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Good news for owners of IR designations as Trademark Office changes its practice in opposition proceedings

Turkey - [Gün + Partners](#)

- **The Trademark Office has recently changed its practice in opposition proceedings with regard to national designations of IRs**
- **The office has started to notify IR owners via WIPO when an opposition is filed against their designations in Turkey**
- **The difference in treatment between IR designations and national applications had been widely criticised**

The Turkish Patent and Trademark Office has recently changed its practice in opposition proceedings with regard to national designations of international registrations (IR) by starting to notify the IR owner of the opposition via WIPO. This allows the owner to raise a non-use claim, thereby putting an end to the difference in treatment between IR designations and national applications.

Background

The office, as a rule, informs applicants of oppositions filed against their trademark applications and gives them one month - as of the date of notification of the official letter - to file their response. Further, following the entry into force of the Intellectual Property Code No 6769 (IPC) in January 2017, if the trademark relied upon has been registered for more than five years as of the date of application of the opposed application, upon request by the applicant, the office must ask the opponent to prove the genuine use of the trademark relied upon for the relevant goods and services in Turkey. If use cannot be proven for some goods/services, the earlier trademark will be taken into consideration only for the goods/services for which use was proven. The office has thus allowed applicants to raise a non-use defence in terms of national applications since 2017.

However, until recently, the holders of designations of IRs were unable to file a response or request proof of use unless they monitored the designation themselves and noticed the opposition before the office rendered its decision. This was due to the fact that there was no procedure to notify an opposition to an IR owner through WIPO. Therefore, IR owners were unable to reply to oppositions and raise the non-use defence in opposition proceedings against their IR designations in Turkey. This lack of notification to IR holders had been criticised since the entry into force of the IPC, as it violated the rights of IR owners.

Change in practice

The office recently rendered a decision regarding an opposition filed against an IR designation and deprived the IR owner of the possibility of replying and raising the non-use defence. The IR owner pointed out this discrimination in the appeal petition, explaining that the same procedure should be applied to IR designations and national applications, and that depriving IR owners of the right of filing a reply and raising the non-use defence was unfair.

The Higher Board of the office examined the appeal and accepted that rendering a decision without allowing the IR owner to file a reply and raise the non-use defence was indeed unfair. Ultimately, the Higher Board did not allow the IR owner to raise the non-use defence during the appeal phase, as the opponent held other trademark registrations not subject to proof of use and, therefore, a non-use allegation would not have changed the outcome of the opposition. However, the office's remarks in this respect constitute a great progress, which will give equal rights to the holders of IR designations and national applications.

As the non-use defence can be asserted only in the reply petition and within a one-month time limit, in accordance with the procedural rules set forth by the Regulation for the Implementation of the IPC, it is understandable that the Higher Board did not allow the IR owner to raise the non-use defence during the appeal phase. The Higher Board's decision regarding the other trademark registrations not subject to proof of use was also reasonable. However, what would have happened if the opponent had not held other registrations not subject to proof of use? In other words, although the Higher Board stated that depriving the IR owner of its right of defence was unfair, would the board have allowed the IR owner to raise the non-use defence during the appeal phase if the opponent had not owned other marks not subject to proof of use, despite the explicit language of the regulation? The authors believe that the office would remedy this deficiency should such a situation arise.

As a matter of fact, the authors have been orally informed by the office that it would start notifying the holders of IR designations via WIPO when oppositions are filed, and also grant them one month to file their responses and, where possible, raise the non-use defence. Further, recently some IR owners have been notified of oppositions via WIPO. Therefore, it seems that the office has found a way to overcome such a deficiency and taken a great step, in practice, to treat IR designations and national applications equally. On the other hand, as no formal announcement has been made by the office, IR owners are advised to continue monitoring their designations through their local counsel.

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