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DEPARTMENT OF INTELLECTUAL PROPERTY, TECHNOLOGY

POLICIES AND INNOVATION MANAGEMENT

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THE CONCEPT OF “WELL-KNOWN TRADEMARKS”

Master’s Thesis

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DECLARATION

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To the Directorship of the Graduate School of Social Sciences,

I hereby declare that; all information in my master's thesis, titled "*The Concept of Well-Known Trademarks*", (Ankara, 2021)" which has been prepared under the supervision of Assist. Prof. Dr. Selin ÖZDEN MERHACI and Prof. Dr. Arzu OĞUZ has been gathered and submitted in compliance with academic rules and ethical conduct principles and as required by these rules and principles, and that I have fully indicated and cited all sources that are not original to this work. I also declare that, I have acted according to scientific research and ethical rules during my study process and that if it is proven otherwise, I will accept all legal consequences.

Date: ../../....

Sinan Haluk TANDOĞAN

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LIST OF ABBREVIATIONS

ARIPO	:	African Regional Intellectual Property Organization
BC	:	Before Christ
BGH	:	Bundesgerichtshof
BTHAE	:	Banka ve Ticaret Hukuku Araştırma Enstitüsü
ed.	:	edition
etc.	:	<i>et cetera</i> (and other similar things)
EU	:	European Union
ff.	:	<i>folio</i> (and the following pages)
fn.	:	footnote
GRUR	:	Gewerblicher Rechtsschutz und Urheberrecht (magazine)
HLR	:	Harvard Law Review
ibid.	:	<i>ibidem</i> (in the same place)
PC	:	Paris Convention
p./pp.	:	page/pages
TIPC	:	Turkish Industrial Property Code numbered 6769
TLT	:	Trademark Law Treaty
TRIPS	:	The Agreement on Trade-Related Aspects of Intellectual Property Rights
TÜRKPATENT	:	Turkish Patent and Trademark Office
UK	:	United Kingdom
vs	:	<i>versus</i>
WIPO	:	World Intellectual Property Organization

I. INTRODUCTION

The lack of a single, comprehensive, uniform, and up-to-date legal instrument to govern and regulate trademarks, their registration and protection has led the international legal community and codifiers in many countries to come up with their own versions of interpretation and codification of trademark law. While these might have made it a more manageable task to apply trademark law in their respective countries; they have made it harder to apply trademark law in international cases. Moreover, it has also become more difficult from a strictly academic point of view, to class and compare different trademark law systems and to come up with a valid international trademark law which would be applicable to a wide range of disputes and scenarios.

Whilst the above proves to be true for trademark law in general, the situation for a more specific area in trademark law such as “*well-known trademarks*” is even more complicated. There is a profusion of different legal, regional and international legal instruments which govern “*well-known trademarks*”. The natural consequences which this brings about are: uncertainty, lack of clarity and a need to elaborate on the areas which are left uncodified.

This work aims to address these consequences to some extent, to fill the gaps regarding the interpretation and application of the law surrounding well-known trademarks. In this spirit, this work will first provide a general overview of trademarks, which includes their definition and scope along with a description of why trademarks are needed. Later, it will progress to deal with different types of marks and to provide a brief explanation of the legal framework underlying trademarks. Then it will analyse what constitutes a “*well-known trademark*” by considering different criteria suggested in the

doctrine and by WIPO itself. It will then scrutinize the special protection granted to “well-known trademarks” and will attempt to come up with a conclusion as to whether “the protection granted to well-known marks” and whether the criteria suggested for being deemed well-known are adequate and sufficient by considering various academic works and court judgments from different legal systems.

II. TRADEMARKS, A GENERAL OVERVIEW

A) A Brief History of Trademarks

The trademark concept has been an indispensable part of human life since the ancient times, with its first examples dating back to circa 1000 BC.¹ Unlike their hunter-gatherer forefathers, humans who have adopted a settled life-style and began early attempts at agriculture, have developed a system where division of labour was a dominant part of their daily lives. They found out that, instead of having every individual in the society produce all kinds of food, instruments or weapons etc. for themselves, they would have better outcomes, if each individual was made responsible for producing what they were best at producing. In this system, a person with a particularly developed skillset when it comes to working with metal would, for instance, be deemed the village blacksmith. Similarly, someone with deep knowledge in horticulture would be responsible for the cultivation of fruits and vegetables. With this system, the societal structure tilted towards a more specialized one. People could now purchase their daily needs from specialized producers instead of having to take care of them all, themselves.

This system has also enabled people to determine whether the quality of the product was satisfactory without having to check the product for defects every time. This effect was achieved by the mere examination of the manufacturer's mark on the product itself. In case of a clay pot, for example, a mark on the pot showing that it was made by "Potter X", would assure the buyer of the pot that the pot was of satisfactory quality, without a need to further investigate the product, which would be both money and time consuming. This new practice meant that buyers of products could now place their trusts on a mark on the product itself, which would prove to the buyer that the product was made by a

¹WIPO. *WIPO Intellectual Property Handbook*. Geneva. 2008. p. 67. (WIPO IPH)

skilful producer from whom they bought a product before and was satisfied as to its quality and fitness for purpose. Over time, this practice has transformed into the modern concept of trademarks, in the sense they are perceived today, which now serve many more and complex purposes compared to its predecessors. In today's world of intricate webs of international trade and of market-oriented economies, trademarks, especially well-known ones, and the legal protection offered to them by national regional and international legal structures have become figures of extreme importance.

B) Definition, Purpose and Overview

Before making an in-depth analysis of well-known trademarks and the way they are protected, it is essential to deal with the main principles and concepts relating to trademarks in general to better understand the key-words and mechanics behind them. For achieving this purpose, the definition and purpose of trademarks will be examined in this chapter of this work. In this spirit, although there is a profusion of different approaches to the definition and scope of the concept of trademarks around the globe, in many different national and regional legal systems, trademarks, as widely accepted by the global legal community, are defined as signs that serve the purposes of “individualizing the goods and/or services of commercial enterprises” and of distinguishing them from those of its competitors.² A trademark in this sense, can, *inter*

² ARKAN, S. *Ticari İşletme Hukuku*. BTHAE. Ankara. 2015. p. 275; MICHAELS, A. A *Practical Guide to Trade Mark Law*. Sweet & Maxwell. 3rd ed. 2002. p. 2; KITCHEN, D. & LLEWEYN, D. & MELLOR, J. & MAEDA, R. & MOODY-STUART, T. & KEELING, D. *Kerly's Law of Trade Marks and Trade Names*. Sweet & Maxwell.

alia, consist of words, names, arbitrary designations, letters, slogans, pictures, symbols and even of sounds and smells, or a reasonable combination of these. The trademark definition in Article 15/(1) of “the Agreement on Trade-Related Aspects of Intellectual Property Rights” (“TRIPS Agreement”), which is an international multilateral agreement signed between all the countries within the World Trade Organization (“WTO”) and came into effect on 1 January 1995³, is very similar to the generic definition above with the minor addition of a discretion granted to member states, as regards signs which are “*not inherently capable of (...) distinguishing goods or services*”⁴. As per the above article, member states are given the power to register such signs if they see that the sign has acquired distinctiveness through usage. This shows that the scope of what constitutes a trademark has been broadened even more, with the coming into force of the TRIPS Agreement, since as can be seen above, signs which would not normally be considered a trademark, due to them not being inherently able to “distinguish the goods and/or services that they are attached to”, can now be registered as trademarks if the authorities within the member states are sufficiently convinced that they have somehow acquired “distinctiveness through use”.

Similarly, in the *ratio decidendi* of a leading United States Supreme Court case, the main function of a trademark is said to be “*to identify the origin or ownership of the goods to which [they are] affixed*”.⁵ This demonstrates that, in addition to the above-mentioned

London. 14th ed. 2005. p. 8; MCCARTHY, T. J.: *McCarthy on Trademarks and Unfair Competition*. Thomson West, 5th ed. 2019. paragraph 3:1.

³WTO. WTO- Overview: the TRIPS Agreement. https://www.wto.org/english/tratop_e/trips_e/intel2_e.htm. Date Accessed: 15.02.2020.

⁴ TRIPS. Article 15/(1).

⁵ Hanover Star Milling Co. v. Metcalf. 240 U. S. 403,412 (1916).

purposes of trademarks which are to distinguish and individualize, trademarks also serve the purpose of indicating origin.⁶ This is also in line with the historical usage of trademarks as briefly explained above in the introduction, where purchasers of products would place their trusts on the marks affixed to the product which would demonstrate to them that the good is from a trust-worthy producer known to them, from whom they have previously purchased similar products and were satisfied with their quality and fitness for purpose.

Here it is important to note that, while the above is true for and valid in Turkish Law, according to the current law in force in Turkey as of the date of this work ⁷, which is applicable to trademarks, their registration and protection, an additional requirement over the ones specified above is sought in applications for the registration of trademarks. This is the requirement that, the potential trademark for which registration is sought be capable of “*being represented on the register [in a manner which would] determine the clear and precise subject matter of the protection afforded to its proprietor.*”⁸ In other words, as per the TIPC, for a trademark to be valid and enforceable in Turkey, it should be capable of being registered in such a way that its scope and subject matter are easily and clearly discernible without room for doubt.

⁶ SCHECHTER, I. Frank. *The Rational Basis of Trademark Protection*. HLR.Vol. 40. No. 6. (Apr., 1927). pp. 813-833.

⁷ Turkish Industrial Property Code numbered 6769 and dated 22.12.2016 (TIPC).

⁸ TIPC. Article 4.

C) The Need for Trademarks

The abundance of trademarks in today's developed and developing economies is directly related to the players in the markets and their competitive goals. Therefore, it can be said that the necessity of protecting trademarks is greatly tied to creating a relevant market for the goods and/or services the players in that market, namely traders, offer to the consumers at large. This leads to the conclusion that trademarks are only necessary and useful in competitive market situations where there are more than one competing entities. In a situation to the contrary, for instance where a sole entity produces and supplies a certain type of product or offers such a service, there would be no need for trademark protection. This is because in such a scenario, the consumers or the end-users of the said product or service would have no option but to purchase the said product or obtain the said service provided by the sole entity. In a way, here the consumers are "*forced to get what the sole operating entity makes available.*"⁹ Similarly, if, in the above-mentioned hypothetical scenario, the said entity introduces a new and innovative product or service to the market and comes up with a very appealing name for them, through which it produces a great amount of revenue, which proves to be a success for the entity, there would still be no need for trademark protection since there would be no competitors which seek to take unfair advantage of the entity's success, by copying the said service or product.

On the other hand, in a functioning market economy with proper competition and numerous players, the situation would be entirely different. Here, trademarks and their

⁹ WIPO. *The Role of Trademarks, Industrial Designs and Geographical Indications in the Market*. WIPO Distance Learning Module 302. p. 1.

protection would be an essential part of trade. The entities in such a market, for instance, might be marketing and selling a similar or even a product with the same properties which in the eyes of the consumers are interchangeable. In such a case, each entity would want to be able to sell the most products and get the most service contracts and if possible kick their competitor out of the market. Moreover, if one of the entities comes up with an innovative idea similar to the one exemplified above, then this entity would want to protect its idea so that it would not fall into the hands of its rivals by way of imitation. These effects would be achieved by using trademarks and the protection system that comes along with it. With a registered trademark, the said entity would be able to protect its ideas, prevent the practice of counterfeiting to a great extent and appeal to the consumers in the market for increasing sales. This system also allows the consumers to identify the goods and services of the said entity and would ensure continuity in demand for them, thus making it easier for the entity to determine the right price-quality balance. Moreover, such a system will serve as a driving force for entities in the same market which have been less successful in the past, to try to come up with new ideas and innovations, which would be to the benefit of the consumers, since such a practice will usually increase quality, decrease production costs and ultimately decrease the prices of products.

D) Trademarks vs Service Marks

In most academic sources, “trademarks and service marks are dealt with under the same section”. This approach is thought to be true since they serve similar purposes and have similar effects on competition. A trademark, as explained in great detail above, is a mark which distinguishes the goods of a certain entity from those of its competitors. A service mark, on the other hand, is a mark which distinguishes and protects services rather

than goods. In other words, it “*refers to activities of an intangible nature*”¹⁰. It is important to note that, unless otherwise specified, in most scholarly works, when the word “trademark” is used, it usually describes both service marks and trademarks. However, for practical purposes it is still necessary to distinguish between these two and point out the main differences between them.

Just as goods that are supplied to the market in modern trade by commercial entities, services are also becoming an important part of commercial life, as they are increasingly offered to a wider market. In other words, the boundary for offering services is no longer limited to national borders. As a natural consequence of this, a need for marks which would make the consumers differentiate between services offered by different entities has arisen. Such services in the modern world now include; offering insurance, banking, airline travel, vehicle rental, advertising etc. Service marks in this sense serve the same distinguishing purpose as explained above and therefore have been applied in correlation with the law in place which applies to trademarks. Most requirements for registration, protection, renewal use and cancellation of service marks, and the way they are licenced and assigned are the same as in trademarks. For this reason, protection offered to service marks has been codified in most cases by way of an amendment to the existing trademark articles in relevant codes or by the simple addition of a sub-section related to service marks.¹¹ Therefore, in the following sections of this work, unless expressly specified otherwise, the same approach will be taken and the word trademark will be used in such a way that it includes both service marks and trademarks where reasonably applicable.

¹⁰ WIPO. *Trademarks*. WIPO Distance Learning Module. p. 2.

¹¹ WIPO. *WIPO IPH*. p. 68.

E) Certification Marks vs Collective Marks

In addition to trademarks and service marks, some legal systems, such as the Turkish Legal System, also allow the usage of certification marks and collective marks on certain goods and services, usually in addition to the trademark or service mark of the good or service itself. A certification mark in this sense is a mark which indicates that the goods or services which bear the mark are certified by the administrator of the mark as regards the goods' origin, the production process and materials used during manufacture; or the services' manner of being performed. In other words, the mark shows that a standard has been met while producing the goods or performing the services which bear the mark. The most renowned example of a certification mark is the example of "WOOLMARK", which certifies to purchasers of textile products that, the product has a certain guaranteed fibre content and has been approved by the Woolmark Company which owns the certification mark and only allows the usage of the "WOOLMARK" if the products have met their standards.¹²

Compared to certification marks, collective marks form a more closed community, which is almost like a "club"¹³ in the sense that not every entity who meets the criteria and standards of the administrator association is allowed to use the collective mark. Instead, in most legal systems, the entity wishing to use the collective mark would need to become a member or an associate of the administrator association before they are allowed to use the collective mark on their products or services. A collective mark, which can be used following the completion of the procedure set out above, is a mark which

¹² Woolmark Company. *About Woolmark Licencing*.

<https://www.woolmark.com/certification/>. Date Accessed: 18.02.2020.

¹³ WIPO. *WIPO IPH*. p. 69.

distinguishes the services or goods of the above-exemplified association, from those of other entities.¹⁴ This achieves the goal of indicating to the purchasers/users of the products or services that they have been produced or performed in a certain place in accordance with certain quality related procedures and standards.

F) Registered vs Unregistered Trademarks

1. Unregistered Trademarks

When the spectrum of usage of trademarks throughout the globe is examined, it will be seen that in addition to the widely-used registered trademarks, unregistered trademarks are also used in some countries to the extent their legal system allows. Furthermore, some legal systems also go further and offer legal protection to unregistered trademarks as well under separate sets of rules. Unregistered trademarks, “just like registered trademarks are used to distinguish goods and services”, with the slight distinction that they are not registered in a central country-wide trademark register. In most cases these kinds of trademarks are protected “*to the extent that they are known to the relevant public as a distinctive sign of a certain undertaking.*”¹⁵ There are no widely-accepted international agreements which deal with unregistered trademark protection so far, since the system is tilted towards the protection of registered trademarks. However, the WIPO administered “Paris Convention for the Protection of Industrial Property”¹⁶, includes a term which is

¹⁴ see UK Trade Marks Act 1994.

¹⁵ WIPO. *Trademarks*. WIPO Distance Learning Module. p. 5.

¹⁶ see https://www.wipo.int/treaties/en/text.jsp?file_id=288514.

applicable to unregistered trademarks. Although the said article¹⁷ does not expressly refer to unregistered trademarks nor directly offers them protection; the fact that the usage of a mark, which is found to be very similar to a previously existing unregistered trademark and is capable of creating confusion, is prohibited in the said article, indirectly protects the unregistered trademark, since the subsequent usage of it by other entities is prohibited. Despite the fact that there is no widely-accepted international system to protect unregistered trademarks, as briefly mentioned above, in some countries, national laws exist which aim to protect unregistered trademarks. This makes sense since the trademark protection regime, despite the attempts of WIPO and other organizations, is still somewhat territorial as will be explained in the following sections of this work. These national laws either deal with registered and unregistered trademarks in the same code such as the case in Germany¹⁸ and Italy¹⁹ or they deal with them by relying on sets of rules about unfair competition²⁰ or torts, as is the case in the United Kingdom.²¹

¹⁷ Article 10bis titled “*Unfair Competition*” section 3/(1) reads: “*The following in particular shall be prohibited (...) all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor*”.

¹⁸ see the German Act on the Protection of Trade Marks and other Signs (referred to as the German Trade Mark Act) (*Gesetz über den Schutz von Marken und sonstigen Kennzeichen*).

¹⁹ see the Italian Industrial Property Code (*Codice della Proprieta Industriale*) as amended by Legislative Decree No. 15/2019.

²⁰ DINWOODIE, G & JANIS, M. *Trademarks and Unfair Competition Law and Policy* 5th ed. Aspen Publishers. New York. 2004.

²¹ In the UK, the tort applicable to such a case is the “*tort of passing-off*”.

Similarly, in Article 6/(3) TIPC, it is stated that the application for the registration of a trademark must be rejected if “*a right to [an unregistered] trademark (...) [is] acquired prior to the date of application or the date of the priority claimed for the application*” in case there is an opposition by the proprietor of the unregistered mark. Moreover, it is also possible in Turkish law to protect unregistered trademarks by resorting to remedies set out in articles related to unfair competition in the Turkish Commercial Code.²²

2. Registered Trademarks

Historically, the protection offered to trademarks have only been through their use. In other words, trademarks were protected because, through their usage, they became known in the market to the consumers. This meant that, the fact that an entity came up with a great idea for a trademark, (but hadn't started using it before other entities), didn't prevent other entities who started using the same trademark after the original entity who came up with the trademark, from taking advantage of it. For this and other similar practical reasons, towards the end of the 19th century, states such as the UK and Germany started to use a registered system for keeping a record of trademarks. After that, this practice has caught on and many other countries came up with their own version of a trademark register. This new system allowed for a much more organized way of keeping trademark records and quickly became an international standard. With the new system, a trademark proprietor could simply file its intention to use the trademark, with the relevant trademark authorities in the country in which they intend to use the trademark. This would be enough to obtain protection in most cases. This means that, in this system, protection for the trademark starts before the actual “usage of the trademark in the course of trade”. The

²² Turkish Commercial Code Numbered 6102 and Dated 14.02.2011.

registered system also has the benefit of covering the whole territory of the state in which the trademark is registered, as opposed to the situation in unregistered trademarks, where protection is only provided for the places where the trademark has in fact been used. Most importantly, the scope of the protection offered to registered trademarks is much wider than that offered to unregistered ones. The protection offered to well-known trademarks is even broader as will be seen below in the following sections of this work. Yet, even though this is the case, in some legal systems this broad protection is made conditional on the completion of the usual trademark registration procedure.²³

G) Relevant National, Regional and International Legislation

It is indispensable to set out the main sources of law which govern or are related to trademarks and the regime which protects them in general, before analysing “well-known trademarks” and their protection. This is because these sources of law, whether national, regional or international and the principles incorporated within, are applicable to “well-known trademarks” just as well as regular trademarks (though sometimes with minor distinctions).

In this sense, it is important to note, as briefly mentioned above, just like intellectual property rights in general, trademarks, as a rule, offer territorial protection. Although there have been many attempts, some of which, successful to a great extent, to unify the law related to trademarks or to ease the registration process of trademarks in multiple

²³ This is especially true in situations where Article 6bis of the Paris Convention is not applicable. For further information on this see the chapter below on well-known marks.

jurisdictions, the national laws still prove to be the most important factor in determining the scope, effect and validity of the protection offered to trademarks.

1. National Legislation on Trademarks

To better understand these aspects of trademark protection, one must first examine the national rules regarding trademark protection. In this sense, if an entity desires to obtain protection for its trademark in a country, that is “the exclusive right to use the trademark” inside the borders of that country, then it should, as a rule, register its trademark with the relevant authorities (this is a specialized body inside the executive, and usually is a trademark office) following the required procedure and criteria set out in the national trademark law of that country. The resulting right to obtain protection for the trademark and the registration process itself is regulated by the national legislation of the state in which the application for trademark registration is made.

In Turkey, such issues are dealt with under the TIPC and the relevant filing authority for filing such trademark applications is the Turkish Patent and Trademark Office (TÜRKPATENT).²⁴ Similarly in the UK, trademarks are governed by the “Trade Marks

²⁴ For more information on the functioning and structure of the Turkish Patent and Trademark Office or TURKPTATENT, visit <https://www.turkpatent.gov.tr/TURKPATENT/?lang=en>.

A trademark search engine is also conveniently added to the web-site, which can be used to search for trademarks with the entered parameters.

Act 1994²⁵ and the relevant filing authority which keeps the trademark register is the Intellectual Property Office of the United Kingdom²⁶.

2. Regional Law on Trademarks

It is explained above that the backbone of trademark protection is still national laws. However, some agreements and arrangements between countries who share a border or countries situated in the same geographical area, might exist to facilitate trade and encourage innovation. Three distinct examples of regional systems in this sense are: the regional centralized registration system created by the Banjul Protocol²⁷, the system established by Regulation numbered 40/1994²⁸ in the European Union and the Benelux System administered by the Benelux Office for Intellectual Property.²⁹

²⁵ Trade Marks Act 1994 makes up the most important part of the United Kingdom's trademark legislation and can be found in: <https://www.gov.uk/government/publications/trade-marks-act-1994>. Date Accessed: 31.08.2020.

²⁶ The Office is an executive agency of the Department for Business, Energy and Industrial Strategy.

²⁷ Banjul Protocol on Marks (2019).

²⁸ Which, as of the date of this work is substituted by the Regulation no. 207/2009 of the EU.

²⁹ The System is administered by the Benelux Office for Intellectual Property which is set up by the Benelux Convention on Intellectual Property (trademarks and designs) as amended by the Protocol of 11-12-2017.

The trademark registration system established by the Banjul Protocol enables trademark owners to register their trademarks through the African Regional Intellectual Property Organization (ARIPO)³⁰.³¹ This makes it possible for the trademark owner which seeks to obtain protection in more than one state, to file a single registration application but get more than one national trademark for each country which has signed the Banjul Protocol on Marks. According to ARIPO records, ARIPO is comprised of 19 member states, among which there are countries such as: Malawi, Zimbabwe and Kenya.

The system set up in the European Union by the EU Regulation no. 40/1994 on the Community Trademark, is a completely dissimilar system compared to the one set up by the Banjul Protocol. Unlike the case in the Banjul system where a single application led to numerous national trademarks, in the European system established by the above-mentioned protocol, an application in the sense described by the said regulation results in a single *community trademark*, which is valid within the whole European Union and is governed by the regulation itself. This should not be confused with centralized registration systems such as the Banjul System set up by the Banjul Protocol or the

³⁰ the African Regional Intellectual Property Organization was founded in the late 1970s and one of its main objectives according to its web site is “to promote the harmonization and development of the industrial property laws, and matters related thereto, appropriate to the needs of its members and of the region as a whole”.

³¹ ARIPO. *The Banjul Protocol on Marks. (2019 version). Zimbabwe.*

Available on: <https://www.aripo.org/wp-content/uploads/2018/11/Banjul-Protocol-2019.pdf.pdf>. Date Accessed: 16.01.2021.

Madrid System established by the Madrid Protocol³² which result in multiple trademarks and “*makes it possible to protect a mark in a large number of countries by obtaining an international registration that has effect in each of the designated*”³³ countries. In other words, where the system in the EU Regulation no. 40/1994, results in a single community mark valid in many countries, after a single application; the Banjul System results in numerous trademarks in different countries again after a single application. Therefore, while both systems aim to facilitate and speed up the process involved in obtaining trademark protection in more than one country or in a specific region such as Africa or the European Union, they work in different ways as explained above.

The registration system created by the Benelux Convention and administered by the “Benelux Office for Intellectual Property” (BOIP) which results in the registration of a “Benelux Trademark” was and will be referred to as the Benelux System for convenience in this work. The Benelux System is another example of such a regional trademark system where the process involved in obtaining protection for a trademark is facilitated. The Benelux Convention, which has substituted the “*Benelux Trademark Law 1971*” established the BOIP which now deals with the registration and enforcement of Benelux

³² The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks as amended on 12 November 2007. Available in: <https://wipolex.wipo.int/en/treaties/textdetails/12603>.

³³ WIPO. *WIPO Administered Treaties-Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks*. Available on: https://www.wipo.int/treaties/en/registration/madrid_protocol/. Date Accessed: 20.02.2020.

Trademarks.³⁴ A successful registration with the BOIP for obtaining a *Benelux Trademark* grants the proprietor of the registered trademark, protection in each of the countries comprising the Benelux Union, namely, Belgium, the Netherlands and Luxembourg. In this sense, it enables the proprietor of such a mark to be granted regional protection for his/her mark, without having to apply for registration in 3 different countries which can be costly and time-consuming. In other words, it confers the trademark proprietor a single Benelux Trademark, which provides protection for the mark in the countries forming the Benelux Union.³⁵ It is also worth mentioning here that the Benelux Convention which sets the foundation for the Benelux System as described above, does not confer protection for trademarks which are unregistered, as a rule. The sole exception to this rule is “*the protection of well-known marks*” in the sense referred to in the Paris Convention under Article 6bis. This is because of the fact that the Benelux Convention is drafted in such a way that it upholds the principles set out in “the Paris Convention” due to policy and coherence reasons.³⁶

³⁴ The Preamble in the Benelux Convention on Intellectual Property (trademarks and Designs). 2017. Available on: https://www.boip.int/system/files/document/2019-02/Benelux%20Convention%20on%20Intellectual%20Property_01032019.pdf. Date Accessed: 16.01.2021.

³⁵ It should be noted that the BOIP is not in any way connected to or affiliated with the Benelux Union. The term Benelux Union is used above to merely describe the territory which comprises Belgium, the Netherlands and Luxembourg.

³⁶ Article 2.2ter/2-(d) Benelux Convention on Intellectual Property (trademarks and Designs). 2017.

3. International Laws Regarding Trademarks in General

The most important international sources of law which are applicable to trademarks are; “the Paris Convention”³⁷, “the Trademark Law Treaty”³⁸, “the Madrid Agreement and the Protocol” relating to it³⁹ and the TRIPS Agreement⁴⁰. These will be explained in some detail below.

a) The Paris Convention

The Paris Convention is a pioneer in the sense that it was among the first international legal instruments which dealt with industrial property in an extensive way. Numerous principles of utmost importance were incorporated into the agreement, some of which were never seen before. One such principle is the notion of “national treatment”. This notion is dealt with under Articles 2 and 3 of the Convention.⁴¹

³⁷ The Paris Convention for the Protection of Industrial Property dated 1883 and as amended on 1979. The Treaty text can be found online in: https://www.wipo.int/treaties/en/text.jsp?file_id=288514.

³⁸ The Trademark Law Treaty (TLT) was adopted on 27 October 1994 in a diplomatic conference in Geneva and came into force on 1 August 1996.

³⁹ The Madrid Agreement Concerning the International Registration of Marks, which dates from 1891 and the Protocol Relating to the Madrid Agreement adopted in 1989.

⁴⁰ The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) which entered into force on 1 January 1995.

⁴¹ Article 2 PC: (1) *Nationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals; all without*

As per this principle, when it comes to protecting industrial property, which naturally includes trademarks, each country in the union created by the Convention must grant to “nationals of other countries” in the union, “the same protection it grants to its own nationals”.⁴² This means that Germany and in particular, German Intellectual Property Offices must treat Italian applicants who wish to obtain industrial property protection in Germany, the same way they would treat German nationals when it comes to protecting industrial property. In other words, if an Italian citizen applies for trademark protection in Germany, then Germany is bound to treat the application as if it was made by a German citizen.

prejudice to the rights specially provided for by this Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with.

(2) However, no requirement as to domicile or establishment in the country where protection is claimed may be imposed upon nationals of countries of the Union for the enjoyment of any industrial property rights.

(3) The provisions of the laws of each of the countries of the Union relating to judicial and administrative procedure and to jurisdiction, and to the designation of an address for service or the appointment of an agent, which may be required by the laws on industrial property are expressly reserved.

Article 3 PC: Nationals of countries outside the Union who are domiciled or who have real and effective industrial or commercial establishments in the territory of one of the countries of the Union shall be treated in the same manner as nationals of the countries of the Union.

⁴² WIPO. *WIPO IPH*. p. 242.

However, this does not ensure the best protection for international industrial property protection seeking applicants. For instance, in a case where the country in which protection is sought does not grant extensive protection to such industrial property, even for its own nationals, would not be in breach of “the principle of national treatment”, since the nationals of this country and others would be treated the same way, although the level of protection is low for both of them. To resolve this issue, the Convention has provided for another principle called “*the minimum standard of protection*”, which, as the name suggests, ensures that each country in the union set up by the Convention, provides protection to industrial property rights at least to the minimum standard allowed by the convention. For achieving this purpose, the Convention itself includes some substantive law provisions which the countries in the union must abide by to satisfy the above-mentioned principle.

The Convention also confers to applicants who have “*duly filed an application for [...] the registration [...] of a trademark, in one of the countries of the Union, or [to their] successor in title, (...), for the purpose of filing in the other countries, a right of priority (...)*”⁴³ This means that any “*subsequent filing in any of the other countries of the Union before the expiration*” of the period granted by the Convention as the priority period, cannot be “*invalidated by reason of any acts accomplished in the interval, in particular, another filing [...] the use of the mark, and such acts cannot give rise to any third-party right or any right of personal possession.*”⁴⁴ This means that an applicant who wishes to obtain protection for its trademark in its own country along with other countries in the union set up by the Paris Convention, will have a six months priority period in which it can apply for registration for the same trademark in other countries in the union without

⁴³ Article 4/A-(1).

⁴⁴ Article 4/B.

fear of losing the trademark to other entities. One final point to note here is that, the Paris Convention itself does not regulate filing conditions and the registration process of trademarks⁴⁵ which are still regulated by the national laws of the countries in which protection is sought, which is in line with the above explanation which states that national laws still play an important role in regulating trademarks and their registration.

a. The Trademark Law Treaty

The Trademark Law Treaty, unlike some parts of the Paris Convention⁴⁶ does not deal with substantive law issues regarding trademarks. It deals with administrative procedures as regards national applications for trademark protection and the protection of the trademark itself and with harmonizing these. One prominent aspect of the Treaty is the obligation to provide protection for service marks, since Article 2 of the Treaty applies to services as well as goods.

There are some countries still, in which service marks are not recognized and registrable. This means that, such countries which have signed the treaty must recognize services, as being capable of being the subject matter of protection by service marks.⁴⁷

⁴⁵ Although some limits have been set regarding the registration of trademarks, such as the one which states that an application cannot be refused or a registration cannot be invalidated on grounds that the registration, renewal or filing of the trademark has not been made in the country of origin.

⁴⁶ see the chapter on “*Paris Convention for the Protection of Industrial Property*” above.

⁴⁷ WIPO. *WIPO IPH*. p. 297.

b) **“The Madrid Agreement” and “the Protocol relating to the Madrid Agreement”**

The Madrid Agreement and the Protocol relating to the Madrid Agreement together create a system referred to as the Madrid System which works in the way explained above and result in multiple trademarks after an international registration request which includes designated countries in which protection is desired.⁴⁸ In this system, an “international registration” may only be sought if the trademark has already been registered “in the office of origin” or where the international registration is governed exclusively by the provisions in “the Protocol relating to the Madrid Agreement”.⁴⁹ If this rule has been complied with and the relevant fees are paid, registration will be effected in countries which the applicant has designated in its application after an initial examination by the office of origin. The resulting trademarks in each designated country in this system will be treated the same way and will have the same legal effect as a trademark which has been directly filed with the national office of the designated country. The system has many benefits among which there are the ease of filing one registration in one language and speed.

c) **“The TRIPS Agreement”**

The TRIPS Agreement, is one of the most extensive and successful international treaties of intellectual property ever drafted. It includes key provisions such as provisions defining what notions such as “intellectual property”, “national treatment” and most importantly “most-favoured nation” -which has not been incorporated in an international

⁴⁸ see “*Regional Law on Trademarks*” above.

⁴⁹ WIPO. *WIPO IPH*. p. 288

agreement before- are, for the purposes of the Agreement. Section 2 in the Agreement is on trademarks and deals with the “*availability, scope and use of trademark rights*”⁵⁰ which will be discussed in the chapter below in the context of “well-known trademarks” and their protection.

⁵⁰ *ibid.* 350.

III. WELL-KNOWN TRADEMARKS

A) Definition and Overview

Some trademarks throughout history have obtained such recognition that they were considerably better-known than regular trademarks. However, Paris Convention dated 1883⁵¹, which included provisions to grant special protection to well-known marks, was the first legal instrument to recognize well-known trademarks as a legal concept. The Convention however did not include specific instructions as to how well-known marks were to be protected or registered. Instead, it left a margin of appreciation for each state signing the Convention -thus becoming a member of the Union formed by the Convention- to choose how to regulate these issues. Therefore, it is possible to see different approaches to the issue in different countries when it comes to, for instance, the registration and recognition of well-known trademarks. As a natural result, it is possible to come across many different definitions of well-known marks around the globe. However, it is possible to broadly define well-known marks as, marks which enjoy “a relatively high reputation”⁵² and are extensively known to the relevant general public.⁵³

⁵¹ see “*The Paris Convention*” above in Chapter 1 for more information.

⁵² FindLaw by Thomson Reuters. Article on: *Recognition of Well-Known Trademarks*. Available on: <https://corporate.findlaw.com/intellectual-property/recognition-of-well-known-trademarks.html>. Date Accessed: 28.02.2020.

⁵³ *WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks* offers a detailed description as to what constitutes a well-known trademark. Therefore, it will be examined in detail in the following sections of this work, see fn. 61 below.

Well-known marks in this sense can include both trademarks and service marks as already pointed above in the first chapter of this work. Such marks are recognized in most countries of the world and enjoy protection against other signs “*which are considered a reproduction, imitation or translation of that mark provided that they are likely to cause confusion in the relevant sector of the public.*”⁵⁴ Moreover, in many countries, national laws allow them to be protected even in cases where they are not registered, if the protection is about goods or services which “*are identical with, or similar to, those for which they have gained their reputation.*”⁵⁵ Moreover, in countries such as the Republic of Turkey, provided some conditions are satisfied, well-known marks also may be protected against marks which pertain to goods and services of a dissimilar nature, compared to the well-known one. These national laws, which serve the purpose of protecting well-known marks, in most cases stem from the countries’ obligations under international conventions and treaties more specifically, “the Paris Convention” and “the TRIPS Agreement”. These in general allow entities with less financial reserves and commercial activity to make their –in most cases foreign- trademarks well-known, and obtain protection without having to register their trademarks. However, if such trademarks are nevertheless registered with the relevant office, then, it would be possible in most countries to obtain additional protection for the trademark against dilution and

⁵⁴ WIPO. “Well-known Marks”. Available on: https://www.wipo.int/sme/en/ip_business/marks/well_known_marks.htm. Date Accessed: 28.02.2020.

⁵⁵ *ibid.*

counterfeiting.^{56 57. 58} To sum up, it is possible to state that international legal instruments such as the ones mentioned above and national laws, confer special protection to well-known marks, which are, from economical and sociological points of view somewhat more vulnerable compared to regular trademarks. In many countries including Turkey, well-known mark status is conferred to trademarks upon a successful application to the national intellectual property office or by a court decision confirming such status.

B) Criteria for Being Recognized as a “Well-Known” Trademark

1. Brief Overview and Doctrine

So far, in this work, generally accepted definitions of both regular and well-known trademarks have been given and the relevant sources of law which are applicable to these have been listed and examined to some extent. However, there has been no explanation regarding what makes a trademark “well-known”. This is because, there are no such

⁵⁶ Dilution, as will also be explained in detail below, is diminishing the value of a trademark in the eyes of the relevant public by making unauthorized and unfair use of a trademark.

⁵⁷ Counterfeiting is an act which comprises imitating the product or service offered by the original trademark holder, with the purpose of giving the impression that the goods or services obtained originate from the genuine trademark holder. Therefore, counterfeiting would only be effective if the trademark imitated is well-known, in other words, worth imitating. This is why, well-known trademarks are more susceptible to counterfeiting and require stronger protection compared to regular trademarks.

⁵⁸ This effect is achieved with the application of Article 16.3 of the TRIPS Agreement.

generally accepted globally applicable guidelines which one can follow to determine whether “a mark is well-known or not”. The reason why there are no such guidelines or definitions is because of the very nature of trademarks. The perceived popularity of a trademark or service mark in a market and whether they are well-known or not are strictly dependant on the characteristics of that specific market. In most cases these characteristics vary drastically among markets. Therefore, instead of attempting to codify a single, comprehensive and all-inclusive definition for what *constitutes “a well-known trademark or service mark”*, law-makers have deliberately refrained from doing so. Instead, they found it to be the more sensible way to assess the fame and popularity of a mark by looking at the extent to which they satisfy some long-established criteria.⁵⁹

As a result of the above, in the doctrine, some criteria have been suggested with the aim of helping legal professionals and decision makers decide whether a “mark is well-known or not”. Among these are, the uniqueness of the mark, it’s “ability to distinguish the goods and services” to which the mark pertains, from other goods and services, its reputation, similarity with other trademarks or the quality of the goods which bear the trademark.⁶⁰ Although many national laws have their own criteria for determining how well-known a trademark is, most of these have at least been influenced, if not shaped by the criteria set out within “*the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks*”, which will from now on be referred to as collectively the “*WIPO Criteria*”.⁶¹

⁵⁹ BAŞTÜRK, Z. *Markadan Patente*. Elma Yayınevi.2010. p. 61.

⁶⁰ For more information on this see von HEYDT in German association for the Protection of Intellectual Property (GRUR) Journal 1959. p. 29.

⁶¹ Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks adopted by the Assembly of the Paris Union for the Protection of Industrial Property and

2. The WIPO Criteria

With the aim of attempting to unify the practice on determining “whether a trademark or a service mark is well-known or not” and for helping decision makers and practitioners by filling the legal gap on this issue, WIPO has issued the “*Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks*”, which includes the WIPO Criteria⁶². The wording of these criteria has intentionally been widely drafted and where possible, in a manner which does not create closed lists. For example, in Section 1 of Article 2, it is stated that while “determining whether a trademark is a well-known trademark”, “*the competent authority [must] take into account any circumstances from which it may be inferred that the mark is well known.*”⁶³ The reason behind this exemplifying rather than declaring language is the consideration that there are many *sui generis* cases around the world with an unimaginable number of different examples of well-known trademark. For instance, a trademark may have been deemed to be well-known due to its extremely long usage in one country whereas in other examples the case might be that they have achieved this reputation in a single year with a successful

the General Assembly of the WIPO at the Thirty-Fourth Series of Meetings of the Assemblies of the Member States of WIPO September 20 to 29, 1999. Available in: <https://www.wipo.int/publications/en/details.jsp?id=346>. Date Accessed: 16.01.2021.

(*WIPO Joint Recommendation*)

⁶² see *WIPO Joint Recommendation*. These can be found in Part I: Determination of Well-Known Marks under, Article 2 titled *Determination of Whether a Mark is a Well-Known Mark in a Member State* under the section on “Factors for Consideration”.

⁶³ *WIPO Joint Recommendation*. Article 2/1-(a)..

marketing campaign. As can be seen from this example, it would be impossible for the drafters of the WIPO Criteria to include all possible situations that are present in practice or to foresee the ones that might possibly arise in the future. In spite of the fact that this is the case, the Joint Recommendation still remains to be an extensive and much-referred to instrument which should be taken into account before making a decision on whether a trademark is “well-known or not”. To that extent, the WIPO Criteria⁶⁴ will be critically examined one by one below in sub headings.

a) **“The Degree of Knowledge or Recognition of the Mark in the Relevant Sector of the Public”⁶⁵**

One of the most useful criteria which is used in determining how well-known a trademark is, is that of “*the Degree of Knowledge or Recognition of the Mark in the Relevant Sector of the Public*”. It is obvious that the “degree of knowledge and recognition” of the trademark are essential factors when it comes to determining “whether a trademark is well-known or not” since the first idea that comes to mind when making such a determination is about how widely the trademark is recognized. The problematic part of this criterion, however, its second part or more specifically the part about “*the relevant sector of the public*”, since what constitutes “*the relevant sector of the public*” is controversial. To clarify the ambiguity surrounding this concept, in the Joint

⁶⁴ WIPO has expressly stated in subsection (b) of Article 2 that these should be considered while making a decision, but that the factors which should be considered should not be limited to those and that other factors, if relevant should also be taken into account alongside these.

⁶⁵ *WIPO Joint Recommendation*. Article 2/1(b)-1.

Recommendation, WIPO has included a section specifically about the relevant sector of the public.⁶⁶ In this section, along with actual consumers of the goods bearing the trademark, who are in fact people who have actually bought the product or have benefitted from the services of the trademark owning entity; potential consumers of such goods and/or services are also included within the scope of the concept of “*the relevant sector of the public*”. In addition to the above, the section also states that, “*persons involved in channels of distribution*” and “*business circles dealing with the type of goods and/or services to which the mark applies*” should also be included within the scope of the

⁶⁶ *WIPO Joint Recommendation*. Article 2/2 titled “Relevant Sector of the Public” is as follows: “(2) (a) *Relevant sectors of the public shall include, but shall not necessarily be limited to: (i) actual and/or potential consumers of the type of goods and/or services to which the mark applies; (ii) persons involved in channels of distribution of the type of goods and/or services to which the mark applies; (iii) business circles dealing with the type of goods and/or services to which the mark applies.*

(b) *Where a mark is determined to be well known in at least one relevant sector of the public in a Member State, the mark shall be considered by the Member State to be a well-known mark.*

(c) *Where a mark is determined to be known in at least one relevant sector of the public in a Member State, the mark may be considered by the Member State to be a well-known mark.*

(d) *A Member State may determine that a mark is a well-known mark, even if the mark is not well known or, if the Member States applies subparagraph (c), known, in any relevant sector of the public of the Member State.”*

“*relevant sector of the public*”⁶⁷. This recommendation has been affirmed in the Turkish legal doctrine as well.⁶⁸ Therefore, it becomes possible with this approach to define “*the relevant sector of the public*” in different ways. In other words, no single definitive definition of the concept exists under this approach. This means that trademarks pertaining to consumer goods which are commonly used by consumers in their daily lives such as milk would have different boundaries when it comes to defining “*the relevant sector of the public*” compared to specialist goods, such as, a joint replacement implant which only, interested consumers or a relevant cross-section of the public consumes. In the first example above, “*the relevant sector of the public*” would be consumers at large in a certain geographical area and would form a more crowded set and “*the relevant sector of the public*” for the latter example would consist of orthopaedic surgeons and would comprise a smaller number of consumers. This approach is reasonable in the sense that it would be illogical to expect every single consumer to know about and be interested in all kinds of goods and services, and to take their knowledge about them into account when making the determination regarding what “*the relevant sector of the public*” is for a particular good and/or service.⁶⁹ Therefore, to sum up, it suffices for a trademark

⁶⁷ “The relevant sector of the public test” has been applied in the famous McDonald’s case, where the scope of the concept of being “well-known” has been set as being “*well-known to persons interested in the goods or services to which the mark relates*”.

⁶⁸ OĞUZ, A. *Tanınmış Marka ve Tanınmış Marka Ölçütlerinin Uygulanması*. Terazi Hukuk Dergisi. 13.140. 2018.: pp. 35-48; see İMİRLİOĞLU, D. *6769 sayılı Sınai Mülkiyet Kanunu’na Göre Marka Hukukunda Ayırt Ediciliğin Zedelenmesi. 556 Sayılı KHK ile Karşılaştırmalı*. Ankara. 2017.

⁶⁹ OĞUZ, A. p. 41.

relating to goods and/or services to become known in a certain cross-section⁷⁰ of the public to be deemed well-known. It is also important to note here that; the mentioned points above are stated to be guidelines only by WIPO and are in no way meant to be exhaustive.

To sum this criterion up, it is possible to say, considering the above-mentioned points that, “*the degree of knowledge or recognition of the mark in the relevant sector of the public*” is a rational and comprehensive criterion in determining whether the trademark in examination is well-known or not and is supported and affirmed in the doctrine regarding this issue.

b) “The Duration, Extent and Geographical Area of any Use of the Mark”⁷¹

Another criterion suggested by WIPO in “the Joint Recommendation” “for determining whether a trademark is well-known or not” is the criterion of “*the duration, extent and geographical area of any use of the mark*”. Here it is important to note that this criterion differs from that in the Joint Recommendation Article 2/1(b)-3, in the sense that in the latter, the criterion is an assessment of the promotion pertaining to the mark whereas in this criterion it is an assessment of the actual use of the mark. To better understand the underlying principles in this criterion, it is necessary to examine it by dividing it into two parts, the first part being the “*duration of any use of the mark*” and the second being the “*extent and geographical area of any use of the mark*”.

⁷⁰ To refer to the same concept, WIPO, uses the words “*at least one relevant sector of the public in a Member State*” in the *WIPO Joint Recommendation*.

⁷¹ *WIPO Joint Recommendation*. Article 2/1(b)-2.

aa) “duration of any use of the mark”

It has been suggested in the Joint Recommendation that the “*duration of the use of the [trademark]*” should be an indicator that the trademark or the service mark has reached the well-known status. This concept is possibly a reflection of previous academic works suggesting duration of use as an indicator in the doctrine.⁷² The supporters of this view believe that the long duration of the use of the trademark in the course of trade dramatically affects how well the trademark is known. Although this is in some cases true to some extent, setting the duration of use of the trademark as a strict and objective criterion would disregard the realities of the modern commercial world. This is because, in the 21st century, popularity is the product of a fast-paced game. This can easily be demonstrated with the example of two similar products in the same market, namely Product A and Product B. Product A is a good with a trademark on which consumers have placed their trusts for over 100 years. As a result of this long use, endless waves of marketing and advertising campaigns, the trademark pertaining to Product A has managed to be deemed a well-known trademark. Product A in this sense affirms the suggestion that the duration of the use of the trademark should be used as a criterion in determining “whether a trademark is well-known or not”. On the other hand, when Product B is considered, it will be seen that the case is not like that. The market for technological gadgets, such as smart-phones and televisions in today’s world is an unstable market since, there usually is a boom in the sale of new smart-phones for instance, until newer and improved models are released at which point the older models stop being essential to the consumers in the market. In this sense, if it is assumed that Product B is a new product of a technology company, and that after clever advertising

⁷² see REIMER, in GRUR 1951 p. 224-225.

manoeuvres, the company has managed to make the trademark related to Product B well-known in just two months, the duration of the use of the trademark relating to Product A becomes irrelevant since both products have eventually managed to be well-known, but in different time-frames. As can be seen from this example, the duration of the use of the trademark is not always a clear indicator of whether s mark is well-known or not, especially in today's fast-paced market economies.

Therefore, while this work acknowledges the importance of the duration of the use of the trademark during trade, in determining how well-known a trademark is, as one of many criteria, it does not agree with the view that the duration of the use of the trademark should be strictly followed in making such a determination.

bb) “the extent and geographical area of any use of the mark”

The second part of the criterion in “Article 2/1(b)-2 of the Joint Recommendation” comprises the “*extent and geographical area of any use of the mark*”. It is important to note here that this part is particularly about “the *extent and geographical area of any use of the mark*” and not about in which geographical area a trademark needs to be well-known in order to be recognized as a well-known trademark. In this sense, one could infer that the large extent and the immense geographical area of the use of the trademark makes it well-known, since the number of people in such an area is very high, which brings along with it popularity. While this is in most cases correct, one should always keep in mind that, as explained above in this work, trademarks still confer essentially territorial rights upon their holders. Naturally, the protection offered to well-known marks are no

exception. Therefore, since in most legal systems⁷³, there is no need for a trademark to be well-known in a large geographical area to be considered well-known and since, due to this whether the goods pertaining to the trademark are traded in a large geographical area, does not in the, above-mentioned sense, indicate that the trademark is well-known, the second part of the above criterion should also be considered as a supplementary criterion.

⁷⁴ However, this does not disprove the *a fortiori* case that trademarks with a worldwide reputation which permeates the borders of states, should be considered well-known trademarks, at least as well as ones that have acquired the well-known status in a single state.

c) **“The Duration, Extent and Geographical Area of any Promotion of the Mark”⁷⁵**

Under the WIPO Joint Recommendation, it has also been stated that “*the duration, extent and geographical area of any promotion⁷⁶ of the mark*” can be used as a criterion in “determining whether a trademark is well-known or not”.

⁷³ Such as the TIPC.

⁷⁴ DİRİKKAN, H. *Tanınmış Markanın Korunması*. Seçkin Yayınları. Ankara. 2003. p. 108.

⁷⁵ *WIPO Joint Recommendation*. Article 2/1(b)-3.

⁷⁶ The scope of the concept of “promotion” has been defined broadly in the *WIPO Joint Recommendation*. In this sense, promotion activities recognized in the Article include “*advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies*”.

This criterion is in line with Article 16/(2) TRIPS, titled “*Rights Conferred*”⁷⁷ in the sense that both recognize the importance of the promotion and advertising of the product pertaining to the trademark or the trademark itself. Here, in the said article, the option of recognizing knowledge of the trademark in the public, which has been created via its promotion, as a criterion in investigating how well-known a trademark is, is held open to member states.

Therefore, since in many countries such as Turkey⁷⁸, international agreements, if ratified and duly put into force, have the force of law and are considered to be binding just as national laws, the requirement in 16/(2) TRIPS, to recognize the knowledge in “the relevant sector of the public” which has been achieved through promotion as described in the above sense, is binding for the signatories of the TRIPS Agreement. As of the date of this work, all members of the WTO⁷⁹, are parties to the TRIPS Agreement, which makes the criterion in WIPO Joint Recommendation Article 2/1(b)-3 a generally recognized one.

⁷⁷ Article 16/(2) TRIPS Agreement is as follows: “*Article 6bis of the Paris Convention (1967) shall apply, mutatis mutandis, to services. In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark.*” Full text of the Agreement is available online on: https://www.wto.org/english/docs_e/legal_e/27-trips_04_e.htm

⁷⁸ For example, Article 90/(4) of the Constitution of the Republic of Turkey states that; international agreements which have been duly ratified and put into force are binding as national laws and have the force of law.

⁷⁹ 164 states, as of the date of this work.

However, the fact that the criterion has found its place in national laws of many states doesn't mean it is the single and most determinative criterion in determining whether a mark is "well-known or not". This is because, while this is a useful criterion and should rank among other criteria in making the determination about how well-known a mark is, as explained above, it should not be the sole indicator to use, since doing so would once again disregard the realities of the modern market economies. In this sense, if the above were accepted to be true, it would mean that the protection afforded to well-known trademarks is solely about protecting the trademark proprietors' financial interests by reimbursing them for the promotion and advertising expenses they have made.⁸⁰

Moreover, the above finding, about the knowledge of trademarks related to hypothetical Product A and Product B on their duration of use, would be true for the promotion of the trademark as well, since a trademark relating to a well-designed, innovative and useful product could easily start to be recognized as a well-known trademark in the market without any need to promote the product at all.

d) **"The Duration and Geographical Area of any Registrations, and/or any Applications for Registration, of the Mark, to the Extent that They Reflect Use or Recognition of the Mark"**⁸¹

"WIPO Joint Recommendation" Article 2/1(b)-4 states that "*the duration and geographical area of any registrations, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark*" is also a criterion

⁸⁰ see ZOLLNER and ELSAESSER in DIRİKKAN, H. p. 109.

⁸¹ WIPO Joint Recommendation. Article 2/1(b)-4.

which can be used to determine whether a trademark or service mark is well-known or not. Registration in many states, in other words the extent of the registration of the mark is a good preliminary indicator that the trademark or service mark might be well-known. This is because, it can be inferred from such a situation that the trademark proprietor has sought such extensive protection because it was needed, as the mark has reached a certain degree of knowledge and reputation in the eyes of the consumers in countries in which registration applications have been made. It should be noted, however, that, the reason why the proprietor has applied for registration in such an extensive geographical area might not be related to how well-known the trademark is. It can reflect the mere economic and marketing decisions of the proprietor or even be completely arbitrary. Thus, it is essential to examine the trademark further after applying this criterion to make a conclusive decision as regards whether “the mark is well-known or not”.

- e) **“The Record of Successful Enforcement of Rights in the Mark, in particular, the Extent to Which the Mark was Recognized as Well-Known by Competent Authorities”⁸²**

“The record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well-known by competent authorities”, has been given place in the “WIPO Joint Recommendation” as a criterion in determining if a trademark is well-known or not. This criterion differs from the others listed above and below in the sense that it does not evaluate economic implications, extent of usage, geographical area or duration of the use of the trademark, or even legal validity. Instead, it states that, the

⁸² *WIPO Joint Recommendation*. Article 2/1(b)-5.

extent to which the trademark or service mark is recognized as a “well-known trademark or service mark” by the competent authorities such as intellectual property offices or registers in countries, should be a factor in determining whether a mark is well-known or not. Just like the above criterion, this one is also a good indicator that the mark may be a well-known one. This is because, as long as the decisions or conclusions of the relevant “competent authorities” are considered to be sound and legally correct; the fact that a group consisting of experts in the field has found that a mark is well-known, might be a strong indicator that a mark is indeed well-known. Moreover, if it is considered that the people working in these competent authorities directly apply the relevant law, in a sense, they become the enforcers of the law and the way they apply it becomes a part of the relevant law. This alone, is enough to say that, “the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well-known by competent authorities” should serve as *prima facie* evidence that the mark in examination is well-known. However, as briefly pointed out above, such an approach, and therefore the criteria itself disregards two possible scenarios which might harm the credibility of this test. The first one is that, it disregards possible misjudgements or eccentric decisions of national intellectual property offices in some countries -which might as well result from the *sui generis* nature of national laws in those countries- which might lead to the false impression that the trademark or service mark is well-known, whereas in fact it might be not. The second one is that, not all countries allow the registration of service marks in their intellectual property registers and that this might

result in losing the well-known status of a service mark, which is in fact well-known, but could not be deemed as such due to legal registration barriers⁸³.

f) **“The Value Associated with the Mark”**⁸⁴

“*The value associated with the mark*” is also suggested as a criterion in “the Joint Recommendation”, in determining whether a trademark or service mark “is well-known or not”. This work supports the view that the value associated with the mark is closely related to the quality of the goods or services that the trademark or service mark represents. The same goes for the “type of products or services the trademark or service mark represents”. This is because these factors collectively comprise the brand image related to those goods or services. Therefore, while examining the accuracy and efficiency of this criterion, the above-mentioned concepts will be examined, in order to reach a substantial conclusion.

In this sense, it has been suggested in the doctrine that, the kind and quality of the goods and/or services which the trademark or service mark represents, which ultimately serves as an indicator of “*the value associated with the mark*”, can be considered a criterion in determining how well-known a mark is.^{85 86} This is mainly because there are, at least compared to marks representing non-luxury goods and/or services, more abusive

⁸³ KOGLIN, L.V. & SUDHINDRA N. & BURRONE, E.& JAIYA, G.S. *Making a Mark: An Introduction to Trademarks for Small and Medium-sized Enterprises*. WIPO. Geneva. 2017. p. 15.

⁸⁴ *WIPO Joint Recommendation*. Article 2/1(b)-6.

⁸⁵ DİRİKKAN, H. p. 104.

⁸⁶ see MEYER and STECKLER in DİRİKKAN, H. p. 104.

conducts such as counterfeiting and dilution, related to marks representing luxury goods or services.⁸⁷ This is a rational assertion since, for there to be counterfeiting of the goods, there needs to be a good brand image and reputation to take unfair advantage of, in the first place. However, “*the value associated with the mark*” cannot serve as the single determinative criterion in evaluating how well-known a mark is since, making such an assertion would mean only allowing luxury trademarks or service marks to be well-known, whereas it is just as much possible for trademarks or service marks relating to everyday goods such as trademarks relating to alimentary goods or similar consumer goods such as shampoos or soap bars. Therefore, the conclusion that can be drawn from this analysis is that, while luxury trademarks or service marks may be a strong indicator that these are well-known, especially in the relevant sector of the public –such as luxury yacht purchasers which form a cross-section of the public- they cannot be applied to reach conclusive results in every single case, especially when everyday consumer goods are being examined.

The section above offers an examination and criticism of the criteria which are set out in the WIPO Joint Recommendation. While they may collectively serve as a useful means for determining whether a trademark or service mark is well-known or not, as explained above, in most cases, they should not be isolated and referred to without taking the others into consideration since this would lead to false conclusions. WIPO itself has, in the text of the Joint Recommendation, stated that, these criteria should only be taken into account as “*guidelines*”, to assist in making a determination, and that they are in no way “*pre-conditions for reaching that determination.*”⁸⁸ It has also acknowledged the reality that, particular circumstances of and factors effecting each case should be

⁸⁷ BGH 29.11.1984 in GRUR 1985, pp. 550 ff.

⁸⁸ WIPO Joint Recommendation. Article 2/1-(c).

considered, since this might lead to the application or disapplication of some of the criteria above.⁸⁹

In addition to the above, the Joint Recommendation lists the “*factors which shall not be required*” while “*determining whether a mark is a well-known mark*”. Among those listed, there are factors such as requiring an application for registration related to the mark or requiring the mark to be used or registered in the member state. Another factor which shall not be taken into account in this sense is whether the trademark or service mark is well-known by “*the public at large in the [m]ember [s]tate*”.⁹⁰

While the reception for the WIPO Joint Recommendation has been greatly positive, some criticism of it exists in some parts of the world. The fact that it allows protection to unregistered and unused trademarks to some extent, under the above-mentioned principles, is criticised from an economical point of view by the commentators who think that the Joint Recommendation is not fit for regulating the issue of well-known trademarks. They believe that, especially in the United States of America, “

⁸⁹ *WIPO Joint Recommendation*. Article 2/1-(c) regarding this issue is as follows: “*The above factors, which are guidelines to assist the competent authority to determine whether the mark is a well-known mark, are not pre-conditions for reaching that determination. Rather, the determination in each case will depend upon the particular circumstances of that case. In some cases, all of the factors may be relevant. In other cases, some of the factors may be relevant. In still other cases none of the factors may be relevant, and the decision may be based on additional factors that are not listed in subparagraph (b), above. Such additional factors may be relevant, alone, or in combination with one or more of the factors listed in subparagraph (b), above.*”

⁹⁰ These factors which the member states are instructed not to take into account are set out in the *WIPO Joint Recommendation* under Article 2/3-(a).

“the Joint Recommendation allows the attainment of enforceable trademark rights without investment in a trademark's goodwill and diminishes the quantity of available trademarks that local entrepreneurs could adapt to lower their costs of entry into the market.”⁹¹

Due to this, they put forward the idea that the WIPO Joint Recommendation undermines the trademark policies of “the United States of America”.

3. Other Criteria Suggested in the Doctrine

In addition to the ones examined above, some other criteria by which it can be assessed whether a trademark is well-known or not, have been suggested in the doctrine.

a) Originality of the Trademark

One such criterion is the originality of the trademark or service mark. Originality of the trademark in this sense is related to concepts such as the memorability, impressiveness and impact on consumers. If a trademark, by its unique design makes the consumers think about a specific company and quality, the chances of it being declared an original

⁹¹ GRINBERG, M. “*The WIPO Joint Recommendation Protecting Well-Known Marks and the Forgotten Goodwill*”. 5 Chi. -Kent J. Intell. Prop. 1. (2005).

Available at: <http://scholarship.kentlaw.iit.edu/ckjip/vol5/iss1/1>. Date Accessed: 16.01.2021.

trademark are greatly increased.⁹² Thus, if it can be said that a trademark is original, this might be a good indicator that it is well-known as well. However, it is also pointed out in the doctrine that originality is the product of the effort and funds the trademark proprietor has put into the trademark to demonstrate its goods and services.⁹³ Therefore, originality does not merely arise from the intrinsic qualities of the trademark or service mark itself, but also from the efforts and funds the proprietor has put into it, in the sense described above. The “rationale for protecting a well-known trademark or service mark” which has gained good reputation in the eyes of the consumers in the way described above is, to protect it even though it lacks distinctiveness to some extent, because the consumers can easily distinguish the product or service pertaining to the trademark from others.⁹⁴

Therefore, the mere examination of a trademark on its originality, without looking at how the trademark has come to be known as original might lead to untrue conclusions. Consequently, to accept originality as a *sine qua non* criterion in determining if a trademark is well-known or not would not be reasonable.⁹⁵

⁹² POROY, R. & TEKİNALP, Ü. “Marka Hakkına İlişkin Bazı Sorunlar” in .Prof. Dr. Halûk TANDOĞAN’ın Hâtırasına Armağan. BTHAE. .Ankara. 1990. p. 335.

⁹³ DİRİKKAN, H. p. 91.

⁹⁴ BGH 22.10.1954 in GRUR 1955 p. 299 ff.

⁹⁵ This assertion is justified in the sense that there are many well-known marks which lack originality in the sense described above. For a detailed analysis on this, please see ZIMMERLI in DİRİKKAN, H. p.92.

b) The Degree of “Similarity between the Well-Known Mark and the Subsequently Used Identical or Similar Mark”

For a well-known trademark or service mark to be safe-guarded, there needs to be an unfair usage of a similar or identical “trademark or service mark” or at least an application for registration for such marks or in other cases, an entity should take or attempt to take unfair advantage of the “well-known trademark or service mark”. In other words, the similarity between “the well-known mark” and the subsequently used “identical or similar trademark or service mark” in the sense exemplified above is used to determine whether there has been a breach of trademark related rights. For this reason, it has been put forward that, the similarity between the well-known mark and the subsequently used identical or similar trademark or service mark should be used as an indicator of whether a mark is well-known or not. However, it is easily discernible that in most cases, such an approach would not yield accurate results. This is because of the fact that; such a factor is only useful when it comes to determining whether there is a risk of breach or whether there has been an actual breach of trademark proprietors’ rights. Therefore, the degree of similarity between the well-known mark and the subsequently used mark should not be used as an objective criterion in deciding whether “a mark is well-known or not”.⁹⁶

c) Solitariness of the Mark in the Relevant Market

Solitariness of the trademark or service mark in the relevant market has been often referred to in the doctrine as a requisite criterion to declare such a mark to be well-known. In the Continental European Civil Law Legal Tradition, especially in German Law, before

⁹⁶ see BECHER, GRUR 1951 in DİRİKKAN, H. p.109.

the German Trademark Code⁹⁷ came into force, it was accepted in the case law regarding this issue⁹⁸ and in the doctrine⁹⁹, that well-known marks could only exist if they were solitary in the relevant market. Some commentators drew a distinction between famous marks and well-known marks while examining this issue and have stated that famous marks need to be in a state of solitariness in the market to be protected as well-known marks, whereas actual well-known marks did not need to fulfil such a criterion. After the said code came into force however, this approach was largely abandoned since it was no longer accepted that a trademark needs to be solitary in the relevant market to be deemed well-known. This is mainly because of the realities of the modern fast-paced markets of the world of the twenty first century, where the dynamics of the market can shift quickly and easily, making the above approach arbitrary.

4. The Approach and Criteria Suggested in the Turkish Doctrine

Many Turkish commentators have elaborated on what constitutes a well-known trademark or service mark and have attempted to come up with their own conclusive criteria which can be used to determine whether a trademark or service mark is well-known or not. Such academic examinations have been present long before the TIPC came into force, and are now considered well-founded legal definitions. One might claim that some of these works were published before the coming into force of the TIPC and are

⁹⁷ Act on the Protection of Trade Marks and other Signs of 25 October 1994 (Federal Law Gazette [BGBl.]) Part I p. 3082, as last amended by Art. 11 of the Act of 17 July 2017, Federal Law Gazette (Bundesgesetzblatt). Part I p. 2541.

⁹⁸ BGH 11/11/1958 (GRUR 1959 p. 182 ff., BGH 02/04/1987 [GRUR 1987 p. 711 ff.]).

⁹⁹ STECKLER&ELSAESSER&KOHL in DİRİKKAN, H. pp. 96. ff.

therefore outdated. However, since the concepts and main rules have not changed with the coming into force of the said code, the ideas and principles in these works remain to be true. These prominent academic legal examinations will be explained in some detail below.¹⁰⁰

One such commentator¹⁰¹ states that¹⁰² a well-known mark, as a concept, is defined neither in the Paris Convention nor the relevant legislation at the time and therefore, to fill this gap, suggests that a mark should only be considered as a well-known mark if it is “well-known by the relevant sector of the public both within the relevant country and outside its borders”. He also adds that the trademark proprietor should be a citizen or resident of, or a commercial enterprise incorporated in a state which is a part of the union formed by the Paris Convention. Therefore, according to this approach, trademarks or service marks which have gained fame in a single city or several cities in a particular country, are not accepted as well-known trademarks or service marks.

The commentator also believes that global marks and well-known marks are different concepts. In this sense, he describes global marks as, marks which are globally known. He adds that the goods and/or services pertaining to the mark should be sold or performed throughout the globe, and even if that is not the case, he expects them to be at least known throughout the globe by the relevant cross-section of the public. Well-known marks according to the commentator on the other hand, are marks which are well-known in the sense mentioned in the Paris Convention, which are known to a large number of people and have high economic value. He states that, even if the mark is not globally famous, it would suffice for a mark to be well-known in some countries of the union formed by the

¹⁰⁰ For more information on the subject see: OĞUZ, A. p. 38-39.

¹⁰¹ see TEKİNALP, Ü. Fikri Mülkiyet Hukuku. İstanbul 1999

¹⁰² Before the coming into force of the TIPC.

Paris Convention, for them to be recognized as well-known marks.¹⁰³ Moreover, he supports the view that, in the case where protection is sought for a well-known trademark or service mark in Turkey, the registration and use of such mark is not a pre-requisite for obtaining protection.

According to another commentator, a large section of the relevant sector of the public knowing that, the mark in examination belongs to a proprietor who falls within the scope of the protection offered by the Paris Convention, is enough to declare it a well-known mark. However, this view is thought to lead to inaccurate results, when it is considered that a well-known mark needs to be known to not only the relevant sector of the public, but also to consumers who are not purchasers of the product or users of the service the trademark or service mark pertains to.^{104 105} The supporters of this view believe, in other words that, a mark is well-known if it is also known to the consumers who do not usually benefit from the goods or services the trademark proprietor provides.

Another commentator has, after examining the famous Nike Decision issued by the Swiss Federal Court and taking into consideration the preamble of the Swiss Trademark Code¹⁰⁶, has extracted the underlying principles which govern well-known marks. He lists these as, the commercial value of the mark, the suitability of the mark's advertising power to be used in the marketing of other goods and services, the knowledge of the mark not just in the relevant sector of the public but also in the public who are not regular

¹⁰³ TEKİNALP, Ü. *Fikri Mülkiyet Hukuku*. İstanbul. 1999. p. 366. ff.

¹⁰⁴ ARKAN, S. *Marka Hukuku*. V.1 Ankara 1997. p. 93.

¹⁰⁵ For a comparison of different views in the Turkish Doctrine on this matter see : OĞUZ, A. p. 38.

¹⁰⁶ CC 232.11 Federal Act of 28 August 1992 on the Protection of Trade Marks and Indications of Source (Trade Mark Protection Act, TmPA).

consumers of the goods or users of the services the trademark or service mark pertains to, and another identical mark being used in the market.^{107 108}

Another commentator states that marks which have a big distribution network in a country and are well-known in the relevant sector of the public as a result of extensive and intense marketing and promotion campaigns should be considered well-known marks. He also agrees with the approach that the mark should reflexively make the product or service to which it pertains come to the mind of the consumers to be deemed well-known.^{109 110}

Another commentator agrees with the above view that a trademark or service mark is only well-known if it is also known to the consumers who do not usually benefit from the goods or services the trademark proprietor provides. He states that a mark can only be considered to be well-known if it is also known to people other than those who sell or consume the product or benefit from the services which bears the trademark or the service mark. He agrees with the statement made above, which puts forward the idea that well-known marks represent a higher economic value compared to regular and famous marks and adds that; “for a mark to be well-known, the goods or services pertaining to the mark should reflexively come to mind when one effortlessly thinks of the trademark or service mark.” He claims that, if the trademark immediately creates, in the minds of the consumers, an image or at least an idea of the goods or services the mark relates to, then

¹⁰⁷ NOMER, F. “*Tanınmış Marka-Nike*”. in *Erdoğan Moroğlu’na Armağan*. Beta Yayıncılık. İstanbul 1992. p. 502.

¹⁰⁸ NOMER, F. in OĞUZ, A. p. 38.

¹⁰⁹ EYÜBOĞLU, S. *Tanınmış Marka*. Ankara Barosu FMR Dergisi. i. 2. 2001. p. 113.

¹¹⁰ see EYÜBOĞLU in OĞUZ, A. p. 38.

it can be said to be well-known.¹¹¹ He also states that, as a trademark or service mark is used in the course of trade, its distinguishing power increases and it goes through some stages of reputation such as being a well-known mark, until ultimately it reaches the status of “global mark”.¹¹² Here, it is understood that the commentator believes that the use of the trademark in the course of trade is essential in giving it the well-known status. He is also of the opinion that, a mark being well-known only in a certain cross-section of the public, such as the “*Remington*” trademark for hunting rifles, being well-known among hunting enthusiasts, is enough to consider it a well-known mark.¹¹³

a) Criteria Used by “the Turkish Patent and Trademark Office”

Certain criteria are used by “the Turkish Patent and Trademark Office” (TÜRKPATENT) to determine whether a mark can be protected in the register as a mark with special protection or not. Similarly, TÜRKPATENT applies these criteria in determining “whether a mark is well-known or not”.¹¹⁴ Among these are: the duration of the usage of the mark and for how long it was registered, the extent to which the registration and usage of the mark is achieved, both within Turkey and in foreign countries, the size of the market share, annual sales and presence of the goods and/or services pertaining to the mark, marketing and promotional activities related to the mark, including, *inter alia*, TV advertisements and local newspaper advertisements, other kind of advertisements and marketing campaigns, the presence or absence of a court ruling

¹¹¹ YASAMAN., H. & POROY R. *Ticari İşletme Hukuku*. İstanbul 2004. p. 305.

¹¹² YASAMAN, H. *Marka Hukuku 556 Sayılı KHK Şerhi* (Altay, Ayoğlu, Yusufoglu Yüksel). V.1. Vedat Kitapçılık. İstanbul. 2004. p. 24.

¹¹³ *ibid.* 25.

¹¹⁴ Official Gazette dated 19.11.2003 and numbered 24294.

showing that the mark is a well-known mark or ongoing trials relating to the same, the originality of the mark etc. By using one the above, or several as a starting point, TÜRKPATENT decides whether the mark can be registered as a well-known mark within Turkey and benefit from the protection this affords.

b) Well-known Marks from the Perspective of the Turkish Supreme Court

Over the years the Turkish Supreme Court has repeatedly used its own definition of what a well-known mark is.¹¹⁵ According to this definition, a well-known mark is a mark which can be defined as a reflexive association made by a certain group of people with an enterprise or person, without taking into account geographical, cultural and age barriers into account.¹¹⁶

In other decisions, the Supreme Court drew attention to the above-mentioned fact that there is, to date, no single and all-inclusive definition of what a well-known trademark is, neither in the Turkish Trademark Law, nor in international and foreign laws. They also state that, in the absence of the above, one should focus on how much the mark has permeated the consciousness of a substantial percentage of the public, or at least on how much this has happened in relation to the average consumer of the goods or services to which the mark relates.¹¹⁷ They add that, in addition to the above, the mark should be

¹¹⁵ DİLMAÇ, Ş. *Uluslararası Metinlerde Tanınmış Marka ve Markanın Sulandırılması*. Seçkin Yayınları. Ankara. 2014. p. 57.

¹¹⁶ 11th Civil Chamber of the Supreme Court of the Republic of Turkey's Judgments numbered E. 2002/10575, E. 1999/8859, E. 1997/5647.

¹¹⁷ 11th Civil Chamber of the Supreme Court of the Republic of Turkey's Judgment numbered 2003/7150 E., 2004/1792 K. and dated 26.02.2004.

well-known in its own sector and that it should have a developed distribution network, in order to be categorised as a well-known mark. In another decision¹¹⁸, the Supreme Court has stated that the WIPO Criteria,¹¹⁹ which has been examined above are also valid and applicable in Turkish Law, as definitive guidelines even though member states do not have to compulsorily abide by it. This means that the WIPO Criteria has been given legal weight and acceptance by a higher legal authority, which in turn means that lower civil courts in the country also need to follow this set precedent for the purpose of uniformly applying the law.

5. Other Criteria to be Taken into Account

In addition to the criteria and factors mentioned above, it is possible to state that other criteria and factors have been developed in assessing “whether a trademark or service mark is well-known or not”.¹²⁰ These can be supplementary to the WIPO criteria¹²¹ and to the criteria suggested in the Turkish doctrine which are mentioned above; or can be applied as standalone factors while making an assessment about how well-known a trademark or service mark is. Some of these, and their efficiency and accuracy will be examined below.

¹¹⁸ Assembly of Civil Chambers of the Supreme Court of the Republic of Turkey’s decision dated 21.09.2005 and numbered 2005/11-476 E. 2005/483 K.

¹¹⁹ see Chapter 2 titled “*the WIPO Criteria*” above.

¹²⁰ BLAKENEY, M. in ÇOLAK, U. *Türk Marka Hukuku*. On İki Levha Yayıncılık. İstanbul. 2012. p. 215.

¹²¹ see the chapter about the “*WIPO Criteria*” above.

a) The Date of the Creation of the Mark

It has been suggested that, the date of the creation of the mark is a good indicator in assessing whether a “trademark or service mark is well-known or not”. This idea has found some support in the doctrine as well, as some commentators assert that a trademark or service mark which had been in use for a very long time would have established a greater reputation in the eyes of the consumers. However, this work does not agree with the view that the date of creation of the mark is an objective and accurate measure of how well-known a trademark or service mark is because of the reasons listed below. Firstly, the date of creation of the mark, in most cases, coincides with the duration of use of the mark. As mentioned above, in the section about the WIPO Criteria, the duration of use of the trademark or service mark, is a criterion listed in the WIPO Joint Recommendation. Therefore, this work supports the view that there is no need to list this factor as a separate additional factor which can be used to determine whether a mark is well-known or not. In other words, making an assessment based on the date of creation of the mark is, in the majority cases, would be the same as making an assessment based on the duration of use of the trademark. This is because in most situations, the creation and the usage of the trademark or service mark happens at the same time. For this factor to be a standalone and accurate measure of how well-known a mark is, the creation and the usage of the trademark must happen on different dates. For instance, the trademark might be created two years before its proprietor starts to use it. However, this would still not work because of numerous reasons. One such reason is that, many believe, including WIPO, as is demonstrated under the Joint Recommendation that, the marketing and promotion of the product or service which pertains to the trademark or service mark, is considered to be using the trademark or service mark. Moreover, if a trademark or service mark is created on a certain date but has not been promoted or advertised, it would not be realistic to expect it to be well-known among consumers since there would be no means for them to

hear of the existence of the said trademark or service mark. Consequently, since promotional campaigns and similar marketing movements are considered to be making use of the mark, and since without these a newly created mark cannot gain substantial positive reputation in the eyes of the consumers, there would be no cases where the assessment of the date creation of the mark would lead to different results than making an assessment on the duration of use of the mark.

Secondly, as already discussed above,¹²² the date of creation of the trademark or the service mark, or due to the reasons stated in the paragraph above, the duration of use of the trademark or service mark¹²³ is not always a good indicator that a mark is well-known. This is because, just as demonstrated in the above-mentioned examples, it has been a common occurrence in today's fast-paced market economies, for a trademark or service mark to reach the status of a "*well-known mark*" in a considerably short amount of time, whereas other marks which have been around for decades might not yet start to be known as well-known in the public. This proves to be true, especially when the current dynamics of product or service markets which are ever volatile are considered. Consequently, it would be a rational statement about this factor to state that, in limited cases where it applies, the date of creation of the mark can be used as a supplementary factor only, in deciding whether a trademark or service mark is well-known or not.

¹²² see the chapter about the "*WIPO Criteria*" above.

¹²³ since these two would lead to the same practical results due to the reasons discussed above.

b) Number of Stores Opened under Licences or via Franchising

The number of stores opened under licences or via franchising is also mentioned among factors which might help in making the determination about whether a trademark or service mark is well-known or not.¹²⁴ This factor, although not determinative by itself, such as some of the other factors mentioned above, can serve as a good indicator in “determining whether a mark is well-known or not”. The reason behind this has its roots in the dynamics of free market economies. Actors in such markets move with the aim of maximizing their profits. For achieving this goal, they usually have several options. One option might be to start as a small start-up company and to meticulously and patiently build a good reputation for the trademark or service mark which pertains to the goods or services the start-up offers. Although, with a bit of luck, this might lead to extremely positive results if the whole process is monitored and managed efficiently, it might also be time consuming and expensive. This is because, the reputation-building phase, as this work refers to it, which comprises: advertising, marketing and other promotional campaigns; might be very costly, especially for a small firm, which seeks to establish sufficient good-will among its customers in a short period of time. For this reason, an actor in the market might choose to follow other paths, which are entirely different options than the one explained above. This might be to search for a suitable company which already produces reliable products, to sign an exclusive sales concession contract¹²⁵. An exclusive sales concession contract in this sense is a contract in which the

¹²⁴ ÇOLAK, U. 2012. p. 215.

¹²⁵ For extensive information on exclusive sales concession contracts and the rules that govern them, see TANDOĞAN, H. *Borçlar Hukuku-Özel Borç İlişkileri*. V. I/1. İstanbul. 2008. pp. 27-61.

producer agrees to supply the goods to the exclusive seller in exchange for a money consideration, and the exclusive seller undertakes to exclusively sell and promote these in its own name and account either in the whole market or in a specific section of the market.¹²⁶ This type of contract is usually concluded between entities such as the start-ups mentioned above who wish to kick-start their business without having to establish a good reputation for their mark; and producers who already own a well-known trademark which pertains to goods, but do not want to set up a sales and marketing network at all, or set up one in a new geographical area or market.¹²⁷ This kind of arrangement is useful for entities which have just started trading, which seek to be in the position of the exclusive seller in the contract. Another similar and more extensive option allows the actors in the market to, in a way, skip the reputation building phase and to start trading by taking advantage of the previously established reputation and good-will of an already existing trademark or service mark. This process is usually governed by licensing or franchising regimes. By utilizing these concepts, actors in the market can start trading with almost a guaranteed clientele, without having to go through all the hard work related to building a trademark and the related reputation from scratch, not to mention avoiding paying the related expenses. Of course, for such investments made by market actors, for obtaining licenses or establishing franchises from well-known trademark or service mark proprietors, to be feasible, the actors should be convinced that there is enough good-will and reputation relating to the mark in the market among consumers. This is why the number of stores opened under licensing and franchising regimes is an indicative factor that the mark might be a well-known mark. In other words, if there are lots of stores opened globally under the said regimes, then it is only logical to expect the mark to be

¹²⁶ TANDOĞAN, H. *Borçlar Hukuku-Özel Borç İlişkileri Cilt I/1*. İstanbul 2008 p. 27.

¹²⁷ *ibid.* 28.

well-known, since if that was not the case, the actors in the market who act with the view of maximizing profit would not agree to open such stores if they were not convinced that there would be an established clientele tied to the trademark or service mark which they are allowed the use of, with a licence or by franchising. Therefore, in many cases, it can be said that, if there are lots of stores with a certain trademark or service mark, which are opened under licensing or franchising regimes, then the said trademark or service mark which pertains to the goods and/or services the entity supplies, is a well-known mark. This proves to be true when the current status of well-known trademarks such as *McDonald's* and *Burger King* is examined in Turkey¹²⁸ and in many other countries in which these are operational.

c) **Number of Branches**

The number of stores and branches opened under a trademark or service mark is also considered to be an indicator when it comes to assessing whether the mark is well-known or not. It has been explained above in this work that whether a trademark is well-known or not is directly related to the image or idea that appears reflexively in the minds of the consumers. When it is considered that human mind works in such a way that the images and ideas that it retains are a direct result of what the eyes see, claiming that the more people see a trademark or service mark, the higher its remembrance rate, will be correct. Consequently, expecting a trademark which has lots of stores around a certain geographical area to be better known compared to ones that do not is natural. Moreover, from an economic point of view, trademark proprietors who have managed to open lots of branches has probably done so because of the high level of popularity their products

¹²⁸ ÇOLAK, U. p. 215.

(goods and/or services) have reached. Therefore, the high number of branches opened under a trademark or service mark might show that the trademark or service mark is well-known. However, it should be noted that, just as some of the other factors exemplified above, the number of branches does not always accurately indicate that a trademark or service mark is well-known, and that, this should be a supplementary factor as well.

d) Daily Average Number of Website Visitors

It is an undeniable fact that the internet, in today's world, has become an essential and central part of human lives. This is not a temporary trend either, which can easily be noticed by looking at how all aspects of life are increasingly becoming dependent on the internet. As technology advances, new and different ways to use the internet, such as crypto-currencies, the block chain technology and online shopping networks, are developed as well. So much so that, some commercial entities are now only offering their services from the internet, without having to set up physical shops and branches. Some examples to this include *Amazon*¹²⁹ and *Ebay*, both of which offer online shopping services to their customers.

¹²⁹ Amazon has recently opened physical retail shops called Amazon Go in some selected locations. Some of these also function in a revolutionary way, called the “*Just Walk Out System*” which allows its customers to pick up any item in the store and just walk out without having to wait in line for the cash register to pay for the items they wish to purchase. The system then automatically charges your account and thanks to this, you do not have to carry cash, or even a credit card with you, as long as you have your smart phone with you. More information on this can be found on Amazon's own web-page on this matter.

Moreover, it can be said that creating a good widespread reputation for a trademark is relatively easier and cheaper and sometimes faster than attempting to do the same in the old-fashioned way. This is in correlation with the explanations above, in the section¹³⁰ about the duration of use of the trademark or service mark, where it was stated that the long duration of use of the mark is not always a good indicator that the mark is well-known due to the reality that a mark may reach a high level of recognition in the public in a very short period of time with the use of intense and extensive marketing campaigns, which might just as well occur over the internet.

The high daily average number of web-site visitors a web-site pertaining to a “trademark or service mark” has, therefore could be a preliminary indicator that the said “trademark or service mark” might be a well-known mark. This is because of the fact that, the high number of visits such a web-site has, implies that there is substantial knowledge in the public regarding the mark. This is just like a situation where a store is visited a lot in a busy highway, only in this case, the busy highway store is one that does not physically exist and only operates online. Therefore, this factor is a good supplementary factor in aiding professionals, in cases where it is applicable, when they are examining a trademark on whether it is well-known or not.

https://www.amazon.com/b/ref=s9_acss_bw_cg_agojwo_1a1_w?node=20931388011&pf_rd_m=ATVPDKIKX0DER&pf_rd_s=merchandised-search-2&pf_rd_r=CZ9HQ9WKQ7Y0ABP5H9T&pf_rd_t=101&pf_rd_p=af2fd307-caca-4918-828c-dd8277d81050&pf_rd_i=16008589011).

However, this does not change the fact that Amazon still functions primarily over the internet and that the large portion of its customers still make their purchases online.

¹³⁰ see the “*duration of any use of the mark*” above.

e) **The Number and Frequency of Searches Through Search Engines**

It has been suggested by some commentators that the number and frequency of searches through search engines can be used as a secondary¹³¹ factor/indicator while determining whether a trademark or service mark is well-known or not. In this sense, they support the view that the high frequency of searches made through search engines such as Google and Bing, should at least serve as a strong persuasive evidence that the mark in examination is well-known. This assertion is true since, as described above under the heading “*Daily Average Number of Website Visitors*”, the internet has become an indispensable part of human life. If the general public has made a great number of searches through search engines such as the ones mentioned above, then it can be said with some accuracy that, the said public is highly interested in the goods and/or services offered by the proprietor of the mark which is searched through the search engines. Consequently, it is not unrealistic to expect such a highly searched trademark or service mark to be well-known among the consumers. Such high search numbers and other related data and statistics can easily be obtained via *Google Trends*.¹³² However, it should also be noted that while the above case proves to be true in many examples, this should not be confused with the default sorting of the search results which are obtained when the search button is clicked. This is because such outcomes are not always directly related to click rates or number of visits. They might be altered artificially by using metatags or even by paying the service providers a certain amount, to be listed among the top results when a certain word is searched through the search engine.

¹³¹ ÇOLAK, U. p. 216.

¹³² The service can be reached on <https://trends.google.com/trends/?geo=>. To obtain specific information about a certain geographical area, users of this service can enter the relevant area code (such as US or TR) after the equals sign in the URL shown above.

IV. SPECIAL PROTECTION GRANTED TO “WELL-KNOWN TRADEMARKS AND SERVICE MARKS”

A) Rationale Behind the Special Protection

Now that the subject of which factors and criteria are used or suggested when it comes to determining whether a trademark or service mark is well-known or not, is dealt with, this work will move to explaining why a special kind of protection has been granted to such well-known marks. Many explanations regarding this matter has been made both in the doctrine and the related case law. While some of these had their roots in economic figures, some others are based on historic and legal grounds. The common denominator in all, is that due to various reasons, well-known trademarks and service marks should be granted protection which differs from and in some cases, goes beyond, that granted to regular trademarks and service marks. It has been suggested by some commentators that well-known trademarks and service marks are more fragile in the market in an economic sense compared to regular trademarks and service marks and that, this is why they need to be protected more extensively. Others have stated that it is easier and more tempting from the point of view of the entities wishing to or attempting to take unfair advantage of the trademark or service mark by unlawful practices such as counterfeiting or dilution.¹³³ This is true since many well-known marks have a global market and a global demand among customers. Due to this, it is easier and definitely more profitable for counterfeiters who wish to make profit out of the reputation of the good or service which is marketed under a certain well-known trademark or service mark. This can be demonstrated by a simple example. If it is assumed that Trademark X is a regular trademark which pertains

¹³³ Davidoff & Cie SA and another v Gofkid Ltd Case C-292/00 (ECJ, 9 January 2003).

to goods which are only locally sold in a certain geographical area, and that Trademark Y is a well-known trademark which pertains to goods which are marketed and sold in many countries and to a wide demographic of consumers; it will be understood intuitively that, it is easier for the proprietors of Trademark X to keep track of the illegal activities carried on by entities with ill intentions, because they only need to worry about and inspect a relatively manageable area, which is the said specific geographical area. However, it would naturally be harder for the proprietors of Trademark Y to keep under control all illegal and unfair activities carried out under their well-known trademark, since it would be extremely hard for them to examine every case in such a large geographical area, which might as well be more than ten countries. Other commentators have claimed that well-known trademarks and service marks need better protection because they represent a bigger economic value, in some cases the value of the well-known mark reaching up to almost one hundred billion dollars.¹³⁴

All of the above collectively make sense when the current position of the well-known trademarks and service marks in the market and their value in the eyes of the consumers are examined. Moreover, it is also stated in the doctrine that “*a famous mark’s reputation may not only extend across borders but can reach to unrelated fields of activity far beyond the scope of the original goods or services in relation to which the mark is used.*”¹³⁵ Therefore, they state that, if the above is accepted to be true, then if regular norms of protection are applied to well-known trademarks or service marks, this would be

¹³⁴ BADENHAUSEN, K. “*Brands: The Management Factor*”. Financial World. 1 August 1995. pp. 50-51.

¹³⁵ MOSTERT, F. *Famous and Well-Known Marks: An International Analysis*. Butterworths. London. 1997. p. 5.

insufficient to adequately protect them. This approach will be explained in some detail below.

It has also been discussed in the doctrine whether extended protection for well-known trademarks and service marks is necessary. In this sense, one should consider the following scenario about a possible clash of interest between a local businessman and the proprietor of a well-known trademark. Let us assume that in Country X, a rather isolated or recently developing country, a businessman opens a store under Trademark A, and that this trademark is actually a well-known trademark registered outside the borders of Country X, belonging to Proprietor A. The mental state of the businessman, whether innocent, negligent or malicious, is irrelevant here. Should the existence and registration of the well-known mark in another state serve as a barrier for registration and/or use of the trademark in Country X, for the businessman, under these circumstances? If this question is answered in the negative, then this would eventually lead to the above-mentioned clash. This would happen in the following way. The fact that the original proprietor of the well-known trademark had not started using the trademark in Country X would either mean that the consumers of the products marketed and sold under the well-known product to be unaware of the product wholly, or that they already know of the product because of their particular interest in the product, their previous visits to the countries in which the product is sold or due to the online research they have made. While this is the case in Country X, in other countries where the well-known trademark has already been started to be used, it has gained a good reputation in the eyes of the consumers, hence the status of “well-known”. For the first set of consumers in Country X, where the said consumers are at least already aware of the product, the subsequent registration of the trademark for the businessman in Country X would lead to several results. The first of which would be that, they would start buying the product without having to do further research because they have already heard of it before. This would be

problematic from an equitable point of view, since the businessman would be taking unfair advantage of the popularity of the well-known mark, which has been raised to the level it is then, as a result of extensive, expensive and frequent marketing campaigns and promotional activities. This would of course be happening without the businessman spending a single dollar for advertising, which is by its nature unequitable and unjust. The second problem would arise in cases where the local businessman operating in Country X does not do a very good job in keeping the quality associated with the mark. This might happen in many ways, such as, serving bad and low-quality burgers, if it is assumed that the trademark is that of a fast-food chain which serves burgers. In such a case, the businessman would be tarnishing the brand-image that comes with the trademark and go as far as diluting the well-known trademark.¹³⁶ This would have numerous negative impacts on the original trademark proprietor who has made it well-known on his/her own account and by his/her own efforts. First of all, if any of the two owners of the trademark, namely the local businessman in Country X, and the original proprietor, Proprietor A, decide to expand their business, the question of, under whose name the trademark is to be registered would constitute a problem, if the areas in which they want protection clashes, which is more than a far-fetched possibility. Even if by some luck, the expansion areas do not clash and have no chance of overlapping in the future, the problems would still not be alleviated. This is because of the negative experience the consumers in Country X may face and the mobility of the consumers in today's world. If a certain consumer was to buy one of the above-mentioned burgers and was to get a stomach-ache because of the poor quality of the burger, he/she would not prefer buying a burger with the same trademark in another country he visits as a tourist or one in which he/she decides to relocate to, for work or for whatever reason; even though the burger is

¹³⁶ These concepts will be explored below in the following sections of this work.

completely unrelated to the one he/she has had in Country X. Of course, such a consumer wouldn't be aware of the distinction between the local businessman and Proprietor A, and the different level of quality they offer their consumers in their products. Another case may be that the same consumer in Country X writing negative reviews, or sharing his/her bad experience with the company online, which is easily viewable by millions of internet users across the globe, some of which located in the countries in which Proprietor A itself uses the well-known mark. This might once again lead to a decrease in the number of customers Proprietor A has, because of reasons completely irrelevant to him/her which he/she is unaware of, and cannot be blamed for. This would once again be unfair and unjust. As can be understood from the examples demonstrated above, the need to offer wider protection to well-known trademarks and service marks to adequately and sufficiently protect them from present and future exploits becomes essential.

It has also been discussed in the doctrine that offering a *sui generis* protection to well-known trademarks and service marks has become essential because of advancements in technology. Some of these advancements, which are thought to have increased the need to protect trademarks and service marks and especially the well-known ones are; advancements in the transportation and maritime commerce technologies, the methods of mass production, the internet and the social media. The advancement in the transportation and maritime commerce technologies to start with, have enabled the goods to be sold in areas where it was not possible to sell them before. In other words, this has led to the removal of geographical barriers in trade and

“along with the removal of most geographical barriers, such as the increase in the distance a ship or plane can cover without the need to refuel, or the ability to

*sail in icy waters with the introduction of icebreakers, goods can now be sold to virtually every part of the world.”*¹³⁷

This meant that, entities who held trademarks which pertained to the goods they produced, would now be sold and marketed around the globe. Secondly, the methods of mass production used in the modern world have also laid the groundwork for the protection of well-known marks, since they have enabled goods to be produced in an extremely fast and relatively cheaper way, compared to conventional methods. In this sense, if it is considered that before such techniques were introduced, an artisan would only produce for instance around ten items per day, and that after the introduction of mass production techniques, this number might increase as much as to a thousand, it would not be hard to understand why the reputation and knowledge of the product in the public has increased. This is because, a high number of products offered to the public will always bring along higher knowledge of the product, compared to ones that are offered in only small numbers.

Finally, the internet and the social media have also had a tremendous effect on the need to protect well-known marks. This is because, sometimes without even the users of such services being aware of it, they have served as a great way of advertising, creating a false need and impression of necessity among the public for luxury goods, services or brands. It is a known fact that internet has enabled advertising services to extend their reach and spread to even the remotest cities in the world. This has led to trademark and service marks to be known more.¹³⁸ It has even made it possible for consumers in such

¹³⁷ TANDOĞAN, S. *The Seller's Right to Cure Non-Conforming Goods and Documents*. King's College London LLM Dissertation. 2019. p. 4.

¹³⁸ YASAMAN, H. “*Tanınmış Markalar*”. *Ord. Prof. Dr. Halil Arslanlı'nın Anısına Armağan*. 1978. p. 692.

cities to instantly recognize the product even though they have not seen it before. This is possible because of the “*indicating source*” function of the trademarks, which means that the consumers learn about the source of the product by looking at the trademark on it.¹³⁹ The above contemplated collectively has made well-known mark protection indispensable.¹⁴⁰

This is why, when the above is considered, it will be understood why exceptions to the generally accepted principles governing the protection of regular trademarks have been made for the adequate protection of well-known marks. Some of these principles are; territoriality, class-based protection and the requirement for a trademark to be registered. As stated above, for the adequate protection of well-known trademarks and service marks; exceptions have been made to the above-listed principles.¹⁴¹ Therefore, to better understand the purpose of providing a special kind of protection to well-known trademarks and service marks, these will be briefly discussed below.

B) Territoriality

The principle of territoriality governs the law of trademarks. As briefly mentioned above¹⁴², although there are several attempts, some of which have proved to be successful, at unifying trademark law under international or at least regional norms, the law of

¹³⁹ KARAYALÇIN, Y. *Ticaret Hukuku C.1, Giriş- Ticari İşletme*. Ankara. 1968. p. 403.

¹⁴⁰ OĞUZ, A. p. 43.

¹⁴¹ ÇOLAK, U. p. 340.

¹⁴² see “*Relevant National, Regional and International Legislation*” above.

trademarks is still to a great extent territorial just as they were agreed to be, under the Paris Convention.¹⁴³

Therefore, under normal circumstances, a trademark proprietor does not have the right to claim any rights arising from his/her registration in a particular country, in other countries, which is in essence a reflection of the principle of territoriality.

Despite the above statement that the drafters of the Paris Convention have intended trademarks to confer territorial rights; as previously stated, since well-known marks constitute a grand exception to this principle¹⁴⁴, they have also included certain exceptions to this principle in the Convention as well, as can be seen in the articles about

¹⁴³ Article 6 titled “*Marks: Conditions of Registration; Independence of Protection of Same Mark in Different Countries*”, has the following wording in section (1):

“The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation.” This shows that the drafters of the Convention have intended trademarks to be territorial, as can be understood by looking at the words “*by its domestic legislation*”. Though it is important to keep in mind the two following sections of the same article as well. These are as follows: “(2) *However, an application for the registration of a mark filed by a national of a country of the Union in any country of the Union may not be refused, nor may a registration be invalidated, on the ground that filing, registration, or renewal, has not been effected in the country of origin.*

(3) *A mark duly registered in a country of the Union shall be regarded as independent of marks registered in the other countries of the Union, including the country of origin.”*

¹⁴⁴ YASAMAN, H. *Marka Hukuku ile İlgili Makaleler Hukuki Mütalâalar Bilirkişi Raporları*. V. 3. İstanbul.2008. p. 23.

well-known marks.¹⁴⁵ In such articles, it is allowed for well-known trademarks to be recognized and protected without the need to use or register the trademark in the country in which protection is sought. This demonstrates that the principle of territoriality is pierced for the purpose of providing protection to “well-known trademarks and service marks.”

In this sense, in many countries including Turkey, for” trademarks or service marks” to be recognized as well-known trademarks or service marks, it is not required for them to be previously used or registered. They will obtain protection almost automatically as per “Article 6bis of the Paris Convention”. This once again shows that, the principle of territoriality is pierced. This is because, even though such a well-known trademark or service mark is not previously used or registered in the country in which protection is sought, just by virtue of being in a member state to the Paris Union, established by the Paris Convention, the well-known mark has the power of acting as a barrier to the registration of subsequent similar or identical marks or of acting as a ground for cancellation. However, this does not make well-known trademarks and service marks entirely exempt from the principle of territoriality in the sense that, for the above powers to be practiced, the trademark or service mark is still required to “be well-known in the country in which protection is sought”, in many legal systems. Turkey is no exception to this principle.¹⁴⁶ In other words, as stated above, even though there are some exceptions to the principle of territoriality, especially in the registration and use of well-known marks, trademarks are still largely governed by, as the above example demonstrates, the principle of territoriality.

¹⁴⁵ For example, Article 6bis.

¹⁴⁶ OCAK, N. “*Markalarda Tescilin Sağladığı Korumanın Kapsamı*”. Prof. Dr. Ali Bozer’e Armağan. BTHAE. Ankara. 1998. p. 269- 283.

C) Class-Based Protection

One of the main principles governing trademarks and their protection, in almost all countries with a developed and complex legal system which provides protection to trademarks, is the principle of class-based protection. Class-based protection means that, when, under normal circumstances, a trademark or service mark is registered in a trademark register, the following protection granted to the trademark or service mark is class-based, which means that the scope of the trademark or service mark protection is limited to similar or identical goods and/or services to the mark registered in the register. Therefore, under this principle, obtaining protection for non-identical and dissimilar goods is not possible. However, a different set of rules has been developed for providing adequate and sufficient protection to well-known trademarks and service marks. As explained above in the chapter titled “*Rationale Behind the Special Protection*”, well-known marks need stronger protection. This purpose has been greatly achieved through the TRIPS Agreement,¹⁴⁷ In “Article 16/ (3) of the TRIPS Agreement”¹⁴⁸, the proprietor of the well-known mark is granted protection for all classes of goods and services for the well-known mark, provided that the mark is actually well-known and that the additional

¹⁴⁷ see “*the TRIPS Agreement*” above.

¹⁴⁸ Article 16/(3) TRIPS is as follows: “*Article 6bis of the Paris Convention (1967) shall apply, mutatis mutandis, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.*”

criteria set out in the said article is fulfilled as well. This way, it is possible to obtain protection for the well-known mark for “dissimilar goods and services” as well, which constitutes a clear exception to the principle of class-based protection. Once again, such extended protection is deemed to be necessary for the adequate protection of well-known trademarks and service marks.

D) The Requirement for the Mark to be Registered

Another principle which governs trademarks in general is the principle which requires that the trademark or service mark for which protection is sought to be registered in a register. This proves to be true, when the general practice of protecting trademarks in many countries and the related legislation, is examined. The Turkish Industrial Property Code, also requires the marks to be registered under normal circumstances, for them to be protected.¹⁴⁹ This clearly demonstrates that the rule is to have registered trademarks. However, as it is the case in almost all areas of law, there are many exceptions to this rule. Some examples to such exceptions in the TIPC are in Article 6. In this article, it is stated that “

If a right to a non-registered trademark or to another sign used in the course of trade was acquired prior to the date of application or the date of the priority claimed for the application for registration of a trademark, the trademark application shall be refused upon opposition of the proprietor of that prior sign.¹⁵⁰

¹⁴⁹ Article 7/(1) TIPC is as follows: “Trademark protection provided by this Code shall be acquired by registration.”

¹⁵⁰ Article 6/(3) TIPC.

This shows that although the main principle is the one which states that the registration of the mark is essential, the prior rights of unregistered trademark proprietors will be recognized to some extent.¹⁵¹

However, the most essential exception to the above-mentioned principle in the TIPC, concerning well-known marks is in Article 6/(4) TIPC. This article states that:

“Trademark applications, which are identical or similar to the well-known marks within the context of Article 6 bis of the Paris Convention, shall be refused, upon opposition, in respect of identical and similar goods or services.”

This demonstrates that the intention of the lawmakers who drafted the TIPC, was to make an exception to the principle of registration and to block any subsequent applications for the registration of any trademark which is similar or identical to a well-known mark, even in cases where it is “not registered in the country in which protection is sought”.¹⁵²

E) Some Unlawful Acts to be Protected Against

The reasons behind granting well-known trademarks and service marks a special kind of extended protection is explained in the above sections. This section will deal with three of the most commonly seen and when observed from an economic stand-point, the most

¹⁵¹ A similar approach is also present in Article 6/(6) TIPC, which states that *“An application for registration of a trademark shall be refused upon the opposition of the right holder if it consists of a person’s name, trade name, photography, copyright or any other intellectual property right of another.”*

¹⁵² ARSLAN, Ö. *Marka Hakkının Sona Ermesi*, Ankara. 2019. p. 78.

detrimental unlawful acts which concern well-known marks. These are trademark piracy, counterfeiting and dilution. It has been explained above how well-known marks are, in a sense, more fragile compared to regular marks. This statement was essentially made in consideration of the three unlawful acts mentioned above, and that is why it is indispensable to closely examine them separately. Although the practice of the above and the protection, safe-guards and remedies against them may differ to a small extent across different legal systems, the main principles mentioned below will, in most cases, continue to be valid for all of these.

1. Trademark Piracy

WIPO defines trademark piracy as “*the registration or use of a generally well-known foreign trademark that is not registered in the country, or is invalid as a result of non-use.*”¹⁵³ As stated above, the Paris Convention¹⁵⁴ requires well-known trademarks to be protected even in cases where they are not registered in the country in which protection is sought. However, unlike the case in the TRIPS Agreement, it only allows for the protection of similar or identical goods. This means that, in a sense, the “trademark pirates” are left with an opportunity to use the well-known trademarks or service marks for dissimilar goods and to take unfair advantage of the well-known trademarks. It is stated that the WIPO Joint Recommendation offers “*some guidance in this respect*”¹⁵⁵. However, due to the reason stated above, an improved and more extensive system of

¹⁵³ WIPO. *WIPO IPH*. p. 90.

¹⁵⁴ specifically, Article 6bis.

¹⁵⁵ *ibid.* 90.

protection is needed, in order to be able to offer better-suited protection to well-known trademarks and their proprietors against the said risk of trademark piracy, especially for dissimilar goods and services.

2. Counterfeiting

Counterfeiting is the act of unlawfully imitating a product. The product produced this way is referred to as “*the counterfeit*”. The counterfeit, in this sense, usually, is made as identical to the one produced by the original trademark proprietor and “*gives the impression of being the genuine product (for instance a LOUIS VUITTON bag), originating from the genuine manufacturer or trader.*”¹⁵⁶ As one might expect, counterfeiting is only profitable and feasible if the product of which a counterfeit is made, has obtained a certain level of knowledge and reputation in the eyes of the consumers. This is because, the main aim of counterfeiting is to take unfair advantage of another’s commercial success, in most cases without having to pay the relevant taxes to states. If the opposite were true, then counterfeiting would not be profitable for the party producing it, since the costs of marketing and producing the counterfeit product within certain specifications combined would be drastically above that of producing a new original product. Therefore, in most cases, goods that bear a well-known trademark are made subject to counterfeiting.

Counterfeiting in today’s world, has become an issue of importance due to several reasons. According to WIPO,¹⁵⁷ for certain luxury products bearing a well-known trademark, the worldwide sales of their counterfeit has exceeded the sales of the genuine product. This alarming fact shows how serious the issue is and how fast a response

¹⁵⁶ *ibid.* 90.

¹⁵⁷ *ibid.* 90.

mechanism is needed. As mentioned above, counterfeit products usually bear trademarks, in most cases, trademarks which are well-known. Therefore, it is possible to enforce against such counterfeiters through regular actions for trademark infringement. However, this does not always provide a sufficiently efficient and fast remedy to trademark proprietors, especially when how long it takes for courts to issue their final judgment, and the extensive geographical area in which the trademark is used, are considered. Therefore, an improved system of protection is needed to adequately and sufficiently protect well-known trademarks against counterfeiting. For such a system to be effective, it needs to have certain qualities. One of them is for the system to implement serious criminal sanctions against counterfeiting crimes, which should in serious cases go as far as imprisonment. Another one is the issuance of fast and efficient interim injunctions by the courts, for a fast response to the possibilities of the counterfeiters hiding themselves or the counterfeit goods they have produced and that of moving their business elsewhere, where they have not yet been discovered. Such interim injunctions would also temporarily protect the trademark proprietor for the duration of the judgment until the final decision has been issued by the courts. It would also be so much faster than issuing a final judgment, which would prevent the counterfeiters from furthering their aims. Here, some form of “undertaking in damages”¹⁵⁸ might be required from the party asking the court for the interim injunction, to be able to compensate the other party if the court finds eventually that the application was not justly made. One final aspect of the system should be to establish efficient and intensive customs checks at borders. This is important because in many cases, the counterfeit goods which their seller intends to sell, enters the market from foreign countries such as People’s Republic of China. In other cases, if the

¹⁵⁸ As in the legal system of the UK, where in some cases, an undertaking in damages is a pre-requisite in asking the court for an interim remedy.

counterfeit goods are produced in a certain country, then through customs checks, the goods could be prevented from being sold to other countries, meanwhile preventing the counterfeiters from extending their operations. A system comprising the above elements would prevent the practice of counterfeiting to a great extent and protect trademark proprietors and especially the proprietors of well-known trademarks.

3. Dilution

Dilution is also referred to as “whittling away” or “blurring of the mark”, in the doctrine. It is caused when a trademark or service “*mark’s ability to identify the goods or services for which it is registered is weakened.*” In other words, the “use of an identical or similar sign by a third party leads to dilution of the identity of the mark.”¹⁵⁹ Protection against dilution first appeared in the United States of America under Federal Laws.¹⁶⁰ Therefore, it can be said that the main principles governing protection against dilution formed under these federal laws. After that, it became an act which is protected against and considered unlawful in many states. For example, in Turkish Law, dilution is dealt with under Article 6/(5) of the Turkish Industrial Property Code¹⁶¹.

¹⁵⁹WIPO, on:

https://www.wipo.int/edocs/mdocs/mdocs/en/wipo_ipr_ty_17/wipo_ipr_ty_17_t15.pdf. Date Accessed: 25.03.2020.

¹⁶⁰ BÜYÜKKILIÇ, G. *Marka Hukukunda Tanınmış Markanın Sulandırmaya Karşı Korunması*. On İki Levha Yayıncılık. İstanbul. 2019. p. 356.

¹⁶¹ Article 6/(5) TIPC is as follows: “*A trademark application which is identical with, or similar to, an earlier registered trademark or registration application, shall be refused upon opposition of the proprietor of the earlier trademark; irrespective of whether the*

Under the said article, it is regulated that a trademark application must be rejected following an opposition from a trademark proprietor who holds another earlier trademark which is either similar or identical to the one for which a registration application is made; if it is decided that such registration of the trademark would “*be detrimental to the distinctive character or the reputation of the earlier trade mark due to the reputation of the earlier trademark in Turkey.*” Here it can be clearly seen that the intention of the drafters of the TIPC was to prevent entities from diluting trademarks, and especially well-known ones. It is explained above how “well-known trademarks and service marks” are more fragile in the context of counterfeiting. This is true in the context of dilution as well. Well-known marks are especially targeted by entities wishing to take unfair advantage of them because the benefit to be obtained from diluting a well-known trademark is greatly higher than doing the same for a regular trademark. The reasons specified above, in the section about counterfeiting, regarding this issue are also, once again, valid in the context of dilution as well. In this sense, what the regulations and safeguards against dilution aim to protect is the following: protection against cases where the reputation of the trademark or service mark may be harmed, cases where the distinguishing power of these marks are lessened due to unfair activities, where the trust the consumers have placed on the product in the market is detrimentally effected and where “unfair advantage” is taken of the trademark or service mark in general. ¹⁶²

goods or services for which it is used or registered are identical with, similar or different from those for which the latter trademark is applied for; if the use of the latter trademark without due cause would take unfair advantage of, or be detrimental to the distinctive character or the reputation of the earlier trade mark due to the reputation of the earlier trademark in Turkey.”

¹⁶² OĞUZ, A. p. 45.

V. THE PROTECTION OF “WELL-KNOWN MARKS” IN VARIOUS LEGAL CONTEXTS

A) The Paris Convention

As briefly explained above in the general chapter about “the Paris Convention”¹⁶³, the “Paris Convention for the Protection of Industrial Property” is one of the most important international instruments which govern trademarks, and well-known trademarks. The said chapter above dealt with the question of why the convention is an essential source of law in relation with trademarks in general and the main principles it has introduced in the field. Under this sub-heading, the convention will be examined in the context of well-known marks specifically. Here, the special protection granted to “well-known marks” under the convention will also be explained.

The Paris Convention marks a turning point in the history and practice of trademarks because the concept of a well-known mark first appeared in “the Paris Convention”. For this reason, many subsequent treaties, such as the Trademark Law Treaty¹⁶⁴ and the Singapore Treaty¹⁶⁵, have made it an obligation to comply with the terms of the convention. The Convention deals with well-known marks under Article 6bis.¹⁶⁶ It has

¹⁶³ see “*The Paris Convention*” above.

¹⁶⁴ under Article 15.

¹⁶⁵ Singapore Treaty on the Law of Trademarks (2006). Available on: <https://wipolex.wipo.int/en/treaties/textdetails/12668>. Date Accessed: 16.01.2021.

¹⁶⁶ Article 6bis Paris Convention, titled Well-Known Marks is as follows “(1) *The countries of the Union undertake, ex officio if their legislation so permits, or at the request*

been stated above that the convention establishes a union usually referred to as the Paris Union, in which members to the union are required to protect the rights of citizens of foreign countries in trademark matters as they would protect their own citizens and treat them equally in this sense. The convention also requires the marks which are deemed to be well-known, to be well-known in the country in which trademark protection is sought, in other words the target state. This leads to two outcomes. The first of which is that the mark need not be well-known in any other part of the world to obtain protection as long as it is well-known in the target state. However, the well-known mark should be deemed to be well-known “*by the competent administrative or judicial authorities*” in the member state.¹⁶⁷ The second outcome is that, in cases where the trademark is well-known in many states around the world, but for some reason is not well-known in the target state or not known at all in it, it is not possible for it to be deemed a well-known mark and

of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

(2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.

(3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith.”

¹⁶⁷ WIPO. *WIPO IPH*. p. 252.

benefit from the protection offered to them under the convention. The convention also allows well-known marks to be protected even if they are not registered or used in the target state in the sense described below. Although the convention deals with the above-mentioned aspects of well-known marks, there are two areas where the Paris Convention does not offer clear guidance. First of them is a test or criteria by which knowledge of the public on the mark can be determined. In other words, the convention does not include, factors or criteria which can be used to determine whether a mark is a well-known mark or not. It only points out that while making the determination on whether a mark is well-known or not, the knowledge of the general public should be taken into account.

As discussed above, the *WIPO Joint Recommendation* fills this gap to some extent and helps practitioners and registration authorities on this matter. The second area which the Paris Convention does not deal with or replace is the issue of trademark proprietors from states other than the target state, pursuing their rights in the target state. Such proprietors, despite the application of “the principle of national treatment” under Article 2, would still have to rely on the national trademark laws of the target state under such a situation, since the convention does not include any substantive law articles to regulate the matter.

Many states including Turkey¹⁶⁸ and the United Kingdom¹⁶⁹¹⁷⁰ have either transposed or incorporated the articles of the convention into their national laws, or deemed the

¹⁶⁸ POROY & TEKİNALP. p. 335.

¹⁶⁹ DAVIS, J. *Intellectual Property Law*. 4th ed. Oxford University Press. 2014. p. 236.

¹⁷⁰ In the United Kingdom, Article 6bis PC is implemented into the national law of the country by Section 56 of the Trade Marks Act 1994. DAVIS discusses in her book *Intellectual Property Law* that Section 56 offers a limited protection regime to well-known marks which are not registered in the UK and adds that it allows a trademark

convention to be directly applicable in relevant cases. Via these, the convention requires the states in the Paris Union to “*refuse or to cancel the registration, and to prohibit the use, of a trademark*” if it is a reproduction of any sort, of similar or identical goods produced under another trademark which is well-known in the target state, in the sense stated above. It does not have to be the whole product or well-known mark which is reproduced. It suffices that the “*essential part of the mark constitutes a reproduction of any such well-known mark*” to fall within the scope of this section. The members of the Paris Union have been granted a limited margin of appreciation regarding the period in which the trademark proprietor has to make an application for the cancellation of the mark which he/she thinks breaches his/her rights arising from the trademark, as long as it is at least five years. However, the time limit specified above, which is required to be at least five years “*from the date of registration*” of the trademark, does not operate in cases where “*the cancellation or the prohibition of the use of marks registered or used in bad faith*” is requested.¹⁷¹ The fact that the convention offers the above protection to well-known mark proprietors has been deemed unnecessary by some. However, as explained above in “*Rationale Behind the Special Protection*” the protection granted is a necessity.

“*proprietor to obtain an injunction against the use in the UK of an identical or similar trade mark in relation to identical or similar goods or services where use is likely to cause confusion.*” She states that the proprietor of the trademark may also “*prevent registration of a later conflicting mark, or seek to have it declared invalid*” but draws attention to the fact that the proprietor “*does not have the right to claim damages*” or the ability to act against the use of the mark on goods that are not similar to the ones produced by the proprietor. This happened to be the case in most countries until the coming into force of the TRIPS Agreement, which will be examined from this point of view below.

¹⁷¹ POROY & TEKİNALP. p. 335; Article 6bis /(3) PC.

Moreover, as WIPO puts it, “*the protection of well-known trademarks is deemed justified on the grounds that a trademark that has acquired goodwill and a reputation in a member country ought to give rise to a right for its owner.*”¹⁷² The convention, which confers upon well-known trademark proprietors the above rights, was and still is an indispensable international instrument which governs well-known trademarks. However, it is important to note that the convention was drafted in 1883, more than 100 years ago, when the needs of the proprietors, the realities of the markets and the technology was drastically different from those in today’s world. As a natural consequence of this, the convention, although amended several times throughout the past years, can be considered to be outdated in several areas and due to this, it would be absurd to expect it to answer to all needs and questions arising from the practice today.

B) The TRIPS Agreement

“The Agreement on Trade-Related Aspects of Intellectual Property Rights”, commonly referred to as “the TRIPS Agreement”, as mentioned above¹⁷³ has revolutionized the way trademarks are regulated. The above section about the TRIPS Agreement has made a brief introduction to the agreement and dealt with the principles it has introduced, such as the principle of “*most-favoured nation*”. This sub-heading will focus on how the TRIPS Agreement approaches well-known marks and on what kind of protection it promotes for them. As stated above, although it was first of its kind in the

¹⁷² WIPO. *WIPO IPH*. p. 252.

¹⁷³ see “*the TRIPS Agreement*” above for a general introduction to the TRIPS Agreement and the principles it has introduced.

century it was drafted in and is considered to be a progressive instrument, the Paris Convention started to fail to answer the needs of the new century. Therefore, as there have been paradigm shifting changes regarding trademarks and the way they are perceived, there was a need for a new and more comprehensive international instrument. This need was addressed at the “*end of the Uruguay Round of the General Agreement on Tariffs and Trade (GATT)*”¹⁷⁴ between 1989 and 1990”¹⁷⁵, and the resulting text was the TRIPS Agreement. Article 16 TRIPS¹⁷⁶ is among the most important articles in the text

¹⁷⁴ The full text of the General Agreement on Tariffs and Trade is available on: https://www.wto.org/english/docs_e/legal_e/gatt47.pdf.

¹⁷⁵ see GERVAIS, D., *The TRIPS Agreement: Negotiating History*. Sweet & Maxwell. London. 2012. Part I.

¹⁷⁶ Article 16 TRIPS, titled “Rights Conferred” is as follows: “(1) *The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner’s consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use.*

(2) *Article 6bis of the Paris Convention (1967) shall apply, mutatis mutandis, to services. In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark.*

of the agreement when it comes to dealing with well-known marks. After examining this and other related articles in the agreement, it will be seen that the drafters of the agreement have intended the agreement to introduce new principles and to replace or at least improve some of those in the Paris Convention.

In this sense, the TRIPS Agreement elaborates on the foundation set by the Paris Convention and, although not as detailed as the ones in the WIPO Joint Recommendation, offers some guidance on how to determine the presence of a well-known mark. The agreement states to that extent that; in *“determining whether a trademark is well-known, account shall be taken of the knowledge of the trademark in the relevant sector of the public, including knowledge in that Member [State] obtained as a result of the promotion of the trademark.”* Here it can be seen that, in the spirit described above, the drafters of the agreement have intended to evaluate how well-known a mark is by using *“the relevant sector of the public”* as an indicator, instead of public at large, as was the case in the Paris Convention. This has allowed for more accurate determinations to be made concerning how well-known a trademark or service mark is and has revolutionized the way practitioners and proprietors approach the issue. Moreover, the fact that the agreement allows the inclusion of the knowledge acquired via promotion of the mark as a factor in determining whether a mark is well-known or not has also increased the accuracy of the results obtained via such determination. One should also note the wording of the said

(3) Article 6bis of the Paris Convention (1967) shall apply, mutatis mutandis, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.”

section in the agreement since, the factors specified in the agreement are not meant to be exhaustive, as can be understood by the word “*including*”.

Another addition brought about by the TRIPS Agreement is the addition of services to the scope of protection offered under Article 6bis PC, which meant that service marks¹⁷⁷, could now benefit from the same protection offered to trademarks in “the Paris Convention”. However, the most revolutionary aspect of the TRIPS Agreement in relation to well-known trademarks and service marks is the extension of the protection “*given under art 6bis [PC] to goods or services which are not similar to those in respect of which the mark is registered*”¹⁷⁸, and is regulated under section 3 of Article 6 TRIPS. According to the said section, the above extension is possible only if the “*use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark*” and if “*the interests of the owner of the registered trademark are likely to be damaged by such use.*” Provided these conditions are met, “the TRIPS Agreement” drastically increases the protection granted to “well-known trademarks and service marks”. This is in line with the above-mentioned idea that “well-known trademarks and service marks” require an extended regime of protection to sufficiently and adequately protect them unlike regular trademarks and service marks. Although this is the case, it is argued that extending the protection to dissimilar goods means offering more protection to “well-known trademarks and service marks” than is needed and therefore is too much. However, this work does not agree with the said view, since as already discussed above, well-known marks are more fragile compared to regular ones and since it is easier to take unfair advantage of them with greater profit, they need the extended protection offered to them by the TRIPS

¹⁷⁷ see “*Trademarks vs Service Marks*” above.

¹⁷⁸ DAVIS, J. p. 236.

Agreement. Almost all trading countries of the world must have agreed with this statement, since they all have signed the TRIPS Agreement.

C) Protection under Turkish Law

The regulation of trademarks and the protection offered to them, as mentioned above, are still, to a great extent, governed by national legal systems, with minor exceptions due to the still prevailing principle of territoriality. Turkish law is no exception to this, and under the Turkish Legal System, the Turkish Industrial Property Code or shortly the TIPC, governs all kinds of industrial property, including trademarks and other various issues pertaining to them. Before the coming into force of the TIPC, industrial property, and specifically trademarks and well-known marks were regulated under several decree laws. With the TIPC, these have been unified under one code and the difficulties in practice, arising from the presence of several legal instruments have been overcome. There are a number of articles about trademarks in the TIPC, however one of the most important articles in the TIPC regarding trademarks is Article 6. Article 6 TIPC titled “*Relative grounds for refusal in trademark registration*” regulates as the title suggests, the relative grounds for refusal when a trademark is in the registration process and along with it includes certain rules about well-known marks.¹⁷⁹ This article demonstrates that

¹⁷⁹ Article 6 TIPC is as follows: “(1) *An application for trademark registration shall be refused upon opposition if there exists a likelihood of confusion on the part of the public, including the likelihood of association with the earlier trademark, due to identicalness with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered.*”

(2) *A trademark application for the registration of an identical or indistinguishably similar trademark filed by a commercial agent or representative in his own name without the trademark proprietor's consent and without any justifiable ground shall be refused upon the trademark proprietor's opposition.*

(3) *If a right to a non-registered trademark or to another sign used in the course of trade was acquired prior to the date of application or the date of the priority claimed for the application for registration of a trademark, the trademark application shall be refused upon opposition of the proprietor of that prior sign.*

(4) *Trademark applications which are identical or similar to the well-known marks within the context of Article 6bis of the Paris Convention, shall be refused upon opposition in respect of the identical and similar goods or services.*

(5) *A trademark application which is identical with, or similar to, an earlier registered trademark or application irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the latter trademark is applied for, and the use of the latter trademark without due cause would take unfair advantage of, or be detrimental to the distinctive character or the repute of the earlier trade mark due to the reputation the earlier trademark has in Turkey; shall be refused upon opposition of the proprietor of that earlier trademark.*

(6) *An application for registration of a trademark shall be refused upon the opposition of the right holder if it consists of a person's name, trade name, photography, copyright or any other intellectual property right of another.*

(7) *An application for registration of a trademark identical to or similar to a collective mark or a guarantee mark with identical or similar goods or services, that is filed within three years following the expiration of the protection of the collective mark or guarantee mark due to non-renewal shall be refused upon opposition of the previous right holder.*

most of the rules regarding the protection of well-known marks which were present in the previous decree law have been preserved in the TIPC. This means that, the means for protecting them have been, to a great extent, left untouched with minor alterations. In this sense, in the TIPC, well-known marks are protected through the means listed below. They can be protected by using the presence of an earlier well-known trademark as a relative ground for refusal in any subsequent trademark registration application. They can also nullify a registered trademark or service mark by serving as a ground for nullity. Moreover, well-known marks are also protected against unauthorized usage.¹⁸⁰ In addition to the above, the regime of protection granted to regular trademarks and service marks can also be operated for well-known marks, which are still trademarks. These are, acting as an absolute ground for refusal for identical goods and services, as a relative ground for refusal for identical or similar goods or services and finally, protection against unfair use.

Some of the above means for protection will be explained below for clarity. It has been stated above that well-known marks can be protected through operating the relative grounds for refusal. This means that, in case where an identical or similar trademark to a well-known mark, in the sense described in the Paris Convention, is sought to be registered, the registration application pertaining to the said trademark will be refused.

(8) An application for registration of a trademark identical to or similar to a registered trademark with identical or similar goods or services, that is filed within two years following the expiration of the protection of the registered trademark due to non-renewal shall be refused upon opposition of previous trademark proprietor provided that the trademark has been used during this period.

(9) Trademark applications filed in bad faith shall be refused upon opposition.”

¹⁸⁰ TEKİNALP, Ü. *Fikri Mülkiyet Hukuku*. Vedat Kitapçılık. 2012. p. 430.

The main purpose of the regulations regarding relative grounds for refusal is to protect the proprietor of an earlier absolute right, (in most cases a trademark) and not to protect the public interest. Therefore, they do not operate automatically. This means that they are not automatically taken into account by TÜRKPATENT and that they have to be specifically raised.¹⁸¹ Another means stated above is the filing of a law-suit against an already somehow registered well-known trademark (in the name of an entity other than the original proprietor), by the original owner of the well-known trademark, in order to nullify it.

It should be noted however that, in order for the means of protection in Article 6/(4) and Article 6/(5) to be operated, some conditions need to be present. To start with, in order to benefit from the protection provided in Article 6/(4) TIPC, there needs to be a well-known mark in the sense described in the Paris Convention, as stated above. Moreover, the trademark against which protection is sought should be similar to or identical to the trademark which is sought to be protected. Finally, the goods and/or services which pertain to the trademark or service mark of the entity seeking protection should be similar to or identical to those pertaining to the trademark or service mark of the entity against which the protection mechanism is operated. It should be stated here as well that, the well-known mark in the sense described in the Paris Convention, for which protection is sought under Article 6/(4) TIPC, need not be registered in Turkey, which makes it easier for the proprietors of such marks to benefit from the protection stated above.¹⁸²

Similarly, in order to operate the protection regime regulated under Article 6/(5) TIPC, certain conditions have to be collectively present as well. First of all, unlike the

¹⁸¹ ÇAĞLAR, H. *Marka Hukuku Temel Esaslar*. Adalet Yayınevi. Ankara .2013. p. 65.

¹⁸² OĞUZ, A. p. 37 .

situation in Article 6/(4) TIPC, where the goods and/or services which pertain to the well-known mark was required to be identical to or similar to those pertaining to the trademark or service mark of the entity against which protection is sought, in Article 6/(5) TIPC, no such requirement is present. This means that the scope of protection offered in the said article is wider than that of Article 6/(4) TIPC. Though the requirement for the mark for which protection is sought to be either identical to or similar to the one belonging to the entity against which protection is sought is applicable to the protection in Article 6/(5) TIPC. However, it should be kept in mind that, to benefit from this protection, the well-known mark, needs to be registered in Turkey.¹⁸³

Another condition for Article 6/(5) TIPC to be operated,¹⁸⁴ is the requirement of the trademark for which protection is sought, to have reached a certain degree of knowledge and reputation in Turkey. The important distinction here is in the wording of Article 6/(5) TIPC. If the wording of both Article 6/(5) TIPC and Article 6/(4) TIPC is examined, it will be seen that the drafters of the said articles have used different a wording when referring to marks which are protected under the said articles. Article 6/(4) TIPC, in this sense makes a reference to well-known marks, which are well-known in the sense described in the Paris Convention, where Article 6/(5) TIPC refers to marks which have attained a certain degree of knowledge and reputation in Turkey, and therefore can be referred to as renown marks. It is discussed in the doctrine that this distinction in the wording of the said articles is deliberate, and that they aim to refer to marks of different levels of recognition and reputation in the public.¹⁸⁵

It has been stated above that, the TIPC has preserved most of the old principles that were present in the decree laws governing the issue, with minor distinctions. Such a

¹⁸³ *ibid.* 37.

¹⁸⁴ and another difference between Article 6/(5) TIPC and Article 6/(4) TIPC.

¹⁸⁵ OĞUZ, A. p. 37.

distinction is the inclusion of the concept of “*due cause*” as the TIPC refers to it. This concept allows the proprietor of the trademark who has subsequently applied for the registration of his/her trademark to put forward a “*due cause*” to defend himself/herself, and protect his/her trademark by being allowed to keep it registered. However, this concept is merely an exception to the general rule. The protection operates when the above criteria are present and there are no “*just causes*” applicable to the situation, in the sense described above. If such an objection that the grounds stated in Article 6/(5) TIPC is made by the original proprietor of such a mark, then the competent authorities resolve the conflict by looking at some factors. These are; whether the well-known mark of the original proprietor who has made the objection has a prior registration or registration application, whether the objected mark and the mark of the original proprietor are identical or similar, whether the mark of the original proprietor has reached a certain degree of knowledge and reputation in Turkey, in the sense described above and whether the reputation and distinguishing power of the mark is detrimentally affected.¹⁸⁶

Another such distinction between the old decree law governing trademarks and the TIPC is, the inclusion of the wording: “*applications for identical or similar*” marks, which remedies the absence in the relevant section of the old decree law¹⁸⁷ regarding similar marks. In addition to the above, perhaps the most important distinction between the old decree law and the TIPC is the one in Article 7/2-c TIPC. In this article, it has been codified that protection would be granted to a trademark registered in Turkey against

¹⁸⁶ İMİRLİOĞLU, D. 6769 Sayılı Sınai Mülkiyet Kanunu’na Göre Marka Hukukunda Ayırt Edicilik ve Markanın Ayırt Ediciliğinin Zedelenmesi, 556 Sayılı KHK ile Karşılaştırmalı, Ankara. (2017) p. 209 in OĞUZ, A. *ibid.* 38.

¹⁸⁷ Section 8/4 of the *Promulgated Decree Law Numbered 556 Regarding the Protection of Marks* dated 24.06.1995.

another sign which was used without due cause, in the sense described above, regardless of whether it pertains to goods or services which are identical or similar to that of the registered mark. In other words, under the TIPC, such registered well-known marks would be protected even if the goods and/or services pertaining to the conflicting sign are in different classes.¹⁸⁸ Moreover, as it is also clear from the wording of the previous sentence, the TIPC does not require the conflicting sign to be a trademark, as long as the first registered one is a trademark or service mark. This conclusion is drawn merely by looking at the wording of Article 7/2-c TIPC. Similarly, it is not required by the code, for the conflicting sign to be registered to fall within the scope of the above article.¹⁸⁹

D) Well-known Marks in Selected Judgements and Decisions

As explained in great detail above, since well-known marks and the rules regulating them are not comprehensive in the sense that they do not have the capacity to answer every possible dispute arising out of them, there have been many law-suits which have well-known marks as their subject matter. In some of these cases, the question of, what constitutes a well-known mark, has been argued. In others, the issue of whether a specific trademark or service mark is well-known or not has been discussed. Finally, in some others, the claimants in the said cases argued that a rival trademark or trademark application has to be either cancelled, refused or nullified due to the fact that they –the claimants- are the proprietors of a well-known mark which serves as a ground for refusal, cancellation or nullification. The common denominator in these cases is that they all serve as good sources to learn more about well-known marks and that they fill the gaps in international, regional and national legislation which regulate well-known marks and the

¹⁸⁸ BÜYÜKKILIÇ, G. p. 132.

¹⁸⁹ *ibid.* p. 130.

way they are protected. Some of these cases will be briefly discussed below to demonstrate how the above purpose is achieved.

One of the most important cases concerning well-known marks, in the above sense, is the *General Motors (GM) vs Yplon SA (2000)*¹⁹⁰ case. In this case, it has been pointed out by the advocate general that well-known marks “*presumably will have to command a very high degree of consumer recognition, greater than that for marks with a reputation*”¹⁹¹ to be classified as well-known marks.

Moreover, the decision states, unlike other views in the doctrine which state that a certain percentage of the public should be in the know of the trademark for the trademark to be recognized as a well-known mark, that it “*cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined*” in the decision, for it to be deemed well-known. Just as the approach in the *WIPO Joint Recommendation*, explained in detail in the chapters above, in this case, the view that the assessment of whether a mark is well-known or not should be made by looking at the “*relevant sector of the public*” rather than at the public at large, is accepted. This is demonstrated with the words, “*the degree of knowledge required must be considered to be reached when the earlier mark is known by*

¹⁹⁰ General Motors Corporation and Yplon SA; on the interpretation of Article 5(2) of the First Council Directive (89/104/EEC) of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Judgment of the Court 14 September 1999. The full text of the judgment is available in English on: <https://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:61997CJ0375&from=en>. Date Accessed: 16.01.2021.

¹⁹¹ DAVIS, J. p. 237.

*a significant part of the public concerned by the products or services covered by that trade mark*¹⁹², in the case. Moreover, once again, similar to the WIPO Joint Recommendation, the judgment in the said case states that factors such as the “*market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it*”¹⁹³ should be used in determining whether a trademark is well-known or not, among other relevant facts of the case.

Another decision issued by the Turkish Supreme Court’s General Assembly of Civil Chambers, states that no clear and comprehensive definition of what constitutes a well-known mark has been provided in the Paris Convention and the TRIPS Agreement. For this reason, in its judgement, the General Assembly of Civil Chambers states that, a well-known mark is a reflexive association which surfaces in the minds of consumers, as a result of good quality, the guarantee associated with the products pertaining to the mark, and a good distribution and marketing network. The decision also states that such an association should not be made as a result of any hostility or competition among rivals, and that the decisions and recommendations of WIPO should be taken into account when issuing a judgment about well-known marks.¹⁹⁴ In another judgment issued by the 11th Civil Chamber of the Turkish Supreme Court,¹⁹⁵ the majority view about which consumers should be taken into account when making the determination about whether a

¹⁹² Paragraph 26 of the *General Motors Corporation vs. Yplon SA (2000)* Judgment.

¹⁹³ Paragraph 27 of the *General Motors Corporation vs. Yplon SA (2000)* Judgment.

¹⁹⁴ General Assembly of Civil Chambers of the Supreme Court of the Republic of Turkey’s Judgment dated 21.09.2005, (2005/11.476 E., 2005/483 K.).

¹⁹⁵ 11th Civil Chamber of the Supreme Court of the Republic of Turkey’s Judgment dated 03.04.2007 (2005/14028 E., 2007/5223 K.).

mark is well-known or not, is accepted. In this sense, it is stated in the text of the judgment that while making the determination about whether a mark is well-known or not in Turkey, the knowledge of the sector of the public in Turkey which the trademark appeals to should be assessed rather than assessing the knowledge of a random consumers in the public. The wording of the judgment also specifies that such knowledge should be present in a substantial number of consumers and at least in the average consumers in the cross-section of the public which is formed out of the consumers to which the trademark appeals.

Another important case regarding well-known marks and the concept of bad faith in their registration is the Burger King Case in South Africa.¹⁹⁶ In the said case, the Burger King Corporation opposes a registration application made by a South African company, to register the Burger King trademark for burgers. The case is interesting in the sense that it sheds some light to several different areas concerning registration of a well-known mark. The registrar, in the said case stated that the Burger King trademark was well-known, especially in the United States of America, however, found that its proprietors has not used or registered the said trademark in South Africa. For this reason, the registrar stated that *“the Burger King Corporation had not established a reputation in the Burger King mark in South Africa. Nonetheless, the registrar, determined that the local Wimpy company was not the true proprietor of the mark had no right to apply for registration.”*¹⁹⁷ This was mainly because he observed that;

¹⁹⁶ SA Wimpy (Pty) Ltd v Burger King Corporation, decision of the Registrar of Trade Marks 14 June 1978, reported in September 1978 South African Patent Journal, 166, noted at 69 TMR 172 (1979).

¹⁹⁷ MOSTERT, F. *pp.* 44-45.

*“the managing director of Wimpy was well aware of the reputation of the Burger King mark in the United States and had deliberately proceeded with the application. Accordingly, in view of Wimpy’s bad faith and deliberate misappropriation of the Burger King mark, the Registrar, in exercising his discretion, denied the application and upheld the opposition in favour of Burger King.”*¹⁹⁸

This case, as shown above offers a good demonstration of how the element of bad faith can affect the registration of well-known marks, especially in the name of proprietors other than the true, original proprietors of the mark, in countries other than the country in which the trademark was developed and first launched. Moreover, it shows how a well-known mark, which is indeed well-known can be considered to be in a weaker position, especially in cases where the well-known trademark (or service mark) has not yet been used or registered in countries other than the country in which the well-known mark was first launched or where the mark first acquired its well-known status.

¹⁹⁸ *ibid.* 45.

VI. CONCLUSION

As demonstrated in this work, well-known trademarks and service marks around the globe, have been granted additional protection by national, regional, and international legal instruments, in order to sufficiently and adequately protect them. The reasons behind this are twofold. The first is that well-known marks are more fragile, compared to regular ones, as explained above, as they are easier to take unfair advantage of, since the unlawful profit which can be made out of such practices is usually higher and since, due to the extensive use of such marks around the globe, they are more susceptible to practices such as counterfeiting and dilution. The second reason is that, well-known marks are, by their nature, very different from trademarks which do not enjoy such high level of recognition and reputation in the eyes of the consumers. This becomes apparent when the way well-known marks are treated, especially in international legal instruments, is examined. In such instruments, certain qualities are bestowed upon well-known marks, which allow them to be, in a sense, exempt from principles governing trademarks. For instance, well-known marks, constitute exceptions to the principles of: territoriality, class-based protection and the requirement for the mark to be registered, which are considered building blocks of a trademark. With the Paris Convention and the TRIPS Agreement, the above principles are pierced in a way which broadens the protection offered to well-known marks. It is stated by some that, the protection regime relating to well-known marks confers too much protection to well-known marks, so much so that they end up having an unfair and unbalanced association with regular trademarks. However, as demonstrated in this work, despite the above statement that the main reason behind granting extra protection to well-known marks is not to reimburse the proprietor for the expenses it has incurred to create a well-known mark; when the exceptional nature of well-known marks and the amount of time, funds and effort spent by their proprietors on

raising the mark to the status of “*well-known*” is taken into consideration, it will be seen that the level of protection afforded to well-known marks is actually no more than necessary. Moreover, as technology advances faster than it ever did in history, and as the effects of globalization have impacted even the remotest towns in the world, information on, or at least knowledge of, trademarks (and service marks) is reaching more consumers than it ever reached. This means that, in the near future, the legal instruments which well-known marks rely on, to obtain protection will become insufficient in answering to the needs of their proprietors, with the exponential development of technology, the social media and the production techniques; which is when a reformed and more extensive set of rules will be needed, to keep the legal status quo surrounding well-known marks.

ABSTRACT

Along with the advancements in the telecommunication technologies, and the widespread usage of social media, information now disseminates across the entire globe in a matter of seconds. The effect of this has been twofold in the world of trademarks and service marks, in that, it has been both beneficial and detrimental to the proprietors of such marks, and even more so, if such marks are well-known marks. The benefit enjoyed by the proprietors in the above sense, is that they do not have to go through all the trouble of promoting and marketing their mark, as now it takes less time, funds and effort for the trademark or service mark to be introduced to consumers in even the remotest parts of the world. The detrimental effect incurred by such proprietors on the other hand is, the fact that their well-known trademark and/or service mark now needs more protection as it is easier to take unfair advantage of such marks compared to regular ones. The special protection regime granted to well-known marks, by national laws, regional legal instruments and international legal instruments such as the Paris Convention and the TRIPS Agreement, aims to answer to this need and to provide adequate protection to these marks. To achieve this purpose, these legal instruments have been drafted in such a way that they confer well-known marks a special position among other trademarks in the sense that they are held exempt from principles such as the principles of territoriality, class-based protection and the requirement for the mark to be registered to obtain protection. This work, therefore, focuses on what constitutes a well-known mark, how they are exempt, to some extent, from the above principles and how they are regulated and protected in various legal contexts.

ÖZET

Telekomünikasyon teknolojilerinin gelişmesi ve sosyal medyanın yaygın ve yoğun kullanımı sonucu bilgi, günümüzde, dünyanın herhangi bir yerine saniyeler içinde ulaştırılabilmektedir. Bu durumun markalar ve marka sahipleri bakımından- özellikle bahsi geçen markalar tanınmış markalar ise- biri olumlu biri olumsuz olmak üzere iki sonucu olmuştur. Bu bakımdan, ortaya çıkan olumlu sonuç, söz konusu marka sahiplerinin artık eskiye kıyasla daha az zaman, para ve emek harcayarak markalarını dünyanın en ücra şehirlerindeki tüketicilere bile tanıtılabiliyor olmalarıdır. Diğer yandan, ortaya çıkan olumsuz sonuç ise, tanınmışlık ve kullanımları artan markalarının, bunlardan haksız fayda sağlamanın da daha kolay hale gelmesi sebebiyle, daha çok korunmaya ihtiyaç duymaya başlamalarıdır. Tanınmış markalara; ulusal hukuk sistemleri, bölgesel ve Paris Sözleşmesi ile TRIPS Anlaşması gibi uluslararası hukuk metinleri tarafından tanınan özel genişletilmiş koruma rejimi de yukarıda bahsi geçen artan koruma ihtiyacına cevap vermek amacıyla ortaya çıkmıştır. Bu amaca ulaşmak için, söz konusu hukuki metinler, tanınmış markaları ayrıcalıklı bir konuma getirecek şekilde kaleme alınmış ve bu şekilde, tanınmış markalar, marka hukukuna egemen olan bölgesellik, sınıf esasına dayalı koruma ve tescil ilkesi gibi kuralların bir kısmından belli ölçüde muaf tutulmuştur.

Bu çalışmada, yukarıda bahsi geçen esaslar ve muafiyetler çerçevesinde; tanınmış marka kavramı, tanınmış markalara sunulan özel ve genişletilmiş koruma ile çeşitli hukuki metinlerde ve yargı kararlarında tanınmış markaların ele alınışı konuları incelenmiştir.

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