

# Turkey

---

Contributing firm

**Akinci Law Office**

Authors

**Mert Yalcin**

Partner

**Serkan Onukar**

Associate

## 1. Legal framework

---

### National

Turkish trademark law is regulated by Decree-Law 556 on the Protection of Trademarks, which was published on June 27 1995, and the implementing regulations.

The decree protects registered trademarks only. Protection for unregistered marks may be available under the Commercial Code, the Obligation Code or the Criminal Code.

### International

The following international treaties have been integrated into the Turkish legal framework:

- the Paris Convention for the Protection of Industrial Property;
- the Madrid Protocol for the International Registration of Marks;
- the Nice Agreement on the International Classification of Goods and Services for the Registration of Marks;
- the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks;
- the Trademark Law Treaty (although this has not yet been ratified); and
- the World Intellectual Property Organization Convention.

## 2. Unregistered marks

---

### Protection

Unregistered trademarks can be protected through civil actions and unfair competition proceedings.

Unregistered marks may benefit from protection under another head of intellectual property. Marks may be protected as a registered job title or trade name under the relevant provisions of the Commercial Code. In the same way, unregistered

marks that qualify as industrial designs may be protectable under the Decree-Law on the Protection of Industrial Designs, and marks that represent creative works may be protected under the Copyright Law. Furthermore, a mark formed partially or completely of a person's name or image may be protected under provisions relating to the protection of personal rights.

### Use requirements

There are no specific use requirements in relation to unregistered marks in any provisions of Turkish law, except that the unregistered mark must have been created and/or used for the first time by the party demanding protection.

## 3. Registered marks

---

### Ownership

According to Decree-Law 556 a trademark can be owned by:

- any natural person or corporate body residing in Turkey or having industrial or commercial activities in Turkey;
- any person who has the right to bring an application under the Paris Convention; or
- any natural person or corporate body based in a foreign country which has an agreement of reciprocity with Turkey in relation to the protection of trademarks.

Only a natural person or corporate body may apply for registration of a mark at the Turkish Patent Institute. Foreign parties must be represented by a patent attorney.

### Scope of protection

According to the decree-law, a sign must conform to the definition of a 'trademark' in order to be registered and protected. The sign must be capable of distinguishing the owner's goods or services from those of other undertakings and may include the following:

- a person's name;
- a word or words;
- figures;
- numbers;
- letters; and
- three-dimensional shapes.

Colours, sounds and smells may be registered and protected under the decree-law, as long as they are distinctive.

Article 7 of the decree-law sets out the types of sign that cannot be registered as a trademark.

These include:

- signs that do not conform to Article 5 – that is, signs that do not have the capacity to distinguish or that do not conform to the definition of a 'trademark';
- signs that are identical or confusingly similar to a mark with an earlier filing date or date of registration in respect of identical or similar products or services;
- signs that consist exclusively of signs or indications which serve in trade to indicate the kind, characteristics, quality, intended purpose, value or geographical origin of the relevant goods or services, or serve to designate the time of production of the goods or rendering of the services;
- marks that consist exclusively of signs and names used to distinguish specific groups of craftsmen, professionals or tradesmen, or that have become customary in the current and established practices of the trade;
- signs pertaining to the shape of the product which results from the nature of the goods, which is necessary to obtain a technical result or which gives substantial value to the goods;
- signs that are of such a nature as to deceive the public regarding the nature, quality, place of production or geographical origin of the goods or services;
- signs that have not been authorized by the competent authorities and are to be refused pursuant to Article 6ter of the Paris Convention;
- signs containing badges, emblems or escutcheons other than those covered by Article 6ter of the Paris Convention which have not been authorized by the competent authorities and are of particular historical and cultural public interest;
- well-known marks according to Article 6bis of the Paris Convention, where the use has not been authorized;
- marks that contain religious symbols; and
- marks which are contrary to public policy and to accepted principles of morality.

Signs that fall within the second to fourth bullet points above may still be registered if they have acquired distinctive character through use in respect of the goods and services for which they are to be registered.

A registered trademark shall be declared invalid by the competent court in the following cases:

- where it is in breach of Article 7 of the decree-law. However, any action based on an earlier well-known trademark must be started within five years of the date of registration, unless the later mark was registered in bad faith, in which case there is no time limit;
- where the mark is invalid on relative grounds;
- where the mark has not been used for an uninterrupted period of five years, unless the mark owner has a justifiable reason for not using the mark. However, the court shall not take into consideration use that commences during the three months prior to the institution of proceedings;
- where the trademark has become generic in respect of the goods or services covered by the registration through acts or omissions of the trademark owner;
- where, as a result of the use made by the proprietor or by a person authorized by him, there exists a likelihood of confusion on the part of the public as to the nature, quality, place of production or geographical

origin of the goods or services covered by the registration; or

- where the owner of a collective or guarantee mark does not take action against a use of the mark which constitutes a violation of the technical regulation governing the mark.

If the mark is invalid for only some of the products or services, the mark shall be held invalid for just those products or services.

#### 4. Procedures

---

##### Examination

As established in Article 23 of the decree-law, an application to register a trademark must be filed before the Turkish Patent Institute. An application for registration of a mark must be filed together with the following:

- a petition, the form and contents of which are specified in the implementing regulations, including information identifying the applicant;
- a representation of the trademark suitable for reproduction;
- a list of the products or services for which the trademark shall be used;
- the original receipt documenting payment of the application fees;
- the original receipt documenting payment of the class fees;
- a power of attorney, if an agent is appointed;
- a signature circular, where the applicant is a legal person; and
- documents evidencing the applicant's business activity.

The application fee must be paid at the time of filing in order for an application for the registration of a trademark to be valid. The processing fee, as of January 1 2006, for an application for registration in a single class of the Nice Classification is TL140 (approximately €91).

Registration in two classes costs TL204 (approximately €132), while the fee for three classes is TL304 (approximately €196). A fee of TL199 (approximately €128) applies to each additional class thereafter.

An accelerated examination procedure is available at a cost of TL3,171 (approximately €2,046).

Separate applications must be filed for each trademark.

The Trademarks Department of the Turkish Patent Institute examines applications for both absolute and relative grounds for refusal. If no ground for refusal is found in the first examination, the application will be published in the monthly *Official Trademark Bulletin* pursuant to Article 33 of the decree-law.

If the application is refused totally or partially following the first examination, the applicant may lodge an appeal with the institute within two months. The institute will then re-examine the application. If the appeal is successful, the application will be published in full or in part in the *Official Trademark Bulletin*.

The Trademarks Department has a separate division for the examination of oppositions and appeals. Parties who are not satisfied with the decisions of this division can also appeal to the institute's Re-examination and Evaluation Board – the highest administrative body of the institute. The board's decisions can be appealed to the courts within two months.

Correction of any errors that do not cause any changes in the goods and services and the scope of the application (eg, spelling errors) shall be allowed during the application examination stage upon the request of the applicant. An applicant may also withdraw an application prior to registration pursuant to Articles 37 and 38 of the decree-law.

### Opposition

According to Article 35 of the decree-law, any interested third party may file an opposition within three months of the publication date of the *Official Trademark Bulletin* in which the disputed mark features. Oppositions must be submitted in writing and contain arguments. The institute may request further facts, evidence and documents to be supplied within a prescribed period. If it does not receive the requested documents within the time limit, the institute will disregard the opposition.

The institute may invite the parties to come to a settlement.

If the opposition is found to be valid for some of the goods or services covered by the trademark application, the opposition shall be accepted in respect of those goods or services.

If no oppositions are filed within the relevant time limit, or if the filed oppositions are rejected by the institute, the application will be registered in the Trademarks Register and published in the *Official Trademark Bulletin*.

Under Article 34, any natural or legal person or any group representing manufacturers, producers, suppliers of services, traders or consumers may submit to the institute their written observations that the trademark does not conform to the registration requirements set out in Article 7, following the publication of the trademark application. However, they shall not be party to any proceedings before the institute.

### Registration

Pursuant to Article 39, an application without defects or that has had any deficiencies remedied, and which was not opposed or the subject of a successful opposition within the prescribed period, shall be entered in the Trademarks Register, and the applicant shall receive a trademark certificate of registration.

The Trademarks Register is open to public inspection upon request and payment of the prescribed fee. Once entered in the register, a trademark shall be published with the relevant information prescribed in Article 39.

### Renewal

A trademark is registered for a period of 10 years from the date of filing of the application. Registration may be renewed for further periods of 10 years, upon payment of the renewal fee (TL509 - approximately €328 - if the request is within six months before the expiry date and TL681 - approximately €440 - if the request is within six months after the expiry date) at the request of the right holder or of a person authorized by the right holder.

The request for renewal shall be submitted and the renewal fee paid within a period of six months before the last day of the month in which protection ends. If a right holder fails to meet this deadline, it may submit a request for renewal within six months after the last day of the month in which protection ends, upon payment of an additional fee.

Renewal shall take effect from the day following the date on which the existing registration expires. The renewal shall be entered in the register.

A trademark will cease to be protected if it has not been renewed within six months after the expiry of the period of protection.

### Removal from register

**Cancellation/surrender:** The rights of a trademark shall be cancelled upon:

- the expiry of the protection period and non-renewal within the prescribed period; or
- the surrender of the rights by the mark owner.

The cancellation of rights in a trademark shall be published in the relevant *Official Trademark Bulletin*.

The mark owner may surrender its rights in respect of some or all of the goods and services for which it is registered. The surrender shall be declared in writing to the institute. Surrender shall have effect as of the date of entry in the Trademarks Register.

**Revocation/invalidation:** A registered trademark shall be declared invalid by the courts in the following cases:

- where there is absolute grounds for refusal of registration of a trademark;
- where there is relative grounds for refusal of registration;
- where the registration has not been used;
- where the trademark has become generic in respect of the relevant goods or services as a result of acts of the mark owner;
- where, due to the use made by the proprietor or by any person authorized by the proprietor, there exists a likelihood of confusion on the part of the public as to the nature, quality, place of production or geographical origin of the goods or services for which it is registered; or
- where, in the case of collective or guarantee marks, the mark is used in violation of the technical regulation.

If invalidity relates only to certain goods or services, a partial invalidation shall be effected with respect to those products and services. Reasons two to four above will not apply where the trademark has acquired distinctive character through use for the goods and services covered by the application.

An application for invalidation may be brought by any interested party, the state prosecutor or related official authorities.

Article 44 of the decree notes that a final decision on invalidity shall have retroactive effect with the exception of the following:

- any final decision for violation of the trademark reached and enforced prior to the decision of invalidity; or

- contracts concluded and executed prior to the decision of invalidity. (However, partial or total reimbursement of sums paid under the contract may be claimed on grounds of equity to an extent justifiable by the circumstances.)

---

## 5. Enforcement

### Complexity

Trademark infringement occurs when a third party uses an identical or similar mark to that of the registered mark for identical or similar goods or services without the consent of the mark owner in a way that is likely to cause confusion. Recognized marks are entitled to increased protection, in that use of an identical or similar mark for different goods or services to those covered by the recognized mark shall be considered a violation. Other causes of action include:

- using an imitating trademark;
- selling, distributing or importing goods bearing such an imitating mark or holding them for trade purposes; and
- breaching licensing provisions or transferring such rights to third parties without authorization.

Customs authorities are authorized to prevent trademark violations. Customs may seize infringing goods upon the request of a right holder where such goods are believed to violate its rights.

Use of imitating marks constitutes a crime which is punishable by way of a fine and / or imprisonment.

In Turkey, copyright and IP civil and criminal courts are established only in Istanbul and Ankara. The city of Izmir has a copyright and IP criminal court. In other cities, trademark cases

are heard by commercial courts of first instance or civil courts of first instance.

When calculating any loss of profit suffered by a right owner as a result of an infringement, the court will take into consideration, among other things:

- the mark's economic importance;
- the length of time for which the mark had been validly registered at the time of the violation; and
- the number and variety of licences in force at the time of the infringement.

If the court decides that the mark has a significant impact on the sale of the relevant product, it may add a reasonable amount to the earnings calculation.

In the case of a recognized trademark, if the reputation of the mark is damaged because of the violation, the mark owner may request additional compensation.

Owners of unregistered marks may be able to bring actions for:

- a declaration that the mark is infringed;
- an order prohibiting the infringing use;
- an order of rectification for the damaging consequences of the violation; and/or
- compensation for economic or moral damages.

### Timeframe

Typically, the court will hold its first hearing within two to three months of the filing of the case. Standard court proceedings, involving exchange of relevant documents and petitions, witness statements and expert evidence, take approximately 12 to 16 months. However, the plaintiff may also request preliminary measures, in both civil and criminal cases, prohibiting any use of the infringing mark. Preliminary rulings are usually issued within five days of the request. Appeals usually take around 12 months.

## 6. Ownership changes – legalization requirements

A mark may be partially or completely transferred, either as part of a business or separately.

In order to be valid, the transfer agreement must be in writing and signed by both parties. However, in transactions where the transfer is performed by the court, these conditions are not necessary.

After a partial transfer, a registration certificate should be issued in the name of the transferee for the transferred part.

The necessary documents for the transfer are as follows:

- a notarized transfer certificate;
- the transferee's certificate of business;
- an original of the trademark registration certificate;
- originals of the documents showing that the transfer fee, transfer annotation, register record and notifications fees have been paid;
- an original of the signature circular where the transferee is a corporate body; and
- an original of the power of attorney, where relevant.

## 7. Related rights

Areas of overlap include copyright and design rights. A design may be protected as a registered industrial design and may also be protected under copyright law.

## 8. Online issues

Registered and unregistered trademarks are protected against unauthorized use on the

Internet under Decree-Law 556. 'Unauthorized use' includes use of a mark on websites, in hyperlinks, in online advertisements, in metatags and in domain names.

The Internet Supreme Council of the Ministry of Communications of the Turkish Republic (ISCMC) determines the policies of Turkey's '.tr.' country-code top-level domain. It also prepares settlement proposals for disputes arising out of domain name registrations and delivers these proposals to Domain Name Management (DNM), which is part of the Middle East Technical University's Department of Computer Engineering. The ISCMC has founded the Domain Name System Working Commission to help coordinate domain name practice. The commission prepared the draft of the '.tr' Dispute Resolution Machinery Regulation on Domain Names.

The regulation applies to the following types of dispute:

- cases involving a registered domain name where the dispute is between a domain name holder and a third party who is alleging that the domain name registration is unlawful;
- cases between the DNM and a third party where the third party alleges that the domain name registration entered by the DNM is unlawful; and
- cases between the DNM and an applicant for domain name registration where the applicant alleges that the rejection by the DNM of its application is unfair.

Decisions of the ISCMC can be appealed to the administrative courts.