

## Usage Requirements for Well-known Trademarks in Turkey

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The Council of Appellate Circuits of the Turkish Court of Appeals (the council) recently rendered a key decision (2010/11-695 E., 2011/47 K) with regard to well-known trademark usage requirements in different classes.

As is widely known, well-known trademark usage requirements and protection in different classes is a contentious issue in many jurisdictions. The council has finally decided that a well-known trademark cannot be protected in different classes and will be partially cancelled if the trademark is not in use in these classes.

Actually, this decision might create a paradox with the expanded well-known trademark protection in different classes. In the subject case, a foreign company started a non-use action against a well-known Turkish furniture company that actively uses its trademark only in class 20, but owns registrations for whole classes. The claimant claimed the partial revocation of the subject trademark for all classes other than class 20.

The First Instance Court (FIC) dismissed the case on the grounds that well-known trademarks should be protected for all the goods and services that are covered by the registration. The FIC stated that, although there is no exception for use requirement of well-known trademarks in Trademark Decree Law no: 556, the provisions of this legal arrangement should be interpreted together with Article 8/4 of the same, which expands the protection of well-known trademarks.

The claimant appealed the decision. The Appeals Court reversed the decision of the FIC with the reasoning that well-known trademarks can be subject to non-use actions. The Appeals Court stated that the usage requirement provisions do not have an exception for well-known trademarks. A well-known trademark can be subject to non-use action and to partial revocation for the classes in which it is not in use.

The Decree Law no: 556 expands the protection of well-known trademarks with Article 8/4; this article gives the well-known trademark owners the right to oppose or initiate a lawsuit against an applicant who tries to register the well-known trademark in different classes.

In other words, the provision that provides enhanced protection for well-known trademarks does not bring an exception with regard to the usage requirement. The file was sent back to the FIC.

The FIC insisted on its original decision so it was appealed and sent to the council by the claimant. The council reversed the FIC's decision in keeping with the Appeals Court, but on more detailed grounds. The council stated that there is no exception in Decree Law no: 556 for well-known trademarks with regard to the five-year usage requirement.

On the other hand, Decree Law no: 556 Article 7/1-(i) and Article 8/4 give the right for the trademark owner to oppose or start a cancellation action against any trademark that is similar or identical to the well-known trademark in different classes.

Articles 7/1-(i) and Article 8/4 of Decree Law no: 556 protect well-known trademarks in the case the well-known trademark owner can prove that the other party will gain an unfair and unlawful benefit from the well-known trademark and that the average consumer will link the other party's trademark with the well-known trademark.

The council is of the opinion that since 7/1-(i) and Article 8/4 will protect well-known trademarks there is no reason to immunize well-known trademarks from the usage requirement. On the other hand, as a result of the above explained reason, the Turkish Patent Institute cannot ex officio reject a trademark application that is similar/identical to a well-known trademark, but covers the classes that the well-known trademark does not cover or actively use.

In conclusion, the council decided that well-known trademarks can also be subject to partial revocation for the classes which are not in use. In Turkey the decisions of the council set precedence for the First Instance and Appeals Courts. Although this decision might be considered fair for this case, since it will be binding precedent it will create a paradox with the expanded well-known trademark protection in different classes. The well-known trademark owners may have difficulties because of this decision.

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