



**SCREENING CHAPTER 7  
INTELLECTUAL PROPERTY LAW**

**AGENDA ITEM XIII:  
TRADEMARKS**

**Country Session: The Republic of TURKEY  
2-3 March 2006**



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## HISTORICAL BACKGROUND

- Distinctive Signs Regulation (1871)
- Trademark Law Number: 551 (1965)



## CURRENT LEGISLATION

- Decree-Law No. 556 (DL-556) Pertaining to the Protection of Trademarks, in force as from 27 June 1995  
(as amended on 3 November 1995 and 22 June 2004)
- By-law implementing the Decree-Law
- Non-registered trademarks are protected under Turkish Commercial Code (provisions on unfair competition)



## COMPETENT AUTHORITY

- Turkish Patent Institute
- Total Staff of TMs Department: 90
- Trademark Examiners: 36



## INTERNATIONAL AGREEMENTS

- Paris Convention (1925)
- World Intellectual Property Organization (WIPO) (1976)
- GATT – TRIPS (1995)
- Madrid Protocol (1999)
- Trademark Law Treaty (2005)
- Nice Agreement (1996)
- Vienna Agreement (1996)



## PURPOSE AND SCOPE (Article 1)

- The purpose of DL-556 is to protect the trademarks registered in conformity with the provisions of DL-556.
- The Decree-Law shall apply to trademarks in respect of goods or services subject to registration or to application in Turkey as;
  - an individual trademark
  - a collective mark
  - a guarantee mark



## REGISTRATION PROCEDURE

- Filing an application
- Formal Examination
- Classification
- Similarity Search
- Substantive Examination
- Publication
- Opposition
- Appeal
- Registration or Refusal

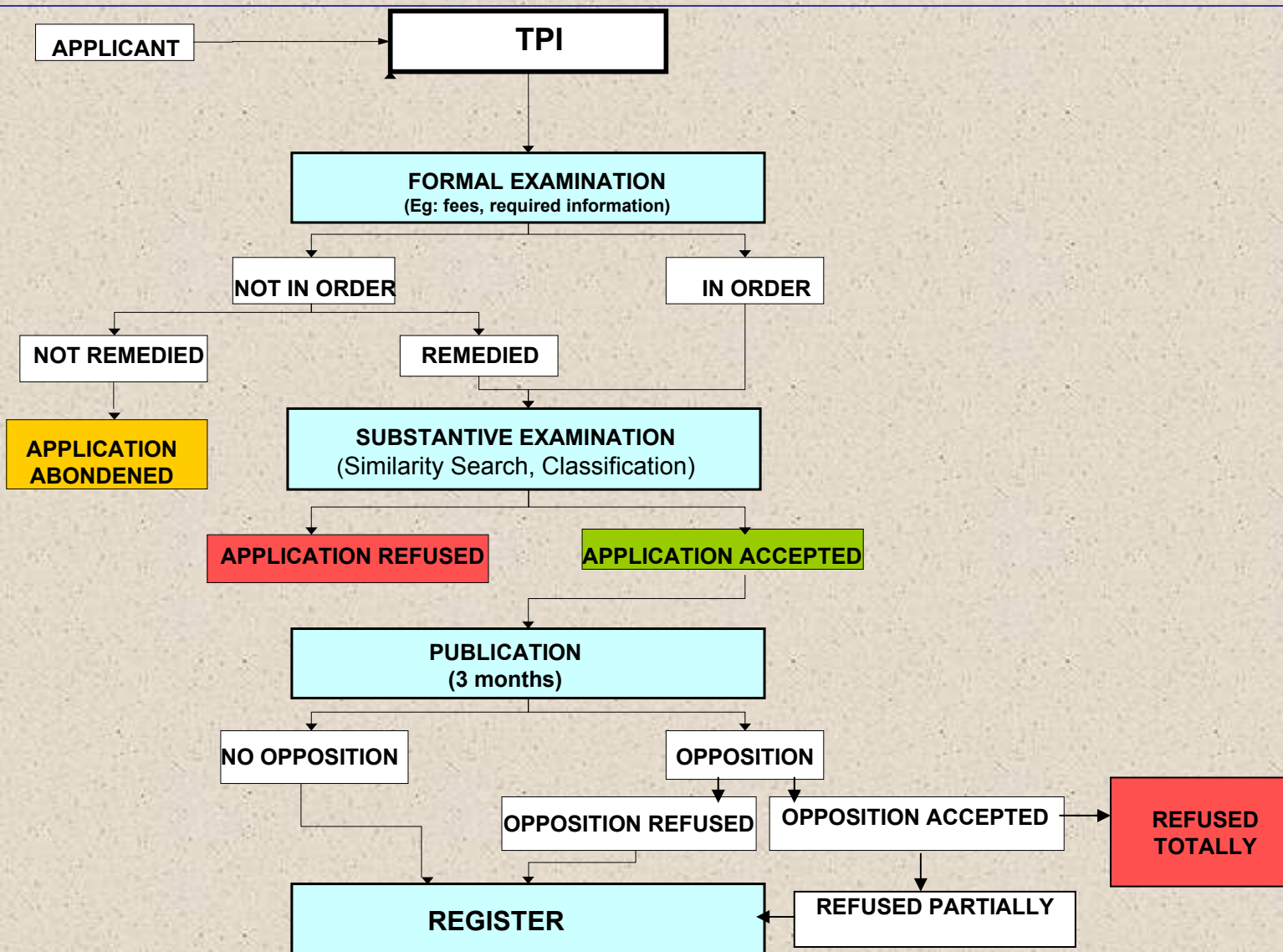




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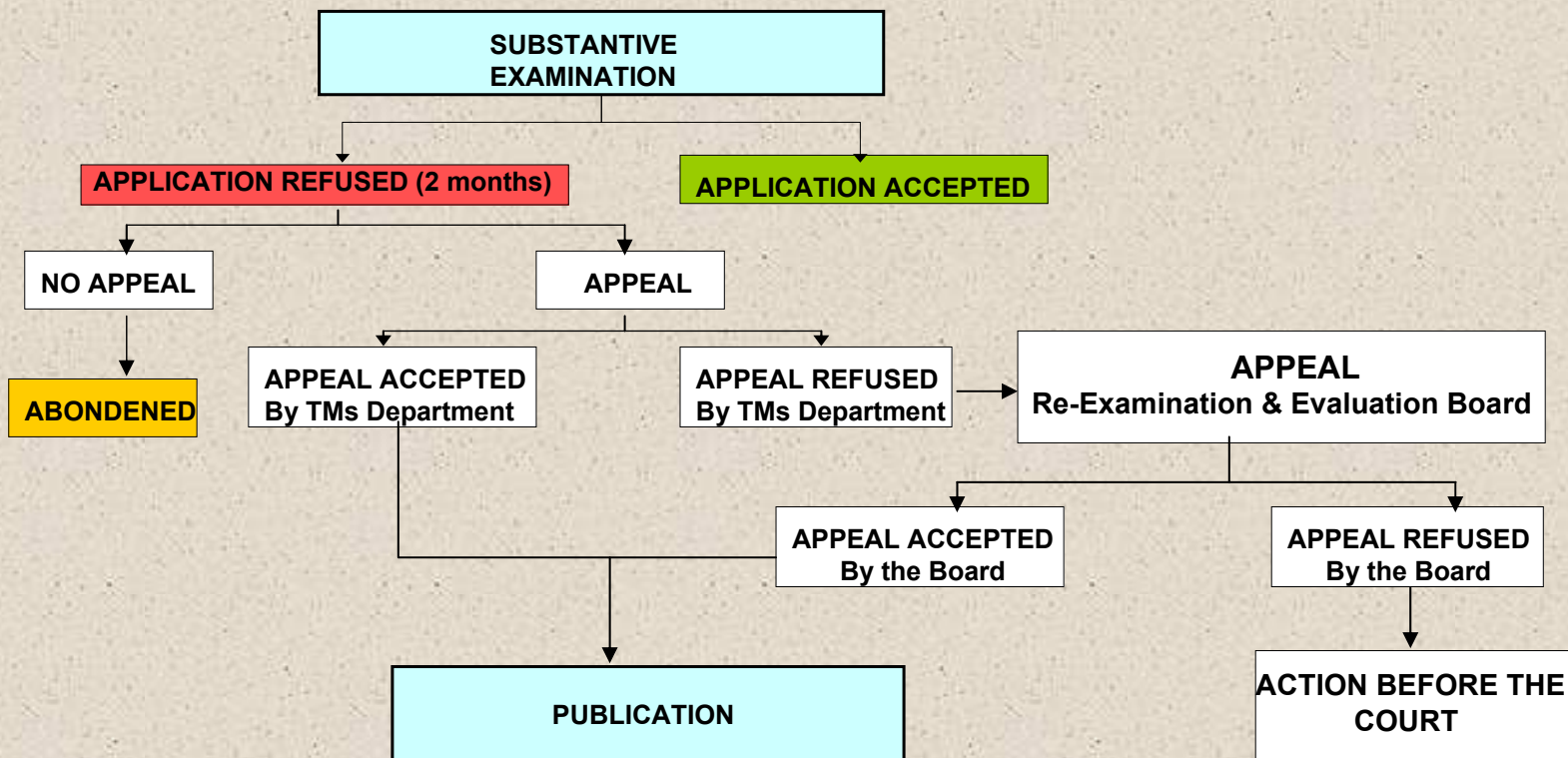


THE SYSTEM





# THE APPEAL SYSTEM





## RE-EXAMINATION AND EVALUATION BOARD

- Any decision taken by TPI in respect of TMs can be susceptible to an appeal
- The Board is composed of at least 3 members
  - President/Vice President of TPI and
  - at least 2 examiners
- Decision of the Board is the final decision of the TPI
- Actions before the court can be brought against the decisions of the Board

## PERSONS ENTITLED TO PROTECTION (Article 3)

### a) Nationals

- of a country which is a signatory of the Paris Convention
- of a WTO Member State

### b) Natural or legal persons who are domiciled or have their seat or who have a real and effective commercial or industrial establishment in

- Turkey
- a country which is a party to the Paris Convention and WTO

### c) Nationals of a State enjoying recognized reciprocity with Turkey



## SIGNS OF WHICH A TM MAY CONSIST (Article 5)

Provided that

- It is capable of distinguishing the goods and services of one undertaking from the goods and services of other undertakings
- It is capable of being represented graphically
- It is capable of being published and reproduced by printing

The following may be registered as a TM

- Words, including personal names
- Designs
- Letters
- Numerals
- The shape of goods or of their packaging



## PROTECTION BY REGISTRATION (Article 6)

- Protection of a TM under DL-556 is obtained by registration.



## **ABSOLUTE GROUNDS FOR REFUSAL (Article 7)**

1. The following shall not be registered
  - a) Trade marks which are devoid of any distinctive character
  - b) Earlier similar or identical trademarks / trademark applications
  - c) Signs that have a generic meaning or descriptive (describe kind, quality, quantity, geographical origin or other characteristics of the goods and services)
  - d) Signs or names which have become customary in trade and established trade practice
  - f) Signs containing the shape of the product which results from the nature of the good, which is necessary to obtain a technical result or which gives substantial value to the good
  - g) Signs that could deceive the public



## **ABSOLUTE GROUNDS FOR REFUSAL (Article 7) (cont.)**

- h) Signs which have not been authorized by the competent authorities and are to be refused pursuant to Article 6ter of the Paris Convention
  - i) Well-known marks
  - j) Trademarks which contain religious symbols
  - k) Signs that are contrary to public order or morality
2. The provisions of (a), (c) and (d) can not be invoked to refuse the registration of a trademark which has been used before the registration and has acquired through this usage distinctive character in respect of the goods and services for which it is to be registered
3. The TM applications which consist of GIs exclusively are refused according to
- Article 7/1(c) of DL-556 Pertaining to the Protection of TMs
  - Article 18 of DL-555 Pertaining to the Protection of GIs





## RELATIVE GROUNDS FOR REFUSAL (Article 8)

The following shall not be registered upon opposition by the proprietor of earlier rights:

- a) Likelihood of confusion/association: earlier identical/similar signs for identical/similar goods or services
- b) Application by an agent or representative without the consent of the holder
- c) Non-registered signs used in the course of trade before
- d) Signs that take unfair advantage of marks with a reputation or being detrimental to the distinctive character or repute (albeit for completely different goods and services)
- e) Names, photography, copyright or industrial property rights of third parties
- f) Identity or similarity with an earlier non-renewed collective or guarantee mark
- g) Identity or similarity with an earlier non-renewed TM



## RIGHTS CONFERRED BY A REGISTERED TM (Article 9)

To prevent the use of

- Identical signs for identical goods/services
- Signs which could cause likelihood of confusion/association because of identity or similarity
- Signs which could take unfair advantage, or be detrimental to the distinctive character/reputation of the TM

The following actions of the third parties may be prohibited

- Using the sign on the goods or packaging
- Putting the goods on the market or stocking for this purpose
- Import and export
- Using on business papers, advertising



## LIMITATION OF THE RIGHTS (Article 12)

The proprietor of a trademark can not prevent the third parties from using in the course of trade

- His own name, address
- Indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of rendering of the services, or other characteristics of the goods or services

Provided that

- The use is effected in accordance with honest practices in industrial or commercial matters



## EXHAUSTION OF THE RIGHTS (Article 13)

- TM proprietor can not prohibit use if the goods are put on the market in Turkey by the proprietor or with his consent
- Right of prohibition in case of changing or impairment



## USE OF THE TRADEMARK (Article 14)

### Reasons for revocation

- Non-use within 5 years after registration
- Uninterrupted suspension of use for 5 years

### Actions of use

- Using without altering the distinctive character of TM
- Using for export purposes
- Using with the consent of the proprietor
- Importing of goods

Revocation decision is given by the court



## LEGAL TRANSACTIONS (Article 15)

A trademark may be

- Transferred (totally or partially)
- Charged as a security
- Licenced (totally or partially)
- Subject to inheritance



## **RIGHT OF PRIORITY (Article 25)**

- Former application in a State which is party to Paris Convention
- A national application within six months.

## **EXHIBITION PRIORITY (Article 26):**

- Displaying goods or services in a State which is party to Paris Convention
- A national application within six months.



## **DURATION OF REGISTRATION (Article 40)**

Protected for 10 years from the date of filing

## **RENEWAL (Article 41)**

Could be renewed at the request of the proprietor or any authorized person in every 10 years





## INVALIDITY (Article 42)

Grounds for invalidity:

- Absolute and relative grounds
- Non-use
- Becoming a common name
- Becoming misleading
- Use of a collective/guarantee mark in breach of the technical specification



## TERMINATION OF THE RIGHTS (Article 45)

- Expiry of the protection period and non-renewal
- Surrender



## INFRINGEMENT (Article 61)

- Using without consent, counterfeiting
- Causing likelihood of confusion
- Taking unfair advantage
- Being detrimental to the distinctive character, reputation
- Selling, distributing, importing or exporting of counterfeit goods
- To participate, assist, encourage the aforementioned acts
- Abstaining from giving information in case of infringement



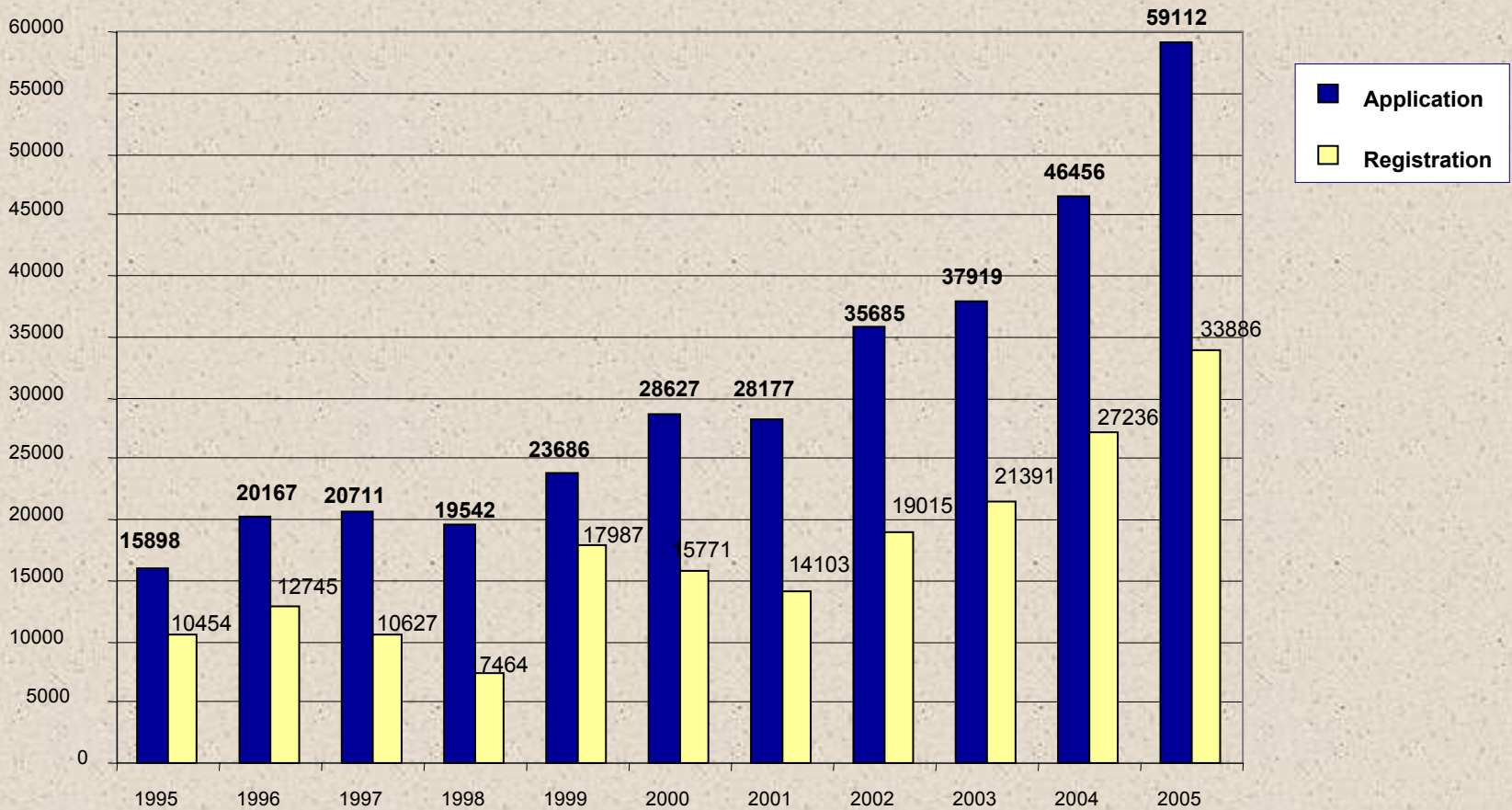
## MADRID PROTOCOL

### Turkey

- Party to the Madrid Protocol
- Can be designated from 65 countries
- Can be designated based on a CTM



### TRADEMARK APPLICATIONS AND REGISTRATIONS BETWEEN 1995-2005





**THANK YOU FOR YOUR ATTENTION**