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Supreme Court softens conditions for bad-faith claims

Turkey - [Kenaroğlu Avukatlık Bürosu](#)

- Under previous practice, it was very difficult to prevail in opposition proceedings based on bad faith
- The Supreme Court has recently held that the copying of a fanciful mark is, in itself, sufficient to demonstrate bad faith, without any further conditions having to be met
- This should encourage right holders to fight against bad-faith applications in Turkey

In a recently issued precedent, the Turkish Supreme Court has recognised that, if a trademark application copies an earlier trademark consisting of a unique and fanciful term, this will be sufficient to uphold a claim of bad faith against the applicant - regardless of whether the earlier mark is in use or has a reputation on the Turkish market.

Bad faith in Turkish trademark practice

The concept of 'bad faith' was introduced by Article 6/9 of the Turkish IP Law, which states that "trademark applications filed in bad faith shall be refused upon opposition". However, the law does not specify the grounds on which bad-faith claims must be based in order for such claims to be upheld, and this has caused numerous discussions, as well as an inconsistent practice.

In general, copying a trademark was not, in itself, deemed sufficient to be an indication of bad faith; this had to be supported by strong arguments and evidence, such as:

- proving the intensive use and reputation of the earlier trademark on the market; and
- demonstrating the unfair intentions of the applicant.

As a result, it was very difficult to prevail in opposition proceedings based on bad faith, especially if the earlier trademark was not extensively used or did not have a strong reputation on the market.

Background of the case

A trademark application for KEPSE AL-ŞHALAN ('*kepse*' being the name of an Arabian food) in Classes 30 and 35 was opposed based on the earlier trademark AL-SHALAN in Class 31. The applicant's alleged bad faith was the opponent's strongest argument.

The bad-faith arguments were rejected by the Turkish Patent and Trademark Office (PTO), as the opponent had failed to prove the active use or reputation of its trademark AL-SHALAN on the Turkish market, and there was no further indication of the applicant's bad faith within the file. The PTO's approach was not surprising in view of the prevailing practice.

Supreme Court decision

The case was appealed to the Supreme Court, which accepted the bad-faith claims. The court emphasised that the opponent's trademark, which consisted of a unique word that was not part of the Turkish language, had been identically copied by the applicant; this could not be a coincidence. The court added that there was no need to assess whether the opponent's trademark was in use or had a reputation on the market, as the copying was clear.

Comment

In contrast to the prevailing practice so far, it was found that the copying of a unique/fanciful trademark was, in itself, sufficient to demonstrate bad faith, without any further conditions having to be met.

The decision is significant not only because it changes the practice, but also because it will encourage right holders to fight against bad-faith copies of their trademarks, even where these are not in active use or do not have a reputation on the Turkish market. Nevertheless, bad faith is still a grey area in Turkish trademark practice, and practitioners are looking forward to more decisions being issued in order to provide clarity.

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