

New Exception to Trademark Use Requirements in Turkey

1 Jan 2012

The Turkish Court of Appeals rendered a landmark decision regarding the trademark use requirement. According to local legislation and practice, only the use of a trademark in Turkey fulfills that requirement. Additionally, importing goods bearing the trademark is also considered as 'use' for that trademark.

The Court of Appeals granted a new exception to the above explained rule. In a recent lawsuit that was filed against an international broadcasting company for the cancellation of its trademark (which is registered in class 38) based on non-use, the court found that a trademark may meet the use requirement without actually being produced or served within Turkish borders.

In the lawsuit the plaintiff alleged that the defendant was not broadcasting via cablecast and registered before the Radio and Television Supreme Council for the last five years, which proved that the subject trademark had not been in use in Turkey.

The defendant based its defense on the fact that the trademark was in use in Turkey through Internet or satellite broadcasting. The defendant also claimed that the subject channel can be viewed in the public domain, including at hotels.

The Court of Appeals upheld the First Instance Court's decision, stating that broadcasting services that are not served within Turkey and provided via satellite or Internet are considered as "use of the trademark within Turkey", based on the reason that the defendant's TV channels are easily viewed by the general public in Turkey.

The Court of Appeals stated that transmission is defined as the "initial emission by terrestrial transmitter, by cable or by satellite or whatever nature in encoded or unencoded form of television program services for reception by the general public" according to article 2/a of the European Convention of Transfrontier Television.

Even though the Trademark Decree Law no: 556 does not require that the broadcasting or initial emission take place within Turkish borders the Court of Appeals agreed that the trademark is in use in Turkey since the general public can easily view a TV channel by Internet or satellite even though the TV channel does not operate in Turkey. In addition, developing technology enables the TV broadcasting companies to provide their services through different platforms.

With this decision, the Court of Appeals created an important exception to the use requirement in Turkey. In practice, the Turkish Patent Institute and the First Instance Court have long recognized the use of a trademark via online international shopping sites as fulfilling the use requirement. It seems that with globalization the principle of territoriality and use requirement within a territory will slowly be eroded.

Assigning Trademarks During Pending Lawsuits

According to Turkish Trademark Legislation, if a trademark has not been used or the use has been suspended for a five-year period, the trademark shall be due for cancellation. A non-use action may be initiated against the proprietor of the trademark on whose name the trademark stands, at the time when the lawsuit is initiated. However, what happens if the trademark is transferred to a third party during the non-use action?

The Assembly of Civil Chambers rendered a landmark decision about transfer of a trademark during the period that it is subject to non-use actions. In a recent lawsuit covering this topic the assembly decided that the plaintiff should proceed to legal action with the new proprietor.

The assembly stated that the transfer of a trademark has the same effect as the "transfer of the claim" and the assignee shall take over the trademark with all its rights and claims. For this reason the ongoing non-use action will remain as it is and will continue with the new proprietor.

Related Practices

- [Trademarks](#)
-

Related Attorneys

- [I?IK ÖZDO?AN, LL.M.](#)
 - [EZG? BAKLACI GÜLKOKAR, LL.M.](#)
-