

23 Mar
2021

No registration or proof of use, no problem: how the Turkish IP system supports all legitimate rights holders

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Registering a trademark grants its owner a number of advantages, but the Turkish Trademark Law does not leave unregistered rights holders defenceless – even when their marks are not in use in Turkey.

In Turkish practice, trademark rights are established through the creation and use of a mark in the market. Registration has a probative role only when it comes to those marks that were already in use before they were registered. Meanwhile, for trademarks that have not yet been used in the market, rights are established at the moment of registration.

Although the Turkish Industrial Property Code 6769 grants stronger protection to registered trademarks, it also includes unique, effective solutions to assure the protection of unregistered marks against unlawful use and/or registration by third parties.

With such a varied system offering protection to both registered and unregistered trademarks, the Turkish regime is generally considered fair for everyone.

Registered versus unregistered trademarks

The fact that the system attributes more importance to registration can have a significant effect on brand protection. Registrants are entitled to apply for both civil and criminal remedies against infringers, while unregistered trademark owners can seek protection through civil proceedings only. Infringement of a registered trademark constitutes an unlawful act and a crime punishable by up to three years' imprisonment and/or a judicial fine. In addition, the infringer will be prohibited from using the disputed trademark in the market. However, infringement of an unregistered trademark is deemed as merely an unlawful act requiring civil sanctions only.

The fact that the system encourages registration is also evident when it comes to the protection of well-known trademarks. According to the Industrial Property Code, registered trademarks (or trademarks pending registration) that have acquired well-known status in Turkey can be granted broader protection beyond the goods and services covered by the registration. This enables the owner to protect its mark even in relation to different goods or services where the right conditions are met. However, a trademark that is not registered in Turkey but is well known within the meaning of Article 6*bis* of the Paris Convention will enjoy protection only with regard to the goods and/or services for which it is well known.

Another advantage of registration is the five-year grace period afforded to registrants to start using their trademarks in the market. This means that registrants gain exclusive rights in their marks immediately but have five years to bear any burden in connection with them. On the other hand, owners of unregistered trademarks must be able to provide solid evidence of actual and extensive use of their mark in the market in order to claim protection.

Unregistered marks in use in Turkey

According to the Industrial Property Code, using and/or registering a previously unregistered third-party trademark that is already in use in Turkey constitutes infringement, as well as unfair competition under the Turkish Commercial Code.

If the legitimate rights holder can prove that it is the creator of the mark and can demonstrate prior use in Turkey, it can seek refusal of the application for the identical or confusingly similar mark before the Turkish Patent and Trademark Office (TPTO). Alternatively, the legitimate rights holder can claim invalidation of the disputed registration and termination of the unauthorised use of the mark by filing a civil court action before the first-instance Turkish IP courts.

However, legitimate rights holders are often sued for trademark infringement and unfair competition by third parties that have registered their marks in their own name. In order to avoid such risks, genuine rights holders should – from the moment they become aware of an unauthorised registration for their mark – apply to the first-instance civil IP courts to claim invalidation of the registration, termination of the use on the mark and, crucially, obtain a reverse preliminary injunction preventing the registrant from claiming and exercising its rights arising from the disputed registration against the genuine owner. As invalidation proceedings can take two to three years, obtaining a reverse preliminary injunction is vital for the legitimate rights holder to enter or continue using its mark in the Turkish market.

In February 2021 the First Chamber of the Istanbul Civil IP Court granted an extensive preliminary injunction preventing a defendant who had registered an unregistered trademark with prior use in the Turkish market in his name from claiming and/or exercising any rights arising from the unauthorised registration until the invalidation proceedings had been concluded.

Legitimate rights holders that are not lucky enough to file such actions before being sued for infringement by a registrant can file a counteraction, claiming invalidation of the unauthorised registration, termination of the use of the trademark by the plaintiff (the unauthorised registrant) and a reverse preliminary injunction preventing the plaintiff from claiming and exercising any rights arising from the disputed registration.

Obviously, it is better for legitimate rights holders to act first before being sued for infringement for using their own trademark. Even when there is no risk of a counter attack, it is still important to act quickly (and within five years under any circumstances) against the unauthorised registration and use of a mark. Staying silent for an extended period may be perceived as letting the registrant or user invest in the mark and can lead to a loss of rights. Indeed, in 2013 the 11th Circuit Court of Appeals decided that the request by a legitimate rights holder (the creator the disputed trademark, which had demonstrated prior use) for invalidation of the defendant's unauthorised registration should be rejected, as the plaintiff was aware of the defendant's registration but still waited four years to commence court proceedings (Case 15989/22520).

Unregistered marks with no use in Turkey

The Industrial Property Code also protects genuine rights in unregistered trademarks that have not been used in Turkey. However, such exceptional protection is based on a number of strict conditions.

Bad faith

Registering an identical or confusingly similar version of an unregistered trademark – even if it is not in use in Turkey – can be considered a bad-faith action. Therefore, the legitimate rights holder is entitled to oppose the application and request its refusal before the TPTO. The legitimate rights holder can also claim invalidation of the registration and termination of the bad-faith use of the mark by filing a civil court action before the first-instance IP courts.

Generally, the legitimate rights holder must support any claims of bad faith with specific evidence indicating that the applicant was aware of its genuine or prior rights in the sign and therefore acted in clear bad faith. However, when the disputed mark is a truly original word or logo, the legitimate rights holder may not need to provide such evidence, as it would be considered unlikely that the applicant would choose to register or use such a unique sign without being aware of the prior unregistered mark.

In a recent opposition case, the TPTO refused an application for the BOBCAT mark depicted below, even though the genuine owner had not used the mark in the Turkish market, on the grounds that: "It was unlikely for the applicant to choose such a unique logo and register it in his name coincidentally and without being aware of the opponent's trademark."



However, in another recent opposition case, the TPTO concluded that the creator of the TOTTO trademark, which had prior use and a number of registrations in foreign jurisdictions, could not prove that the applicant had acted in bad faith when choosing to apply to register the mark in Turkey, where it had no prior use. Therefore, the TPTO refused the opposition.

Well-known status in other countries

The genuine owner of an unregistered trademark that is not in use in Turkey but is well known in foreign jurisdictions under the meaning of Article 6*bis* of the Paris Convention can oppose an application for an identical or confusingly similar version of the mark and/or claim invalidation of the registration and termination of the use of the mark by filing a civil court action.

In such administrative or legal actions, the genuine rights holder is expected to prove that the trademark has earned a certain level of reputation in at least some member countries of the Paris Convention.

Unfair authorised actions by the local agent

The Industrial Property Code prevents the local representatives of legitimate rights holders (eg, franchisers, distributors, agents and licensors) from registering the relevant trademark or an indistinguishably similar version of it in their names without clear consent from the genuine owner.

Legitimate rights holders are entitled to oppose a local agent's application for an identical or confusingly similar version of their unregistered mark and/or claim invalidation of the registration and termination of the unauthorised use of the mark by filing a civil court action.

The Third Chamber of the Ankara Civil IP Court previously ruled to invalidate the trademark registration for GUAM on the grounds that it was filed by the former distributor of the genuine owner without its consent. In 2016 the 11th Circuit Court of Appeals upheld the decision (Case No 10193/7986).

How to protect unregistered marks against infringement occurring in different forms

Registering and using a third party's unregistered trademark in a different form (eg, a domain name, trade name, router code, keyword or in a similar manner with a commercial impression) is another common problem facing genuine rights holders.

According to the Industrial Property Code, if a legitimate rights holder can prove that it is the creator of the related sign and has been using it in the local market from an earlier date, it can commence civil proceedings to claim cancellation of a later registration and termination of the use of such marks by third parties.

In a recent decision, the First Chamber of the Bakırköy Civil IP Court concluded that the unauthorised use of the KMAX mark in 'www.kmax.com.tr' by the genuine owner's former distributor constituted trademark infringement and unfair competition. Therefore, the domain name registration was cancelled.



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TAGS

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