

Registering Well-Known Trademarks in Turkey

16 Feb 2015

Article 7/1-? of the Turkish Trademark Decree Law no. 556 established a legal basis in 1995 for the Turkish Patent Institute (TPI) to refuse trademark applications on the basis that an application is similar to a well-known trademark. However, at the time, there was no mechanism available to the TPI for establishing whether a given trademark was well known or not.

Therefore, the TPI established the well-known trademark registry with the goal of recording and making information about well-known trademarks publicly accessible. The TPI has issued several bulletins since 1996 announcing the trademarks which the TPI deemed to be "well-known". By 2004, the TPI had recorded more than 100 trademarks as being well-known.

However, this registry is not a reliable source for trademark owners. Despite Article 7/1-?, if a trademark is registered as being well-known, this will not necessarily prevent all later inappropriate trademarks being registered. Even if a trademark is registered as well-known, the trademark owner should continue to monitor third-party trademark applications.

Despite this, it is still worth a trademark owner obtaining a well-known registration for its trademark. Such a registration can be valuable evidence in any dispute which may later arise.

Criteria and process

When considering applications by trademark holders to be registered as well-known, the TPI considers the following factors:

- The trademark's history and length of use;
- The extent and geographical area of the trademark's registration (in Turkey and abroad);
- The extent and geographical area of any promotion for the trademark;
- Advertising activities undertaken with respect to the trademark, particularly within Turkey;
- Any other promotional activities which cannot be considered to be advertising but which support the trademark's well-known character, eg, publications;
- Any court decisions which:
 - Accept or discuss the trademark's well-known character; and/or
 - Show the trademark owner's willingness to protect its trademark, eg, opposition procedures, seizures, injunctions, and unfair competition actions;
- Research regarding public opinion of the trademark, such as market surveys or polls;
- Information about the trademark owner;
- Any awards the trademark owner has won with respect to the subject trademark;
- Information about whether the trademark symbolises its owner and whether the trademark reflexively reminds viewers about the goods which the trademark applies to;
- Information about the export and import of goods which carry the trademark; and
- The trademark's nominal value.

The TPI's Re-Examination and Evaluation Board examines applications based on the documents provided by the parties. It will not seek expert opinion during the examination.

If the TPI accepts that a trademark is well-known, it will usually also note that the trademark is either well-known in a specific sector, or is well-known beyond the sector that the trademark owner operates within. This distinction is not based on the related legislation, but rather is applied by the TPI in practice. As a result, confusion often arises about the nature of well-known trademark protection.

If a trademark application is similar to a registered well-known trademark, the TPI can reject the application on absolute grounds, even if it relates to goods and services which are not related to the well-known trademark.

In practice the TPI is very careful when applying this rule, particularly with regard to registered well-known trademarks which have a lower degree of recognition among the general public. Even if a later trademark application is identical to a registered well-known trademark, the TPI may only require particular goods or services to be removed from the trademark application.

Therefore, owners of well-known trademarks should still monitor the Turkish trademark registry for applications and registrations which may be inappropriately similar to their own trademark.

A standalone registry

The TPI's well-known trademarks registry simply determines the well-known character of the trademark, and nothing else. It does not include the trademark owner's name and trademark owners are not required to renew the registration, or record trademark ownership changes in any way.

In reality, a trademark's public recognition (which the well-known status is at least partly based on) is fluid and will change over time. For this reason, the TPI should introduce a system to periodically re-examine trademarks which have been registered in the well-known trademark registry. In practice, once a trademark is registered as being well-known, it enjoys this status indefinitely. Arguably, this could cause the TPI to render unfair decisions.

Consequently, Turkish courts do not take the TPI's well-known trademark registry into account as a first place when considering disputes even though registering a trademark as a well-known trademark before the TPI is an indicator of well-known character of the trademark. If a trademark's registration in the well-known registry is included in a lawsuit claim, the courts will send the files to an expert body for consideration, rather than relying exclusively on the registry.

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