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Legitimacy of Turkish PTO's registry of well-known trademarks thrown into doubt

Turkey - Kenaroğlu Avukatlik Burosu

- **Earlier this year the Court of Appeals held that it was not legitimate for the PTO to hold a registry of well-known trademarks**
- **Although decisions of the Court of Appeals are not binding, it seems that the first-instance IP courts have started to adopt the Court of Appeal's approach**
- **It remains to be seen which direction the first-instance courts will take**

Background

The Turkish Patent and Trademark Office (PTO) holds a registry of well-known trademarks; the trademarks recorded in this registry enjoy broader protection in proceedings before the PTO and the IP courts, as their reputation has already been recognised. More than 750 trademarks are currently recorded in this registry and recognised as well known. Rights holders are expected to file an application for well-known status and, if their application is rejected, they may challenge the PTO's unfavourable decision by filing a cancellation action before the Ankara Civil IP Court.

Ankara Civil IP Court decision

In a recent decision, the Fifth Chamber of the Ankara Civil IP Court rejected an action for the cancellation of a PTO decision refusing to record the plaintiff's trademark in the registry of well-known trademarks on the ground that the level of reputation of the trademark at issue did not meet the PTO's criteria. The court's decision was based on the premise that the PTO is not authorised to hold a special registry of well-known trademarks.

The Ankara Civil IP Court relied on a recent decision of the Turkish Court of Appeals (Case No 2019/2980, 5 February 2020) holding that it was not legitimate for the PTO to evaluate the well-known status of trademarks and to hold a registry for this purpose. The decision of the Court of Appeals came as a shock to Turkish trademark practitioners and the PTO, since the PTO's registry has existed for many years and there is no legal regulation preventing the PTO from holding such a registry or recognising the well-known status of registered trademarks.

Comment

Decisions of the Court of Appeals are not binding on the first-instance courts and, accordingly, the judges are free to keep accepting such cases until the PTO is prevented by law from holding a registry of well-known trademarks. Nevertheless, it seems that the first-instance IP courts have started to adopt the Court of Appeal's approach and reject cases based on the above-mentioned ground.

It remains to be seen which direction the practice of the first-instance courts will take but, in the meantime, some crucial questions arise:

- What will be the legal status of the well-known trademarks already recorded in the registry?
- What will happen to applications for well-known status pending before the PTO?
- Will the PTO terminate its practice and remove the registry of well-known trademarks, or challenge this unexpected decision of the Court of Appeals?

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TAGS

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