

Local Trademark Applications versus International Registrations: Unsettled Practice in Turkey Suggests Local Applications are Wiser in Short Term

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International intellectual property right-holders generally prefer to deal with Turkish trademark rights via an International Registration Application ("**IR Application**"), rather than filing a local trademark application in Turkey. IR Applications are generally easier to manage when right-holders are dealing with multiple countries.

The WIPO Madrid System is the foremost international filing system for IR Applications. The Madrid Union currently has 101 members, covering 117 countries (including Turkey). It allows applicants to file a single trademark application, with a single set of fees, leading to trademark protection in up to 117 countries.

Once a right holder obtains a trademark registration through the Madrid System, it can manage all designated countries in one place, in one language, as well as securely file all requests and amendments from a single account. Therefore, the practical advantage of international applications via the Madrid System are clear in terms of costs, time and security. The alternative to an IR Application is for right-holders to file separate local trademark applications directly in each of the relevant countries.

In an IR Application, WIPO will examine the application contents, but each local trademark office may still apply specific requirements and procedures for trademark applications, registrations or designations which have been filed through the Madrid System. Therefore, local factors and peculiarities remain relevant during IR Applications.

In general, companies develop their approach to global trademark filings based on a range of factors, such as marketing strategy and co-existence agreements. Based on these factors, a company will choose to either file an IR Application, or make a local trademark application to the relevant country's trademark registration body.

Turkey recently overhauled its intellectual property regime, introducing new legislation in January 2017. The changes have meant that practices in Turkey for trademark applications remain uncertain and occasionally inconsistent, especially when IR Applications are involved.

Therefore, companies should also address some extra considerations when deciding whether to make an IR Application or local application when Turkish trademark rights are involved. The current uncertainty and inconsistency in Turkish trademark practices mean a local trademark registration is preferable at least in the short term, to ensure solid legal protection exists and rights are not lost through missed communications, or by letting the opportunity pass to raise the non-use defence against opponents.

The advantages of a making a Turkish trademark application are:

- **Quicker registration:** The registration period of local applications is significantly shorter than those made via the Madrid System, which can take 18 months or more.
- **A local point of contact:** Local trademark applications involve a local recorded attorney. Therefore, if a mistake or irregularity arises during the application which can be solved with a brief discussion or simple action, the Turkish Patent and Trademark Office ("TPTO") has an easy point of contact to deal with this.

- **Monitoring oppositions:** Filing a response to a third-party opposition is not required in Turkish practice. Therefore, to expedite proceedings, the TPTO does not inform IR Applicants about oppositions. Rather, the TPTO will only notify IR Applicants if their application is rejected based on an opposition. During a local application, the TPTO will generally notify the local attorney about oppositions. Further, official fees apply for appealing the TPTO's rejection of a trademark application, while no official fees apply to respond to an opposition at the earlier stage.
- **Raising the non-use defence against oppositions:** During opposition proceedings based on similarity, if the opponent's trademark has been registered for five years or more, the applicant can ask the TPTO to request the opponent prove its use of the trademark ("Non-Use Defence"). The opponent must then prove it used the trademark as of either the later trademark application's filing date, or priority date. The TPTO will reject the opposition if the opponent fails to satisfactorily prove it used the trademark within this five-year period. However, the opposition phase is the only time when the trademark applicant can raise the Non-Use Defence. Therefore, since the TPTO does not inform IR Applicants about oppositions (explained in point above), IR applicants could potentially lose their only opportunity to raise the Non-Use Defence and force the evidentiary onus back onto the opponent.

The TPTO's failure to inform IR Applicants about oppositions has gradually become a problem for IR Applications in Turkey. To address this, we (as a local Turkish law firm) have begun recording ourselves as the attorneys for IR Applications. Occasional cases still exist though where the TPTO has failed to inform the local attorney of record about development or problems which arise during IR Application processes.

Therefore, to be safe side, it is prudent to file a local trademark application, as well as record a local attorney for ongoing IR Applications. Once Turkish practice has settled, international right-holders will be better laced to consider filing IR Applications again, using filing strategies which are specifically tailored to their needs. However, even once practice is settled, the shorter trademark registration periods and easier communication which come with a local trademark application will continue, vis-à-vis IR Applications

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