

TURKEY

Dilemma over well-known trademark registry continues in Turkey

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We have previously reported on the Turkish Court of Cassation's decision concluding that the Turkish Patent and Trademark Office (the office) has no authority to create and maintain a registry for well-known trademarks and discussed the possible repercussions of this decision for trademark owners (Turkey well-known trademark registry is again open for debate).

In this article we will examine how practice has been shaped in the light of this decision, offer tips for brand owners during this interim period and predict what to expect in future.

The Turkish Court of Cassation's decision (No. 2019/2980 E-2020/991 K dated February 5 2020) had been finalised without the review of the General Assembly of the Court of Cassation, which could unify the jurisprudence in the event of resistance against the decision. But the court of first instance did not resist in its decision. The plaintiff appealed the decision of the first instance court but since the same chamber of the Court of Cassation examined it, the appeal was dismissed. Therefore the decision of the court of first instance rendered in accordance with the Court of Cassation's decision has become final.

Developments since the decision

Following the decision of the Court of Cassation, we have observed that in practice the first instance IP courts and regional courts of appeals have adopted the decision of the Court of Cassation and given dismissal decisions in pending court

actions that are of the same nature.

Recent decisions of the courts that we have reviewed made reference to the decision of the Court of Cassation and the reasoning was the same: the office has no authority ordered by law to keep an official registry for recording well-known trademarks and there is no legal benefit in initiating a cancellation action against the office due to the rejection of an application to record trademarks as well-known, since the well-known status of a trademark should be proven in a given case where it is argued in accordance with established precedents.

However, the office has continued to maintain its registry for recording well-known trademarks, and has accepted, processed, and even recorded new trademarks on the well-known trademark registry. The office has also listed the official fee for filing for determination of the trademarks in its updated 2022 tariff, another indication that it will continue its practice.

The Court of Cassation's decision is debatable as it does not provide satisfactory reasoning in making a change from its former precedents that shaped the practice for the last two decades. Indeed, the rules and regulations did not change in essence during this period. Further, a well-known trademark recordation does not prevent the courts from reviewing the well-known status of a trademark in each case and indeed the practice has been that way for many years. On the contrary, implementation has shown that a well-known trademark registry has practical benefits in the oppositions filed by trademark owners before the office.

Differences between courts and the office

At present, there is clearly a dilemma about the well-known trademark registry of the office since the courts and the office have a different interpretation and implementation. While the courts follow the decision of the Court of Cassation, the office has not made any

change to its implementation.

Given that the office has not changed its practice, trademark owners may still consider filing a well-known status determination and recordation application if there is evidence and if consequently the chances seem good. However, if the application for a well-known trademark is rejected, there is no benefit in filing a court action against the decision of the office, unless the current precedents of the Court of Cassation change.

Trademark owners that have a recordation of a well-known trademark by the office should closely monitor the implementation of the office in relation to oppositions and consider filing additional evidence proving the well-known status in cases where a well-known trademark record is relied upon.

To our best knowledge as of the date of this article, there is no case before the General Assembly of the Court of Cassation, whose decision would be binding on the courts. Such a decision, if rendered, could urge the office to review its policy and implementation and perhaps lobby for a new regulation clearly authorising the office to record well-known trademarks.