

## The Required Evidence Regarding Proof of Use in Trademark Matters

*22 Nov 2021*

With the introduction of the Industrial Property Law ("IPL"), the "proof of use" practice, which is applied in EUIPO and many countries, came into force in trademark opposition cases. In this article, we discuss how it works in Turkey.

Upon the request of the owner of a trademark application, a party opposing trademark application must prove the use of the trademark on which the opposition is based to the extent it has been registered for more than five years at the application or priority date of the opposed trademark application.

If the opponent cannot provide evidence that it has been seriously using the basis trademark of the opposition in Turkey within five years prior to the application date or has justified reasons for not using it, its opposition shall be rejected within the scope of the likelihood of confusion, which is regulated in Article 6/1 of the IPL.

Evidence of use must be submitted within one month after the notification made by the Turkish Trademark and Patent Office ("TPTO") is received. The fact that this period is short often creates problems, particularly when foreign opponents must present evidence regarding their use in Turkey. Therefore, it is best to determine which basis trademarks are subject to the request for proof of use when filing an opposition against a trademark application and to start gathering the evidence of use for these trademarks.

Despite the fact that proof of use has been applied for about four years, trademark owners still continue to have problems regarding the sufficiency of the evidence due to the lack of clear provisions within the scope of the IPL. As a result, they often lose their rights due to their inability to present sufficient evidence.

### **Evidence that can be submitted for proof of use:**

Pursuant to the Proof of Use Guidelines published by the TPTO in 2017, the opponents may submit the following evidence to prove the use of their basis marks:

- Invoices,
- Catalogue, price list and product codes,
- Samples of packaging and promotional materials,
- Advertisement, promotion, market survey, public opinion research,
- Commercial information such as the turnover, profit, domestic and international distribution channels of the goods or services, and the awards they won,
- Statements containing explanations about the evidence

Although these are the main types of evidence to be submitted, it is generally accepted that any kind of evidence showing the use of the mark and bearing a date may be submitted. The submitted evidence is uploaded to the online system and may only be viewed by the parties of the opposition.

### **Important matters to consider regarding the evidence:**

- Submitted evidence must contain the trademark for which the use must be proven. A use which does not alter the distinctive character of the trademark will be considered as valid. For example, the use of the

trademark by adding or removing words and devices that do not have distinctiveness is valid.

- There is no special regulation regarding the quantity of evidence. The important thing is to prove that the trademark has been meaningfully used in the five years before the application date of the trademark which is the subject of the opposition. Accordingly, it is important that the evidence includes dates and that these dates are distributed over the five years in question.
- Invoices showing the sale of a product or service that directly bears the trademark are considered the strongest evidence. How many invoices should be submitted depends on the nature of the product or service. For example, while more invoices should be presented for products that are bought daily, it may be sufficient to submit less invoices since expensive and non-daily bought products and services are sold less frequently. If possible, submitting 10 invoices per month over a 5-year period will suffice.
- The use must be associated with the owner of the trademark registration. If the evidence shows that the trademark is used by a third party, the relationship between this party and the trademark owner must be proven. In this context, it is possible to submit agreements that give the right to use trademarks, such as license and distributorship agreements. If the trademark owner and the company using the trademark are affiliates, company records may be submitted. In cases where the relationship between the companies cannot be proven with an official document, it is possible to submit an affidavit signed by the company using the trademark explaining the relationship between the parties. Although there is no validity condition for such affidavits, a notarized affidavit will be considered stronger evidence.
- The opposition will be examined based on the goods and services for which the use is proven. In this context, it is necessary to prove that the trademark is used on the registered goods and services. If the use can only be proven in terms of some goods and services, the opposition will be examined taking into account those goods and services.

Considering that the opposition will be rejected in light of the likelihood of confusion (one of the most important grounds of opposition) as a result of not proving the use with sufficient evidence, trademark owners should gather the necessary and sufficient evidence with utmost care.

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