

TURKEY
Trademark Law

Decree-law No. 556 as amended by Law No. 4128 of November 7, 1995
ENTRY INTO FORCE: November 7, 1995

TABLE OF CONTENTS

PART I GENERAL PROVISIONS

Section I Aim, Scope, Definitions and Persons Entitled to Protection

Art. 1 Aim and Scope

Art. 2 Definitions

Art. 3 Persons Entitled to Protection

Art. 4 Priority of International Agreements

Section II Signs that May Constitute a Trademark and Means of Acquiring Trademark Rights

Art. 5 Signs that May Constitute a Trademark

Art. 6 Means of Acquiring Trademark Rights

Art. 7 Absolute Grounds for Refusal of Trademark Registration

Art. 8 Relative Grounds for Refusal of Trademark Registration

Section III Scope of Protection of the Trademark

Art. 9 Rights Conferred by a Registered Trademark

Art. 10 Reproduction of the Trademark in Dictionaries and Reference Works

Art. 11 Prohibition of the Use of a Trademark Registered in the Name of an Agent or Representative

Art. 12 Limits on the Effects of a Registered Trademark

Art. 13 Exhaustion of the Rights Conferred by a Registered Trademark

Section IV Use of the Trademark

Art. 14 Use of the Trademark

Section V Legal Transactions Relating to Trademark Rights

Art. 15 Legal Transactions

Art. 16 Transfer of the Trademark

- Art. 17 Transfer of a Trademark Registered in the Name of an Agent or Representative
- Art. 18 Using the Trademark as Security
- Art. 19 Attachment
- Art. 20 Licensing
- Art. 21 Licensing Conditions
- Art. 22 Legal Procedures

PART II APPLICATION

Section I Filing of Application

- Art. 23 Filing of Application
- Art. 24 Classification
- Art. 25 Right of Priority
- Art. 26 Exhibition Priority
- Art. 27 Effect of Priority Rights
- Art. 28 Claiming and Evidencing of Priority

PART III REGISTRATION PROCEDURES

Section I Examination of the Application

- Art. 29 Examination for Compliance with Filing Conditions
- Art. 30 Remedying Deficiencies Regarding Compliance With Filing Conditions
- Art. 31 Examination as to Entitlement
- Art. 32 Examination as to Absolute Grounds for Refusal

Section II Publication of the Application

- Art. 33 Publication of the Application

Section III Observations by Third Parties

- Art. 34 Observations by Third Parties
- Art. 35 Opposition
- Art. 36 Examination of the Opposition

Section IV Procedural Matters Relating to Trademark Applications

Art. 37 Corrections

Art. 38 Withdrawal

Section V Registration

Art. 39 Registration

PART IV TERM OF REGISTRATION AND RENEWAL OF A TRADEMARK

Art. 40 Term of Registration

Art. 41 Renewal

PART V INVALIDITY OF A TRADEMARK AND TERMINATION OF TRADEMARK RIGHTS

Section I Invalidity of a Trademark

Art. 42 Invalidity

Art. 43 Application for a Declaration of Invalidity

Art. 44 Effect of Invalidity

Section II Termination of Rights

Art. 45 Causes of Termination

Art. 46 Surrender of Rights

PART VI APPEALS AGAINST DECISIONS OF THE INSTITUTE

Art. 47 Appeals

Art. 48 Persons Entitled to Appeal

Art. 49 Form of Appeal

Art. 50 Rectifying a Decision

Art. 51 Examination of Appeals

Art. 52 Decision on Appeal

Art. 53 Court Actions Against Decisions

PART VII GUARANTEE MARKS AND COLLECTIVE MARKS

Art. 54 Guarantee Marks

Art. 55 Collective Marks

Art. 56 Technical Rules Governing Guarantee and Collective Marks

Art. 57 Amending the Technical Rules

- Art. 58 Rules Contrary to this Decree-Law
- Art. 59 Use in Violation of the Technical Rules
- Art. 60 Transfer and Licensing

PART VIII INFRINGEMENT OF RIGHTS

- Art. 61 Infringement
- Art. 61A
- Art. 62 Action by the Proprietor of the Trademark
- Art. 63 Competent Courts
- Art. 64 Compensation
- Art. 65 Documents Evidencing Infringement
- Art. 66 Non-Realization of Profits
- Art. 67 Increasing the Amount of the Profits Not Realized
- Art. 68 Reputation of the Trademark
- Art. 69 Persons Against Whom Action May Not Be Brought
- Art. 70 Time Limits
- Art. 71 Competent Courts
- Art. 72 Publication of Court Decisions
- Art. 73 Action by the Licensee
- Art. 74 Claims of Non-Infringement
- Art. 75 Action to Secure Evidence
- Art. 76 Precautionary Measures
- Art. 77 Nature of the Precautionary Measures
- Art. 78 Civil Procedure Code
- Art. 79 Seizure at Customs

PART IX REPRESENTATION AND AGENTS

- Art. 80 Representation Before the Institute

PART X PAYMENT OF FEES AND LEGAL EFFECTS

- Art. 81 Conditions of Payment of Fees and Effects

PART XI FINAL PROVISIONS

- Art. 82 Provisions Repealed

TRANSITIONAL PROVISIONS

- Art. 83 Entry Into Force
- Art. 84 Execution

PART I GENERAL PROVISIONS

Section I Aim, Scope, Definitions and Persons Entitled to Protection

Art. 1 Aim and Scope

The aim of this Decree-Law is to protect trademarks registered in conformity with the provisions thereof.

This Decree-Law establishes the principles, rules and conditions for the protection of trademarks.

Art. 2 Definitions

For the purposes of this Decree-Law:

(a) "trademarks" means trademarks or service marks, including guarantee marks and collective marks;

(b) "Paris Convention" means the Paris Convention for the Protection of Industrial Property of March 20, 1883, and those of its amendments ratified by Turkey;

(c) "Institute" means the Turkish Patent Institute established by Decree-Law No. 544;

(d) "trademark agents" means the persons entitled to represent third parties before the Institute in the assertion and protection of the rights provided for in this Decree-Law.

Art. 3 Persons Entitled to Protection

The protection conferred by this Decree-Law shall be available to natural and legal persons domiciled or having industrial or commercial establishments within the territory of the Turkish Republic, or to persons having application rights deriving from the Paris or Berne Conventions or the Agreement Establishing the World Trade Organization.

Natural or legal persons other than those referred to in the first paragraph of this Article who are nationals of States that accord legal and de facto protection to nationals of the Turkish Republic shall enjoy trademark protection in Turkey according to the principle of reciprocity.

Art. 4 Priority of International Agreements

Where the provisions of international agreements that have entered into force as provided in the laws of the Turkish Republic offer more favorable conditions than this Decree-Law, the persons referred to in Article 2 may request treatment according to those more favorable conditions.

Section II Signs that May Constitute a Trademark and Means of Acquiring Trademark Rights

Art. 5 Signs that May Constitute a Trademark

Provided that it is capable of distinguishing the goods and services of one undertaking from the goods and services of other undertakings, a trademark may consist of any kind of sign capable of being represented graphically, such as words, including personal names, designs, letters and numerals, the shape of the goods or their packaging and similarly descriptive elements capable of being published and being reproduced by printing.

A trademark may be registered together with the product or the packaging thereof. Registration of the product or the packaging alone does not confer exclusive rights, however.

Art. 6 Means of Acquiring Trademark Rights

Protection for a trademark under this Decree-Law is obtained by registration.

Art. 7 Absolute Grounds for Refusal of Trademark Registration

The following signs shall not be registered as trademarks:

- (a) signs that do not conform to the provisions of Article 5;
- (b) trademarks identical or confusingly similar to a trademark registered or filed for registration earlier in respect of an identical or confusingly similar type of product or service;
- (c) trademarks consisting exclusively of signs or indications that serve intrade to indicate the kind, characteristics, quality, quantity, intended purpose, value or geographical origin or to designate the time of production of the goods or rendering of the services or other characteristics of the goods or services;
- (d) trademarks consisting exclusively of signs and names that are used to distinguish specific groups of craftsmen, professionals or tradesmen or have become customary in the current and established practices of the trade;
- (e) signs constituted by the shape of the product, resulting from the nature of the product, necessary to obtain a technical result or giving substantial value to the product;
- (f) trademarks that are of such a nature as to deceive the public, notably as to the nature, quality, place of production or geographical origin of the goods and services;

- (g) trademarks that have not been authorized by the competent authorities and are to be refused under Article 6ter of the Paris Convention;
- (h) trademarks incorporating badges, emblems or escutcheons other than those covered by Article 6ter of the Paris Convention that have not been authorized by the competent authorities and are of particular historical and cultural interest to the public;
- (i) trademarks that have not been authorized by their owners and well-known marks within the meaning of Article 6bis of the Paris Convention;
- (j) trademarks that incorporate religious symbols;
- (k) trademarks that are contrary to public policy and to accepted principles of morality.

The provisions of subparagraphs (b), (c) and (d), above, may not be invoked to refuse the registration of a trademark that has been used before registration and through such use has acquired distinctive character in relation to the goods and services for which it is to be registered.

Art. 8 Relative Grounds for Refusal of Trademark Registration

On opposition from the proprietor of a trademark registration application or registered trademark, the trademark registration applied for shall not be granted under the following circumstances:

- (a) if the trademark filed for registration is identical to a registered trademark or to a trademark that has an earlier application date and the protection is sought for identical goods or services;
- (b) if, because of its identicalness or similarity to a trademark that has an earlier application date or to a registered trademark and because of the identicalness or similarity of the goods and services covered by the trademarks, there exists a risk of confusion on the part of the public and that risk of confusion includes the likelihood of association with the registered trademark or with the trademark that has an earlier application date.

On opposition from the proprietor of a trademark, a trademark shall not be registered where an agent or representative of the proprietor of the trademark has applied for such registration in his own name without the proprietor's consent and without valid justification.

On opposition from the proprietor of an unregistered trademark or of another sign used in the course of trade, the trademark registration applied for shall not be granted where:

(a) the rights in the sign were acquired prior to the date of the trademark registration application, or the priority date claimed for the said application;

(b) the sign confers on its proprietor the right to prohibit the use of a subsequent trademark.

A trademark filed for registration that is identical or similar to a registered trademark or to a trademark with an earlier application date may be used for different goods and services. However, where a registered trademark or a trademark with an earlier application date has a reputation, and where the use without due cause of the trademark filed for registration would take unfair advantage of or be detrimental to the distinctive character or reputation of the registered trademark or of the trademark with an earlier application date, on opposition from the proprietor of the earlier trademark the trademark applied for shall not be registered, even for use in connection with goods or services that are not similar to those for which the earlier trademark is registered.

On opposition from the holder of the relevant rights, the trademark filed for registration shall not be registered if it contains the name or photograph or infringes the copyright or any industrial property rights of third parties.

On opposition, a trademark filed for registration that is identical or similar to a collective or guarantee mark shall not be registered for three years following the expiry date of the collective or guarantee mark.

A trademark filed for registration that is identical or similar to a trademark the registration of which has not been renewed, and which is to be registered for identical or similar goods and services, on opposition, shall not be registered for two years following the expiry date.

Section III Scope of Protection of the Trademark

Art. 9 Rights Conferred by a Registered Trademark

The proprietor of a trademark shall be entitled to prevent third parties from doing the following without his consent:

(a) using any sign that is identical to the registered trademark in relation to goods or services that are identical to those for which the trademark is registered;

(b) using any sign which, because of its identicalness or similarity to the registered trademark and the identicalness or similarity of the goods or services covered by the registered trademark and sign, creates a risk

of confusion on the part of the public, including the risk of association between the sign and the trademark;

(c) using any sign that is identical or similar to the registered trademark in relation to goods or services that are not similar to those for which the trademark is registered, but where the use of that sign without due cause takes unfair advantage of or is detrimental to the distinctive character or reputation of the registered trademark.

The following may be prohibited under the first paragraph above:

- (i) affixing the sign to the goods or to the packaging thereof;
- (ii) offering the goods, placing them on the market or stocking them for those purposes under the sign, or offering or supplying services under it;
- (iii) importing or exporting the goods under the sign;
- (iv) using the sign on business papers and in advertising.

The rights conferred by a registered trademark shall be binding on third parties from the date of publication of the registration of the trademark. Compensation may be claimed for matters arising after the date of publication of a trademark application. However, the rights arising from the publication of an application shall be considered included among the rights conferred by the publication of the registration of the trademark. The court to which the case is referred may not rule on the merits of the case until the registration has been published.

Art. 10 Reproduction of the Trademark in Dictionaries and Reference Works

Where a trademark is reproduced in a dictionary, encyclopedia or similar reference work without any mention that it is registered, thereby giving the impression that it is the generic name of the goods or services for which the trademark is registered, the publisher shall, at the request of the proprietor, correct the fault in the next edition.

Art. 11 Prohibition of the Use of a Trademark Registered in the Name of an Agent or Representative

Where a trademark is registered in the name of the agent or representative of the proprietor of the trademark without the said proprietor's consent, the proprietor shall be entitled to oppose the use of the trademark unless the agent or representative has valid justification.

Art. 12 Limits on the Effects of a Registered Trademark

The proprietor of a trademark may not prevent a third party from using, in the course of trade, his own name or address, information concerning the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or rendering of the services, or other characteristics of the goods or services, provided that the use is made in accordance with proper practice in industrial or commercial matters.

Art. 13 Exhaustion of the Rights Conferred by a Registered Trademark

Acts in relation to a product incorporating a registered trademark shall not constitute a breach of the rights therein where they occur after the product has been put on the market in Turkey by the proprietor or with his consent.

The proprietor shall have the right, even where the foregoing paragraph applies, to oppose further commercialization of the goods, notably where the condition of the goods is changed or impaired after they have been placed on the market.

Section IV Use of the Trademark

Art. 14 Use of the Trademark

If, within a period of five years following registration, the trademark has not been put to use without a justifiable reason, or if the use thereof has been suspended for an uninterrupted period of five years, the trademark shall be invalidated.

The following shall be understood to constitute use:

- (a) use of the registered trademark in a form differing in elements that do not alter the distinctive character thereof;
- (b) use of the trademark on goods or their packaging solely for export purposes;
- (c) use of the trademark with the consent of the proprietor;
- (d) importation of the goods bearing the trademark.

Section V Legal Transactions Relating to Trademark Rights

Art. 15 Legal Transactions

A registered trademark may be transferred to a third party, used as security or licensed, and may be passed on by inheritance. The relevant provisions of the Civil Code shall apply with respect to security rights.

Inter vivos transactions concerning the registered trademark shall be

evidenced in writing.

Art. 16 Transfer of the Trademark

A registered trademark may be transferred in respect of some or all of the goods or services for which it is registered.

Transfer of a whole undertaking, together with its assets and liabilities, shall, unless provided otherwise, include the rights in the undertaking's trademarks. This provision shall apply to the contractual obligation to transfer the undertaking.

Without prejudice to the second paragraph above, the assignment of a registered trademark shall be evidenced in writing and signed by the parties to the contract, except when it is the result of a court decision. Contracts entered into otherwise shall be considered void.

Where the nature of the transfer is such as to mislead the public concerning the nature, quality or geographical origin of the goods or services for which it is registered, the Institute shall not register the transfer unless the successors agree to limit registration of the trademark to goods or services regarding which it is not likely to mislead.

The transfer shall be entered in the Register and published at the request of one of the parties.

As long as the transfer has not been entered in the Register, the parties may not invoke the rights arising from the registration of the trademark against third parties acting in good faith.

Art. 17 Transfer of a Trademark Registered in the Name of an Agent or Representative

Where a trademark is registered in the name of an agent or representative of the proprietor of a trademark without the consent of the said proprietor, the proprietor shall be entitled to demand the assignment of the registration to him unless the agent or representative justifies his action.

Art. 18 Using the Trademark as Security

A registered trademark may be used as security independently of the undertaking.

Use as security shall be recorded in the Register and published at the request of one of the parties.

Art. 19 Attachment

A registered trademark may be attached independently of the undertaking. The attachment shall be entered in the Register and published.

Art. 20 Licensing

The rights in a registered trademark may be licensed in respect of some or all of the goods and services for which it is registered.

Art. 21 Licensing Conditions

A license may be exclusive or non-exclusive.

Unless otherwise provided in the contract, the license shall be understood to be non-exclusive. The licensor may use the trademark himself, and may license the same trademark to third parties.

In the case of an exclusive license, the licensor may not grant licenses to other parties and may not make use of the trademark unless the contract specifically so provides.

Unless the contract specifically so provides, the licensee may not transfer the rights under the license or grant a sublicense.

Unless otherwise provided in the contract, the licensee shall have exclusive rights in the use of the trademark during the period of protection.

Unless otherwise provided in the contract, the holder of an exclusive license may, in the event of infringement of the trademark rights, institute in his own name all legal proceedings available to the proprietor of the trademark under this Decree-Law. Holders of non-exclusive licenses shall not have the right to institute legal proceedings.

In the event of infringement, the holder of a non-exclusive license may serve notice on the proprietor of the trademark, through a notary public, to institute such proceedings as may be required. Should the proprietor of the trademark refuse, or within three months of receipt of the notice fail, to institute proceedings, the non-exclusive license holder shall have the right to institute proceedings himself. The licensee may, in the face of serious damage that will persist with the passage of time, apply to the court for the issue of a restraining injunction. The licensee who has instituted proceedings shall notify the proprietor of the trademark accordingly.

The proprietor of the trademark shall take the necessary measures to ensure the quality of the products produced or services rendered by the licensee. Where the provisions of the license contract have been breached by the licensee, proceedings may be instituted to invoke the rights under a registered trademark against the said licensee.

A license shall not be enforceable against third parties acting in good faith until it is registered.

A license contract may not contain provisions contrary to this Decree-Law and other related laws, decrees and regulations. Such contrary provisions of a license contract shall be void even if they conform to legal provisions

that have come into force after the signing of the contract.

Art. 22 Legal Procedures

Legal procedures relating to the transfer, licensing, attachment and use as security of a trademark and changes in the proprietorship thereof shall apply also to a trademark application.

PART II APPLICATION

Section I Filing of Application

Art. 23 Filing of Application

An application for registration of a sign shall be filed with the following:

- (a) a request, the form and contents of which shall be specified in the Implementing Regulations, including information identifying the applicant;
- (b) a representation of the trademark suitable for reproduction;
- (c) a list of the goods or services for which the trademark is to be used;
- (d) the original receipt attesting payment of the application fees;
- (e) the original receipt attesting payment of the class fees;
- (f) the power of attorney if an agent is appointed;
- (g) a signature circular where the applicant is a legal person;
- (h) documents evidencing the applicant's business activity.

The application fee shall be paid at the time of filing for the trademark registration application to be valid.

A separate application shall be filed for each trademark.

All documents filed with the application for registration of a trademark or submitted to the Institute later shall comply with the Implementing Regulations.

Art. 24 Classification

The goods and services for which the trademark is to be registered shall be classified according to the International Classification of Goods and Services. The principles of classification shall be specified in the Implementing Regulations.

Art. 25 Right of Priority

Natural or legal persons who are nationals of any State party to the Paris Convention or, if not nationals, are domiciled or have an active business in such a State shall enjoy a right of priority of six months, counted from the date on which a valid application for registration of a trademark was filed with the authorized bodies of the State concerned, for the filing of an application for a registration certificate in Turkey in respect of the same trademark. Priority rights not exercised within that period shall be considered void.

Where priority is claimed under the first paragraph above, all applications

filed and registration certificates obtained by third parties in respect of trademarks falling within the scope of protection shall be declared invalid as from the date recognized as giving rise to the right of priority. If a natural or legal person who is a national of a State party to the Paris Convention has filed a valid application in a State not party to the Paris Convention, he shall enjoy the right of priority under this Article in respect of that filing.

Art. 26 Exhibition Priority

Natural or legal persons within the meaning of the first paragraph of Article 3 who have displayed the goods or services to which the trademark is affixed at national or international exhibitions in Turkey or at official or officially recognized national or international exhibitions in States party to the Paris Convention may claim a right of priority for registration of the trademark in Turkey if the application claiming priority is filed within six months from the date of the first display of the goods.

If the goods or services to which the trademark is affixed have been displayed at the exhibition before the official opening date, the right of priority shall start from the date on which the goods or services were first displayed at the exhibition.

The officials of the exhibition held in Turkey shall supply evidence specifying the names of the goods or types of the services, the date of first display and the official opening date on which the goods or services were displayed to the public.

With respect to goods and services displayed in foreign countries, the evidence specified in the foregoing paragraph shall be supplied by the relevant authorities of the State concerned.

Goods to which the trademark is affixed may not be prevented from being displayed at an exhibition in Turkey or from being returned to their country of origin after the close of the exhibition.

Where there have been two or more applicants for a trademark registered or registration applied for in respect of the same goods or services, the applicant who first displayed the goods or services or, if both displayed at the same time, the one who files his application first shall enjoy the right of priority.

Art. 27 Effect of Priority Rights

The priority rights deriving from Articles 25 and 26 shall have effect as from the date of the application for which the priority is claimed.

Art. 28 Claiming and Evidencing of Priority

An applicant wishing to avail himself of his priority rights shall file a declaration of priority with his application for registration of a sign. If the right of priority is not substantiated within three months of the filing of the application, the declaration of priority shall be considered invalid.

Exhibition priority rights granted shall not extend the period of priority laid down in Article 25.

PART III REGISTRATION PROCEDURES

Section I Examination of the Application

Art. 29 Examination for Compliance with Filing Conditions

The Institute shall examine whether the application complies with the conditions specified in Article 23 and whether there are deficiencies. If it concludes that there are no deficiencies, the application shall be accorded as the date of filing the date, hour and minute of the original filing of the application with the Institute or with the body authorized for the purpose by the Institute.

If a priority declaration has been filed, the Institute shall undertake an examination in accordance with Articles 25, 26 and 27.

Art. 30 Remedying Deficiencies Regarding Compliance With Filing Conditions

If deficiencies regarding compliance with the conditions of Article 23 are noted, the Institute shall request the applicant to remedy those deficiencies within the period specified in the Implementing Regulations. The Institute shall refuse an application where the information identifying the applicant as provided in subparagraph (a) of Article 23 is completely or partly lacking, or where any of the documents provided for in subparagraphs (b), (c) and (d) has not been supplied.

If the applicant complies with the Institute's request and remedies, within the time specified in the Implementing Regulations, those deficiencies that fall within the scope of subparagraphs (e), (f), (g) and (h) of Article 23, the Institute shall allow the date on which the deficient application was originally filed as the date of filing.

Failure to satisfy the requirement for the claiming of priority shall result only in loss of the right of priority for the application.

Art. 31 Examination as to Entitlement

Applications filed by natural or legal persons who are not within the scope of Article 3 shall be refused.

Art. 32 Examination as to Absolute Grounds for Refusal

On concluding that there are no deficiencies regarding compliance with the conditions of filing, the Institute shall examine the application to determine whether it is eligible for registration under Article 7 in respect of all or some of the goods or services to be registered. Any application found ineligible shall be refused under Article 7 in respect

of all or some of those goods or services.

Section II Publication of the Application

Art. 33 Publication of the Application

An application for registration of a trademark that complies with the application conditions and has not been refused under Article 29, 30, 31 or 32 shall be published in the relevant Bulletin.

Where an application is refused under any of the Articles referred to in the foregoing paragraph, after publication of the application, the decision of refusal shall also be published.

Section III Observations by Third Parties

Art. 34 Observations by Third Parties

Any natural or legal person or any group representing manufacturers, producers, providers of services, traders or consumers may, following the publication of the trademark application, submit written observations to the Institute alleging that the trademark does not conform to the registration requirements under Article 7. They shall not be party to the proceedings before the Institute, however.

Art. 35 Opposition

Notices of opposition to the registration of a trademark on the ground that it may not be registered under Article 7 or 8, and notices of opposition on the ground that there is evidence of bad faith in the application, shall be submitted within three months of the publication of the application.

Opposition under the last paragraph of Article 8 shall be refused if the opposing party does not use his trademark during the period specified. Oppositions shall be submitted in writing and shall contain a statement of grounds. The Institute may request the supply of further facts, evidence and documents within the period specified in the Implementing Regulations. Where the additional facts, evidence and documents requested are not submitted within the period prescribed by the Implementing Regulations, the opposition shall be deemed not to have been made.

Art. 36 Examination of the Opposition

During the examination of the opposition, the Institute may, when it deems fit and as often as necessary, request the parties to submit observations in writing and communicate observations and objections so submitted to

the other parties involved.

The Institute may, if it sees fit, invite the parties to reach an amicable settlement.

The Institute shall refuse the opposition if it is found not to be valid. If the opposition is found to be valid for some of the goods or services for which the trademark application has been filed, the opposition shall be accepted in respect of those goods or services.

Section IV Procedural Matters Relating to Trademark Applications

Art. 37 Corrections

At the request of the applicant, corrections to spelling errors and to errors in the name and address of the applicant that do not cause any change in the goods or services or the scope of the application shall be allowed during the examination stage.

Art. 38 Withdrawal

A trademark application may be withdrawn by the applicant before it is registered.

Section V Registration

Art. 39 Registration

Where an application filed under this Decree-Law and the related Regulations has been found to be without defects, where its deficiencies have been remedied, where it has received no opposition within the prescribed period or where opposition to it has been refused, it shall be entered in the Register. The applicant shall receive a certificate of trademark registration.

The Register entry shall include: the date of registration of the trademark, the representation of the trademark, the application date, the list of the goods or services for which the trademark is to be used, the classification of the goods or services, the name and nationality of the proprietor of the trademark and the agent's name if applicable, the title, address and country of registration of the legal person, any changes relating to the trademark and to the rights in the trademark and any other particulars specified in the Implementing Regulations.

The Trademark Registry shall be open to the public. Copies of register entries shall be obtainable on request and payment of the prescribed fee. On registration a trademark shall be published as provided in the Implementing Regulations together with the information contained in the

second paragraph above.

PART IV TERM OF REGISTRATION AND RENEWAL OF A TRADEMARK

Art. 40 Term of Registration

A trademark shall be registered for a period of ten years from the date of filing of the application. Registration may be renewed for further periods of ten years.

Art. 41 Renewal

The registration of a trademark shall be renewed, on payment of the renewal fee, at the request of the owner of the rights or of the person authorized by him.

The Institute shall inform the owner of the rights of the expiry of the registration within the time specified in the Implementing Regulations. The Institute shall not be liable for failure to give such information. The request for renewal shall be submitted and the renewal fee paid within six months before the last day of the month in which protection ends. Where that time limit is not met, the request may be submitted within a further period of six months from the day referred to in the previous sentence on payment of an additional fee.

Renewal shall take effect on the day following the date on which the current registration expires. The renewal shall be entered in the Register. The provisions of this Decree-Law shall cease to have effect on trademarks that have not been renewed within the six months following expiry of the term of protection.

PART V INVALIDITY OF A TRADEMARK AND TERMINATION OF TRADEMARK RIGHTS

Section I Invalidity of a Trademark

Art. 42 Invalidity

A registered trademark shall be declared invalid by the court in the following cases:

(a) where it is at variance with Article 7 (however, actions relating to well-known trademarks within the meaning of subparagraph (i) of Article 7 have to be instituted within five years from the date of registration; where there is bad faith the time limit shall not apply);

(b) where it is at variance with Article 8 (however, with regard to proceedings instituted under the last paragraph of Article 8, if the previous owner of rights has not used his trademark during the two years following expiry of the term of protection it shall not constitute a reason for invalidity);

(c) where it is at variance with Article 14 (however, bona fide use between the date of institution of the proceedings and the expiry of the five-year period shall not constitute a reason for invalidity; if use has been made on realization that proceedings are to be instituted, the court shall not take into consideration the use made during the three months prior to the institution of the proceedings);

(d) where the trademark has become generic for the goods or services through the action of the proprietor of the trademark;

(e) where, as a result of the use made by the proprietor or by the person authorized by him, there is a likelihood of confusion on the part of the public as to the nature, quality, place of production and geographical origin of the goods or services for which it is registered;

(f) where it is used in violation of Article 59.

Where the invalidity relates to only some of the goods or services, partial invalidation shall be ordered in respect of those goods or services. Where the trademark has acquired distinctive character in relation to the goods and services for which it is to be registered through use prior to registration, the provisions of subparagraphs (b), (c) and (d) above may not be invoked in support of invalidation.

Art. 43 Application for a Declaration of Invalidity

Any injured party, the State prosecutor or related official authorities may apply to the court for invalidation.

Art. 44 Effect of Invalidity

A final decision declaring invalidity shall have retroactive effect. The retroactive effect of invalidity shall not extend to the following, but without prejudice to compensation claims for damage caused by negligence or lack of good faith on the part of the proprietor of the trademark:

- (a) a final decision on infringement of the trademark reached and enforced prior to the declaration of invalidity;
- (b) contracts concluded and executed prior to the declaration of invalidity; however, partial or total repayment of sums paid under the contract may be claimed, on the grounds of equity, to an extent justifiable by the circumstances.

A final declaration of invalidity shall be effective against all persons.

Section II Termination of Rights

Art. 45 Causes of Termination

The rights in a trademark shall terminate on:

- (a) expiry of the term of protection and failure to renew within the prescribed period;
- (b) surrender of his rights by the proprietor of the trademark.

The termination of the rights in a trademark shall have effect from the time at which the cause of the termination arose. The termination of the rights in a trademark shall be published in the current Bulletin.

Art. 46 Surrender of Rights

The proprietor of a trademark may surrender his rights in respect of some or all of the goods or services for which it is registered.

The surrender shall be declared in writing to the Institute. It shall be effective as of the date of the corresponding entry in the Register. The proprietor of a trademark may not surrender his rights without obtaining the consent of the licensees or holders of rights recorded in the Register. Where a claim on the rights is made by a third party, the surrender of the rights may not be requested without the consent of the said third party.

PART VI APPEALS AGAINST DECISIONS OF THE INSTITUTE

Art. 47 Appeals

Appeals may be lodged against decisions of the Institute. Where an appeal is lodged against an interim decision, a separate appeal shall be allowed on the decision becoming final.

Art. 48 Persons Entitled to Appeal

Any party adversely affected by a decision of the Institute may appeal. Any other parties to the proceedings shall be party to the appeal as of right.

Art. 49 Form of Appeal

A notice of appeal shall be filed with the Institute in writing within two months of the notification of the decision. The appeal fee shall be paid on the filing of the notice for the appeal to be examined. The grounds for appeal shall be submitted in a written statement within two months of the notification of the decision. Where the statement of the grounds for appeal is not submitted within that period, the appeal shall be deemed not to have been filed.

Art. 50 Rectifying a Decision

The relevant department of the Institute may rectify its decision on finding that the appeal is well-founded. This shall not apply where the appellant is opposed by another party to the proceedings.

If the appeal is not found acceptable by the relevant department, it shall be forwarded by that department to the Reexamination and Evaluation Board without any comment on its merits.

Art. 51 Examination of Appeals

The Reexamination and Evaluation Board shall consider the appeal if it is admissible.

The Reexamination and Evaluation Board shall invite the parties to submit, within the period prescribed by the Implementing Regulations, their comments on the observations of the other parties or on its own observations.

Art. 52 Decision on Appeal

After the examination, the Reexamination and Evaluation Board shall issue its decision.

Art. 53 Court Actions Against Decisions

Actions against final decisions of the Reexamination and Evaluation Board may be instituted with the competent court, within two months of notification of the said decision, in respect of the appeals provided for in Articles 47 to 52 inclusive.

PART VII GUARANTEE MARKS AND COLLECTIVE MARKS

Art. 54 Guarantee Marks

A guarantee mark shall, under the control of the proprietor of the mark, serve to guarantee the common characteristics of undertakings and of the production methods, geographical signs and quality of those undertakings.

Art. 55 Collective Marks

A collective mark is a mark used by a group of undertakings of producers or traders or providers of services.

A collective mark shall serve to distinguish the goods and services of the undertakings belonging to the group from those of other undertakings.

Art. 56 Technical Rules Governing Guarantee and Collective Marks

When an application for registration of a guarantee or a collective mark is filed, rules governing the ways and means of using the mark must also be filed.

The rules governing the guarantee mark shall contain provisions regarding the common characteristics of the goods and services under guarantee, procedures for the supervision of the use of the mark and the penalties to be imposed when necessary.

The rules governing the collective mark shall specify the undertakings authorized to use the mark. Proprietors of a collective mark shall act collectively for the registration of the mark. An application by one of the parties shall be sufficient for the renewal of a collective mark.

Art. 57 Amending the Technical Rules

Technical rules may not be amended except with the approval of the Institute. Any changes to be made in the technical rules shall be rejected by the Institute where they are at variance with the second and third paragraphs of Article 56 or contrary to public policy or principles of morality.

Art. 58 Rules Contrary to this Decree-Law

Where a technical rule does not conform to the requirements of Article 56, the Institute shall serve notice on the proprietor of the mark to make the necessary changes. Where the proprietor of the mark does not make the changes requested and amend the rule accordingly, the request for registration of the collective mark or guarantee mark shall be rejected.

Art. 59 Use in Violation of the Technical Rules

Where the proprietor of a collective or a guarantee mark disregards a

use of the mark that constitutes a violation of the technical rules, and neglects to remedy the offense within the time specified by the court in response to an action brought by one of the parties, the mark shall be invalidated by the court.

Art. 60 Transfer and Licensing

The transfer or licensing of a guarantee mark or collective mark shall become valid only on being recorded in the Register.

PART VIII INFRINGEMENT OF RIGHTS

Art. 61 Infringement

The following shall be considered infringements of a trademark:

- (a) violations of Article 9;
- (b) the use of an identical or confusingly similar trademark without the consent of the proprietor of the trademark;
- (c) the sale, distribution, putting to commercial use or importation, or holding for such purposes, of goods bearing a trademark that is known or should be known to be an unlawful imitation;
- (d) the transfer to third parties or broadening of rights acquired under a licensing contract;
- (e) participation or assistance in or any form of encouragement or promotion of the acts referred to in subparagraphs (a), (b) and (c) above;
- (f) failure to explain where and how a product bearing the registered trademark or one confusingly similar to it was obtained when found to be in possession thereof.

Art. 61A

(a) Persons who make false statements as to the true identity of the holder of the trademark rights, or those who remove without authority the notice of trademark rights properly placed on a product or on its packaging, or who falsely present themselves as owners of the rights in a trademark application or trademark shall be sentenced to imprisonment for a term of between one and two years and to a fine of between 300 million and 600 million liras.

(b) Persons who without authority transfer a trademark, deposit it as security or take any other such action with a view to the exercise of any of the rights of transfer, or who use it as security, attach it and exercise other such rights provided for in the relevant articles or held under license, and those who affix signs on a product produced or placed on sale by themselves or by others, or on the packaging thereof or in business documents or advertising material in such a way as to convey the impression that a relationship exists with legally protected trademark rights, or who to the same end use written matter, signs or expressions in advertisements and commercials in the published and visual media without being the rightful owners of the trademark, or who do the foregoing after the expiry of the term of protection or after invalidation or termination of the trademark rights, shall be sentenced to imprisonment for a term of between two and three years and to a fine of between 600 million and

1 billion liras.

(c) Those who have committed any of the offenses specified in Article 61 shall be sentenced to imprisonment for a term of between two and four years and to a fine of between 600 million and 1 billion liras, in addition to which the judgment shall order the closure of the premises of their undertaking for a period of not less than one year, during which time they shall also be prevented from practising any commercial activity. Where the offenses specified above are committed by persons working in the undertaking, either on their own initiative or on instructions given them in the course of their duties, the staff and the owner or manager or their representative or the person holding whatever title who is de facto managing the undertaking who have not prevented the offense shall be punished in the same manner. Where the offenses specified in Article 61 have been committed in the performance of tasks on behalf of a legal entity, the legal entity shall also be liable for the fines, expenses and damages in place of the actual persons who have committed the offense. For those assisting in the acts, depending on the nature of the action, the provisions of Articles 64, 65, 66 and 67 of the Turkish Penal Code shall apply. Prosecution for the offenses specified above shall take place on a complaint.

Subparagraph 8 of paragraph 1 of Article 344 of Criminal Procedure Code No. 1412 shall not apply to the implementation of this Article. The right of complaint shall belong to the person whose trademark rights have been infringed, and also to the Institute for all offenses except those provided for in Article 61; it shall belong to consumer associations and to establishments governed by Law No. 5590 or 507 for false statements as to the true identity of the holder of the trademark rights, for the affixing of signs on a product produced and placed on sale by oneself or by others, or on the packaging thereof or in commercial documents or advertising material in such a way as to convey the impression that a relationship exists with protected trademark rights, for the use to the same end of written matter, signs or expressions in advertisements and commercials in the published and visual media without being the rightful owner of the trademark, or for such acts performed after the expiry of the term of protection or after invalidation or termination of the trademark rights. Proceedings against such offending acts should be initiated within two years of the date on which the offending act and the offender became known. Complaints concerning acts falling within the scope of this provision shall be treated as urgent matters. The provisions of Article 36 of the Turkish Penal Code and the relevant Articles of the Criminal Procedure Code shall apply to the seizure, confiscation or destruction of the goods,

and of the equipment and machinery used to produce those goods, in relation to which offenses have been committed through infringement of the rights arising from a trademark application or a protected trademark in accordance with this Decree-Law.

Art. 62 Action by the Proprietor of the Trademark

The proprietor of a trademark whose rights have been infringed may in particular apply to the court for the following:

- (a) cessation of the infringing acts;
- (b) remedies for infringement and compensation for damages incurred;
- (c) confiscation of the goods, and the equipment and machinery used to produce those goods, by which the trademark rights have been infringed, such production and use being an offense;
- (d) recognition of ownership of the goods confiscated under subparagraph (c), above, in which case the value of the goods shall be deducted from the compensation awarded; where the value of the goods is found to be greater than the compensation value awarded, the proprietor of the trademark shall repay the balance to the infringing party;
- (e) enforcement measures to prevent the continued infringement of rights, removal of the trademark from the goods and from vehicles or, if essential for the prevention of the acts of infringement, destruction of the goods and vehicles confiscated in particular under subparagraph (c), above;
- (f) disclosure of the court judgment to the public and to those concerned, the cost thereof to be met by the offending party.

Art. 63 Competent Courts

The competent court for the institution of civil proceedings by the proprietor of a trademark against third parties shall be the court of the domicile of the plaintiff, the place in which the act was committed or the place in which the act had effect.

Where the plaintiff is not a citizen of the Republic of Turkey, the competent court shall be that of the domicile of the authorized agent entered in the Register or, if the agent's registration has been cancelled, that of the domicile of the Institute.

The competent court for the institution of proceedings by third parties against the proprietor of a trademark shall be the court of the domicile of the defendant. If the applicant for or holder of trademark rights is not domiciled in Turkey, the provisions of the second paragraph above shall apply.

Where there are several competent courts, the court at which the proceedings

are instituted first shall be the competent court.

Art. 64 Compensation

The person who, without the consent of the proprietor of the trademark, produces, sells, distributes or puts to commercial use, or imports or keeps in his possession for those purposes, a product that unlawfully imitates the trademark shall be responsible for remedying the illegality and compensating for any damage he has caused.

A person who uses an unlawful imitation of a trademark, having been informed of the infringement by the proprietor of the trademark and requested to stop the infringement or any other misuse that may exist, shall be liable to compensate for the damage he has caused.

Art. 65 Documents Evidencing Infringement

The proprietor of a trademark may request from the infringing party the documents relating to the use of the trademark without his consent, for assessment of the injuries suffered as a result of the trademark infringement.

Art. 66 Non-Realization of Profits

The injuries suffered by the proprietor of the trademark shall include not only the value of the actual loss but also the income not realized owing to the infringement of trademark rights.

The loss of income shall be calculated according to one of the following criteria at the discretion of the proprietor of the trademark who has suffered the injury:

- (a) the potential income that the proprietor of the trademark would have realized if there had been no competition from the infringing party;
- (b) the income actually realized by the infringing party from the use of the trademark;
- (c) the license fee that would have been paid if the party infringing the trademark rights had made use of the trademark under a legal licensing contract. The calculation of the profits not realized shall take into account, in particular, the economic value of the trademark, the term of protection remaining at the time of infringement, the type and number of the licenses outstanding and similar factors.

Art. 67 Increasing the Amount of the Profits Not Realized

Where the proprietor of the trademark has selected one of the calculation methods specified in subparagraphs (a), (b) and (c) of Article 66, the

court may add a reasonable additional amount if, in its opinion, the trademark contributes substantially to the economic value of the product. The assessment of the trademark's contribution to the economic value of the product shall be based on verification that the demand for the product is to a large extent due to the trademark.

Art. 68 Reputation of the Trademark

The proprietor of a trademark may request extra damages for the harm done through the improper use of the trademark by the infringing party that was detrimental to the reputation of the sign.

Art. 69 Persons Against Whom Action May Not Be Brought

The proprietor of a trademark may not institute proceedings under this Part of this Decree-Law against those who have used goods placed on the market by a person who has paid compensation to him. This provision shall not apply if there is evidence of bad faith.

Art. 70 Time Limits

The provisions of the Code of Contractual Obligations on time limits shall apply to the time limits for action against infringements of trademark rights.

Art. 71 Competent Courts

Special courts to be established by the Ministry of Justice shall have jurisdiction over all actions and claims provided for in this Decree-Law. The High Council of Judges and Prosecutors shall determine which of the commercial courts of first instance and criminal courts of first instance are to be appointed as special courts, and shall specify the jurisdiction of each on a request from the Ministry of Justice.

The special courts referred to in the first paragraph above shall have jurisdiction over actions brought against decisions of the Institute under this Decree-Law and over actions brought against the Institute by third parties who have suffered from its decisions.

Art. 72 Publication of Court Decisions

Where a court judgment has become final, the successful party may request the publication in full or in summary form of the final judgment in a daily paper, on radio or television or by any other medium of communication, the cost thereof to be met by the other party.

The nature and extent of the publication shall be specified in the judgment. The right of publication shall be void if not exercised within three months

of the judgment becoming final.

Art. 73 Action by the Licensee

Unless otherwise provided in the contract, the holder of an exclusive license may, in the event of infringement of the trademark rights, institute in his own name all legal proceedings that have been made available to the proprietor of the trademark by this Decree-Law. Holders of non-exclusive licenses shall not have the right to institute legal proceedings.

In the event of infringement, the holder of a non-exclusive license may, through a notary public, serve notice on the proprietor of the trademark to institute such proceedings as may be required.

In the event of the proprietor of the trademark right refusing or, within three months of receipt of the aforesaid notice, failing to institute proceedings, the non-exclusive license holder shall have the right to institute proceedings.

In the event of serious damage that will persist with the passage of time, the licensee may apply to the court for the issue of a restraining injunction. A licensee who has instituted proceedings under the third paragraph above shall notify the proprietor of the trademark that the proceedings have been instituted.

Art. 74 Claims of Non-Infringement

Any interested party may institute proceedings against the proprietor of a trademark to obtain a non-infringement ruling.

Prior to the institution of proceedings under the foregoing paragraph, a notice shall be sent through a notary public for the attention of the proprietor of the trademark to enable the holder of the trademark rights to express his observations on whether the trademark to be used on the goods being or to be produced by the requesting party in Turkey infringes the said trademark rights.

Where the proprietor of the trademark, on receiving such a notice, does not respond within a month of receipt thereof, or where the content of the response is not found acceptable by the requesting party, the latter party shall have the right to institute proceedings under the first paragraph above.

Persons against whom infringement actions have been brought in respect of the trademark rights may not institute proceedings under the first paragraph above.

The institution of proceedings shall be communicated to all holders of rights who are entered in the Register.

The actions referred to in this Article may also be instituted in conjunction with an invalidation action.

Art. 75 Action to Secure Evidence

Any person legally entitled to bring action under this Decree-Law may request the court to determine and secure evidence of acts of trademark infringement.

Art. 76 Precautionary Measures

Any person legally entitled to bring action under this Decree-Law may request the court to order precautionary measures provided that he can prove the existence of acts of actual use of the trademark or serious preparations for such use that would constitute infringement.

The request for precautionary measures may be filed before or on the institution of proceedings or later. The request for precautionary measures shall be examined separately.

Art. 77 Nature of the Precautionary Measures

The precautionary measures shall be of such a nature as to permit the securing of the judgment, and shall in particular provide for the following:

- (a) cessation of acts of infringement of the plaintiff's trademark rights;
- (b) seizure within the borders of Turkey, including at the customs or in free ports or free trade areas, and the holding in custody, of produced or imported goods that have infringed the trademark rights;
- (c) provision of security for such damage as may have to be compensated.

Art. 78 Civil Procedure Code

With respect to other securing actions and precautionary measures, the provisions of the Civil Procedure Code shall apply.

Art. 79 Seizure at Customs

The customs authorities shall withhold as a precautionary measure, on either exportation or importation, goods that have infringed the rights in a trademark.

Withholding procedures shall be laid down by legislation to be enacted for the purpose.

The withholding measure applied by the customs authorities shall cease to have effect if proceedings are not instituted before the special court or if a restraining injunction is not obtained from the court within 10 days of the said measure.

PART IX REPRESENTATION AND AGENTS

Art. 80 Representation Before the Institute

Representation before the Institute in trademark matters may only be undertaken by the following:

- (a) natural or legal persons who have filed an application; legal persons may only be represented by those duly empowered to do so by their authorized bodies;
- (b) trademark agents.

Persons domiciled outside the country may only be represented by trademark agents.

Where an agent has been appointed, all procedures shall be conducted through him. All notices made to the agent shall be considered to have been made to his principal.

PART X PAYMENT OF FEES AND LEGAL EFFECTS

Art. 81 Conditions of Payment of Fees and Effects

The fees prescribed by the Implementing Regulations for the filing of an application and for a registered trademark shall be paid by the applicant, by the proprietor of the trademark or by the trademark agent.

Where the prescribed fees for the registration of a trademark have not been paid within the period provided for in this Decree-Law, the application for the registration of the trademark shall be deemed to have been withdrawn.

PART XI FINAL PROVISIONS

Art. 82 Provisions Repealed

Trademark Law No. 551 of March 3, 1995, is hereby repealed.

TRANSITIONAL PROVISIONS

1. The provisions of the Law valid on the date of the application shall apply to applications for the registration of a trademark filed prior to the entry into force of this Decree-Law.

Without prejudice to all acts of transfer or inheritance and licensing contracts concluded and registered prior to the entry into force of this Decree-Law, the provisions of this Decree-Law shall apply to any further action or changes in relation to such matters.

2. Those who have actually made use of their service marks may request registration thereof by filing evidence of such use within 12 months of the entry into force of this Decree-Law.

The Institute shall examine the requests of service mark users after the expiry of 12 months, taking into consideration the date of first use.

3. For the purposes of this Decree-Law, until the special courts are established, at the request of the Ministry of Justice, the High Council of Judges and Prosecutors shall select, from among the commercial courts of first instance and the criminal courts of first instance, those to be appointed as special courts, and shall specify the jurisdiction of each.

Art. 83 Entry Into Force

This Decree-Law shall enter into force on the day of its publication.

Art. 84 Execution

This Decree-Law shall be executed by the Council of Ministers.