

Oppositions Based on Unregistered Marks in Turkey

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The Turkish Trade Mark Registry frequently receives applications seeking to register well-known trademarks, celebrities' names and trademarks owned by foreign companies that have not been registered in Turkey. Some trademark owners are not disturbed by these applications as they are not active in the Turkish market. But most trademark owners do not file oppositions against these applications because they assume that it is necessary to have existing Turkish registrations in order to file oppositions.

Therefore, the applications are being registered and tragically becoming obstacles for trademark owners to register or use their trademarks in Turkey in the future. A good example of this is the Luella case.

Lessons of the Luella Case

The Turkish owner of the trademark Luella seized some Luella branded goods of the famous English fashion company from the luxurious shop of its distributor. The Italian clothing company Gorotto SPA also had to pull its Gas branded goods out of the Turkish market because the trademark Gas was registered in the name of a Turkish company years before.

Once the trademarks are registered it becomes harder to overcome the obstacles to proper registration by the original owners. A cancellation lawsuit takes a long time and the cost of such cases is much greater than the opposition procedure. Therefore, filing an opposition against the published trademark application is the most advantageous way to protect your trademark.

As a rule in Turkey, only the owner of a Turkish registration or application can file an opposition against a published application. Although this is the common rule, in some cases unregistered trademark owners' oppositions can also be accepted.

The "Earlier Right" Exception

One of these exceptions is the unregistered trade mark owners' "earlier right" as defined in Decree Law number 556 article 8/3. According to this article, if the unregistered mark has been used in the course of trade before the filing date of the published application, the application will be refused upon receipt of the unregistered trademark owner's opposition.

Therefore, if the unregistered trademark owner uses the trademark in Turkey before the filing date of the published trademark and if this usage can be proved by various arguments (invoices, purchase orders, brochures, catalogs, etc), the Institute may consider an unregistered trade mark owner's opposition and refuse the trademark application.

Also, when the agent or the representative of the unregistered trademark owner files an application to register the trademark with no valid grounds, the unregistered trademark owner's opposition will be accepted.

According to Decree Law number 556 article 8/2, the application of an applicant who uses the unregistered trade mark with the consent of the unregistered trade mark owner such as a representative, agent or distributor, will be refused upon the opposition of the unregistered trade mark owner. The relationship between unregistered trade mark

owners and applicants is not numerous clauses. Any relationship that gives an applicant the right to use the unregistered trademark can be considered within the scope of this article.

Even if the relationship between the unregistered trademark owner and the applicant ends, the trademark owner can base its opposition on this article as the former relationship between the applicant and the unregistered trademark owner proves the applicant's bad faith.

On the other hand, the Turkish Patent Institute or the courts refuse not only identical trademark applications with the unregistered trademark, but also similar trade marks that will likely cause confusion for the relevant public.

Further, an applicant's bad faith is one of the important and comprehensive arguments upon which the unregistered trademark owner can base his/her opposition.

Although Decree Law 556 stipulates bad faith as one of the grounds for an opposition, the circumstances that define the application as having been done in bad faith are not given.

However according to the Institute and the Appeals Court's decisions, applications filed to take advantage of other trade marks, to blackmail the unregistered trademark owner, to sell the trademarks for large amounts, or applications which are submitted on a date by which the applicant knew or should have known of the unregistered trademark are considered as having been made in bad faith.

In addition to these, the Institute also considers applications filed to register international celebrities' names or well-known trademarks in which the applicant and the unregistered trademark owner are active as having been made in bad faith. Therefore, the Institute refused the applications Curious Britney Spears, Paris Hilton, Emilio Pucci, Marc Jacobs, Beyonce, Boucheron and Gossip Girl for the reasons mentioned above.

Check the Records

It is advisable that before filing an opposition based on these grounds the unregistered trademark owner should check the Institute's records to determine whether the applicant owns an earlier trademark registration for the same mark.

If the applicant has previously registered the unregistered trade mark, the Institute will refuse the unregistered trademark owner's opposition because of the acquired rights of the applicant.

In that case, it will be more advantageous to wait for the application to be registered and then to start a cancellation action against all the applicant's registrations.

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