

Trademark Frustrations in Turkey

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The acceptability of consent letters, co-existence agreements and sister company arrangements are often explored by the applicants whose trademarks are provisionally refused based on a prior registration in Turkey.

Contrary to all expectations, consent letters, co-existence agreements and sister company arrangements do not overcome a provisional refusal in Turkey. In other words, even if the prior registration holder consents to the later trademark, the Turkish Patent Institute (TPI) will still not cancel the provisional refusal decision.

Once a trademark application is filed, the TPI examines the application according to article 7 of Decree Law no. 556. According to article 1 (b) of the law, trademarks that are identical or confusingly similar to an earlier trademark for the same or similar goods or services are ex officio refused. In this case, the only option is to appeal against the provisional refusal decision and demonstrate the dissimilarity of the trademarks or of the relevant goods or services.

Until 2004, alleging distinctiveness acquired by usage before the registration date could also overcome the provisional refusal. However, this is no longer an option since the law was amended because, according to the TPI, a phrase can only be registered in the name of one holder for given goods or services.

Applicants whose trademarks are provisionally refused based on a prior registration in Turkey might consider the following approaches:

- Submitting a letter of consent or co-existence agreement: Turkish Trademark Law does not mention the registration holder's consent to a later trademark application. The grounds of provisional refusal are considered to be a public policy and therefore a consumer protection matter. For this reason, even the registration holder's consent is not enough to overcome provisional refusal.
- Agreements between sister companies: In some cases, the later trademark application is refused because of the applicant's sister company's older registration. Even if the applicant clearly explains and proves the companies' relationship, the TPI will still not cancel the provisional refusal decision. In this case, the only way to overcome the provisional refusal is to gather the trademarks under the same roof. Therefore, the applicant usually appeals the provisional refusal decision to gain time and reassigns the older trademark.
- Assignment of the provisionally refused trademark to the existing holder until it is registered: This act can be invalid as it can be considered as a fraud against the law. Additionally, article 16/5 of the law prevents this. According to the article, when a trademark registration is assigned, it is necessary also to assign any identical or similar trademarks (for the same/similar goods or services). In practice, when an application for recordal of the trademark assignment is filed, the TPI gives two months for the assignment of the remaining identical/similar trademarks to the assignee. If these marks are not gathered under the same roof within two months, the application for the recordal of the assignment is refused. Therefore, assigning the provisionally refused trademark to the older registration holder only serves to have the trademark registered in the name of the older registration holder.

In fact, it is not possible to overcome provisional refusal using conventional means. Therefore, it seems that the only option is to register the trademark of the older registration holder and try to obtain a licence from it.

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