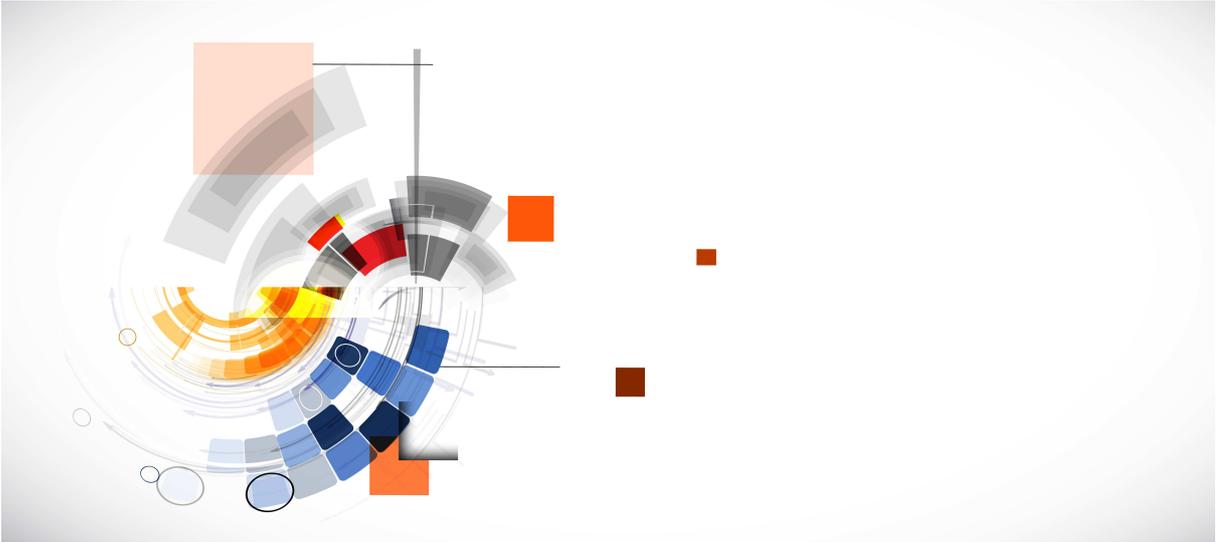


Trademark – News (*)

Non-use, as a counter-claim

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(*) Turkey's new Draft IP Law is before the Parliament

Non-use, as a counter-claim

Current Legislation

According to the Article 14 of the current Turkish Decree Law no: 556 on Trademarks, it is possible to institute a court action for the cancellation of a registered trademark on the basis of the **non-use if the trademark has not been put into use for the past 5 years period**. However **non-use** can only be claimed before the IP Court and Turkish Patent Institute is NOT entitled to consider and evaluate the use of the trademark, even if **non-use** is claimed by one of the parties during the examination of an objection and/or opposition.

Furthermore, there is no clear additional provision concerning non-use in the current Decree Law no: 556.

Proposed Changes by the Draft IP Law

The Article 19 of the Draft states that during the examination of an opposition filed against the publication of a trademark application, **upon request of the applicant**, the Institute is entitled to ask the opponent to prove the use of the trademark on which the opposition is based. In case the opponent is unable to prove the serious use of his trademark in Turkey or there is no legitimate reason for non-use, **the opposition is rejected**.

In case the use of the trademark is only proven for some of the covered goods or services, the examination of the opposition will be limited with such goods/ services for which the use has been proven by the opponent.

In addition, the Article 25 states that during the examination of a cancellation action instituted on the basis of the risk of confusion between the trademarks (Article 6/1), the non-use of the trademark on which the cancellation action is based can be asserted **as a counter-claim** by the defendant. Likewise, Article 29 states that the non-use counter-claim can also be put forward in the trademark infringement actions by the defendant.

Comment

Articles 19, 25 and 29 of the Draft clearly indicate that **non-use** can be asserted as a **counter-claim** during the examination of an opposition by the applicant and/or as a **counter-claim** during litigation before the Court by the defendant.

It is evident that the failure of the trademark holder to prove the use will result in the rejection of the opposition/court action and can trigger the counterpart to question the validity of the trademark on the basis of non-use.

The proposed version of the draft is in compliance with of the EU Trademark Regulation (Article 42).