Turkey: Will the Constitutional Court’s Latest Cancellation of the Provisions of the Trademark Decree Law Help Bring Forward a Trademark Code?

Legislative Framework

Trademark or/and service mark applications can be filed in Turkey in accordance with the Decree Law No. 556 ("Decree Law") enacted in 1995. In addition, Turkey is a party to numerous international agreements concerning trademarks, the most important of which are the Paris Convention, TRIPS, the Madrid Protocol, and TLT. Although it is generally in harmony with the related international regulations, Turkey’s Decree Law draws heavy criticism for not possessing the characteristics of a regular code. In addition, the Decree Law has been partially cancelled by Turkey’s Constitutional Court for that very same reason and still, the fact that it remains in force gives rise to serious uncertainty. The latest cancellation by the Constitutional Court took place in May 2015.

Well-known Trademarks- Cancellation of Article 7/1(i) of the Decree Law

Two different articles in the Decree Law regulate the matter of well-known trademarks in Turkey. According to art. 7/1(i) of the Decree Law, third-party applications filed without permission of the genuine trademark owners for trademarks that is in the context of the well-known trademark description of art 6bis 1 of the Paris Convention shall be rejected by the Turkish Patent Institute ("TPI") ex officio. Pursuant to the above-mentioned provision, trademarks that are recognized as being well-known according to the Paris Convention are also being protected as well-known trademarks in Turkey. The protection provided to well-known trademarks under this article is restricted to identical and similar products and services. The protection provided by the Decree Law art 7/1 (i) does not require for the trademark to be registered or to be in use in Turkey. Furthermore, it is also not necessary for the trademark to be known in Turkey. A trademark that is well-known in the Paris Convention’s other member states, according to the art 6bis 1 of the Convention, will also be protected as a well-known trademark in Turkey without requiring any other condition.

In May 2015, the Turkish Constitutional Court struck out art 7/1(i) on the basis that it is unconstitutional. The ruling closely follows the Constitutional Court’s striking out on similar grounds both art 16 (5) of the Decree Law and art 16/2, which revoked the TPI power to require those assigning a trademark to assign similar trademarks in the same portfolio.

The arguments put forward by the Ankara 3rd Court of Intellectual and Industrial Property Rights in striking out art 7/1(i) centred on liberal free market economic theory and the unlawful restriction of fundamental rights and freedom. Under the 3rd Court’s ruling, art 7/1(i) was deemed to violate the Turkish Constitution, in the same way as art 61-a, b and d was cancelled as unconstitutional by the Constitutional Court on the grounds that crimes and penalties should be regulated by the law.

Now that art 7/1(i) has been cancelled, the TPI will no longer have the ability to refuse well-known trademarks on absolute grounds. Well-known trademarks owners will therefore need to be more active in monitoring the trademark applications that have been made.
The Constitutional Court's recent striking of Decree Law articles further highlights the necessity for the strengthening of Turkey's trademark legislation and the need for enforcement of the country's Draft Trademark Law, which was sent to the Turkish Grand National Assembly in 2009.