

**REPUBLIC OF TURKEY**

**ANKARA UNIVERSITY**

**GRADUATE SCHOOL OF SOCIAL SCIENCES**

**DEPARTMENT OF INTELLECTUAL PROPERTY, TECHNOLOGY  
POLICIES AND INNOVATION MANAGEMENT**

**MASTER OF LAWS (LL.M.) in INTELLECTUAL PROPERTY**

**LETTERS OF CONSENT IN TRADEMARK LAW**

**Master's Thesis**

**Aslı İBİŞ**

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**Prof. Dr. Arzu OĞUZ**

**Co-Supervisors**

**Ankara, 2020**

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## **DECLARATION**

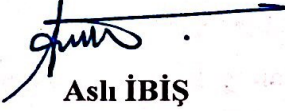
**REPUBLIC OF TURKEY**

**ANKARA UNIVERSITY**

**To the Directorship of Graduate School of Social Sciences,**

I hereby, declare that all information in my master's thesis named "Letters of Consent in Trademark Law, (Ankara, 2020)" 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, 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 the study process and if it is proven otherwise, I will accept all legal consequences.

Date: 13.03.2020

  
Aslı İBİŞ

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## LIST OF ABBREVIATIONS

**ECJ** : European Court of Justice

**EU** : European Union

**EUIPO** : European Union Intellectual Property Office

**INTA** : International Trademark Association

**OHIM** : Office for Harmonization in the Internal Market

**TCC No. 4721** : Turkish Civil Code No. 4721

**TCC No. 6012** : Turkish Commercial Code No. 6012

**TCO** : Turkish Code of Obligations No. 6098

**TFEU** : Treaty on the Functioning of the EU

**TIPC** : Turkish Industrial Property Code No. 6769

**TPTO** : Turkish Patent and Trademark Office (TÜRKPATENT)

**WIPO** : World Intellectual Property Office

**ed.** : Edition

**ibid.** : ibidem, in the same place

**p.** : Page

**para.** : Paragraph

**vol.** : Volume

## INTRODUCTION

In modern market economies, manufacturers and service providers fiercely compete in the market and aim to be “the one” in the eyes of consumers. This is the ultimate goal of every manufacturer and service provider in today’s world. What makes them identifiable, recognizable and more valuable is their brand or as referred to in the legal terminology their “trademark”. In the modern sense, a trademark is considered as the most precious asset of the players in the market. Therefore, trademark holders seek a way to protect the said asset against unauthorized uses by third parties. Such protection is provided by the rules of law.

There are different ways of protecting a trademark yet; the strongest way to do so is to register the trademark. Registration of a trademark grants the entity applying for registration, an absolute trademark right, which can be enforced against third parties. In addition to the concept of registration, further principles also apply to the protection of trademarks such as the principle of specialty of trademark.

The principle of specialty of trademark applies to registered trademarks and creates a more secured environment against the risk of “*existence of identical or similar trademarks*”. According to the principle of specialty of trademark, “*the existence of identical or similar trademarks on identical or similar goods or services*” is not allowed in order to safeguard the rights of the earlier trademark proprietor and to eliminate the risk of likelihood of confusion for the consumers between identical or similar trademarks.

In Turkey, the principle of specialty of trademark is reflected under the refusal grounds for registration. Unlike the European Union (“EU”) trademark law, the Turkish trademark law applies the principle of specialty more strictly and regards “*the existence*



*of an identical or indistinguishably similar trademark on identical or similar goods or services*” as an absolute ground for refusal of registration. In the EU, however, “*the existence of an earlier identical or similar trademark on identical or similar goods or services*” has been envisaged as a relative ground for registration, which can only be enforced upon an opposition. In Turkey, in case there is an earlier “*identical or indistinguishably similar trademark on identical or similar goods or services*”, the Turkish Patent and Trademark Office (“TPTO”) will directly refuse the later trademark registration application. Such ground has been related to the public interest since the Abrogated Decree Law No. 556 on the Protection of Trademarks (“Abrogated Decree Law No. 556”) and preserved under the Turkish Industrial Property Code No. 6769 (“TIPC”) as an absolute ground for refusal of registration<sup>1</sup>. Nonetheless, the provision has been a matter of debate for a long time due to its nature and its relation with the public interest. Such debate has recently surfaced, with the adoption of an exception to the above-mentioned principle.

Due to the need of the trademark holders and the change in the understanding of the EU, Turkey has also given green light to the co-existence of trademarks despite the principle of specialty of trademark. Before the TIPC came into force, under the Abrogated Decree Law No. 556, there was no provision in relation to the voluntary co-existence of identical or similar registered trademarks. The exception has been officially provided by a provision under the TIPC, which allows the registration of “*identical or*

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<sup>1</sup> Abrogated Decree Law No. 556 on the Protection of Trademarks, dated 27.06.1995, published in the Official Gazette dated 27.06.1995, numbered 22326, abrogated on 22.12.2016; Turkish Industrial Property Code No. 6769, dated 22.12.16, published in Official Gazette dated 10.1.17 numbered 29944. (*in force*).

*indistinguishably similar trademarks on identical or similar goods or services*” through a letter of consent issued by the earlier trademark owner.

According to Article 5/3 of the TIPC, a letter of consent issued in accordance with the rules of the TIPC and submitted to the TPTO within the prescribed time period, will prevent the *ex officio* refusal of the TPTO based on Article 5/1(ç). This is regarded as an exception to the principle of specialty of trademark and a way to enable the co-existence of registered trademarks in Turkey. Letters of consent are subject to a number of strict requirements provided by the law in order to be deemed valid and enforceable before the TPTO. In practice, before issuing letters of consent, parties usually conclude either a private agreement in relation to letters of consent or a trademark co-existence agreement for the purpose of regulating the co-existence relationship. Such private agreements have also had a huge impact on the co-existence relationship.

This work aims to provide a well-rounded analysis of the co-existence of *“identical or indistinguishably similar trademarks on identical or similar goods or services through letters of consent”* in trademark law. It also attempts to shed light particularly on letters of consent and implementation of letters of consent in Turkey and is constructed upon three main chapters.

The first chapter will provide an overview of protection of trademarks through registration and grounds for refusal of registration under the TIPC. Following that, the work will analyse the principle of specialty of trademark and how this principle is reflected under the refusal grounds for registration under the TIPC. Additionally, the first chapter will analyse the co-existence exception and the role of the voluntary co-existence of registered trademarks in general and its differences from other similar voluntary institutions. In the second chapter, the work will analyse the co-existence of registered trademarks through letters of consent in Turkey. The chapter will cover, *inter*

*alia* the legal nature, parties, scope, form and submission of letters of consent. In addition to that, the role of the private agreements in relation to letter of consent will be analysed. In the final chapter, the EU trademark law in relation to letters of consent and the harmonization level of Turkish trademark law with the EU Trademark Directive will be examined. Finally, the impact of letters of consent practice on consumer law and competition law along with the recent criticism on the practice of letters of consent from different perspectives will be evaluated. The work tries to answer the question of whether the present letter of consent practice is in line with the essential functions and purposes of trademark.



## CHAPTER ONE

### **PROTECTION OF TRADEMARKS, THE PRINCIPLE OF SPECIALTY OF TRADEMARK AND THE CO-EXISTENCE OF TRADEMARKS**

#### **I. Protection of Trademarks and Registration**

##### **A. Trademarks in General**

Trademark is considered as one of the rights of intellectual property law, which has gained a huge importance within the last decade, especially with the development of market-oriented economies embodying competing manufacturers who offer a variety of goods or services to consumers<sup>2</sup>. Even in same sector, usually, there are number of goods, which are almost identical or bearing unapparent differences. By looking at their quality, ingredients or price, consumers may differentiate a good from another<sup>3</sup>. Nonetheless, differentiation of a good may not be as easy as it seems for the consumers who are not professional enough to do so. Therefore, it is necessary to guide and protect the weak ones and enable them to make the right decision among various goods or services.

The solution developed has been branding the goods and services with a sign chosen by the owner of the good or service and distinguish that good or service from the others. Under the intellectual property law, such sign is called as “trademark”. A trademark is protected by the law, as long as it is in compliance with the rules of intellectual property law determined with respect to it. Unlike other intellectual property rights, which protect intellectual creations, trademarks are in relation to signs that

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<sup>2</sup> **WIPO**, “WIPO Intellectual Property Handbook”, WIPO Publication 2004, 2nd ed., p. 67. (*WIPO, “IP Handbook”*).

<sup>3</sup> *ibid.*

represent a particular good or service in the market and transmit information to consumers with respect to the relevant good or service provided in that market<sup>4</sup>.

A trademark is a distinctive tool that indicates the origin of the goods or services to enable consumers to distinguish that good or service from the others<sup>5</sup>. This is also mentioned by the European Court of Justice (“ECJ”) and consistently repeated under many decisions<sup>6</sup>. According to the wording of the ECJ under the Sieckmann case: “(...) *the essential function of a trademark is to guarantee the identity of the origin of the marketed product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish that product or service from others which have another origin(...)*”<sup>7</sup>. With this function, by pointing the identity of origin and being distinctive to the consumers, on one hand, the proprietor may be able to prevent any

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<sup>4</sup> *ibid.*, p. 4.

<sup>5</sup> **Kitchen**, David & **Llewelyn**, David & **Mellor**, James & **Maeda**, Richard & **Moody-Stuart**, Thomas & **Keeling**, D., “Kerly’s Law of Trade Marks and Trade Names” Sweet & Maxwell, London, 14<sup>th</sup> ed., 2005 p. 8; **Michaels**, Amanda “A Practical Guide to Trade Mark Law”, Sweet& Maxwell, 3rd ed., 2002, p. 2.

<sup>6</sup> **Kitchen & Llewelyn & Mellor & Maeda & Moody-Stuart & Keeling**, p. 9; Loendersloot, Case C-349/45 (1997) E.C.R. I-6227, para. 22 and 28; Canon, Case C-39/97, (1998) E.C.R. I-5507, para. 28.

<sup>7</sup> Ralf Sieckmann v Deutsches Patent –und Markenamt-, Case C-273/00, E.C.J. (2003), RPC 38, para. 35, English translation available at: <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A62000CJ0273>, accessed on 31.01.2020.

competitors to unfairly take advantage of his mark's commercial reputation<sup>8</sup>. On the other hand, the consumers may be guaranteed with the quality and the origin of the good or service provided under a particular mark. This function of trademarks goes hand in hand with other functions of trademark such as advertisement, quality assurance and guarantee functions<sup>9</sup>. Additionally, a distinctive trademark underpins brand attractiveness, recognition and an increase in the value of the trademark and the good or service represented by it<sup>10</sup>.

In Turkey, trademarks are grouped within industrial property rights alongside the patent and industrial design rights under the Turkish Industrial Property Code No. 6769 ("TIPC") and the rules with respect to trademarks, the rights assigned to it and the criteria of protectability of trademarks are provided thereunder<sup>11</sup>.

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<sup>8</sup> **Davis**, Jennifer "Intellectual Property Law", Oxford University Press, Core Text Series, 4th ed. 2012, p. 207; Koninklijke Philips Electronics NV v Remington Consumers Products Ltd, Case C-299/99, E.C.J. (2002), available at: <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A61999CC0299>, accessed on 31.01.2020.

<sup>9</sup> **Çağlar**, Hayrettin, "Marka Hukuku: Temel Esaslar", Adalet Yayınevi, Ankara, 2013, p. 33; **Michaels**, p. 2.

<sup>10</sup> **Davis**, p. 201.

<sup>11</sup> Turkish Industrial Property Code No. 6769, dated 22.12.16, published in Official Gazette dated 10.1.17 numbered 29944.

## B. Legal Nature of Trademarks and the Trademark Right

The legal nature of trademarks has been controversial for a long time due to the lack of clarification with respect to it. The doctrine questions “what actually trademarks are referring to” and “whether a trademark constitutes a property” and “whether the right on a trademark constitutes an ownership right”<sup>12</sup>. There are various different approaches within the doctrine in this regard<sup>13</sup>. Since 2008, the Constitutional Court of Turkey made number of annulment decisions finding that intellectual property rights, including trademark right, constitute ownership rights<sup>14</sup>. Although, the Constitutional Court of Turkey regarded intellectual property rights as ownership rights, the nature of trademarks was still in question until 2015. In 2015, in order to shed light on the debates on the legal nature of trademarks, the Constitutional Court of Turkey considered trademarks as intangible assets and determined that their monetary value can be measured<sup>15</sup>.

According to the Turkish Civil Code No. 4721 (“TCC No. 4721”), which defines the scope of ownership rights, ownership right means the legal right to possess an

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<sup>12</sup> **Gün**, Buket, “Marka Hukukunda Birlikte Var Olma”, İstanbul Üniversitesi Hukuk Fakültesi Özel Hukuk Yüksek Lisans Tezleri Dizisi”, Oniki Levha Yayınları, İstanbul, September 2019; p. 26.

<sup>13</sup> *See below, supranotes no. 18 & 19.*

<sup>14</sup> Anayasa Mahkemesi, 2004-3/47, dated 31.01.2008 (Official Gazette dated 20.03.2008, numbered 26822), Anayasa Mahkemesi, 2004-81/48, dated 31.01.2008 (Official Gazette dated 20.03.2008 numbered 26822), Anayasa Mahkemesi, 2013-100/14, dated 29.01.2014 (Official Gazette dated 29.05.2014, numbered 29014).

<sup>15</sup> Anayasa Mahkemesi, 2015/33 E. 2015/50 K dated 27.05.2015.

asset<sup>16</sup>. Under the TCC No. 4721 assets are divided as immovable assets and movable assets. Pursuant to Article 704 regarding the ownership on immovable assets, immovable assets are classified as lands, independent and perpetual rights registered on a separate page on the registry and independent flats. On the other hand, Article 762 regarding the ownership on movable asset defines movable assets as movable tangible assets and natural forces which are not capable of being owned and do not fall within the scope of immovable ownership. As it can be seen from these definitions under the TCC No. 4721, there is no indication with respect to intangible assets and intangible ownership<sup>17</sup>.

The legal nature of intangible assets and ownership on intangible assets still remain unanswered under the TCC No. 4721. In this sense, some authors still argue that since the trademark right cannot be considered as an ownership right, it should be regarded as an intellectual right<sup>18</sup>. On the contrary, many authors identify the right on a trademark as ownership right, since it grants a possession and exclusive rights and authorities to the owner of the trademark<sup>19</sup>. Although, it is not regarded as a classical

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<sup>16</sup> Turkish Civil Code No. 4721, dated 22.11.2001, published in the Official Gazette dated 08.12.2001, numbered 24607.

<sup>17</sup> **Kılıç**, Ahmet Hasan: “Markaların Birlikte Var Olma Sözleşmesi”, TFM 2017, 2(2), p. 79.

<sup>18</sup> See: **Kaya**, Arslan, “Marka Hukuku”, İstanbul, 2006, p. 38; **Tekinalp**, Ünal, “Fikri Mülkiyet Hukuku”, Güncelleştirilmiş ve Genişletilmiş 5.Baskı, Vedat Kitapçılık, İstanbul, 2012, p. 21-22.

<sup>19</sup> See: **Yasaman**, Hamdi & **Altay**, Sıtkı Anlam & **Ayoğlu**, Tolga & **Yusufoğlu**, Fülürya & **Yüksel**, Sinan, “Marka Hukuku: 556 sayılı KHK şehri, C.1, İstanbul, 2004, p. 174-175; **Kitchen & Llewelyn & Mellor & Maeda & Moody-Stuart & Keeling**, p.



ownership right defined under the TCC No. 4721, it could be referred as an ownership right in light of Article 35 of Turkish Constitution<sup>20</sup>. As it could be from above-mentioned annulment decisions, the Constitutional Court of Turkey has adopted this approach as well.

Trademark grants an ownership right to the owner of a trademark, which contains exclusive rights and authorities including but not limited to the right to use (*usus*), right to enjoy (*fructus*) and right to dispose (*abusus*)<sup>21</sup>. Trademark right is an absolute right, which can be enforced against third parties. Therefore, owner of a trademark can prevent unauthorized use of his/her trademark by any third person. The owner may also derive profit from his/her trademark by ways of licensing or franchising. Alternatively, the trademark owner may consent the registration of an “*identical or similar trademark on identical or similar goods or services*”. Additionally, trademark proprietor may conclude a trademark co-existence agreement with a person who wants to exist in the market with identical or similar trademark. As long as the trademark is considered as an ownership right, the trademark owner may freely exercise the rights on it and conclude trademark co-existence agreements<sup>22</sup>. However, under

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540; **McCarthy**, Thomas J., “McCarthy on Trademarks and Unfair Competition”, 4th ed., 6 vol., 2007, para. 2.30.

<sup>20</sup> **Kılıç**, p. 80; **Tekinalp**, p. 5; **Gün**, p. 32.

<sup>21</sup> **Gün**, p. 32.

<sup>22</sup> **Moss**, Marina: “Trademark ‘Coexistence’ Agreements: Legitimate Contracts or Tools of Consumer Deception?”, *Loyola Consumer Law Review*, vol. 18, issue 2/4, 2005, p. 197: According to Moss, in case trademarks are considered as “properties”, then the proprietors of trademarks can conclude valid trademark co-existence agreements although such agreements are in contradiction with the public interest. On the other

Turkish law, although the trademark right is considered as an absolute ownership right, the exclusive rights and authorities of the trademark owner may be limited by law to protect the public benefit and the consumers<sup>23</sup>.

Under the TIPC, trademarks are protected through registration. Once a trademark is registered in accordance with the rules of the TIPC in Turkey, the trademark right is granted and the applicant becomes the proprietor of trademark, who has the exclusive powers and authorities stated under Article 7 of the TIPC. The trademark proprietor may enforce the respective rights against third parties from the date of publication of registration in the Bulletin<sup>24</sup>.

Apart from that, trademarks can be protected through use as well<sup>25</sup>. Registration is not necessarily needed for protection of trademarks and grant of a trademark right to the owner. Nevertheless, as opposed to registered trademarks, unregistered trademarks are protected by the provisions of the Turkish Commercial Code No. 6012 (“TCC No. 6012”) related to unfair competition<sup>26</sup>. However, the full protection for a trademark is

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hand, in case trademarks are not considered as properties, then it is not possible to conclude trademark co-existence agreements that contradict with the public interest.

<sup>23</sup> **Gün**, p. 82; It is essential to balance the benefits of the consumers and the trademark owners; also see Article 35 of the Constitution of Turkey.

<sup>24</sup> TIPC, Article 7, para.1 & para.4.

<sup>25</sup> **WIPO**, “IP Handbook”, p. 77.

<sup>26</sup> Turkish Commercial Code No. 6012, dated 13.01.2011, published in the Official Gazette dated 14.02.2011, numbered 27846.

provided through registration and it is stronger than the one provided for unregistered trademarks<sup>27</sup>.

### C. Protection of Trademarks Through Registration

According to the “*Paris Convention for the Protection of Industrial Property*”, the contracting countries are obliged to provide a trademark registration system for the protection of trademarks<sup>28</sup>. Turkey has provided a registration system as well under which a full protection for trademarks is provided. According to Article 7/1 of the TIPC, trademark protection is subject to the registration principle<sup>29</sup>. Therefore, only the registered trademarks are protected by the provisions of the TIPC.

The registration system provided under the TIPC is territorial and domestic<sup>30</sup>. A trademark registered in Turkey is protected only in Turkey. According to the principle

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<sup>27</sup> **Çolak**, Uğur: “Türk Marka Hukuku”, Genişletilmiş ve Güncellenmiş 3. Baskı, Oniki Levha Yayınları, İstanbul, 2016, p. 379. (**Çolak**, “*Marka Hukuku*”, 2016); **Çağlar**, p. 37.

<sup>28</sup> Paris Convention for the Protection of Industrial Property, 20.03.1883, <https://wipolex.wipo.int/en/text/287556>, accessed 11.01.2020: Since May 16, 1976 the Republic of Turkey is a contracting state of the Paris Convention. (“*Paris Convention*”).

<sup>29</sup> TIPC, Article 7/1: “*Trademark protection provided by this Code shall be acquired by registration*”. Translation available at <https://www.turkpatent.gov.tr/TURKPATENT/resources/temp/4D59A7D3-A564-40A1-9C96-DB1E3D157E90.pdf;jsessionid=BDF39FA3EA1C89B51DB4D3386FC83621>, accessed on 23.01.2020.

<sup>30</sup> **Çolak**, “*Marka Hukuku*”, 2016, p. 609; **Tekinalp**, p. 384.

of territoriality, although a trademark is registered abroad, trademarks, which are not registered before the Turkish Patent and Trademark Office (“TPTO”) in Turkey cannot benefit from the protection provided under the TIPC<sup>31</sup>. However, with the development of regional and international registration platforms and enforcement of international agreements, currently it is available to protect a trademark in more than one country with a single application. The most significant example of the exception of the principle of territoriality is a special trademark protection provided across the European Union (“EU”)<sup>32</sup>.

Registration is granted upon “first-come first-served” basis. In other words, registration is granted to the earlier applicant provided that the application meets the requirements of the TIPC<sup>33</sup>. The earlier applicant becomes the proprietor of the trademark. The trademark right is not an indefinite right and it is subject to a time limit prescribed under the TIPC. Pursuant to Article 23/1 of the TIPC, trademarks will be protected for “10 years from the date of application for registration”. Without being subject to a limitation, registration may be renewed after 10 years.

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<sup>31</sup> Unless otherwise is not clearly mentioned, all references made under this work refer to the registered trademarks.

<sup>32</sup> Regulation (EU) 2017/1001 on the EU Trademark, L 154/1, 16.06.2017, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32017R1001>, accessed 11.01.2020, (“EU Trademark Regulation”); With a single application filed for the registration as a community trademark, a trademark may be protected simultaneously in 27 Member States for 10 years.

<sup>33</sup> **Tekinalp**, p. 383; **Çolak**, “Marka Hukuku” p. 95.

Before being registered by the TPTO, a sign must be in compliance with the registrability criteria and must not be contrary to the refusal grounds for registration stated under Article 4, Article 5 and Article 6 of the TIPC.

### 1. Registrability of Trademarks

The criteria for registrability of signs as trademarks are generally similar in all around the world<sup>34</sup>. Both under national trademark laws and the Paris Convention, the criteria for registrability are developed in parallel with the purposes and functions of a trademark which aim to enable the consumers to distinguish the goods or services of one enterprise from another and to eliminate the harmful and misleading impacts on public<sup>35</sup>.

In Turkey, initially, in order to be registrable as a trademark, a sign should be compatible with the definition stated under the TIPC. Under the TIPC, trademarks may consist of “*any sign including words, names, figures, colours, letters, numbers, sounds and the shape of goods or their packaging (...)*”<sup>36</sup>. The list thereunder is not an exhaustive but an illustrative list of what kind of signs can be registered. Before the enactment of the TIPC, the definition was narrower under the Abrogated Decree Law on Protection of Trademarks No. 556 (“Abrogated Decree Law No. 556”). Any signs which are capable of graphic representation, reproduction and publication through

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<sup>34</sup> WIPO, “IP Handbook”, p. 71.

<sup>35</sup> Paris Convention, Article 6quinquies A & B.

<sup>36</sup> TIPC, Article 4, Translation available at <https://www.turkpatent.gov.tr/TURKPATENT/resources/temp/4D59A7D3-A564-40A1-9C96-DB1E3D157E90.pdf;jsessionid=BDF39FA3EA1C89B51DB4D3386FC83621>, accessed on 23.01.2020.

printing were considered as trademarks<sup>37</sup>. This definition was precluding the untraditional signs, which are lack of material embodiment such as colours, motions, sounds and smells and was not letting colours and sounds to be protected as trademarks under no circumstances<sup>38</sup>. Unlike the narrower approach adopted under the Abrogated Decree Law No. 556, the TIPC adopted a broader and more flexible criteria for registrability.

According to the second part of Article 4 of the TIPC, any sign can be protected as a trademark “(...) *provided that they are capable of distinguishing the goods or services of one undertaking from those of others’ and being represented on the registry, in a manner to determine the clear and precise subject matter of the protection afforded to its proprietor*<sup>39</sup>”. In other words, under Turkish trademark law, in order to be protected as a trademark, a sign has to be distinguishable from other goods or services<sup>40</sup>. A sign, which is devoid of a distinctive character, will not be registered and benefit from the protection provided by the law<sup>41</sup>.

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<sup>37</sup> Abrogated Decree Law No. 556, Article 5.

<sup>38</sup> **Davis**, p. 206; **Çağlar**, p. 12.

<sup>39</sup> TIPC, Article 4, Translation available at <https://www.turkpatent.gov.tr/TURKPATENT/resources/temp/4D59A7D3-A564-40A1-9C96-DB1E3D157E90.pdf;jsessionid=BDF39FA3EA1C89B51DB4D3386FC83621>, accessed on 23.01.2020.

<sup>40</sup> *ibid.*

<sup>41</sup> TIPC, Article 5/1(b): “ (1) *The following signs set out below shall not be registered as trademark (...) b) Signs which are devoid of any distinctive character (...)*”.

Translation available at <https://www.turkpatent.gov.tr/TURKPATENT/resources/temp/4D59A7D3-A564-40A1->

Representability on registry is also an important element of registrability. With the TIPC, untraditional signs, which are lack of material embodiment, have been permissible to be considered as trademarks as long as they are distinctive and representable on the registry. Within this respect, the constituent elements of a trademark can be listed as distinctiveness and capability of being represented on the registry<sup>42</sup>. Consequently, as long as a sign meets the requirements stated under Article 4 of the TIPC and does not fall within the scope of Articles 5 and 6 in relation to the refusal grounds for registration, it can be registered.

## 2. Grounds for Refusal of Registration

In order to be registrable and protectable by the TIPC, a sign must not be contrary to the refusal grounds for registration mentioned under the TIPC as well. The grounds for refusal of registration under the TIPC are grouped as absolute grounds and relative grounds. Under the TIPC, a trademark is registrable as long as it is permissible under Article 4 of the TIPC and does not embody a circumstance, which would trigger any of the refusal grounds of registration set forth under Article 5 and Article 6 of the TIPC.

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[9C96-DB1E3D157E90.pdf;jsessionid=BDF39FA3EA1C89B51DB4D3386FC83621](https://www.who.int/publications/m/item/9C96-DB1E3D157E90.pdf?jsessionid=BDF39FA3EA1C89B51DB4D3386FC83621),

accessed on 23.01.2020.

<sup>42</sup> **Tekinalp**, p. 360; Some authors also include “the sign” as the third element, see **Oğuz**, S., p.18; “under the UK trademark law Art.2 of the UK Trademark Act 1994 requires three elements (...) (i) the sign, (ii) the capability of being represented graphically and (iii) capability of distinguishing goods or services of one undertaking from those of other undertakings”, see: **Kitchen & Llewelyn & Mellor & Maeda & Moody-Stuart & Keeling**, p. 12.

### a. Absolute Grounds for Refusal of Registration

Absolute grounds for refusal of registration have been set out under Article 5 of the TIPC. Those grounds are considered by the TPTO *ex officio*, without requiring an objection from a related third party at the registration stage. The absolute grounds for refusal indicates grounds that are intrinsic to the nature of the mark itself, instead of the rights of individual third parties<sup>43</sup>. In other words, signs that fall within the scope of absolute grounds are blocked for any person because of their nature and characteristics, not simply because of prevailing rights of third persons over them<sup>44</sup>.

The absolute grounds are in relation to the public interest<sup>45</sup>. This is because of the fact that such marks may mislead the consumers and hamper their capability to distinguish a good or service from another. With this respect, those grounds make a particular mark impermissible for registration.

In case of the presence of an absolute refusal ground, the TPTO will reject a trademark application *ex officio*. The absolute grounds for refusal or registration are

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<sup>43</sup> **Bently L. & Sherman B.**, “Intellectual Property Law”, Oxford, 4th ed., 2014, p. 928; **Davis**, p. 208.

<sup>44</sup> **Karahan, Sami & Suluk, Cahit & Saraç, Tahir & Nal**, Temel: “Fikri Mülkiyet Hukukunun Esasları”, Seçkin Yayınları, Ankara, 2011, p. 163; Yargıtay 11. HD., E: 5790, K: 5790, dated 29.04.1999.

<sup>45</sup> **Bently & Sherman**, p. 928; Sat. 1 Satellitenfernsehen GmbH v. OHIM, Case C-329/02 (2004) ECR I-8317, para. 25.



conclusive and cannot be further expanded by the TPTO<sup>46</sup>. In other words, the TPTO is bound with those pre-determined grounds and cannot reject a trademark registration application based on a different ground other than those stated under Article 5. In a case, where the TPTO omits to reject an application that falls within the ambit of the absolute grounds and that mark has been registered unlawfully, any person may initiate proceedings for the invalidation of the trademark at anytime<sup>47</sup>. As per Article 17/1 of the TIPC, examination by the TPTO with respect to the absolute grounds for refusal of registration is conducted after an examination with respect to the form of application.

In general, the absolute grounds for refusal cannot be overcome with any exceptions such as the demonstration of the given consent of the registered right holder<sup>48</sup>. However, there is an exception to this principle under the TIPC for absolute ground for refusal dealt under Article 5/1(ç), which will be discussed below in detail.

#### **b. Relative Grounds for Refusal of Registration**

There are also relative grounds for refusal of registration, which are set out under Article 6 of the TIPC. Those grounds are referred as “relative” since they are

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<sup>46</sup> **Oğuz**, Selenay, “Marka Hukukunda Birlikte Var Olma Sözleşmesi”, Grafiker Yayınları, Ankara, 2019, p.24; **Karahan**, “ Marka Hukukunda Hükümsüzlük Davaları”, Mimoza Yayıncılık, Konya, 2002, p. 14.

<sup>47</sup> See: **Tekinalp**, p. 400; The *ex officio* examination is one of the duties of the TPTO, thus the TPTO must examine the trademark application. In line with this duty it may be said that the TPTO has a neglect of duty, in case TPTO fails to examine and register a trademark despite the fact that it is contrary to Article 5.

<sup>48</sup> **Bently & Sherman**, p. 928.

related to a conflict with an earlier trademark or right<sup>49</sup>. The relative grounds are parallel with the infringement proceedings under the TIPC<sup>50</sup>. Essentially, relative grounds for refusal of registration cover the circumstances in which a later sign conflicts with an earlier trademark. Such grounds are not as impermissible as the ones dealt under absolute grounds. Thus, these are not considered in relation to the public interest<sup>51</sup>.

The TPTO does not have an *ex officio* authority to refuse a trademark application based on relative refusal grounds. The TPTO will refuse a trademark application upon the opposition of a third party based on any relative grounds for refusal of registration stated under Article 6. If there is no opposition, the trademark will be registered by the TPTO. There are nine relative grounds under the TIPC and most of them cover the situations in which a later trademark conflicts with an earlier trademark due to the level of similarity between earlier and later trademark and the likelihood of confusion created.

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<sup>49</sup> **Çağlar**, p. 65; **Davis**, p. 217.

<sup>50</sup> **Çolak**, “Marka Hukuku”, 2016, p. 204.

<sup>51</sup> *ibid.*, p. 129: There is no need for an *ex officio* refusal by the TPTO. Nevertheless, in some jurisdictions, relative grounds for refusal of registration is subject to an *ex officio* examination e.g. Poland, Greece, Finland etc.

## II. Principle of Specialty of Trademark and the Existence of an Identical or Similar Earlier Trademark as a Ground for Refusal of Registration

### A. The Principle of Specialty of Trademark

Registration of trademarks are, *inter alia*, subject to the principle of specialty of trademark<sup>52</sup>. According to this principle, “*the existence of identical or similar trademarks on identical or similar goods or services*” is not allowed<sup>53</sup>. In other words, a trademark has to be sole and unique in the relevant good or service class that it is preferred to be used. Thus, two different proprietors cannot own identical or similar trademarks separately and simultaneously<sup>54</sup>. One must bear in mind that, this should not be confused with the share of ownership of a single registered trademark. A trademark ownership can be shared among more than one person and in such a case there is a single ownership of a trademark, which is shared by more than one person<sup>55</sup>. The principle of specialty does not let more than one ownership or concurrent registrations

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<sup>52</sup> “The Principle of Specialty of Trademark” refers to “*Markanın Tekliği İlkesi*” in Turkish trademark law and it is also translated as “The Principle of Uniqueness” by some authors e.g. **Arkan**, “SMK’nın 5.3. Maddesi, p.1”; also see **Tekinalp**, p. 384: “*Protection of trademarks is also subject to the principle of the real ownership and the principle of priority.*”; **Eminoğlu**, Cafer: “Marka Sahibinin Tekliği İlkesi ve Bu İlkenin Markanın Devri Bağlamında İncelenmesi (Anayasa Mahkemesi’nin 556 Sayılı KHK’nın m.16/5 Hükümünü İptal Eden Kararı Bağlamında Bir Değerlendirme), Yıldırım Beyazıt Hukuk Dergisi, 2016/1, Ankara, Ocak 2016, p. 233.

<sup>53</sup> **Gün**, p. 37.

<sup>54</sup> **Çolak**, “Marka Hukuku”, 2016, p. 373; **Tekinalp**, p. 381; **Eminoğlu**, p. 233; **Arkan**, Sabih, “Marka Hukuku”, C.1, Ankara 1997, p. 76. (**Arkan**, “*Marka Hukuku*”).

<sup>55</sup> **Gün**, p. 48.

in relation to “identical or similar trademarks”. In line with this principle, a sign, which is “identical or similar to an earlier trademark”, cannot be used or registered concurrently “on identical or similar goods or services”<sup>56</sup>.

As mentioned earlier during the discussion about the legal nature of trademarks, a trademark is defined as an intangible asset, which does not have a physical presence. Due to its intangible nature, a trademark may be possessed and used by more than one person. However, such possession or use might contradict with the purpose of trademarks, which is to distinguish the goods or services presented under a trademark from other “identical or similar goods or services”. Otherwise, the consumers may mistakenly purchase a different good or service due to the misconfusion created with concurrent trademarks. Obviously, such a case would hamper the capability of consumers to distinguish<sup>57</sup>. In order to solve this problem, it is accepted under trademark law that a trademark grants exclusive rights solely to its proprietor and prevent others to use or concurrently register it<sup>58</sup>.

Although it is not clearly stated under the TIPC, the principle of specialty of trademark is accepted under Turkish trademark law and confirmed with number of decisions of *Yargıtay*<sup>59</sup> (i.e. Supreme Court of Appeals in Turkey)<sup>60</sup>. To illustrate, in

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<sup>56</sup> **Eminoğlu**, p. 231.

<sup>57</sup> **Arkan**, Sabih: “Sınai Mülkiyet Kanunu’nun 5.3. Maddesiyle İlgili Bazı Düşünceler, 33 Banka Hukuku Dergisi, 2017, p. 6. (**Arkan**, “SMK’nın 5.3. Maddesi”); **Gün**, p. 48.

<sup>58</sup> **Tekinalp**, p. 381; **Çağlar**, p. 35; **Çolak**, “Marka Hukuku”, p. 378; **Kaya**, p. 40.

<sup>59</sup> *Yargıtay* is the Supreme Court of Appeals in Turkey which is the last instance to review the verdicts given by criminal or civil justice courts on criminal and civil cases. (Hereinafter referred as “*Yargıtay*”). 11th Civil Chamber of *Yargıtay* (*Yargıtay 11.HD.*)

2006, *Yargıtay* accepted the specialty of trademark, along with the principle of priority and said it is not possible to make concurrent registrations<sup>61</sup>. The principle of specialty of trademark goes hand in hand with the principle of priority, which protects the trademark holder who has registered or applied for registration before anyone else<sup>62</sup>. A sign, which has been registered or been subject to a registration application, will not be registered for “identical or similar goods or services” later. An earlier registration prevents later registrations of identical or similar trademarks. The TIPC also recognizes the principle of specialty of trademark by envisaging the existence of an identical or similar earlier trademark, both as an absolute and a relative ground for refusal<sup>63</sup>. In light of this the TPTO may refuse an application *ex officio* or the earlier trademark proprietor may enforce his/her exclusive rights and prevent third persons to register an identical or similar trademark.

Despite the acknowledgement of the principle of specialty under Turkish trademark law, *Yargıtay* also ruled that there may be written opt-outs in relation to the

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reviews the verdicts of the specialised court for intellectual and industrial property rights.

<sup>60</sup> **Çolak**, “Marka Hukuku”, 2016, p. 373; *Yargıtay* 11. HD. 1999/7608 E., 1999/7608 K., dated 07.10.1999; *Yargıtay* 11. HD., 2005/1359 E., 2002/3136 K. dated 02.03.2006; *Yargıtay* Hukuk Genel Kurulu, 2003/11-578 E., 2003/703 K., dated 19.11.2003.

<sup>61</sup> *Yargıtay* 11. HD., 2005/1359 E. 2002/3136 K. dated 02.03.2006.

<sup>62</sup> **Oğuz**, Arzu & **Özkan**, Zehra: “*Yargıtay* Kararları Işığında Sınai Mülkiyet Kanunu’nun 5/1-ç Maddesi Anlamında Ayırt Edilemeyecek Kadar Benzer İşaretler”, *Terazi Hukuk Dergisi*, C: 13, S: 141, 2018, p. 41; **Eminoğlu**, p. 236; **Çağlar**, p. 47; **Tekinalp**, p. 383.

<sup>63</sup> **Tekinalp**, p. 383.

principle of specialty of trademark<sup>64</sup>. The exception to the principle of specialty could be referred as “*the co-existence of identical or similar trademarks on identical or similar goods or services*”<sup>65</sup>. Before the enactment of the TIPC, there were some cases in which identical or similar trademarks co-exist despite the principle of specialty of trademark due to forfeiture and lapse of time given under the law<sup>66</sup>. However, it was not possible to voluntarily co-register identical or similar trademarks on identical goods or services. The TIPC has opened a new chapter and introduced letters of consent to prevent an *ex officio* refusal by the TPTO based on the absolute refusal ground dealt under Article 5/1(ç)<sup>67</sup>.

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<sup>64</sup> Yargıtay 11. HD., 1999/1724 E., 1999/7608 K., dated 07.10.1999 “...*except for the written exceptions, a trademark cannot be owned by two persons...*”.

<sup>65</sup> **Yıldız**, Burçak: “Mükerrer Markanın Seri Markasının Tescili – SMK m.5.1.c ve m. 6.1 Hükümlerine Yargı Kararlarıyla Getirilen İstisna, Banka ve Ticaret Hukuku Dergisi 34-4, 2018, 93-122, p. 98.

<sup>66</sup> *See below, Chapter Two, I:* In addition to that it was possible to enable the co-existence of trademarks through an agreement between parties under which the earlier trademark proprietor agrees not to oppose to the registration of identical or similar trademarks.

<sup>67</sup> **Mumcuoğlu**, Hande: “A New Chapter of IP in Turkey: Green Light for Trademark Owners to Co-Exist”, <https://iprgezgini.org/2016/06/13/a-new-chapter-of-ip-in-turkey-green-light-for-trademark-owners-to-co-exist/>, published on 13.06.2016, accessed on 09.02. 2020.

With this novelty introduced by the TIPC, some authors argued that the principle of specialty of trademark is not present anymore under the Turkish trademark law<sup>68</sup>. On the other hand, as *Yargıtay* mentioned earlier, the co-existence of trademarks should be considered as an exception to the principle of specialty of trademark<sup>69</sup>. The principle of specialty of trademark is still present under Turkish trademark as it can be demonstrated with Article 5/1(ç) and Article 6/1 of the TIPC since both provisions envisage refusal grounds in relation to the existence of identical or similar trademarks. Especially, Article 5/1(ç) is an eminent reflection of the principle of speciality of trademark since in principle it does not let the registration of “*identical or indistinguishably similar trademarks on identical or similar goods or services*” and regards such circumstance as an absolute ground for refusal. Nevertheless, now the law envisages an exception to this rule and enables the co-existence of “*identical or indistinguishably similar trademarks*” through letters of consent issued by the earlier trademark proprietors. This exception is inline with the above-mentioned approach of *Yargıtay*.

#### **B. Existence of an “Identical or Similar Earlier Trademark” as a Ground for Refusal of Registration**

Under Turkish trademark law, depending on the extent of similarity and likelihood of confusion between trademarks, existence of an earlier identical or similar registered prior trademark may either be considered as an absolute refusal ground under Article 5/1(ç) of the TIPC or a relative refusal ground under Article 6/1 of the TIPC. Both provisions reflect the principle of speciality of trademark yet, Article 5/1(ç) may be considered as a stricter reflection due to its absolute nature. Before, going deep into

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<sup>68</sup> **Suluk**, Cahit & **Karasu**, Rauf & **Nal**, Temel, “Fikri Mülkiyet Hukuku”, 2. Baskı, Ankara, 2018, p. 178. **Arkan**, “SMK’nın 5.3. Maddesi”, p. 6.

<sup>69</sup> *See above, supranote no. 64.*

the analysis of the co-existence exception provided in terms of Article 5/1(ç), it is necessary to discuss the differences between said grounds for refusal (Article 5/1(ç) and Article 6/1).

### **1. Article 5/1(ç) of the TIPC: “Existence of an Identical or Indistinguishably Similar Earlier Trademark” as an Absolute Refusal Ground**

The absolute refusal ground dealt under Article 5/1(ç) varies from other absolute grounds due its scope and purpose. As mentioned earlier, in general the absolute grounds outline the circumstances intrinsic to the nature of the trademark such as “*being devoid of distinctive character*” or “*deceiving the public*”<sup>70</sup>. However, as opposed to the other grounds stated under Article 5 of the TIPC, Article 5/1(ç) envisages a refusal ground in relation to the existence of an earlier registered trademark, which is not intrinsic to the nature of the later mark itself<sup>71</sup>. Under Article 5/1(ç), earlier trademark applications and registrations are protected unconditionally against later registration applications in relation to “*identical or indistinguishably similar signs on*

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<sup>70</sup> See TIPC, Article 5/1.

<sup>71</sup> TIPC, Article 5/1 (ç): “*The following signs set out below shall not be registered as trademark: (...) Signs which are identical to or indistinguishably similar to a trademark, which has been registered or which has been applied for registration, relating to identical goods and services or to goods and services for the identical type (...)*”.

Translation available at <https://www.turkpatent.gov.tr/TURKPATENT/resources/temp/4D59A7D3-A564-40A1-9C96-DB1E3D157E90.pdf;jsessionid=BDF39FA3EA1C89B51DB4D3386FC83621>, accessed on 23.01.2020.



*identical or similar goods or services*”. There is no need to demonstrate any likelihood of confusion for Article 5/1(ç) to come into play<sup>72</sup>.

Basically, Article 5/1(ç) of the TIPC outlines the impact of a prior registered trademark over later trademark applications in relation to “*identical or indistinguishably similar trademarks on identical or similar goods or services*”. According to this provision, such later trademark registration applications will be refused *ex officio* by the TPTO in case there is an “*identical or indistinguishably similar sign which has already been registered or been subject to a registration application on identical or similar goods or services*”. This provision protects the earlier trademark proprietors’ rights who registered their trademarks before anyone else<sup>73</sup>. Such ground is also referred as “double-identity of trademarks”<sup>74</sup>.

In order for Article 5/1(ç) to be applicable four conditions must be satisfied<sup>75</sup>:

- i) the earlier registered sign and the later sign must be “*identical or indistinguishably similar*” to each other (there is no obligation to demonstrate the likelihood of confusion);
- ii) both signs must be in relation to “*identical or similar goods or services*”<sup>76</sup>;
- iii) a priority-seniority relationship among the signs must be present;

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<sup>72</sup> **Bently & Sherman**, p. 975; **Oğuz, A & Özkan**, p. 42.

<sup>73</sup> **Bozbel**, Savaş: “Gerekçeli Sınai Mülkiyet Kanunu”, <https://bozbel.files.wordpress.com/2018/05/gerekc3a7eli-sc4b1nai-mc3bclkiyet-kanunu.pdf>, accessed on 16.11.2019, p. 13.

<sup>74</sup> **Bently & Sherman**, p. 975.

<sup>75</sup> **Eminoğlu**, p. 235; **Karahan & Suluk & Saraç & Nal**, p. 164.

<sup>76</sup> See: **Karahan & Suluk & Saraç & Nal**, p. 164; **Oğuz, A & Özkan**, p. 42-43.

- iv) there must not be an exception that enables the registration of “*identical or indistinguishably similar signs on identical or similar goods or services*”.

Before the TIPC, such ground was referred as an absolute ground under Article 7/1(b) of the Decree No. 556. Pursuant to Article 7/1(b), “*signs that are identical or indistinguishably similar to a trademark, which has been registered or has been subject to an application for registration on identical or similar goods or services*” will not be registered as trademarks. The wording of Article 7/1(b) has been preserved under Article 5/1(ç) of the TIPC.

The Constitutional Court of Turkey explained the rationale behind Article 7/1(b) of the Abrogated Decree Law No.556 as protecting the essential functions of trademarks which are to be distinctive and preserve the quality of goods and services, specialty of trademark, ownership right of earlier trademark owner and expectations of consumers<sup>77</sup>. In this regard, such ground is seen in relation to “public interest” and that is why it is considered as an absolute ground in the first place<sup>78</sup>.

Since such provision is an absolute ground, assessment of similarity between trademarks is conducted *ex officio* by the TPTO. It is the duty of the TPTO to assess the similarity between trademarks and refuse the later trademark if it is “*identical or indistinguishably similar to an earlier registered trademark on identical or similar*

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<sup>77</sup>Anayasa Mahkemesi Genel Kurulu, 2015/118 s. Karar, 23.12.2015, [www.kararlaryeni.anayasa.gov.tr](http://www.kararlaryeni.anayasa.gov.tr) › Uploads › 2015-118, accessed 17.12.2019.

<sup>78</sup> **Mumcuoğlu**, <https://iprgezgini.org/2016/06/13/a-new-chapter-of-ip-in-turkey-green-light-for-trademark-owners-to-co-exist/>, accessed on 09.02.2020.

*goods or services*”. In this regard, if the TPTO does not refuse the relevant trademark, related persons may still initiate invalidation proceedings against it<sup>79</sup>.

Although Article 5/1(ç) is regarded as an absolute ground, it would not be wrong to say that it has been approximated to a relative ground, when Article 17/1 of the TIPC is considered<sup>80</sup>. Under Article 17/1, third parties cannot submit observations with respect to Article 5/1(ç) as opposed to other absolute grounds<sup>81</sup>. Hence, Article 5/1(ç) is clearly set apart from other absolute grounds. In addition to that, unlike the other absolute grounds, Article 5/1(ç) is subject to an exception. Article 5/3 of the TIPC envisages an exception to Article 5/1(ç) and enables the co-existence of “*identical or indistinguishably similar marks on identical or similar goods or services*”. In principle, Article 5/1(ç) of the TIPC does not let the registration of “*identical or indistinguishably similar marks*” to be made as mentioned above. However, due to the need of market within this respect, an exception to Article 5/1(ç) and the principle of specialty of

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<sup>79</sup> **Karahan & Suluk & Saraç & Nal**, p. 164.

<sup>80</sup> **Gün**, p. 44.

<sup>81</sup> TIPC, Article 17/1: “*After the publication of the trademark application, everyone may submit to the Office their observations with grounds and in writing that the trademark application should not be registered within the scope of the subparagraphs of the Article 5, with the exception of subparagraph (ç), until the registration of the trademark. However, these persons may not be party to the proceedings before the Office.*”, Translation available at: <https://www.turkpatent.gov.tr/TURKPATENT/resources/temp/4D59A7D3-A564-40A1-9C96-DB1E3D157E90.pdf;jsessionid=BDF39FA3EA1C89B51DB4D3386FC83621>, accessed on 23.01.2020.

trademark is provided with the TIPC under Article 5/3, which will be dealt in detail below.

## **2. Article 6/1 of the TIPC: “Existence of an Identical or Similar Trademark” as a Relative Refusal Ground**

Article 5/1(ç) of the TIPC is not the only provision with respect to the existence of an earlier “identical or similar trademark on identical or similar goods or services”. Such circumstance is also mentioned as a relative ground for refusal of registration under Article 6 of the TIPC.

Before the enactment of the TIPC, “*existence of identical or similar trademarks on identical or similar goods or services*” was dealt under Article 8/1(a) and Article 8/1(b) of the Abrogated Decree No. 556 as relative grounds. With the TIPC, these provisions have been merged under Article 6/1 and re-drafted as to cover both circumstances stated under Article 8/1(a) and 8/1(b) of the Abrogated Decree No.556.

As per Article 6/1 of the TIPC, “*an application for trademark registration shall be refused upon opposition, if there is a likelihood of confusion on the part of the public*”<sup>82</sup>. Under the TIPC, such likelihood of confusion involves “*the likelihood of association with an earlier trademark due to [identicalness] with or similarity to both of the earlier trademark and of the goods and services covered*”<sup>83</sup>.

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<sup>82</sup> TIPC, Article 6/1, Translation available at <https://www.turkpatent.gov.tr/TURKPATENT/resources/temp/4D59A7D3-A564-40A1-9C96-DB1E3D157E90.pdf;jsessionid=BDF39FA3EA1C89B51DB4D3386FC83621>, accessed 23.01.2020.

<sup>83</sup> TIPC, Article 6/1, second sentence: This is a new addition under the TIPC.

This provision essentially relies upon the existence of likelihood of confusion. Likelihood of confusion can be defined as likelihood of confusion of the public as regards the origin of the mark<sup>84</sup>. With the addition of the “including a likelihood of association” in Article 6/1 under the TIPC, the trademark protection has been extended beyond protecting the trademark’s function as an indicator of origin. The provision also aims to protect the commercial value and reputation of the trademark against any dilution that may be caused by an association with another mark, even the public was not confused as regards the origin<sup>85</sup>. In light of these, in the presence of a likelihood of confusion, Article 6/1 of the TIPC would also come into play upon opposition of a related person.

### **3. Evaluation of Article 5/1(ç) and Article 6/1 of the TIPC and the Notions of “Identicalness” and “Indistinguishable Similarity”**

In light of these two provisions under the TIPC, it could be said that, either the TPTO may enforce its *ex officio* examination authority and refuse identical or indistinguishably similar trademarks based on the absolute refusal ground or a third person may oppose to the registration of a mark for the same reason under Article 6(1) of the TIPC. Although at first glance the scope of both provisions seems indifferent, Article 5/1(ç)’s scope is different and narrower than Article 6/1.

Both Article 5/1(ç) and Article 6(1) of the TIPC focus on the distinctiveness function of trademarks and rely upon the principle of specialty of trademark<sup>86</sup>. Both

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<sup>84</sup> **Tekinalp**, p. 435; **Çolak**, “Marka Hukuku”, 2016, p. 207; **Davis**, p. 219; **Çağlar**, p. 67.

<sup>85</sup> **Davis**, p. 219.

<sup>86</sup> **Gün**, p. 42.

provisions aim to prevent registration of “identical or similar trademarks on identical or similar goods or services” and protect the specialty of trademark. However, the similarity of both provisions at first glance has created an ambiguity in terms of the scope of application of both provisions, since the Abrogated Decree Law No. 556.

Essentially, the ground covered under Article 5/1(ç) does not refer to a circumstance intrinsic to the nature of the sign itself. The absolute refusal grounds normally cover circumstances that are intrinsic to the nature of the sign. The relative grounds of refusal of registration under Article 6, on the other hand, are based on the possible conflicts with earlier trademarks. Although, as to its scope and purpose Article 5/1(ç) has a nature close to a relative refusal ground for registration, it is regulated as an absolute refusal ground of registration under the TIPC<sup>87</sup>. The reason for this division might be the fact that in the presence of identicalness or indistinguishable similarity, the consumers may not be able to distinguish one good or service from another. In this sense, the purpose for this regulation is protecting public from the risk of confusion while protecting the rights of the earlier registered proprietors<sup>88</sup>.

In order to clarify the scope of both provisions, *Yargıtay* ruled that, unlike the relative grounds (Article 8/1(a) and Article 8/1(b) under the Abrogated Decree Law No.556 - Article 6/1 of the TIPC), absolute ground for refusal (Article 7/1(b) Abrogated Decree Law No.556 - Article 5/1(ç) of the TIPC) requires at least “indistinguishable similarity” between earlier trademark and the later sign and does not require “likelihood

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<sup>87</sup> **Arkan**, “SMK’nin 5.3. Maddesi”, p. 10.

<sup>88</sup> **Bozbel**, p. 13.

of confusion by the public”<sup>89</sup>. With respect to this, TPTO can enforce its *ex officio* refusal authority, as long as there is “*identicalness or indistinguishable similarity of trademarks on identical or similar goods or services*”. “*Identicalness*” has a clear meaning and it refers to the sameness of signs without any differences<sup>90</sup>. Nevertheless, the “*indistinguishable similarity*” notion is not easy to identify and open to the interpretation of the courts and doctrine<sup>91</sup>. In order to provide a clarification, the General Assembly of *Yargıtay* identified the notion of “*indistinguishable similarity*” in terms of trademark law. In 2012, the General Assembly of *Yargıtay* stated that, if the differences among two signs are insignificantly little according to the overall impression of the average consumer on the goods or services that the trademark covers, there is an “*indistinguishable similarity*” and in such a case, even there is not an opposition, the TPTO will consider such similarity *ex officio* and refuse the trademark application<sup>92</sup>. According to *Yargıtay*, the similarity needs to be obvious and significant to the extent that there is no need to analyse the likelihood of confusion that such similarity might create<sup>93</sup>. Similar approach has been adopted under the EU law as well for the

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<sup>89</sup> Yargıtay 11. HD., 2009/13322 E. , 2011/14579 K. dated 23.10.2011: The wording of old provisions of the Abrogated Decree Law No.556 remained identical under Article 5/1(ç) and Article 6(1) of the TIPC, the decision of *Yargıtay* is still considerable.

<sup>90</sup> **Oğuz, A. & Özkan**, p. 41; **Çağlar**, p. 48.

<sup>91</sup> **Karahan**, p. 43; **Oğuz, A. & Özkan**, p. 41; **Çağlar**, p. 48.

<sup>92</sup> Yargıtay Hukuk Genel Kurulu, 2012/11-154 E., 2012/659 K., dated 05.10.2012.

<sup>93</sup> *ibid.*; Yargıtay 11. HD., 2009/13222 E., 2011/14579 K., dated 27.10.2011; Yargıtay 11. HD., 2012/2797 E., 2012/4986 K., dated 30.03.2012; Yargıtay 11. HD. 2010/8474 E., 2012/9165 K., dated 29.5.2012.

determination of “*indistinguishable similarity*”<sup>94</sup>. The most important benchmark for such determination is the classification of the goods or services that relevant trademarks are attached to<sup>95</sup>.

The TIPC aims to harmonize the Turkish trademark law with the EU trademark law. In this regard, the grounds for refusal of registration under the TIPC reflect the ones under the EU Trademark Directive No. 2015/2436<sup>96</sup>. However under the EU law, unlike Turkish trademark law “*existence of an identical or indistinguishably similar trademark*” falls within the ambit of relative refusal grounds and not regarded as an absolute ground<sup>97</sup>. Turkish trademark law adopts a stricter approach than the one in the EU and authorizes the TPTO to refuse later trademark application based on Article 5/1(ç), without requiring an opposition by relevant persons. Although Article 5/1(ç) is regarded as an absolute refusal ground under the TIPC, it is differentiated from other

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<sup>94</sup> See: **Hildebrandt**, Ulrich: “Harmonised Trade Mark Law in Europe: Case Law of the European Court of Justice”, Carl Heymanns Verlag, 2nd ed., Munich, 2008, p. 104-106.

<sup>95</sup> **Oğuz**, A. & **Özkan**, p. 41; **Paslı**, Ali, “Marka Hukukunda Ürün Benzerliği”, Vedat Kitapçılık, İstanbul, 2018, p. 50-52.

<sup>96</sup> **Bozbel**, p. 15.

<sup>97</sup> See Article 5/1: Directive (EU) 2015/2436 to approximate the laws of the Member States relating to trademarks, L 336/I 16.12.2015, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32015L2436>, accessed on 11.01.2020. (Hereinafter referred as “EU Trademark Directive”)



absolute grounds and approximated to relative refusal grounds<sup>98</sup>. Number of scholars criticize the ambiguity created under the Turkish law with respect to Article 5/1(ç)<sup>99</sup>.

In addition to the above-mentioned, it could also be said that the principle of specialty of trademark accepted under Article 5/1(ç) of the TIPC has been softened upon the enactment of the TIPC. As mentioned earlier, *Yargıtay* had ruled that there might be exceptions to the principle of specialty of trademark<sup>100</sup>. An exception provided with Article 5/3 of the TIPC, which provides the opportunity for co-existence of “*identical or indistinguishably similar trademarks on identical or similar goods or services*” through letters of consent issued by the earlier proprietor of trademark, despite the principle of specialty of trademark.

### **III. The Co-Existence Exception: Co-Existence of Identical or Similar Trademarks on Identical or Similar Goods or Services**

#### **A. Co-Existence of Trademarks in General**

In principle, the law does not let the existence of “*identical or similar trademarks on identical or similar goods or services*” simultaneously, in light of the principle of specialty of trademark. The co-existence of identical or similar trademarks contradicts with the principle of specialty of trademark, since the principle is based on the idea of “*non-co-existence of identical or similar trademarks*”. As mentioned earlier, the grounds for refusal of registration are designed with respect to the principle of specialty of

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<sup>98</sup> **Gün**, p. 44.

<sup>99</sup> See: **Arkan**, “SMK’nın 5.3. Maddesi”, p. 5-11; **Oğuz, A & Özkan**, p. 42; **Tekinalp**, p. 374; also *See below, Chapter Three, II*.

<sup>100</sup> *See above, supranote no. 64.*

trademark under the TIPC<sup>101</sup>. However, lately, such principle has been softened and the voluntary co-existence of identical or similar trademarks has been enabled under certain circumstances in Turkey<sup>102</sup>.

Co-existence of trademarks is described as a situation “...in which two different enterprises use a similar or identical trademark to market a product or service without necessarily interfering with each other’s businesses”<sup>103</sup>. It means the simultaneous and peaceful registration and/or use of identical or similar trademarks by different enterprises in identical or similar markets<sup>104</sup>.

Co-existence of trademarks has been a necessary concept due to the need of commercial world within the last decade. Especially, with the introduction of the EU Trademark, businesses, which operate under “identical or similar trademarks on identical or similar goods or services” in different local markets, has started to interfere in each other’s market<sup>105</sup>. A high potential for conflicts and disagreements has emerged

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<sup>101</sup> **Gün**, p. 50.

<sup>102</sup> See below, Chapter Three, I for the consent exception that enables the co-existence of identical or similar trademarks.

<sup>103</sup> **Nanayakkara**, Tamara: “IP and Business: Trademark Coexistence”, WIPO Magazine, Issue 6/2006, [http://www.wipo.int/wipo\\_magazine/en/2006/06/article\\_0007.html](http://www.wipo.int/wipo_magazine/en/2006/06/article_0007.html), November 2006, accessed on 09.02.2020.

<sup>104</sup> **Gün**, p. 51.

<sup>105</sup> **Thomsen**, Carin: “Trademark Co-Existence Agreements in the Perspective of EU Competition Law”, Master Thesis, University of Gothenburg, School of Business, Economics and Law, 2012, p. 28.

due to overlapping signs and overcrowding registries<sup>106</sup>. To solve such possible conflicts and eliminate oppositions, co-existence of trademarks has been an attractive option for the trademark holders, especially in the EU<sup>107</sup>.

In addition to that, in the context of commercial acquisition, parties started seek for a trademark co-existence arrangement as well<sup>108</sup>. To illustrate it with a scenario, a business (the seller) wants to sell one of its subsidiaries and the right to use of trademark. However, the seller still wants to use that trademark on “identical or similar goods or services”. In order to achieve this purpose parties need a way to co-exist and operate under identical or similar trademarks peacefully<sup>109</sup>.

In this regard, a system that enables the voluntary trademark co-existence has started to evolve in number of jurisdictions, including but not limited to the EU and Turkey in order to solve conflicts, prevent further possible infringements and expensive and long litigation process.

Essentially, the co-existence of trademarks is not a new concept under the trademark law. Under certain circumstances, identical or similar trademarks can co-exist

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<sup>106</sup> **Elsmore**, J. Matthew: “Trademark Co-Existence Agreements: What is all the (lack of) fuss about?”, *SCRIPTed: A Journal of Law, technology and Society* 5, no.1, April 2008, p. 11 (*Elsmore*, “*Trademark Co-Existence Agreements*”); **Oğuz**, S., p.44.

<sup>107</sup> **Elsmore**, p. 7; **Oğuz**, S., p. 147.

<sup>108</sup> **Thomsen**, p. 29.

<sup>109</sup> *ibid.*; See **Smith**, Joel & **Compton**, Megan: “ Trademark Co-Existence Agreements – Practicalities and Pitfalls”, *World Trademark Review*, November 2008, <https://www.worldtrademarkreview.com/brand-management/trademark-coexistence-agreements-practicalities-and-pitfalls>, accessed on 15.12.2019. p. 37.

on identical or similar goods or services through non-voluntary arrangements, namely the rules of the law or the court decisions as well<sup>110</sup>. What has been newly introduced in trademark law is the voluntary co-existence of trademarks, which has been enabled through private agreements between two or more trademark holders or unilateral letters of consent issued by the earlier trademark proprietor.

A voluntary co-existence mechanism has initially been evolved through private agreements in order to protect the parties from the threat of trademark infringement proceedings and enable the peaceful co-existence of identical or similar trademarks. Under such agreements parties agree on “the co-existence of identical or similar trademarks on identical or similar goods or services”<sup>111</sup>. Such agreements are generally identified as trademark co-existence agreements, but they are also referred as consent agreements, consent to use agreements, mutual consent to use agreements, delimitation agreements or prior right agreements<sup>112</sup>. A general definition for a trademark co-existence agreement has been made by the International Trademark Association as “*an agreement by two or more persons that similar marks can co-exist without any likelihood of confusion; allows the parties to set rules by which the marks can peacefully co-exist*”<sup>113</sup>. Under trademark co-existence agreements parties may also

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<sup>110</sup> See below, Chapter Two, I for the non-voluntary co-existence of trademarks in Turkey.

<sup>111</sup> Çolak, “Marka Hukuku”, 2016, p. 291; Kılıç, p. 88.

<sup>112</sup> Under this work, “*Trademark Co-Existence Agreements*” will be used to identify all agreements that are in relation to the co-existence of identical or similar trademarks.

<sup>113</sup> International Trademark Association (“INTA”), “Glossary”, available at <https://www.inta.org/TrademarkBasics/Pages/glossary.aspx>, accessed 23.11.2019.

stipulate to what extent and under what conditions, each trademark can be used by its proprietor.

One of the first trademark co-existence agreements was concluded between the Apple Corps., a corporation owned by the members of the Beatles and the Apple Computer back in 1981<sup>114</sup>. Under this agreement, parties set forth terms and conditions in relation to the use and registration of their Apple sign. Although, in general, the trademark co-existence agreements were not identified under the laws, they are started to be regarded enforceable<sup>115</sup>. Under *Omega Engineering Incorporated v. Omega SA*, a trademark co-existence agreement was regarded enforceable by the OHIM<sup>116</sup>.

Agreements in relation to the co-existence of trademarks drafted in many different ways in terms of the principle of freedom of contract and such agreements may be either for the purposes of use or registration<sup>117</sup>. Under the trademark co-existence agreements for the purposes of use, parties may only envisage conditions in relation to

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<sup>114</sup> Apple Corps Limited and Apple Computer Inc, EWHC 748 (2004); For further information see: **Elsmore**, J. Matthew, “Who gets the biggest bite?: A Discussion of the long and winding Apple trade mark dispute”, N I R. Nordiskt Immateriellt Raettsskydd. 2007, (5). 427-446.

<sup>115</sup> **Cohen**, Jeffrey R., “ The enforceability and impact of trademark co-existence agreements”, Journal of Intellectual Property Law & Practice, 20120, vol.5, no.10, p. 680.

<sup>116</sup> *Omega Engineering Incorporated v Omega SA (Omega AG) (Omega Ltd)* 2010, EWHC 1211 (Ch), Chancery Division (England and Wales), 28 May 2010.

<sup>117</sup> **Kılıç**, p. 88-89; **Gün**, p. 51.

the use of trademarks and they agree on not to bring any proceedings against each other<sup>118</sup>.

Under the trademark co-existence agreements for the purpose of registration, on the other hand, the earlier trademark proprietor expressly agrees to the registration of later identical or similar trademark by expressing consent for registration and agreeing on not bringing a proceeding against the later identical or similar trademark in order to enable the registration of that trademark and the peaceful co-existence<sup>119</sup>. Both

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<sup>118</sup> See **Kılıç**, p. 89: Trademark co-existence agreements for the purpose of use may be concluded in two scenarios. In the first scenario, there may be two identical or similar trademarks, which have already been registered. Under a trademark co-existence agreements, parties may agree on a peaceful co-existence their identical or similar trademarks and not bringing a proceeding against each other. In the second scenario, a trademark co-existence agreement can be made between an unregistered trademark holder and a registered trademark holder or an unregistered trademark. In this case, the unregistered trademark holder and the other party agree on the peaceful co-existence of their identical or similar trademarks and not bringing a proceeding against each other. This type of trademark co-existence agreements are not within the scope of this work.

<sup>119</sup> See **Kılıç**, p. 88: Trademark co-existence agreements for the purpose of registration may be concluded in three different scenarios. In the first scenario, the registered trademark owner consents to the registration of an identical or similar trademark on identical or similar goods. In the second scenario, the registered well-known trademark proprietor consents to the registration of an identical or similar trademark. Lastly, in the third scenario, the unregistered trademark owner agrees not to oppose against the trademark application and consents to the trademark registration. Under such agreements, in addition to the consent and the commitment of non-opposition parties

agreements have not been expressly forbidden, yet the enforcement of the trademark co-existence agreements for the purpose of registration has been doubtful<sup>120</sup>. Since, the existence of identical or similar trademarks has been regarded as a refusal grounds for registration, due to the principle of specialty of trademark. Therefore, recognition of the parties' intention the registration of identical or similar trademarks depends on the laws of each country and the practice before official patent and trademark authorities<sup>121</sup>.

In order to enable the enforcement of the trademark co-existence agreements for the purpose of registration, number of jurisdictions adopted a unilateral administrative consent mechanism in order to overcome a refusal of “identical or similar trademark on

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may envisage terms and conditions in relation to the co-existence relationship. This work only covers the trademark co-existence agreements for the purpose of registration under which the earlier trademark proprietor is obliged to issue a letter of consent for the registration of identical or indistinguishably similar trademarks; *See below, Chapter Two, II.*

<sup>120</sup> Hereinafter the “*Trademark Co-Existence Agreements*” will be used to refer the trademark co-existence agreements for the purpose of registration under which the earlier trademark holder consents to the registration of later identical or similar trademark and the parties agree on the co-existence of trademarks subject to the terms and conditions thereunder.

<sup>121</sup> *See below, Chapter Two, I* for the position in Turkey: In Turkey, even if the parties conclude a trademark co-existence agreement for the purpose of registration, in case there is an identical or indistinguishably similar trademark, the registration can only be made through the submission of a valid and enforceable letter of consent within the scope of the TIPC.

identical or similar goods or services”<sup>122</sup>. Number of jurisdictions introduced a written agreement consisting the consent of the earlier proprietor of the trademark to the registration of later identical or similar trademark under their trademark law<sup>123</sup>. It is seen as a possible solution to overcome an objection to the registration of a trademark based on a prior registration and encourage settlements among trademark owners<sup>124</sup>. Upon this development, the voluntary arrangements concluded between private parties in relation to co-existence of trademarks have started to be recognized by many jurisdictions<sup>125</sup>. Lately, it is demonstrated with the EUIPO’s statistics for 2019 that there is a gradual decrease in the number of oppositions and a significant increase in the number of oppositions finally settled<sup>126</sup>. These results show that the settlement among parties through the consent become more eminent and attractive day by day.

This change has also happened in Turkey and with the enactment of Article 5/3 of the TIPC. Submission of “*letters of consent*” issued by the earlier trademark proprietors is introduced as a way to enable the co-existence of registered trademarks and enforce trademark co-existence agreements made for the purpose of registration (which were not enabling the registration of identical or indistinguishably similar

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<sup>122</sup> See: **WIPO**, “Summary of Replies to the Questionnaire on Letters of Consent”, SCT/22/6, February 2010. (*WIPO*, “Summary”)

<sup>123</sup> **WIPO**, “Summary”, p.2; “The consent may be expressed and called differently in different jurisdictions (e.g. trademark co-existence agreement or consent agreement).”

<sup>124</sup> *ibid.*, p.1.

<sup>125</sup> *ibid.*

<sup>126</sup> EUIPO Statistics, [https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/about\\_euipo/the\\_office/statistics-of-european-union-trade-marks\\_en.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_euipo/the_office/statistics-of-european-union-trade-marks_en.pdf), accessed 04.12.19.



trademarks under no circumstances) and eliminate the *ex officio* refusal by the TPTO based on the existence of an “*identical or indistinguishably similar trademark on identical or similar goods or services*” under Article 5/3 of the TIPC.

## **B. Differentiation of the Co-Existence of Trademarks From Similar Institutions**

Co-existence of trademarks is often confused with the licensing and assignment of trademark, yet it is a different arrangement by which the parties agree to the co-existence of identical or similar trademarks<sup>127</sup>. Nonetheless, they need to be differentiated from each other since they have different consequences in trademark law, before analysing the co-existence of “*identical or indistinguishably similar trademarks*” in Turkey through letters of consent.

### **1. Licensing**

Under the licensing, trademark owners may license third parties to use their trademarks. Especially, foreign companies from developed countries usually give licence in relation to the use of their trademarks to local businesses in developing countries<sup>128</sup>. The licensing is established with a licence agreement between two parties, namely the licensor and the licensee. Under, licence agreements, the licensor confers the right to use on the trademark to the licensee. The licensor agrees not to exercise his/her right to prevent other persons from exploiting or using his/her trademark in exchange

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<sup>127</sup> **Wilkof, Neil J. & Burkitt, Daniel**: “Trademark Licensing”, 2<sup>nd</sup> ed. Sweet&Maxwell, London, 2006, p. 188.

<sup>128</sup> **Yasaman & Altay & Ayoğlu & Yusufoglu & Yüksel**, p. 737; **Çolak**, “Marka Hukuku”, 2016, p. 643; **WIPO**, “IP Handbook”, p. 94.

for a fee and subject to a “*quality control*”<sup>129</sup>. The proprietor of trademark effectively controls the use by licensee particularly with respect to the conditions that they have agreed upon under the licence agreement. Under the licensing, the essence of the right remains with the proprietor and in exchange for that, the right to use the trademark is conferred to the licensee<sup>130</sup>.

On the other hand, under a trademark co-existence agreement<sup>131</sup> the earlier trademark proprietor does not grant the right to use the trademark to the other party. Rather one party consent to the registration of an “identical or similar trademark” either by agreeing to give an express consent for the registration or agreeing under a trademark co-existence agreement to remain silent and not to oppose or bring any invalidation proceedings against the registration of “identical or similar trademarks”. With this arrangement, the later trademark holder holds an independent trademark right that incorporates the all rights and authorities assigned to a registered trademark. Upon the registration of later trademark, such trademark becomes independent from the earlier trademark and the applicant is granted with the absolute ownership right on the registered identical or similar trademark. Conversely, under the licensing arrangement, the licensee cannot claim ownership rights with respect to the mark being subject to licensing<sup>132</sup>.

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<sup>129</sup> **Wilkoff & Burkitt**, p. 188, **WIPO**, “IP Handbook”, p. 99.

<sup>130</sup> **Oğuz**, S., p. 83.

<sup>131</sup> The trademark co-existence agreements for the purpose of registration are referred here; *See supranotes no. 119 &120.*; It must be noted that under the trademark co-existence agreements for the purpose of use (*see above, supranote no. 18*), the right to use is not granted; For further information see **Gün**, p. 55-57.

<sup>132</sup> **WIPO**, “IP Handbook”, p. 95; **Gün**, p. 57; **Kılıç**, p. 81-82;

## 2. Assignment of Trademark

None of the voluntary trademark co-existence arrangements transfer the ownership on a trademark to another person<sup>133</sup>. Under the trademark co-existence the earlier proprietors' ownership on the earlier trademarks remains another ownership is created for another person. In case of a trademark co-existence agreement for the purpose of registration, the earlier trademark proprietor either expressly consents to the registration of "identical or similar trademark on identical or similar goods or services" or agrees not to oppose against a trademark application.

Whereas under the assignment of trademark, the proprietor transfers the ownership right to another person and loses the title of proprietor<sup>134</sup>. Assignment of trademarks may only be in connection with some of the goods or services that the registration has been made on or all of them. On the other hand, letters of consent cannot be given for some of the goods/or services.

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<sup>133</sup> **Wilkoff & Burkitt**, p. 189.

<sup>134</sup> **Çolak**, "Marka Hukuku", 2016, p. 614; **Wilkoff & Burkitt**, p. 189.

## CHAPTER TWO

### **CO-EXISTENCE OF IDENTICAL OR SIMILAR TRADEMARKS THROUGH LETTERS OF CONSENT IN TURKEY**

#### **I. Co-Existence of Trademarks in Turkey**

The principle of specialty of trademark has a strong influence in Turkish trademark law. As mentioned earlier, under Turkish trademark law circumstances in relation to “the existence of an identical or similar earlier trademark on identical or similar goods or services” regarded within the scope of grounds for refusal of registration, as it is in the EU. Nonetheless, different from the EU trademark law, existence of an “*identical or indistinguishably similar earlier trademark*” is specifically regarded as an absolute refusal ground for registration under Article 5/1(ç) of the TIPC<sup>135</sup>. This means that in case of “*existence of identical or indistinguishably similar earlier registered trademark on identical or similar goods or services*”, the later trademark application will be refused by the TPTO *ex officio*.

Co-existence of trademarks is a concept contrary to the above-mentioned refusal grounds for registration under the TIPC<sup>136</sup>. Thus, in principle, the co-existence of trademarks is not allowed under trademark law. However, with the needs of the market, the co-existence of trademarks has been considered as an exception to the principle of specialty of trademark law and the absolute ground for refusal of registration dealt under Article 5/1(ç) of the TIPC.

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<sup>135</sup> TIPC, Article 5/1(ç).

<sup>136</sup> *See above, Chapter One, II & III.*

## A. Non-Voluntary Co-Existence of Trademarks in Turkey

Under Turkish trademark law, it is not always necessary to have a voluntary arrangement for trademarks to co-exist<sup>137</sup>. Despite the principle of specialty of trademark, under certain circumstances, identical or similar trademarks can co-exist on “identical or similar goods or services” through the rules of the law or the court decisions as well. For example, there might be two different entities operating under identical or similar trademarks in different regions and might have remained silent for some reason.

According to several decisions of *Yargıtay*, the peaceful co-existence of trademarks may be considered as a proof that there is not a likelihood of confusion among these trademarks and parties lose their right to claim invalidation, due to acquiescence<sup>138</sup>. Similarly, under Article 25/6 of the TIPC, it is also clearly specified that unless the trademark has been registered in bad faith, if a trademark proprietor has acquiesced to the use of a trademark for five (5) consecutive years, the trademark proprietor cannot claim the invalidation of the respective trademark. For that reason, due to the inaction of the proprietor for five (5) consecutive years against the later mark that he knows or should have known, the exceptions prevail and the concurrent marks co-exist together<sup>139</sup>. Such circumstances were available also under the Abrogated Decree Law No. 556 yet the law was not recognizing private voluntary arrangements until the enactment of the TIPC.

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<sup>137</sup> **Çolak**, “Marka Hukuku”, 2016, p. 292.

<sup>138</sup> *Yargıtay* 11.HD., 2013/17968 E.,2014/6993 K., dated 09.04.2014; *Yargıtay* 11.HD., 2012/8617 E., 2013/11464 K., dated 03.06.2013.

<sup>139</sup> **Yıldız**, p. 98.

## B. Voluntary Co-Existence of Trademarks in Turkey

In Turkey, before 2016, under the Abrogated Decree Law No. 556, there was not a provision in force regarding the co-existence of trademarks. Nevertheless, trademark co-existence agreements have been used in Turkey since the Abrogated Decree Law No.556<sup>140</sup>. There was not an obstacle against such agreements. Although, they were not enforceable before the Turkish Patent Institute (former name of the TPTO), they were enforced among the parties of the trademark co-existence agreement, namely the earlier trademark proprietor and the holder of the later sign. Trademark co-existence agreements were useful to overcome an opposition and refusal based on Article 8/1(a) and 8/1(b) of the Abrogated Decree Law No.556. However they were not preventing the absolute refusal of registration based on Article 7/1(b).

Before the enactment of the TIPC, under the Abrogated Decree Law No. 556 Article 7/1(b), an application for a trademark, which is “*identical or indistinguishably similar to an earlier registered mark*”, used to be rejected *ex officio* by the TPTO, without considering any voluntary arrangement between parties. There were no exceptions to this absolute refusal ground and the TPTO was not recognizing any voluntary arrangements issued by the registered proprietor. The TPTO was not considering the intention of parties to co-exist despite the identicalness or indistinguishable similarity. This strict practice has been controversial due to the need in the market to avoid an *ex officio* refusal based on Article 7/1(b) of the Abrogated Decree Law No. 556. Especially, since the co-existence exception has been

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<sup>140</sup> **Kılıç**, p. 79; **Gün**, p. 172: Trademark co-existence agreements have been as settlement agreements under which the earlier trademark proprietor agrees not to oppose a trademark application which falls within the scope of relative grounds for refusal since the Abrogated Decree Law No. 556.

acknowledged by *Yargıtay*<sup>141</sup>, it has been necessary to modify the law and provide for an exception to that absolute refusal ground for registration.

The voluntary co-existence exception has officially entered into Turkish trademark law in 2017, with the enactment of Article 5/3 of the TIPC with respect the letter of consent. With the exception provided under Article 5/3 of the TIPC, a green light is given to the trademark owners who wish to co-exist, by allowing the registration of “*identical or indistinguishably similar trademarks on identical or similar goods or services*”, with the submission of a letter of consent issued by the prior registered trademark owner<sup>142</sup>. Since 2017, despite the *ex officio* refusal authority of the TPTO, provided that the earlier proprietor submits a letter of consent in line with the TIPC, the later trademark application will not be refused based on Article 5/1(ç). This is an important way of overcoming refusals under Article 5/1(ç). If the applicant obtains the consent of the proprietor of earlier trademark to the registration, the TPTO cannot reject the application of later identical or indistinguishably similar trademark for registration. The TPTO does not have discretion within this respect<sup>143</sup>.

The TIPC enabled the voluntary co-existence of identical or indistinguishably similar trademarks through letters of consent with Article 5/3. It is claimed that with the enactment of Article 5/3 of the TIPC, trademark co-existence agreements have entered

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<sup>141</sup> See: *supranote no. 64*.

<sup>142</sup> **Çolak**, Uğur, “Türk Marka Hukuku”, 6769 sayılı Sınai Mülkiyet Kanunu’na Göre Hazırlanmış 4. Baskı, Oniki Levha Yayınları, İstanbul, 2018, p. 148, (**Çolak**, “*Marka Hukuku*”, 2018); **Mumcuoğlu**, <https://iprgezgini.org/2016/06/13/a-new-chapter-of-ip-in-turkey-green-light-for-trademark-owners-to-co-exist/>, accessed on 09.02.2020.

<sup>143</sup> **Kitchen & Llewelyn & Mellor & Maeda & Moody-Stuart & Keeling**, p. 68.

into Turkish trademark law<sup>144</sup>. The objective of Article 5/3 is to introduce the co-existence of “*identical or indistinguishably similar trademarks on identical or similar goods or services*” and protect the intent of the earlier registered proprietor to permit later trademark holder to register identical or similar mark.

When the wording of Article 5/3 of the TIPC is considered, it could be seen that the legislator introduced another instrument to achieve this objective, namely “*the letter of consent*”. In Turkey, trademark co-existence agreements and the letter of consent are two different legal instruments and they have different purposes in trademark law<sup>145</sup>. In this regard, we believe that it would be right to say that the legislator has introduced the co-existence of registered trademarks through letters of consent, not actually the trademark co-existence agreements<sup>146</sup>. The trademark co-existence agreements are still

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<sup>144</sup> **Oğuz**, S., p. 154; **Çolak**, “Marka Hukuku”, 2018, p. 148.

<sup>145</sup> **McCarthy**, p. 292-293; **Wilkof**, Neil, “Out of the Shadows: The Unique World of Trademark Consent Agreements“, *The Law and Practice of Trademark Transactions*, Ed. Irene Calboli & Jacques de Werra, United Kingdom, 2016, p. 273: However, this is not the case in all jurisdictions. For instance, in the USA, there is a single contractual arrangement that either serves as a letter of consent or a trademark co-existence agreement and unless, there is a likelihood of confusion parties may incorporate terms and conditions as they wish.

<sup>146</sup> *See above, I-B*: As mentioned at the beginning of this chapter, the trademark co-existence agreements have been applicable as settlement agreements since the Abrogated Decree No. 556, since there have not been any limitations against such agreements to be concluded. Such agreements were being used as settlement agreement among parties under which the earlier trademark proprietor agrees not to oppose against



not enforceable before the TPTO<sup>147</sup>. Especially in case of “*existence of identical or indistinguishably similar trademarks on identical or similar goods or services*”, without a letter of consent issued by the earlier trademark proprietor and submitted to the TPTO, a trademark co-existence agreement, by itself, does not enable the registration of “*identical or indistinguishably similar trademarks on identical or similar goods or services*”. Therefore, even though, such agreements can be concluded in practice, they are non-functional in terms of registration of trademarks.

Nevertheless, parties can still conclude such agreements to overcome relative refusal ground under Article 6/1. In that case, the parties may enable the registration of identical or similar trademarks within the ambit of Article 6/1. Alternatively, in relation to the “*identical or indistinguishably similar trademarks*” parties can enter into trademark co-existence agreements in advance before the grant of a letter of consent for the registration of “*identical or indistinguishably similar trademarks*”. Under such agreements in addition to the grant of letter of consent, parties can envisage terms and conditions in relation to the co-existence relationship<sup>148</sup>. All in all, it could be said that

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later trademark that falls within the scope of relative refusal grounds. However, it was not possible to overcome the absolute refusal ground dealt under Article 7/1(b).

<sup>147</sup> Also see below, Chapter Two, III in relation to the enforcement of private agreements in relation to the letter of consent: This analysis incorporates an evaluation of the trademark co-existence agreements as well.

<sup>148</sup> For further information see below, Chapter Two, III: Parties can enter into parallel private agreements, before the submission of the letter of consent. Such agreement may only be in relation to the grant of letter of consent or it may be a broader agreement, which incorporate terms and conditions in relation to the co-existence relationship.

with the enactment in relation to letters of consent, such types of trademark co-existence agreements will inevitably be more eminent in Turkish trademark law as well<sup>149</sup>.

## II. Letters of Consent in Turkish Trademark Law

### A. Article 5/3 of the TIPC and Letters of Consent in General

Before the enactment of the TIPC, the Abrogated Decree Law No.556 was not envisaging the letter of consent practice. Registration of signs which are “*identical or indistinguishably similar to an earlier trademark*”, were refused *ex officio*, based on the absolute refusal ground dealt under Article 7/1(b) of the Abrogated Decree Law No. 556 without being subject to any exceptions<sup>150</sup>. As mentioned earlier, essentially, the principle of specialty of trademark has been present under Turkish trademark law. Similar to Article 7/1(b) of the Abrogated Decree Law No.556, Article 5/1(ç) of the TIPC also reflects the principle of specialty of trademark, which in principle does not let “*the co-existence of identical or similar trademarks*”<sup>151</sup>.

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<sup>149</sup> Çolak, “Marka Hukuku”, 2018, p. 148.

<sup>150</sup> Abrogated Decree Law No. 556, Article 7/1(b): “*Following signs shall not be registered as trademark: (...) trademarks identical or confusingly similar with a trademark registered earlier or with an earlier date of application for registration in respect of an identical or same type of product or services (...)*” . Translation available at: <https://www.wipo.int/edocs/lexdocs/laws/en/tr/tr037en.pdf>, accessed 25.01.2020.

<sup>151</sup> TIPC, Article 5/3: “*A trademark application shall not be refused according to Article 5/1(ç), if a notarial document indicating the clear consent of the prior trademark proprietor for the registration of the application is submitted to the TPTO. Procedure and rules regarding the letter of consent shall be determined by regulation.*”

Translation available at:

The letter of consent has entered into Turkish trademark law for the first time in 2017 under Article 5/3 of the TIPC as an exception to the absolute refusal ground for registration dealt under Article 5/1(ç) based on “*the existence of an identical or indistinguishably similar earlier registered trademark*”. Article 5/3 provides a way to overcome the *ex officio* refusal by the TPTO via unilateral declaration of intention in relation to the co-existence of identical or similar trademarks. The TPTO recognizes such declaration as long as it is made through a letter of consent in line with Article 5/3 of the TIPC and does not refuse a trademark registration application based on Article 5/1(ç) of the TIPC. It could be said that with the enactment of Article 5/3, the long-awaited co-existence principle has been introduced under the Turkish trademark law.

The letter of consent is defined by the WIPO as “*an agreement of the holder of a prior registered trademark consenting registration of a later trademark*”<sup>152</sup>. According to the WIPO, letters of consent are tools to overcome the refusal of registration based on the existence of an earlier identical or similar registered mark<sup>153</sup>. Although the letter of consent was not identified under Turkish trademark law before the enactment of the TIPC, in number of jurisdictions it was possible to overcome the *ex officio* refusal of registration based on the existence of an identical or similar earlier registered trademark

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<https://www.turkpatent.gov.tr/TURKPATENT/resources/temp/4D59A7D3-A564-40A1-9C96-DB1E3D157E90.pdf;jsessionid=BDF39FA3EA1C89B51DB4D3386FC83621>, accessed 23.01.2020.

<sup>152</sup> WIPO, “Summary”, p. 2, para. 3.

<sup>153</sup> *ibid.*, p. 1., para. 3

through the submission of a letter of consent<sup>154</sup>. In addition to that, in number of jurisdictions it was even possible to overcome an opposition or a request of invalidation or cancellation based on the existence of an earlier registered trademark<sup>155</sup>. According to the WIPO's analysis, the consent is expressed under different names in different jurisdictions such as co-existence agreements or transactional agreements<sup>156</sup>.

In Turkey, the consent to registration may be provided under private agreements between parties however, what is recognized before the TPTO is the letter of consent prepared in accordance with the rules of the TIPC and the Regulation on the Implementation of the TIPC (hereinafter referred as "*Implementation Regulation*")<sup>157</sup>. Therefore, under Turkish trademark law, letters of consents and the private agreements in relation to the consent to registration and trademark co-existence agreements are differentiated from each other. Their legal nature, content, validity and enforcement in accordance with the TIPC are not the same. In light of Article 5(3) of the TIPC,

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<sup>154</sup> *ibid.*, p. 25: In 2009, 68% of the Member States were providing the letter of consent exception in their national trademark laws "*to overcome an ex officio refusal or a trademark registration based on an earlier registered trademark*".

<sup>155</sup> *ibid.*: In 2009, 60% of the Member States were providing the letter of consent exception in their national trademark laws "*to overcome an opposition to a trademark registration based on an earlier registered trademark*" and 51% of the Member States were providing the letter of consent exception in their national trademark laws "*to overcome a request for invalidation or cancellation of a trademark registration based on an earlier registered trademark*".

<sup>156</sup> WIPO, "Summary", p.1., para. 3.

<sup>157</sup> Regulation on the Implementation of the TIPC, published in the Official Gazette dated 24.04.2017 numbered 30047; *See below, Chapter Two, III.*

registration of identical or indistinguishably similar marks will not be refused by the TPTO based on the absolute ground defined under Article 5/1(ç), provided that the applicant submits a letter of consent issued by the earlier registered proprietor in accordance with the rules of the TIPC. Any other agreement consisting the consent to registration is not enforceable before the TPTO. Only the letter of consent enables the registration of “*identical or indistinguishably similar signs on identical or similar goods or services*”.

Article 5/3 of the TIPC is only applicable for the trademarks registered or to be registered. Unregistered trademarks do not fall within the scope of Article 5 of the TIPC<sup>158</sup>. Hence, Article 5/3 of the TIPC and letters of consent thereunder are inapplicable to unregistered trademarks. In this circumstance, in order to co-exist in the market with the prior unregistered trademarks and avoid any claims against the registration of later identical or similar trademark, parties can conclude a trademark co-existence agreement under which the unregistered trademark proprietor agrees to co-exist with a registered trademark by promising not to oppose against such a trademark based on Article 6/3 of the TIPC<sup>159</sup>.

Similarly, no consent can be given for the registration of a trademark by relying on a consent given by the proprietors of other prior industrial property rights<sup>160</sup>. Similar

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<sup>158</sup> Article 6/3 of the TIPC applies to the unregistered trademarks and envisages that “*If a right to [an unregistered trademark]... 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 shall be refused upon opposition of the proprietor of that sign.*”

<sup>159</sup> **Gün**, p. 108; also see *supranote no. 119*.

<sup>160</sup> For further information on the agreements in relation to the co-existence of trademarks and other industrial property rights also see: **Gün**, p. 283-287.

to the above-mentioned case, in such circumstances parties can conclude co-existence agreements under which earlier right holder agrees not to oppose against the trademark application or invalidate the later trademark registration.

With the presentation of a letter of consent to the TPTO, it is solely possible to overcome an *ex officio* refusal of a trademark registration based on “*the existence of identical or indistinguishably similar trademarks on identical or similar goods or services*”. The TIPC has provided the letter of consent in order to harmonize Turkish trademark law with the EU Trademark Regulation and the EU Trademark Directive and meet the need of trademark owners who want to co-exist in the market<sup>161</sup>. With Article 5/3 of the TIPC, it is aimed to protect the consent of the trademark owners to co-exist in the market place, especially the ones who are affiliated to each other economically<sup>162</sup>.

## **B. Legal Nature of Letters of Consent**

Letter of consent is a unilateral legal transaction, which contains the consent of the earlier registered trademark proprietor for the registration of the later trademark application<sup>163</sup>. In unilateral legal transactions, it is sufficient to have one party to be present and declare its intention for the establishment of the aimed legal transaction<sup>164</sup>.

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<sup>161</sup> **Bozbel**, para. 5-6.

<sup>162</sup> *ibid.* , p. 14.

<sup>163</sup> **Gün**, p. 102.

<sup>164</sup> For more information about “unilateral legal transactions” See: **Kılıçoğlu**, Ahmet, “Borçlar Hukuku Genel Hükümler”, Turhan Kitabevi, Ankara 2014, p. 47; **Oğuzman M. Kemal & Öz M. Turgut**, “Borçlar Hukuku: Genel Hükümler”, C.1, 13.Bası, İstanbul 2015, p. 36; **Kocayusufpaşaoğlu**, Necip, Borçlar Hukukuna Giriş – Hukuki İşlem-

Therefore there is only one party to letter of consent who may be referred as the consenter. The other party, who makes the later application, cannot be considered as a party to letter of consent due to the unilateral nature of letters of consent. This could be demonstrated with the forms provided by the TPTO, which solely require the unilateral declaration and signature of the earlier trademark proprietor who is consenting, not the later trademark proprietor to whom the consent is given<sup>165</sup>. The forms of letters of consent provided by the TPTO must be filled out and signed by the earlier trademark proprietor in order to make a letter of consent submission to the TPTO. Nonetheless, it must be noted that a unilateral legal transaction may impose rights and obligations to more than one party. Therefore, having a unilateral legal transaction does not mean that the obligations given thereunder will only be imposed to the earlier trademark proprietor<sup>166</sup>.

### C. Parties to Letters of Consent

A letter of consent is considered as a unilateral legal transaction since it contains the consent of one party, namely the earlier trademark proprietor. The other party, who is consented to register identical or indistinguishably similar trademark, is not a party to letter of consent. With a letter of consent the later trademark holder only obtains a right

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*Sözleşme (Kocayusufpaşaoğlu & Hatemi & Serozan & Arpacı, Borçlar Hukuku Genel Bölüm C.I.)* 4. Bası, İstanbul 2008, p. 94-95.

<sup>165</sup> TPTO forms available at:

<https://www.turkpatent.gov.tr/TURKPATENT/forms/informationDetail?id=100>,

accessed 18.10.2019

<sup>166</sup> **Oğuzman & Öz**, p. 36; **Kılıçoğlu**, p. 47: “The rights and obligations under a letter of consent arise for both the earlier registered trademark proprietor and later trademark proprietor.”

to register identical or indistinguishable trademark without being subject to a refusal based on Article 5/1(ç) of the TIPC.

Article 5/3 of the TIPC explicitly states that “*the earlier trademark proprietor*” must issue a letter of consent and consent to the registration of the later trademark application in order to overcome an *ex officio* refusal by the TPTO for the later trademark application. Here, one might question whether the holder of an earlier trademark application can issue a letter of consent for the registration of later identical or indistinguishably similar mark. It is crystal clear under Article 5/3 that the letter of consent can only be issued by “the earlier trademark proprietor”. Therefore, the holder of a registration application cannot be considered as a trademark proprietor and thus, it could be said that the holder of a trademark application cannot issue a letter of consent and be a party to letter of consent<sup>167</sup>. Nevertheless, Article 10 of the Implementation Regulation explicitly states that holder(s) of registration application can also fill out the letter of consent forms provided by the TPTO. Although, the earlier applicant can fill out the letter of consent form and submit it to the TPTO, the letter of consent will be valid and enforceable as long as the earlier registration application is accomplished and the registration is made<sup>168</sup>. Therefore, Article 5/3 will kick in and eliminate a refusal based on Article 5/1(ç).

Although, Article 5/3 of the TIPC does not make a clear reference to the real proprietor of the trademark, due to the general doctrine of real ownership under trademark law, only the real proprietor of the earlier registered mark can give consent to the later mark for registration under the letter of consent otherwise, the letter of consent

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<sup>167</sup> **Gün**, p. 108; The holder of an application can still oppose to the registration of an identical or indistinguishably similar mark.

<sup>168</sup> *ibid.* , p.109.



is considered invalid<sup>169</sup>. In light of the principle of real ownership, the earlier trademark proprietor who consents to the registration has to be the real owner of the trademark. In other words, if the proprietor of the trademark is not the real owner of the trademark, the earliest real trademark owner may invalidate all later registrations<sup>170</sup>. It must be noted that, in this case the trademark, which has been registered based on a letter of consent, may not be invalidated automatically along with the invalidation of the trademark of the consenter. The real trademark owner has to initiate separate proceedings against the consented trademark owner, since as of the acceptance of the letter of consent and the registration of the consented later trademark, such trademark will be independent from the earlier trademark. On the other hand, with the invalidation of the earlier trademark of the unreal proprietor, the letter of consent issued by that proprietor will also be invalid due to Article 27 of the TIPC. Pursuant to Article 27 of the TIPC, if a trademark is invalidated, such invalidation will be effective from the application date and the trademark will be deemed not to have been protected.

A trademark is not always owned by a single owner. Multiple proprietors may own a single trademark. In case of multiple proprietors, the letter of consent needs to be issued with the consent of all trademark proprietors recorded. Absence of consent or signature from any of the proprietors will deem the letter of consent invalid.

Another point that needs to be mentioned with respect to the parties is that, the unregistered trademark proprietors cannot be party to letters of consent. In other words, proprietors of unregistered trademarks cannot issue letters of consent within the means

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<sup>169</sup> **Karahan & Suluk & Saraç & Nal**, p. 11; **Çolak**, “Marka Hukuku”, 2016, p. 368: The Doctrine of Real Ownership is referred as “Gerçek Hak Sahipliği Doktrini” under Turkish trademark law; also see: Yargıtay 11. HD., 6134/13829 K., dated 23.12.2015.

<sup>170</sup> **Gün**, p. 108.

of Article 5/3, since this provision only covers the registered trademarks. Similarly, letters of consent can only be issued by proprietors of registered trademarks to enable the registration of another “trademark”<sup>171</sup>. Owner of another industrial property right cannot issue letters of consent and consent to the registration of trademarks<sup>172</sup>.

There may be multiple earlier “*identical or indistinguishably similar*” trademarks “*on identical or similar goods or services*”, which have already co-existed in the market so far. Some of those marks might have been registered on the basis of a letter of consent issued by the earlier trademarks’ proprietors. In such a case, if another application is filed for an identical or similar trademark, in order to avoid a refusal based on Article 5/1(ç) of the TIPC, the later trademark owner should obtain letters of consent from all earlier registered proprietors<sup>173</sup>.

If the prospective later trademark owner fails to obtain a letter of consent from any of the earlier proprietors, the later application shall be refused *ex officio* by the TPTO based on Article 5/1(ç) of the TIPC. Therefore, the applicant is advised to obtain letters of consent from all earlier trademark proprietors of registered trademarks<sup>174</sup>. In

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<sup>171</sup> *ibid.*

<sup>172</sup> In such cases parties may conclude “*Co-existence Agreements*”. Co-existence of other industrial property rights and trademarks is not within the scope of this work, for further information see **Gün**, p. 283-287.

<sup>173</sup> **Gün**, p. 108.

<sup>174</sup> **WIPO**, “Summary”, p. 9-10: According to the WIPO’s analysis, which was conducted in 2009, 35 member countries have already required this; The TPTO has not clarified the issue on whether a separate letter of consent is required from all of the earlier trademark proprietors.

this case, all letters of consent will be independent from each other and each earlier proprietor will be party to different letter of consent<sup>175</sup>.

#### **D. The Scope of Letters of Consent**

Pursuant to the TIPC, a letter of consent must be unequivocal and unconditional and must provide the mandatory content required by the law. Article 5/3 of the TIPC outlines the main elements that a letter of consent must incorporate within its scope. Additionally, there are further requirements provided for letters of consent under Article 10 of the Implementation Regulation.

##### **1. Unequivocal and Unconditional Consent**

Letters of consent must provide the unequivocal consent of the earlier trademark proprietor for the registration of “*identical or indistinguishably similar trademarks on identical or similar goods or services*”<sup>176</sup>. The consent of the earlier trademark proprietor must be clearly stated under the form of letter of consent.

In addition to that, as per Article 10/5 of the Implementation Regulation, the letter of consent must be unconditional<sup>177</sup>. For instance, if the consent is given on the condition that the later trademark will be used in a particular way or in particular goods or services or at a particular location, such letter of consent will not satisfy the requirements under Article 10/5 of the Implementation Regulation and will be deemed invalid. Therefore, the letter of consent must not embody any conditions in it.

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<sup>175</sup> **Gün**, p. 110.

<sup>176</sup> TIPC, Article 5/3.

<sup>177</sup> Implementation Regulation, Article 10/5: “*The letter of consent must be unequivocal and unconditional (...)*”.

The consent given by the earlier trademark proprietor is limited to the earlier trademark proprietor's registration and the entitlements thereunder. In this regard, the consent can only be given for the signs, which are found "*identical or indistinguishably similar to the earlier registered trademark on identical or similar goods*"<sup>178</sup>.

Under trademark law, it is also not possible to make the registration on a particular good or service<sup>179</sup>. In Turkey, trademarks are registered under inclusive classes, which embody more than one good or services under various sub-classes<sup>180</sup>.

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<sup>178</sup> TIPC, Article 11/4: "*Goods or services shall not be presumed as being similar on the ground that they are in the same class and goods or services shall not be regarded as being dissimilar on the ground that they are in different classes*". Translation available at <https://www.turkpatent.gov.tr/TURKPATENT/resources/temp/4D59A7D3-A564-40A1-9C96-DB1E3D157E90.pdf;jsessionid=BDF39FA3EA1C89B51DB4D3386FC83621>, accessed on 23.01.2020; also see Chapter One, II-B,3

<sup>179</sup> TIPC, Article 11/3: "*Goods or services for which application is filed shall be classified in accordance with Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, which was ratified pursuant to the decision of the Council of Ministers dated 12/7/1995 numbered 95/7094. The Office may perform necessary corrections on classes and class numbers belonging to goods and services in the application.*" Translation available at <https://www.turkpatent.gov.tr/TURKPATENT/resources/temp/4D59A7D3-A564-40A1-9C96-DB1E3D157E90.pdf;jsessionid=BDF39FA3EA1C89B51DB4D3386FC83621>, accessed on 23.01.2020.

<sup>180</sup> **Ünsal**, Önder Erol, "Muvafakatname İstisnası – Sınai Mülkiyet Kanunu ile Marka Alanında Getirilen Bir Yenilik, IPR Gezgini"; February 2017,

The registration should be made on a class or sub-class determined by the Nice classification. To illustrate, if the trademark has been registered for Class 25 (class that both covers clothing, footwear and headwear for human beings), the consent can be given for entire Class 25 or any of the sub-class provided under Class 25 or classes similar to the Class 25<sup>181</sup>. For instance, an earlier trademark might have been registered for Class 25. Since, Class 25 includes headwear for human beings as well (a sub-class under Class 25), registration of an identical or indistinguishably similar trademark for such class also requires the consent of the earlier proprietor according to Article 5/3 of the TIPC. If the earlier proprietor is not bothered with the registration of an “identical or similar trademark” for headwear, consent may be given for the registration of identical trademark for the relevant class.

Since the letter of consent must be unconditional, it is not possible to limit the registration for a particular good or service under the letter of consent by putting a condition thereunder. Letters of consent must specify the class or the sub-classes that the consent for registration is given to in accordance with the Nice Classification<sup>182</sup>. If

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<https://iprgezgini.org/2017/02/12/muvafakatname-istisnasi-sinai-mulkiyet-kanunu-ile-marka-alaninda-getirilen-bir-yenilik/>, accessed on 09.02.2020.

<sup>181</sup> For TÜRKPATENT classification which is in line with the Nice Classification, See: <https://www.turkpatent.gov.tr/TURKPATENT/commonContent/MClassification/>, accessed on 03.12.2019.; For the Nice Classification, See: [https://www.wipo.int/classifications/nice/nclpub/en/fr/?basic\\_numbers=show&class\\_number=25&explanatory\\_notes=show&lang=en&menulang=en&mode=flat&notion=&pagination=no&version=20200101](https://www.wipo.int/classifications/nice/nclpub/en/fr/?basic_numbers=show&class_number=25&explanatory_notes=show&lang=en&menulang=en&mode=flat&notion=&pagination=no&version=20200101), accessed on 27.01.2020.

<sup>182</sup> TPTO Letter of Consent Forms available in Turkish at <https://www.turkpatent.gov.tr/TURKPATENT/forms/informationDetail?id=100> ,

the earlier trademark's registration is for headwear including caps, which is considered as a sub-class under Class 25 and the later applicant wants to register their trademark for baseball caps only, the earlier trademark proprietor must consent to the registration for the sub-class of "the caps being headwear". It is not possible to make the registration and give the consent for baseball caps only.

According to such classification, in principle, the goods or services under a class are considered as same type of other goods or services under that class, in this sense the letter of consent should be given for all goods or services under a particular class<sup>183</sup>. Nevertheless, it must also be noted that, pursuant to the Communiqué Regarding the Classification of Goods or Services for Registration of Trademarks, it is explicitly stated that the TPTO may interpret such classes narrowly or broadly while determining the identicalness of goods or services<sup>184</sup>. This means that the determination of identicalness cannot be made without any review by the TPTO and the goods or services cannot be

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accessed on 27.01.2020: *"In case the consent is given for all goods and/or services that the earlier trademark has been registered or applied for, it is sufficient to mention "all goods and services within the scope of registration" under the list of goods or services. On the other hand, in case the consent is given with respect to some of the goods and/or services that the earlier trademark has been registered or applied for, only the goods or services for which the consent is given must be mentioned along with their Nice Classification codes"*.

<sup>183</sup> **Arkan**, "Marka Hukuku", p. 74; **Suluk & Karasu & Nal**, p. 177

<sup>184</sup> Communiqué Regarding the Classification of Goods or Services for Registration of Trademarks (TPE: 2016/2), available at: <https://www.turkpatent.gov.tr/TURKPATENT/resources/temp/86D9FC05-00FC-445B-BAE9-38BBB38AD845.pdf>, accessed on 20.02.2020.

regarded as identical just because they are grouped under the same class nor the goods or services under different classes cannot be regarded different<sup>185</sup>. While filling out the letter of consent form, the earlier registered trademark proprietor should check up on the identicalness or similarity of the later trademark application before issuing a letter of consent for the prospective applicant. It is not possible to envisage any conditions in relation to the scope of goods or services under letters of consent.

In federal states such as the United States of America, regional i.e. state-level protections may be provided by registration and thus, in such jurisdictions the consent for registration may be geographically limited<sup>186</sup>. On the other hand, in Turkey, letters of consent cannot have a geographically limited scope, since Turkey is a unitary state and the trademark protection through registration is provided all around Turkey. Therefore, once a letter of consent is submitted to the TPTO and the registration is made in accordance with the rules of the TIPC, the later trademark will be protected in all parts of Turkey under equal conditions. In addition to that, due to the unconditional nature of letters of consent, the parties cannot envisage conditions under letters of consent in relation to geographical scope of trademark. For instance, it is not possible to put a condition under the letter of consent for the later trademark owner to use the

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<sup>185</sup> **Oğuz, A. & Özkan**, p. 43; **Çolak**, “Marka Hukuku”, 2016, p. 126: “*Even the goods or services under different classes may be regarded as identical or indistinguishably similar*”.

<sup>186</sup> **Gün**, p. 119; Also see **United States Patent and Trademark Office**, “Trademark Manual of Examining Procedure (TMEP)”, October 2018, <https://tmepl.uspto.gov/RDMS/TMEP/current#/current/TMEP-1200d1e6229.html>, accessed on 02.03.20.

trademark only in İstanbul. Otherwise the letter of consent will be invalid in terms of Article 10/5 of the Implementation Regulation.

In addition to above, it is also not possible to limit the consent for registration for a specific period of time or restrict to transfer a trademark which was registered on the basis of a letter of consent under the TIPC.

Although, letters of consent must be unconditional in order to be valid and enforceable before the TPTO, parties are still free to negotiate conditions under a parallel agreement within their private relationship<sup>187</sup>. In practice, before issuing a letter of consent parties conclude a private agreement among each other and they put conditions under such agreements if they wish. Nevertheless, such agreements are not enforceable before the TPTO. In the event of the breach of condition under such an agreement, parties cannot claim anything before the TPTO yet they may sue the other party for breach of contract before the civil courts, not the specialized courts for intellectual and industrial property rights<sup>188</sup>.

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<sup>187</sup> This agreement may be referred either as a trademark co-existence agreement or a consent agreement or a private agreement, which gives the obligation to issue a letter of consent to the prior trademark proprietor; *See below, Chapter Two, I-C.*

<sup>188</sup> **Kitchen & Llewelyn & Mellor & Maeda & Moody-Stuart & Keeling**, p. 68; “*If the consent is unconditional but is provided as part of an agreement which specifies the manner of use then, (...), in the event of breach, the earlier proprietor would have to sue for breach of contract*”; Similar with this approach in Turkey, the rules of the TCO will be applicable to the breach of contract disputes, not the rules under the TIPC; see **Gün**, p. 130; **Kılıç**, p. 91.



## 2. Mandatory Content

According to Article 10/1 of the Regulation, letters of consent must be in accordance with the forms provided by the TPTO. The earlier trademark proprietor must fill out the forms completely. In order to be deemed valid, the letter of consent must include the below-mentioned content:

- a) Applicant(s)' details of identity and contact information,
- b) If the form of letter of consent is submitted at the application stage, sample of the trademark subject to consent for registration;
- c) If the form of letter of consent is submitted at the appeal stage, the application number subject to consent for registration;
- d) Earlier trademark proprietor(s)' or applicant(s)' details of identity and contact information and the application or registration number of the earlier trademark or application subject to consent for registration;
- e) Number of classes of goods and/or services for which the consent is given;
- f) If the form of the letter of consent is signed by an attorney on behalf of the earlier applicant or trademark proprietor; the notarized power of attorney including the authorization for consent or a notarized copy of the power of attorney.

Pursuant to Article 10/2 of the Implementation Regulation in case the form of letter of consent does not include any of the listed items, a two-month grace period is given to the applicant to complete the deficiencies and provide all listed items thereunder. If the applicant does not remedy the deficiencies, the application is deemed not to have been made<sup>189</sup>.

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<sup>189</sup> Implementation Regulation, Article 10/2, second sentence.

As per Article 10/4 of the Implementation Regulation, in the event of presence of “*exclusive*” licensees on a trademark, the earlier trademark proprietor must attach the written permissions of such licensees to its application. Nonetheless, no such protection is provided for non-exclusive licensees or any other right holders.

#### **E. Form of Letters of Consent**

According to Article 5/3 of the TIPC, letters of consent must be notarized. There are no further explanations with respect to the form of letters of consent under the TIPC. The Implementation Regulation determines the procedure and further rules with respect to letters of consent<sup>190</sup>. According to Article 10 of the Implementation Regulation, letters of consent must be issued and signed in accordance with the letter of consent forms accepted by the TPTO. The notarization is compulsory for letters of consent to be valid and enforceable.

The TPTO has published two letter of consent forms on its website<sup>191</sup>. In case there is more than one trademark proprietor, the TPTO Consent Form for Multiple

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<sup>190</sup> TIPC, Article 5/3, second sentence: “(...) *Procedure and rules regarding letter of consent shall be determined by regulation.*” Translation available at <https://www.turkpatent.gov.tr/TURKPATENT/resources/temp/4D59A7D3-A564-40A1-9C96-DB1E3D157E90.pdf;jsessionid=BDF39FA3EA1C89B51DB4D3386FC83621>, accessed on 23.01.2020.

<sup>191</sup> TPTO Letter of Consent Forms <https://www.turkpatent.gov.tr/TURKPATENT/forms/informationDetail?id=100>, accessed on 18.10.2019 (hereinafter referred as “TPTO Consent Form for Single Owner” and “TPTO Consent Form for Multiple Owners”, both forms will be referred together as “TPTO Consent Forms”).

Owners must be filled out. There is no need for multiple proprietors to issue separate forms for a single application. Under the TPTO Consent Form for Multiple Owners, the number of the trademark proprietors, the details and signatures of all trademark proprietors must be provided. Similarly, if the later sign, which obtains consent to be registered, is aimed be owned by more than one person, the number and details of all prospective trademark owners must be provided under the TPTO Consent Form for Multiple Owners as well. Since the later applicants (prospective trademark proprietors) are not parties to letters of consent, their signature is not required under the TPTO Consent Forms<sup>192</sup>.

In case there is only a single earlier trademark proprietor, the TPTO Consent Form for a Single Owner must be filled out and signed by the earlier trademark proprietor. If the earlier proprietor or the applicant who gives the consent is a real person, the letter of consent must include the name/surname and the signature. If the earlier proprietor or the applicant who gives the consent is a legal person, the commercial title and the stamp of the relevant legal person must be provided under the form<sup>193</sup>. The information provided under the forms with respect to the earlier trademark proprietors, must match with the records of the registration or the earlier application filed before the TPTO.

Pursuant to Article 10/6 of the Implementation Regulation, for each trademark application a separate consent form must be submitted. For example, if there are two different applicants who want to register “*identical or indistinguishably similar trademark on identical or similar goods or services*”, the earlier trademark proprietor must give clear consent under two different letter of consent forms.

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<sup>192</sup> See above Chapter Two, II-A.

<sup>193</sup> See the TPTO Consent Forms.

There is not a provision on how the form is going to be filled out under the TIPC and the Regulation yet, on the forms provided by the TPTO it is stated that the forms should be filled electronically<sup>194</sup>. This is also in line with Article 184 of the TIPC. Pursuant to Article 184/4 of the TIPC, legal transactions and actions related to industrial property rights shall be made in a written form. After filling out the form electronically and printing it out, the later applicant (prospective trademark owner) must get an approval from the notary and then, submit the form to the TPTO along with the filled registration application form.

#### **F. Submission of Letters of Consent**

Pursuant to Article 10/3 of the Implementation Regulation, the form of letter of consent may be submitted to the TPTO together with the form of registration application in order to accelerate the examination process before the TPTO<sup>195</sup>. Since letters of consent are presented for the purpose of registration, it may be presented from the date of application until the initial decision of the TPTO regarding the registration of trademark in question.

In the event of an objection against the refusal decision of the TPTO for registration, forms of letter of consent may also be submitted at the appeal stage, until the TPTO makes its final decision with respect to the objection<sup>196</sup>. Similarly, in case of an objection from third parties against registered trademarks based on Article 5/1(ç) of the TIPC, the later trademark proprietor may still present the letter of consent obtained from the earlier trademark proprietor to refute the objection. It is controversial whether

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<sup>194</sup> **Gün**, p. 105.

<sup>195</sup> *ibid.* , p.107.

<sup>196</sup> Implementation Regulation, Article 10/3.

a letter of consent can be presented after the final decision of the TPTO for the registration of later trademark<sup>197</sup>.

The form of the letter of consent must be submitted properly in order to be enforceable before the TPTO. Therefore, despite a consent request, if the later trademark proprietor omits to submit the form of letter of consent duly and properly, the consent request will be deemed not to have been made.

### **G. Irrevocability of Letters of Consent**

According to the WIPO's analysis on the practice of letters of consent across the WIPO Member States in the majority of 58 Member States, it is not possible to revoke a letter of consent after a trademark was granted on that basis<sup>198</sup>. Turkey also adopts the same approach. According to Article 10/5 of the Implementation Regulation, due to its unconditional nature, once it is given, the consent cannot be revoked or withdrawn by the earlier trademark proprietor in any circumstance. No grace period is prescribed for the revocation of consent, therefore it could be said that once the letter of consent is submitted to the TPTO, the earlier trademark proprietor cannot revoke or withdraw the consent and interfere in the entitlements of later registered trademark<sup>199</sup>.

Here, one might question what happens to the letter of consent in the event that the circumstances, which formed the letter of consent changes at a later stage for the

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<sup>197</sup> **Gün**, p.114: "The letter of consent cannot be submitted after the refusal decision of the TPTO"; For the opposing view see: **Güneş**, İlhami, "6769 sayılı Mülkiyet Hukuku Işığında Uygulamalı Marka Hukuku", Adalet Yayınları, June 2018, p. 64: "The letter of consent may be submitted after the refusal decision of the TPTO".

<sup>198</sup> **WIPO**, "Summary", p. 17.

<sup>199</sup> **Arkan**, "SMK'nın 5.3. Maddesi", p. 9; **Gün**, p. 117.

earlier trademark proprietor. There might be number of changing circumstances in commercial life<sup>200</sup>. Neither the TIPC nor the Regulation makes an exception to the irrevocability of the letter of consent. Hence, it could be said that in spite of any changing circumstances, the letter of consent cannot be revoked. The main reason behind this issue is the fact that the registration of later mark gives birth to an independent protected trademark. With the letter of consent, the earlier trademark proprietor trademark does not share the ownership on that mark and enables another person to be trademark proprietor<sup>201</sup>. In this respect, the earlier proprietor has to bear the risk of changing circumstances under the letter of consent, while giving its consent<sup>202</sup>.

#### **H. Impacts and Consequences of Letters of Consent**

With the submission of letters of consent, the later trademark application will not be refused by the TPTO based on Article 5/1(ç) and identical or indistinguishably similar trademark will be registered and protected in accordance with Article 7 of the TIPC. Registration of the later consented mark grants the later trademark proprietor, all rights conferred to a registered trademark under Article 7 of the TIPC. In other words, the later trademark proprietor will have an absolute and independent trademark right, which fully embodies all of the rights and authorities provided for a registered

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<sup>200</sup> See **Gün**, p. 120: “The earlier registered trademark may turn into a well-known trademark etc.”

<sup>201</sup> *ibid.* , p. 121; also see *Chapter One, III-B for the differences of co-existence from other similar institutions.*

<sup>202</sup> *ibid.*

trademark for the time period of protection<sup>203</sup>. On the other hand, the earlier trademark proprietor's rights will be limited. With the given consent the earlier trademark proprietor waives the rights to objection and file a lawsuit against the later registered trademark<sup>204</sup>. However, this does not mean the abandonment of the intellectual property rights arising from the prior registry. The earlier trademark owner cannot use his exclusive rights arising from the earlier registered trademark against the later registered trademark proprietor<sup>205</sup>.

As mentioned at the beginning of this work, the most important impact and consequence of letters of consent is the co-existence of “*identical or indistinguishably similar trademarks on identical or similar goods or services*”, despite the principle of specialty of trademark<sup>206</sup>. Letters of consent have started to be used by many registered trademark proprietors<sup>207</sup>. For instance, the Ferrero SPA, the earlier trademark proprietor of “Kinder” trademark, which has been registered for Class 30 on chocolate, issued a

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<sup>203</sup> Considering that the trademark right is a property right and thus an absolute right which would be enforced against anybody, see Chapter One, I. ; for the parallel view see **Gün**, p.103-104; **Kılıç**, p. 81.

<sup>204</sup> **Arkan**, “SMK'nın 5.3. Maddesi”, p. 9.

<sup>205</sup> **Kılıç**, p. 91.

<sup>206</sup> *See above, Chapter One, II.*

<sup>207</sup> For further examples of the registered trademarks upon letters of consent see: **Akın**, Elif Betül, “SMK Kapsamında Muvafakat Kavramı ve Uygulamadaki Yansımaları”, available at

[http://docs.wixstatic.com/ugd/dd2a5f\\_5d621fee5e7f497f862bf9fc55b7c06b.pdf](http://docs.wixstatic.com/ugd/dd2a5f_5d621fee5e7f497f862bf9fc55b7c06b.pdf),

accessed on 20.02.2020.

letter of consent for the registration of Kinder Choco Cereals owned by the Somertac SA in Class 30<sup>208</sup>.

Under letters of consent, earlier trademark proprietors simply give consent to the registration of “*identical or indistinguishably similar trademarks*” unconditionally and cannot envisage any conditions in relation to the co-existence of such trademarks in the post-registration stage. It must be borne in mind that the earlier trademark proprietors and the later trademark proprietor may want to regulate the co-existence relationship among each other by envisaging terms and conditions in relation to the use of their trademarks after registration. As mentioned above, due to the unconditional nature of letters of consent, parties cannot envisage any conditions in relation to the co-existence relationship under letters of consent. In addition to that, the earlier trademark proprietor may prefer to grant letter of consent in exchange for a fee or any other benefit promise by the prospective later trademark proprietor. In practice, in order to envisage terms and conditions in relation to the consent and co-existence relationship, parties conclude a private agreement among each other, which will be analysed in detail below.

### **III. Private Agreements in Relation to Letter of Consent**

#### **A. Private Agreements in Relation to Letter of Consent in General**

As mentioned earlier, letters of consent enable the registration of “*identical or indistinguishably similar signs on identical or similar goods or services*” despite the absolute refusal ground for registration dealt under Article 5/1(ç) of the TIPC<sup>209</sup>. Such agreements differ from the aforementioned institutions such as licensing and the

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<sup>208</sup> *ibid.*, p. 18-19.

<sup>209</sup> TIPC, Article 5/3.



assignment of trademark<sup>210</sup>. Letter of consent is an unconditional unilateral agreement, which is subject to a strict form and scope under the TIPC<sup>211</sup>. Letters of consent have to be unequivocal and unconditional in order to meet the statutory requirements under the TIPC and to be accepted and enforced before the TPTO<sup>212</sup>.

The earlier trademark proprietor who gives the consent cannot envisage conditions or any corresponding considerations for the later applicant such as “payment of a fee in exchange for the grant of consent” under the letter of consent. However, one must bear in mind that, majority of the earlier trademark proprietors might not want to give consent to the registration of identical or indistinguishably similar trademark in exchange for nothing.

In addition to that, after being submitted to the TPTO and enabling the registration of the later identical or indistinguishably similar trademark, the letter of consent fulfils its task. The earlier trademark proprietor cannot revoke or withdraw the consent, once it is given<sup>213</sup>. It is undesirable for the earlier trademark proprietor to enable someone else to register identical or indistinguishably trademark without being subject to any conditions that would protect the future value of the trademark against any adverse effects caused by the later trademark proprietor<sup>214</sup>. Therefore, the post-

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<sup>210</sup> *See above, Chapter One, III.*

<sup>211</sup> *See above, Chapter Two, I.*

<sup>212</sup> TIPC, Article 5/3; Implementation Regulation, Article 10/5.

<sup>213</sup> Implementation Regulation, Article 10/4.

<sup>214</sup> **Gün**, p. 128: “The private agreements in relation to the letter of consent are not only essential for the independent persons and enterprises, but also important for the group companies in which the holding company gives a letter of consent to the subsidiary companies.”

registration stage is also crucial for the earlier trademark proprietor in terms of usage of identical or similar trademarks in the future.

It is assumed that, in addition to letters of consent, the parties may conclude a private agreement among each other that incorporate various conditions and sanctions in relation to the consent and the co-existence relationship<sup>215</sup>. When the above-mentioned consequences of letters of consent are taken into consideration, it would be advantageous particularly for the earlier trademark proprietor to conclude an up-front agreement with the applicant in relation to the grant of letter of consent and the co-existence of trademarks. It is not mandatory for the parties to conclude such a private agreement for the registration of later identical or indistinguishably similar signs under Turkish law<sup>216</sup>. What law requires for registration, is the letter of consent issued by the earlier proprietor under Article 5/3 of the TIPC in order to enable the registration and co-existence of “*identical or indistinguishably similar trademarks*”. However, it would be advisable for parties to conclude a private agreement prior to the issuance of letter of consent in order to regulate the relationship among each other and set forth conditions and corresponding considerations “such as payment of a fee” or “transfer of a share” in exchange for the grant of a letter of consent.

In this sense, if parties wish to add further rights, obligations or duties with respect to the consent and co-existence relationship, they can do so by concluding a

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<sup>215</sup> **Akın**, Elif Betül, “Sınai Mülkiyet Kanunu’nda Marka Tescil Süreçlerine İlişkin Düzenlemeler ve Yenilikler”, 6769 sayılı Sınai Mülkiyet Kanunu Sempozyumu, 9-10 Mart 2017, Editör Feyzan Hayal Şehirli Çelik, Banka ve Ticaret Hukuku Araştırma Enstitüsü, Ankara 2017, p.183. (**Akın**, “*SMK’da Marka Tescil Süreçlerine İlişkin Düzenlemeler ve Yenilikler*”).

<sup>216</sup> **Gün**, p. 128.

parallel private agreement among each other as a basis for the grant of a letter of consent. Such agreement may only be in relation to the commitment to letters of consent or a broader agreement under which conditions and terms in relation to the co-existence of trademarks are provided.

### **B. Legal Nature of the Private Agreements in Relation to Letter of Consent**

Private agreements in relation to letter of consent are concluded between more than one person, namely between the earlier trademark proprietor and the applicant on a contractual bargain over the grant of letter of consent. Therefore they have a bilateral nature as opposed to the letter of consent, which has a unilateral nature<sup>217</sup>.

The TIPC does not prevent or limit the earlier trademark proprietor and the later applicant to enter into any private agreements in relation to the letter of consent and co-existence of trademarks after registration<sup>218</sup>. Therefore, under Turkish trademark law, there is no obstacle for parties to regulate their relationship with a private agreement as long as they are in compliance with the general principles of the TCO<sup>219</sup>. However, the TPTO is not bound with any provisions of such agreements<sup>220</sup>. The reason for that is, neither of these types of agreements are identified nor recognized under the TIPC.

Such agreements are not identified under the TCO as well. Therefore they can be referred as innominate *sui generis* contracts, which are concluded voluntarily among

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<sup>217</sup> See above, Chapter Two, II-B.

<sup>218</sup> Kılıç, p. 78.

<sup>219</sup> See TCO, Article 27: The scope of contracts must be in compliance with the compulsory legal rules and must not be contrary to the public order, general rules of ethics and personal rights.

<sup>220</sup> Gün, p. 129.

parties<sup>221</sup>. Since there are no rules with respect to such contracts, they are entered into and assessed in light of the general rules of the TCO for the contracts. According to the TCO, private agreements concluded between more than one person will be subject to the principle of freedom of contract<sup>222</sup>.

### C. Types of the Private Agreements in Relation to Letter of Consent

Private agreements in relation to letter of consent are drafted in accordance with the principle of freedom of contract. The principle of freedom of contract refers to the freedom of the parties to freely set up an agreement and determine the terms and conditions of it freely<sup>223</sup>. In this regard, the private agreements may have different scopes, duration, terms and conditions<sup>224</sup>. Therefore, the scope of such agreements may vary according to the expectations of the parties<sup>225</sup>. For instance, a private agreement in

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<sup>221</sup> **Oğuz**, S., p. 50; **Elsmore**, “Trademark Co-Existence Agreements”, p. 9: For further information in relation to “ the *Sui Generis Contracts* ” see **Tandoğan**, Haluk, “Özel Borç İlişkileri”, İstanbul, Vedat Kitapçılık, 6. Basım, 2008, p. 13: “*The sui generis contracts do not embody the elements of the innominate contracts identified by the law neither wholly nor partially*”.

<sup>222</sup> TCO, Article 26: “*Parties of a contract may freely determine the scope of a contract in light of the principle of freedom of contract*”.

<sup>223</sup> **Kılıçoğlu**, p. 78-82: “*The principle of freedom of contract embodies the freedom to set up an agreement, freedom to determine the type, scope and terms and conditions of the agreement, freedom to choose the other party of the agreement, freedom to amend or terminate the existing agreement and the freedom of form.*”; **Oğuzman & Öz**, p. 141.

<sup>224</sup> **Gün**, p. 51.

<sup>225</sup> **Wilkof**, p. 269.

relation to the letter of consent may only be in relation to the grant of letter of consent in exchange for a corresponding consideration such as payment of a fee or transfer of a share<sup>226</sup>.

Alternatively, the agreement may have a broader scope and be in relation to the grant of letter of consent and use of “*identical or indistinguishably similar trademarks on identical or similar goods or services*” after registration<sup>227</sup>. In practice, the latter is generally named as the trademark co-existence agreements<sup>228</sup>. Generally, under trademark co-existence agreements parties reciprocally agree to recognize their identical or similar trademarks and enable peacefully co-exist without creating a likelihood of confusion<sup>229</sup>. Under such agreement parties envisage conditions in relation to the use of their trademarks, agree not to bring any opposition or invalidation claims against each other’s trademarks.

In order to enable the registration of “*identical or indistinguishably similar trademarks*” in Turkey, under such an agreement parties must envisage an obligation for the earlier trademark proprietor to issue a letter of consent within the means of Article 5/3 of the TIPC. As mentioned several times in this work, the TPTO is not

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<sup>226</sup> **Gün**, p. 56 & p. 128: “Such agreements are neither letters of consent nor trademark co-existence agreements”; **Kılıç**, p. 89.

<sup>227</sup> **Kılıç**, p. 88-89.

<sup>228</sup> Under this work “*Private Agreements in Relation to the Letter of Consent*” covers any type of agreements, including but not limited to the trademark co-existence agreements, that envisage an obligation for the earlier trademark proprietor to grant a letter of consent for the registration of identical or indistinguishably similar trademark on identical or similar goods or services.

<sup>229</sup> **Gün**, p. 71.

bound with such private agreements, therefore in order to enable the registration and co-existence of “*identical or indistinguishably similar trademarks*” the earlier trademark proprietor of trademark must issue a letter of consent. Otherwise, such trademarks cannot be registered and co-exist due to the absolute ground for refusal of registration dealt under Article 5/1(ç) of the TIPC.

#### **D. Scope of the Private Agreements in Relation to Letter of Consent**

The private agreements in relation to letter of consent require the earlier trademark proprietor to issue a letter of consent in accordance with the TIPC, for the registration of later “*identical or indistinguishably similar mark*”<sup>230</sup>. Essentially, under this contract, the earlier trademark proprietor agrees to issue letter of consent and in return, the owner of the later “*identical or indistinguishably similar mark*” usually agrees to pay a specified amount in exchange for the given consent<sup>231</sup>. In case the agreement is only in relation to the grant of the letter of consent in exchange for a corresponding consideration, then it is simply a private agreement in relation to the letter of consent. In lieu of such an agreement, the later applicant or the agent acting on behalf of the applicant, may request the earlier trademark proprietor to fulfil its essential obligation to issue a letter of consent.

As mentioned above, with respect to the principle of freedom of contract, the scope of contract may be broadened as parties wish. In practice, usually such agreements also regulate the co-existence of trademarks after the registration. Trademark co-existence agreements usually envisage conditions with respect to the use of trademarks. Since the letter of consent is unconditional and irrevocable, the earlier

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<sup>230</sup> **Gün**, p. 128.

<sup>231</sup> *ibid.* ; **Kılıç**, p. 89.

trademark proprietor can only set forth conditions under a private agreement, which has been mutually concluded between the earlier trademark proprietor and the later applicant. Under the trademark co-existence agreements parties may set forth conditions in relation to the use of later identical or indistinguishably trademark<sup>232</sup>. Such conditions may be with respect to the scope of the goods and services. For instance, the use of the trademark on certain goods or services may be limited under the trademark co-existence agreements. Besides, parties may envisage conditions with respect to the geographical scope or the manner of use of the trademark<sup>233</sup>. In addition to that, under such an agreement, parties may also agree on not competing with each other<sup>234</sup>.

Private agreements in relation to letter of consent (including trademark co-existence agreements) may be concluded either between independent persons or enterprises or dependent ones including the companies under the same ownership structure<sup>235</sup>. In each occasion, the undertaking to grant letter of consent must be borne by the registered proprietor of the earlier trademark who is going to consent the registration of identical or indistinguishably similar later sign.

#### **E. Form of the Private Agreements in Relation to Letter of Consent**

Unless otherwise is specifically stated, a private agreement in relation to the letter of consent is not subject to a mandatory form pursuant to Article 12 of the TCO. However, according to Article 148/4 of the TIPC, legal transactions in relation to

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<sup>232</sup> Moss, p. 209.

<sup>233</sup> Oğuz, S., p. 77-78; INTA, “Glossary”, available at <https://www.inta.org/TrademarkBasics/Pages/glossary.aspx>, accessed 23.11.2019.

<sup>234</sup> For further information see Kılıç, p. 90-91.

<sup>235</sup> Gün, p. 128.

industrial property rights are subject to a written form. With respect to the form of private agreements, here one must differentiate the types of private agreements in relation to letter of consent from each other.

In case there is an agreement, which is solely in relation to the grant of letter of consent, it could be said that such agreement will be subject to Article 12 of the TCO. Although the letter of consent is a legal transaction in relation to industrial property rights, the commitment to grant a letter of consent is not a direct legal transaction in relation to industrial property rights<sup>236</sup>. With respect to this, private agreements solely in relation to letter of consent are not subject to a written form set out under Article 148 of the TIPC. However, in case such agreement is concluded in a written form, it can be considered as evidence in terms of the relationship among the parties.

In case of trademark co-existence agreements, which envisage terms and conditions in relation to the co-existence of trademarks in addition to the obligation to grant a letter of consent the form of the agreement will be subject to Article 148 of the TIPC. Trademark co-existence agreements are concluded between more than one person on a contractual bargain over trademark rights<sup>237</sup>. As mentioned earlier, essentially under the trademark co-existence agreements parties agree to co-exist peacefully without causing likelihood of confusion<sup>238</sup>. Therefore the essential commitment under such agreement is to “co-exist with identical or similar trademark on identical or similar goods or services”. It could be said that such agreement is directly in relation to industrial property rights themselves, as opposed to an agreement solely provides the commitment to grant a letter of consent. Therefore, such agreements should be made in

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<sup>236</sup> **Gün**, p. 129.

<sup>237</sup> **Elsmore**, “Trademark Co-Existence Agreements”, p. 9.

<sup>238</sup> *See above, Chapter Two, II-A.*



written form, as Article 148 requires the agreements in relation to the industrial property rights to be made in written form stated thereunder<sup>239</sup>. We are of the view that the trademark co-existence agreements are not subject to the written form envisaged under Article 148. As mentioned earlier, such agreements are not within the scope of the TIPC and thus, they cannot be brought before the specialized courts for intellectual and industrial property rights, when there is a dispute<sup>240</sup>. In this sense, it would be subject to the rules under TCO and the principle of freedom of form<sup>241</sup>. Therefore, it is not necessary for the parties to conclude the agreement in a written form yet it would be advantageous for them to do so in order to use the agreement as a proof of parties' obligations, in the event of disagreement or dispute.

#### **F. Enforceability of the Private Agreements in Relation to Letter of Consent**

Both trademark co-existence agreements and letters of consent serve for the same objective, which is to enable the co-existence of “*identical or indistinguishably similar trademarks on identical or similar goods or services*”. Nonetheless, not only their legal nature, impacts and consequences but also, their enforceability differ from each other.

In Turkey, within the scope of Article 5/3 of the TIPC, letter of consent is a tool to overcome an *ex officio* refusal of registration or an opposition of a relevant third party based on Article 5/1(ç) of the TIPC. Conversely, the private agreements in relation to the letter of consent cannot overcome a refusal based on Article 5/1(ç) and enable the

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<sup>239</sup> See **Gün**, p. 129.

<sup>240</sup> *See supranote no. 188.*

<sup>241</sup> **Kılıçoğlu**, p. 78; **Oğuzman & Öz**, p. 141.

registration of identical or similar trademarks in Turkey<sup>242</sup>. Therefore, unless the earlier trademark proprietor submits a letter of consent in accordance with the rules of the TIPC and the Implementation Regulation, private agreements in relation to the letter of consent cannot be enforced before the TPTO.

With the letter of consent the later applicant may request the registration of “*identical or indistinguishably similar trademark*” whereas with a private agreement in relation to letter of consent, the applicant cannot make such claim before the TPTO. The TPTO is not bound with such agreements<sup>243</sup>. In addition to that, since the private agreements have a relative nature, the parties can only make claims against each other. Therefore, in case of a breach of such private agreements, parties may sue each other in terms of breach of contract under the rules of the TCO since the TPTO cannot enforce its authorities against breach of private agreements<sup>244</sup>.

Under the private agreements in relation to letter of consent there are two essential obligations. The earlier trademark proprietor commits to grant a letter of consent and in exchange for that, the applicant generally commits to make a payment<sup>245</sup>. Under the trademark co-existence agreements, in addition to these obligations parties may provide conditions with respect to the use of the trademarks.

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<sup>242</sup> **Gün**, p. 72; Under trademark co-existence agreements, the earlier registered proprietor of trademark might agree to acquiesce to the use of a later trademark for five consecutive years in order to enable it to be registered in accordance with Article 25/6 of the TIPC.

<sup>243</sup> **Gün**, p. 129.

<sup>244</sup> See TCO, Article 125 & Article 126.

<sup>245</sup> **Kılıç**, p. 89.

If the registered proprietor of the earlier trademark abstain from granting a letter of consent, in that case, the other party of the agreement, namely the later applicant, may seek rights and remedies arising from the contract through the provisions regarding the breach of contract under the TCO. Similarly, in case of non-fulfilment of the obligation, for instance non-payment of the specified amount, again the earlier proprietor who has given the consent, can only make claims in terms of the TCO. Since the letter of consent is irrevocable, the earlier trademark proprietor cannot revoke his consent or request the invalidation of the later registered trademark due to the breach of the private agreement in relation the letter of consent. In the event of breach of the conditions under the trademark co-existence agreement, again, such breach cannot be claimed before the TPTO<sup>246</sup>. For instance, in case of a breach of a condition in relation to the use of trademarks, parties cannot request the cancellation of the trademark from the TPTO<sup>247</sup>. In addition to that the earlier registered trademark proprietor cannot intervene in the licensing or assignment of the later registered identical or indistinguishably similar trademark<sup>248</sup>.

In order to secure themselves from the adverse effects of the breach, parties should underpin the private agreement with damages and panel clauses, in order to discourage parties to breach the contract and to be able to make any claims in lieu of such clauses<sup>249</sup>.

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<sup>246</sup> **Gün**, p.130.

<sup>247</sup> **Akın**, “SMK’da Marka Tescil Süreçlerine İlişkin Düzenlemeler ve Yenilikler”, p. 184.

<sup>248</sup> *ibid.*, p. 185.

<sup>249</sup> **Gün**, p.129.

## CHAPTER THREE

### LETTERS OF CONSENT IN THE EU AND THE CRITICAL ANALYSIS OF THE LETTER OF CONSENT PRACTICE IN TURKEY

#### I. Letters of Consent in the EU

##### A. Letters of Consent under the EU Trademark Directive

The letter of consent concept has been introduced in the EU initially with the Directive 2008/95/EC, which has been repealed and replaced by the EU Trademark Directive<sup>250</sup>.

Pursuant to Article 5/4 of the Directive 2008/95/EU in appropriate circumstances, under their national laws, the Member States may prevent the refusal or invalidation of a later trademark application if the earlier trademark proprietor consents to the registration of the later trademark<sup>251</sup>. This provision has been preserved yet slightly modified under the Directive 2015/2436 (EU Trademark Directive)<sup>252</sup>.

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<sup>250</sup> Directive 2008/95/EC to approximate the laws of the Member States relating to trademarks, 22.10.2008.

<sup>251</sup> Directive 2008/95/EC, Article 5/4: *“The Member States may permit that in appropriate circumstances registration need not be refused or the trademark need not be declared invalid where the proprietor of the earlier trademark or other earlier right consents to the registration of the later trademark.”*

<sup>252</sup> Both Directive 2008/95/EU and Directive 2015/2436 (EU Trademark Directive) aim harmonization with the Paris Convention since the Member States are bound with the provisions of the Paris Convention. In this sense, the provisions with respect to consent reflect Article 5 Section C-3 of the Paris Convention.: See the Preamble of the Directive 2008/95/EU & Directive 2015/2436; also see **Arkan**, “SMK’nın 5.3. Maddesi”, p. 8.

According to Article 5/4 of the Directive 2015/2436 (EU Trademark Directive), under their national laws, the Member States must ensure that there is no obligation to refuse or invalidate a later trademark application in case the earlier trademark proprietor gives consent to the registration of later trademark<sup>253</sup>.

Before assessing the old and new approach of the EU with respect to letters of consent, one must consider the aim of the EU Trademark Directive under the EU law. A directive in general is defined as a “*legislative act that sets out a goal that all EU countries must achieve*”.<sup>254</sup> Accordingly, the EU Trademark Directive aims to achieve a harmonization of the national trademark laws of the Member States in order to eliminate divergent practices across the EU that impede the effective operation of the European market for trademarks<sup>255</sup>. The EU Trademark Directive provides for number of substantive provisions some of which are mandatory to be transposed under the national trademark laws of the Member States. There are also non-compulsory provisions, which remain at the discretion of the Member States to transpose<sup>256</sup>.

When the language of the old Directive respect to letters of consent is considered, it could be said that the provision with respect to letters of consent, namely

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<sup>253</sup> Directive 2015/2436 (EU Trademark Directive), Article 5/5: “*The Member States shall ensure that in appropriate circumstances there is no obligation to refuse registration or to declare trademark invalid where the proprietor of the earlier trademark or other earlier right consents to the registration of the later trademark.*”

<sup>254</sup> **EUROPA**, “Regulations, Directives and other acts”, [https://europa.eu/european-union/eu-law/legal-acts\\_en](https://europa.eu/european-union/eu-law/legal-acts_en), accessed 03.02.20.

<sup>255</sup> **Maniatis**, Spyros, “Trade Marks in Europe: A Practical Jurisprudence”, Sweet & Maxwell, London, 2006, p.5.

<sup>256</sup> *ibid.*, p. 6.

Article 5/4, was a non-compulsory provision under the Directive 2008/95/EC. On the other hand, Article 5/5 of the Directive 2015/2436 has a mandatory nature since it uses the phrase of “*The Member States shall ensure (...)*” as opposed to the old Directive’s language that says, “*The Member States may prevent (...)*”. In light of this it could be said that, although it was up to the Member States to provide a mechanism that would prevent the refusal or invalidation of a later trademark application with the consent of the earlier trademark proprietor, with the Directive 2015/2436 such discretion has been lifted. As per Article 5/5 of the Directive 2015/2436 (hereinafter referred as the “EU Trademark Directive”), the Member States must recognize the consent of the earlier trademark proprietor for the registration of later trademark and ensure that there is no obligation for refusal or invalidation of a trademark application in case there is consent from the earlier trademark proprietor.

The most important characteristic of a directive is that it does not dictate the means of achieving the goals provided under the directives. The Member States may devise their national laws on how to achieve the goals<sup>257</sup>. In this sense, Member States may provide different details and means for the provision that they need to transpose into their national laws. As a result of this, the laws of the Member States may diverge.

In case of Article 5/5 of the EU Trademark Directive, it is mandatory for the Member States to ensure that there is no obligation to refuse or invalidate a trademark in case the earlier trademark proprietor or holder of other right “*consents to the registration of the later trademark*”<sup>258</sup>. Unless otherwise stated, since there is no

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<sup>257</sup> EUROPA, [https://europa.eu/european-union/eu-law/legal-acts\\_en](https://europa.eu/european-union/eu-law/legal-acts_en), accessed 03.02.20.

<sup>258</sup> According to another view, under Article 5/5 it is not mandatory for the Member States to transpose the consent mechanism into their national laws yet in case a Member

mandate with respect to the details of the provision, it is up to the Member States to determine on which circumstances and through what kind of instruments the consent can be given.

It is not clear under the EU Trademark Directive, on which circumstances consent for registration of later trademark can be given. Article 5/5 of the EU Trademark Directive envisages that it will be applicable in “*appropriate circumstances*”. What is meant by the “*appropriate circumstances*” is not identified under the EU Trademark Directive. Therefore, the determination of the appropriate circumstances may inevitably vary in each Member State. Therefore, it may be claimed that the appropriate circumstances may be determined in light of the national laws of each Member State<sup>259</sup>.

In addition to that, one might interpret “*appropriate circumstances*” in light of Article 5 of the EU Trademark Directive. As the provision regarding the consent has been provided as a part of Article 5, which deals with relative grounds for refusal or invalidity, one might claim that the appropriate circumstances may be determined among the circumstances, which are regarded as relative grounds for refusal under the Directive.

As opposed to the Turkish trademark law, under the EU law, refusal grounds for registration in relation to an earlier trademark are considered as relative refusal grounds, which can be enforced through the opposition proceeding. Therefore in general, the

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State transposes the consent mechanism into its national laws, the relevant Member State shall ensure that there is no obligation to refuse or invalidate a trademark application: See **Gün**, p. 135.

<sup>259</sup> **Gün**, p. 134.

consent exception may be provided in relation to the relative grounds for registration. Nevertheless, in some countries the consent can be provided in order to “overcome an *ex officio* refusal of a trademark registration based on an earlier registered trademark”<sup>260</sup>.

Similarly, it also not identified under the EU Trademark Directive through which instruments the consent may be given. The consent may be expressed through different means and may be named differently such as letters of consent, co-existence agreements or transactional agreements<sup>261</sup>.

### **B. Letters of Consent under the EU Trademark Regulation**

The EU Trademark Regulation governs the rules with respect to the EU trademark, which is protected across the EU<sup>262</sup>. Regulations are binding legislative acts of the EU, which are applied directly with its entirety<sup>263</sup>. Therefore, the rules under the EU Trademark Regulation are applicable for the EU trademarks without a need for transposition of such rules into the national laws of the Member States.

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<sup>260</sup> WIPO, “Summary”, p.25: “68% of the Member States enable letters of consent to overcome an *ex officio* refusal of a trademark registration based on an earlier trademark”; In Turkey the letter of consent is used as a tool to overcome an absolute ground for refusal of registration also *see above, Chapter Two*.

<sup>261</sup> WIPO, “Summary”, p.2: “Under this analysis the term of “letter of consent” is used to identify a written agreement of the holder of a prior registered trademark consenting to the registration of a later trademark.”

<sup>262</sup> EU Trademark Regulation, Preamble, para. 2.

<sup>263</sup> EUROPA, [https://europa.eu/european-union/eu-law/legal-acts\\_en](https://europa.eu/european-union/eu-law/legal-acts_en), accessed 03.02.20.



There is a different basis under the EU Trademark Regulation for the co-existence of EU trademarks from the one provided under the EU Trademark Directive. Pursuant to Article 60/3 of the EU Trademark Regulation, a trademark may not be invalidated in case the earlier trademark proprietor expressly consents to the registration of the later conflicting trademark before the invalidity action is brought<sup>264</sup>. Similar to the EU Trademark Directive, the consent exception provided under the EU Trademark Regulation is an exception to the relative ground for invalidity of trademarks.

Nevertheless, not every trademark co-existence agreements concerning the EU trademarks are enforceable<sup>265</sup>. In order to be enforceable these agreements must clearly incorporate the explicit consent of the earlier trademark proprietor<sup>266</sup>.

Previously, it was not clear under the EU Trademark Regulation, whether the trademark co-existence agreements are recognized during the opposition proceedings. Under EU Trademark Regulation there is not a consent exception for the opposition

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<sup>264</sup> EU Trademark Regulation, Article 60/3: “ *An EU trade mark may not be declared invalid where the proprietor of a right referred to in paragraph 1 or 2 consents expressly to the registration of the EU trade mark before submission of the application for a declaration of invalidity or the counterclaim.*”

<sup>265</sup> **Giannino**, Micheal, “A coexistence agreement concerning EU trade marks must include the explicit consent of the holder of earlier rights to the registration of the conflicting mark”, *Journal of Intellectual Property Law & Practice*; Volume 12, Issue 12; 1 December 2017, <https://doi.org/10.1093/jiplp/jpx175>, accessed on 12.02.2020, p.961.

<sup>266</sup> *ibid.*; *Agricola Italiana Alimentare Spa (AIA) v EUIPO*, T-389/16, EU: T:2017:492; 13 July 2017: The Court held that no express consent to the registration within the meaning of the EU Trademark Regulation could be found in the agreement.

proceedings. This has been a controversial issue before the OHIM and diverging decisions made by the OHIM<sup>267</sup>. According to OHIM in one opposition proceeding, since there is no legal basis to reject opposition under the EU Trademark Regulation, the consent agreements are not recognized in opposition proceedings. This meant that even if the earlier proprietor consented to the registration under an agreement, that party could still oppose to the registration of the later EU Trademark<sup>268</sup>. Yet, the OHIM has changed its approach with the *Omega Engineering v Omega SA*, and now the trademark co-existence agreements are relevant and enforceable in opposition proceedings<sup>269</sup>.

### **C. Harmonization of the Turkish Trademark Law with the EU Trademark Law**

In general, the TIPC has been enacted in accordance with the rules of the EU trademark law, in order to provide a more aligned trademark law with the EU trademark law<sup>270</sup>. In this sense, it could be said that the letter of consent practice has been adopted in Turkey upon the enactment under the EU Trademark Directive. Nevertheless, the enactment in Turkey in relation the consent bears significant differences.

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<sup>267</sup> See: **Ball**, Imke, “Law in Action: Trade Mark Coexistence Agreements and OHIM – Uneasy Bedfellows”, 2012, <http://scriptiesonline.uba.uva.nl/document/451652>, accessed on 12.02.20, p. 14-28.

<sup>268</sup> *ibid.*; See the example given thereunder OHIM, Opposition decision no. 2509-2001, 24 October 2001 (Gallo/Fratelli Gallo).

<sup>269</sup> **Cohen**, p. 682; *Omega Engineering Incorporated v Omega SA (Omega AG) (Omega Ltd)* 2010, EWHC 1211 (Ch), Chancery Division (England and Wales), 28 May 2010.

<sup>270</sup> **Bozbel**, p.13-15; **Çolak**, “Marka Hukuku”, 2018, p. 147.

As mentioned earlier, under Article 5/5 of the EU Trademark Directive there is no obligation to refuse or invalidate a trademark registration in the presence of the consent of the earlier trademark proprietor or the holder of other earlier right in relation to the registration of the later trademark. The consent of the earlier proprietor is recognized “*in appropriate circumstances*” as per Article 5/5. There is no clarification with respect to the appropriate circumstances under the EU Trademark Directive yet, it is provided as a part of the relative grounds for refusal of registration. In this context, one might claim that it has to be seen as an exception to those grounds<sup>271</sup>. In addition to that it is not expressly determined under the EU Trademark Directive, under which instrument the consent will be recognized.

Under Turkish trademark law, the letter of consent is used as a tool to overcome an *ex officio* refusal of a trademark registration based on “*the existence of identical or indistinguishably similar earlier trademark on identical or similar goods or services*”, which has been envisaged as an absolute refusal ground for refusal of registration under Article 5/1(ç) of the TIPC<sup>272</sup>. Therefore, as opposed to the EU Trademark Directive, the consent practice has been provided under the provision in relation to the absolute grounds for refusal of registration. Essentially, the absolute refusal ground provided under Article 5/1(ç) has been regarded as a relative refusal ground for registration under the EU Trademark Directive<sup>273</sup>. Nevertheless, in Turkey different from the EU law, “*the existence of an identical or indistinguishably similar trademark on identical or similar goods or services*” is seen as an absolute refusal ground for registration. On the other

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<sup>271</sup> See above, Chapter Three, I-A.

<sup>272</sup> TIPC, Article 5/3.

<sup>273</sup> See above Chapter One, II-B.

hand, in most of the jurisdictions in the EU, such ground is considered as a relative ground for refusal since it is not a ground related to the intrinsic nature of the mark<sup>274</sup>.

It is not clear under the TIPC whether letters of consent also overcome an opposition to a trademark registration or a request for invalidation or cancellation of a trademark registration<sup>275</sup>. There is not a provision in this regard under the TIPC.

In addition to that under Turkish trademark law, the consent presented to the TPTO needs to comply with the formal requirements. Bilateral private agreements in relation to letter of consent are not recognized before the TPTO. TPTO only recognizes letters of consent issued in accordance with the procedural rules provided under the TIPC and the Implementation Regulation<sup>276</sup>.

In relation to the parties of letters of consent, under Turkish trademark law it is clearly stated that only the consent given by the earlier trademark proprietor is recognized to overcome the refusal of registration. The EU Trademark Directive follows a different approach and enables the Member States to consider the consent given by the proprietors of other earlier rights<sup>277</sup>. Therefore, as opposed to the Turkish trademark law, not only the consent of the earlier trademark proprietors but also the consent of the

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<sup>274</sup> **Gün**, p. 41; also see **Davis**, p. 218 on the relative grounds for refusal of registration under the UK Trademark Act 1994.

<sup>275</sup> *See below, Chapter Three, II-B.*

<sup>276</sup> *See above, Chapter Two, II-B.*

<sup>277</sup> *See: EU Trademark Directive, Article 5/5:*

owners of other earlier industrial property rights may overcome a refusal of registration<sup>278</sup>.

## **II. Critical Analysis of the Letter of Consent Practice in Turkey**

### **A. Impact of Letters of Consent on Different Branches of Law**

Letters of consent enable the co-existence of “*identical or indistinguishably similar trademarks on identical or similar goods or services*” under Turkish trademark. In order to analyse the impact of the letter of consent practice on trademark law, one must consider the impact on consumer and competition, which are two branches of law strongly correlate with trademark law.

#### **1. Letters of Consent and Consumer Law**

In Turkey, consumers are protected through the Law No. 6502 relating to the Consumer Protection (“Law No.6502”)<sup>279</sup>. Pursuant to Article 62/1 of the Law No. 6502 it is not permitted to involve in unfair commercial practices that would hamper the consumers’ ability to make right decisions<sup>280</sup>. Unfair commercial practices consist

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<sup>278</sup> **Gün**, p. 284: As an example see the UK Trademark Act 1994, Section 5/5: “*Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.*” (It must be noted that although the UK has left the EU as of 31.01.20, the rules under the UK trademark law is still in line with the EU Trademark Directive.)

<sup>279</sup> Law No. 6502 on the Protection of Consumer, dated 07.11.2013, published in the Official Gazette dated 28.11.2013, numbered 28835.

<sup>280</sup> Law No. 6502, Article 62/1: “*(...) Unfair commercial practices targeting the consumer shall be forbidden.*” Translation available at:

practices, which would deceive the consumers in relation to the identity of manufacturer or service provider and the quality of good or service they provided<sup>281</sup>. In this sense, one must shed light into the matter of whether “*the co-existence of identical or indistinguishably similar trademarks on identical or similar goods or services through letters of consent*” may also deceive the consumers and contradict with the principles of consumer law<sup>282</sup>.

Essentially, similar to consumer law, trademark law also aims to protect the consumers<sup>283</sup>. The main function of the trademark is to enable the consumers to distinguish one good or service from the others through trademarks<sup>284</sup>. Thus, trademarks, which are deceitful, lack of any distinctive character or embodying a likelihood of confusion for the consumers may not be registered<sup>285</sup>. In addition to that consumer protection is also guaranteed by the principle of specialty of trademark. The principle of specialty of trademark adopted under the TIPC prevents any likelihood of confusion for the consumers by not allowing co-existence of identical or similar trademarks on identical or similar goods or services<sup>286</sup>. As per Article 5/1(ç) of the

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<http://www.judiciaryofturkey.gov.tr/Consumer-Protection-Law-is-available-on-our-website>, accessed 06.02.20.

<sup>281</sup> **Aslan**, İ. Yılmaz, “6502 sayılı Kanuna Göre Tüketici Hukuku”, 4.Basım, 2014, p. 88.

<sup>282</sup> **Oğuz**, S., p. 54.

<sup>283</sup> **Moss**, p. 199.

<sup>284</sup> *See above, Chapter One, I.*

<sup>285</sup> *See TIPC, Article 5 in relation to the absolute grounds for refusal of registration & Article 6 in relation to relative grounds for refusal of registration.*

<sup>286</sup> *See above Chapter One, I-B.*

TIPC, “*identical or indistinguishably similar trademarks on identical or similar goods or services*” shall not be registered. Such ground has been regarded as an absolute refusal ground for registration in relation to the public interest<sup>287</sup>. Nevertheless, in certain circumstances, despite the possibility of the likelihood of confusion and the protection of public interest, registration of similar trademarks on identical or similar goods or services is possible. With Article 5/3 of the TIPC, even it is possible to register “*identical or indistinguishably similar trademarks on identical or similar goods or services*”.

Letters of consent in trademark law enable “*identical or indistinguishably similar trademarks*” to be registered and co-exist simultaneously in the market<sup>288</sup>. Unless the consumers are not well informed in course of the co-existence of relevant trademarks, there is a risk of likelihood of confusion and deception for consumers<sup>289</sup>. In such a case, it would not be wrong to claim that the possibility of confusion for the consumers might reach to the greatest level, since the more similar the trademarks, the greater the potential for confusion will be<sup>290</sup>. This would obviously raise a question in terms of the welfare of consumers and the public interest<sup>291</sup>.

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<sup>287</sup> See above, Chapter One, II.

<sup>288</sup> See above, Chapter Two, I.

<sup>289</sup> Gün, p. 80.

<sup>290</sup> Moss, p. 221.

<sup>291</sup> Elsmore, “Trademark Co-Existence Agreements”, p.12; Nanayakkara, Tamara, “Independent Existence or Co-Existence of Identical or Similar Marks”, [https://www.wipo.int/export/sites/www/sme/en/documents/pdf/trademarks\\_identical.pdf](https://www.wipo.int/export/sites/www/sme/en/documents/pdf/trademarks_identical.pdf), accessed on 09.02.2020, p.1: On the other hand, the co-existence of trademarks may be a useful practice for protecting the brand image against the possibility of imitation.

It is a doubtful question whether the consumers who are deceived from the co-existence of trademarks can initiate invalidation proceedings against relevant identical or indistinguishably similar trademarks on the ground that it contradicts with the public benefit.

Under Article 5/3 of the TIPC, no reference is made in relation to “*the likelihood of confusion for consumers*”. According to Article 5/3 of the TIPC, as long as a letter of consent is submitted to the TPTO in accordance with the rules of the TIPC and the Implementation Regulation, the later mark will not be refused by the TPTO based on the absolute ground under Article 5/1(ç). The TPTO will not examine whether there is a likelihood of confusion or not. Thus, the presence of likelihood of confusion would not prevent the registration of identical or indistinguishably similar trademarks through the letter of consent as per Article 5/3<sup>292</sup>.

However, there is no obstacle for the consumers to initiate invalidation proceedings against the later registered trademark due to the breach of their interests in accordance with Article 25 of the TIPC. As per Article 25/2 of the TIPC, persons who

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Since trademarks are intangible assets, they might be easily used by the others or related with other goods or services by the consumers. In case of an unwanted use by third parties and wrong relation made by the consumers, the initial proprietor of the trademark may be harmed. By allowing other entities to benefit from the same or similar trademark on identical or similar goods or services, instead of leaving a chance for enterprises to duplicate the relevant goods or services and damage the brand’s image, the initial -real- trademark owner can economically protect his/her trademark and the consumers are also protected from risk of wrong relations.

<sup>292</sup> **Gün**, p. 122.



have interests may request the invalidation of trademark by the competent courts<sup>293</sup>. The phrase of “*persons who have interests*” should be interpreted broadly and the consumers should also be able to initiate invalidation proceedings<sup>294</sup>. Therefore in this sense, a trademark, which has been registered upon letter of consent, can be subject to the invalidation proceedings initiated by the consumers based on its contradiction with public interest. In case the co-existence of identical or similar trademarks would be against the public interest, the competent court should terminate the co-existence<sup>295</sup>.

Here one might claim that, invalidation of trademark right hampers the ownership rights of the earlier trademark proprietor and the later trademark right proprietor. Considering that trademark constitutes an ownership right, the proprietor of trademark can freely enjoy the ownership right and consent the registration of identical or indistinguishably similar trademarks despite the adverse effects on the public<sup>296</sup>. Although the trademark right is considered as an absolute ownership right under

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<sup>293</sup> **TIPC**, Article 25: “(1) *If one of the conditions mentioned under Articles 5 or 6 exist, invalidation of trademark shall be decided by the court. (2) Persons who have interests, public prosecutors or relevant public institutions and organizations may request the court to decide on the invalidity of trademark.*”, Translation available at: <https://www.turkpatent.gov.tr/TURKPATENT/resources/temp/4D59A7D3-A564-40A1-9C96-DB1E3D157E90.pdf;jsessionid=BDF39FA3EA1C89B51DB4D3386FC83621> , accessed on 07.02.20.

<sup>294</sup> **Tekinalp**, p. 475; **Yasaman & Altay & Ayoğlu & Yusufoglu & Yüksel**, p. 893.

<sup>295</sup> **Nanayakarra**, “IP and Business”, [https://www.wipo.int/wipo\\_magazine/en/2006/06/article\\_0007.html](https://www.wipo.int/wipo_magazine/en/2006/06/article_0007.html), accessed on 07.02.20.

<sup>296</sup> **Moss**, p. 197.

Turkish law, the ownership right can be limited in case it is in contradiction with the public interest as per Article 35 of the Constitution of Turkey<sup>297</sup>.

Therefore it could be said that the reliance on letters of consent without considering the welfare of consumers may violate the public interest and contradict with the essential purpose of the trademarks<sup>298</sup>. In this sense, the welfare of the customers should be considered under the TIPC.

## **2. Letters of Consent and Competition Law**

Co-existence of identical or indistinguishably similar trademarks may also have certain impacts on the competition. Especially, in case the earlier trademark proprietors and the later applicants (prospective later trademark proprietors) conclude trademark co-existence agreements prior to the issuance of the letter of consent in order to regulate the co-existence<sup>299</sup>. Trademark co-existence agreements might have an adverse effect on

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<sup>297</sup> See above, Chapter One, I; Constitution of Turkey, Article 35: “(1) Everyone has the right to own and inherit property. (2) These rights may be limited by the law only in view of public interest. (3) The exercise of the right to property shall not contravene public interest.”, Translation available at: <http://www.judiciaryofturkey.gov.tr/Current-version-of--Constitution-of-the-Republic-of-Turkey--including-latest--amendments> , accessed on 07.02.20.

<sup>298</sup> Oğuz, S., p. 55.

<sup>299</sup> Law No. 4054 on the Protection of Competition, dated 07.12.1994, published in the Official Gazette dated 13.12.1994, numbered 22140; See above, Chapter Two, II: Prior to the issuance of the letter of consent, parties may conclude a private agreement in relation to the grant of letter of consent. Such agreement may also incorporate terms and conditions with respect to the co-existence of trademarks and use of the trademarks

the competition in the market since it might incorporate restrictive conditions in relation to the use of trademarks in the market that would hamper the competition.

Law No. 4054 on the Protection of the Competition (“Law No.4054”) aims to protect the competition in market by preventing the practices and agreements of the undertakings that would distort and restrict the competition<sup>300</sup>. Essentially, trademark law also serves to the competition by enabling the consumers to distinguish the goods or services in the market and encouraging the manufacturers and service providers to increase the quality of their goods and services<sup>301</sup>. Nonetheless, a private agreement in relation to the trademarks might be in contradiction with the competition law<sup>302</sup>. Pursuant to Article 4/1 of the Law No. 4054, any agreements between undertakings, which would adversely affect the competition, will be regarded illegal<sup>303</sup>.

In competition law, agreements are grouped as horizontal and vertical agreements depending on their parties<sup>304</sup>. According to this classification, trademark co-

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during the co-existence. In that case such agreement is referred as the trademark co-existence agreement.

<sup>300</sup> Law No. 4054, Article 1: “*The objective of this Law is to prevent agreements, decisions and practices preventing, distorting or restricting competition in markets for goods and services (...)*”, Translation available at: <http://www.judiciaryofturkey.gov.tr/The-Law-on-the-Protection-of-Competition.>, accessed on 09.02.2020.

<sup>301</sup> **Thomsen**, p. 21.

<sup>302</sup> **Oğuz**, S., p. 91.

<sup>303</sup> Law No. 4054, Article 4/1.

<sup>304</sup> See: **Aslan**, İ. Yılmaz, “Rekabet Hukuku: Teori, Uygulama ve Mevzuat”, 4.Baskı, Bursa, 2007, p. 247: There are two types of agreements in competition law: vertical

existence agreements are considered as horizontal agreements<sup>305</sup>. For undertakings to involve in a practice breaching Article 4 of the Law No. 4054, there must be two or more undertakings, which are acting co-ordinately in such a way that their practice possibly restricts or aims to restrict the competition<sup>306</sup>. Under trademark co-existence agreements there are two or more parties who co-ordinately agree on the co-existence of trademarks in accordance with the pre-determined conditions for use<sup>307</sup>. Therefore, trademark co-existence agreements may be in contradiction with competition law if they adversely affect the competition in market<sup>308</sup>.

As mentioned earlier, as opposed to letters of consent, the trademark co-existence agreements may contain conditions in relation to the use of trademarks<sup>309</sup>. Such conditions may be in relation to the geographical scope of use or the scope of goods or services on which the trademarks will be used. This could be considered as a “*market partitioning*” in competition law and may have an adverse impact on the competition and breach Article 4 of the Law No. 4054<sup>310</sup>. According to the European Commission, trademark co-existence agreements also subject to an examination as per

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agreements and horizontal agreements. Vertical agreements are concluded between undertakings at different levels of the supply chain whereas horizontal agreements are concluded between undertakings at the same level of the supply chain. (*Aslan, “Rekabet Hukuku”*).

<sup>305</sup> **Thomsen**, p. 31.

<sup>306</sup> See: TIPC, Article 4.

<sup>307</sup> **Gün**, p. 83.

<sup>308</sup> **Moss**, p. 199; **Thomsen**, p. 36.

<sup>309</sup> *See above, Chapter Two, III.*

<sup>310</sup> **Thomsen**, p. 36; **Aslan**, “*Rekabet Hukuku*”, p. 237.

Article 101 of the TFEU<sup>311</sup>. Similarly, in principle trademark co-existence agreements in Turkey are also be subject to an examination in terms of the competition law. It would not be right to claim that all trademark co-existence agreements or conditions thereunder contradict with the competition law<sup>312</sup>. Hence, each trademark co-existence agreement has to be assessed separately in order to determine its impact on the competition<sup>313</sup>.

Nevertheless, in Turkey it is not easy to assess trademark co-existence agreements since they have a relative nature<sup>314</sup>. They are not submitted to the TPTO and not registered. It is also not possible in Turkey to enforce such agreements other than in a relative relationship<sup>315</sup>. As mentioned earlier, in order to enable the registration of identical or indistinguishably similar trademarks and the co-existence of such trademarks on identical or similar goods or services, a letter of consent is needed to be

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<sup>311</sup> TFEU, Article 101: *“The following shall be seen as incompatible with the internal market: all agreements between undertakings, decisions by associations of undertakings and concerted practices which may affect trade between Member States and which have as their object or effect the prevention, restriction or distortion of competition within the internal market, and in particular those which (...)”*, available at [https://eur-lex.europa.eu/eli/treaty/tfeu\\_2008/art\\_101/o](https://eur-lex.europa.eu/eli/treaty/tfeu_2008/art_101/o) , accessed on 09.02.2020.

<sup>312</sup> **Gün**, p. 87; **Thomsen**, p. 41; See Penney’s Trademark (78/193), 1978, 2 CMLR 100 available at <https://eur-lex.europa.eu/legal-content/FI/TXT/?uri=CELEX:31978D0193> accessed on 09.02.2020.

<sup>313</sup> **Oğuz**, S., p. 98.

<sup>314</sup> **Gün**, p. 86.

<sup>315</sup> *See above, Chapter Two, III.*

submitted to the TPTO. The letter of consent submitted to the TPTO has to be unequivocal and unconditional to be valid and enforceable.

Under the current trademark law of Turkey, it is not easy to track trademark co-existence agreements at the moment<sup>316</sup>. The background arrangements between the parties are not reflected under letters of consent. Thus, trademark co-existence agreements and the terms and conditions thereunder usually remain private among the parties of the agreement and it is hard for the Turkish Competition Authority to review such agreements and determine whether they adversely affect the competition or not<sup>317</sup>.

## **B. Problems under Article 5/3 of the TIPC in Relation to Letters of Consent**

The enactment under the TIPC in relation to letters of consent is a positive development yet may be criticised in light of various aspects<sup>318</sup>.

### **1. Ambiguity in Relation to the Grounds for Refusal of Registration and the Principle of Specialty of Trademark**

The existence of “*identical or indistinguishably similar trademarks on identical or similar goods or services*” has been regarded as an absolute refusal ground for registration of a trademark under the TIPC. The absolute refusal grounds for registration are in relation to the public interest<sup>319</sup>. In this case, normally, it should not be possible to overcome an absolute ground for refusal of registration and register the trademark since it would be against to the nature of the absolute grounds for refusal of registration,

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<sup>316</sup> **Gün**, p. 86.

<sup>317</sup> *ibid.*

<sup>318</sup> **Arkan**, “SMK’nın 5.3. Maddesi”, p. 9.

<sup>319</sup> **Arkan**, “Marka Hukuku”, p. 71; *See above, Chapter One, I.*

which is protecting the public interest<sup>320</sup>. However, such ground has been adopted in order to protect the rights of the earlier trademark proprietors<sup>321</sup>.

When the rationale of Article 5/1(ç) and the possibility to overcome the refusal through letters of consent is considered, it could be said that Article 5/1(ç) is a relative refusal ground of registration in its essence<sup>322</sup>. Under Article 5/5 of the EU Trademark Directive, such ground has been regarded a relative refusal ground as well. Therefore, regarding such ground as an absolute refusal ground for registration creates a divergence between the TIPC and the EU Trademark Directive<sup>323</sup>.

Another ambiguity in relation to the letter of consent practice is about the principle of specialty of trademark. Upon adoption of letters of consent under the TIPC, it was claimed that the principle of specialty of trademark is not present anymore in Turkish trademark law<sup>324</sup>. Nevertheless, Arkan thinks that the principle of specialty of trademark still exists and the co-existence of trademarks should be considered as an exception to this principle<sup>325</sup>. When Article 5 of the TIPC is considered, it is crystal

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<sup>320</sup> **Arkan**, “SMK’nın 5.3.Maddesi”, p. 9; **Ünsal**, Erol, “Muvafakat Mektubu (Letter of Consent) Üzerine Tescil Sorunu”, November 2011, <https://iprgezgini.org/2013/12/16/muvafakat-mektubu-letter-of-consent-uzerine-tescil-sorunu/>, published on 16.12.2013, accessed on 11.02.20. (**Ünsal**, “Muvafakat Mektubu Üzerine”)

<sup>321</sup> **Bozbel**, p. 13.

<sup>322</sup> **Arkan**, “SMK’nın 5.3. Maddesi”, p. 10.

<sup>323</sup> **Oğuz**, A. & **Özkan**, p. 41.

<sup>324</sup> **Suluk & Karasu & Nal**, p. 178.

<sup>325</sup> **Arkan**, “SMK’nın 5.3. Maddesi”, p. 10; This approach is also in line with the decision of Yargıtay; *see supranote no. 64*.

clear that under Turkish law, the principle of specialty of trademark still exists since the main rule is the absolute refusal of a later trademark application if there is an earlier identical or indistinguishably similar trademark. Therefore, in line with Arkan's thoughts co-existence of trademarks should be considered as exceptions to the principle of specialty of trademark owner.

## **2. Lack of Clarity in Relation to the Implementation of Letters of Consent**

It is not specifically determined under Article 5/3 that on what occasions the letter of consent can be given. Similarly under Article 5/5 of the EU Trademark Directive, it is stated that the refusal of registration may be overcome "*in appropriate circumstances*".

According to the rationale of Article 5/3, the intention of the later applicant and the earlier trademark proprietor to co-exist in the market is protected<sup>326</sup>. Especially, the ones who are affiliated to each other either economically or in other means may benefit from letters of consent. For instance in group companies, with the letter of consent issued by the holding company, the trademark, which has been registered on behalf of the holding company, may also be registered for the other companies within the group<sup>327</sup>.

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<sup>326</sup> **Bozbel**, p. 15.

<sup>327</sup> See *ibid* .: In such a case, the consumers may find a single addressee and there will not be a likelihood of confusion for the consumers. Such approach is also in line with Paris Convention, Article 5, Section C/3: "*Concurrent use of the same mark on identical or similar goods by industrial or commercial establishments considered as co-proprietors of the mark according to the provisions of the domestic law of the country where protection is claimed shall not prevent registration or diminish in any the*



In addition to that it is not clear whether Article 5/3 of the TIPC would be applicable in cases where the consumers are possibly deceived from the co-existence of trademarks through letters of consent. The letter of consent does not lift the likelihood of confusion between the earlier registered trademark and the later registered trademark based on the letter of consent<sup>328</sup>. The TPTO does not conduct an examination in relation to the likelihood of confusion while enforcing the letter of consent and registering the later identical or indistinguishably similar trademark. Considering the irrevocability of the letter of consent, in order to protect the consumers against any adverse consequences and possibility of confusion, for the registration of later identical or indistinguishably similar trademark “the absence of likelihood of confusion” should be one of the requirements<sup>329</sup>. In line with Paris Convention, Article 5, Section C/3, an addition to Article 5/3 saying that “*the later registration based on the letter of consent shall only be made as long as the public is not deceived*” should be made<sup>330</sup>.

Another lack of clarity in relation to the implementation of letters of consent is whether the letter of consent also overcomes the opposition based on Article 6/1 of the TIPC<sup>331</sup>. As mentioned earlier, Article 6/1 of the TIPC is a relative refusal ground for registration, which requires a smaller degree of similarity than the one required under Article 5/1 and the presence of a treat of likelihood of confusion to be applicable<sup>332</sup>.

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*protection granted to the said mark in any country of the Union, provided that such use does not result in misleading the public and is not contrary to the public interest”.*

<sup>328</sup> **Wilkof**, p. 255.

<sup>329</sup> **Gün**, p. 116.

<sup>330</sup> **Arkan**, “SMK’nın 5.3. Maddesi”, p. 11.

<sup>331</sup> See: **Gün**, p. 94-97.

<sup>332</sup> *See above, Chapter One, II.*

When there is not a likelihood of confusion between two trademarks, the trademark will not be refused by the TPTO as per Article 6/1. However, in case there is an identical or similar trademark on identical or similar goods or services and there is a likelihood of confusion between those trademarks, the later trademark applicant is under threat of refusal of registration in case there is an opposition made within this respect. Under the EU Trademark Directive, the scope of consent is broader than the one under the TIPC since it does not limit it to the “*identical or indistinguishably similar trademarks on identical or similar goods or services*” and also cover the circumstances stated under Article 6/1 of the TIPC<sup>333</sup>. On the other hand, Article 5/3 of the TIPC clearly envisages that a letter of consent will only prevent a refusal based on Article 5/1(ç)<sup>334</sup>. In case there is not a letter of consent, the TPTO will refuse the later trademark application. However, in case of a ground falls within the scope of Article 6/1, even if there is not a letter of consent, as long as there is no opposition, the trademark will not be refused by the TPTO. Accordingly, in such cases letters of consent cannot be given against an opposition made based on Article 6/1 of the TIPC. The registration can only be made upon non-opposition against the later trademark application, not through the letter of consent<sup>335</sup>.

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<sup>333</sup> **Gün**, p. 94: It must be also noted that both circumstances are seen as a relative ground for refusal of registration as opposed to the TIPC; *See above, Chapter One, II & Chapter Three, II-A.*

<sup>334</sup> Some authors are of the view that letters of consent should also prevent refusals based on Article 6/1; for further information see **Güneş**, p. 68; **Gün**, p. 96.

<sup>335</sup> **Gün**, p. 96.

In order to eliminate the opposition risk based on Article 6/1 of the TIPC, parties may settle and conclude a trademark co-existence agreement<sup>336</sup>. Under such an agreement the earlier trademark proprietor may promise not to oppose later trademark application for registration and enable the co-existence of trademarks.

Proprietor of a well-known trademark can give letter of consent for the registration of “*identical or indistinguishably similar trademark in relation to the identical or similar goods or services*” that the well-known trademark is registered for. It is also claimed that the letter of consent can be given in relation the unregistered goods or services for the well-known marks<sup>337</sup>. Nevertheless, as mentioned earlier, the letter of consent can only be given to overcome the refusal based on Article 5/1(ç) of the TIPC, by the earlier registered proprietor of trademark. Therefore letters of consent cannot overcome the grounds under Article 6/4 and Article 6/5 of the TIPC<sup>338</sup>.

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<sup>336</sup> *ibid.* ; p. 95: Such agreements have a relative nature. Therefore in case of breach of such agreements by one of the parties, the other party may seek remedies in terms of the TCO No. 4098; For different types of trademark co-existence agreements *see supranotes no. 118 & 119.*

<sup>337</sup> **Kılıç**, p. 89.

<sup>338</sup> **Gün**, p. 100: In such cases, parties may conclude a trademark co-existence agreement under which the proprietor of earlier well-known trademark holder agrees not to oppose the registration of later trademark based on Article 6/4 and Article 6/5 of the TIPC; TIPC, Article 6/4: “*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 the identical and similar goods or services.*”; TIPC, Article 6/5: “*A trademark application which is identical with, or similar to, an earlier registered trademark or application irrespective of whether the goods or*

### 3. Examination of the TPTO and the Lack of Protection for the Consumers

The letter of consent is submitted to the TPTO in order to overcome a refusal based on Article 5/1(ç) and initiate the administrative registration process of the later identical or indistinguishably similar trademark. The process before the TPTO is a controversial issue since, Article 5/3 of the TIPC does not enable an examination over letters of consent<sup>339</sup>. Upon the submission of the letter of consent, “*identical or indistinguishably similar trademarks on identical or similar goods or services*” will be registered by the TPTO, without an examination with respect to the likelihood of confusion for the consumers. It is undesirable to make the registration and enable the co-existence of trademarks without considering the public interest<sup>340</sup>.

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*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.”* Translation available at:

<https://www.turkpatent.gov.tr/TURKPATENT/resources/temp/4D59A7D3-A564-40A1-9C96-DB1E3D157E90.pdf;jsessionid=BDF39FA3EA1C89B51DB4D3386FC83621>, accessed on 10.02.20.

<sup>339</sup> **Gün**, p. 122.

<sup>340</sup> *See above, Chapter Three, II-A* for the impacts on the consumers; also see **Gün**, p. 121-127; **Wilkof**, p. 261; **Ünsal**, “Muvafakat Mektubu Üzerine”, <https://iprgezgini.org/2013/12/16/muvafakat-mektubu-letter-of-consent-uzerine-tescil-sorunu/>, accessed on 11.02.2020.

Although, under the official translation published on the website of the TPTO it is stated that in the event of submission of the letter of consent the later trademark application “*may not be refused*”, under the original Turkish text of the TIPC it is stated that the application “*shall not be refused*”<sup>341</sup>. When the original text is considered, the TPTO does not conduct an examination and register the trademark upon the submission of the letter of consent. The TPTO does not have discretion for the refusal of trademark.

When the possible impacts on the consumers and the likelihood of confusion that might be arose is considered, the TPTO should be able to examine whether the trademarks subject to letters of consent create a likelihood of confusion<sup>342</sup>. In this respect, Article 5/3 of the TIPC should be amended accordingly.

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<sup>341</sup> Here it may be argued that the English translation does not accurately reflect the meaning under the original text: See TIPC, Article 5/3: “A trademark application may not be refused according to subparagraph (ç) of the first paragraph if a notarial document indicating the clear consent of the prior trademark proprietor for the registration of the application is submitted to the Office (...)” English translation available at: <https://www.turkpatent.gov.tr/TURKPATENT/resources/temp/4D59A7D3-A564-40A1-9C96-DB1E3D157E90.pdf;jsessionid=BDF39FA3EA1C89B51DB4D3386FC83621>, accessed on 11.02.2020; Original Text in Turkish: “Bir marka başvurusu, önceki marka sahibinin başvurunun tesciline açıkça muvafakat ettiğini gösteren noter onaylı belgenin Kuruma sunulması hâlinde birinci fıkranın (ç) bendine göre reddedilemez (...)”.

<sup>342</sup> **Gün**, p. 121.

## CONCLUSION

This work has analysed the registration of “*identical or indistinguishably similar trademarks on identical or similar goods or services*” through letters of consent, despite the principle of specialty of trademark and the absolute refusal ground for registration in this regard. As it can be seen from the overall analysis, the voluntary co-existence of trademarks is possible in Turkey as of 2017, with the submission of a letter of consent to the TPTO, along with the later trademark application.

Letters of consent must include the clear and unconditional consent of the earlier proprietor of trademark. Letters of consent are irrevocable and once they are submitted, the earlier trademark proprietor cannot revoke the consent for registration. Therefore, letters of consent are not regarded as contracts but as unilateral legal documents that are issued by the earlier trademark proprietor and are used for the administrative process before the TPTO.

In practice, letters of consent are usually underpinned by bilateral private contracts concluded between the earlier trademark proprietor and the later applicant. Under such contracts, parties may envisage conditions in relation to the co-existence relationship and payment of a fee in exchange for the given consent. Although, such agreements and conditions thereunder are not enforceable before the TPTO, they seem practical and advantageous for the parties when it comes to regulating their relationship, since they are not able to do so under letters of consent.

Letters of consent are seen as a positive development as the co-existence of trademarks has been a need for trademark holders, especially for group companies. In addition to that, it is also parallel with the developments in the EU, which have already recognized the letter of consent concept under the EU Trademark Directive.

Nevertheless, under this work, it has been determined that there is still a lack of clarity in relation the implementation of letters of consent in Turkey. The provisions under the Turkish trademark law in relation to the refusal grounds for registration and letters of consent are not totally harmonized with the EU trademark aw. Such a divergence in Turkish trademark law also creates uncertainties and serious problems in terms of consumer law and competition law. In this sense, the letter of consent practice in Turkey needs some revisions in order to correlate with the public benefit and protection of the consumers and other players in the market.



## ABSTRACT

*This work analyses the co-existence of identical or indistinguishably similar trademarks through letters of consent in light of the Turkish Industrial Property Code No. 6769. The analysis starts with an overview of the protection of trademarks through registration, the refusal grounds for registration and the role of the principle of specialty of trademark. Then, it continues with the examination of the co-existence of identical or similar trademarks. Having explained the co-existence of trademarks in general, the analysis continues with a deeper examination of the co-existence of trademarks through letters of consent in Turkey. Letters of consent have been explained in detail, along with private agreements in relation to letter of consent, which would eventually trigger the implementation of letters of consent. The final part of the work focuses on letters of consent under the European Union trademark law by examining the harmonization of the Turkish trademark law. Additionally, the work sets out the criticism in the doctrine regarding letters of consent practice from different perspectives.*

**Key Words:** *Letter of Consent, Trademark Co-Existence Agreements, Principle of Specialty of Trademark, Absolute Grounds for Refusal of Registration, Relative Grounds for Refusal of Registration*



## ÖZET

*Bu çalışma, 6769 sayılı Sınai Mülkiyet Kanunu ışığında benzer veya ayırt edilemeyecek derecede benzer markaların muvafakatname vasıtasıyla birlikte var olma imkanını incelemektedir. Çalışma markaların tescil vasıtasıyla korunması, tescilin reddi nedenleri ve markanın tekliği ilkesinin genel olarak incelenmesiyle başlamaktadır. Daha sonrasında çalışma, aynı veya benzer markaların birlikte var olması kurumuna değinmektedir. Markaların birlikte var olmasına genel olarak değinildikten sonra, çalışma detaylı olarak markaların Türkiye’de muvafakatname aracılığıyla birlikte var olmalarını incelemektedir. Marka hukukunda muvafakatname, muvafakatname verilmesini tetikleyen ve muvafakatnameye ilişkin olarak taraflar arasında özel olarak düzenlenen anlaşma ile birlikte incelenmektedir. Çalışmanın son bölümü, Avrupa Birliği marka hukuku kapsamında muvafakat düzenlemesini ve Türk marka hukukunun söz konusu hükümler ile uyumluluğunu incelemektedir. Bununla birlikte çalışma muvafakatname uygulamasına ilişkin doktrindeki eleştirileri de farklı açılardan değerlendirmektedir.*

**Anahtar Kelimeler:** *Muvafakatname, Markaların Birlikte Var Olma Anlaşması, Markanın Tekliği İlkesi, Mutlak Red Nedenleri, Nispi Red Nedenleri*

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