



client alert

INTELLECTUAL PROPERTY | TURKEY |

MAY 2015

CONSTITUTIONAL SUPREME COURT WEAKENS 'SINGULARITY' IN TURKISH TRADEMARK REGULATION

In a decision published in the Official Gazette on 15 May 2015, Article 16 sub-clause 5 of Decree-Law no. 556 on the Protection of Trademarks was struck down by the Constitutional Supreme Court of Turkey.

Article 16 sub-clause 5 of Decree-Law no. 556 stated, "During the assignment of a registered trademark, if there are other trademark registrations for the same trademark or for confusingly similar trademarks for the same or similar goods and services at a level that may mislead the public, such trademarks must also be assigned". This article is an extension of sub-clause 1/b of Article 7 (regulating absolute grounds for refusal) of the same Decree-Law, which stipulates that trademarks that are the same as or confusingly similar to previous trademark registrations or applications for the same or similar goods and services cannot be registered as trademarks. These articles are widely considered to be the basis of 'singularity' in Turkish Trademark Law.

The 3rd Civil Court of Intellectual Property in Ankara challenged Article 16 sub-clause 5 on the grounds of several principles of the Turkish Constitution, including Fundamental Rights and Liberties, the Right of Property and the Freedom of Contract. The Civil Court asserted that Article 16 sub-clause 5 has a scope that extends far beyond Article 7 with respect to the issue of misleading the public. In addition, the Court remarked that the notion of singularity as protected by Articles 7 sub-clause 1/b and 16 sub-clause 5 of the Decree-Law are not consistent with the Freedom of Contract or international trademark regulations (The Civil Court could not challenge Article 7 sub-clause 1/b as it was not directly related to the case at hand). Finally, the Civil Court also reasoned that in accordance with Article 91 of the Turkish Constitution, property rights cannot be regulated by decree-laws.

The Constitutional Supreme Court examined the challenge only with respect to Article 91 of the Turkish Constitution and established its decision to strike down Article 16 sub-clause 5 of the Decree-Law on this basis. Thus, Article 16 sub-clause 5 has become one of several Decree-Law no. 556 provisions to be cancelled only on the grounds of Article 91 of the Turkish Constitution.

While Article 7 sub-clause 1/b remains in force, pursuant to the cancellation of Article 16 sub-clause 5, serial trademarks can now be partially assigned without consideration for whether the public may be misled with regard to the similarity of the trademarks and/or goods or services involved.

The general opinion of both the Turkish doctrine and practitioners is that the Decree-Law is not sufficient to protect trademark rights efficiently. The Draft Law on Trademarks was submitted to the Turkish Grand National Assembly in 2009, but has remained in committee for deliberation ever since.

In compliance with Turkish Bar regulations, opinions relating to Turkish law matters that are included in this client alert have been issued by Özdirekcan Dündar Şenocak Avukatlık Ortaklığı, a Turkish law firm acting as correspondent firm of Gide Loyrette Nouel in Turkey.

CONTACTS

MATTHIEU ROY

roy@gide.com

ESRA DUNDAR LOISEAU

dundar@odsavukatlik.com

You can also find this legal update on our website in the News & Insights section: gide.com

This newsletter is a free, periodical electronic publication edited by the law firm Gide Loyrette Nouel (the "Law Firm"), and published for Gide's clients and business associates. The newsletter is strictly limited to personal use by its addressees and is intended to provide non-exhaustive, general legal information. The newsletter is not intended to be and should not be construed as providing legal advice. The addressee is solely liable for any use of the information contained herein and the Law Firm shall not be held responsible for any damages, direct, indirect or otherwise, arising from the use of the information by the addressee. In accordance with the French Data Protection Act, you may request access to, rectification of, or deletion of your personal data processed by our Communications department (privacy@gide.com).