific registry for well-known trademarks" among the duties of the PTO, which should be sufficient to overcome the reasoning of the Court of Cassation (which found the practice of maintaining a well-known trademark registry to be without legal basis). The president also emphasised that the PTO had been receiving applications for the recordation of well-known trademarks, even after the decisions of the Court of Cassation, and that it had recently started to examine these applications.

Difference in approaches expected to be eliminated soon

At present, the courts and the PTO follow a different interpretation and implementation concerning the recordation of well-known trademarks. While the courts follow the decision of the Court of Cassation, the PTO has not changed its practice - despite the finalisation of the decision. It is expected that this difference will be abolished thanks to a new regulation that will explicitly give the PTO the authority to maintain the well-known trademark registry.

As the PTO has kept its longstanding practice, rights owners may continue to file applications for the recognition and recordation of their trademarks as well known if there is sufficient evidence (ie, if the chances of success seem high). However, if an application for the recordation of a trademark as well known is rejected, there is no benefit in filing a court action against the PTO's decision unless the current legislation remains unchanged, in view of the decision of the Court of Cassation.

Uğur Aktekin

Author | Partner

ugur.aktekin@gun.av.tr

Gün + Partners

Begüm Soydan Sayılkan

Author | Senior associate

begum. soydan@gun.av.tr

Gün + Partners