

Turkey

Kenaroglu Intellectual Property

Exploring the options available to owners of popular marks

The Turkish trademark regime not only provides wider protection for well-known marks, but has also established a special registry for such marks for advance acceptance of their reputation in any conflict

Thanks to developing technology and improved digital promotion facilities, customers are only a click away from your advertisements, meaning that it is much easier for brands to become widely known – even in regions in which they have never been used.

Unfortunately, these advances have left well-known trademarks increasingly vulnerable to opportunistic copying and parodies, both online and offline. It is widely agreed that well-known marks need broader protection than ordinary marks. Turkey grants such protection through various statutes, including:

- Article 6bis of the Paris Convention, which sets out protection for unregistered well-known trademarks;
- Article 8(4) of the Trademark Decree Law (556), adapted from Article 16(3) of the Agreement on Trade-Related Aspects of IP Rights (TRIPs), which sets out protection for registered well-known marks; and
- articles implementing the rules for including a trademark on the Turkish Patent Institute's (TPI) special register of well-known marks. Marks on this register enjoy broader protection in any proceedings before the TPI and the IP courts, with advance acceptance of their reputation for an unlimited period.

This article explores the different options available for the protection of well-known and famous trademarks in Turkey.

Article 6bis of Paris Convention

As a member of the Paris Convention, Turkey has implemented the principles of Article 6bis, which applies broader protection to well-known trademarks against unauthorised applications for identical or confusingly similar trademarks

covering identical or similar goods or services – even where these marks have not been registered in Turkey.

In order to qualify for Article 6bis protection, a mark must be well known among consumers of the goods or services for which protection is claimed, owing to its extensive use – along with extensive advertising – in any country which is a signatory to the Paris Convention. In addition to the defined reputation, the mark need not have been used or have had a reputation in Turkey.

Article 6bis was listed as an absolute ground for refusal under Article 7(i) of the Trademark Decree Law (556) and the TPI was obliged to reject *ex officio* unauthorised third-party applications filed for well-known trademarks. Although Article 7(i) was abolished by the Constitutional Court on May 27 2015, Article 6bis may be still raised as a ground for challenging unauthorised filings during either opposition or appeal actions before the TPI or court actions before the IP courts, under Article 90 of the Constitution.

The draft IP Law – which is due to come into effect by the end of 2016 – also recognises Article 6bis as a relative ground for refusal. Once the law comes into force, Article 6bis will reassume its place in the Turkish trademark regime, but the current scope of protection granted to non-registered well-known trademarks will remain unchanged.

Article 16(3) of TRIPs

Well-known trademarks are also protected under Article 8(4) of the Trademark Decree Law, which is the equivalent of Article 16(3) of TRIPs. In contrast to the protection established by Article 6bis, Article 8(4) grants protection to well-known trademarks for dissimilar goods or services, provided that:

- the well-known mark is registered with the Turkish trademark registry or its application date is earlier than that of the allegedly similar mark;
- the well-known mark not only is recognised by consumers in its specific sector, but also has a general reputation among Turkish customers as a result of its extensive use or promotion in the market; and
- there is a possibility that the later mark would take unfair advantage of or be detrimental to the distinctive character or reputation of the well-known mark.

Where goods or services covered by the later trademark relate to goods or services covered by the well-known mark, it should be easier to persuade the TPI or the IP courts that there is a risk of one of these three conditions applying.

Distinctiveness is another factor which must be considered while determining the scope of the protection to be granted to well-known marks for dissimilar goods or services.

Two recent decisions of the TPI serve as concrete examples of its approach towards widening protection for distinctive well-known trademarks. Two different owners of well-known trademarks opposed two different applications covering identical goods and services in the food sector. One of the opponent's marks was registered and well known for goods in the textiles industry, while the other covered goods in the personal accessories sector. Both oppositions were based on the well-known status of the related marks. The TPI refused the opposition by the owner of the well-known mark in the textile industry due to the fact that the original mark was not highly distinctive, whereas it accepted the arguments of the other opponent.



Both opponents' trademarks were equally well known in Turkey on the cited date and the trademarks in question were confusingly similar to the same. The only reason behind the TPI's refusal was its approach that the registration of a weakly distinctive trademark in a completely different sector may be permissible.

The same approach has also been adopted by the IP courts, yet the courts still grant much broader protection to weakly distinctive well-known trademarks, in comparison with the TPI.

The draft law would introduce an exception to the principle of protecting well-known trademarks in different classes. Once it comes into force, a trademark which is identical or confusingly similar to a well-known mark may be registrable in different classes in case it is filed with due cause. This change will bring Turkish trademark law into line with TRIPs on this issue.

Special register for well-known marks

The TPI has a register of well-known trademarks, which is not the case in some other countries. Listed marks enjoy broader protection in proceedings before the TPI and the IP courts, with advance acceptance of their reputation.

Proving that an unregistered mark is well known is onerous and expensive under current practice, as the rights holder must submit all necessary information and documents to prove its arguments in every single administrative or legal case. However, once the mark has been accepted and recorded as being well known in the TPI's special register, the rights holder no longer needs to provide such proof.

More than 450 trademarks are currently recorded in this special register and protected as well known. In order for a mark to be recognised as well known, the applicant must submit the following documents and information to the TPI:

- a comprehensive petition explaining the mark's well-known status in light of the TPI's criteria;
- an extensive evidence list explaining the content and aim of each piece of evidence submitted and its connection to the TPI's criteria; and



Yasemin Kenaroglu

Partner
yasemin@kenaroglu.av.tr

Yasemin Kenaroglu, founder of Kenaroglu Law Firm, has more than 13 years' experience in IP law. She is a registered attorney at law (Istanbul Bar Association, 2003) and a trademark and patent attorney (Turkish Patent Institute, 2005), as well as an active member of the International Trademark Association and the European Communities Trademark Association. Ms Kenaroglu has been recommended in the *WTR 1000* and *Managing Intellectual Property's* IP Stars as a leading IP practitioner.



Yasemin Aktas Dag

Attorney at law
aktasdag@kenaroglu.av.tr

Yasemin Aktas Dag has been working at Kenaroglu Law Firm since 2011, mainly on IP litigation, prosecution and enforcement matters. She is a registered attorney at law (Istanbul Bar Association, 2011), a trademark and patent attorney (Turkish Patent Institute, 2013) and an active member of the International Trademark Association and the European Communities Trademark Association, the International Federation of IP Attorneys and the International Association for the Protection of Intellectual Property.

- documentary evidence, together with partial or complete translations as necessary.

It may take up to 18 months for the TPI to rule on a right holder's claims for registration of its trademark.

The broader protection granted by such registration remains valid indefinitely. The mark's inclusion in the register can be used as direct and solid proof of its well-known status at any time.

There is no disadvantage to filing such applications, as neither the filing particulars nor the TPI's decision as to the mark's well-known status is open to the public. If the application is accepted, the TPI will publish this in its bulletin. Such a favourable decision is final and binding and cannot be challenged by any third parties.

In case of refusal of the application, third parties will be unaware of this unfavourable result and it thus cannot be used against the applicant in subsequent proceedings.

Bad-faith claims

Article 35 of the Trademark Decree Law protects rights holders against later applications or registrations filed in bad faith and provides for the refusal and cancellation of bad-faith filings.

Neither the TPI nor the IP courts require solid proof of bad faith on behalf of an applicant or registrant through particular evidence, although they do need to be

convinced that there was bad faith at the time of the application.

When it comes to persuading the authorities to accept bad-faith claims, the owners of well-known marks are always one step ahead, owing to the approach internalised in Turkish practice that the identity or confusing similarity of a later trademark to a well-known trademark shall be accepted as a sign of bad faith on the part of the applicant.

While no explicit legislation in Turkey governs this approach, it has been adopted by both the TPI and the IP courts regardless of whether the well-known mark in question appears on the TPI's special register, and has led to trademark applications being rejected or invalidated pursuant to Article 35 of the Trademark Decree Law together with Article 6*bis* of the Paris Convention or Article 8(4) of the decree law.

In a recent precedent issued by the TPI, an application for a mark which was indistinguishably similar to an opponent's unregistered well-known mark was recognised as a bad-faith filing, owing to this strong similarity, and was totally rejected.

Similarly, in a recent invalidation action before the Istanbul Civil IP Court of First Instance, it was accepted that a trademark registration which was identical to an unregistered well-known trademark was a bad-faith filing. As a consequence, the registered mark was invalidated, despite covering different goods. **WTR**