



Study Question

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Bad faith trademarks

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I. Current law and practice

Bad faith - prior third party use or filing

1 Does your Group's current law provide for an action against the application or registration for a trademark in a jurisdiction by a party (Party A), if that trademark or a similar sign is already used in one or more jurisdictions by another party (Party B), but is not registered in the jurisdiction where Party A has filed the trademark?

If yes, please answer questions 2) – 7). If no, please go to question 8).

Yes

Please Explain

2 Is the application or registration as described under question 1) above denoted as "bad faith"? If not, what is it called?

Yes

Please Explain

Bad faith is not specifically defined under Turkish laws. The application or registration described under question 1 may be evaluated on the basis of bad faith, but also on the basis of prior use or other relevant grounds depending on the specific circumstances.

3 Are the following factors relevant for proving an application or registration as described under question 1) in your jurisdiction?

Please tick or fill in all boxes as applicable to your jurisdiction. If you select "other", please describe further.

- Party A knows, or should reasonably be aware, of use of an identical or similar sign abroad for identical goods or services

Please Explain

- Party A knows, or should reasonably be aware, of use of an identical or similar sign abroad for similar goods or services

Please Explain

- Party A knows, or should reasonably be aware, of use of an identical or similar sign in the same jurisdiction for identical goods or services

Please Explain

- Party A knows, or should reasonably be aware, of use of an identical or similar sign in the same jurisdiction for similar goods or services

Please Explain

- Party A intends to prevent Party B from continuing to use the earlier sign or to only allow such under certain conditions (e.g. a license)

Please Explain

- the degree of legal protection enjoyed by Party B

Please Explain

4 Is any one or more of the above factors sufficient on their own, or will the assessment instead always take the specific circumstances of the case into account? If one or more of those factors are sufficient on their own, please identify those factors.

No

Please Explain

None of the above listed factors are sufficient on their own to establish bad faith. The assessment takes the specific circumstances into account.

In practice, however, bad faith would likely be accepted directly if Party A is aware of the fact that Party B owns a similar or confusingly similar trademark and this is proven by evidence.

5 Which of the following factors are relevant to establishing whether there was or should have been knowledge as described under question 3) above?

Please tick or fill in all boxes as applicable to your jurisdiction. If you select "other", please describe further.

- whether Party A operates in the same or a similar field of business as Party B

Please Explain

- whether the earlier sign is well known or enjoys a reputation

Please Explain

- whether there have been formal or informal dealings or contact between Party A and B (such as an agreement, written communication etc.)

Please Explain

- other

Please Explain

- Whether the earlier sign includes original and highly distinctive words or devices, which are registered or used in or out of the country in the name of/by Party B and which are not possible to be chosen or formed coincidentally; and
- Whether Party A systematically files for trademarks that are registered and/or recognized abroad or within Turkey.

6 Is the degree of similarity between the signs relevant? Please explain why in either case.

Yes

Please Explain

The degree of similarity between the signs is relevant in determination of bad faith. Even in cases where the word elements are different, such factors as the similarity of the fonts, colour combinations, stylizations, device elements and overall similarity are taken into consideration during the evaluation of the degree of similarity between the signs. The higher the degree of similarity between the signs is, the higher the possibility that the bad faith of Party A may be accepted. Where the degree of similarity between the signs is low, the possibility of choosing of such sign as a matter of coincidence increases.

7 Is the degree of similarity between the goods/services relevant? Please explain why in either case.

Yes

Please Explain

The degree of similarity between the goods/services is relevant. The higher the degree of similarity between the goods/services is, the higher the possibility that the bad faith of Party A may be accepted. However, even in cases where the identical or confusingly similar signs cover totally different goods/services, the bad faith of Party A may be accepted depending on the specific circumstances of the case (such examples include but are not limited to the degree of recognition, originality, distinctive character of the sign of Party B, the issue as to whether there existed/exists any past/current relationship between the parties.)

Repeat filings

8 Can the filing of a trademark in your Group's jurisdiction by a trademark owner for a trademark identical or similar to a trademark it already owns in that jurisdiction be refused or cancelled on the ground that the previous trademark fails to meet applicable genuine use requirements?

If yes, please answer questions 9) -11). If no, please go to question 12).

No

Please Explain

9 Is the application or registration as described under question 8) above denoted as "bad faith"? If not, what is it called?

10 Which of the following factors are relevant when assessing whether a trademark as described under question 8) should be refused or cancelled?

Please tick or fill in all boxes as applicable to your jurisdiction. If you select "other", please describe further.

11 Are the answers to questions 8) -10) above different if the previous trademark is no longer in force? Please explain.

Defensive marks

12 Is it permissible under your Group's current law to file a trademark if the trademark owner does not have any intent to use that trademark for part or all of the goods/services claimed? If not, is there a timeframe (and if so, what) for such intention to use (e.g. must the intent be to start use immediately)?

If yes, please answer question 13). If no, please go to question 14).

Yes

Please Explain

13 Is the application or registration as described under question 12) above denoted as "bad faith"? If not, what is it called?

No

It is called...

It is not denoted as "bad faith". There is no specific, established definition for such defensive marks in Turkish laws. Intent to use is not required in trademark application process.

Other

14 Does any other conduct in respect of trademarks, as an independent ground for action, amount to bad faith ¹⁶ under your Group's current law? If so, what conduct and how is it denoted, ie as "bad faith" or something else?

¹⁶ Including fraud within the context of this Study Question, as explained on p. 1 at paragraph 5.

The assessment of bad faith takes the specific circumstances of the case into account. The following examples can be considered as indications of bad faith:

Such signs including but not limited to those;

- that include original and highly distinctive words or devices, which are registered or used in or out of the country in the name of/by the other party and which are not possible to be chosen or formed coincidentally;
- which are identical or similar to the signs/trademarks of the other party, which are highly distinctive and well-recognized in the market, and the registration of which will lead to a likelihood of association or unfair advantage considering the claimed goods/services;
- which are filed by a party that has a contract, preliminary contract, trade or employer-employee relationship with the other party and which are identical or confusingly similar to the other party's signs/trademarks that are original with respect to colour, design, script and layout etc.;
- which are filed with the intention of registering a domain name of the other party as a trademark to sell or rent it to the genuine owner thereof or prevent the competitor company's commercial activity
- where the applicant systematically files for trademarks that are registered abroad or within Turkey, acts with the purpose of forcing the genuine owner of the trademark into making an agreement or selling their trademark, preventing their competitors and the products thereof from entering into the market, etc.

Type of proceedings

15 In which proceedings can the grounds, insofar as they are available under your Group's current law, described in your response to questions 1), 8), 12) and 14) above be invoked in your jurisdiction?

Please tick or fill in all boxes as applicable to your jurisdiction. If you select either of the last two boxes, please describe further.

- opposition proceedings (before the trademark/IP office)

Please Explain

- court proceedings concerning a bad faith application

Please Explain

- court proceedings concerning a bad faith registration

Please Explain

II. Policy considerations and proposals for improvements of your current law

6.a Could any of the following aspects of your Group's current law be improved?

The possibility of taking action against the application or registration of a trademark in a jurisdiction by a Party A, if that trademark or a similar sign is already used in one or more jurisdictions by a Party B, but is not registered in the jurisdiction where Party A has filed the trademark

Please tick or fill in only the applicable box. If you select "yes", please explain.

No

Please Explain

6.k Could any of the following aspects of your Group's current law be improved?

The possibility of taking action against or refusing the refiling of a trademark by a trademark owner as described above under question 8) above

Please tick or fill in only the applicable box. If you select "yes", please explain.

Yes

Please Explain

Repeat filings are not an absolute or relevant ground for refusal in Turkey thus is not examined by the local authority. As a policy consideration; repeat filings might be considered as a ground for opposition within the concept of bad-faith and that applicant's intention of repeat filing could be questioned upon third party oppositions.

It is, however, necessary to clarify whether the subsequent application has been made to overcome the genuine use requirements of the previous application or to avoid non-use cancellation actions, in order to treat a repeat filing as bad faith.

This should not be a new legal arrangement, but an improvement with the interpretation that repeat filing can be considered as a type of bad faith application would be appropriate.

6.c Could any of the following aspects of your Group's current law be improved?

The possibility of taking action against or refusing the filing of a trademark by a trademark owner without an intent to use such for part or all of the goods/services claimed as described above under question 12) above.

Please tick or fill in only the applicable box. If you select "yes", please explain.

No

Please Explain

6.d

Could any of the following aspects of your Group's current law be improved?

The possibility of taking action against other conduct as described in your response to question 14) above.

Please tick or fill in only the applicable box. If you select "yes", please explain.

No

Please Explain

17

Are there any other policy considerations and/or proposals for improvement to your current law falling within the scope of this Study Question?

No.

Proposals for harmonisation

18

Does your Group consider that harmonisation in any or all of the four areas described in question 16) above is desirable?

If yes, please respond to the following questions without regard to your Group's current law.

Even if no, please address the following questions to the extent your Group considers your Group's current law could be improved.

No

Please Explain

Harmonization regarding bad faith relating to the actions described under question 16 is not desirable since different circumstances may cause a need to analyze those four areas case by case showing that bad faith is a subjective issue in all those four areas.

19

Does your Group consider there should be a harmonised definition of bad faith?

Please tick or fill in only the applicable box. If you have different reasons for selecting "no" or "yes" to those identified, please explain.

No; identifying circumstances that can be relevant in assessing whether the types of conduct identified above under question 16) are allowed can be helpful, but a definition as such does not allow sufficient flexibility

Please Explain

Bad faith - third party use or filing

20 Should it be possible to take action against the application or registration for a trademark in a jurisdiction by a Party A, if that trademark or a similar sign is already used in one or more jurisdictions by a Party B, but is not registered in the jurisdiction where Party A has filed the trademark?

If yes, please answer questions 21) – 25). If no, please go to question 26).

Yes

Please Explain

21 Which of the following should be relevant factors for proving an application or registration as described under question 20)?

Please tick or fill in all relevant boxes. If you select "other", please describe further.

- Party A knows, or should reasonably be aware, of use of an identical or similar sign abroad for identical goods or services

Please Explain

- Party A knows, or should reasonably be aware, of use of an identical or similar sign abroad for similar goods or services

Please Explain

- Party A knows, or should reasonably be aware, of use of an identical or similar sign in the same jurisdiction for identical goods or services

Please Explain

- Party A knows, or should reasonably be aware, of use of an identical or similar sign in the same jurisdiction for similar goods or services

Please Explain

- Party A intends to prevent Party B from continuing to use the earlier sign or to only allow such under certain conditions (e.g. a license)

Please Explain

- the degree of legal protection enjoyed by Party B's sign and the sign used by party A

Please Explain

22 Should any one or more of the above factors be sufficient on their own, or should the assessment instead always take the specific circumstances of the case into account? If one or more factors should be sufficient on their own, which should they be?

The assessment should always take the specific circumstances into account and examine the existence of bad-faith case by case.

The significance of specific assessment especially arises where:

- Party B's sign is not inherently distinctive, is diluted or a weak sign;
- Bad faith assessment would vary depending on the likelihood of potential consumer confusion based on the level of perception of the targeted consumer e.g. children, academicians, professionals, women.
- The stylization and layout of Party A's sign is identical to that of the sign as used by Party B.
- Party B's sign has been registered in numerous different countries around the world for identical or directly related goods/services;
- Party B's sign has a broad geographical scope of protection and distribution channels,
- Party A has a legitimate interest in the sign applied for, e.g. the sign may be applicant's name etc.
- Party A systematically files/registers trademarks that are owned by third parties and/or recognized abroad or within the same jurisdiction.
- Party's B's scope of commercial activity is specific, such as aviation, mining, energy.

23 Which of the following should be relevant when establishing whether there was or should have been knowledge as described above under question 21) above?

Please tick or fill in all relevant boxes. If you select "other", please describe further.

- whether Party A operates in the same or a similar field of business as Party B

Please Explain

- whether the earlier sign is well known or enjoys a reputation

Please Explain

- whether there have been formal or informal dealings or contact between Party A and B (such as an agreement, written communication etc.)

Please Explain

- other

Please Explain

- whether Party A coexists and operates in same jurisdiction as Party B.
- whether Party A filed any obstructive trademarks or involved in any unfair competition practices in the past, which can set an example.

24 Should the degree of similarity between the signs be relevant? Please explain why or why not.

Yes

Please Explain

The degree of similarity between the signs should be relevant.

Even in cases where the word elements are different, such factors as the similarity of the fonts, color combinations, stylizations, device elements and overall similarity should be taken into consideration during the evaluation of the degree of similarity between the signs. The higher the degree of similarity between the signs is, the higher the possibility that the bad faith of Party A may be accepted.

25 Should the degree of similarity between the goods/services be relevant? Please explain why or why not.

Yes

Please Explain

The degree of similarity between the goods/services should be relevant. The higher the degree of similarity between the goods/services is, the higher the possibility that the bad faith of Party A may be accepted. However, even in cases where the identical or confusingly similar signs cover totally different goods/services, the bad faith of Party A may be accepted depending on the specific circumstances of the case.

Repeat filings

26 Should it be possible to refuse or cancel the filing by a trademark owner of a trademark identical or similar to a trademark it already owns in your Group's jurisdiction on the grounds that it fails to meet applicable genuine use requirements?

If yes, please answer questions 27) – 28). If no, please go to question 29).

Yes

Please Explain

Repeat filings should not be an absolute ground of refusal. However, repeat filing might be considered as a ground for opposition within the concept of bad-faith and that applicant's intention of repeat filing could be questioned upon third party oppositions.

27 Which of the following factors should be relevant when assessing whether a trademark as described under question 26) above should be refused or cancelled?

Please tick or fill in all relevant boxes. If you select "other", please describe further.

- the degree of overlap between the goods/services

Please Explain

Yes. In order for the latter application to be considered as a repeat filing the goods and services of new application should be identical to or covered by the earlier mark's goods and services.

Refusal or cancellation of a repeat filing should only affect the goods and services which are covered by the previous registration. Unless there is evidence to the contrary, the act of registering a sign for new classes of goods/services should not on its own demonstrate bad faith.

- whether or not the signs are identical

Please Explain

Yes. The signs should be identical or at least indistinguishably similar.

- if the signs are different, the degree of difference

Please Explain

Yes. Insignificant differences which do not alter distinctive character of the sign might be disregarded.

- absence or presence of intent to use

Please Explain

Yes.

- other intentions (e.g. the filing of an updated version of a trademark to meet evolving market requirements)

Please Explain

Yes, depending on significance of the difference between the earlier and latter sign.

- number of goods/services

Please Explain

No. The significant point is whether the list of goods and services of earlier mark are conflicted with the list of goods of the new application.

- other

Please explain how each of the factors selected above should influence the assessment.

An allegation of bad faith is a serious allegation that must be proven on the balance of probabilities based on that the assessment should take the specific circumstances into account.

28 Should the answers to questions 26) - 27) above be different if the previous trademark is no longer in force? if so, how?

The answers might be different; depending on the ground why the earlier mark is no longer in force.

If the earlier mark is withdrawn/cancelled upon the owner's request, then the latter application might be subject to refusal.

If the earlier mark is cancelled through a Court decision based on non use and that the latter mark is filed during or after finalization of the Court proceedings the latter application might be refused or at least (intent of applicant) questioned, if for instance the plaintiff in the lawsuit opposes the latter one.

However, if the earlier mark is lapsed due to non-renewal, such might not be a sufficient ground for refusal of the latter application; there is a possibility that the applicant missed the deadline to renew his earlier registration by mistake or by missing the deadline for any reason.

Defensive marks

29 Should it be permissible to file a trademark if the trademark owner does not have any intent to use that trademark for part or all of the goods/services claimed? If not, should there be a timeframe (and if so, what) for such intention to use (e.g. must the intent be to start use immediately)? Please explain.

Yes. Due to potential long term business plans of the applicant, it should be permissible to file a trademark application for a broad specification of goods and services. Lack of use of a trademark should be subject to cancellation upon third party claims after a certain time has passed.

Other

30 Should any other conduct in respect of trademarks, as an independent ground for action, amount to bad faith ¹⁷? If yes, please explain.

¹⁷ Including fraud within the context of this Study Question, as explained on p. 1 under paragraph 5 above.

No. bad faith should be assessed in its entirety considering all of the factors of significance in each individual case.

Type of proceedings

31 In which proceedings should it be possible to invoke the grounds described in your response to questions 20), 26), 29) and 30) above, inasfar as they should be grounds for action in your view?

Please tick or fill in all boxes. If you select either of the last two boxes, please describe further

- opposition proceedings (before the trademark/IP office)

Please Explain

- a cancellation action (before the trademark/IP office)

Please Explain

- court proceedings concerning a bad faith application

Please Explain

- court proceedings concerning a bad faith registration

Please Explain

Other

32

Please comment on any additional issues concerning bad faith (or equivalent concepts) in the context of trademark law you consider relevant to this Study Question.

- The agent or the representative carries out bad faith registration towards the trademark which is used by the genuine trademark owner/client,
- A pattern of registering trademarks that are deliberate misspellings of other registered trademarks;

Please indicate which industry sector views are included in part "III. Proposals of harmonization" on this form:

Please enter the name of your nominee for Study Committee representative for this Question (see Rule 12.8, Regulations of AIPPI). Study Committee leadership is chosen from amongst the nominated Study Committee representatives. Thus, persons not nominated as a Study Committee representative cannot be in the Study Committee leadership.

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