

## Turkish Court of Cassation Clarifies the Uncertainty for Non-Use Actions

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11<sup>th</sup> Chamber of Turkish Court of Cassation rendered a long-awaited decision on the cancellation of trademarks that have not been in use for five years starting from the registration date. The court concluded that, although in principle, the laws cannot be applied retrospectively, the will of the legislator should be considered.

The discussions stemmed from a four-day gap period between two laws. The article 14 of the Decree Law number 556 on the Protection of Trademarks ("**Abrogated Decree Law**") regulating the cancellation actions for trademarks that have not been in use for five years from the registration date, was annulled by Turkish Constitutional Court's decision dated 14 December 2016. The decision was published in Official Gazette 6 January 2017, entering into the effect on the same day. However, cancellation actions due to non-use were regulated on 10 January 2017 with new Industrial Property Law number 6769 ("**IP Law**"). Consequently, the ways to fill the gap period between the Abrogated Decree Law and newly introduced IP Law, that is between 6 January 2017 and 10 January 2017, and its possible outcomes have long been debated.

The case was brought against the Turkish Patent and Trademark Office's ("**TÜRKPATENT**") ex-officio provisional refusal based on the article 5/1 (ç) of the IP Law, as well as the former trademark owner.

Ankara 2<sup>nd</sup> Intellectual and Industrial Rights Civil Court rejected the lawsuit filed against TÜRKPATENT while accepting the one against the trademark cancellation due to non-use, based on the following reasons:

- Pursuant to articles 20 and 21 of the IP Law, the necessary legal remedies have not been exhausted.
- Trademark cancellation lawsuit due to non-use of article 9 of the same law, the owner of the past and the future was brought a burden for use.
- The defendant has the burden of proving the use of the trademark for milk products and its validity for fruit juices.
- The defendant did not provide any evidence for use despite the precise deadline.

Following this decision dated 31 January 2019 and numbered 2017/226, defendant's attorney made an appeal request. Ankara District Court of Justice's dated 17 January 2019 and numbered 2018/664 E. has been appealed.

After reviewing the dispute, 11<sup>th</sup> Chamber of the Court of Cassation decided that:

- Article 9/1 of the IP Law aims to remove the trademarks that are not being used, from the trademark registry list. Hence, the examination and the final decision should be made by taking these reasons into consideration.
- Prior to the IP Law, articles 42/1-c and 14 of Abrogated Decree Law also aimed to cancel trademarks that had not been used for at least five years.
- Although in principle of non-inviolability of laws is adopted as a rule, in cases where laws have prospective consequences, Turkish Grand National Assembly may issue a retroactive law.
- Consequently, the will of the legislator and legal possibility should be taken into account for the four-day gap between the date of publication of the official newspaper and the effective date.
- The trademark subject to the case was not genuinely used by the owner in regard to the goods and services which was registered for.

Based on these grounds, the Court of Cassation has cleared the path towards the cancellation actions and put an end to discussions with the decision number 2019/1765 E. and 2019/4421 K. and dated 14 June 2019. Please see this [link](#) for the full text of the decision.

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