

# TURKISH COMMERCIAL LAW REVIEW

## ARTICLE SERIES: INTELLECTUAL PROPERTY

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A New Era for Intellectual and Industrial Rights in Turkey:  
the Industrial Property Law No. 6769

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# Potential Risks Associated with the Non-Use of a Registered Trademark

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## ABSTRACT

*A registered trademark vests wide range of authorities to its holder and if renewed properly, such authorities are valid indefinitely. The primary legislation in relation to registered trademarks in Turkey is the Industrial Property Law No. 6769, which imposes certain obligations on trademark owners. Most importantly, according to Article 9 if, the registered trademark has not been put to serious use within a continuous period of five years or if the use thereof has been suspended for more than five years it shall be repealed. Revocation of a trademark due to non-use was previously regulated under Article 14 of Trademark Decree Law No. 556, which had been cancelled by the Turkish Constitutional Court before the IPL was promulgated. Similarly, the IPL expanded the legal consequences associated with the non-use of trademark by introducing three new Articles (19, 25 and 29) This article focuses on the sanctions imposed on non-used registered trademarks and the ongoing implementation of Articles 9, 19, 21, 25, 29 of the IPL and discusses the repercussions of the revocation of Article 14 of the Trademark Decree Law.*

## I. INTRODUCTION

A trademark right is an intangible industrial right, which provides its owner with an exclusive title that can be set forth against anyone. The protection of the trademark right is obtained by means of registration, which is valid for ten years and may be renewed for successive ten-year periods for an unlimited time to ensure the validity of such trademark registration.<sup>1</sup>

The relevant legislation is the Turkish Industrial Property Law No. 6769 (the IPL) which came into force on 10 January 2017, replacing the Trademark Decree Law No. 556 (the Trademark Decree Law) which had been in place since 1995. Furthermore, the Agreement on Trade-Related Aspects of Intellectual Property (TRIPS) is also applicable in the Turkish legal context as Turkey is a signatory thereto.

Under Article 9 of the IPL, ‘the use of the trademark’ in Turkey is a prerequisite

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1 Article 23 of the Turkish Industrial Property Law No. 6769, 2017.

for the continuation of the protection conferred by the registration of a trademark.<sup>2</sup> Pursuant to the related articles of the IPL, a registered trademark which has not been in continuous use for five years following its registration may be cancelled under certain circumstances. The main reason behind this requirement is its function in distinguishing ‘the goods and services of a business operation from the goods and services of others’. Where a registered trademark has been in use by the trademark owner for an uninterrupted five-year period, it attains a distinctive quality under the law.<sup>3</sup> Another reason for the requirement to use a trademark is to ensure that other parties have the opportunity to put the non-used trademark to use.

Nevertheless, this requirement is not stipulated under any Turkish legislation as a condition for first-time trademark applications or renewals filed before the Turkish Patent and Trademark Office (TPTO). Thus, due to a gap in the law, a trademark which has never been used in Turkey or the use of which has been suspended can be registered or renewed before the TPTO. Yet, such registration is not protected against any cancellation. Furthermore, the owner of the unused trademark is not provided the protections conferred by registration, including the right to object to new applications for trademarks that are similar or identical to the owner’s own trademark, in which case the trademark owner would have to prove their uninterrupted use of such trademark.

Nonetheless, neither the TPTO nor the courts have the right to carry out an ex-officio examination on a trademark to determine whether such a trademark is in use or not. This type of an examination will be conducted only where a third party files a cancellation action before the TPTO. In such case, upon filing of a cancellation action, the court requests from the respondent trademark owner to submit any evidence proving the use of their trademark. If the trademark owner fails to submit sufficient evidence showing its use, the registration may be cancelled fully or to the extent of its non-use.

Under the previous legislation, i.e., the Trademark Decree Law, in case of non-use (or the suspension of the use) of the trademark for an uninterrupted period of five years following the registration—whether starting from the beginning of the ten-year validity period or at any time during such period—, the mere sanction was the cancellation of the trademark. In contrast, the IPL stipulates more comprehensive sanctions, whereby the owner of the non-used registered trademark may not benefit from the protection inferred from the registration in an infringement or invalidation action filed before the court against third parties or in oppositions filed before the TPTO against trademarks of third parties.<sup>4</sup>

In order to understand the significance of the changes enacted by the IPL the next section of this article examines the requirement of use as regulated under the IPL.

## II. ‘THE REQUIREMENT OF USE’ AS REGULATED UNDER THE IPL

It is stipulated in Article 9 of the IPL that;

If, within a period of five years following the registration, trademark has

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2 Article 3 and Article 9 of the Turkish Industrial Property Law No. 6769, 2017.

3 U. Çolak, *Türk Marka Hukuku* (İstanbul: 12 Levha Yayınları, Second Edition), 852.

4 Articles 9, 19 and 26 of the IPL.

not been put to use in terms of the goods or services under the scope of the registration by the trademark owner seriously in Turkey without a justifiable reason or if the use has been suspended for an uninterrupted period of five years, the trademark shall be repealed.

The following are deemed to satisfy the ‘the use of a trademark’ under the IPL:

- (1) Use of the registered mark in a form differing in elements which do not alter the distinctive character of the trademark,
- (2) Use of the trademark on goods or their packaging solely for export purposes,
- (3) Use of the trademark with the consent of the owner.<sup>5</sup>

The form of use listed under (1) stipulates that the trademark is considered in use if new definitive denominations are added to the trademark that preserve the distinctive character of the trademark. The evaluation of whether the distinctive character of a trademark is changed or not is carried out on a case-by-case basis.<sup>6</sup> In case one or more of the distinctive elements in the trademarks containing more than one distinctive element is not used, the distinctive character of the trademark is considered to have been changed.

Other forms of use such as the use of the trademark on newspaper and magazine ads and in TV commercials, promotions of the trademark, use in public relations, tenders and domain names, use on invoices and other print collateral (if different from the trade name of the business enterprise and in a form which highlights the branding element in the trade name of the business enterprise) also constitute a use that preserves the distinctive character of the trademark.<sup>7</sup>

The form of use listed under (2) (i.e. use of the trademark on goods or their packaging solely for export purposes) states that the product carrying the respective trademark must be exported from Turkey with the purpose of being sold in a foreign country. In this case, in order to accept such use of a trademark, the respective trademark should be applied on the exported goods and/or their packaging in Turkey before being exported.

The form of use listed under (3) (i.e. use with the consent of the proprietor) implies that even if the trademark is not used by the trademark owner, another party’s use on the cited trademark satisfies the condition if its owner’s authorisation is obtained. Such authorisation is granted by the registrant under the scope of a license, sole dealership, franchising agreements, etc.

#### **a) Distinction between a Well-Known Trademark and an Unknown Trademark**

One practical question that arises in the enforcement of Article 9 is the distinction between a well-known trademark and an unknown one. Where a trademark is well-known by the public but is not used in relation to certain goods and/or services, will its

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<sup>5</sup> Article 9 of the IPL.

<sup>6</sup> *Ibid.*

<sup>7</sup> U. Çolak, *Türk Marka Hukuku* (İstanbul: 12 Levha Yayınları, Second Edition), 852.

notability prevent the trademark from being cancelled in terms of the goods/services for which the trademark registration is not used?

In *Adidas v. OHIM & Shoe Branding Europe*<sup>8</sup> that was heard before the Court of Justice of the European Union (CJEU), the Court concluded that the well-known status of a trademark would not prevent third parties from requesting the partial cancellation of the cited trademark. Accordingly, the registration of well-known trademarks can be partially cancelled if they are not used in relation to certain goods or services.<sup>9</sup> This approach was adopted in Turkey by the Court of Cassation General Assembly of Civil Chambers in 2010.<sup>10</sup> Consequently, Turkish courts expect that the below-discussed requirements are met not only by owners of unknown trademarks, but also by those of well-known trademarks.

## b) Requirements of 'Use' Under the IPL

### 1. *The Five-Year Time Period and the Definition of Justifiable Reason*

In accordance with Article 9 of the IPL, if, within a period of five years following the registration, a trademark has not been put to use without a justifiable reason or if the use has been suspended for an uninterrupted period of five years, the trademark shall be repealed. In this case any claim of non-use or any request of cancellation may not be set forth against a trademark for which within a period of five years has not passed following the registration date.

It is accepted that a trademark owner may discontinue using a trademark from time to time during its commercial activities.<sup>11</sup> In order for the non-use of the trademark to be a cause for cancellation, the act of non-use has to be performed knowingly and willingly by the owner.<sup>12</sup> When the non-use of the trademark stems from reasons unavoidable by the trademark owner, such a cause of cancellation would not materialise.<sup>13</sup>

While the circumstances that constitute 'a justified reason' for the non-use of a trademark are not clearly described in the IPL, events such as war and natural disasters, which develop outside the willpower and beyond control of the trademark owner and which cannot be intervened by the trademark owner, are generally considered justified reasons as they prevent the use of a trademark. In contrast, a registrant's bankruptcy which leads to the confiscation or expropriation of its trademarks is not considered to be a justified reason.<sup>14</sup> Nevertheless, every case shall be interpreted according to its own circumstances.

<sup>8</sup> *Adidas v. OHIM & Shoe Branding Europe* Case T-145/14 (2015).

<sup>9</sup> H. Yasaman, *Marka Hukuku* (İstanbul: Vedat Kitapçılık, 2004), 628-657.

<sup>10</sup> Decision no.2010/11-695 E., 2011/47 K. dated 9 February 2011 issued by the Court of Cassation General Assembly of Civil Chambers.

<sup>11</sup> Article 9 of the IPL.

<sup>12</sup> *Ibid.*

<sup>13</sup> E. Noyan & İ. Güneş, *Marka Hukuku* (Ankara: Adalet Yayınevi, 2015), 443.

<sup>14</sup> Decision no.2001/844 E. and 2001/3429 K. dated 9 April 2001 issued by the 11<sup>th</sup> Civil Chamber of the Court of Cassation.

The notion of ‘justified reason’, referred to as ‘valid reasons for non-use’, is regulated under Article 19 of the TRIPS titled ‘Requirement of Use’. Accordingly, circumstances arising independently of the will of the owner of the trademark which constitute an obstacle to the use of the trademark, such as import restrictions on or other government requirements for goods or services protected by the trademark, shall be recognised as valid reasons for non-use.<sup>15</sup>

In case the trademark owner allows a third party the use of a trademark and such a third party can justify its reasons for non-use based on ‘valid reasons for non-use,’ it will be subject to a similar evaluation as the one carried out on the owner.<sup>16</sup> However, this does not mean that the uninterrupted five-year period stipulated for the beginning of the use of the trademark would begin as of the date of authorisation granted to the licensee of the trademark. On the contrary, the five-year period is tied to the trademark and not the user and thus, comprises usage by the owner and any authorised third parties. Furthermore, where the trademark is assigned to another party, the stipulated time period will not restart but accrue independently of who the rightsholder is.

## 2. *The Territory of the Use*

‘The territory of the use’ is another important element in determining whether the use meets the requirements. In accordance with Article 9 of the IPL, the trademark must be used in Turkey. The use of the trademark in any part of Turkey would be considered sufficient to comply with the requirement.

Where the owner grants a license to a resident outside the country for the use of its trademark, despite the trademark being registered in Turkey, any use of it abroad does not suffice to meet ‘the use of the trademark’ requirement under the IPL.<sup>17</sup> In order for such trademark to meet the standard, it is required to be used within Turkey.

On the other hand, where the use abroad targets the Turkish market or people residing in Turkey, then such use can be considered within the scope of Article 9 of the IPL.<sup>18</sup> For instance, the advertisements and announcements published in a foreign magazine may be accepted as a valid use if the respective magazine is also sold in Turkey. In this example, the language of the magazine would not be relevant for a determination of the territory of use.<sup>19</sup>

Another highly-disputed issue in this respect is whether the online use can be considered as use in Turkey. Together with the advancements in technology and the rapidly increasing presence of the Internet in daily life, traditional forms of communication and commerce have made way to their online counterparts. For instance, movies and TV shows are now predominantly watched online, newspapers are read online and shopping is done online. These developments have raised the issue of territory with respect to the

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15 U. Çolak, *Türk Marka Hukuku* (İstanbul: 12 Levha Yayınları, Second Edition), 867.

16 Article 9 of the IPL.

17 Decision no. 2007/3234E., 2008/5432 K. dated 22 April 2008 issued by the 11<sup>th</sup> Civil Chamber of the Court of Cassation.

18 Article 3 of the IPL.

19 U. Çolak, *Türk Marka Hukuku* (İstanbul: 12 Levha Yayınları, Second Edition), 853.

online use of trademarks and required courts to make a determination on whether such use can be considered one within Turkey. On 3 March 2011, the Court of Cassation held that online use of trademarks meets the geographic requirements of Article 9 of the IPL and are considered use within Turkey.<sup>20</sup>

### 3. *The 'Serious Use' Standard*

In addition to the geographic requirement under Article 9 of the IPL, such use is also required to be a 'serious' one.<sup>21</sup> The term 'serious' is not defined in the IPL but based on the text of Article 4 of the IPL, which stipulates a use that makes it possible to 'distinguish the goods and services of one undertaking from the goods and services of other undertakings', it is understood to be a use (x) in a frequent manner in the market or in a location affecting the market, which (y) provides a benefit from the trademark in accordance with its functions and (z) enables a means for promoting the good or the service in the market and distinguishing from the goods and services of the other business operations.<sup>22</sup>

In other words, in order to mention a use of the trademark, the use should be able to create a market share. The fact that a good or service, which is not manufactured or sold, is advertised and/or promoted will not be sufficient to prove that such trademark is seriously used.<sup>23</sup>

The concept of 'serious use' was also addressed in the 2003 *AJAX v. ANSUL*<sup>24</sup> decision by CJEU which considered it to be a symbolic use to merely keep the rights granted by the trademark at hand. Where the trademark owner grants a license for the use of a trademark, the use by the licensee is also sufficient to prove a 'serious use' of the trademark. In other words, use of the trademark by the licensee is considered equivalent to use by the trademark owner.

### 4. *Purpose of Use*

In accordance with Article 9 of the IPL, a trademark must be used with respect to the goods and/or services written on the registration certificate.<sup>25</sup> Use for goods and/or services similar to those on the certificate is not sufficient to satisfy this requirement.<sup>26</sup>

Accordingly, if a trademark is used for a certain good or service and not for all goods and/or services set forth in the registration certificate, then such use will validate the trademark registration only with respect to the individual goods and services for

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20 Decision no. 2009/3437 E. and 2011/2191 K. dated 3 March 2011 issued by the 11<sup>th</sup> Civil Chamber of the Court of Cassation, Decision no. 2012/4565 E. and 2013/6444 K. dated 1 April 2013 issued by the 11<sup>th</sup> Civil Chamber of the Court of Cassation.

21 Article 9 of the IPL.

22 Ü. Tekinalp, *Fikri Mülkiyet Hukuku* (İstanbul: Vedat Kitapçılık, Fifth Edition), 460.

23 U. Çolak, *Türk Marka Hukuku* (İstanbul: 12 Levha Yayınları, Second Edition), 760.

24 *Ajax v. Ansul Case C-40/01* (2003).

25 Article 9 of the IPL.

26 Decision no. 2013/348 E, 2013/18993 K. dated 5 February 2013 and Decision no. 2011/11201E. and 2011/15344 K. dated 17 November 2011 issued by the 11<sup>th</sup> Civil Chamber of the Court of Cassation.

which the trademark is used. Even if the use is similar to those on the certificate, the registration with respect to the unused goods and/or services will be cancelled.<sup>27</sup>

### III. THE BURDEN OF PROOF

Under the IPL, in a court action for cancellation based on non-use, the burden of proving the uninterrupted and serious use of a registered trademark is on the defendant.<sup>28</sup> The trademark owner is required to provide concrete evidence that establishes the use of the trademark. It is stated in the doctrine that ‘as underlined by CJEU, the proof of use should not be provided for by means of assumptions or probabilities but by means of objective evidences’.<sup>29</sup>

In order to constitute admissible evidence proving the use of a trademark, the evidence submitted should indicate the date and the location of the trademark use and the type of the products for which the trademark is registered. For instance, in order to prove the trademark use by means of submitted invoices, catalogues and brochures, the respective invoices need to contain the trademark and the catalogues and brochures have to indicate the date of publication.<sup>30</sup>

Furthermore, in accordance with Article 26/4 of the IPL, any use of the trademark by the owner with the purpose of evading cancellation shall not be taken into consideration in a cancellation action.

### IV. RISKS ASSOCIATED WITH THE NON-USE OF A REGISTERED TRADEMARK

#### a) Cancellation of the Trademark Registration

The heaviest sanction that can be issued for the non-use of the trademark is the partial or full cancellation of the trademark registration. Such cancellation may be authorised only upon the request of the related parties.<sup>31</sup>

According to the Trademark Decree Law, a request for cancellation of a trademark registration can only be requested in a court action against the registrant. However, with the enactment of Article 26 of the IPL, the authority to make a cancellation decision was transferred from courts to the TPTO<sup>32</sup>. However, the enforcement of such change has

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<sup>27</sup> Article 9 of the IPL.

<sup>28</sup> Decision no. 2010/5602 E., 2011/14744 K. dated 1 November 2011 T., Decision no. 2010/12615 E., 2010/12750 K. dated 9 December 2010 and the Decision no. 2008/10389 E., 2010/1349 K. dated 8 February 2010 issued by the 11<sup>th</sup> Civil Chamber of the Court of Cassation.

<sup>29</sup> Case T-325/06 *Boston Scientific Ltd v. Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Judgment of the Court of First Instance (8<sup>th</sup> Chamber) dated 10 October 2008. U. Çolak, *Türk Marka Hukuku* (İstanbul: 12 Levha Yayınları, Second Edition), 767.

<sup>30</sup> Decision no. 2015/6031 E., 2015/13268 K dated 9 December 2015 issued by the 11<sup>th</sup> Civil Chamber of the Court of Cassation.

<sup>31</sup> Articles 9 and 26 of the IPL.

<sup>32</sup> The grounds for these regulations are the provisions of the EU Trademark Directive 9 no.2015/2436 and the EU Regulation 10 no.2015/2424 and the Amended EU Community Trademark Regulation 11 no. 207/2009. Whereas, in the respective provisions of the Regulation, in the cases which require cancellation or invalidation of the trademarks of the Member States, the respective request of cancellation or invalidation



been postponed for seven years and the TPTO will begin to hear cancellation requests after 10 January 2024. In accordance with Interim Article 4 of the IPL, until Article 26 comes into force, cancellation requests shall be evaluated by courts in accordance with the procedures in the said article. Following the requests, the TPTO will convey them to the registrants and will require them to submit evidences of use in respect of the trademarks within one month. Upon the request of the registrant, such one-month period can be extended by another month at most.

After the evidence is submitted by the trademark owner or after the end of the one-month (or extended) period, if any, the TPTO will re-examine the file and announce its decision. In contrast to the traditional legal procedure established by the Trademark Decree Law, which involved testimony by the parties at trial and expert reports, under the IPL regime a decision on whether the trademark will be cancelled or not shall be issued following an examination of the information and documents submitted in the actual file. This evaluation procedure, which is expected to accelerate cancellation processes of the non-used trademarks provided for in Article 26 of the IPL, will also be taken as the basis for cancellation requests to be evaluated by the courts in seven years. However, in current practice, it is observed that the courts are still adopting the general jurisdiction procedure determined in the Turkish Civil Procedure Law No. 6100 (the Turkish Civil Procedure Law).<sup>33</sup>

## b) The Non-Use Defence

### 1. *Non-use in Opposition Actions*

In accordance with Article 19/2 of the IPL, in opposition actions based on an already-registered trademark registration and provided that the trademark has been registered for at least five years in Turkey as of the application or prior date of the opposed application, the opponent can be requested to submit evidence showing its 'serious use' of the trademark or justified reasons for its non-use of the trademark. In other words, where a registered trademark owner has not used their trademark for an uninterrupted five-year period and opposes a trademark application based on its prior registered non-used trademark, they might face a claim by the applicant requiring the registered trademark owner to prove its use.

In this case, a one-month period will be given to the opponent to submit their evidence showing the use. If the opponent is unable to prove that the trademark is seriously used or that the non-use is based on a justified reason, the opposition action will be dismissed. In case it is proven that the trademark in question is used for merely a part of the goods or services within the scope of registration, the opposition will be examined merely by taking into account such goods or services.<sup>34</sup>

At this point it should be mentioned that since the exception of non-use can be set forth for the grounds of opposition based on the trademark registrations with a prior

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can be set forth by means of filing a court action, they were made liable with enabling the filing of the request before the administrative authorities and to complete the required domestic rules of law until 14 January 2023.

<sup>33</sup> The Turkish Civil Procedure Law, numbered 6100 and dated 12 January 2011, published in the Official Gazette numbered 27836 and dated 4 February 2011.

<sup>34</sup> Article 19 of the IPL.

date, inability to prove the use will not prevent the opposition from being examined in terms of the grounds such as notability, bad faith etc. and will not prevent the application from being dismissed again based on such grounds.

Two other governing pieces of legislation in relation to the procedure of opposition actions are the Regulation No. 30047 for the Implementation of the Industrial Property Law<sup>35</sup> and the Guidelines for Proving Use, 2017 published by the TPTO.<sup>36</sup> These set forth the procedural details in non-use claims.

## 2. *Non-Use in Invalidation Actions*

In accordance with Article 25/7 of the IPL, the exception of non-use stipulated in Article 19/2 can also be set forth in invalidation cases based on prior trademark registration. Two different time periods are stipulated for the exception of non-use that can be asserted in an invalidation case.

In the first case, the date of the invalidation action will be essential for determining the five-year period. Where the trademarks in question have been registered for five years or longer, the owner of the trademark may raise the non-use defence and demand to use the claimant's trademarks.<sup>37</sup>

In the second case, where the claimant's trademark has been registered for at least five years on the application or priority date of the trademark, the claimant is required to prove that they have used the trademarks retrospectively, before the subject application or priority date.<sup>38</sup>

If the claimant is unable to prove that the trademark is seriously used or that the non-use is based on a justified reason, the requests for invalidation will be partially or completely dismissed.

The right for an exception in the invalidation cases is asserted in accordance with the general procedural rules determined in the Turkish Civil Procedure Law.<sup>39</sup>

## 3. *Non-Use in Infringement Actions*

In Article 29 of the IPL, which governs the legal remedies applied in trademark infringements, the party against whom a court action for trademark right infringement is filed can argue for the exception of non-use. Accordingly, the starting point of the five-year period of use is determined as the date of filing of the court action for trademark right infringement and the exception to non-use may be raised where the trademark in question has been registered for five years or more as of the filing of the court action.<sup>40</sup>

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35 Regulation Concerning the Execution of the Industrial Property Law, published in the Official gazette dated 24 April 2017 and numbered 30047.

36 'The Guidelines for Proving Use' published by the TPTO can be found on the following link; <<http://www.turkpatent.gov.tr/TurkPatent/resources/temp/06BC31D4-EDDC-411A-9E47-332F344B27F6.pdf>>.

37 Article 19 of the IPL.

38 *Ibid.*

39 The Turkish Civil Procedure Law numbered 6100.

40 Article 29 of the IPL.

Where the trademark owner confronted with the exception to non-use is unable to prove that their trademark is used in accordance with the essentials determined in Article 9 of the IPL, the claims of infringement will not be heard or will be partially or completely dismissed.<sup>41</sup>

## V. THE EFFECT OF THE CANCELLATION OF ARTICLE 14 OF THE TRADEMARK DECREE LAW ON PENDING CASES

The Constitutional Court have repealed Article 14 of the Trademark Decree Law on the grounds that basic rights and freedoms including the right of property cannot be regulated by decrees pursuant to Articles 91/1 of Constitution. It was stated in Article 14 of the Trademark Decree Law that ‘if, within a period of five years following the registration, trademark has not been put to use without a justifiable reason or if the use has been suspended for an uninterrupted period of five years, the trademark shall be repealed’.

Article 42/1(c) of the same Trademark Decree Law also set forth the ‘non-use of a trademark without a justifiable reason as of the registration date of such trademark’ as a reason for invalidation. This Article 42/1(c) was annulled by a Constitutional Court decision in 2014.<sup>42</sup> The Court stated that ‘the trademark right is a proprietary right and the proprietary rights cannot be regulated by means of the ‘decree laws.’<sup>43</sup>

Together with the said annulment, although the ‘non-use of a registered trademark within the stipulated time period’ under Article 42/1(c) has been removed from the list of reasons in invalidation actions, the cancellation of the non-used trademark could still be requested in accordance with Article 14 of the Trademark Decree Law.

However, on 6 January 2017 the Constitutional Court issued another decision with regard to a cancellation action and annulled Article 14 of the Trademark Decree Law.<sup>44</sup> The decision to annul Article 14 was based on the grounds that the ownership right on the trademark is a proprietary right and a fundamental right within the scope of the Constitution which therefore cannot be regulated by means of a decree law. Together with this second decision, all domestic rules of law governing cancellation and invalidation actions of a trademark based on non-use have been annulled and all pending cases based on these two Articles dismissed.

Only four days after the said decision of annulment, on 10 January 2017, the IPL came into force and Article 9 of the IPL brought back the right to initiate a cancellation action based on the non-use of a trademark.

In theory, laws are effective prospectively, with retrospective enforcement being the exception, in which case a regulation is required to set forth such exception. In the case of Article 9, since there is no regulation stipulating the retrospective implementation of Article 9 of the IPL, it is accepted that said regulation would not apply retrospectively,

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<sup>41</sup> *Ibid.*

<sup>42</sup> Decision no. 2013/147 E. and 2014/75 K. issued on 9 April 2014.

<sup>43</sup> *Ibid.*

<sup>44</sup> Decision no. 2016/148 E., 2016/189 K dated 14 December 2016 issued by the Constitutional Court.

raising the question of how to proceed with cancellation actions that were dismissed in the four days between 6 January and 10 January 2017 based on the annulment decision by the Constitutional Court.

According to one view, with the issuance of the decisions for the cancellation of Article 14 of the Trademark Decree Law, the cancellation actions that were brought within the scope of Article 14 lost their legal grounds and therefore should be dismissed.<sup>45</sup> Moreover, in accordance with Article 152/3 of the Constitution the Constitutional Court is required to render a decision on a case within five months following its receipt. If it fails to do so in the said period, then lower court cases awaiting the Constitutional Court's decision shall be adjudicated and finalised based on the applicable laws in force at the time of such decision. However, if the Constitutional Court decides prior to the lower court's entry of judgment, then the lower court must defer to the Constitutional Court's decision.<sup>46</sup>

According to a contrasting view, in line with the Turkish Civil Code<sup>47</sup> and the TRIPS Agreement,<sup>48</sup> where there are gaps in the law with respect to a certain legal issue, judges are entitled to fill in the loopholes by means of commentary by reviewing relevant provisions in international agreements and the outcomes of similar cases. Two examples of such international agreements are the Paris Convention for the Protection of Industrial Property (the Paris Convention) and the TRIPS.

'The requirement to use a trademark' is regulated under Article 5/c of the Paris Convention,<sup>49</sup> which sets forth that if 'the use of the registered mark is compulsory' in any country that is a party to the Convention then 'the registration may be cancelled only after a reasonable period unless its owner can prove use of the trademark. Unlike the Paris Convention, Article 19 of TRIPS defines the reasonable period by stipulating that unless a force majeure event emerges independent of the trademark owner's will, 'an uninterrupted period of at least three –years of non-use of the trademark' is a ground for cancellation of the trademark registration. However, both legislations specify that these conditions are applicable only where the 'use of the registered trademark is obligatory in a country'<sup>50</sup> or 'the use of trademark is a requirement for sustaining the registration'<sup>51</sup>. Therefore, neither the Paris Convention nor the TRIPS regard the non-use of a trademark alone as an absolute prerequisite for the cancellation of a trademark.<sup>52</sup>

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45 Hayrettin Çağlar, *Non-Use of Trademark and its Legal Consequences*, C. XXI, Y. 2017, N. 1, p. 16.

46 Article 152/3 of the Constitution.

47 Article 2 of the TCC.

48 TRIPS is considered as statutory law in accordance with Article 90/5 of the Constitutional Law Article 90/5 of the Constitutional Law: 'The international agreements which duly come into force are statutory.'

49 Article 5 of the Paris Convention.

50 *Ibid.*

51 Article, 19 of TRIPS.

52 Ali Paşlı, 'Impact of the Revocation of Article 14 of the Trademark Decree Law: Will the Invalidation/Cancellation Actions Based on Non-Use be Dropped?', Ticaret Kanunu Blog, <<http://www.ticaretkanunu.net/makale-25/>>.

However, judges sitting at relevant Turkish courts adopt the first view.<sup>53</sup> This translates to Courts of First Instance rejecting pending cases and the Court of Appeals and the Regional Courts of Appeals (which are second-level appellate courts) reversing the judgments rendered by the Courts of First Instance. Once such cases are sent back for re-trial before the Courts of First Instance they are dismissed on the grounds that the provision set as grounds for the case has been annulled. In order for such cancellation actions to be heard they need to be reframed based on Article 9 of the IPL and refiled as a new lawsuit.

## VI. CONCLUSION

The afore-summarised regulations brought about by the IPL have changed both the administrative and judicial practices in Turkey. Furthermore, they have provided applicants and infringers of already-existing trademarks with an avenue to defend their cases by raising the non-use defence in certain actions such as oppositions, invalidations and infringement actions.

While these changes have allowed for a more effective protection of trademarks, the IPL fails to vest the non-use defence in *ex-officio* refusals where the latter application is identical or similar to already-registered trademarks.

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<sup>53</sup> Decision no. 2016/481E., 2017/3185K. dated 30 May 2017 issued by the 11<sup>th</sup> Civil Chamber of the Court of Appeals.