

Significance of Proof of Use in Trademark Oppositions under Turkish Law

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I. Legal Framework and the Purpose of the Proof of Trademark Use

The Industrial Property Law with Number 6769 (“IP Law”) has been published in the Official Gazette of January 10, 2017, introducing several changes to the Turkish trademarks law. Proof of use of a trademark is one of these changes brought by the IP Law.

According to Article 19/2, the applicant is entitled to request opposing party to submit evidence proving that he/she had genuinely used his/her trademark on the goods and services relating to the opposition during the five-years period before the date of application or the date of priority of the latter application or he has a proper reason for not using his trademark during that period. This provision is only valid for the oppositions based on likelihood of confusion which is set forth under Article 6 of the same law. Besides, Article 19/2 will be valid on the condition that the trademark, which is the ground for opposition, has been registered for at least five years at the date of application or date of priority of the application for which the opposition is filed. If the opposing party fails to prove the aforesaid, opposition shall be refused. If it is proven that the trademark, which is the ground for opposition, has been used only for some of the goods or services which are covered by registration, then the opposition shall be examined by taking into account the goods or services whose use is proven.

As stated above, proof of use is only valid for the oppositions set forth under the first paragraph of Article 6 of the IP Law which reads as follows:

“If the applied mark is identical or similar with a registered or previously applied mark and if it covers the same or similar goods and services with the registered or the applied mark, if the registered or the applied mark has the possibility of being confused by the public and if this

possibility for confusion also involves a possibility that it is associated with a registered or applied mark, then the trademark application should be rejected upon opposition”.

In other words, proof of use will not be valid for the well-known trademarks which are set out under Paris Convention, for the trademark which consists of a person’s name, trade name, photography, copyright or any other intellectual property right of another and for the trademark which can be harmed due to its reputation in Turkey.

The provision regarding proof of use aims to prevent new entrepreneurs come across with an unreal entry barrier to the market and the registered trademarks to be used effectively in the market. Besides, the European Union Trademark Directive and European Union Trademark Code include similar provisions as “Non-use as defense in opposition proceedings”. Therefore, one could say that this provision is brought for aligning with the European Union Regulations.

II. Turkish Patent and Trademark Office’s Guideline on Proof of Use

The Turkish Patent and Trademark Office has published a Guideline for Proof of Use (“Guideline”) which consists of clarifications for the purpose of guiding both the applicants who can claim proof of use and the opposing parties who can present evidence of use. The Guideline evaluates potential documents and information to be submitted as evidence and categorizes them. It also provides details on the necessary content and form of the documents.

The Guideline explains the conditions for the proof of trademark use. These conditions are as follows:

- This provision under the IP Law is effective for the applications made after January 10, 2017. On the other hand, for the applications made before January 10, 2017, Decree Law on Trademark Protection with number 556 will be valid.

- As stated above, proof of use is valid only for the oppositions set forth under the first paragraph of Article 6 and a trademark should be registered at least for five years as of the date of application or priority in order to be subject to proof of use claim.

- The applicant can use the proof of use argument during the opposition period. If the applicant did not request for a proof of trademark use during the opposition period, this request cannot be made during the opposition which will be reviewed by Reexamination and Evaluation Board.

- The opposing party should submit evidences which demonstrate that he/she has been using the trademark seriously in Turkey, 5 years prior to the date of application or priority upon the request of applicant. If the opposing party does not submit evidences upon request of the applicant, his/her opposition will be rejected, unless there are other reasons for opposition.

- Except for the ones requested by Turkish Patent and Trademark Office, evidences cannot be submitted after the periods regulated under the Regulation on the Implementation of IP Law, and if the applicant submits the evidences after these periods, Turkish Patent and Trademark Office should not accept it.

- If it is proved that the trademark subject to the opposition has been used only for some of the goods or services, the opposition will be reviewed only for the goods and services which are proved to be used.

III. Evidences that Demonstrate Trademark Use in Turkey

The applicant shall request proof of use within one month as of being notified of the opposition by specifying the goods or services that the use is requested to be proved. The Guideline also includes the form (M116 Counter View Form) which the applicant should be fill for requesting proof of trademark use. If this form cannot be used, the applicant should request proof of use in a clear way, and in accordance with the conditions set forth under the Guideline.

According to the Guideline, the evidences should be clear, comprehensible and reliable enough. The evidences submitted by the opposing party should indicate enough information regarding the quality, place, time and scope of trademark use.

The opposing party should submit the evidences by enumerating and listing them, and he/she should write the registration number of the relevant trademark on every document, which preferably does not exceed one hundred pages. The opposing party should also indicate the total number of pages and submit the evidences which cannot be submitted in a written format via magnetic or optic transporters. The information and documents should not be stapled. The evidences can include every kind of supportive documents (e.g. package, label, price list, catalog, invoice, photograph, etc.). If such documents exist, the opposing party should highlight the parts where demonstrate the use of the trademark subject to the opposition in order to show the use clearly.

According to the Guideline, invoice is a very strong evidence for proving the use of trademark, as it directly refers the commercial activity and as it includes date, the goods and services and the prices of such goods and services.

The Guideline also states that catalogs, price lists and product codes are supportive documents for the invoices even though they do not prove exactly that the trademark is subject to commercial activities. The images of products and packages and the signboards which demonstrate where the goods and services are sold are also some of the significant evidences.

Advertisements, promotions, marketing researches are also considered as important evidences according to the Guideline.

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