

TRADEMARK PROTECTION

Introduction

A trademark is a word, phrase, symbol, or design that individualizes the goods and services of an enterprise and distinguishes them from those of others. It does not only give its owner the exclusive right to use it, but also enables the owner to inhibit others from using a similar mark that may be confusing for the general public.

The broad application and the minimum criteria for the protection of trademarks is set out in the Paris Convention for the Industrial Property Rights (“Convention”) to which Türkiye is a contracting party along with 176 other countries. The legal rules in Turkish jurisdiction relating to trademarks are embodied in the Code of Industrial Property (“CIP”).

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Registration and Protection of Trademarks

The legal protection of trademarks provided by CIP begins with the registration application; accordingly, unregistered signs do not benefit from trademark protection under Turkish law.

However, it should also be noted that an exception is provided in CIP and in the Convention for “well-known trademarks”, allowing their owners to object to registration applications for marks correlated to identical or similar goods.

Nonetheless, such an objection must be supported with a lot of documentary evidence proving the well-known status of the relevant mark. For this reason, it is crucial to register trademarks for business owners for the purpose of securing their maximum profit regarding the marks they use in the practice.

Trademarks can consist of any symbols such as words, shapes, sounds, colours or letters. In order to be registered as a trademark, a sign must:

- a) have a distinctive character which makes it possible to distinguish the goods and services it represents from others, and
- b) represent the subject matter of the trademark in a clear and precise manner.

The Registration Process

Registration applications for trademarks are made to the Turkish Patent and Trademark Office ("TPTO"). At first, applications go through a formal examination, data capture, classification and search procedures. If all necessary documents are not provided in the registration application, an additional period of 2 months is given to the applicant to provide the missing documents.

The documents required for a trademark application are stated below:

- a) Application form,
- b) Sample of trademark,
- c) List of goods and services being subject of the application,
- d) Proof of the payment of the application fee,
- e) Technical specification (if the application is made for a collective or guarantee trademark),
- f) Proof of the payment of request fee for pre-emptive right (if any),
- g) If letters other than the roman alphabet are used in the sample of trademark, the correspondent letters of those in the roman alphabet.

If there is no absolute ground for refusal detected in the application, TPTO accepts the registration request once the formal procedures are done. Accepted applications are declared in the Trademark Bulletin of the TPTO to let third parties submit their objections, if any, to the registration within 2 months commencing from the date of the declaration of the registration of the trademark.

Once successfully registered, the term of protection for trademarks is 10 years from the date of the submission of the application and is renewable every 10 years. Registered

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trademarks are also published in the Trademark Bulletin of TPTO.

Grounds for Refusal of Registration

Where there is an absolute ground for refusal, TPTO *ex officio* refuses trademark applications. Third parties can object to a trademark application on both absolute grounds and relative grounds for refusal.

Notable absolute grounds for refusal of trademark applications are as follows:

- a) It does not have a distinctive character, which is likely to cause confusion among other similar products,
- b) It is very similar to or indistinguishable from an earlier trademark representing the same class of products or services,
- c) It contains a sign or signs which are commonly used in commerce or specifically by groups representing an occupation, a field of art or trade,
- d) It contains religious symbols, or it contradicts public order or public morality, and
- e) It contains a geographical indication.

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Notable relative grounds for refusal of trademark applications are as follows:

- a) It is likely to cause confusion due to its similarity to another registered trademark of similar goods or services,
- b) It is an unauthorized application of a similar trademark, made by the agent or representative of the trademark owner in their own name,
- c) It is similar to an unregistered, yet well-known trademark under the Convention,
- d) The content of the trademark infringes copyrights or industrial property rights of a third party, and
- e) The application is filed in bad faith.

Pre-Emptive Right

In principle, the trademark rights of the first applicant for a registration are protected in terms of CIP. However, trademark

applicants in one of the contracting States to the Paris Convention or to the Agreement Establishing the World Trade Organization have a right of priority in Türkiye for trademark applications. This means that within six months commencing from the date of the submission of an application in one of the member States, the registration request of the same trademark in Türkiye cannot be refused on the grounds that a similar trademark application has been made in Türkiye in that period. If an application for the registration of the relevant trademark is not made within the abovementioned period of time, then the pre-emptive right cannot be benefited from anymore.

The applicant must obtain an official document regarding the pre-emptive right from the competent authority in the country where he made the first application in order to avail himself of the pre-emptive right in Türkiye.

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International Trademark Registration

In principle, trademarks are protected only in the country in which they are registered. In this sense, if a trademark owner wants to obtain trademark protection in multiple jurisdictions, he has to register his trademark in multiple countries.

The International Trademark System (“Madrid System”) allows trademark applicants to do this in a much more convenient and cost-effective manner. By submitting a single application and paying one set of fees, applicants may have their trademarks registered in up to 129 countries.

In order to use the Madrid System, trademark owners must either be a citizen, be domiciled or have an industrial or commercial establishment in one of the member countries of the Madrid Protocol.

Trademark Infringements

Actions which are considered to be infringing trademark rights are stipulated in CIP. Notable examples of trademark infringements are as follows:

- a) Imitating a trademark by using a sign indiscernible from the said trademark without the authorization of the trademark owner,
- b) Selling, distributing or releasing in the market products or services by using the similarity of a sign, on the products and services, to a registered trademark,
- c) Expanding the rights granted by the trademark owner through licensing and/or transferring these rights to third parties, and
- d) Using a sign similar to a registered trademark for different goods or services not represented by the trademark to the detriment of the distinctive character of the said trademark.

Although the formulation of CIP is fairly simple, trademark infringement can appear in a variety of ways in different mediums that are not specifically regulated in law. Unlawful use of domain names in deceptive manners and imitating other enterprises' trademarks, or the use of trademarks in meta-tags to attract customers to one's website has also become prevalent trademark infringement examples. Online infringements can be especially troublesome as they are more difficult to detect.

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Sanctions and Remedies

The remedies for trademark infringements are stipulated in CIP. The authority of hearing trademark cases is with the Specialised Courts of Intellectual Property Rights. Trademark owners can seek before these courses the rulings stated below:

- a) prevention of infringing acts, including the use of signs on products and services causing the infringement, release of products and services carrying these signs, use of signs for advertising purposes or as a trade name,
- b) compensation for damages (if the infringer is at fault),
- c) confiscation or the transfer of the ownership of products or the equipment used for the infringing act to the trademark owner, and
- d) publication and declaration to those concerned of the court decision given against the infringer, with the publication and declaration expenses being covered by the infringer himself.

An interlocutory injunction can also be given by the court, in case the situation calls for urgency and there is a risk of irreversible loss of rights. The claimant has to bring enough evidence to the court to support his claim that the conditions for an injunction are fulfilled. Requests for interlocutory injunctions are examined separately by the court, before the main hearing of the case.

Apart from the remedies, criminal sanctions are also stipulated in CIP. These include:

- a) 1-3 years of imprisonment and judicial fine for producing, storing, selling, importing or exporting products infringing trademark rights,
- b) 1-3 years of imprisonment and judicial fine for removing a trademark sign from a package without authority, and
- c) 2-4 years of imprisonment and judicial fine for transferring or pledging trademark rights without authority through licencing.

Other measures may be applied to legal persons being responsible for trademark infringements.

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Termination of Trademark Right

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In Turkish law, trademark rights can terminate mainly in four different ways; namely nullity, annulment, renouncement, and expiry.

Those having an interest, public prosecutors, or state institutions and organizations concerned can bring a lawsuit against the trademark owners, claiming nullity of the relevant trademark, where absolute or relative grounds for refusal exist. When a court rules for the nullity, the protection of the nullified trademark is deemed to have never come into existence.

The annulment of trademarks comes into question in three different situations. If the trademark has not been used in Türkiye for 5 years commencing from the date of registration; or it turns into a conventional name for the goods or services it was registered for; or it deludes the public regarding the features, quality or the geographical source of the goods or services it was registered for, then the court rules for the annulment of the relevant trademark.

When a trademark owner renounces his right on the trademark he has registered, the trademark right terminates. However, it should be noted that unless all persons officially have a right to or owning a license regarding the relevant trademark permit for such a renouncement, the trademark owner cannot apply this method to terminate the trademark.

Lastly, if the trademark is not renewed within the time stipulated in CIP, upon the expiry of the protection term, the trademark right terminates.

