

Non-Use Defence in Opposition Proceedings in Turkey

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In 2017, both the Industrial Property Code No. 6769 (the IPC) and the Regulation on the Implementation of the IPC (the Regulation) were published and entered into force, uniting all IP rights in one Code which were previously regulated by different decree-laws.

The non-use defence in opposition proceedings was introduced with the IPC. According to the IPC if the trade mark claimed to be similar to the application is registered for more than 5 years as of the application date (or priority date) of the opposed application, upon request of the applicant, the Turkish Patent and Trademark Office (the Office) shall ask the opponent to prove the effective use in Turkey on the relevant goods and/or services within the scope of the trade mark relied upon the opposition.

Upon an opposition to an application, the Office has to notify the applicant that an opposition has been filed. The applicant is entitled to submit responses within one month as of the notification date of the opposition. Together with the responses, the applicant may also request the proof of use of the opponent's trade marks, if the opposition is based on likelihood of confusion argument (Article 6/1 of the IPC). The Office shall then notify the opponent and inform that such proof of use can be submitted within one month.

The trade marks for which use could not be proven will not be taken into consideration in the evaluation of the opposition based on similarity. If it is proved that the trade mark is used only for some goods/services within the scope of the registration, the opposition will be reviewed only on the basis of goods/services for which use has been proven.

Since the counter non-use claim in opposition proceedings is a whole new concept, to clarify the use and role of the concept, the Office published the Proof of Use Guidelines (the Guidelines) on 28 April, 2017 and updated it on 30 September, 2017. In the Guidelines, among other explanations, the Office explains the qualifications of proof of use evidence and lists the evidence materials which can be used to prove the genuine use of a trade mark in Turkey.

According to the Guidelines : invoices, price lists, catalogues, product codes, products, packaging, signboard visuals, advertisements, promotions and their invoices, marketing surveys, opinion researches, information about the commercial activity and any additional documents/statements regarding Turkey

can be submitted to prove the genuine use of the trade mark. While assessing the genuine use, the following factors are taken into account by the Office: time, place, nature, extent of use and use for the goods/services for which the trade mark is registered.

All evidence should be linkable with the trade mark, should be dated and should demonstrate the genuine trade mark use in Turkey in the last 5 years (retrospective from the date of application/priority of the opposed trade mark).

Under Turkish regulations no medicinal product for human use can be sold and marketed unless it obtains a marketing authorization from the Turkish Ministry of Health. Such applications can be made only by real or legal persons residing in Turkey. In addition, it is strictly forbidden to advertise all type of drugs to the general public. Only authorized products can be promoted to healthcare professionals. Drugs cannot be sold directly from the pharmaceutical company to patients. Pharmaceutical companies sell their drugs to warehouses, which then sell to pharmacies.

Due to these special regulations, pharmaceutical trade mark owners face some difficulties to prove the genuine use of their trade marks in Turkey, when requested. As it is mentioned above, among other materials, the genuine use of a trade mark may be proven by catalogues, advertisements and promotions. The Guidelines state explicitly that submitting visuals or videos of advertisements and promotion materials and the invoices thereof constitutes great importance.

Pharmaceutical trade mark owners cannot submit any evidence showing the advertising of their products to the general public in Turkey. It is possible however to submit promotional materials intended for healthcare professionals and information and documentation regarding scientific meetings held in relation to their products.

Due to this legal impediment faced by trade mark owners to prove the genuine use of the trade mark, submitting other types of documentation will be particularly important. However, since in most of the cases the trade mark is registered on behalf of the foreign entity, the link between the Turkish entity holding the marketing authorization of the product and the foreign trade mark owner should also be explained and supported by documents. If the invoices and other documents proving the use of the trade

mark are issued by another entity, even if this entity is affiliated to the trade mark owner, we see that the Office does not directly accept such evidence and seeks license or sublicense agreements as well as franchise and/or merchandising agreements in order to accept the relationship between the companies and the use of the trade mark. Therefore, submitting documentation which will satisfy the Office showing the link between the entities is very important to prove the use of a trade mark. Hence evidence showing the sale of the product by the marketing authorization holder to a warehouse might not suffice to prove that the trade mark has been genuinely used by the trade mark holder or by an authorized representative.

The maximum sale prices of pharmaceuticals are set by the Ministry of Health and are published in the Ministry's official website as well as the number and date of the marketing authorization of the product. This information is available to the public and may be used as evidence supporting the retrospective use claim.

In a recent case where the trade mark relied on in the opposition was used on pharmaceuticals, the Office accepted that the trade mark was used based on invoices and other evidence showing the use of the trade mark and did not seek further documentation showing the advertisement or promotion of the goods. It was explained in the proof of use petition that due to regulatory reasons, only invoices and documents regarding the proceedings before the Ministry of Health such as MA, price listings, etc. could be submitted. This decision also proves that the Office will tailor the proof of use implementation, depending on the type of goods and taking into consideration other laws and relevant legislation.

Although the proceedings and examinations related to the non-use defence can still be considered as quite new, we see that the Office has already adapted its examination procedures according to different industries and their specific regulatory requirements. The Office accepts that evidence related to the advertising of pharmaceuticals is not available due to regulatory prohibitions. Therefore any other kind of evidence showing the retrospective use of the trade mark is accepted; thus allowing pharmaceutical companies to benefit from a fair examination made by the Office which relies on the knowledge of the specific conditions and requirements related to the industry.