

Trademark: Relative Grounds for Refusal

Introduction

Industrial Property Code (“IPC”, Law No. 6769) which has come into force in January 2017, regulates relative grounds for refusal in trademark registration. Article 6 of IPC provides several circumstances where a third party has the right to raise objection to prevent trademark registration. Article 6 is in line with the EU Directive 2015/2436 of the European Parliament and of the Council (“EU Directive”) which sets the procedural rules for registration of trademarks.

1

Relative grounds for refusal of trademark registration are not taken into consideration *ex officio* by Turkish Patent and Trademark Office (“TPTO”). Therefore, the relevant persons should raise an objection over the application of trademark registration for the examination that will be conducted by TPTO.

Pursuant to Article 18 of IPC, relevant persons should raise a written objection to TPTO within two months from the publication of the trademark application in the trademark bulletin.

Likelihood of Confusion

An application for registration of a trademark shall be refused upon an objection where there is a probability of misunderstanding on the part of the public, including the possibility that the registered trademark or an earlier application for registration of a trademark is

identical or similar with the application and, furthermore, the goods or services are identical or similar with the application.

In light of judicial decisions and doctrine, criteria that should be taken into consideration while evaluating whether there is a confusion or not, are as follows:

- The whole impression of the trademarks on the customer,
- The addressed consumer group for the trademark,
- The distinctive power of the previous trademark,
- The recognition of the previous trademark,
- Remindful parts of trademarks that consist of words and figures or names and surnames,
- The similarity between the trademarks and the goods or services.

Commercial Agent's or Representative's Application

2

If the commercial agent or representative files an application to register the same or indistinguishable copy of a trademark on his/her behalf without the permission of the trademark owner and without a justified reason, the application is rejected upon the objection of the trademark owner.

Objection of Right Owner of an Unregistered Trademark

It is exceptionally accepted that the trademark right can be obtained and protected by the prior use in the course of trade without relying on registration. Pursuant to IPC, if the right is obtained for an unregistered trademark or sign used during trade before the application date, the new application is rejected upon the objection of the right owner.

Protection for Well-known Trademarks

An application for registration of a trademark that is identical or similar to well-known trademarks that are within the scope of Article 6 bis of Paris Convention is refused upon an objection.

Infringement of Third-Party IP Rights

A trademark registration application which includes a person's name, trade name, photograph or infringes the copyright or any other intellectual property right is refused by TPTO with the objection of the right owner. Unlike other grounds for refusal, in this case the trademarks must have been registered before the new application.

Collective Marks and Guarantee Marks

Collective marks and guarantee marks can be renewed, like other trademarks, after the ten-year protection period expires. A trademark application made within three years from the end of protection period for the same or similar with a collective mark or a guarantee mark in respect of same or similar goods or services, is rejected upon the objection of the previous right holder.

Non-Renewal of Registered Trademarks

3

An application for registration of a trademark made within two years from the end of the protection period due to non-renewal of the registered trademark which is same or similar in respect of same or similar goods and services is rejected upon the objection of the previous trademark owner.

Unlike the provision concerning collective marks and guarantee marks, the objection period is two years and the condition for raising an objection is the use of the trademark during this two-year period.

Applications Filed in Bad Faith

Trademark applications filed in bad faith are among the absolute grounds for refusal under Article 4/2 of the EU Directive. According to IPC, however, application for registration of trademark made in bad faith will be rejected upon the objection. A registration contrary to the purpose and functions of the registration in cases where the trademark owner intends to suppress, blackmail or block *bona fide* third parties is regarded as bad faith, according to court precedents.

GURULKAN ÇAKIR AVUKATLIK ORTAKLIĞI

Polat İş Merkezi, Offices 28-29
Mecidiyeköy 34387
Istanbul, TURKEY

T +90 212 215 30 00
M info@gurulkan.com
W www.gurulkan.com



Gurulkan Çakır Avukatlık Ortaklığı ("Gurulkan Çakır") is an attorney partnership registered at Istanbul Bar Association with a license number 105 and at the Union of Turkish Bar Associations with a license number 206.

This publication provides general information only and should not be relied upon in making any decision. It is not intended to provide legal or other advice. Gurulkan Çakır and its partners will not be liable for any loss or damage arising from reliance being placed on any of the information contained in this publication.

Before acting on any information, readers should consider the appropriateness of the information provided herein, having regard to their legal and financial status, objectives and needs. In particular, readers should seek independent professional advice prior to making any decision.

This publication may not be reproduced, in part or whole, by any process without prior written consent of Gurulkan Çakır.
