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'Back-up' application filed to circumvent use requirement deemed to have been made in bad faith

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- **The view that the filing of back-up applications constitutes bad faith finds its roots in the Turkish doctrine**
- **Applications filed with the purpose of circumventing the use requirement and reserving unused trademarks shall be rejected**
- **In a recent case, the TPO followed a similar approach and rejected a back-up application on the ground of bad faith**

A trademark application, filed solely for the purpose of replacing a trademark cancelled by the First-Instance Court for non-use, has been rejected by the Turkish Patent and Trademark Office (PTO) on the ground that it had been filed in bad faith - even though the cancellation decision had been appealed to the Higher Court and was not yet final.

Background

The plaintiff, an Italian company that manufactures and sells coffee machines under a trademark registered in certain countries (but not in Turkey), filed a non-use cancellation action against the same trademark, registered by a local company for various goods and services including coffee machines. The plaintiff sought the partial cancellation of the registration insofar as the conflicting goods were concerned.

The First-Instance Court ordered the partial cancellation of the defendant's registration based on non-use and the defendant appealed to the Higher Court. In the meantime, the defendant filed a new application for the same trademark covering the goods which had been removed from the scope of its previous registration due to non-use.

The genuine owner of the trademark - the plaintiff in the cancellation action pending before the Higher Court - also opposed this new application before the PTO, claiming that it should be refused in its entirety on the ground that it had been filed as a back-up (also known as 'iteration' in the doctrine) and, therefore, had been made in bad faith.

TPO decision

The view that the filing of back-up applications constitutes bad faith finds its roots in the Turkish doctrine and in Supreme Court decisions. In accordance with the relevant sources, subsequent applications filed with the purpose of circumventing the use requirement and reserving unused trademarks shall be rejected on the grounds of bad faith and violation of the principle of commercial honesty.

During the examination of the opposition, the TPO followed a similar approach to that adopted by the Turkish practice and decided to refuse the new application in its entirety on the ground of bad faith, even though the non-use cancellation action had not been finalised.

Comment

This decision is significant not only in that it reveals the TPO's attitude towards back-up applications, but also in that it sets a significant precedent against the obstruction of competitors and the reservation of trademarks.

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