

Trademark Oppositions: Bad News Without Bad Faith

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A common problem of opposition proceedings arises when the rights to a given phrase are acquired by the applicant based on an earlier registration. Once a trademark has been registered, the registrant acquires the rights to the relevant phrase for subject goods and services.

As a rule, the Turkish Patent Institute (TPI) protects the acquired rights of a registrant arising from its earlier registration. Therefore, when the owner of the acquired rights files a trademark application for the phrase (with little or no change) and the application is opposed, the TPI will refuse the opposition because of the applicant's acquired rights, even if the opposer's trademark is similar to that in the application. In such cases, it is not possible to get positive results in an opposition proceeding unless the prior registration is cancelled.

The protection of acquired rights may sometimes cause a vicious cycle for trademark owners. It can support a malicious applicant's challenge to a trademark owner, forcing the owner to embark on a difficult and time-consuming journey. Rather than focusing on opposition proceedings, it might be better to look at how a trademark owner can be successful in a cancellation action against an infringing trademark.

First of all, it should be noted that it takes at least three years to finalize a trademark cancellation action. And as long as the cancellation action is not finalized, the subject trademark will be alive. In most cases, a defendant will file a new trademark application for the same trademark while the cancellation action is underway.

When this application is published and the plaintiff (trademark owner) files an opposition, the TPI is likely to refuse the opposition because of the applicant's acquired rights, which arise from its earlier trademark, which in turn is subject to the cancellation action. Additionally, while the opponent can request that opposition proceedings are suspended until the cancellation action is finalized, the TPI does not normally accept this request, or otherwise only suspends proceedings for six or seven months.

So in addition to challenging one trademark, an owner may find himself in the position of having to challenge an initial registration and a subsequent, identical or similar one. So a single overlooked trademark might cause an ever-growing problem to a trademark owner.

However, in some exceptional cases, acquired rights are not protected. Though the TPI still protects an applicant's acquired rights arising from earlier registrations, it also takes into account the applicant's bad faith and any intention to imitate its opponent's trademarks. If the applicant intends to imitate a third party's trademark, and therefore cause confusion to consumers the TPI will refuse the application.

Case in point, the TPI recently refused the stylized 'Maplink' trademark upon opposition, even though the applicant registered the word mark 'Map-Link' in 2004. The TPI refused the application on the grounds that the applicant was aware of the opponent's trademark and intended to acquire unlawful profit. In other words, in such cases, the TPI does not protect the acquired rights of the applicant, but rather considers whether the applicant was aware of the opponent's trademark before filing its own application.

But while the TPI does take into account an applicant's bad faith, it is still advisable to monitor applications published in the *Official Trademark Bulletin*, to prevent an applicant acquiring the rights of the real owner. Otherwise, the real rights owner has to launch a risky challenge.

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