

One Year On: Consent Letters in Turkish Trademark Law

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The Industrial Property Law ("IP Law") introduced consent letters to Turkish trademark law in January 2017, a mechanism which practitioners had waited a long time for. After around a year with the new regime, we share some insights on how the Turkish Patent and Trademark Office ("TPTO") approaches co-existence agreements, as well as key things for right holders to watch out for in practice.

Consent Letters Introduced to Turkey in January 2017

Under Turkish law, if an identical or indistinguishably similar trademark exists, which covers the same classes (or classes which cover the same kind of goods) this is an absolute ground for rejecting a later trademark application.

Before the IP Law was enacted in January 2017, it was not possible to overcome such a rejection if the earlier trademark remained active. Sister company concepts and co-existent agreements were not sufficient tools to overcome ex-officio refusals. Therefore, even if the earlier right-holder consented to the later trademark, the TPTO would not cancel its provisional refusal decision.

However, the new IP Law allowed later trademark applicants to overcome a provisional refusal decision from the TPTO by submitting a notarized consent letter from the earlier right-holder.

Requirements for Consent Letters

According to the IP Law, consent should meet the following requirements:

- Consent letters must use the TPTO's standard form, available on its website.
- Consent letters must be notarized.
- Consent letters can be submitted at the time of filing, or right after receiving a refusal decision.
- Consent letters must contain a visual of the trademark for which consent is given.
- If consent is given after a refusal decision, the letter must also contain the trademark application number.
- The consent must remain within the earlier registration holder's terms of the goods. In other words, the earlier trademark holder can only give consent within the terms of its registration.
- Consent must be given unconditionally.
- Notable Aspects of the TPTO's Approach
Based on our observations and experience, the following points are important in practice:
- Consent is irrevocable: The earlier right-holder cannot revoke its consent in any situation, nor give consent for a fixed period.
- Consent is limited to the earlier registration holder's entitlements: Consent must be given within the goods of the services which are covered by the earlier right-holder's trademark registration. In practice, consent-givers prefer to specify criteria and approve the application which they are consenting to. However, the TPTO does not allow this nuanced approach.
- Consent should be given for all goods in coinciding subclasses: The TPTO carries out its absolute ground examination on a subclass basis. While deciding to reject a trademark, it considers whether the application:
 - Is identical or indistinguishably similar to an earlier trademark, and
 - Covers the same goods covered by an earlier trademark, or the goods fall into the scope of the same subclasses.

For instance, if the earlier trademark covers headgears articles (a subclass under class 25) and the applicant wishes to register their mark for caps (an article falls under the subclass "headgears"), the earlier right-holder must consent to the later registration covering headgears articles. If the consent only covers caps, the TPTO will reject the application on the basis that the consent's scope is insufficient.

- Consent must be unconditional: The earlier right-holder cannot limit the subclass goods, nor include other requirements/obligations in the consent form.
- Consent must be given for each and every application: The later registration (obtained via consent) will not give the applicant acquired rights.
- Oppositions against confusingly similar trademarks: If the earlier right-holder later files a confusingly similar application to the trademark which was subject to the consent, the later trademark holder (who obtained trademark registration via consent) can file an opposition to that application, independent of the consent relationship.

Parallel Consent Arrangements

The TPTO's approach over the last year makes clear that it requires clean and unconditional consent, without the parties adding any further restrictions or limitations. Rather, it prefers to simply hear a YES/NO answer from the earlier right-holder, giving unconditional consent to the later registration. This approach excludes all other consent conditions which parties may discuss and agree upon.

The TPTO's approach leaves the parties to negotiate the terms of a potential settlement outside of its proceedings. Accordingly, parties should agree a separate co-existence arrangement, before building a consent relationship in the TPTO context.

Related Attorneys

- [İ?IK ÖZDO?AN, LL.M.](#)
- [YONCA ?ELEB?](#)