



Change to Recordal of Well-Known Marks Implemented

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November 19 2007 | Contributed by Gün + Partners

Intellectual Property, Turkey

In light of a recent decision of the Court of Appeals, the Turkish Patent Institute (TPI) has changed its practice with regard to the categorization and recordal of well-known marks.

Turkey is a party to the Paris Convention for the Protection of Industrial Property and the Agreement on Trade-Related Aspects of Intellectual Property Rights, both of which grant special protection to well-known marks. Turkey has also incorporated provisions on the protection of well-known marks into Trademark Decree-Law 556.

In 1997 the TPI adopted a policy of recording well-known marks by way of either a direct application from a mark owner or a declaration from the courts. The TPI refers to this list when reviewing applications for absolute grounds of refusal. Once a trademark is recorded as well known, the owner does not have the burden of proving the well-known status of its mark in opposition or appeal matters before the TPI.

In 2005 the TPI altered its practice of recording well-known marks following the enactment of Law 5000 on the Foundation and Duties of the TPI. The TPI established two categories of well-known mark: those that are well known in the relevant sector and those that are generally well known. It then began accepting applications to register marks in either category. The TPI examined the applications under its own criteria, purportedly based on World Intellectual Property Organization recommendations on the recognition of well-known trademarks.

Under these criteria, recorded marks that were well known in the relevant sector were protected against third-party registration of similar marks only in relation to goods or services similar to those covered by the well-known mark. On the other hand, recorded marks that were generally well known were protected against any third-party registration of a similar mark regardless of the class of goods or services involved.

However, as of August 2007 the TPI has abandoned its practice of recording marks that are well known in the relevant sector. This change follows a Court of Appeal decision issued on May 4 2007 (2006/427).

In that case, the appellate court upheld an earlier ruling in which a specialized IP court in Ankara cancelled the TPI's decision to recognize the trademark ASELSAN as a well-known mark in the relevant sector. The TPI's finding contradicted the applicant's claim that the ASELSAN mark is generally well known. The IP court stated that the decree-law does not provide for separate categories of well-known trademark. Once a mark meets the

minimum conditions for well-known status, it should be protected in all circumstances against third-party registration of a similar mark in relation to any class of goods and services. Accordingly, the court ruled that the TPI's decision to develop two categories of protection for well-known marks was incorrect.

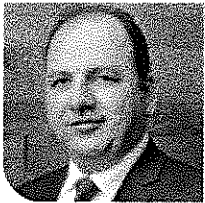
As of August 2007 the TPI will record all relevant well-known trademarks in one category. Any marks previously recorded as well known in the relevant sector will now be recorded as well-known marks. Any conflicts that arise following this move will be resolved on a case-by-case basis.

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