

You use your Mark in Turkey, but can you correctly prove it?

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As many of you are aware of, since 10 January 2017 Turkey has a New IP Law (Number 6769) in force. One of the most important points in the New Law regards opposition proceedings. The Applicant now has the right to request their Opponent(s) to prove serious and genuine use of its mark in Turkey in the last 5 years or submit justified reasons thereof, if the Opponent's mark passed the 5 years use term on the filing/priority date of opposed mark. If such use cannot be proven, then the opposition would be dismissed regarding the argument based on opponent's earlier registered mark, yet other arguments such as bad faith, well-knownness, company name, etc., can still be examined.

Since the practice is brand new for Turkey and for the Turkish Patent and Trademark Office (TPTO), a lot of discussion has been going on since January as to how this article will be applied.

Recently the TPTO published a Guideline indicating how the 'request for proof of use' can be claimed by the Applicants, and 'evidence of use' should be submitted by the Opponents.

'Evidence of Use' can be submitted in two different levels:

1. either at the time of filing the opposition with the opposition writ, or
2. after the opposition is filed when the Applicant requests the Opponent to prove genuine and serious use in Turkey.

Normally when a mark is opposed, the TPTO informs the Applicant and gives him/her one month time to submit his/her counter arguments and evidence. The Guideline states that now, within this one month time frame, the Applicant can not only submit his counter arguments but with the same form can also ask the Opponent to prove use of the mark upon which the opposition is based. Or alternatively, should the Applicant not submit any counter arguments, evidence of such use can be requested by a letter to the TPTO using the wording provided in the Guideline.

After being notified, the Opponent has one month time to provide evidence of use.

The Guideline sets out the following guidance for the filing of 'Evidence of Use':

- a. Include a list of the evidence provided, categorized by type and indicating number.
- b. Mark each piece of evidence with the registration number of the mark for which use is sought to be proven.
- c. It is advised that the total number of pages submitted should not exceed 100 pages.
- d. Page numbers and total page numbers must be clearly indicated.
- e. Documents and their attachments should be scanned in A4 format.

- f. Information and documents should NOT be sent in hardcover nor stapled.
- g. Evidence would include but need not be limited to packages, price lists, catalogs, invoices, photographs, and newspaper/magazine advertisements. On each sample of use provided, the parts showing the mark should be marked clearly.
- h. Do not include the physical product samples - ONLY scanned pictures are to be submitted.

NOTE: Should the TPTO find any deficiencies in the evidence submitted then they will allow the Opponent one extra month to comply with the necessities for any evidence that is:

- not clear,
- not readable,
- not classified appropriately,
- could not be understood (its relation with the opponent's mark),
- and that could not be linked to the matter.

If such deficiencies are not addressed satisfactorily within one month, the relevant pieces of evidence will be disregarded.

IMPORTANT: While completing the deficiencies, the Opponent may NOT expand the scope of his opposition.

TPTO has provided a sample "Form of Use" in the Guideline as well.

Requirements for submitting evidence under different Categories:

Invoices

- TPTO advises that invoices are considered the strongest evidence of use.
- Should prove use in Turkey.
- Should include information linked to the mark where the opposition is based.
- Date should be indicated and readable.
- Amounts stated need to be consistent with the goods/services indicated.
- If there is more than one mark stated on an invoice then the part related to the mark based in opposition should be clearly indicated.
- If goods stated are not clear then additional information needs to be provided.
- Invoices need to be in chronological order, showing a continuous commercial effect.

Catalogs, Price Lists and Product Codes

These documents may not prove genuine use of the mark itself, but can be supportive if they are submitted along with invoices and bear dates. If the products are indicated with product codes, then additional explanation stating which code refers to which product should be provided by referring to invoice number and its date. Otherwise invoices that cannot be linked to a product would not be taken into account.

Products, Packages and Signboard Samples

Submit digital (scanned) images. They provide good evidence particularly if they bear a date. In some instances, packaging might be updated, therefore pictures showing old and new package samples are recommended.

Advertisements, Publicity, Promotion Materials, Market and Public Research

These evidence materials (pictures) need to show the mark and the goods/services provided clearly. Videos, visuals and sound recording are all accepted and need to be submitted in electronic / digital format.

Pictures of promotion materials such as key holders, calendars, notebooks, agendas etc., are also acceptable. TPTO recommends invoices showing promotion and advertisement costs be submitted as well.

Market and Public Researches - are not considered 'first degree of evidence' but can be supportive to the other evidence submitted.

Fairs

Visuals (pictures, video recordings, etc.) showing attendance to Fairs, Certificate of Attendance, costs to attend the Fair, all fall within this category and are admissible as evidence.

Information about Commercial Activities

Instead of focusing on the brand owner (Opponent), the focus should be given to the brand. For example:

- evidence showing distribution channels in Turkey and abroad
- branches of the brand owner
- profit
- service network
- number of stores
- awards, quality certificates

All of these will be considered as supporting evidence to the other evidence provided.

Regarding online sales - as long as the brand and good/services can be linked and seen, visuals from the website are accepted. If the brand is the main element of the Opponent's domain name, then web statistics such as hit/entry and/or numbers/statistics can be supportive evidence.

Affidavits and Statements

Can be taken from experts in that field and/or from suppliers / customers / sellers / distributors etc. The TPTO requests that the affidavits or statements be written with clear and concrete wording.

In addition to all of the above, if the Opponent has other relevant evidence to submit, he/she is welcome to submit them as long as they are submitted in a clear and appropriate format and listed.

In a nutshell, we strongly recommend the following:

1. Continually collect evidence of use in Turkey: If you are using your mark in Turkey, try to carefully collect evidence of such use. Be sure that your mark is seen on all the evidence you collect and that ALL evidence shows a clear date.
2. Warn your local representatives: be sure that your mark is being used properly on their invoices, advertising, etc., and that they keep evidence of use.
3. It is not quantity but quality that counts: TPTO recommends that your evidence submitted be limited to 100 pages in total. Do NOT fill your evidence file with useless documents/images - be selective.
4. Be sure that your local counsel submits your evidence in good order and according to the TPTO criteria.
5. Check dates before filing: When filing an Opposition, always check the filing/priority date of the application you wish to oppose. The evidence of use you must provide for is the 5 years preceding the opposed mark's filing/priority date.
6. Check your Trademark portfolio: keep track of when your 5 years use terms are passing for your marks and make a schedule for at least the next 5 years showing which of your marks will be vulnerable to non-use.
7. Be selective as to which goods/services you would like to direct your opposition while opposing an application in Turkey.

For more information, please contact:



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