



TRADEMARK LAW IN TÜRKİYE
KEY DEVELOPMENTS AND PREDICTIONS

2025

Trademarks and Designs

We provide wide ranging and comprehensive legal services in relation to trademarks and designs. Our comprehensive services include advisory, prosecution, watch, opposition, appeals, enforcement, litigation and transactional services on all aspects of trademarks and designs including registration and enforcement strategies, IP due diligences as well as availability searches and clearance opinions.

We are authorised to represent clients before civil and criminal courts, and court of cassation as well as all administrative authorities such as Turkish Patent and Trademark Office ("TURKPATENT"), customs, domain name authorities. Some of our lawyers are also qualified as trademark and patent attorneys authorised to act before TURKPATENT.

We regularly handle nullity and invalidity, cancellation, well-known trademark protection, anti-dilution, passing off, unfair competition and trade dress actions and large scale damages claims before courts as well as customs seizure applications and criminal and civil searches and seizures.

Combining our litigation, transaction and industry knowledge we draft, negotiate trademark and design related agreements and transactions including manufacturing, toll-manufacturing, co-existence, co-promotion settlement and licensing agreements.

Introduction

The year 2024 can be described as a stable yet relatively uneventful period for Turkish trademark law, with no major legislative changes or ground-breaking reforms.

As of 10 January 2024, the regulation allowing the administrative revocation of trademarks before the Turkish Patent and Trademark Office officially entered into force. However, the anticipated secondary regulations were not implemented, leaving uncertainties surrounding the process throughout the year. Similarly, the uncertainty surrounding the Well-Known Trademark Registry remains unresolved. One notable development in concern with the Turkish Patent and Trademark Office was the update to the trademark classification system.

In terms of case law, a significant decision was issued by the 16th Civil Chamber of the Istanbul Regional Court of Appeal, which revisited the principle of loss of rights due to acquiescence in trademark infringement cases. This decision introduced a fresh perspective to the discussion. Additionally, the Court of Cassation's ruling on the likelihood of confusion in pharmaceutical trademarks has contributed a new dimension to ongoing legal debates. Also, the registration of series titles as trademarks in the television and film industry has re-ignited discussions on the intersection between trademark law and copyright law.

At the same time, developments in domain name disputes and online trademark enforcement have also been noteworthy, as digital platforms continue to be a battleground for intellectual property rights.

Artificial intelligence (AI) continues to shape trademark law, just as it does in other legal fields. From trademark creation to enforcement, AI-driven solutions are raising new legal questions and challenges.

Despite persistent challenges, the fight against counterfeit products remains a key area of focus. In particular, the battle against counterfeit auto spare parts—given the serious safety risks involved—has gained momentum, with increased collaboration between automotive associations and law firms leading to significant outcomes.

In this publication, we provide insights into these developments and their implications for trademark law.

Table of Content

3

[Never Ending Delay for Administrative Revocation of Trademarks](#)

7

[Update on The Well-known Trademark Registry Debate in Turkey](#)

9

[Turkish Patent and Trademark Office's 2024 Revisions:
Updates to the Trademark Classification System](#)

11

[The Concept of Loss of Rights due to Acquiescence in Trademark Infringement Actions](#)

14

[Court of Cassation Renders Controversial Decision on
Likelihood of Confusion in Dispute Over Pharma Marks](#)

16

[Trademark Protection for Work Titles: Challenges and Insights](#)

19

[Insights from ICANN 81 and Domain Name Disputes in Türkiye](#)

21

[Artificial Intelligence and Trademark Law](#)

23

[Online Enforcement in Türkiye: Addressing IP Infringements in the Digital Era](#)

25

[How Automotive Associations and Law Firms Can Combat Counterfeit Auto Parts Together](#)

Never Ending Delay for Administrative Revocation of Trademarks



In accordance with Article 26 of the Industrial Property Law ("IP Code") no. 6769, interested persons may request the Office to revoke a trademark pursuant to paragraph 2 of Article 26 and the decision for revocation of a trademark can be taken accordingly.

For a long time, the authority to revoke the trademarks belonged to the IP Courts as regulated by the former Decree Law no. 556 on the Protection of Trademarks. However, with the entry into force of the IP Code on January 10, 2017, the authority to revoke trademarks has been given to the Turkish Patent and Trademark Office ("the Office") and to provide a transition period, the entry into force of Article 26 has been postponed for 7 years. In the meantime, as per Provisional Article 4 of the IP Code the authority to revoke trademarks has been left with the IP Courts. This regulation is in line with European Union legislation ("EU Directive 2015/2436"), considered as the reference legislation for the IP Code.

On October 20, 2023, the Office published a Draft Regulation for Amendment of the Regulation on the Implementation of the Industrial Property Code¹ ("Draft Regulation")

on its website for comments. Considering that the Draft Regulation has been presented for comments in the Office's website well-before January 10, 2024, it was assumed that the legal basis of administrative revocation will be ready and a smooth transition will be made from judicial revocation to administrative revocation of trademarks in January 2024. No further steps were taken after receiving the comments on the Draft Regulation and on January 10, 2024, just a simple "Pre-Application Request for Trademark Revocation" tab was added to the Electronic Application System ("EPATS") under Third Party Transactions to simply collect the requests. However, although it has been more than 1 year since the effective date of the administrative revocation, no development has been achieved on the examination of the administrative revocation requests in terms of their merits.

Further to this, on April 24, 2024 the Communiqué on "the Turkish Patent and Trademark Office 2024 Fee Tariff" was published. Along with it, revocation requests continued to be collected by paying its fee determined for 2024, i.e. TRY 16.300 + VAT of 20% (totally around EUR 530). Finally, on

December 06, 2024, the Office sent accruals for revocation requests filed before the entry into force of the Communiqué (so between January 10, 2024 until April 24, 2024) which were received without the relevant fee and asked for their payment. As of January 01, 2025, the fee of the revocation request has been determined and published as TRY 23.458,33 + VAT of 20% (totally around EUR 760). So, the Office accepts and obtains the revocation requests filed.

Considering that the Draft Regulation states that the Office's final revocation decision will be recorded in the registry and published in the bulletin will have an immediate effect, the proper examination of the revocation request is important. In a court action filed by the trademark proprietor against the Office's decision revoking his/her trademark which should not have been revoked in the first place, if the court decides that the trademark revoked upon the Office's decision should not have been revoked after all, then the trademark proprietor may unfairly lose the protection of the trademark until this court decision becomes final and enforceable, which may take 3 or more years. Nevertheless, we still expect the administrative revocation to be cost and time effective compared to revocation actions before courts. Indeed, considering that the finalization of a court action may take 3 years or more, whereas an opposition procedure before the Office can be finalized within 4-12 months, it could be said that, by comparison, revocation

requests before the Office would be finalized in a similar period. There are several reasons for this, among which are the facilitated notification procedure granted to the Office by Articles 160/6 and 160/7 of the IP Code and the simplicity of the administrative procedures and the absence of some of the procedures in the court proceedings such as the expert examination to name as the primary reasons.

We assume that the Office's workload will also become quite heavy with respect to trademark revocation matters. Indeed, applicants can strategically request revocation of basis trademarks as a counterattack to oppositions filed and of obstacle trademarks in terms of Article 5/1(ç)² of the IP Code and ask the Office to hold of examining the opposition and/or appeal until a final decision is rendered on the revocation request. Similarly, trademark squatters or infringers may target trademarks of the genuine trademark owners by abusing the administrative revocation system.

In light of all such considerations, we anticipate that the procedures for the administrative revocation can be more practical in terms of time and costs and foresee an increase in such cases. For this reason, we think that it will be suitable for the trademark proprietors ensure that their trademarks are mentioned on invoices, products, catalogues, etc., and archive these together with any other available evidence such as advertisements, magazine or newspaper articles, etc., in order to avoid problems which may arise in the future in

cases of proof of use concerning revocation requests.

While the Office is accepting revocation requests as pre-applications and before the Office was able to get to the merits of the revocation requests, an application was made to the Constitutional Court by the Ankara 4th IP Court for the annulment of the authority granted to the Office for revocation of trademarks. As a result, the Constitutional Court decided for the refusal of the application due to lack of authority to file such application by the Ankara 4th IP Court. The Constitutional Court reasoned its decision that an application to the Constitutional Court can only be made, if a court that is hearing a case finds the provisions of a law to be applied due to this case to be contrary to the Constitution. In other words, in order for a court to apply to the Constitutional Court, it must have a case that has been filed in accordance with the procedure and falls within the jurisdiction of the court, and the rule requested to be annulled must be applied in that case. The Constitutional Court stated that as the Ankara 4th IP Court did not have the jurisdiction to hear the revocation action, it is not authorized / it does not have the jurisdiction to file an application before the Constitutional Court against the relevant provision as well.

Therefore, the Office still holds the sole authority to revoke the trademarks and while having more than one year has passed as of the entry into force of Article 26, all of the

interested parties look forward to the entry into force of the Draft Regulation and to put the administrative revocation into force and quickly examine the pending request from 2024 and the ones which will be filed in 2025!

¹ This Draft Regulation has not yet been published as of 03.03.2025.

² Signs which are identical to or indistinguishably similar to a trademark, which has been registered or which has been applied for registration, relating to identical goods and services or to goods and services of the identical type.

Update on the Well-known Trademark Registry Debate in Türkiye

The well-known trademark registry of the Turkish Patent and Trademark Office ("the Office") became a discussion topic after the Turkish Court of Cassation decided in 2020 that the Office has no authority to create and maintain a registry for well-known trademarks (see [\(Turkey well-known trademark registry is again open for debate\)](#))

First-instance intellectual property courts and regional courts of appeals adopted this decision immediately and changed their practice, while the Office has maintained its registry for well-known trademarks.



In a decision dated 1 February 2023 and numbered 2023/83 E. 2023/7 K., the General Assembly of the Court of Cassation ruled that even though the

Office created a registry to record trademarks that are considered to be of well-known status according to results of the Office's own examination, it is not entitled to create such a registry under existing laws, and the well-known status of a trademark should be proven in each case, as this status is not a fixed constant.

In addition, the General Assembly ruled that the courts are not entitled to render a decision about determination of well-known status in a way that would constitute a final

verdict on the well-known status. This means that the courts could examine and decide whether a trademark is well known as a prior issue only, while deciding on the justifications put forward by the plaintiff that are based on the well-known trademark argument. In other words, the courts are not authorised to determine whether a trademark is well known as part of the verdict where their decisions concerning the grounds of the plaintiff are explained.

The decision of the General Assembly of the Court of Cassation is binding for the courts, and the courts are expected to decide in line with precedents in cases where well-known status of a trademark is under question.

On the other hand, throughout 2024 the Office has not changed its practice, and it is still possible to file an application for determination and registration of well-known status of a trademark before the Office. Although the Office has also announced official fees for such applications in January 2024, there has not been any change in the legislation as discussed in our previous article ([\(Debate on well-known Trademark Registry Expected to be Resolved Soon\)](#)).

While this issue remains unresolved, the Court of Cassation rendered a decision (dated 25 January 2024 and numbered 2022/4067 E. 2024/620 K.) after the General Assembly's above-mentioned decision where there are references to the well-known trademark

registry of the Office and the scope of protection that registration of well-known trademarks provides with regard to goods and services. It seems that the Court of Cassation overlooked the General Assembly's decision, as the dates of both decisions are close to each other and the courts shall follow the General Assembly's guidance in future cases.

The Office is expected to announce its new official fees for 2025 soon, including the fee for filing an application for determination and registration of well-known status. Meanwhile, right holders and practitioners are eager to know whether a new regulation will enter into force to give the Office authority to maintain the well-known trademark registry.

Turkish Patent and Trademark Office's 2024 Revisions: Updates to the Trademark Classification System



At the end of 2024, Turkish Patent and Trademark Office ("the Office") made a significant move by publishing a revised communiqué on the classification of goods and services for trademark registration applications. The changes, which came into effect following their publication in the Official Gazette on 20 December 2024, align the Turkish classification system with the latest updates made to the Nice Classification. These revisions aim to make the trademark application process smoother, more efficient and accessible for applicants.

The Office's list of goods and services serves as a reference point for applicants and is regularly updated to reflect the evolving market and legal landscape. While based on the Nice Classification, the Turkish version includes structural features adapted to local needs and practices. One of the key features is the sub-classification system, which divides each class into more specific categories. This helps to better define the scope of protection and aims to avoid ambiguity in

case of disputes. For instance, goods or services within the same subclass of a class are considered similar as a rule during the ex-officio examination, whereas those in different subclasses are deemed different.

It is important to note that the Office's list is not exhaustive of every good or service covered by the Nice Classification, and it is not mandatory for applicants to use it when filing applications. Trademark holders can choose either to adopt the exact wording of the Office's list or draft their own specifications. However, local applicants often prefer using the standardised list while foreign applicants tend to draft more specific descriptions or prefer using the phrases from the Nice Classification directly.

A comparison between the revised list and the previous version dated 2017 reveals several changes, ranging from the deletion or addition of goods to the reclassification of certain items. Among the most significant updates are those reflecting technological

advancements, such as the inclusion of “artificial intelligence humanoid robots”, “cryptocurrencies”, “NFTs”, “drones” and “unmanned aerial vehicles”. Two new subclasses have also been introduced: one under class 09 for “humanoid robots with AI and related technologies” and another under class 45 covering “astrological and spiritual counselling services”.

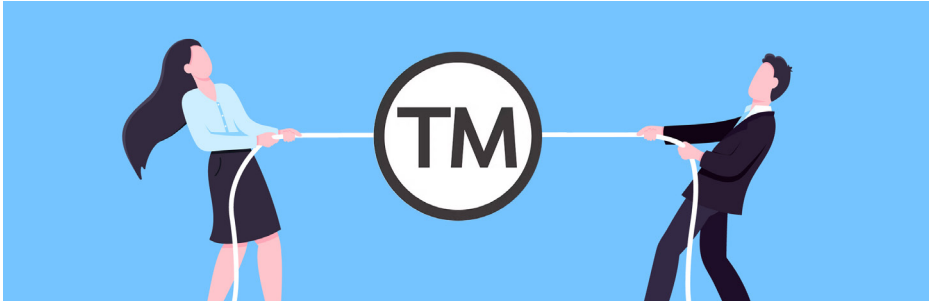
The Office has also added categories that reflect local market needs and emerging sectors in Türkiye. For example, the addition of transportation and accommodation services within the scope of health tourism and services for “arranging travel visas and documents” to Class 39 are noteworthy additions in this context.

A frequently asked question following this revision is whether the scope of the trademark classes has changed and whether right holders need to file new applications to include the newly added goods and services. In fact, the scope of the classes has not expanded. The newly listed items were already considered to be covered within the respective classes but had not been explicitly defined in the previous version of the list. For instance, “dental services” and “psychological services” have always been considered to be within the scope of “medical services” under class 44, but their specific mention was added to the updated list, providing clarity. As such, submitting new applications is not necessary to protect rights for these goods and services, though trademark owners may consider filing

fresh applications if their business activities specifically focus on the newly added goods and services. In case of potential future disputes, right holders may benefit in filing new applications covering especially the new subclasses such as “*Humanoid robots with artificial intelligence, laboratory robots, educational robots, robots for security surveillance*” as a precautionary measure if they have or will have use on these goods.

In conclusion, the Office’s recent revisions offer a more streamlined and Nice Classification-aligned system for trademark applications. These updates reflect technological advancements and emerging market trends, while also enhancing clarity for both local and international applicants. Although new applications are not mandatory, right holders in the affected sectors should carefully review the updated list and consider filing fresh applications for the newly added goods and services to ensure their trademarks are duly protected.

The Concept of Loss of Rights due to Acquiescence in Trademark Infringement Actions



The acts deemed as infringement of a trademark are listed under Article 29 of the Industrial Property Code No. 6769 ("IP Code"), and the claims that the right holders whose trademark rights have been infringed may request from the courts and that they may assert against the infringing party are detailed in Article 149 of the same Code.

Although it is possible for the right holder to assert the claims outlined in the Code against the infringing party as long as the infringement continues, there is, in fact, a limit to this period. Indeed, it is not possible for the right holder to bring forward their rights against the infringing party "over many years" without using their trademark rights to keep the infringing party or parties under constant threat of legal action; in other words, right holders cannot continue to keep their rights while "remaining silent".

This situation has found its place in the IP Code in regards to invalidation actions, and it is clearly stipulated in Article 25/6 of the IP Code that "Where a trademark proprietor has acquiesced in the use of a latter trademark for

a period of five successive years while being aware or should have been aware of this use, trademark proprietor cannot assert his/her trademark as an invalidation ground unless the registration of the latter trademark is in bad faith." Loss of rights due to acquiescence is also included in Article 16 of the Regulation (EU) No. 2017/1001 of the European Parliament and the Council of the European Union of 14 June 2017 and Article 9 of Regulation (EU) No. 2015/2436 as an obstacle to the filing of an infringement action.

As there is no explicit provision in the IP Code for infringement actions, the limits of the right in these matters are regulated by Article 2 of the Turkish Civil Code, "the principle of honest behaviour³". The principle of honest behaviour constitutes the foundation of jurisprudence, and the exercise of a right is only possible as long as it remains within the framework of this principle.

In judicial decisions, the assessment of whether or not the loss of rights by acquiescence has occurred in scope of infringement actions relies upon the essence

of both Article 25/6 of the IP Code and the principle of honest behaviour. Indeed, while the Court of Cassation has concluded that the plaintiff has lost its rights due to acquiescence for a period of less than 5 years in some cases, in other cases, it has been evaluated that the plaintiff lost its rights for acquiescence longer than 5 years. As stated, this assessment is based on the principle of honest behaviour.

In determining the loss of rights due to acquiescence, it is necessary to determine the starting point of the period. In determining this, the concept of “acting like a prudent merchant” regulated under Article 18/2 of the Turkish Commercial Code comes into play. Accordingly, the right holder is expected to act as a prudent merchant and exercise due diligence to be aware or is in a position to know about the use or registration of the trademark in question.

Within the framework of the principles of acting honestly and acting as a prudent merchant, the prohibition of contradictory behaviour should also be mentioned. In the established precedents of the Court of Cassation, Article 2 of the Turkish Civil Code is accepted as the main basis of the loss of rights by acquiescence. In this respect, in cases where the plaintiff knows or is in a position to know about the infringement and after establishing trust that the plaintiff will not file a lawsuit against the infringing party and after allowing significant investment in the infringed right, filing a lawsuit contrary to this trust will constitute a prohibition of contradictory

behaviour. In other words, such behaviour is considered as contrary to the rule of honesty in accordance with Article 2 of the Turkish Civil Code, and this behaviour will not be protected by law. Thus, the Court of Cassation has introduced the concept of “prohibition of contradictory behaviour” by combining the prudent merchant’s “knowing or being in a position to know about the infringement” position under the Turkish Commercial Code and the principle of honesty under the Turkish Civil Code, and shed light on the concept of loss of rights by acquiescence in infringement cases. The prohibition of contradictory behaviour may arise not only by remaining silent, but also with other acts that may constitute acceptance/consent, followed by a lawsuit against the infringing party to end the infringement.

In a decision issued in 2023, the Istanbul 16th Civil Chamber of the Regional Court of Appeal (RCA) brought a new perspective to the concept of loss of rights due to acquiescence in infringement cases and examined some additional conditions such as “genuine use” and “acts that interrupts the time period”. In the particular case, although the plaintiff had sold the defendant’s products bearing the subject trademark on its own website, it filed an infringement action against the defendant years later. The RCA stated in its decision that: “the calculation of the period should be based on the date when the defendant started to use the trademark genuinely and it is not appropriate to calculate the period from

the date of the first invoice”, “considering that the plaintiff gave a notice on 28.11.2016 and filed a lawsuit on 20.01.2017, the 5-year period from the date of the first invoice on 19.02.2013 until the date of the lawsuit has not passed”, “plaintiff stated that the defendant’s products were not sold and that the images were removed from the plaintiff’s website within a short period of time”, “plaintiff sent a notice and filed a lawsuit within a reasonable period of time therefore the rejection of the lawsuit was not deemed appropriate on these grounds.”

It is mentioned that the calculation of the loss of rights due to acquiescence is based on the date on which the right holder determined the infringing use. However, in the above mentioned decision, the RCA took the date of the right holder’s learning of the “genuine use” as the date of learning of the infringing use. The meaning attributed by the RCA to the concept of “the use of a trademark” and the meaning attributed by the doctrine, case law and the IP Code to “the use of a trademark” do not coincide with each other. Indeed, while it should be accepted that the defendant’s invoice indicates the use of the trademark has started, it is not possible to agree with the decision to the contrary. As a matter of fact, it is clear that the trademark enters the market and reaches the consumer with the sale of the product and trademark use is sufficient and there is no regulation, opinion or decision stating that the use must reach a certain point in order to be considered genuine use.

Moreover, even if “while being aware or should have been aware of this situation” in Article 25/6 of the IP Code is strictly applied to the concrete case, and even if the use mentioned in the Article is understood as “serious use”, the invoice evidence should be accepted as indicating serious and genuine use.

On the other hand, in its decision, the RCA considers the plaintiff’s letter of warning as a criterion for the calculation of the loss of rights due to acquiescence. Will this period run without any interruption from the date the right holder learns of the infringing use, or are there certain actions that interrupts or suspends this period? It is accepted in the established precedents of the Court of Cassation that acts such as sending letters of warning do not interrupt or suspend the running of this period. In other words, for the right holder to assert their rights, it is not sufficient to not show “acceptance/consent” by remaining silent, nor is it sufficient to only send a warning letter to assert their rights.

In this context, the right holder must act as a prudent merchant within the framework of the principle of honest behaviour, take actions that can be expected from a reasonable and prudent merchant, and not lead to the perception that a lawsuit will not be filed against the infringing party. Otherwise, it will not be possible to legally protect the plaintiff’s rights on the grounds that the plaintiff did not act as a prudent merchant and violated the principle of honest behaviour.

³ Turkish Civil Code No. 4721, Art. 2: “Everyone must abide by the rules of honesty when exercising their rights and in fulfilling their debts. The legal order does not protect the clear abuse of a right.”

Court of Cassation Renders Controversial Decision on Likelihood of Confusion in Dispute Over Pharma Marks

Background

A Turkish company operating in the pharmaceutical sector, which owns the registered trademarks BATIKAR and BATISOL in Class 5, filed an infringement action against a pharmaceutical company selling antiseptic disinfectants under the trademark MIRADERM BATIMER.

The plaintiff argued that the expression 'batimer' was similar to their BATIKAR and BATISOL trademarks, particularly due to the shared 'bati' element, and that there was a likelihood of confusion.

Decisions



In the initial trial, the IP Court ruled in favour of the defendant, concluding that the trademarks were sufficiently distinct, as the defendant's trademark consisted of two words and there was no other similarity besides the shared

element, 'bati'.

On appeal, the Regional Court reversed this decision, determining that the similarity between the marks, particularly the shared 'bati' element, created a likelihood of confusion. In particular, it emphasised that:

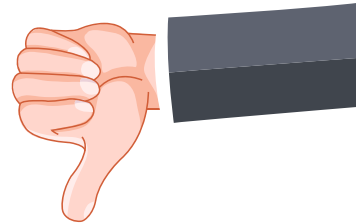
- the products for which the parties' trademarks were used were antiseptic disinfectants which can be purchased

over the counter and appeals to the average consumer; and

- the common element 'bati' is not the name of the active ingredient of the product.

The Regional Court also stated that 'bati' did not have a meaning in the Turkish language and that the defendant was not obligated to use that element. Accordingly, the Court ruled that the defendant's use of MIRADERM BATIMER constituted trademark infringement and unfair competition, and issued injunctions against the defendant.

The defendant appealed to the Court of Cassation; however, the Court upheld the Regional Court's ruling and confirmed that the defendant's use of MIRADERM BATIMER constituted trademark infringement and unfair competition.



Remarks

In terms of the similarity and likelihood of confusion of trademarks in Class 5, the Turkish courts often consider whether the common element of the marks refer to the active ingredient of the products and whether the products in question are sold on prescription or over the counter, and thus attempt at ascertaining if the product is to appeal to a specific consumer group, of whom may (or may not) have a higher degree of prudence.

In this case, it is likely that both the Regional Court and the Court of Cassation followed this line of examination. However, it could also be said that the courts did not take into consideration the nature of the relevant sector and the overall impression created when undertaking the examination of possible similarity and likelihood of confusion.

Although ‘bati’ does not refer to the active ingredient of antiseptic disinfectants, it is frequently used in trademarks for the same type of product, as can easily be determined by looking at the database of the Turkish Patent and Trademark Office or with a quick internet search (such examples are Batiodin, Baticonol, Batikadin, Batiderm and Batticon). In addition, the well-known Batticon brand (which is registered as a well-known trademark before the Office) has become almost synonymous with antiseptic solution and has almost become a generic use for similar products. Therefore, and especially in infringement cases, the courts should take a broader approach when assessing the likelihood of confusion, and should examine the level of distinctiveness of the trademarks by also considering their common use in the relevant sector, where applicable.

In this particular case, and also considering the above facts regarding BATTICON, and that there is another distinctive element in ‘batimer’ (the last syllable of which is different from that of the plaintiff’s trademarks),

the courts may have come to a different conclusion had they taken into account this approach to examining confusing similarity.

Trademark Protection for Work Titles: Challenges and Insights



Article 83 of Law No. 5846 on Intellectual and Artistic Works stipulates that the names of works can be protected independently of the works themselves under the provisions on unfair competition. Our assessment of this protection is discussed in our article, ‘Protection of Work Titles’¹.

An important aspect of work title protection is their registration as trademarks. In practice, it is common for elements of cinematographic works, such as characters and locations, as well as literary works like novels, stories, and poems, and even song or composition titles, to be registered as trademarks. This benefits both the trademark owner and other commercial entities through licensing agreements, while also allowing consumers to experience the work in various forms. For instance, characters from popular animated films are often used in commercial products like toys, clothing, stationery, textiles, magazines, and other printed materials. In such cases, registering the work title for merchandise, as well as magazines and printed materials, provides a significant advantage in the production and

marketing of these licensed products.

However, the registration of the work title as a trademark does not provide direct legal protection to the work itself or its elements. For example, even if the name of a song is registered as a trademark, the use of this name in another song by a different artist may not infringe on the originality of the work. Therefore, when the work title is registered as a trademark, it only offers protection within the scope of Trademark Law, and at this point, understanding the concept of ‘trademark use’ becomes essential.

This debate becomes particularly significant when the work title is registered under ‘*film, television, and radio program production services*’ in Class 41 and ‘*motion pictures, series, and video music clips recorded on optical and electronic media*’ in Class 09. This is because the service type in Class 41 primarily refers to the production service itself. In this context, trademark use may only be considered if the work title is used in connection with the name of a production

company or related production activities. Similarly, regarding the category of goods in Class 09, the registered trademark protects not the content of the work but the physical product recorded on optical and electronic media itself. Therefore, in our opinion, the protection of the work title as a trademark would not constitute trademark use in this case either.

In the disputes before the courts, the issue of whether the use of a work title can be considered as trademark use is evaluated separately according to the circumstances of the case.

For example, within the scope of the decision of the 16th Civil Chamber of the Istanbul Regional Court of Appeals No. E. 2017/2449 K. 2019/2091, dated 11.10.2019, the use of "Diriliş/Resurrection" was assessed in this regard within the lawsuit filed by the plaintiff against the defendant's use of the title as a book name based on its registered trademarks, and the rights to the series it produced, on the grounds of trademark and copyright infringement as well as unfair competition. In this dispute, the Court clearly stated that although the plaintiff's trademarks are registered in Class 41 under "*book, magazine, printing, and publishing services*", the term "Diriliş/Resurrection" does not constitute trademark use that distinguishes the book commodity it appears on from other entrepreneurs' books and publishing services. The Court also clarified that the defendant

did not use the term in a way that could be associated with a particular good or service as a trademark.

Similarly, in the decision of the 11th Civil Chamber of the Court of Cassation (CoC) dated 18.04.2017, numbered E. 2015/14472 K. 2017/2229, a lawsuit was filed to annul the Turkish Patent and Trademark Office's rejection of the plaintiff's objections to the defendant's trademark application for the title of a book published by the plaintiff between 2009-2014. The plaintiff claimed to be the first to use the relevant phrase and the owner of the mark under copyright and industrial property rights. However, the Court concluded that the plaintiff's use could not be considered as "trademark use" under Classes 16 and 41 for goods and services. The work belonged to a different author, and the plaintiff failed to provide evidence of holding rights on the material or any authorisation to use the work. Even if the plaintiff were the owner of the material rights, the defendant's use was not considered an infringement of rights related to processing, reproduction, or distribution as the Court dismissed the case, noting that the phrase had been used as the title of hundreds of works, was anecdotal, and was widely used. As a result, it could not be considered unique or distinctive, and unfair competition protection was not applicable. The decision was upheld by the CoC.

In our opinion, this is a natural consequence of the function of trademark protection, which,

among other things, aims to distinguish the goods/services of one undertaking from those of others, allowing the average consumer to recognise the source of the relevant goods/services and thus differentiate them from other offerings. Trademark protection, by its very nature, requires the existence of use specific to a particular good/service. In contrast, copyright protection primarily seeks to safeguard and reward the creative activity of the human mind, encouraging further creativity. As such, creations that are embodied, reflect the personality of the creator, and fall within the categories specified in the Law on Intellectual and Artistic Works are protected as works. Unlike trademark protection, these works do not need to be specific to a certain good/service. In this context, although there may be situations where both types of protection coexist in a single case, the difference between their purposes and functions becomes clearly evident. The use of a title as a work and as a trademark can thus be distinguished from one another.

¹ <https://gun.av.tr/insights/articles/protection-of-work-titles>

Insights from ICANN 81 and Domain Name Disputes in Türkiye

The 81st ICANN meeting (ICANN 81) was held in Istanbul, Türkiye, in November 2024, offering a significant platform for global discussions on internet governance, domain names, and online policy. The ICANN 81 meeting underscored the importance of evolving global internet governance, particularly through advancements in the New gTLD Program and initiatives like the Registration Data Request Service (RDRS). While these developments highlight strides toward inclusivity and accessibility, challenges such as voluntary participation and procedural inefficiencies persist.

- ICANN 81 Insights: A Global Perspective on Domain Names and Internet Governance

ICANN 81 provided a comprehensive overview of the current state and future direction of the Domain Name System (DNS). Key discussions centred around the ongoing developments in ICANN's New gTLD Program, particularly in the Round 2 of the program. The Round 2 focused on diversity and inclusivity of the DNS including universal acceptance of the new gTLDs, as well as the inclusion of more Internationalized Domain Names (IDNs). ICANN has confirmed that the application round for new gTLDs is expected to open in April 2026 in a time limited window lasting 12-15 weeks and certain restrictions will be applied. Private auctions, closed generics, and plural/singular delegations will not be allowed. It is aimed at improving fairness

and transparency in the process. Another key deliverable for Round 2 is the Applicant Guidebook (AGB). It outlines eligibility criteria, application processes, compliance obligations, objection procedures, applicant commitments, contracting terms, and delegation steps. This is all a reflection of the culmination of studies and policy work that has been done over the last decade. ICANN aims to obtain the Board's approval by 2025 for AGB, with the final public comment period scheduled for May 2025. The AGB is expected to be published by December 2025.



Another topic discussed at ICANN 81 was Registration Data Request Service (RDRS). The RDRS was introduced by ICANN as a response to challenges posed by the GDPR, which restricted public access to domain registration data. The RDRS aims to connect requesters seeking non-public data with registrars who participate in the RDRS. However, participation is voluntary. As of October 2023, approximately 60% of all gTLD registrations were covered by participating registrars. ICANN continues to monitor the effectiveness of RDRS and gathers data to improve the process, but the voluntary nature of registrar participation remains a key limitation. The RDRS has seen limited use,

with only 2,109 total requests submitted in its first year, and those were mostly from IP right holders. Despite being globally available, the participation rate is low, and only 91 registrars are involved. ICANN plans to run the service for two years and will assess its effectiveness afterward, given the low volume of requests and concerns about its ability to fully address post-GDPR access challenges. The primary reason for denials of requests was seen to be incompleteness in the submitted forms. Many requests are either denied or closed due to missing information. There is a need to provide better guidance for requestors and registrars to improve the submission process and reduce the deficiencies regarding these issues.

- **Domain Name Disputes in Turkey: The Role of TRABIS**

TRABIS (".tr" Network Information System), established by the Turkish Information and Communication Technologies Authority ("BTK"), became operational on 14 September 2022 and undertook the management of ".tr" domain names. Upon the introduction of TRABIS, the "first come, first served" principle entered use for allocation of domain names such as 'com.tr', 'org.tr', 'net.tr', 'gen.tr', 'biz.tr', 'tv.tr', 'web.tr', 'info.tr', 'bbs.tr', 'tel.tr', or 'name.tr'. The obligation to submitting any documents to prove the rights of the applicant was abolished.

The introduction of the "first come, first

served" principle necessitated an effective dispute resolution mechanism for domain name disputes. Dispute Resolution Service Providers, which are accredited by TRABIS, have started to handle the alternative dispute resolution process regarding ".tr" domain names. The regulatory rules and proceedings are parallel to the Uniform Domain-Name Dispute-Resolution Policy (UDRP) system.

The alternative dispute resolution mechanism, allowing the litigation-free resolution of domain name disputes for ".tr" domain names, operates in an effective and beneficial manner. Türkiye's efforts in managing domain name disputes through TRABIS reflect a robust approach to adapting international frameworks to local needs. However, ongoing regulatory and procedural refinements are essential to ensure effective enforcement and equitable resolution mechanisms.

As the digital landscape continues to grow, both global and local measures must evolve to balance innovation with fair governance and protection of rights

Artificial Intelligence and Trademark Law



One of the areas where the impact of artificial intelligence (AI) technologies have been intensively discussed is trademark law; while the changes brought about by this technology make attempt to provide innovative and effective processes in terms of registration processes and determination of infringement, it also makes it necessary to re-evaluate the basic concepts of trademark law.

This year, as in previous years, the use of AI technologies by the authorities in relation to trademark registration processes and other administrative procedures continued to increase. As the Index⁴ published by the World Intellectual Property Office (WIPO) reveals, intellectual property offices around the world use these technologies to increase time/cost efficiency and improve accuracy and internal productivity. WIPO, on the other hand, has integrated many AI assistants such as the "Global Goods & Services Terms Explorer", which helps to identify terms during the determination of the list of goods/services in application processes; "WIPO Translate", which provides translation of technical documents; "WIPO Speech-to-Text", that provides fast and accurate transcription

of spoken phrases; and "Global Brand Database", which enables visual similarity searches, into its system to increase efficiency, accuracy and accessibility in its operations⁵.

Pursuant to the "Communiqué on the Classification of Goods and Services for Trademark Registration Applications" published in the Official Gazette dated 20 December 2024, the Turkish Patent and Trademark Office ("Office") has amended the classification of goods and services used in trademark registration applications to reflect, among other things, the relevant technological developments. In this context, the latest changes made in the Nice Classification system were reflected to the existing lists, new subclasses have been added to class 09, as well as other classes, and goods such as "AI humanoid robots, laboratory robots, robots for educational purposes, robots for security surveillance" have been included. This shows that measures are being taken to increase the integration of relevant technologies into trademark registration and protection processes, taking into account their widespread use.

Another point worth mentioning is the trademark infringement that may occur through the use of these technologies, in which case there is still no certainty as to which party should be held liable, and in what framework; indeed, legal regulation and/or court decisions that would shed light on this issue are yet to be established.

However, we believe that the conclusions in the "*Cosmetic Warriors and Lush v Amazon.co.uk and Amazon EU*"⁷ decision may provide clarity on the issue, as it addresses trademark infringement with the use of AI technologies, the level of involvement of AI providers in the relevant purchasing processes and their role in directing consumer preferences as being decisive in determining the liability for possible infringement.

AI technologies seem to necessitate a transformation in terms of the general principles of trademark law. As a matter of fact, with the rise of these technologies, the structure of shopping processes has also changed, and AI assistants, search engines, customer service bots and online marketplaces have started to play an important role in consumers' purchasing preferences. In this context, we have started to encounter situations where either the consumer's purchasing preferences are determined according to the results provided by AI, or the direct act of purchasing is performed automatically by AI with or

without the voice-triggered instructions of the consumer. In the face of AI's ability to correctly analyse complex data, it becomes necessary to reconsider the concepts such as "average consumer" and "likelihood of confusion", which are developed by taking into account the imperfect perception of human beings.

In this context, although the interaction of AI with trademark law, the scope of protection and infringement of rights will become clearer over time with the court decisions, it is of great importance for trademark owners to closely monitor the process by keeping abreast of the opportunities that this technology can provide while determining their commercial strategies, to organise/develop their trademark registration portfolios to cover their use of related technologies and to take measures to avoid situations that may lead to infringement.

⁴ https://www.wipo.int/about-ip/en/artificial_intelligence/search.jsp

⁵ [https://www.wipo.int/en/web/ai-tools-services#:~:text=WIPO%20has%20developed%20an%20AI,Patent%20Classification%20\(IPC\)%20schema.](https://www.wipo.int/en/web/ai-tools-services#:~:text=WIPO%20has%20developed%20an%20AI,Patent%20Classification%20(IPC)%20schema.)

⁶ <https://www.resmigazete.gov.tr/eskiler/2024/12/20241220-6.htm>

⁷ *Cosmetic Warriors and Lush v Amazon.co.uk and Amazon EU* [2014] EWHC 181 (Ch)

⁸ WIPO Conversation on IP and AI, Second Session, Revised Issues Paper on IP Policy and AI, s. 12.

Online Enforcement in Türkiye: Addressing IP Infringements in the Digital Era

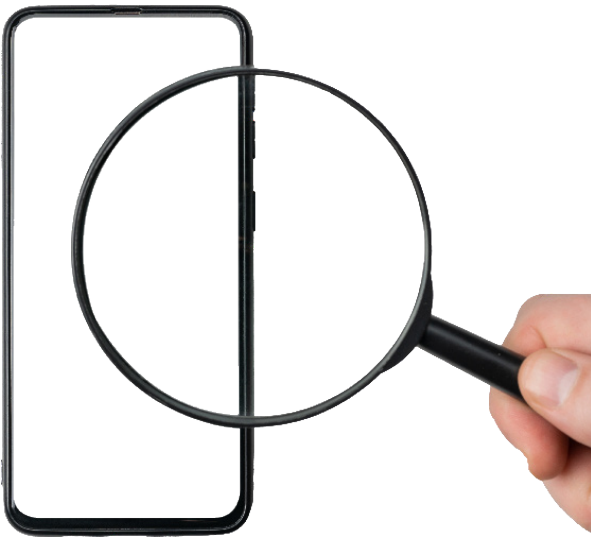
In cases of online infringement of industrial property rights, various actions can be pursued, including civil actions, criminal actions, preliminary injunctions, and notice-and-takedown procedures. Possible ways of enforcement against online infringement is shown below:

ONLINE INFRINGEMENT		
Industrial Property Rights		
Civil actions <ul style="list-style-type: none">• Trademark infringement action• Preliminary injunction for access blocking• Compensation	Criminal actions <ul style="list-style-type: none">• Complaint to the prosecutor's office regarding trademark rights	Notice & Takedown <ul style="list-style-type: none">• Requesting the intermediary service provider to stop the infringement

The legal basis of trademark infringement is regulated under Articles 7 and 29 of the Intellectual Property Code (IP Code). Article 29 of the IP Code states that imitating a trademark or using a mark that is indistinguishably similar—through actions like selling, distributing, importing, or offering products—constitutes trademark infringement. Article 7 of the IP Code gives registered trademark owners the right to block the unauthorised use of identical or similar marks, including online use. This also applies to cases where the trademark is used in domain names, redirect codes, or keywords that could lead to confusion. In such cases, legal action can be taken to determine if there is an infringement, to cease it, and to seek both material and non-material compensation.

If the conditions are met, a request for a preliminary injunction (PI) can be filed either as a standalone application or as part of the main court action. If a PI is granted the courts may temporarily block access to the relevant websites within Türkiye. These decisions are geographically limited and do not prevent the infringing content from being accessible in other countries.

In the case of trademark infringement, a criminal complaint can also be filed pursuant to Article 30 of the IP Code. This article stipulates that individuals who engage in trademark infringement (such as by imitating a trademark or causing confusion through the production, sale, import, or transport of infringing goods) may face imprisonment for one to three years and a judicial fine of up to twenty thousand days.



Regarding notice-and-takedown, intermediary service providers and platforms are not liable for illegal content posted by users as per the general principle. However, they may be held accountable if they fail to remove such content after receiving proper notice from the rights holder. A specific provision under E-Commerce Law No. 6563 which states that platforms are required to remove the content within 48 hours of receiving a complaint accompanied by evidence of the related intellectual property violation. Failure to remove the content or republishing it after it is legally proven to be an infringement may result in an administrative fine for the platform. In 2023, an annulment application was filed to challenge the notice-and-takedown related provisions of E-Commerce Law before the Council of State and the Constitutional Court. The Council of State has suspended key provisions of the regulation, including those related to notice-and-takedown procedures. While the annulment cases are still pending and no final decision has been made, the relevant provisions of the E-Commerce Law remain in effect. However, enforcement of these provisions under the E-Commerce Regulation has been suspended.

In conclusion, Türkiye's legal framework provides robust mechanisms for addressing online intellectual property infringements, encompassing civil, criminal, and administrative remedies. The interplay between the Intellectual Property Code and E-Commerce Law offers trademark owners

diverse tools to combat unauthorised use, from notice-and-takedown procedures to preliminary injunctions. However, ongoing legal challenges and suspended provisions highlight the dynamic and evolving nature of this regulatory landscape. As Türkiye continues to adapt to the complexities of the digital era, balancing enforcement with innovation and access will remain crucial for protecting industrial property rights effectively.

How Automotive Associations and Law Firms Can Combat Counterfeit Auto Parts Together

Auto Spare Parts and Distribution Ecosystem

The automotive industry relies on highly technical products that do not reach end users directly. Instead, these products are distributed through dealers, service centres, mechanics, and authorised resellers, who play a critical role in ensuring that genuine products reach the end user. For instance, essential annual maintenance activities such as spare part replacement, oil refilling, and system updates are carried out by these intermediaries. If one of these actors fails to source authentic products, counterfeit items may enter the supply chain, ultimately having a negative effect on end users.



Risks of Counterfeit Auto Spare Parts

Counterfeit products on the market in the automotive sector have an adverse effect on automotive companies as they lead to a higher number of product returns, more consumer complaints and damage the reputation of brands. Counterfeit products in the automotive industry pose significant risks. From a financial perspective, they lead to increased product returns, consumer complaints, and reputational damage to brands. From a consumer safety standpoint, counterfeit parts or components can cause malfunctions, leading to vehicle breakdowns or even accidents. According to FICCI CASCADE (Federation of Indian Chambers of Commerce and Industry - Committee Against Smuggling and Counterfeiting Activities

Destroying the Economy)), approximately 20% of accidents on Indian roads are caused by counterfeit automobile parts. Moreover, these counterfeit items can have further implications for public health and environmental safety. For example, counterfeit air filters may fail to meet expected emission standards, contributing to air pollution. Brake pads made from sub-standard materials can reduce braking power, which endanger drivers and pedestrians alike. Fake lubricants may lead to engine damage, shortening vehicle lifespan and increasing maintenance costs. These factors make it imperative for stakeholders to take joint action against counterfeiting.

By ensuring that only original parts are distributed and used, dealers, service providers, and repair professionals help safeguard the integrity of vehicles and

consumer safety. Counterfeit products not only disrupt the automotive supply chain but also create legal and financial liabilities for related companies/brand owners. A comprehensive approach involving industry associations, legal professionals, and trademark attorneys is necessary to minimise these risks effectively.

Roles of Actors

Automotive and Aftermarket associations play a crucial role in the fight against counterfeit automotive products. These organisations are privy to extensive technical expertise and market knowledge, given that they consist of multiple brand owners working together. Their collective know-how and broad perspective enable them to identify industry-wide counterfeiting patterns and emerging threats.

Counterfeit product distributors typically supply a variety of components from multiple brands, offering a range of products needed for a single vehicle, rather than focusing on just one brand's items. This makes enforcement efforts more complex. Associations provide strategic guidance by combining their industry insights with the legal expertise of trademark attorneys and law firms. This collaboration strengthens enforcement efforts by ensuring that legal actions are well-targeted and effective, ultimately reducing consumer harm and enhancing the combat against counterfeit operations.

Importance of Collaboration and Joint Actions

One of the most effective measures in combating counterfeit products is the organisation of joint action raids. With the collaboration of associations and lawyers, enforcement efforts can simultaneously target multiple counterfeit products across different brands. For example, last year, joint actions in Türkiye led to the seizure of millions of counterfeit diesel engine components, bearings, filters, and other critical automotive parts. Such large-scale operations maximise impact by disrupting counterfeit supply chains at multiple levels.

Associations also utilise their industry networks and field intelligence to direct enforcement actions more efficiently. Through direct and dynamic communication with stakeholders, they help law firms and trademark attorneys identify high-risk areas and key counterfeit suppliers. This results in a more precise and effective response to counterfeiting threats.

Another valuable initiative facilitated by the collaboration between the associations and law firms is the establishment of hotlines for reporting counterfeit products. Dealers, repairmen, and other industry professionals can report suspected counterfeit items, allowing enforcement bodies to act swiftly. This not only increases awareness within the industry but also encourages authorised resellers to actively participate in the

combat against counterfeiting. For example, during routine annual vehicle maintenance, a repairman may detect a counterfeit component, leading to an immediate investigation and subsequent enforcement action.

The benefits of such collaborative efforts include an increase in the number of counterfeit products seized, enhanced industry know-how, and cost-effective enforcement measures through joint actions. This results in positive outcomes for all stakeholders, including end users, who benefit from higher product quality and safety. Moreover, public health is safeguarded, as counterfeit parts (such as defective air filters) can contribute to environmental pollution and vehicle malfunctions.

Joint actions are particularly effective, not only against manufacturers, wholesalers, and importers of counterfeit goods, but also at the retail level. Even enforcement actions against small-scale counterfeit retailers can have a significant impact, as multiple brand owners can collectively file complaints, increasing the pressure on counterfeit distributors and ensuring a broader enforcement reach.

Conclusion

Collaboration between industry associations and experienced law firms is essential in the combat against counterfeit automotive products. By leveraging their technical

expertise, market intelligence, and legal knowledge, these stakeholders can take effective joint actions to protect brand owners, industry professionals, and end users alike. The successful implementation of enforcement measures (such as joint action raids and counterfeit reporting hotlines) demonstrates that a coordinated approach significantly enhances market integrity. Ultimately, such efforts not only safeguard companies/brand owners from financial and reputational damages but also contribute to consumer safety and environmental protection.

⁹ Article 5 of the Law on the Regulation of Broadcasts via Internet and Prevention of Crimes Committed through Such Broadcasts reads as "(1) Host provider is not obligated to check the content it hosts or to investigate whether it is against to law. (2) Host provider is obliged to remove the content that is against to law if it is notified according to Articles 8 and 9 of this Law."

KEY CONTACTS



MEHMET GÜN
SENIOR PARTNER

mehmet.gun@gun.av.tr



BARIŞ KALAYCI
PARTNER

baris.kalayci@gun.av.tr



GÜLDENİZ DOĞAN ALKAN
PARTNER

guldeniz.dogan@gun.av.tr



HANDE HANÇAR
PARTNER

hande.hancer@gun.av.tr



MUTLU YILDIRIM KÖSE
PARTNER

mutlu.yildirim@gun.av.tr



UĞUR AKTEKİN
PARTNER

ugur.aktekin@gun.av.tr



ZEYNEP SEDA ALHAS
PARTNER

zeynep.alhas@gun.av.tr



PINAR ARIKAN
DIRECTOR

pinar.arikan@gun.av.tr

KEY CONTACTS



BARAN GÜNEY
MANAGING ASSOCIATE

baran.guney@gun.av.tr



BEGÜM SOYDAN SAYILKAN
MANAGING ASSOCIATE

begum.soydan@gun.av.tr



DİCLE DOĞAN
MANAGING ASSOCIATE

dicle.dogan@gun.av.tr



DİLAN SİLA KAYALICA
MANAGING ASSOCIATE

dilan.aslan@gun.av.tr



DİRENÇ BADA
MANAGING ASSOCIATE

direnc.bada@gun.av.tr



İREM GİRENES YÜCESOY
MANAGING ASSOCIATE

irem.girenes@gun.av.tr



ZEYNEP ÇAĞLA ÜSTÜN
MANAGING ASSOCIATE

zeynep.ozcebe@gun.av.tr



ATAHAN ERKUL
SENIOR ASSOCIATE

atahan.erkul@gun.av.tr



AYŞENUR ÇITAK BOZDAĞ
SENIOR ASSOCIATE

aysenur.citak@gun.av.tr



BENGÜ ŞEN GÜRKAN
SENIOR ASSOCIATE

bengu.sen@gun.av.tr



CANSU EVREN
SENIOR ASSOCIATE

cansu.evren@gun.av.tr



ELİF MELİS ÖZSOY
SENIOR ASSOCIATE

elifmelis.ozsoy@gun.av.tr

KEY CONTACTS



HAVVA YILDIZ
SENIOR ASSOCIATE

havva.yildiz@gun.av.tr



KENDAL BASUT
SENIOR ASSOCIATE

kendal.basut@gun.av.tr



MERVE ÇİMEN SEVİNE
SENIOR ASSOCIATE

merve.cimen@gun.av.tr



SELİN BİLİK
SENIOR ASSOCIATE

selin.bilik@gun.av.tr



UTKU SÜNGÜ
SENIOR ASSOCIATE

utku.sungu@gun.av.tr



CANAN TINAZ
SENIOR ATTORNEY

canan.tinaz@gun.av.tr



Firm Overview

We are one of the oldest and largest law firms in Turkey and are considered internationally to be among the top-tier of legal services providers.

We are a full-service law firm leading the intellectual property field among others, providing dispute management, advisory, transactional, prosecution, investigation, and regulatory markets law services to domestic and multinational corporations.

We are based in Istanbul, with working and correspondent offices in Ankara, Izmir and the major commercial centres in Turkey.

We operate mainly in Turkish and English and also work fluently in German and French.

We advise a large portfolio of clients in numerous fields of activity including life sciences, insurance and reinsurance, energy, construction & real estate, logistics, technology, media and telecoms, automotive, FMCG, chemicals and the defense industries.

Our vision is to be the leader in the services we provide, sensitive to wider society, the environment, and our employees as an innovative and sustainable institution.

Our clients' success is at the heart of our own success. We closely monitor developments in the business sectors in which our clients operate and invest in accumulating industry specific knowledge to understand their changing needs. We actively participate in professional, trade and business organisations in Turkey and internationally.

We are committed to adapt to our clients' changing business needs by delivering innovative, high quality and commercially prudent legal solutions.

