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Court of Cassation reopens debate on recordation of well-known trademarks

Turkey - [Gün + Partners](#)

- **The Court of Cassation has held that the Patent and Trademark Office has no authority to create and maintain a registry for the recordation of well-known marks**
- **Well-known status must be evaluated on a case-by-case basis**
- **The finalisation of this decision will have significant repercussions**

In a recent decision that challenges longstanding precedents, the Court of Cassation has concluded that the Turkish Patent and Trademark Office has no authority to create and maintain a registry for the recordation of well-known trademarks.

Background

The plaintiff's original application to have its trademark recorded as well known was rejected by the office's Re-examination and Evaluation Board. The plaintiff then filed a cancellation action against the board's decision before the Ankara Civil IP Court, which decided to partially accept the court action on the grounds that the plaintiff's mark is well known in the relevant business field. The decision was then appealed before the Ankara District Court, but the appeal was dismissed. Following this, the Ankara District Court's decision was appealed before the Court of Cassation.

Decision

On 5 February the Court of Cassation issued its decision (2019/2980 E - 2020/991 K) that the Patent and Trademark Office does not have the authority to create a registry for the recordation of well-known trademarks according to existing law; in addition, well-known status must be evaluated on a case-by-case basis. Finally, the court concluded that the plaintiff had no legal interest in applying to the office for the recordation of its mark as well known and subsequently filing a cancellation action. Accordingly, the Court of Cassation has sent the case back to the IP Court.

Comment

It is now the IP Court's turn to decide whether to comply with the Court of Cassation's decision. If it does – and the new decision becomes final without appeal or is also upheld by the Court of Cassation upon a possible appeal – then the decision will become final. However, if the IP Court maintains its former decision, then the General Assembly of the Court of Cassation will have the final word on any possible appeal.

The Court of Cassation concluded in its various former decisions that the Patent and Trademark Office is authorised to deal with proceedings for the registration and protection of trademarks in a broader sense and to determine the criteria for well-known trademarks. It further stated that it is not possible to file a court action to determine whether a trademark is well known before an application is filed at the office and the results of the recordation process are received. Following these precedents, the office commenced processing applications for the recordation of well-known trademarks. Before starting this practice, it had once published a special bulletin in 1997, in which well-known trademarks were announced.

In addition, the Court of Cassation also accepted in its earlier decisions that trademark owners have a legal interest in filing court actions for a determination that their marks are well known because this provides broader protection from potential infringement and discourages applications that would cause confusion and take unfair advantage of the reputation of the well-known mark. However, with this recent decision, it was accepted that there is no legal interest in filing a court action to cancel the office's decision with regard to the recordation of a well-known mark, as the office is not authorised to maintain such a register.

While the reasoning that well-known status should be examined on a case-by-case basis is entirely correct, the office's record of well-known marks is not binding on courts in practice and trademark owners arguing that their trademark is well known are required to prove their arguments. On the other hand, the regulations did not change in essence following the precedents set by the Court of Cassation from 2004; a fairly established practice has now been developed and implemented over the last 15 years. The practice demonstrates that there is a clear benefit for owners of well-known marks in a register being maintained, as otherwise examiners have to deal with dossiers of evidence when assessing well-known trademark claims, while trademark owners have the burden of proving the well-known status of their marks in each case, while also having to deal with oppositions.

The finalisation of this decision will have significant repercussions. The Patent and Trademark Office may completely cease the recordation of well-known trademarks or there may be a new regulation explicitly authorising the office to record well-known trademarks. Until then, any reversal of the decision will likely lead to considerable uncertainty as to the status of trademarks that were already recorded as well known by the office.

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