

Turkish Court Rules on Obligation to Determine a Trademark's Aim at Time of Registration When Considering Cancellation Actions

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The Turkish Supreme Court recently ruled on the requirement during cancellation actions for the court to determine a trademark's aim at the time of registration. The court reversed a lower court's trademark cancellation decision on the basis that the lower court had failed to determine whether the disputed trademark was registered in order to create a trademark series, or registered to cause confusion with the plaintiff's trademark.

At the First Instance Court, the plaintiff sought cancellation of a two trademarks. The plaintiff claimed its trademark was well-known and the defendant's trademarks caused the likelihood of confusion. It also claimed the disputed trademarks had not been used since registration. The defendant claimed continuous use of the trademarks since 1992, as well as the well-known status of its own trademarks and the investment in the marks.

The Court of First Instance considered two trademarks:

- It rejected the plaintiff's claims for trademark "X", on the basis the defendant's trademark was registered much earlier than the plaintiff's in the United States. The court also held that the plaintiff's trademark was not well-known when the defendant registered its trademark in 1992.
- It upheld the plaintiff's claims for trademark "Y", on the basis the plaintiff had many trademark registrations including the phrase "Y" on the date the defendant was granted trademark "Y". Therefore, the court held there is a risk of causing confusion in the eyes of the average consumer.

Both the defendant and the plaintiff appealed the Court of First Instance's decision to the Supreme Court.

The Supreme Court overturned the lower court's decision for trademark "Y". The matter was referred back to the lower court for further consideration.

The Supreme Court held that the lower court had wrongly made its decision without determining whether:

- The trademark was registered in order to create a trademark series, with already existing trademarks, or
- The trademark was registered in order to cause the likelihood of confusion with the claimant's trademark.

(Case reference: Yarg. 11. HD. 31.05.2016, 2015/9561 E., 2016/5975 K.)

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