

PTO prepares for administrative revocation of trademarks

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Legal updates: case law analysis and intelligence

- Article 26 of the Industrial Property Code, which grants the PTO the authority to revoke trademarks, will come into force on 10 January 2024
- The PTO has recently released a draft regulation for comment
- The draft regulation includes procedural details on how revocation requests will be made before the PTO

Background

The Industrial Property Code No 6769 (IP Code), which entered into force on 10 January 2017, provides that the Turkish Patent and Trademark Office (PTO) has authority to revoke trademarks - and, therefore, foresees an administrative procedure for the revocation of trademarks. However, to allow the PTO to prepare for this change, Article 192/1 provided that Article 26 (which determines the grounds for revocation and grants the authority to revoke trademarks) would enter into force within seven years of the entry into force of the IP Code - that is, 10 January 2024. Within this period, under the provisional Clause 4 of the IP Code, the legislator determined that the authority to revoke trademarks would continue to lie with the civil courts.

Under Article 26 of the IP Code, a trademark registration can be revoked on the following grounds:

- absence of genuine use (Article 9/1 of the IP Code);
- the trademark has become generic or misleading as to the quality, qualification or geographical source of the goods and services falling within its scope; and
- use contrary to the technical specifications for a guarantee or collective mark (Article 32 of the IP Code).

This provision is in line with [Directive 2015/2436](#) and EU practice.

Draft regulation

With the entry into force of Article 26 just around the corner, the PTO has accelerated its preparations and the details on how revocation proceedings will be executed are getting clearer.

The most important and recent update in this regard is that the PTO released the Draft Regulation on Amendments to the Regulation on the Implementation of the Industrial Property Code to obtain the opinion of relevant persons and non-governmental organisations, among others. The draft regulation includes procedural details on how a request to revoke a trademark will be made before the PTO and how it can be withdrawn.

In particular, under Article 30/A-3 of the draft regulation, a revocation request must be filed along with a form containing certain information, including:

- the registration and the goods or services subject to the revocation request;
- the ID and contact information of the request owner; and
- the ID and contact information of the agent, if the request is made by an agent (it is believed that the term 'agent' in this article refers to a 'trademark agent', as this is also mentioned in Article 3/1(j) of the Regulation on the Implementation of the Industrial Property Code).

If the request is not in accordance with Article 30/A-3 and 4, or if the revocation request based on non-use is filed against a trademark that has been registered for less than five years, the PTO will simply dismiss the request and will not send a notice to remedy the deficiency.

Under the draft regulation, the request must be filed against the trademark owner or the legal successor of the trademark owner and, if the trademark is assigned during the revocation proceedings, the request will continue to be heard against the new owner.

On the other hand, the draft regulation does not refer to the department that will examine the revocation requests. However, the authors have been informed unofficially that discussions are taking place to establish a separate department for the examination of revocation requests, other than the existing departments.

Forms including the abovementioned information shall be signed and filed before the PTO. The term 'signed' in Article 30/A-3 may be subject to interpretation and gives the impression that revocation requests must be filed by hand. However, the PTO does not accept requests filed by hand and these can be filed only through the PTO's online system (EPATS). Therefore, it is believed that the phrase "the form shall be signed" in the article at issue is intended to mean 'e-signature'.

Further, both Article 26 of the IP Code and Article 30/A of the draft regulation determine that requests for revocation of a trademark will be made to the PTO - with no reference to the courts. It is therefore understood from both articles that, as of 10 January 2024, requests for the revocation of a trademark can no longer be filed directly before the civil courts via a court action: the sole option in force will be the administrative revocation procedure. This is an issue that was initially discussed while the IP Code was being drafted by the Commission for Industry, Trade, Energy and Natural Resources, Information and Technology. However, as a result of these discussions, and as the article at issue was in line with EU practice, it was decided that the PTO would be granted the authority to revoke trademarks. It is also mentioned in the doctrine that, as the PTO's decisions can be challenged before the IP Courts, granting the authority to revoke trademarks solely to an administrative body is not against the law.

Another important issue is that, as understood from Article 30/A-12, the PTO will execute final decisions with immediate effect. Therefore, although the parties are entitled to file cancellation actions against a final PTO decision, if the PTO decides in favour of revocation, the trademark will be revoked and the revocation will be reflected in the registry immediately. As the Civil IP Court's decisions cannot be executed without being finalised, trademark owners will have to wait for the finalisation of the court's decision in order for the revoked trademark to be restored.

Such immediate effect has pros and cons. The trademark owner cannot postpone the execution of the PTO's rightful decision to revoke a trademark for a period of three to four years by filing a court action against it. However, if the court decides that the PTO's decision to revoke a trademark is wrong, the trademark owner will have to take necessary legal actions against other trademark applications/registrations/uses based on its wrongfully revoked trademark, after that mark is resurrected.

Comment

Considering that this is a draft regulation and that the PTO will take opinions into consideration before it is finalised and approved, it is believed that the abovementioned issues can be resolved by the PTO by the time the regulation is published. Overall, considering the time and cost-effectiveness of procedures before the PTO, this is an exciting new era of administrative

revocations in Turkish trademark law.

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