

Application rejected based on opponent's genuine rights in mark arising from extensive use abroad **Examination/opposition National procedures**
Turkey - Kenaroglu Intellectual Property

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The [Turkish Patent Institute](#) (TPI) has rejected a trademark application filed by a local company based on the opponent's genuine rights in the trademark arising from extensive earlier use of the mark in other countries.

In the opposition proceedings, [HANORAH Italia Srl](#) – the Italian pioneer in the cosmetics industry – requested the refusal of a local application for the trademark HANORAH in Classes 3, 25 and 35 of the [Nice Classification](#). The opposition was based on:

- the opponent's genuine rights in the mark HANORAH, which had been used extensively by the opponent and had become known in foreign markets prior to the filing of the opposed application; and
- the bad faith of the applicant, as it was unlikely that the applicant would have created a trademark identical to that of the opponent and intended to use or register it for identical and similar goods and services without being aware of the opponent and its trademark.

The opponent had not used the trademark locally, had no earlier local application/registration, and did not enjoy any reputation in the Turkish market before the filing date of the contested trademark application. Further, there was no evidence proving the bad faith of the applicant.

In order to successfully base an opposition on genuine rights in the original trademark, the opponent is expected to prove the extensive prior use of the trademark in the Turkish market. In addition, a bad-faith claim against the applicant for the opposed trademark must be supported by concrete evidence. More importantly, the opponent is required to prove the reputation of its trademark with solid evidence in order to claim protection on the basis of the well-known status of its mark under Article 6*bis* of the [Paris Convention](#).

The argument based on the applicant's bad faith was not accepted by the TPI on the ground that there was "no" evidence supporting such argument. Nevertheless, the examiner believed that it was unlikely that the applicant would have created such a unique trademark and intended to use or register it for identical and similar goods and services without being aware of the opponent and its trademark. Therefore, the examiner accepted the opposition based on the genuine rights of the opponent in the trademark HANORAH and the well-known status of that trademark without applying the usual requirements for upholding an opposition based on such arguments.

The TPI's decision in this case is particularly important for Turkish trademark practice, as it reveals that the TPI will relax the requirements with regard to genuine ownership and well-known status when the examiner is convinced of the applicant's bad faith, even though it is not proven by specific evidence.

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