

October 31 2017

- PTO issues clarification of 2017 Proof of Use guidelines
- Explains its criteria for evaluating proof of use in depth and adds 'final evaluations' section
- Visual and written examples provided to give guidance for submitting evidence for proving use of a trademark

The Turkish Patent and Trademark Office (PTO) published the Proof of Use Guidelines on April 28 2017 (please see "[Turkish Patent and Trademark Office issues guidelines for proof of use of trademarks in opposition proceedings](#)"), after the non-use defence was enacted by the new Industrial Property Code 6769 (IPC). In order to clarify the use and functions of this new procedure, the PTO issued an updated version of the guidelines on September 30 2017.

The PTO has added two major topics to the guidelines – "points to take into consideration for evidence submission" and "final evaluations". Under the first topic, the PTO explains in depth its criteria for evaluating proof of use and exemplifies it with precedents. It covers:

- use by the owner or authorised third parties;
- use according to basic function;
- use of a registered trademark without changing the distinctive character;
- genuine use of a trademark;
- domestic use of a trademark;
- valid and acceptable grounds of non-use; and
- use of a trademark for five-year duration retrospectively from the application date of the opposed trademark.

In this regard, the PTO states that although not limited, licence and sub-licence agreements as well as franchise and merchandising agreements are considered and accepted as authorised third-party use and proof provided by those parties is accepted as use of a trademark. Further, the PTO does not directly accept as use of a trademark the claim or use of an identical commercial name.

The guidelines explain the scope of distinctive character according to Article 9 of the IPC. Minor additions, extractions and case changes a trademark are not considered to be a change of the distinctive character of the trademark, if the trademark is perceived as the same product or business by the consumer. The guidelines give both positive and negative examples with respect to the interpretation of the distinctive character of a trademark with minor additions or extractions. Some of the examples accepted as use of a registered trademark published in the guidelines are as follows:

AINHOA
AINHOA BIO
AINHOA SPA WORLD
AINHOA CHOCOLATE



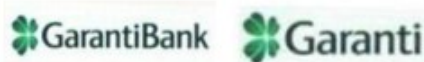
and

are accepted due to minor additions, while



FLAPER

and



are accepted despite the extractions and non-use of a

SEMBELLA



and

FOL'EPI



portion of the trademark. Also,

which do not affect the distinctive character of the trademark. Negative examples considered as change of the distinctive character of the

TONY HAWK



RED KID

REDKIT

trademark include:

and/or



and

D'MEX DIMEKS

. These examples are not considered as use of the registered version since the main or distinctive character has been considered as changed.

There is no clear definition of genuine use available within the IPC. Guidelines define 'genuine use' pursuant to EU legislation and European Court of Justice (ECJ) precedents (eg, *Minimax* (Case C-40/01)). The guidelines cite the PTO's precedents regarding the amount of goods services which are considered sufficient or insufficient to fulfil the genuine use criteria. For example, two invoices and 100 shirts for clothing and TRY5,000 (approximately €1,170) of total sales within three consecutive years are considered insufficient for proof of genuine use.

However, an annual average of 30 handmade guitars, 15 baglamas and 10 lutes for musical instruments and 1,117 bottles of perfume, 1,000 deodorants and 2,500 lipsticks for cosmetic goods are considered to be sufficient for proof of genuine use.

The guidelines clearly state that only domestic use of a trademark will be taken as proof of use and clarify that the term 'domestic' include free zones which are inside of Turkish political borders. According to the guidelines, a valid ground for non-use of a trademark is not limited to *force majeure* – war, economic crisis, natural disasters, changes to customs legislation, import restrictions and embargos can also be accepted as valid grounds for non-use of a trademark.

Finally, a summary section entitled "final evaluations" was added to the guidelines which includes a number of ECJ precedents. Some notable points from this section include:

- strict uniformity between a registered trademark and a trademark in use is not required and equivalence should be broadly interpreted
- multiple registered trademarks can be used together without changing the distinctive character of the subject trademark; and
- if an addition made to a trademark is not distinctive or dominant, the distinctive character of the mark is not changed.

In light of this, the recent update to the guidelines brings a clear perspective to the PTO's evaluation of proof of use. Both visual and written examples are provided to give guidance for submitting evidence for proving use of a trademark. The guidelines will no doubt be widely used by both trademark owners and practitioners. The PTO will also be updating its Trademark Guidelines in the coming months which are expected to provide guidance on the PTO's procedures for in-depth evaluation of applications and oppositions or appeals.

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