

# World Trademark Review Daily

**TPI's change of practice should help prevent bad-faith applications**  
**Turkey - Mehmet Gün & Partners**

**Examination/opposition**  
**National procedures**

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In an important decision, the [Turkish Patent Institute](#) (TPI) has changed its position concerning applications filed in bad faith.

In April 2011 a trademark application consisting of two words - in which the second word was the trademark (registered worldwide) and trade name of an Italian company - was filed in the name of a Turkish company before the TPI.

Although the Italian company filed an opposition against the application, it was expected to proceed to registration, as the applicant had held a valid trademark registration for the phrase at issue since 1999. Even though this registration was the subject of a pending cancellation action for non-use, the TPI's usual practice is to register the application without waiting for the outcome of the court action based on the rights conferred by the earlier trademark, as long as it is valid at the time the decision is granted.

The opposition was based mainly on the ground of bad faith. The opponent raised the following additional grounds:

- the application was identical to the opponent's trade name; and
- the opponent owned local trademarks for the same phrase in different classes.

When considering the ground of bad faith, it was brought to the TPI's attention that the applicant had filed a fresh application to obtain another registration for a trademark that contained the wording at issue in the non-use action.

The TPI upheld the opposition and decided to refuse the application on the grounds that it had been filed in bad faith, as the applicant was aware that there was a pending action against its registration. The TPI also upheld the other grounds of opposition.

The applicant filed an appeal against the decision before the Re-examination and Evaluation Board of the TPI based mainly on its earlier registration, which was still valid as the non-use action was not yet finalised.

The board rejected the appeal, finding that the decision of the TPI was correct. The decision is now thus final in the administrative phase.

The applicant could file a nullity action against the decision of the TPI before the competent civil IP courts; however, the courts interpret the grounds of bad faith in an even broader manner. So far, the TPI had acted cautiously in cases where the applicant held a valid registration; therefore, it had allowed many applicants to register the same trademark repeatedly, even where the rightful ownership of the mark was at issue.

The decision in the present case is thus notable: the change of attitude of the TPI will help prevent the registration of applications filed in bad faith, which is one of the most problematic issues of the Turkish trademark system. It seems that the TPI no longer takes into consideration earlier registrations owned by the applicant when considering oppositions against new applications in cases where there is a pending action filed by the opponent against the earlier registration.

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