

Turkey: opposition to trademark applications under the Madrid System and the non-use defence

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In this Article we highlight a recent update in relation to the practice of the Turkish Patent and Trademark Office ('Turkish Trademark Office'), with regard to the Madrid Agreement Concerning the International Registration of Marks ('Madrid Agreement') and Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks ('Madrid Protocol').

The WIPO Madrid System

Turkey is a member of the World Intellectual Property Organization ('WIPO') Madrid System, which is based on the Madrid Agreement and the Madrid Protocol. Accordingly, international trademark applications filed through the Madrid System may include Turkey among the designated countries.

According to Article 5 of the Madrid Agreement and Article 5 of the Madrid Protocol, international trademark applications filed through the Madrid System and national applications filed directly before a local trademark office should be treated equally, especially in terms of grounds for refusal of the application. Accordingly, any application refused by any country under the Madrid System must correspond with the grounds of refusal that apply to national applications filed directly before the local trademark office, including a refusal based on the opposition to proceedings initiated by any third party.

However, until recently, the principle of equal treatment between local and international trademark registration applications was not applicable in Turkey in terms of filing a counter statement to a notice of opposition.

The non-use defence in counter opposition

In a counter statement to a notice of opposition in Turkey, it is typical for an applicant to rely on the non-use defence whereby the applicant requires the opponent to prove genuine use of the trademark based on which the notice of opposition was filed. Such defence is possible if the opposition is based on the opponent's prior similar trademark registration, under certain conditions.

The non-use defence is of significant importance because absence of genuine use of the opponent's trademark, or the inability of the opponent to submit evidence proving such genuine use (whether directly by the opponent or through a licensing arrangement), could potentially lead to the opposition's proceedings being dismissed.

Recent compliance with the Madrid Agreement by the Turkish Trademark Office

As per the previous practice by the Turkish Trademark Office, the notification of opposition against the international trademark application was sent to WIPO after a decision was taken by the Turkish Trademark Office in the opposition proceedings, without giving the applicant of the international trademark application a chance to file a defence.

This practice practically deprived the applicant from defending its trademark application in the first opposition stage before the Turkish Trademark Office. Additionally, it made it almost impossible for the applicant to use the defence of non-use because this defence can only be used when filing a counter statement in the opposition proceedings before the Turkish Trademark Office, and cannot be filed later within the appeal before the Turkish Re-examination and Evaluation Board. As such, for a period of two months after publication in the trademarks journal the applicant should actively monitor the trademark application in Turkey, in order to respond to any opposition filed against the trademark application as otherwise, an official notification from the Turkish Trademark Office may not be forthcoming.

Recently, although without an official announcement by the Turkish Trademark Office, this practice changed. Now, prior to issuing a decision, the Turkish Trademark Office would notify the applicant to allow the applicant to defend the trademark application and use the non-use defence where applicable, equal to national applications. This new practice comes in line with other previous improvements in relation to trademark protection in Turkey. Such improvements include recognition of product groups within class 35 back in 2011 [1], and issuing Law No. 6769 of 2016 on Industrial Property ('Industrial Property Law'). The Industrial Property Law came into force on 10 January 2017 and allows for the registration of sound and colour trademarks as well as improved trademark protection by including new criminal provisions for trademark infringements [2].

¹<https://www.tamimi.com/law-update-articles/change-in-turkey-trademark-practice/>

²https://www.wipo.int/news/en/wipolex/2017/article_0004.html

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