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# ICLG

The International Comparative Legal Guide to:

## Trade Marks 2019

**8th Edition**

A practical cross-border insight into trade mark work

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## General Chapters:

1	<b>Ranging Abroad: a Spotlight on Infringements Online, and Where to Fight Them –</b> Nick Aries & Tristan Sherliker, Bird & Bird LLP	1
2	<b>Use It or Lose It: Truer Than Ever in the U.S.A. –</b> Karen Lim & Jason D. Jones, Fross Zelnick Lehrman & Zissu, P.C.	6

## Country Question and Answer Chapters:

3	<b>Australia</b>	McCullough Robertson: Belinda Breakspear & Peter Stokes	11
4	<b>Austria</b>	Hule Bachmayr-Heyda Nordberg Rechtsanwälte GmbH: Emanuel Boesch	19
5	<b>Barbados</b>	Clarke Gittens Farmer: Rosalind K. Smith Millar QC	30
6	<b>Belgium</b>	Lydian: Annick Mottet Haugaard & Blandine de Lange	37
7	<b>Bolivia</b>	Bolet & Terrero: Juan Ignacio Zapata	47
8	<b>Brazil</b>	Daniel Law: Robert Daniel-Shores & Roberta Arantes	56
9	<b>Canada</b>	Miller Thomson LLP: Catherine M. Dennis Brooks & David Reive	67
10	<b>Cayman Islands</b>	HSM IP Ltd.: Sophie Peat & Huw Moses	76
11	<b>Chile</b>	PORZIO · RIOS · GARCIA: Cristóbal Porzio & Marcelo Correa	84
12	<b>China</b>	East & Concord Partners: Charles (Chao) Feng	93
13	<b>Cyprus</b>	Koushos Korfiotis Papacharalambous LLC: Eleni Papacharalambous & Georgia Charalambous	103
14	<b>Czech Republic</b>	KOREJZOVA LEGAL v.o.s.: Dr. Petra de Brantes & Mgr. Ivana Toningrová	112
15	<b>Finland</b>	Borenus Attorneys Ltd: Åsa Krook & Ben Rapinoja	119
16	<b>France</b>	Gowling WLG: Céline Bey & Clémence Lapôtre	126
17	<b>Germany</b>	Lubberger Lehment: Anja Wulff	138
18	<b>Greece</b>	Law Offices of Patrinos & Kilimiris: Maria Kilimiris & Manolis Metaxakis	146
19	<b>India</b>	Subramaniam & Associates (SNA): Hari Subramaniam & Philip Abraham	154
20	<b>Ireland</b>	LK Shields: Peter Bolger & Jane O'Grady	163
21	<b>Israel</b>	Ehrlich, Neubauer & Melzer (EN&M), of Ehrlich Group: Yehuda Neubauer & Keren Rubinstein	172
22	<b>Italy</b>	FTCC Studio Legale Associato: Filippo Canu & Pierluigi Cottafavi	182
23	<b>Jamaica</b>	DunnCox: Joanne Wood Rattray & Kelly Akin	192
24	<b>Japan</b>	Fukami Patent Office, P.C.: Yoshitake Kihara & Miki Tomii	202
25	<b>Korea</b>	Lee International IP & Law Group: Mi-Cheong Lee & Robert M. Kim	209
26	<b>Malaysia</b>	Shearn Delamore & Co.: Karen Abraham & Janet Toh	216
27	<b>Malta</b>	Camilleri Preziosi Advocates: Steven Decesare & Sharon Xuereb	227
28	<b>Mexico</b>	OLIVARES: Alonso Camargo & Daniel Sanchez	235
29	<b>Netherlands</b>	Le Poole Bekema: Anne Bekema & Laura Broers	245
30	<b>Nigeria</b>	S. P. A. Ajibade & Co.: John Chike Onyido & Oluwasolape Owoyemi	254
31	<b>Norway</b>	Acapo AS: Kjersti Rogne & Kjersti Staven-Garberg	263
32	<b>Philippines</b>	SyCip Salazar Hernandez & Gatmaitan: Vida M. Panganiban-Alindogan	270
33	<b>Poland</b>	Softysiński Kawecki & Szlęzak: Dr. (hab.) Ewa Skrzydło-Tefelska & Karol Gajek	279
34	<b>Portugal</b>	Baptista, Monteverde & Associados, Sociedade de Advogados, SP, RL: Filipe Teixeira Baptista & Joana Cunha Reis	287
35	<b>Russia</b>	Papula-Nevinpat: Annikki Hämäläinen	295
36	<b>Saudi Arabia</b>	Kadasa Intellectual Property: Mohammad Jomoa & Asif Iqbal	302
37	<b>Serbia</b>	Moravčević Vojnović and Partners in cooperation with Schoenherr: Andrea Radonjanin	312

Continued Overleaf ➡

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Country Question and Answer Chapters:

38	<b>Slovenia</b>	Patentna pisarna d.o.o.: Irena Kadunc & Vesna Kovič	319
39	<b>South Africa</b>	Bouwers Inc.: Deon Bouwer & Adele Els	327
40	<b>Spain</b>	ELZABURU: Fernando Iardia & Ana Sanz	334
41	<b>Sweden</b>	Hannes Snellman Attorneys Ltd.: Christopher Tehrani & Nedim Malovic	346
42	<b>Switzerland</b>	Nater Dallafior Rechtsanwälte AG: Dr. Mathis Berger	354
43	<b>Taiwan</b>	TIPLo Attorneys-at-Law: J. K. Lin & H. G. Chen	362
44	<b>Turkey</b>	OFO VENTURA: Özlem Fütman	373
45	<b>Uganda</b>	OSH Advocates, Solicitors & Legal Consultants: Fredrick K. Sentomero & Doreen Mwesige	383
46	<b>Ukraine</b>	Advance Partners: Oleg Zhukhevych & Maksym Kravchenko	389
47	<b>United Arab Emirates</b>	United Trademark & Patent Services: Maria Farrukh Irfan Khan & Sarmad Hasan Manto	400
48	<b>United Kingdom</b>	Bird & Bird LLP: Nick Aries & Daisy Dier James	408
49	<b>USA</b>	Arent Fox LLP: Michael A. Grow & James R. Davis, II	416
50	<b>Vietnam</b>	Pham & Associates: Pham Vu Khanh Toan	424
51	<b>Zimbabwe</b>	Samuriwo Attorneys: Nancy Samuriwo	433

# Turkey



OFO VENTURA

Özlem Fütman

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Turkish Patent and Trade Mark Office (TÜRKPATENT).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The most pertinent legislation is the Industrial Property Code no. 6769 (IP Code), which came into force on 10 January 2017.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

According to article 4 of the IP Code:

*“Trade marks may consist of any signs like words, including personal names, figures, colours, letters, numbers, sounds and the shape of goods or their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings and being represented on the register in a manner to determine the clear and precise subject matter of the protection afforded to its proprietor.”*

### 2.2 What cannot be registered as a trade mark?

Signs which do not fall within the scope of article 4 of the IP Code, and those which do not fulfil the conditions stated in article 5 of the IP Code (please see question 3.1 below), may not be registered as trade marks.

### 2.3 What information is needed to register a trade mark?

The following information is required:

- If the applicant is a natural person: first and last name and contact details. If he/she is a Turkish citizen, the Turkish ID number is also needed.
- If the applicant is a legal entity: company name and contact details. For Turkish companies, the tax number is needed too.

- If the applicant has a representative, which is mandatory for foreign applicants: name of the agent and his/her registration number before TÜRKPATENT and contact details.
- If priority is claimed: information regarding the priority.
- The goods and services to be covered by the application.
- A sample of the trade mark.

### 2.4 What is the general procedure for trade mark registration?

After filing, the application is first assigned to the Classification Department, where they check the list of goods and services. After that step is successfully completed, the application is examined *ex officio* by TÜRKPATENT in terms of absolute grounds. If it passes the examination smoothly then it is published in the Official Trade Mark Bulletin for two months. If no opposition is filed against it during that two-month publication period, TÜRKPATENT requests that the registration fee be paid within two months of such request being notified. Once the registration fee is paid, the certificate is obtained.

### 2.5 How is a trade mark adequately represented?

A trade mark should be presented at a size of 5cm × 5cm or 7cm × 7cm, in JPEG format.

### 2.6 How are goods and services described?

According to article 11/3 of the IP Code, goods and services are described under the Nice Classification. TÜRKPATENT now applies the 11<sup>th</sup> version of the Nice Classification.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Turkey only. Note that Northern Cyprus (Turkish Cyprus) is a separate jurisdiction and a registration before TÜRKPATENT would NOT give coverage for Northern Cyprus.

### 2.8 Who can own a trade mark in your jurisdiction?

According to article 3 of the IP Code, citizens of the Republic of Turkey; natural or legal entities domiciled or engaged in industrial or commercial activities within the borders of the Republic of

Turkey; persons who have the right of application according to the Paris Convention or the Agreement Establishing the World Trade Organization and according to the reciprocity principle; and persons whose citizenship is in a state that provides Turkish citizens the protection of industrial property rights, can own a trade mark in our jurisdiction.

## 2.9 Can a trade mark acquire distinctive character through use?

Article 5/2 of the IP Code (see question 3.1 below) allows a trade mark to acquire distinctive character through use before registration. Article 25/4 states that if a mark was registered although it should not have been, but acquired distinctiveness through use after its registration and before a nullification action is filed, then it cannot be nullified.

## 2.10 How long on average does registration take?

If everything goes smoothly – namely if the applicant faces no issues regarding the list of goods and services, no Office refusal and/or no third-party opposition – then it takes around six months to conclude the registration process; but of course it also depends on the workload of the examiners.

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The official filing fee is approx. EUR 35 per class, and the official fee for obtaining a registration certificate is approx. EUR 92 regardless of the number of classes. If priority is claimed, the official fee for that is around EUR 50. Attorney fees and expenses should be considered separately.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

A trade mark application can be filed directly before TÜRKPATENT (national filing), but also Turkey can be designated before WIPO through international trade mark applications, since Turkey is a Madrid Protocol country.

## 2.13 Is a Power of Attorney needed?

A POA is not required, except for withdrawals and for partial renewals.

## 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No, this is not required.

## 2.15 How is priority claimed?

Priority should be claimed and the official fee thereof should be paid when the application is filed. The priority document, with its Turkish translation (translated by a sworn translator), should be submitted to TÜRKPATENT within three months as of the filing date.

## 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes; according to articles 31 and 32 of the IP Code, Turkey recognises collective and certification marks.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

1. As per article 5 of the IP Code, the following signs shall not be registered as trade mark:
  - (a) Marks which cannot be a trade mark according to article 4.
  - (b) Marks which are devoid of distinctive character.
  - (c) Marks which consist exclusively of, or include as the main element, signs or indications which serve in trade to designate the kind, type, characteristics, quality, quantity, intended purpose, value, geographical origin, time of production of goods or of rendering of the services, or other characteristics of goods or services.
  - (ç) Marks which are identical to or indistinguishably similar to a trade mark which has been registered or which has been applied for registration, relating to identical, or identical types of, goods and services.
  - (d) Marks which consist exclusively of, or include as the main element, signs or indications used by everyone in the trade area or which serve to distinguish members of a particular professional, vocational or commercial group from others.
  - (e) Marks which consist exclusively of the shape or another characteristic which results from the nature of the goods themselves or the shape or other characteristics, which is mandatory in order to obtain a technical result or gives substantial value to the goods.
  - (f) Marks which would deceive the public in terms of the nature, quality, geographical origin, etc. of the goods or services.
  - (g) Marks which would be refused under article 6 of the Paris Convention.
  - (ğ) Marks other than those covered by article 6 of the Paris Convention but which are of public interest, and which contain historical or cultural values, and emblems, badges or escutcheons for which the consent of the competent authority has not been given.
  - (h) Marks which contain religious values or symbols.
  - (i) Marks which are contrary to public policy or to accepted principles of morality.
  - (ı) Marks which consist of a registered geographical sign or which contain a registered geographical sign.
2. If a trade mark has been used before the application, and through this use has acquired distinctive character in respect of the goods and services which are the subject of the application, the registration of this trade mark may not be refused in accordance with subparagraphs (b), (c) and (d) of paragraph 1 above.

### 3.2 What are the ways to overcome an absolute grounds objection?

If a mark is rejected due to a prior mark within the context of clause (ç) of article 5, it can be challenged by revealing the differences

between the marks and the goods/services, if any. If the marks are identical, or indeed indistinguishably similar, the applicant may obtain a letter of consent from the prior mark's owner to overcome the rejection. TÜRKPATENT has a ready-to-fill letter of consent form, and does not accept any other type of form prepared by the parties themselves.

If the application is rejected partially/entirely within the context of clause (b), (c) or (d) of article 5, it can be challenged by claiming that the mark has already acquired distinctiveness through use in Turkey for the goods/services applied for before the filing date. To overcome such a rejection, the applicant needs to submit strong enough or convincing evidence.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Any applicant whose application is partially/entirely refused due to absolute grounds has the right to appeal that decision.

### 3.4 What is the route of appeal?

Appeals must be filed before the Re-examination and Re-evaluation Board of TÜRKPATENT within two months as of the notification date of the refusal decision, along with payment of the official fee. Appeals must be in writing and bases for appeal cannot be changed after the submission. The Board's decision is final. If the applicant wants to challenge the Board's decision, a lawsuit for cancellation of the decision should be filed before the IP Courts in Ankara.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

As per article 6 of the IP Code:

- (1) An application for a trade mark registration shall be refused upon opposition if there exists a likelihood of confusion on the part of the public, including the likelihood of association with the earlier trade mark, due to identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered.
- (2) An application for registration of an identical or indistinguishably similar trade mark filed by a commercial agent or representative in his own name without the trade mark proprietor's consent and without any justifiable ground shall be refused upon the trade mark proprietor's opposition.
- (3) If a right to a non-registered trade mark or to another sign used in the course of trade was acquired prior to the date of application or the date of the priority claimed for the application for registration of a trade mark, the trade mark application shall be refused upon opposition of the proprietor of that prior sign.
- (4) Trade mark applications which are identical or similar to well-known marks within the context of article 6 *bis* of the Paris Convention, shall be refused upon opposition in respect of the identical and similar goods or services.
- (5) A trade mark application which is identical or similar to an earlier registered trade mark or application irrespective of whether the goods or services for which it is applied for or registered are identical with, similar to or not similar to those for which the latter trade mark is applied for, and the use of the latter trade mark without due cause would take unfair advantage of, or be detrimental to the distinctive character or

the repute of the earlier trade mark due to the reputation the earlier trade mark has in Turkey; shall be refused upon opposition of the proprietor of that earlier trade mark.

- (6) An application for registration of a trade mark shall be refused upon the opposition of the right holder if it consists of a person's name, trade name, photograph, copyright or any other intellectual property right of another.
- (7) An application for registration of a trade mark identical or similar to a collective mark or a guarantee mark with identical or similar goods or services, that is filed within three years following the expiration of the protection of the collective mark or guarantee mark due to non-renewal, shall be refused upon opposition of the previous right holder.
- (8) An application for registration of a trade mark identical or similar to a registered trade mark for identical or similar goods or services, that is filed within two years following the expiration of the protection of the registered trade mark due to non-renewal, shall be refused upon opposition of the previous trade mark proprietor, provided that the trade mark has been used during this period.
- (9) Trade mark applications filed in bad faith shall be refused upon opposition.

### 4.2 Are there ways to overcome a relative grounds objection?

If the third-party opposition is based on likelihood of confusion with the opponent's earlier applied/registered mark, the applicant can argue and try to convince the examiner that there would be no likelihood of confusion by pointing out differences between the marks or goods/services or both. Also, on the filing date or priority date of the opposed mark, if the opponent's base marks are past the five-year use term as of their registration date, then the applicant can invite the opponent to prove genuine use of its marks in Turkey for the claimed goods/services (non-use as a defence). If the opponent cannot prove such, his likelihood of confusion claim would be rejected, but other grounds of opposition can still be examined.

The applicant's counter-arguments to the other bases of the opponent need to be detected case-specifically. However, in almost all cases, the evidence submitted by the opponent has vital importance. For instance, if the opponent claims prior use in Turkey and/or reputation in Turkey and/or well-known nature of its mark within the context of the Paris Convention and TRIPS Agreement, but does not have a well-known trade mark registration before TÜRKPATENT, and/or bad faith of the applicant, yet does not submit any or sufficient evidence, regardless of how these claims are explained they may be rejected.

Another option may be for the parties to come to terms. Sometimes, oppositions are withdrawn in return for the deletion of some goods/services from the opposed mark; in that case, TÜRKPATENT issues a decision stating that there is no need to decide on the opposition.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Any party (applicant and/or opponent) who is not satisfied with the decision can appeal it.

### 4.4 What is the route of appeal?

Appeals must be filed before the Re-examination and Re-evaluation Board of TÜRKPATENT by the payment of the official fee within two months as of notification date of the decision. Appeals should

be in writing and the bases cannot be changed after the filing. The Board's decisions are final. If a party wants to challenge the Board's decision, a lawsuit for its cancellation should be filed before the IP Courts in Ankara. If the opponent files the lawsuit, he/she had better claim nullification of the opposed mark as well, in case the registration procedure is finalised when the lawsuit is pending.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

A trade mark application can be opposed based on absolute and relative grounds.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

According to article 18/1 of the IP Code, relevant persons can oppose published applications.

### 5.3 What is the procedure for opposition?

An opposition can be filed within two months as of the publication date of an application. Oppositions should be in written format and all grounds should be stated in detail in the opposition writ at the time of filing. Payment of the official opposition fee and stating the details of the payment in the opposition writ are obligatory.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

A registration number is given to the application; it is stated as registered in TÜRKPATENT's records and a registration certificate is given to the owner. Note that for international registrations through WIPO, TÜRKPATENT does not provide registration certificates.

### 6.2 From which date following application do an applicant's trade mark rights commence?

An applicant's trade mark rights commence on the application date. If priority is claimed, protection starts on the priority date.

### 6.3 What is the term of a trade mark?

The term is 10 years as of the application date.

### 6.4 How is a trade mark renewed?

A trade mark can be renewed every 10 years. The renewal application should be filed, at the earliest, six months before the renewal deadline. Late renewal is possible within six months as of the actual renewal deadline by paying the penalty fee.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes, this is possible in Turkey.

### 7.2 Are there different types of assignment?

Both entire and partial assignments are possible.

### 7.3 Can an individual register the licensing of a trade mark?

Yes, this is possible in Turkey.

### 7.4 Are there different types of licence?

According to article 24 of the IP Code, exclusive and non-exclusive licences are possible.

### 7.5 Can a trade mark licensee sue for infringement?

According to article 158 of the IP Code, exclusive licensees can sue for infringement unless otherwise stated in the agreement. Non-exclusive licensees can also sue for infringement with a notification to the trade mark owner (licensor) unless otherwise stated in the agreement.

### 7.6 Are quality control clauses necessary in a licence?

Article 24 of the IP Code reads as follows: "The licensor shall take measures to guarantee the quality of goods to be produced or services to be offered by the licensee. The licensee is obliged to comply with the terms of the licence contract. Otherwise, the trade mark proprietor may claim his rights arising from registered trade mark against the licensee." So even if quality clauses are not included in the agreement, the licensee still has to fulfil quality requirements.

### 7.7 Can an individual register a security interest under a trade mark?

Yes, this is possible in Turkey.

### 7.8 Are there different types of security interest?

According to article 148/1 of the IP Code, the industrial property right may be transferred, inherited, become the subject of licence, put in pledge, shown as collateral, seized or become the subject of other legal actions.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

According to article 26/1 of the IP Code, upon request, the revocation of the trade mark shall be decided in the following situations:

- a) Where there exist conditions set out in the first paragraph of article 9, which reads: “If, within a period of five years following the date of registration, the trade mark has not been put to genuine use in Turkey by the trade mark proprietor in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the trade mark shall be revoked, unless there are proper reasons for non-use.”
- b) Trade mark becoming generic for the registered goods or services due to trade mark proprietor’s actions or as a consequence of necessary measures not taken by the trade mark proprietor.
- (c) Trade mark misleading the public concerning the nature, quality or geographic origin of the goods or services for which it is registered, as a result of the use by the trade mark proprietor himself or with the trade mark proprietor’s consent.
- (ç) Use of a trade mark contrary to article 32, which reads: “[I]n case of application of relevant persons, public prosecutors or the relevant public institutions on the grounds that the owner does not take necessary measures in order to prevent the continuous use of the collective mark or the guarantee mark contrary to the technical specification, the mark shall be revoked unless the said contrary use is corrected within the prescribed period.”

## 8.2 What is the procedure for revocation of a trade mark?

Once the five-year use period as of the registration date has passed, a cancellation action based on non-use can be filed before the IP Courts. However, from 10 January 2024, TÜRKPATENT will have the authority to handle cancellation actions.

## 8.3 Who can commence revocation proceedings?

Any party who has an interest may commence such proceedings.

## 8.4 What grounds of defence can be raised to a revocation action?

In terms of non-use, the defendant needs to prove its genuine use in Turkey for each and every good/service where the cancellation claim is directed, or should prove that there are proper reasons for non-use.

Some Trial Courts in Turkey are of the opinion that non-use cancellation actions cannot be filed until 10 January 2022; so you may try your luck by raising this argument and claim dismissal of the case as well. (*NB*: the writers of this chapter do not share that opinion of some Judges, but rather think that cancellation actions can be filed. However, so far we have not heard opinions from the Regional Appeal Courts and the National Appeal Court.)

## 8.5 What is the route of appeal from a decision of revocation?

A party who is not happy with the decision can appeal it, within two weeks as of the notification date, before the Regional Appeal Court. Within two weeks of the Regional Appeal Court’s decision being notified, an appeal before the National Appeal Court is possible too.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

According to article 25 of the IP Code, the grounds for invalidity of a trade mark are absolute and relative grounds.

### 9.2 What is the procedure for invalidation of a trade mark?

Invalidation actions can be filed within five years as of the registration date of the mark in dispute before the IP Courts.

### 9.3 Who can commence invalidation proceedings?

Persons who have an interest, public prosecutors or relevant public institutions and organisations may request the Court to decide on invalidity of a trade mark.

### 9.4 What grounds of defence can be raised to an invalidation action?

The defendant can prove that the absolute/relative grounds shown as the basis of the invalidation action are unjustified.

If the plaintiff’s invalidation claim is based on his earlier registered marks, and if the five-year use term for those marks is passed as of their registration date on the day where the invalidity action is initiated, the defendant can invite the plaintiff to prove genuine use of its base marks in Turkey for the goods/services where invalidity is claimed. If the plaintiff’s mark has been registered for at least five years on the application date or on the date the priority right of trade mark for which invalidation is requested, the plaintiff shall also prove genuine use in Turkey on the aforesaid date of application or date of priority right. If the plaintiff cannot prove it, its claim of likelihood of confusion would be rejected, but other grounds for invalidity can be examined.

Meanwhile, if a trade mark has been registered contrary to subparagraphs (b), (c) and (d) of the first paragraph of article 5 but it has acquired distinctive character as a result of use with regard to the registered goods or services before the invalidation request against the trade mark, such trade mark shall not be invalidated.

Moreover, article 25/6 reads as follows: “Where a trade mark proprietor has acquiesced in the use of a later trade mark for a period of five successive years while he was aware or should have been aware of this situation, trade mark proprietor may not allege his trade mark as an invalidation ground unless the registration of the later trade mark is in bad faith.”

### 9.5 What is the route of appeal from a decision of invalidity?

See question 8.5 above.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

According to article 156 of the IP Code, the courts commissioned

for legal proceedings foreseen in this Code shall be IP civil courts and IP criminal courts.

In legal proceedings to be instituted against third parties by the owner of an industrial property right, the competent court shall be the court where the plaintiff is domiciled or where the action violating the law has taken place or where the impacts of this action are observed.

In the case that the plaintiff is not domiciled in Turkey, the competent court shall be the court where, at the instituting date of the legal proceeding, the business place of the attorney registered in registry is located; and if the record of the attorney has been deleted, the competent court is the court where the headquarters of TÜRKPATENT are located.

In legal proceedings to be instituted against the owner of industrial property right by third parties, the competent court is the court where the defendant is domiciled. In the case that the owner of the industrial property right application or the industrial property right is not domiciled in Turkey, the provisions of the above-mentioned paragraph shall be applied.

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### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

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A written procedure is applied in IP litigation. The burden of proof is on the plaintiffs, except in non-use cancellation actions, where the burden switches to defendant. Each party has the right to submit two petitions. After the parties submit their petitions, or in any case after the two-week response deadline has passed, the Court determines a preliminary hearing date. The preliminary hearing is held only once, but if there is a serious necessity, then only one more preliminary hearing may be held.

At the preliminary hearing, the Court examines the causes of action and preliminary objections, detects the matter in dispute and invites the parties to settle the matter amicably. If at least one of the parties says there cannot be an amicable settlement, the Judge gives two weeks to the parties to submit their evidence that has been indicated before but not submitted yet. If the parties say there is a possibility to settle the matter, the Judge gives them time to negotiate and postpone the process.

During the trial stage, in accordance with the claims and evidence of the parties, if needed an expert examination can be conducted and, if applicable, witness statements can be heard. Then the Trial Court grants a decision. In terms of expert examination, the file can be sent to a maximum of three different expert bodies.

Once the Trial Court grants a decision and the parties are notified of the reasoned decision, the parties have the right to appeal before the Regional Appeal Court within two weeks of notification of the Trial Court's decision. The Regional Appeal Court's decision can be appealed before the National Appeal Court. If none of the parties appeals the Trial Court decision, the decision becomes final.

The trial stage takes approximately one to two years, but may also take longer depending on the workload of the Court, the number of expert examinations, and the level of complication of the dispute. The Regional Appeal Court stage takes around a year, and the National Appeal Court stage may take one to two years, depending on the workload of the Appeal Court.

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### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

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It is possible to request an interim injunction from the Courts with a separate action before filing the main lawsuit, or it may be requested with the main lawsuit. In either case, the Court can do the following:

- a) decide to hear the adversary party and set a hearing date, and then decide whether to grant an injunction or not;
- b) send the file to an expert before making a decision about the injunction request;
- c) grant the injunction immediately; or
- d) refuse the injunction immediately.

The purpose of an interim injunction is to protect the effectiveness of the final decision, therefore its basis can be different in each case, as long as it is compatible with articles 389–399 of the Code of Civil Procedure and article 159 of the IP Code.

The injunction decision granted by the Trial Court can be objected to. The Trial Court's decision, upon objection, can be appealed before the Regional Appeal Court and this Appeal Court's decision is definitive.

If an interim injunction request is refused, that decision can be appealed before the Regional Appeal Court as well, whose decision is definitive.

We have no final injunctions system.

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### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

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Upon the request of a party for disclosure of the relevant documents, if the Court determines that the request is legal and that the document is in the adversary party's possession, the Court would give a deadline to the adversary party to submit the relevant documents. If such documents are not submitted until the given deadline, the Court might grant its decision based on the statement of the party that requested the documents.

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### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

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In principle, in both criminal and civil actions, the evidence needs to be in writing; but if there is a possibility to prove any claim with witnesses, then the Court hears the witnesses' statements. In this case, the statements would be given orally, during a hearing. In both criminal and civil actions, parties can ask their questions to the witnesses directly where cross-examination is possible.

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### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

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Only Civil IP Courts have authority to invalidate trade marks. In an infringement proceeding, the Court handling the file may decide to stay the proceeding to await the outcome of the invalidation action or not.

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### 10.7 After what period is a claim for trade mark infringement time-barred?

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Trade mark infringement is defined as a wrongful act. According to article 72 of the Code of Obligations, civil actions against wrongful acts must be filed within a two-year time period as of the day that the doer and the wrongful act is learnt of. In any case, such civil action must be filed within 10 years as of the date the wrongful act occurred.

If an action is also defined as a crime, the time limitation applicable for the crime would be applied, which would be eight years for trade mark infringement.

However, if infringement is ongoing, the time limitation would not start.

For criminal actions, a complaint must be submitted to the District Attorney within six months as of the day the identity of the infringer and the infringement act is learnt of.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, please see question 12.1 below.

### 10.9 If so, who can pursue a criminal prosecution?

The registered owner of a mark can file a complaint before the District Attorney. For licensees, please see question 7.5 above.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

If trade mark infringement has not occurred, unfair competition may be claimed, depending on the facts of the case.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The main defences are as follows:

- Exhaustion of trade mark rights.
- Hold/use of the goods for the purposes of personal needs.
- Parallel import.
- Failure of trade mark owner to seize the infringing products where compensation for those products has already been paid by the infringer to the trade mark owner.
- Rightful ownership of the mark.
- Fair use of the mark.
- Non-existence of likelihood of confusion.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

Validity of the trade mark can be argued with:

- a counter-claim or separate lawsuit;
- inviting the plaintiff to prove genuine use of its base mark in Turkey for the last five years, if the five-year use term as of registration of the plaintiff's mark has passed;
- lack of legal interest;
- lack of jurisdiction; or
- statute of limitation.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

For civil actions, the following can be claimed:

- a) To determine infringement and to stop the infringing actions.

- b) To prevent possible infringements and to take the necessary measures.
- c) To remedy infringement and compensate material, immaterial and reputational damages.
- d) To seize and/or to grant property rights on the infringing products and machines/tools, etc. used in their production.
- e) To announce the final Court decision in newspapers where the expenses fall to the infringer.

For criminal actions, article 30 of the IP Code reads as follows:

- (1) A person who produces or provides services, puts on the market or sells, imports or exports, buys for commercial purposes, possesses, transports or stores goods, while infringing a trade mark right through quotation or likelihood of confusion, shall be sentenced to one to three years of imprisonment and punished with a judicial fine of up to 20,000 days.
- (2) A person who removes the sign indicating the trade mark protection from a product or packaging without authorisation shall be sentenced to one to three years of imprisonment or punished with a judicial fine of up to 5,000 days.
- (3) A person who makes, without authorisation, a disposition of a trade mark right which is owned by someone else, by transferring, licensing or pledging, shall be sentenced to two to four years of imprisonment and shall be punished with a judicial fine of up to 5,000 days.
- (4) If the crimes indicated in the provisions of this article are committed by acts of a legal entity, additional specific security measures shall be taken.
- (5) To give a sentence due to the crimes indicated in this article, it is mandatory that the trade mark is registered in Turkey.
- (7) If a person selling or putting on the market a counterfeit product submits information about where he acquired those goods and, thus, contributes to the detection of the producers and the seizure of the products, he shall not be sentenced.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

The party who lost a lawsuit in a civil proceeding has to pay an attorney's fee to the other party, which is granted by the Judge based on the related Bar's official Minimum Attorneyship Fee Tariff. The Court orders only the payment of official expenses that are paid by the prevailing party. Courts do not give any decision regarding unofficial attorney's fees and expenses. In criminal proceedings, the Court grants an attorney's fee for the complainant's lawyer to be paid by the accused person; this attorney's fee is also based on the related Bar's official Minimum Attorneyship Fee Tariff. No expenses are granted to the complainant in criminal proceedings.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

A Trial Court's decision can be appealed before the Regional Appeal Court, within two weeks of its notification. The Regional Appeal Court examines a Trial decision both on procedural grounds and in terms of the merits. If, after the regional Appeal Court, the file goes to the National Appeal Court, the National Appeal Court examines the decision only on procedural grounds.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

Generally it is not allowed to submit new evidence at the appeal stage; this is only permitted if the new evidence could not be submitted due to *force majeure*.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Yes, there is. The system essentially works as follows:

1. A form is filed into the customs' general online system and copies of the registration (and renewal) certificates are filed along with the form. If the brand owner is a foreign person/entity, an apostilled POA and its notarised Turkish translation have to be submitted too.
2. After step 1 above, all the customs officers in Turkey start monitoring any knock-offs passing through customs for one year. The monitoring request can be renewed yearly.
3. If a customs officer notices any knock-offs, he/she informs the brand owner's legal representative and stops the goods there. The customs authorities give 10 days to the brand owner to bring a seizure decision either from a District Attorney or from a Civil Court. Upon request, customs may provide an additional 10 days to the brand owner to bring the seizure decision.

Before Civil Court, a seizure can be claimed (in this option, within 10 days a lawsuit should be filed, otherwise seizure lapses) or a lawsuit for infringement (and unfair competition) can be filed and seizure claimed.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

According to article 6/3 of the IP Code, if a right to a non-registered trade mark or to another sign used in the course of trade was acquired prior to the date of an application or the date of the priority claimed for the application for registration of a trade mark, the trade mark application shall be refused upon opposition of the proprietor of that prior sign.

### 15.2 To what extent does a company name offer protection from use by a third party?

According to article 6/6 of the IP Code, an application for registration of a trade mark shall be refused upon the opposition of the right holder if it consists of a person's name, trade name, photograph, copyright or any other intellectual property right of another.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Book titles and film titles might be protected under copyright, if the necessary requirements are fulfilled.

## 16 Domain Names

### 16.1 Who can own a domain name?

“.com.tr” domain names can be owned by natural persons, legal entities and organisations who have commercial activities. “.namesurname.com.tr” sub-domain names can be owned by real persons upon the submission of the identification number. The other sub-domain names can only be owned by natural persons, legal entities and organisations who are active in specific fields. For instance, only lawyers, law firms and lawyer partnerships can own a “.av.tr” domain name.

### 16.2 How is a domain name registered?

“.tr” extension domain names can only be registered before Nic.tr via <https://nic.tr/>. The requirements of a domain name application vary depending on the chosen sub-domain name, but for “.com.tr” domain names, the trade mark application form or trade mark registration certificate obtained from TÜRKPATENT, or the trade registry certificate obtained from the Chamber of Commerce or Chamber of Merchants and Craftsmen, would be needed.

### 16.3 What protection does a domain name afford per se?

The principle in domain name registration is “first come, first served”. Therefore, if a domain name is registered in the name of someone, no one can obtain the same domain name. In addition, the owner of a domain name may prevent third parties from registering or using a trade mark which includes this domain name.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

By the new article which was added to the Turkish Commercial Code and came into force on 1 January 2019, a mandatory mediation process was introduced into Turkish law for commercial disputes, including IP disputes, where monetary debt and compensation are claimed. The mediator must conclude the mediation process within six weeks of her/his appointment date; this period can be extended by two weeks at the most. If the parties cannot settle the matter in mediation, a lawsuit before the Court can be initiated.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

1. Article 14 of Trade Mark Decree Law No. 556 (the former Code) enabled the revocation of a registration due to non-use. However, the Constitutional Court cancelled this article retroactively on the ground that property rights cannot be limited by Decree Laws. This decision was given on 14 February 2016 with docket no. 2016/148E-2016/189K and came into force on 6 January 2017. Under the IP Code no. 6769 (the current Code) which entered into force on 10 January 2017, revocation of a registration due to non-use became possible again. However, that four-day gap in between the effective dates of the Constitutional Court decision and the IP Code caused the the IP Courts to begin to give different

decisions about non-use cancellation actions. Some Courts are handling cancellation actions based on non-use where the lawsuit is filed after the IP Code came into force.

However, for instance, in a non-use cancellation action initiated on 30 January 2017 for a mark which was applied for in 2005 and registered in 2007, the First Instance Court dismissed the case. The Court said that the Constitutional Court decision is retroactive, therefore there is no use requirement before the effective date of the IP Code and the five-year use term has not expired as of the effective date of the IP Code. Currently the case is before the Regional Appeal Court and the final decision is the subject of some curiosity. After this decision, a couple of other Trial Courts in different jurisdictions granted decisions in the same way and they are also under appeal.

2. Before the IP Code came into force, technically, use of a registered mark constituted neither trade mark infringement nor unfair competition, as long as the mark was used for the goods/services for which it was registered. However, now, according to article 155 of the IP Code, in infringement cases the defendant cannot base its defence on its registration if the defendant's mark is registered after the plaintiff's mark. However, the Trial Courts in particular hesitate to apply this article and say the defendant's uses are legitimate because it has a registration.

In a lawsuit, the plaintiff claimed invalidation of the defendant's mark which was registered after the plaintiff's mark, trade mark infringement and unfair competition, and also requested an injunction. The Trial Court dismissed the injunction request by saying that defendant's uses were based on a registered mark. The plaintiff appealed before the Regional Appeal Court. With a decision dated 13 March 2018, the Regional Appeal Court overruled the Trial Court's decision by referring to article 155, which states that in an infringement action defence of valid registration cannot be set forth by the defendant.

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### 17.3 Are there any significant developments expected in the next year?

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We expect that the National Appeal Court will issue some decisions to bring a solution to the chaos regarding non-use cancellation actions filed according to the IP Code.

TÜRKPATENT has been working on a set of guidelines for long time. These guidelines will include explanations and specific examples on how each article of the IP Code is/would be applied in practice. It is expected that these guidelines will be published within 2019. We anticipate that this comprehensive guide will be leading in its field, especially for the resolution of issues on which the guidance is currently vague.

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### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

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Since the IP Code entered into force on 10 January 2017, TÜRKPATENT invites the parties to avail themselves of an optional mediation process in opposition cases where the examiners consider reconciliation to be possible.

In addition, as per the Turkish Commercial Code and as of 1 January 2019, a mandatory mediation process is applied in commercial cases, including IP matters, where monetary debt and compensation are requested.

Therefore, it is beyond question that mediation will be the trending topic in our jurisdiction for a while.

Meanwhile, the protection of personal data has been a very hot topic in Turkey, as the GDPR has been in Europe.

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Özlem Fütman is an IP litigator, Turkish trade mark and patent attorney and European patent attorney who has more than 20 years' experience practising IP law in Turkey. After being an in-house counsel (where she handled the IP portfolio of one of the biggest companies in Turkey) and then working in a reputable IP firm, she founded OFO VENTURA in 2002.

Özlem has broad experience in effectively managing IP portfolios for some of the most recognisable national and international companies operating in Turkey. She applies her considerable experience, tenacity and creativity to the handling of more complex matters such as oppositions, dilution claims, domain name issues, copyright, data protection; negotiating complex licences, customs seizures and anti-counterfeiting matters, as well as non-use and nullification issues. Her clients span all industries, including fashion, food, entertainment, publishing, online games and certification companies. She has also handled IP matters for celebrities, designers, and art institutions.

As a leading expert in geographical indications (GIs), Özlem is a member of MARQUES' GI committee and has spoken and written on the topic extensively. She is an active member of both the Regulatory Committee of the International Association for the Protection of Intellectual Property (AIPPI) Turkey, and of the European Communities Trade Mark Association's (ECTA) Copyright Committee.

She has participated in many other committees and organisations over the last 20 years and is a member of ECTA, the Pharmaceutical Trade Marks Group (PTMG), the German Association for the Protection of Intellectual Property (GRUR), the International Trademark Association (INTA), AIPPI, MARQUES, and the Turkish Patent and Trademark Agents Association.

## OFO·VENTURA

Founded in 2002 to provide clients with a personalised, full-service approach to protecting their intellectual property, our firm's Istanbul office has 10 professionals, including agents and lawyers. The firm handles many large trade mark portfolios for multinational and international clients, particularly in highly regulated areas such as cosmetics, food and beverages and pharma, as well as in the fashion, luxury, sporting goods, stationery and online gaming industries. In addition to handling large trade mark portfolios, the team excels at more complex and contentious IP matters and combines its broad experience and skill sets with the creativity and tenacity required in this tricky market.

OFO VENTURA's opposition practice benefits from the firm's experience and expertise in contentious matters, enabling it to broker settlements through thoughtful negotiations. When necessary, litigators with the firm's litigation arm Fütman Law Firm advocate strongly on behalf of clients at every level, and have been involved in many important court cases in Turkey. The firm handles patent prosecution matters and design prosecution and enforcement. When required, it also provides experienced advice in issues relating to copyright, geographical indications, internet law, sports law, entertainment law and data protection – which makes it a truly full-service IP boutique.

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