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TURKEY: Partial Cancellation of Well-Known Trademarks on Grounds of Non-Use

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In decision 2010/11-695E, 2011/47K of February 9, 2011, the General Assembly of Civil Chambers of the Court of Appeals established a limit to the wide scope of protection for well-known trademarks, holding that pursuant to Articles 14 and 42 of the Decree-Law on the Protection of Trademarks (No. 556, June 27, 1995), the registration for a well-known trademark can be partially cancelled on the ground of non-use.

The Court of Appeals discussed the issue of the strength of a well-known trademark that would be necessary to prevent registration of identical or confusingly similar trademarks for different goods or services. The Court concluded that the partial cancellation of a well-known trademark for goods/services in connection with which it was not used does not prevent the trademark owner from filing opposition against third parties' applications to register identical or similar marks covering different goods/services.

Article 8/4 of the Decree-Law is a reflection of Article 16.3 of the TRIPS Agreement, which provides that Article 6bis of the Paris Convention applies to goods/services not similar to those for which the trademark is registered if (1) use of the trademark for those goods/services suggests a connection between them and the trademark owner and (2) the owner's interests are likely to be damaged by such use. With regard to the implementation of Article 8/4, the Court of Appeals had already established, in its "Le Meridien" decision (March 3, 2007), that even if the well-known status of a trademark is established, the court should still verify whether the use complained of would unfairly benefit from or cause detriment to the distinctive character or reputation of the well-known trademark.

When both decisions are considered together, it can be concluded that although a well-known trademark can be cancelled for non-use in relation to some of the goods/services for which it is registered, that does not prevent the owner from taking action against an application to register an identical or confusingly similar trademark where use of that trademark would unfairly benefit from or cause detriment to the distinctive character or reputation of the well-known trademark.

The Court of Appeals' decision is final and binding and should be followed by other courts. It seems to have put an end to the attempts of owners of well-known trademark owners to argue that registrations could not be cancelled for goods or services for which the trademark was not used, as such a partial cancellation would not clear the way for registration by third parties of identical or confusingly similar trademarks for those goods. Therefore, the owners of well-known trademarks should develop new prosecution and protection strategies and consider more proactive measures to avoid dilution of their trademarks.

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