

May 25 2017

The Industrial Property Code (6769), which abolished previous IP-related decree laws, and the regulation on its implementation entered into force respectively on January 10 2017 and April 24 2017 (see [“New IP Code enters into force: 2017 will be the year of IP rights”](#) and [“Entry into force of new Regulation on the Implementation of the Industrial Property Code”](#)). The code has introduced the long-awaited co-existence principle for trademarks and the possibility to overcome the *ex officio* refusal of trademark applications by the Turkish Patent and Trademark Office (TPTO) on the grounds of senior trademarks or trademark applications. This article provides details of the co-existence principle under the code and its benefits to rights holders.

Article 7 of the abolished Decree Law 556 Pertaining to the Protection of Trademarks regulated the absolute grounds for refusal of trademark applications. Accordingly, the TPTO had the authority to conduct *ex officio* preliminary examinations of trademark applications and refuse them where they fell within the scope of one of the absolute grounds for refusal set out in Article 7 of the decree law.

Article 7/1(b) is one of the absolute grounds for refusal of a trademark application. It states:

“the trademarks identical or indistinguishably similar with a trademark registered earlier or with an earlier filing date for registration in respect of identical or same type of products or services shall not be registered as a trademark.”

Under the article, trademark applications which are identical or at first glance indistinguishably similar to a senior trademark registration or application will be refused in order to prevent any confusion or the public being misled as to the origin of the trademarks. Such *ex officio* refusal does not exist in many jurisdictions, and in those jurisdictions where it does exist it can be overcome by submitting letters of consent or co-existence agreements. However, the decree law did not provide a similar solution to a refusal.

The lack of a co-existence principle within the decree law caused significant problems for right holders, since it was impossible to overcome such refusal decisions even if the applicant obtained a letter of consent from the holder of the senior trademark application or registration. This resulted in many trademark applications being blocked – even where the owners of the senior trademarks and trademark applications that were cited against the application by the TPTO granted permission. In some cases, the TPTO refused trademark applications *ex officio* based on senior trademarks or trademark applications that were both owned by companies operating under the same parent company; it was therefore impossible to lift the refusal decision unless both the trademark application and the cited senior trademarks or trademark applications were unified under the name of the same entity.

The applicant's only option was to appeal refusal decisions, unless the owner of the previous trademark application or registration withdrew its trademark partially or totally. In most cases, the appeals were refused as the trademarks were held to be identical or indistinguishably similar. Even though the courts have a broader interpretation than the TPTO of the concept of what is identical, in cases where the trademarks and the relevant goods or services were identical and/or indistinguishably similar, it was impossible to obtain a favourable decision from the IP courts. The owners of the senior trademarks were not part of the cancellation actions and therefore even if they agreed to registration of the later application, this was impossible.

The code does not remove the *ex officio* examination and refusal authority of the TPTO. Indeed, Article 5/1 (ç) of the code which is equivalent to Article 7/1(b) of the decree law, states that:

“trademarks which are the same with or non-distinctively similar to a trademark which has been registered in relation with the same goods or services or goods or services at the same type or a trademark for which a registration application has been filed on a previous date shall not be registered as a trademark.”

However, according to Article 5/3 of the code, the office cannot now *ex officio* refuse a trademark application based on this absolute ground for refusal if a notarised letter of consent from the senior trademark owner is submitted to the TPTO. The code does not include detailed provisions on the letter of consent and it directly refers to the regulation by stating in Article 5/3 that “the procedures and principles relating to the letter of consent shall be designated by the Regulation”. Accordingly, the procedures and principles on the letter of consent are regulated in Article 10 of the regulation.

According to Article 10, the letter of consent must be in the form approved by the TPTO and must be notarised. The letter of consent should include:

- the identity and contact information of the applicant(s);
- the sample/image of the applied for sign if the letter of consent is submitted together with the application form or the application number if it is submitted at the appeal stage;
- the identity and contact information of the consenting party/parties;
- the application or registration number of the prior dated trademark(s); and
- the subject goods and services and the relevant class numbers.

Where the letter of consent includes none of the above-mentioned information, a two-month grace period will be granted to the applicant to remedy those deficiencies. If such deficiencies are not remedied, the request will be deemed invalid. If an exclusive licensee is recorded in the register, its written permission should also be submitted along with the letter of consent.

The letter of consent may be submitted to the TPTO together with the application form, or in case of a refusal and a subsequent appeal, until a decision is rendered on the appeal. There is no specific provision in the regulation on whether it is possible to submit the letter of consent at the application stage of international trademark applications made through the *World Intellectual Property Organisation* in accordance with the Madrid Protocol. The TPTO has confirmed that the letter of consent can be submitted only at the appeal stage for international applications. It further explained that it is not permissible to submit the letter of consent during the preliminary examination period until a refusal or publication decision has been rendered for both international and national trademark applications.

According to Article 10/3 of the regulation, if the applicant informs the TPTO that the owner of the senior trademark has allowed registration of its trademark application, but does not submit a letter of consent to the office, the TPTO will not inform the applicant of this deficiency or grant the two-month grace period to the applicant in order that it may submit a valid letter of consent. Therefore, such notification by the applicant will have no effect. For instance, if it is mentioned in the appeal that a letter of consent was submitted to the office, but in fact a letter of consent form was not submitted, the office will not inform the applicant or await submission of the letter of consent and such notification will grant no right to the applicant.

However, the rights holder can submit a letter of consent even if some of the above-stated information is lacking or if the letter has not yet been notarised where negotiations with the owner of the senior trademark are ongoing and more time is needed to conclude the negotiations and obtain a letter of consent. This point is especially important for owners of international applications, as an acceleration in the TPTO's process has been observed recently and the letter of consent must be submitted to the office in the case of a refusal and subsequent appeal, until a decision is rendered on the appeal.

The letter of consent must be unconditional, it cannot be retrieved once it is submitted and a separate letter of consent must be given for each trademark application. According to Article 6 of the regulation, it is possible to submit the original or notarised copy of the letter of consent to the TPTO.

Forms for letters of consent are available on the TPTO website and have been prepared in line with Article 10 of the regulation. There are two separate forms: one is for where there is a single applicant and a single consenting party and the other is for where there are multiple applicants (of a single application) or multiple consenting parties. These forms should be completed electronically; otherwise, they will be invalid. A sample/image of the trademark for which consent is given should be included in the forms, and they should be signed and notarised.

The forms must be signed by the consenting party only (ie, the owner of the senior trademark application or registration), not by the applicant. Article 10 of the regulation does not include a clear provision on whether the letter of consent must be in Turkish and/or English, and refers solely to the letter of consent which is "accepted by the Office as valid". In the early days of the entry into force of the code, the TPTO published the above-mentioned forms for letters of consent prepared in Turkish on its official website and stated that only forms executed in Turkish would be acceptable. Accordingly, these forms should be executed before a Turkish notary public in Turkey; for foreign rights holders, representatives who have specific authorisation to sign the forms shall execute them before the notary public. According to an initial declaration of the TPTO, forms executed in English (even with a translation) or in a format other than that provided by the office would not be accepted.

However, since the regulation does not explicitly state that the letter of consent must be in Turkish, the TPTO recently confirmed that it will also accept English letters of consent which are signed, notarised and apostilled (by the consenting party) in a foreign country, provided that the English form includes all the titles

that are on the Turkish form published on the office's official website and a Turkish translation of the form is also submitted to the office along with the notarised English form.

Accordingly, the consenting party can provide a notarised and apostilled power of attorney to its Turkish representatives with specific authorisation to sign the letter of consent form in Turkish. Once the form is executed before a notary public in Turkey by the Turkish representatives of the consenting party, it should be sent to the applicant and submitted to the TPTO, either along with the trademark application or at the appeal stage.

Alternatively, the consenting party can sign the English version of the form before a notary public in its own country. Once the letter of consent form is notarised and apostilled, it should be translated into Turkish and both forms submitted to the TPTO. The English version of the form is not on the TPTO's website, so it is important to ensure that the English form includes all the titles that are on the original Turkish form.

Even though Article 34 of the regulation stated that the official appeal fee paid to the TPTO for its unilateral decisions related to the trademark applications will be returned to the applicant on request if the appeal is accepted, acceptance of appeals due to submission of a letter of consent is excluded from the scope of this article.

Comment

The co-existence principle in the Industrial Property Code is a welcome amendment, as it enables rights holders to overcome a possible *ex officio* refusal of their trademark applications without the need to obtain a favourable decision from the appeal board or the civil IP courts. In cases where the two rights holders operate in different markets and agree to the registration of the trademark, there is no need to claim and prove that the trademarks are not identical or indistinguishably similar as per Article 5/1(ç) of the code. It also assures owners of senior trademarks that if a letter of consent is demanded, it is possible to give consent for only limited goods or services.

Further, it is unnecessary for the parent company to unite the two trademarks under the name of the same company. Therefore, the possibility of submitting letter of consent saves time and money for rights holders. Lastly, the registration of two identical trademarks covering identical goods or services in Turkey is now also possible.

As it is not permissible to submit the letter of consent at the application stage of an international application, an inequality is created between national and international applications; filing a national trademark application thus seems more advantageous than filing an international application. Perhaps it should be made possible to submit a letter of consent during the preliminary examination period up until the TPTO renders its refusal or publication decision on the application, as is possible at the appeal stage.

Despite such deficiencies within the legislation, which will no doubt be rectified in time, the co-existence principle is crucial as it recognises the will of rights holders over the TPTO's unilateral decisions.

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