

TRADEMARK OPPOSITION SYSTEM IN TURKEY

In Turkey Trademarks are registered and protected according to the provisions of the Decree-Law No. 556 Pertaining to the Protection of Trademarks. The registration procedures are fulfilled by the Trademarks Department Of the Turkish Patent Institute (TPI).

The system introduced by the Decree-Law No. 556 has some basic features. One of the most important of all is the ex officio examination by the TPI for relative grounds for refusal which is followed by publication (publication is only for the marks which are not totally refused) for opposition purposes.

The system can be summarized as follows:

1- Once an application is received, firstly, formal examination, data capture, classification and search procedures are completed. Then, the application is forwarded to the examiners for decision.

2- The examiner has to make a decision which could be publication, partial refusal (partial publication) or total refusal.

Examination is performed according to the provisions of Article 7 of the Trademark Decree-Law. In this article you can find the absolute grounds for refusal and also relative grounds for refusal that are to be examined ex officio.

3- The examiner has to take into account the trademark registrations or applications that have an earlier application date (or priority date). If the examiner finds out that the application is identical or similar to a mark (marks) with an earlier application date and these marks are applied or registered for the identical/similar goods and/or services, he/she should refuse the application partially or totally.

4- Applications which are accepted or partially accepted are published in the Trademark Bulletin of the TPI. The publication is for opposition purposes for the third parties and the time limit for filing oppositions is 3 months after publication.

5- The oppositions can be both based on absolute and / or relative grounds for refusal. More clearly, anyone without any earlier rights can file an opposition and mention that the application can not be registered because the registration should be contrary to absolute grounds for refusal (for example the application is descriptive).

And, any real or legal person can file oppositions based on relative grounds; if he/she has an earlier application or registration at the TPI, if he/she thinks that his/her mark is a famous mark that should be protected for different goods/services, if he/she has used the mark before without any registration/application at the TPI, if he/she thinks that the application will create confusion with any of his/her other earlier IP rights (like copyright, trade name, industrial design, etc.) or if he/she thinks the application is made in bad faith.

6- The opposition has to be filed to the TPI. Oppositions are examined by a special section in the Trademarks Department and decisions are made by a group of examiners. In other words the oppositions are not examined by the same examiner who made the first decision or only by one examiner.

7- The decisions of the oppositions section can be appealed to the TPI again. If the opposition is rejected or the application is refused partially or totally, the party or parties who is not satisfied or damaged by the decision could lodge an appeal. The appeals are examined at the Re-Evaluation and Examination Board of the TPI. The board is composed of at least three persons, one of them acting as the president of the board. The board makes the final decision of the TPI in any type of appeals and the decisions of the board could be appealed at the Specialized IP Courts that are based in the capital.

8- As mentioned before TPI examines every trademark application for relative grounds ex officio. But this examination is limited to the earlier identical or similar registrations/applications filed at the TPI for the identical or similar goods and/or services. In the oppositions based on relative grounds, the grounds are not only these. There are more grounds for refusal in the opposition stage (These grounds are already mentioned in paragraph 2 of item 5). So, in the terminology of the International Bureau the system of the TPI should not be named a parallel structure but rather than that should be called a complementary structure.

9- During the examination of the oppositions TPI can invite the parties for settlement. But this procedure is not used frequently.

10- The conflicting parties can change and share their evidence during the opposition procedures, especially in oppositions based on earlier use without registration. TPI collects the evidence and sends it to the related parties asking them to send their point of view and / or evidence.

11- Decree-Law No. 556 Pertaining to the Protection of Trademarks indicates in Article 35 that the oppositions could be filed by any related party. As the term related party is too broad and does not bring any actual limitation the wording is interpreted that anyone can file oppositions if he/she has any kind of interest or relation.

12- In Turkey trademarks are registered after all the examination processes are completed. So, the opposition system in Turkey is a pre-registration opposition system. The system is accompanied by invalidation proceedings that, after the registration of a trademark, can be initiated before the IP courts.

13- For filing oppositions the related party has to pay a fee to the TPI. But the TPI does not have the authority to oblige the losing party to pay the opposition fee or any kind of other costs.

14- Decree-Law No. 556 Pertaining to the Protection of Trademarks also brought the system for the "Observations by the Third Parties". Any third person can claim that a trademark should not be registered according to the absolute grounds for refusal. This procedure is without any fee and it can be done at any time after publication until the registration. As already mentioned the opposition grounds allow oppositions to be based on absolute grounds. So, it could be said that, the third parties thinking that application should not be registered according to the absolute grounds have two alternative options, one is filing an opposition and the other is using the observations by the third parties procedure.