

Trademarks 2021

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Trademarks

2021

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Lexology Getting The Deal Through is delighted to publish the seventeenth edition of *Trademarks*, which is available in print and online at www.lexology.com/gtdt.

Lexology Getting The Deal Through provides international expert analysis in key areas of law, practice and regulation for corporate counsel, cross-border legal practitioners, and company directors and officers.

Throughout this edition, and following the unique Lexology Getting The Deal Through format, the same key questions are answered by leading practitioners in each of the jurisdictions featured. Our coverage this year includes new chapters on Australia, Belgium, Eurasia, India, Luxembourg, Netherlands, Philippines and Poland.

Lexology Getting The Deal Through titles are published annually in print. Please ensure you are referring to the latest edition or to the online version at www.lexology.com/gtdt.

Every effort has been made to cover all matters of concern to readers. However, specific legal advice should always be sought from experienced local advisers.

Lexology Getting The Deal Through gratefully acknowledges the efforts of all the contributors to this volume, who were chosen for their recognised expertise. We also extend special thanks to the contributing editors, Theodore H Davis Jr and Olivia Maria Baratta of Kilpatrick Townsend & Stockton LLP for their continued assistance with this volume.



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CETINKAYA

LEGAL FRAMEWORK

Domestic law

1 | What is the primary legislation governing trademarks in your jurisdiction?

The Industrial Property Law No. 6769 (the Law) became the primary legislation on trademarks after it was published in Official Gazette No. 29944 and came into force on 10 January 2017. Previously, Decree-Law No. 556 on Protection of the Trademarks (the abolished Decree-Law) was in force from 1995 until 10 January 2017 when it was abolished. After the Law No. 6769 came into force, trademarks are also regulated under the Industrial Property Law, including patents, designs and geographical signs. Although there are crucial changes in the new Law, there are still particular provisions of the abolished Decree-Law that remain in effect.

International law

2 | Which international trademark agreements has your jurisdiction signed?

Turkey is a party to number of trademark-related international conventions, the major ones of which are:

- Patent Cooperation Treaty;
- European Patent Convention;
- Patent Cooperation Treaty 1970;
- Agreement on Trade-Related Aspects of IP Rights;
- Paris Convention for the Protection of Industrial Property 1883;
- Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks; and
- the Madrid Agreement Concerning the International Registration of Marks.

Regulators

3 | Which government bodies regulate trademark law?

There are two ways of making a legislative proposal in the Turkish law system. The Cabinet of Ministries or members of parliament may make the legislative proposal. The proposal then goes to the Commission's desk. After the necessary research and examinations are made by the Commission, the legislation is made ready for discussion in the General Assembly. If the Commission accepts the proposal, then it comes in front of the Grand General National Assembly of Turkey for acceptance or denial. Therefore, all laws are regulated by the Grand National Assembly of Turkey, including trademark law.

The Turkish Patent and Trademark Office is authorised to make regulations and guidelines regarding the enforcement of the law. The authority responsible for trademark examinations and registration is also the Turkish Patent and Trademark Office.

REGISTRATION AND USE

Ownership of marks

4 | Who may apply for registration?

According to article 3 of the Industrial Property Law No. 6769 (the Law), Turkish citizens, real or legal persons residing or engaged in commercial or industrial activities within Turkish national borders, persons entitled to apply under the Paris Convention and the Agreement Establishing the World Trade Organization, and nationals of states that provide protection for industrial property rights to Turkish nationals in compliance with the reciprocity principle are entitled to trademark registration.

Scope of trademark

5 | What may and may not be protected and registered as a trademark?

The scope and signs that a trademark may consist of are regulated under article 4 of the Law. Trademarks must be distinguishable, and the rights and protections granted to the owner must be specified explicitly on the registry. In the same article, it is stated that a trademark may comprise any signs, words, personal names, figures, colours, letters, numbers or sounds, as well as the shape of goods or their packaging.

The signs that may not be registered as a trademark are determined under article 5 and consist of signs that:

- are not clearly distinguishable;
- cannot be trademarks within the scope of article 4;
- are contrary to public order and decency;
- comprise religious symbols;
- consist of other qualifications of the goods or services exclusively or as their essential element, and that include the kind, type, characteristics, quality, quantity, purpose, value, geographical origin, or show the time of production or service;
- are generally used by everyone in a trade, or that contain signs or names that are used to distinguish those that are subject to a particular profession, art or trade group, exclusively or essentially;
- consist of the shape or another characteristic resulting from the nature of the goods, or the shape or another characteristic that is mandatory to obtain a technical result or gives substantial value to the goods;
- could mislead the public on matters such as the nature, quality or geographical origin of the goods or services;
- may be refused pursuant to article 6 of the Paris Convention;
- are outside the scope of article 6 of the Paris Convention, but involve the public interest, contain historical or cultural values, emblems, badges or escutcheons; and
- consist of or contain a registered geographical sign.

Unregistered trademarks

6 | Can trademark rights be established without registration?

There are two systems to establish a trademark: registration and actual use. Establishing trademarks without registration falls under the second system. Since Turkey adopted a registration system for trademark protection, Turkish legislation offers limited protection to trademarks that are not registered. Registered trademarks are protected under the Law and international trademark-related conventions. However, trademarks that are not registered in Turkey but established through actual use are protected under the Turkish Commercial Code's unfair competition provisions.

The Commercial Code defines unfair competition as 'the abuse of economic competition by way of actions that are misleading or violating good faith'. Since trademarks are an essential element of competition, unregistered trademarks are protected under this provision. It is not necessary to be a merchant or for the relationship between the parties to be a commercial affair for protection under unfair competition provisions.

Although it is possible for trademarks to be established without registration, it would be safer for trademark owners to register, since registration provides wider protection under Turkish law.

Famous foreign trademarks

7 | Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What proof is required? What protection is provided?

There are many definitions of well-known trademarks. Generally, it is accepted as a criterion that a well-known trademark must be known by those who are not related to the goods or services. A well-known trademark could be mentioned if the mark is known not only by relevant traders or buyers, but also by those who are not relevant or interested in those goods or services.

Well-known trademarks constitute an exception to the principle of the registration system. In its *Dolce Vita* decision of 11th Chamber of Supreme Court dated 20 November 1998, it is stated in parallel with the Swiss Federal Court's opinion that there is no need for well-known trademarks to be used effectively in Turkey. However, as stated above, a well-known trademark must be known by the public even if it is not used domestically.

Standards of proof for being famous domestically must be considered together with the concrete event. The following issues could be considered as a standard of proof for being a well-known trademark:

- the trademark's period of use;
- the geographical area of the use;
- intensity of the use;
- the amount of advertising and promotional expenditure; and
- the market share achieved by the trademark.

It is not obligatory for well-known trademarks that are under the scope of the Paris Convention to be registered in order to be protected in Turkey. Contracting parties of the Paris Convention have undertaken to protect well-known trademarks under article 6-bis(1). Well-known trademarks are also protected under the Turkish Commercial Code's unfair competition provisions.

The protection provided to well-known trademarks owners includes protection as a registration barrier, protection as a reason for invalidity and protection against infringement. Well-known trademarks are considered as a relative ground for refusal of a registration. For a well-known trademark to be protected under this clause, registration is not needed. Protection as a reason for invalidity means that if a well-known

trademark is registered by a third party before the Trademark Office, it is possible for the well-known trademark owner to file an invalidity case against the registration. Finally, it is considered an infringement to counterfeit the trademark by using it or a confusingly similar trademark without the consent of the trademark owner. If there is an infringement of a well-known trademark, the well-known trademark owner may prevent such actions according to the Law. However, to benefit from protection against infringement, it is necessary for well-known trademarks to be registered before the Trademark Office, contrary to other protections.

The benefits of registration

8 | What are the benefits of registration?

The scope of rights conferred by a trademark registration is determined under article 7 of the Law. As stated in the article, a trademark right is an exclusive right of the owner that can be claimed against anyone and is absolute. The trademark right takes effect from the date of the registration application. The registration of a trademark is not obligatory for the owner. Unregistered trademarks are also protected under the Turkish Commercial Code's unfair competition and general provisions. However, if the trademark is registered, there is a stronger protection according to the Law. Additionally, for registered trademarks subject to the Law, any claims for enforcement are seen before specialised IP courts.

The registration of a trademark not only allows marks to be distinguished, but also provides wider protection for the owner, such as the exclusive use of the trademark by its owner, protection against infringements and other matters issued in article 7 of the Law. With trademark registration, any sign included in the trademark cannot be used by others on any goods or packaging, and it cannot be registered by anyone else for the same goods and services.

Although the rights conferred to the trademark owner take effect against third parties as of the publication date of the registration, the rights owner could file a claim for damages arising from infringement after the application has been published in the Bulletin. However, the court cannot decide upon the validity of claims raised before the registration is published.

Filing procedure and documentation

9 | What documentation is needed to file a trademark application? What rules govern the representation of the mark in the application? Is electronic filing available? Are trademark searches available or required before filing? If so, what procedures and fees apply?

The necessary documents for the application are stated in article 11 of the Law, and are as follows:

- the applicant's identity;
- a sample of the trademark;
- a list of goods and services subject to the application;
- information showing that the application fee has been paid;
- power of attorney, if the application has been filed by a representative;
- technical specifications according to article 32 if the application has been filed for collective or guarantee trademarks; and
- information showing that the fee of priority right claim has been paid if priority right is claimed.

On each application, only one trademark registration can be issued. However, a single trademark application can cover multiple classes. The applications may be submitted to the Turkish Patent and Trademark Office (the Trademark Office) in Ankara with a written petition or electronically through the website of the Office.

Before the trademark application, it is possible to do a preliminary search on whether the subject of the registration request has been registered or applied for by someone else. Research before the application is not mandatory and can be made by filling in the relevant form and submitting the document showing the research fee to the authority. It is also possible to do the preliminary search manually through the website of the Trademark Office free of charge.

Registration time frame and cost

10 How long does it typically take, and how much does it typically cost, to obtain a trademark registration? When does registration formally come into effect? What circumstances would increase the estimated time and cost of filing a trademark application and receiving a registration?

The registration process of trademarks begins with the application and ends with the registration, as follows:

- Application: this can be done online or using the reservation system. An application takes one day. The required documents stated on the questions below must be submitted and the application fee of 250 lira must be paid.
- Procedural review: this is done if there is any deficiency according to the Law. Completely prepared applications are processed by the Trademark Office as of the application date, hour and minute. If there is a procedural deficiency, the applicant is given two months to rectify the deficiency. If the deficiencies are not rectified within two months, the application is cancelled.
- Review in terms of absolute refusal reasons: this is a review if there is an absolute refusal reason stated in article 5 of the Law. If it is decided the application cannot be registered, the application is rejected for the goods and services subject to the application. If there is no deficiency and the application is not rejected, it is published in the Bulletin.
- Publication in the Bulletin: complete applications are published in the Bulletin. If there is no opposition or objection within two months of the date of publication, the application is sent to the certification service for registration.
- Third-party observations and oppositions: after the publication of the trademark application, anyone can submit to the Trademark Office their observations with grounds and in writing that the trademark application should not be registered. However, only relevant persons can file oppositions concerning a trademark application that was published in the Bulletin within two months of the publication of the trademark application.
- Registration: if the entire process above is successful and the registration certificate fee is paid, the trademark application will be registered, entered into the registry and finally published in the Bulletin. Issuance of the registration certificate takes one to one-and-a-half months after the Trademark Registration Certificate fee has been paid, which in 2020 is 670 lira.

These periods could be shortened if the application is made online. In addition, if the application is made by an attorney or representative, the process will be shortened since they are experienced in and well informed about trademark applications.

Classification system

11 What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed? Are multi-class applications available and what are the estimated cost savings?

The classification system in Turkey is determined in accordance with the Nice Agreement. Turkey became a party to the agreement on 12 July 1995 and adopted an international classification system of goods and services for the registration of trademarks.

Multi-class trademark applications are allowed under Turkish legislation. However, the fee must be paid for each class. If the fee is not paid for each class, the application will be continued only for the class for which the fee has been paid.

Examination procedure

12 What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? Are letters of consent accepted to overcome an objection based on a third-party mark? May applicants respond to rejections by the trademark office?

The Trademark Office first makes a procedural examination of the application to determine if it satisfies the procedural requirements stated in articles 3 and 11 of the Law. After the procedural examination, the Trademark Office determines if there is any deficiency in the application requirements, and if there are absolute grounds for refusal stated in article 5. An application that has fulfilled these conditions is published in the Bulletin. The Bulletin is published online and anyone can access the Bulletin on the website of the Trademark Office, which is beneficial for trademark owners in preventing infringements.

The Trademark Office also examines conflicts between trademarks. Signs that are identical or indistinguishably similar to a registered trademark, relating to identical goods and services or to goods and services of an identical type, will not be registered.

A trademark application that is identical or indistinguishably similar to a registered trademark will not be rejected if there is a letter of consent from the prior trademark owner that allows registration. The letter of consent must be in a special form issued by the Trademark Office for each trademark application and should be notarised.

Applicants and persons who are adversely affected by the Trademark Office's decision have the right to appeal within two months of the notification date of the decision.

Use of a trademark and registration

13 Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

Trademark and service mark applications can be filed without using the trademark before the application and, therefore, the applicant does not have to prove the use of the trademark before the application.

However, not using the trademark for five years for the registered goods and services after the registration may cause the trademark to be cancelled. In addition, alleged infringers may plead that the trademark has not been used for five years in the case of an infringement action.

In such cases, the trademark owner must prove that the trademark is in use in connection with the goods and services for which it is registered.

Rights owners who are nationals or residents, or have an active commercial enterprise in one of the states that are party to the Paris Convention or the Agreement on Establishing the World Trade Organization have the right to priority in Turkey for registering a trademark whose first application is made within a foreign state. The right must be used and the registration application in Turkey must be made within six months of the first application made in the foreign state. Rights owners must submit the document obtained from the component authorities of such states showing the priority right.

Also, rights owners who are Turkish citizens or residing in Turkey, engaging in commercial activities in Turkey, are under the scope of the Paris Convention or the Agreement on Establishing the World Trade Organization, or are citizens of states in which reciprocity is present between Turkey and that state have priority rights if they display any goods or services under a trademark or present the certified reproduction of the trademark at national or international exhibitions in Turkey, or official or officially recognised exhibitions in countries that are parties to the Paris Convention or the Agreement on Establishing the World Trade Organization have priority rights in Turkey.

Markings

14 | What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

Symbols such as TM and [®] are usually used to indicate trademark use or registration. However, the use of such symbols or phrases is optional. There are no clear legal benefits, risks or disadvantages to using such symbols or phrases.

Since the registry is open to the public and registered trademarks can be viewed on the registry, not knowing that a mark is registered is not a ground of defence for the infringing party.

Appealing a denied application

15 | Is there an appeal process if the application is denied?

Applicants can submit an appeal against decisions by a written petition specifying objections to the decisions of the Patent and Trademark Office within two months of the notification date of the decision. It is not possible to file an appeal without specifying all arguments and evidence. The grounds of appeal cannot be changed, and new grounds cannot be added after the two months of the appeal period expire. There is an appeal fee of 370 lira, which must be paid before the end of the two-month period.

Third-party opposition

16 | Are applications published for opposition? May a third party oppose an application prior to registration, or seek cancellation of a trademark or service mark after registration? What are the primary bases of such challenges, and what are the procedures? May a brand owner oppose a bad-faith application for its mark in a jurisdiction in which it does not have protection? What is the typical range of costs associated with a third-party opposition or cancellation proceeding?

An application in which all examination stages have been completed is published in the Bulletin. If there is no opposition for two months, the application is registered. Oppositions regarding the published trademark must be filed within two months of the publication of the

trademark application in the Bulletin. Oppositions must be submitted to the Trademark Office in writing specifying the grounds of the opposition. The opposition fee for published trademark applications is 160 lira.

Relevant persons can ask the Trademark Office for the revocation of a trademark. Revocation of a trademark occurs as a result of reasons that did not exist during the registration phase but appeared afterwards. A revocation request can be submitted any time after registration. Revocation requests are notified to the trademark owner. After the notification, the trademark owner will submit its evidence and respond in one month to the Office. Reasons for the revocation of a trademark include:

- non-use of the trademark;
- the trademark becoming a common (generic) name for the registered goods or services;
- the trademark being misleading; and
- use contrary to technical regulations.

Persons who have interests can request the invalidity of a trademark after registration. The invalidity of a trademark occurs because of reasons that existed at the beginning of the process. The plaintiff will determine the grounds on which the lawsuit will be filed.

To request the invalidity or revocation of a trademark, the trademark must first be registered in the trademark registry of the Trademark Office.

Bad-faith applications can be defined as registrations that are made against commercial integrity rules, to seize someone else's trademark that is known or unknown, or to take advantage of the recognition of someone else's trademark. For registering someone else's trademark to be considered bad faith, the trademark does not necessarily have to be well known. Even if it is not known, registrations that benefit from someone else's trademark and are carried out without the knowledge of the owner are in bad faith. Bad-faith applications are examined on opposition, not ex officio. The invalidity of a trademark registered in bad faith can be decided upon at the request of the real rights owner.

Duration and maintenance of registration

17 | How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

According to the regulations, the protection period is 10 years following the date of application. Renewal of the registration can be made for further 10-year periods at the request of the trademark owner. Renewal applications must be filed within six months of the end of the 10-year period to the Trademark Office with the documentation showing that the renewal fee has been paid. The fee for renewal is 1,630 lira. If the renewal request or payment documentation is not submitted to the Trademark Office within the six-month period, the renewal request can also be made up to six months after the expiry of the protection, provided that an additional fee is paid. There is no need to submit any documentation to prove genuine use of the trademark for renewal.

Surrender

18 | What is the procedure for surrendering a trademark registration?

A surrender request must be submitted to the Trademark Office in writing or by an online waiver form on the website of the Office. The surrender can be partly or wholly. The following documents are required for the surrender:

- the waiver or surrender form on the website of the Trademark Office;
- power of attorney that directly mentions the waiver authorisation;

- statement of the rights holder confirming the waiver of the trademark; and
- a notarised signature circular or a copy of it if the requester is a legal entity.

The expiration of the trademark right upon the surrender is published in the Bulletin. In the case of more than one trademark owner, the request for waiver must be signed by all the owners.

Related IP rights

19 | Can trademarks be protected under other IP rights (eg, copyright or designs)?

The term 'intellectual property' contains the product of human intelligence, intellectual accumulation and creativity. A trademark may also be considered as a product of human intelligence and creativity. As a result, trademarks may be protected under other IP rights.

Trademarks online and domain names

20 | What regime governs the protection of trademarks online and domain names?

Since there is no special provision in Law No. 6769 regarding the protection of the online trademarks, they are protected under the general provisions.

According to article 3/1-v of the Electronic Communications Law No. 5809, internet domain names mean the names that define the internet protocol number used for identifying the address of a website or a computer on the internet. Internet domain names can be registered as a trademark provided they are distinctive. The rights arising from the registration of a domain name and a trademark are different. Since phrases such as .com, .co.uk and .edu are not distinctive, these parts are not under the protection of the trademark law. In Turkey, the Information and Communication Technologies Authority is responsible for managing the domain name system.

LICENSING AND ASSIGNMENT

Licences

21 | May a licence be recorded against a mark in the jurisdiction? How? Are there any benefits to doing so or detriments to not doing so? What provisions are typically included in a licensing agreement (eg, quality control clauses)?

Licences can be recorded at the Turkish Patent and Trademark Office. The licence can be granted as an exclusive or a non-exclusive licence. The proprietor can grant a licence that includes geographical and time limitations, as well as an unlimited licence. The licence can be granted for some of or all the goods and services for which the trademark is registered.

As per Turkish law, the registration of licence agreements is not compulsory and will not affect the validity of the agreements. However, parties that did not record the licence agreement cannot claim their rights granted with the licence agreement against third parties with goodwill.

With agreements, the proprietor typically undertakes:

- to guarantee the validity of the trademark;
- to prevent the influence of third parties on the trademark;
- to renew the trademark registration;
- not to compete; and
- to act against trademark infringement.

The licensee undertakes:

- to use the trademark;
- to ensure the quality of goods and services to be provided under the trademark;
- to advertise the trademark; and
- to notify the proprietor in the case of an infringement.

Assignment

22 | What can be assigned?

The rights for registered or non-registered trademarks can be assigned, including some of or all the goods and services provided, regardless of goodwill.

Trademark rights can be assigned separately, regardless of other business assets, while the transfer of all business assets includes trademarks unless the exclusion of trademarks is stated in the agreement.

Assignment documentation

23 | What documents are required for assignment and what form must they take? What procedures apply?

Licence agreements granted for registered trademarks shall be in written form for validity. However, for registration of the licence, the agreement shall be conducted before the public notary. After the agreement is conducted and the registration fee paid, which is currently 875 lira, the notary will notify the Turkish Patent and Trademark Office for registration. Upon this notification, the Office registers the licence agreement without any further procedure.

The following documents are required for the registration of the licence agreement:

- a request petition including the registration number and the name of the trademark;
- the licence agreement (if the agreement is conducted in a foreign language, an approved translation is required); and
- documents showing that the registration fee has been paid.

Validity of assignment

24 | Must the assignment be recorded for purposes of its validity?

In accordance with Turkish law, the registration of a licence agreement is not compulsory and will not affect the validity of the agreement. However, persons who did not record the licence agreement cannot claim their rights granted with the licence agreement against third parties with goodwill. In other words, the agreement is binding only inter partes.

Security interests

25 | Are security interests recognised and what form must they take? Must the security interest be recorded for purposes of its validity or enforceability?

Trademark rights can be pledged and provided as a guarantee under Turkish law. The pledge and guarantee agreement shall be in written form and registration is not required for its validity. However, according to doctrine, if the respective agreement is not registered, the rights granted cannot be claimed against third parties with goodwill. The opinion arisen from the comparison made between the transfer and licence agreements that are in parte if not registered to the registry and pledge agreement. As a result of the comparison, doctrine concludes that the agreements are similar in nature. Therefore, the necessity to register transfer and licence agreements is also present for pledge agreements to protect the goodwill of third parties.

ENFORCEMENT

Trademark enforcement proceedings

- 26 | What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

Trademark rights owners can seek preliminary injunctions, civil actions and criminal actions against infringers.

Preliminary injunction and provisional seizure at customs

Trademark owners and other persons who have the authority to file a lawsuit may seek a preliminary injunction provided they prove that the subjected use or potential use of the trademark constitutes or will constitute infringement.

The claimant may request the court to prevent or cease the actions constituting infringement, seize the goods or the tools exclusively used for manufacturing these goods, and provide security to compensate for any damage.

Besides the preliminary injunction ordered by the court, customs authorities can cease the importation and exportation of the infringing goods and seize such goods if an infringement of rights is likely to occur.

Civil action

Civil actions regarding trademarks will be held before the Civil Courts of Intellectual and Industrial Property Rights.

Trademark owners or persons who are authorised to file a civil action can request the court to:

- determine the existence of an infringement;
- prevent possible infringement;
- cease the infringing actions; and
- reinstate the rights owner and compensation for material and moral damage.

Criminal action

Criminal actions regarding trademarks are held before the Criminal Courts of Intellectual and Industrial Property Rights.

People that produce, import, export, possesses, transport, store goods, provide services, put those goods and services on the market or buy those goods or services for commercial purposes while infringing a trademark right through quotation or likelihood of confusion shall be sentenced from one year to three years of imprisonment and punished with a judicial fine of up to 20,000 days.

In addition, people that remove signs indicating a trademark on a product shall be sentenced from one year to three years of imprisonment or punished with a judicial fine of up to 5,000 days.

Finally, people that make a disposition by transferring, licensing or pledging a trademark right owned by another person without authorisation shall be sentenced from two years to four years of imprisonment and punished with a judicial fine of up to 5,000 days.

For criminal sanctions to be imposed on the infringer, the respective trademark must be registered in Turkey.

Procedural format and timing

- 27 | What is the format of the infringement proceeding?

Civil action

Intellectual property disputes are subjected to compulsory mediation if the subject of the lawsuit is monetary. In such cases, the claimant

applies to mediation before filing the lawsuit, and the mediation process shall conclude with non-agreement for filing the lawsuit. The mediation process can take one to eight weeks, depending on the parties' willingness to compromise.

After initiating the lawsuit against the infringer, the term of the proceedings before the first-instance court is approximately two to three years. Turkish law provides a two-staged appeal process, consisting of regional appeal courts and the Court of Cassation. Appeal proceedings can take one to two years at the regional courts stage and one to two years at the Court of Appeals stage.

Claims exceeding 500,000 lira are subjected to a written trial procedure, while others are subjected to a simple trial procedure. The time period of the simple trial procedure is usually shorter than the written trial procedure. The parties may submit to the court any document evidencing the ownership and the infringement, including witnesses' statements. The court also can decide on discovery and expert opinion. Conducting a discovery or obtaining an expert opinion may cause the time frame of the proceedings to become closer to the maximum threshold estimated above.

Criminal action

To initiate a criminal investigation against the infringer, a criminal complaint is filed to the Chief Prosecutor's Office. After the criminal investigation, the prosecutor will decide whether to file a criminal lawsuit against the infringer. The investigation stage is approximately one year. A person whose trademark right is infringed may also request the criminal court to seize the infringing goods before filing a criminal complaint.

After filing the criminal lawsuit, the court can use and request any evidence including discovery, testimony and experts for concluding the lawsuit. The criminal lawsuit stage is approximately one year.

Burden of proof

- 28 | What is the burden of proof to establish infringement or dilution?

In general, the claimant must prove that the subjected use or potential use of the trademark constitutes or will constitute infringement.

In indemnification cases, the claimant must also prove the monetary damage arising from the infringement. However, according to the latest jurisprudence of the Court of Cassation, if proving the monetary damage cannot be expected from the claimant, the court shall determine a convenient amount of compensation.

In addition, the court presumes that the *causa proxima* between the infringement and the damage is present. Therefore, the defendant must prove the contrary.

Standing

- 29 | Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

Rights owners may seek all kinds of remedies against an infringement, regardless of the licences granted for the trademark. In addition, the owners of an exclusive licence may seek remedies unless the contrary is agreed in the agreement.

Non-exclusive licence owners may seek remedies against the infringer provided that the following conditions are met:

- the right to seek remedy should not be restricted in the agreement;
- written notification has been made to the rights owner regarding the infringement; and
- the rights owner does not seek remedy against the infringement within three months of the service of the notification.

Border enforcement and foreign activities

30 | What border enforcement measures are available to halt the import and export of infringing goods? Can activities that take place outside the country of registration support a charge of infringement or dilution?

Customs can cease the importation and exportation of infringing goods and seize such goods upon the request of the rights owner. In addition, customs can seize goods if the goods are likely to infringe trademark rights to ensure that the trademark owner can seek remedies for the infringing goods, and notify the seizure to the trademark owner.

Upon service of the notification, the owner of the rights shall obtain a preliminary injunction decision from the civil courts or criminal courts regarding the goods within three days for perishable goods and 10 days for non-perishable goods.

Discovery

31 | What discovery or disclosure devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

The rights owner may request the courts to decide on the determination of evidence before filing a lawsuit. Within the scope of the determination request, the court may decide on discovery or to send writs to the relevant parties for disclosure of the relevant evidence. In the case of discovery, experts are assigned by the court.

The parties also can assign an expert for the discovery without applying to the court. However, in such cases, the infringer or third parties are not obliged to allow the discovery.

During the main trial against the infringer, the courts usually decide to conduct a separate discovery in both cases. However, the evidence found in a discovery conducted under the supervision of a court is more dependable during the trial.

The rights owner can also seek to obtain evidence from parties outside the country, and this evidence is dependable. In such cases, the discovery request shall be made in accordance with the regulations of the relevant country.

Timing

32 | What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

Preliminary injunction requests are usually completed within one to two weeks.

Actions filed before a civil court are completed in approximately two to three years, including the mediation stage. If the first-instance court's decision is appealed to the regional courts of appeal, the regional court stage will approximately take one to two years. The parties can also appeal the decision to the Court of Cassation, and this stage takes approximately one to two years. Overall, the finalisation of a civil action regarding trademark rights may take four to seven years.

The time frame for a criminal action at first instance is approximately two years, including the investigation stage. If the decision is appealed to the regional courts of appeal, the appeal stage may take approximately one to two years. If the decision of the regional courts is appealed to the Court of Cassation, the time frame is one to two years. Overall, the finalisation of a criminal action regarding trademark rights may take four to six years.

Limitation period

33 | What is the limitation period for filing an infringement action?

In cases where infringements arise from a contract between the rights owner and an infringer, the time limit for filing a civil action is 10 years. If an infringement constitutes a tort, the time limit is two years after the claimant becomes aware of the damage and the identity of the infringer. Otherwise, the time limit is 10 years after the commencement of an infringement.

Where an action also constitutes a crime, and the time limit for the criminal act is longer, the longer period will apply.

If the infringed trademark is not registered in Turkey, the time limit is set by the Turkish Commercial Code is one year after the claimant became aware that an action could be filed against the infringement. Otherwise, the time limit is two years after the right for filing a lawsuit has occurred.

Litigation costs

34 | What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

A person that files a civil lawsuit must pay an application fee of 54.40 lira. The claimant also pays a decision fee of 54.40 lira. If the claim is monetary, the decision fee is 68.31 per thousand lira of the disputed amount.

The claimant will also pay for legal expenses, including notification expenses and expert expenses.

At the end of the trial, the losing party must pay these expenses to the successful party along with the attorneys' fees (which are decided by the court and determined by the Turkish Bar Association).

Appeals

35 | What avenues of appeal are available?

Turkish law provides a two-staged appeal process consisting of regional appeal courts and the Court of Cassation. After the first-instance stage, the parties can appeal decisions for disputes exceeding 5,390 lira to regional courts of appeal. Decisions of the regional courts of appeal can be appealed to the Court of Cassation if the disputed amount exceeds 72,070 lira. The Court of Appeals may hold a hearing if the disputed amount exceeds 108,120 lira.

Defences

36 | What defences are available to a charge of infringement or dilution, or any related action?

The defendant may claim that the trademark is used within the scope of legal use. Legal use includes the use of the names and addresses of real people, explanations regarding the type, amount, purpose, value, production place and time of the goods and services, provided they are within the ordinary course of trade.

The defendant may also plead:

- that the trademark was used by the defendant before its registration;
- joint ownership;
- use of the secondary and generic elements of the trademark;
- that permission was granted by official authorities regarding the use of the trademark;
- that the trademark has been used within the registered commercial title of the defendant;
- that the trademark is not used within the purposes of branding; and
- that the trademark has been used as a common noun and freedom of speech.

Remedies

37 | What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?

The successful party can request the enforcement offices to implement the decision of the court. The court can decide on the following, if it is requested by the claimant:

- determining the existence of an infringement;
- preventing possible infringement;
- ceasing infringing actions;
- reinstating the rights owner and compensation for material and moral damage;
- seizing the infringing goods or goods requiring a penalty, as well as tools exclusively used for manufacturing these goods, without preventing the production of products other than the infringing products;
- granting property right to the claimant on products, devices and machines seized; and
- taking measures to prevent the continuity of infringement, in particular, changing the shapes of products and instruments such as devices and machines seized, erasing the trademarks on them or destroying them if it is essential for preventing the infringement of industrial property rights, at the expense of the infringer.

In the case of a monetary claim, the execution offices will seize the assets of the losing party and sell a sufficient amount of assets for debt enforcement.

In addition, the parties may seek a preliminary injunction or preliminary attachment after the ruling of the court to ensure the implementation of the court's decision.

ADR

38 | Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?

Alternative dispute resolution is available under Turkish law. The parties can sign an arbitration or mediation clause. However, for filing a monetary lawsuit regarding trademark rights, applying to mediation is compulsory.

Results of the mediation and arbitration conducted in Turkey are considered a verdict, and the parties can enforce the decision without filing an enforcement and recognition action. The costs of arbitration and mediation are usually lower than legal costs in Turkey.

If the arbitration is conducted outside Turkey, the decision of the arbitration tribunal cannot be enforced without filing an enforcement and recognition action. Enforcement and recognition actions can take approximately one year.

UPDATE AND TRENDS

Key developments of the past year

39 | Are there any emerging trends, notable court rulings, or hot topics in the law of trademark infringement or dilution in your jurisdiction?

The Turkish Patent and Trademark Office has released the 2019 edition of the Trademark Examination Guide, which stipulates the criterion used by the Office while examining a trademark before registration.

The guide stipulates that the trademark subjected to the application shall be evaluated with the goods and services to be provided under the application while determining the 'descriptiveness' and 'distinctiveness' of the trademark. In addition, the perception of targeted consumers shall also be evaluated in such situations.

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The guide stipulates that the Turkish Trademark and Patent Office will conduct an ex officio evaluation if the trademark subjected to the application is identical or indistinguishably similar to another registered trademark.

Coronavirus

40 | What emergency legislation, relief programmes and other initiatives specific to your practice area has your state implemented to address the pandemic? Have any existing government programmes, laws or regulations been amended to address these concerns? What best practices are advisable for clients?

Within the scope of the covid-19 measures, electronic systems named E-PATS and E-TEBS were introduced. Applications regarding trademarks, including new registration applications or the submission of documents to the Turkish Patent and Trademark Office, can be made electronically using E-PATS. E-TEBS, on the other hand, is a new electronic notification system that allows notifications by the Turkish Patent and Trademark Office to be made electronically to attorneys and other relevant persons registered in the system.

The time limits for objections to the publication, objections to the decision, and renewal and preference requests were extended until 30 April 2020. In addition, for transactions with 15 days or less remaining until the expiry date as of 1 May 2020, 15 days were added to the transaction period.

The time limits for applications to be made to the Civil Courts of Intellectual and Industrial Property and ongoing proceedings were also suspended from 13 March 2020 until 16 June 2020. Time limits and proceedings for preliminary injunctions and preliminary attachments and criminal time limits for trademark infringements were excluded.

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