



G Ü Z E L O Ğ L U

attorneys-at-law | hukuk bürosu

10 Important Points About Trademark Protection in Turkey

By Fatma Esra Güzeloğlu* & Abdülkadir Güzeloğlu

In this article we will elaborate on ten important points regarding trademark law and practice in Turkey.

1. General Overview	2
2. How can I register my trademark in Turkey?	3
3. I am not a citizen of Turkey; can I register my trademark there?	4
4. Under what conditions would my trademark application would be refused?	4
5. What rights trademark registration confers on me?	7
6. How long does it take to register my trademark and how much it costs?	7
7. My trademark is being infringed in Turkey, what can I do?	8
8. Is my trademark legally protected in Turkey even if it is not registered there? ..	8
9. What are the conditions for a valid license agreement?	8
10. What are the topical issues concerning IP Law in Turkey at the moment?	8

* Fatma Esra Güzeloğlu is a lawyer registered at Istanbul Bar Association and a licensed trademark attorney registered at the Turkish Patent Institution.

1. General Overview

Turkey, with its modern legislation that it is in parallel with the EU acquis, knowledgeable administrative body within the Turkish Patent Institution (“TPI”), specialized courts to settle intellectual property (“IP”) related disputes in a speedy and efficient fashion has a well-operating IP system.

Although the said system provides a solid legal infrastructure whereby parties may efficiently register their trademarks and may duly resort to legal channels as necessary, there is still much to do in terms of educating public on the legal consequences of trademark infringements. According to the report published by the Organisation for Economic Co-operation and Development (“OECD”)², Turkey comes third in terms of “where most fake goods originate” in the world, following China and Hong Kong. Hence in order to protect one’s trademark in Turkey, latter should be aware of how to register its trademark as well as respective rights and recourses available to them.

Turkey is a signatory to the following **trademark related** international agreements:

- Convention Establishing the World Intellectual Property Organization (“**WIPO**”), 1967
- Agreement establishing the World Trade Organization (“**WTO**”), 1995
- **Paris Agreement**, 1883
- **Trademark Law Treaty**, 1994
- **Singapore Treaty** on the Law of Trademarks, 2006 (signed, yet to be ratified)
- **Madrid Protocol**, 1989
- **Nice Agreement** Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, 1957
- **Vienna Agreement** Establishing an International Classification of the Figurative Elements of Marks, 1973

² OECD/EUIPO (2016), *Trade in Counterfeit and Pirated Goods: Mapping the Economic Impact*, OECD Publishing, Paris. DOI: <http://dx.doi.org/10.1787/9789264252653-en>

2. How can I register my trademark in Turkey?

Trademarks are registered and protected according to the provisions of the Executive Order No.556 on the Protection of Trademarks (“Executive Order”).

Registration process is initiated through an application to the TPI. Before applying for registration of your trademark, a thorough research should be conducted in order to see if there are any potential grounds for refusal for that specific mark in absolute or relative nature. It is a very important step in order to save time and cost. Pursuant to the outcome of the research, applicant may choose to seek registration keeping the mark as it is or make certain changes on the mark, if possible, depending on the ground for refusal that may potentially jeopardize registration.

Once the research is completed, the application file should be submitted to TPI encompassing all the required documents. TPI notifies the applicant in case of an incomplete application and gives 2 months period to submit any missing documents, should there be any.

If the application is not refused entirely or partially by the TPI, i.e. the file is found to be complete; the trademark is found to be in compliance with absolute grounds for refusal and the applicant is found to be eligible for application (as in Question 3); the application is published in the Trademark Bulletin which is published by the TPI periodically.

Upon its publication in the Trademark Bulletin, application is open for objections for 3 months period. When TPI examines the objections, it may request arguments and counter-arguments from both parties as many times as it deems necessary. TPI may refuse or accept the objection entirely or partially.

If an application is found to be complete and on which there were no objections or any such objections were eventually denied, then it will be registered as a trademark. The applicant will receive a “Trademark Registration Certificate”.

3. I am not a citizen of Turkey; can I register my trademark there?

All natural and legal persons who are domiciled or who have industrial or commercial establishments within Turkey, or the persons who have application rights resulting from the terms of the Paris Convention, Bern Convention or the Agreement Establishing World Trade Organization as well as natural or legal persons who are nationals of states which provide legal or de facto protection to the nationals of the Turkish Republic (reciprocity principle) may register their trademark in Turkey.

Also it should be noted that since Turkey is a signatory to Paris Convention, it is possible to claim **priority** on the basis of a first application filed in one of the Contracting States.

4. Under what conditions would my trademark application would be refused?

A thorough research should be conducted before making an application in order to see whether or not the respective trademark falls into one of the grounds for refusal for registry. There are grounds for refusal of “absolute” and “relative” nature.

Absolute grounds for refusal³ are *sua sponte* taken in to consideration by the TPI, these are:

1. A trademark must consist of a sign that is graphically representable such as words, personal names, designs, letters, numerals, shape of the goods or their packaging as well as any descriptive means;
2. A trademark must be capable of being published and reproduced by printing;
3. A trademark must be capable of distinguishing the goods and services of one undertaking from the ones of other undertakings;
4. A trademarks must not be identical or confusingly similar with an *earlier trademark*⁴ in respect of an identical or same type of product or services;

³ Article 7 of the Executive Order No.556

5. A trademark must not *exclusively* or *primarily* consist of signs or indications which serve in trade to indicate the kind, characteristics, quality, intended purpose, value or geographical origin or specify the time of production or other characteristics of the goods or services;
6. A trademark must not *exclusively* or *primarily* consist of signs or names widely used by all parties in trade practice or used in order to distinguish specific groups of craftsmen, tradesmen or professionals;
7. A trademark must not be composed of signs containing the shape of a good or the shape that gives the substantial value to a good which results from the nature of such good or which is necessary to obtain a technical result;
8. A trademark must not deceive the public as to the nature, quality, place of production or geographical origin of the goods or services;
9. A trademark must not be used without the authorization by the competent authorities and hence are to be refused pursuant to Article 6ter of the Paris Convention;
10. A trademark must not contain badges, emblems or escutcheons other than those covered by Article 6ter of the Paris Convention and which are of particular public interest, unless the consent of the appropriate authorities to their registration has been given;
11. A well-known trademark pursuant to Article 6bis of the Paris Convention must not be used without the authorization by their owners;
12. A trademark must not contain religious values or symbols; or
13. A trademark must not be contrary to the public policy and moral values.

An exception is provided for trademarks which were being used before the date of their registration and have acquired a distinctive character through their usage in relation to the respective goods or services for which the registration is requested. In such case, grounds listed in (1),(2),(3), (5) and (6) shall not constitute a ground for refusal.

⁴ **Earlier trademark** is used to describe an already registered trademark or a trademark with an earlier application date than the one sought to be registered.

As per the **relative grounds for refusal**⁵ ; they are taken into consideration once an objection is filed within 3 months from the date of publication of the application in the Trademark Bulletin of the TPI. Any person may file an objection.⁶

1. Where a trademark in question is identical to an *earlier trademark* for the identical goods or services;
2. Where there is a likelihood of confusion for the public in terms of associating the trademark in question with an earlier trademark because they are identical or similar and the protection is sought for the identical or similar goods or services;
or
3. Where the trademark in question is identical or similar to an earlier trademark but relates to different goods or services, it may still be refused upon the objection of the *owner of an earlier trademark* provided that registration may result in an unfair advantage to the applicant in question due to the reputation the earlier trademark enjoys amongst the public, harm the prestige of the earlier trademark or damage its distinctive characteristic.
4. Where an agent or a representative of an owner of a trademark has applied for registration under his own name without the owner's consent and without a valid reason;
5. Where the rights to the respective sign have been acquired prior to the date of application in question or the date of priority claimed in the application;
6. Where the sign confers on its owner the right to prohibit the use of a subsequent trademark;

⁵ Article 8 of the Executive Order No.556

⁶ If such person has an earlier application or registration at the TPI; considers its mark to be a well-known mark for different goods or services, has been using the mark in question without any registration or application; believes that the subject matter application will lead to confusion with its earlier IP rights (i.e. copyright, trade name...) or thinks the application is made in bad faith.

7. Where the trademark contains the name, photo, copyright or any other intellectual property right of another person than the applicant;
8. Where the trademark is identical or similar to a collective or a guarantee mark and the application in question is made within less than three years from the date of expiry of such collective or of the guarantee mark;
9. Where the trademark is identical or similar with an earlier trademark for identical or similar goods or services that is expired due to non-renewal and the application in question is made within less than two years of the expiry date.

5. **What rights trademark registration confers on me?**

The owner of a trademark is entitled to prevent all third parties from using the trademark without his/her consent. Only exception to this is where a third party uses its own name, address or specifications as to the characteristics, quality, quantity, intended purpose, value, geographical origin, time of production or other characteristics of the goods or services; provided that it is used in good faith and in relation to their relevant commercial or industrial area of practice.

The protection is provided for **10 years** and the rights conferred are perpetual as long as renewed periodically.

6. **How long does it take to register my trademark and how much it costs?**

Fees charged by the TPI may be accessed at the [link](#). In addition, should you decide to work with a trademark attorney, there will be additional fees for the services procured. Please keep in mind that if you are domiciled outside of Turkey, you can only be represented by a trademark attorney and may not apply for registration personally.

The trademark registration process may usually be completed within a year if the application file is submitted in complete and there be no objections. The process may take longer in case of objections as to why the trademark in question should be refused.

7. My trademark is being infringed in Turkey, what can I do?

Depending on the nature of the infringement, both civil and/or criminal lawsuits may be initiated concerning a trademark infringement in Turkey. A party may resort to competent specialized national courts to bring a civil lawsuit and/or file a criminal complaint to give rise to a criminal case.

Also, an **interim measure** is an important tool to minimize the damage before a judgement is rendered in a trademark infringement case. If a person proves that his/her trademark is being infringed in Turkey or there are actual and effective endeavors currently being made for such result, he/she may request an interim measure to secure the effectiveness of an already initiated lawsuit or one to be initiated.

8. Is my trademark legally protected in Turkey even if it is not registered there?

Unregistered trademarks of foreign origin may also be protected in Turkey provided that they are well-known in Turkey. A well-known trademark pursuant to Article 6bis of the Paris Convention cannot be used without the authorization by their owners. Also, unfair competition provisions found in the Commercial Code No: 6102 may be invoked by the owner of an unregistered mark.

9. What are the conditions for a valid license agreement?

In order for a trademark license agreement to be valid in Turkey, it must be concluded in writing. However, the license agreement must also be registered at the TPI in order to be asserted against third parties in good faith. It should also be noted that a license agreement concerning a trademark is *not exclusive* unless otherwise agreed by the parties.

10. What are the topical issues concerning IP Law in Turkey at the moment?

Long-awaited law on industrial property rights was recently approved by the appointed commission and the approved text is currently on the agenda of the Grand National

Assembly of Turkey (“TBMM”) since May 2016 expected to be open for parliamentary discussions in the upcoming months.

Currently, industrial property rights are regulated under several laws and executive orders. The purpose of the law is to gather all different regulations under one roof in order to provide a uniform, effective and up to date legal structure.

Should you have any questions on [trademark law](#) in Turkey or [IP law](#) in general, you may contact us at info@guzeloglu.legal