



ISTANBUL MEDENİYET UNIVERSITY
INSTITUTE OF GRADUATE STUDIES
DEPARTMENT OF PRIVATE LAW

Protection of Well-Known Trademarks Against Dilution

Master's Thesis

Yasemin Nur Demirbuğa

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Supervisor

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STATEMENTS

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I hereby declare that all information in this dissertation has been obtained and presented in accordance with academic rules and ethical conduct. I also declare that, as required by these rules and conducts, I have fully cited and referenced all material and results that are not original to this work.

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GENİŞ ÖZET

Tanınmış Markaların Sulandırılmaya Karşı Korunması

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Danışman: Dr. Ekrem Solak

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Günümüzde bilhassa da küreselleşmenin ve teknolojik gelişmelerin de etkisi ile haksız ticari uygulamaların önüne geçebilmek için fikri ve sınai hakların korunması, özellikle de markaların uluslararası boyutta korunmasının oldukça önemli bir hale geldiği kabul edilmektedir. Zira bir sınai mülkiyet hakkı olan ticari markanın reklam yolu ile, zaman ve emek sarf edilerek tanınmış marka haline gelmesi ile tek başına marka değerinin o teşebbüse ait diğer tüm değerleri geride bıraktığı ve bu durumun piyasa üzerinde çok büyük etkileri olduğu bilinmektedir. Bu sebeple zaman geçtikçe bütün dünyada fikri mülkiyetten doğan hakların ve bilhassa marka ve patente ilişkin hakların korunmasına ilişkin olarak düzenlemelerin değişmeye başladığı ve bu düzenlemelerin kapsamının genişletildiği görülmektedir. Bu değişimlerden Türkiye de doğal olarak nasibini alarak marka korumasında tanınmış marka korumasına yer vermiş; yeni düzenlemeler ve yargı kararları ile söz konusu ihlallerin ne şekilde gerçekleşeceğine dair bir çerçeve oluşturmuştur. Ancak buna rağmen uluslararası anlaşmalar ile belli bir ortak global zeminde buluşulsa da tanınmış marka hakkından doğan ihlallere ilişkin bütün kavramlara mevzuatımızda henüz yer verilmemiş olup, yargı kararları ve doktrin üzerinden bu hususlara ilişkin tartışmalar devam etmektedir. Bununla beraber belirtmek gerekir ki özellikle tanınmış marka merkezinde marka hukuku değişime ayak uydurarak devamlı olarak gelişme göstermektedir, öyle ki markanın işlevleri ve markayı

oluşturabilecek işaretler bakımından temel kabuller bile yavaş yavaş değişmeye başlamaktadır. Nitekim, geleneksel olmayan hologram, hareket ve koku markalarının uluslararası düzlemde kabul edilmeye başlanması, görsel olarak ifade edilemeyen işaretlere karşı yaklaşımın Amerika Birleşik Devletleri öncü olmak üzere yumuşatılması, markanın temel amaç ve işlev zemininin kaynak göstermekten ziyade garanti, reklam, iletişim gibi marka sahibini de odak noktasına koyan unsurlara kayması buna yalnızca küçük örneklerdir. Bütün bu değişimler yatırım, reklamlar ve tanıtım gibi çeşitli yollara başvuruyla zaman içerisinde gösterilen çaba ile bir marka imajı oluşturdıkları göz önüne alındığında en çok da tanınmış markaları ve hak sahiplerinin menfaatlerini etkilemektedir. Markanın tek işlevi artık sadece menşei/kaynak göstergesi olmak olmadığından, tanınmış marka sahibinin çabalarıyla oluşan marka imajı nedeniyle reklam, iletişim ve yatırım işlevleri de tanınmış markalar açısından eşit derecede, hatta belki daha da önemli hale gelmiştir. Klasik bağlamdaki marka koruması ve tecavüz kabul edilen eylemler yalnızca karıştırılma ihtimali zeminindeki, yani mal ve hizmetin menşesine ilişkin karıştırma ihtimaline dayalı ihlallere ilişkin koruma sağlamakta olup, bu düzlemde asıl korunan menfaat marka sahibininkinden ziyade piyasanın ve tüketicinininki olmaktadır.

Tanınmış markalar daha fazla koruma gerektirmekte ve karıştırılma ihtimali bağlamında kabul edilen ihlal halleri, tanınmış markaların menfaatlerini tam olarak korumak için yeterli görülmemektedir. Tanınmış markanın sulandırılması ve “sulandırma” kavramı bu gelişmelerin bir sonucudur. Karıştırılma ihtimaline ve malların kaynağına/menşesine ilişkin karışıklığa dayanan geleneksel marka ihlalinin aksine, sulandırmaya karşı koruma, marka sahibinin yatırım işlevini ve çabalarını kapsar. Sulandırmaya karşı koruma, tanınmış markalara tanınan korumanın kapsamını genişletir ve karıştırma olmasa bile markanın itibarını ve ayırt edici karakterini zarar görmekten korur. Bütün bu unsurlar da göz önüne alınarak klasik marka korumasının bilhassa tanınmış markalar bakımından yetersiz olduğunun artık kabul edilmesi ile, Avrupa’da içtihat hukuku ile doğup; asıl olarak Amerika Birleşik Devletleri’nde hukuki temellerini bulup geliştirilerek markanın sulandırılması kavramı hayatımıza girmiştir. Türk marka hukukunda

da Avrupa Birliđi örnekleri izlenerek sulandırmaya karşı korumaya mevzuatımızda nisbi red sebepleri bağlamında yer verilmiş olsa da açıkça “sulandırma” terimine mevzuatta yer verilmemiştir.

Karıştırılma ihtimali esas alınarak belirlenen geleneksel marka ihlalinin aksine sulandırmaya karşı korumada tüketici nezdinde karıştırılma ihtimali aranmamaktadır. Karıştırılma ihtimalinde, en basit hali ile açıklar isek, hitap edilen tüketici kitlesinde belli bir mal ve hizmeti aldığı düşüncesi ile apayrı bir işletmeye ait aynı veya benzer mal ve hizmetlerini satın alma tehlikesiyle karşı karşıya kalması durumu inceleme altına alınır. Karıştırılmanın fiilen gerçekleşmesi veya gerçekleşmesi tehlikesi olması normal şartlar altında marka hakkına tecavüzün temel unsurlarından biri olarak kabul edilmektedir. Fakat sulandırma değerlendirmesinde, herhangi bir karıştırılma riski aranmaksızın, sonraki markanın kullanımı sonucunda önceki markanın ayırt edici karakterine veya itibarına herhangi bir zarar gelip gelmediđi, veya bu kullanım neticesinde zarar gelme ihtimali bulunup bulunmadıđı inceleme konusu yapılmaktadır. Bunlara ek olarak hem Türk hem de Avrupa Birliđi marka mevzuatında markanın ayırt edici karakterine veya itibarına zarar vererek oluşan sulandırmanın düzenlendiđi hükümlerde markanın itibarından haksız yararlanmaya da yer verilmektedir. Ancak, önceki markanın tanınmışlıđından haksız yarar sağlama Amerika Birleşik Devletleri mevzuatında sulandırmanın bir türü olarak kabul edilmemiş olup, söz konusu durumun teknik olarak bir sulandırma sayılıp sayılmayacağı konusunda doktrinde farklı görüşler bulunmaktadır. Zira tanınmış markanın tanınmışlıđından haksız avantaj sağlama durumunda sulandırma kabul edilen markanın ayırt edici karakterine zarar verme, bir diđer deyişle bulandırma ve markanın itibarına zarar verme, bir diđer deyişle “lekeleme” kavramının aksine, herhangi bir zararın oluşmuş olması veya oluşma riski aranmamaktadır. Önceki markaya verilen zarardan ziyade, asıl odak noktası sonraki markanın haksız bir şekilde elde ettiđi ya da elde edebileceđi avantaj olmaktadır. Nitekim klasik anlamda sulandırmada değerlendirilen zarar unsuru iken, “free riding”, yani haksız avantaj sağlamada değerlendirilen fayda unsuru olacaktır. Ancak bütün bu ihlal çeşitlerinin ortak noktalarının geleneksel marka korumasının kapsamını

tanınmış markalar bakımından genişletmesi, karıştırılma riskinin değerlendirmeye alınmaması ve söz konusu kullanım bakımından haklı bir sebebin bulunmamasının aranması olduğu görülecektir. Haklı bir sebebin bulunmaması istisnası hem Türk hem de Avrupa Birliği mevzuatında tanınmış markanın sulandırmaya karşı korunmasının düzenlendiği madde hükmünde yer almaktadır. Ancak ihlal oluşturan durumlara karşı öne sürülebilecek bu haklı sebebin ne olabileceğine ilişkin herhangi bir açıklamaya ne hükümde ne de mevzuatın geri kalanında yer verilmiştir. Bunun aksine, markanın sulandırılması kavramının bir nevi anavatanı sayılabilecek Amerika Birleşik Devletleri'nde, ABD Revizyon Kanunu içerisinde söz konusu ihlal hallerinin istisnasını oluşturan durumlar ayrı bir maddede kapsamlı olarak düzenlenmiştir. Bunlar yalın ve tasviri dürüst kullanım, yine dürüst kullanım kapsamı içerisinde parodi, yorum veya eleştiri içerikli kullanım, yine dürüst kullanım kapsamı içerisinde karşılaştırmalı reklamda kullanım, haber bildirimini ya da yorumunda kullanım ve ticari olmayan kullanım şeklinde söz konusu maddede örnek olarak sıralanmıştır. Söz konusu kullanım hallerinin hepsi, haklı sebep de dahil olmak üzere özel savunma sebepleri içerisinde yer almaktadır. Velhasıl ilgili savunma sebeplerinin hepsi tanınmış markanın sulandırılması kapsamındaki ihlal halleri bakımından öne sürülebilecektir. Bu savunma sebeplerinin bu kadar kapsamlı şekilde düzenlenmiş olması bir anlamda Amerika Birleşik Devletleri'nde Avrupa Birliği'ne göre sulandırma kapsamının içtihatla daha geniş olarak yorumlanmasından kaynaklı olabilmekle birlikte, bilhassa ifade özgürlüğü ve kamu yararı gibi daha hassasiyet gerektiren durumlar bakımından oldukça önemli ve özel bir hukuki güvence sağlamaktadır. Öte yandan mevzuatımızdaki haklı sebep bakımından her ne kadar içtihatlarla çeşitli kriterler belirtilmiş olsa da haklı sebep kavramının bir nebze daha soyut ve kapsamının kıyasen belirli olmadığı kabul edilmelidir. Bilhassa parodi, eleştiri ve yorum içerikli kullanım bakımından hem mevzuatımızda hem de yargı kararlarında ciddi bir boşluk bulunmaktadır. Her ne kadar eleştirel kullanım bakımından ihtilaflar yargı konusu yapılmış ise de söz konusu ihtilaflar tanınmış marka koruması, dolayısı ile sulandırma yolu ile ihlal halleri bakımından değerlendirilmemiştir. Dolayısı ile belirtilen haller

bakımından da özel bir yasal güvence sağlanması ve de haklı sebebin daha da kapsamlı bir şekilde somutlaştırılması hem toplumsal menfaat hem de ifade özgürlüğü bakımından faydalı olacaktır.

Tüm bunlar göz önüne alınarak, işbu tezde öncelikli amaç tanınmış marka hakkına yönelik ihlallerinden geleneksel anlamda karıştırılma ihtimaline dayanan marka hakkına tecavüz kısaca açıklanarak esas olarak markanın sulandırılması kavramının ABD’de, AB marka hukukunda ve Türk marka hukukunda ne şekilde sınıflandırıldığını ve uluslararası alanda bu durumun ihlallere karşı ne şekilde koruma sağladığını mukayeseli olarak inceleyerek ihlalin yalnızca karıştırılma ihtimali çerçevesinden çıkarak diğer yönlerinin ve de yeni kavramları inceleyerek Türk hukukunda içtihatla sulandırmanın ne şekilde ele alındığı incelenerek bununla beraber mevzuatta eksik olabilecek noktaları ortaya koymaktır.

İşbu amaç ile aşağıda kısaca sıralanan konu başlıkları incelenmiştir. Öncelikle ilk bölümde marka tanımı ve genel olarak marka kavramı, marka olabilecek işaretler, markayı oluşturan elementler ve ayırt edilebilirlik konsepti ve kriterleri, kaynak gösterme, garanti, reklam, yatırım ve iletişim olmak üzere markanın fonksiyonları, buna ilişkin çeşitli görüşler ve örnekler, tanınmış marka kavramı, tanınmış markaya ilişkin Paris Konvansiyonu, TRIPS Anlaşması, Dünya Fikri Mülkiyet Örgütü ve de Türk Patent ve Marka Kurumuna göre ayrı ayrı değerlendirilmek üzere her birinin kriterleri, tanınmış marka kavramına ilişkin tarihsel olarak Türk hukukundaki düzenlemeler ve bu düzenlemeler ışığında koruma kapsamına yer verilmiştir. Daha sonra tanınmış marka bağlamında “sulandırma” kavramı tarihsel bağlamda kısaca açıklanmış ve de sulandırmanın türleri izah edilmiştir. Bu bağlamda sulandırmanın türü olan bulandırma ve lekeleme kavramları; yani markanın itibarına zarar verme, söz konusu markanın ayırt edici karakterini zedeleme konuları anlatılarak Türk ve AB marka hukukunda sulandırma halleri ile birlikte değerlendirilen tanınmış markanın tanınırlığından haksız yarar sağlama haline yer verilmiştir.

Tezin ikinci bölümünde sulandırma kavramı, Amerika Birleşik Devletleri, Avrupa Birliği ve uluslararası düzenlemelerdeki mevzuat ve içtihatlar kapsamında

incelenmiştir. Bir kavram olarak sulandırmanın temelleri çoğunlukla Amerika Birleşik Devletleri'nde şekillenmiş ve yasal çerçevesi de burada oluşturulmuştur. Bu nedenle, sulandırma kavramını anlamak ve etkili bir şekilde anlamak için ABD'deki yasal çerçeveyi ve yasal kapsamı gözlemlemek önemli olup, Avrupa Birliği'nde sulandırma kavramı ABD'deki yaklaşıma benzemekle birlikte önemli farklılıklar da içermektedir. Özellikle Türk marka hukukunun AB'nin marka hukuku yaklaşımlarını yakından takip ettiği ve Türkiye'nin AB ile uyum sürecinin marka hukuku alanında benzerlik ve paralelliklerin oluşmasına katkı sağladığı görülmekte olup Türk hukukunda sulandırmanın AB ile uyumlu olduğu gözlenmektedir. Bu nedenle hem sulandırma kavramının yasal temelini ve gelişimini anlayabilmek, hem de Türk hukukundaki durumu daha net görebilmek adına bu bölümde ABD ve AB hukukundaki düzenlemelere karşılaştırmalı olarak yer verilmiştir.

Son bölümde ise Türk hukukunda tanınmış markaların sulandırmaya karşı korunması ve Türkiye'de markaların sulandırmaya karşı korunması amacıyla getirilen yasal düzenlemeler, sulandırmaya karşı korumanın kapsamı ve koşulları incelenmiştir. Bununla beraber, sulandırmaya ilişkin davalarının Türk yargı sisteminde ele alınış şekli ve korumanın unsurları ayrıntılı olarak değerlendirilecektir. Sulandırmaya ilişkin yargı kararlarında bazı tutarsızlıklar ve kavram kargaşaları olduğu ve bunun da uygulamada sorunlara yol açabildiği görülmektedir. Son olarak, sulandırmaya karşı korumanın istisnaları açıklanarak, özellikle Türk marka hukukuna getirilen yeniliklerden biri olan "haklı sebep" kavramı üzerinde durulmuş ve bu alanda eksiklikler olduğu da gözlemlenmiştir. Sulandırmaya ilişkin istisnaların tamamına mevzuatta yer veren ABD ile karşılaştırıldığında, Türk marka hukukunda sanatsal ifade, ifade özgürlüğü, parodi gibi konularda sulandırmaya karşı düzenlenmiş bir istisnanın bulunmadığı ve yargı kararlarında da durumun farklı olmadığı açıklanmış, mahkemelerin katı tutumu ve belirsizlikler hukuki boşluklara yol açabileceği gözlemlenmiştir. Bilhassa sanatsal ifade, ifade özgürlüğü ve parodi gibi hassas konularda, sulandırmaya karşı koruma alanında daha net ve dengeyi sağlayacak düzenlemelere ihtiyaç duyulabilecektir. Nitekim tezin bu bölümünde Türk

hukukunda sulandırma kavramına ışık tutulmaya çalışılacak, yasal çerçevedeki olası iyileştirmelerin altı çizilecek ve kavramın Türk hukukunda yargı kararları kapsamında değerdendirmesi yapılmıştır. İşbu tez kapsamında odak noktası tanınmış markaların sulandırmaya karşı korunmasının Türk hukuku, AB ve ABD marka hukuku kapsamında incelenmesi, “karıştırılma ihtimali” ve “sulandırma” kavramları arasındaki kontrasta ve bilhassa koruduđu menfaatler bakımından farklılıklara ışık tutulması, tanınmış markalar bakımından sulandırma korumasının istisnalarının ayrıntılı olarak açıklanması ve bu çerçevede Türk hukukundaki kuramsal ve uygulamadaki güncel durumu karşılaştırmalı olarak tartışılmasıdır.

Anahtar Kelimeler: Tanınmış Marka, Marka Hakkının İhlali, Karıştırılma İhtimali, Markanın Sulandırılması, Haklı Sebep

ABSTRACT

Protection of Well-Known Trademarks Against Dilution

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Protection of intellectual property rights had become even more critical due to the developments in the technology and international trade and in order to prevent unfair trading practices in a global level. This is specifically true for the trademarks and the well-known marks in specific considering the trademark has become a well-known mark through advertisement, promotion and advertising by spending time and effort, and as a result the brand value alone surpasses all other assets belonging to that enterprise, and this situation has great effects on the market. Traditionally, trademark infringement is evaluated based on likelihood of confusion which refers to threat of confusion for public amongst conflicting marks. Nevertheless, for the well-known trademarks, the main function of trademark is no longer just being an indicator of the origin/source, therefore possibility of confusion concept that is based on misperception on origin does not exactly cover the interests of possessors of well-known trademarks. This necessity brought forward the concept of dilution, which is evaluated based on actual harm or risk of harm to distinctive nature or to the repute of a trademark, without any consideration of confusion. There are also legal defenses which may be specifically put forward against dilution claims. In this thesis, the concept of well-known trademarks and international treaties and organizations within this context, and the concept of trademark are discussed in comparison based on case law and legislation in the US, EU, and Türkiye with the aim of examining protection against dilution of well-known marks. Lastly, legal defenses which may be put forward

against dilution claims including the concept of due cause within the scope of EU and Turkish legislation in comparison with the thoroughly and comprehensive regulation in the US regarding the exclusions of anti-dilution protection which include fair uses such as parodying, criticism, commenting and the lack of precise protection regulation for this type of uses in Türkiye are discussed.

Keywords: Well-known trademark, Trademark Dilution, Likelihood of Confusion, Due Cause, Fair Use

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ABBREVIATIONS

Art.: Article

Conv.: Paris Convention for The Protection of Industrial Property (As Amended on September 28, 1979)

CJEU: Court of Justice of the European Union

EU: European Union

EUIPO: European Union Intellectual Property Office

EUTMD: Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to Approximate the Laws of the Member States Relating to Trademarks, OJ L 336/1, 23.12.2015.

EUTMR: Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trademark, OJ L 154/1, 16.06.2017

FTDA: Federal Trademark Dilution Act

IPC: Turkish Industrial Property Code No. 6769

Joint Recommendation: World Intellectual Property Organization International Bureau: Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks

OHIM: The Office for Harmonization in the Internal Market

p.: page number

para.: paragraph

TDRA: Trademark Dilution Revision Act

TRIPS: The Agreement on Trade Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods

TCC: Turkish Commercial Code No. 6102

TURKPATENT: Turkish Patent and Trademark Office

US: The United States

USPTO: United States Patent and Trademark Office

WIPO: World Intellectual Property Organization

WTO: World Trade Organization

INTRODUCTION

Due to the globalization and international trade, protecting the intellectual property rights has become a necessity in a global scale. Especially, trademark law is sensitive to the developments in technology and international trade by extension, considering these developments also brought forward new types of infringing acts and trademarks. Well-known marks in particular have been affected by these changes and these trademarks now became incredibly valuable assets which need their own specific type of protection. Considering the advertising, communication, and investment functions have become equally, or arguably even more important with regards to the well-known marks due to the brand image which has been formed by the efforts by the proprietor of well-known mark, the only function of trademarks is not simply being an origin/source indicator. Well-known marks require greater protection and infringing acts which are acknowledged in the context of likelihood of confusion are not deemed adequate in thoroughly protecting the interests of the marks with a repute. Concept of trademark “dilution” is a result of these developments. As opposed to the traditional trademark infringement based on possibility of misperception and confusion to sources/origins of commodities, protection against dilution covers the investment function and trademark holder’s efforts. Anti-dilution protection extends the scope of protection granted to the well-known marks and it guards the reputation and distinctive nature of trademark from harm, even without misperception. In the first part of this thesis, trademarks and their functions, well-known mark notion, criteria based international treaties and organizations, and the concept of dilution, furthermore, types of dilution will be discussed.

In the second part of the thesis, the concept of dilution shall be examined within the scope of legislation and cases in US, EU, and international regulations. Foundations of dilution as a concept were generally first shaped in the United

States and its legal framework was established there as well. Trademark law in the US has specific provisions on dilution, and it has a broad legal scope for trademark protection. Consequently, to effectively comprehend concept of dilution, it is important to observe the legal framework and legal scope in the US. The concept of dilution in the European Union is similar to the US approach, but also has significant differences. The regulations in EU in the field of trademark law may offer different perspectives when dealing with dilution cases. In particular, Turkish trademark law closely follows the EU's trademark law approaches and can be seen to be in a harmonized structure. Türkiye's harmonization process with the EU has contributed to the formation of similarities and parallels in trademark law field. Therefore, in such context, examining legal foundations of dilution concept in US as well as European Union approach is extremely important in terms of understanding how trademark law is shaped in a universal dimension and how it affects the concept in Turkish law.

In the final part, well-known mark protection against dilution within Turkish law will be examined and EU's influence on the legal regulations introduced in Türkiye to protect trademarks against dilution will be addressed, and the scope and the conditions for the protection against dilution will be explained. Furthermore, the way in which dilution cases are handled in the Turkish judicial system and the elements of protection will be evaluated in detail. It can be observed that there are some inconsistencies and conceptual confusions in judicial decisions regarding dilution which may result in producing issues in practice. Lastly, the exceptions to anti-dilution protection will be explained, in particular, the concept of "due cause", which is one of the innovations introduced to Turkish trademark law, will be emphasized. However, it can be also observed that there are shortcomings in this area. Compared to the US which regulated all of the exceptions for dilution, it can be seen that there is still no exception regulated against dilution in matters such as artistic expression, freedom of expression, and parody in Turkish trademark law. Moreover, the situation is no different in case law, and the strict attitude of the courts and uncertainties may lead to legal gaps.

In particular for sensitive issues such as artistic expression, freedom of expression and parody, there may be a need for clearer regulations in the area of protection against dilution while providing a balance. To put it shortly, this part of the thesis will try to shed light on dilution concept in Turkish law, highlighting possible improvements in the legal framework and the assessment of the concept in case law.

CHAPTER I

CONCEPTS OF TRADEMARK, WELL-KNOWN MARK AND TRADEMARK DILUTION

1. TRADEMARK

1.1. Definition and Concept of Trademark

The fundamental definition of a trademark according to the modern Turkish Law, would be that it is a sign, which is used to differentiate the products or services of an enterprise from products or services of other enterprises.¹ This “sign” in question may come in many forms as long as it is distinctive, such as words, names, shapes, colors, numbers, letters and even the scents may be registered as a trademark in some legal systems.²

The definition of the trademark is similar in other legislations such as Lanham Act³ and EU Trademark Law⁴. Based on TRIPS Art. 15/1, any sign, or the combinations of these signs, provided they have the capability to distinguishing

¹Çolak Uğur. *Türk Marka Hukuku*. Oniki Levha, 2016, p.8; Turkish Industrial Property Code, No. 6769, Article 4., Tekinalp, Ünal. *Fikri Mülkiyet Hukuku*. Vedat Kitapçılık, 2012, p. 360.; Karasu, Rauf, et al. *Fikri Mülkiyet Hukuku*. Seçkin Yayıncılık, 2022, p. 151.

² Karasu, Rauf, et al. *Fikri Mülkiyet Hukuku*. p. 160-161.

³ See, Lanham Act § 45, 15 U.S.C. § 1127 (1994 & Supp. 1998). “The term “trademark” includes any word, name, symbol, or device, or any combination thereof— (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”

⁴ See, First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, Article 2, Signs of which a trade mark may consist, “A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.”

products and services of one undertaking from those of other undertakings, will be deemed sufficient in establishing a trademark.

Similarly, WIPO (World Intellectual Property Organization) defines trademark as a sign which is competent in differentiating products and services of one enterprise from those of other enterprises as well.

Based on the indirect definitions provided, it can be said that the shared attributes in these definitions are that firstly there would have to be a sign, and secondly, this sign in question would have to be able to differentiate one commodities and services from those of others.⁵ Likewise, trademark is defined as signs which are used for differentiating an enterprise's commodities or services from commodities or services of others in Turkish doctrine.⁶ In order for it to be capable of distinguishing, this sign in question must also be distinctive, and not descriptive. Therefore, the signs which are not capable of distinguishing will not be considered as a trademark.⁷

These qualifications are vital, because unless these conditions are met, the mark cannot be recorded as trademark, therefore by default it will not be able to be protected as a trademark either. While the estimation for "signs that a trademark may consist of" is not the same in every legal system, in addition to these attributes, it is also important for the sign to be able to be symbolized by such manner which facilitates the extent of coverage being determined in a clear and precise manner with regards to the registrability.⁸ The general attributes of these signs and concept of distinctiveness will be explained in more detail below to be able to refer to trademark well.

⁵ Kaya, Arslan. *Marka Hukuku*. Seçkin Yayıncılık, 2006, p. 15.; Kayıhan, Şaban. *Ticari İşletme Hukuku*. Seçkin Yayıncılık, 2018, p. 135.

⁶ Karahan, Sami. *Ticari İşletme Hukuku*. Mimos, 2013, p. 156.; Kayıhan, Şaban. p. 135.

⁷ Arkan, Sabih. *Marka Hukuku*. Volume I, AÜHF Yayınları No: 520, 1997, p. 36.; Kayıhan, Şaban. p. 136.

⁸ Karasu, Rauf, et al. *Fikri Mülkiyet Hukuku*., p. 153.

1.2. Essential Features of Trademark

1.2.1. Signs

As it was explained briefly above, in order to define what constitutes a trademark, there are mainly two essential features which must be examined, one of them being a “sign”. A trademark is fundamentally a sign, however, not every type of sign may be acceptable as a trademark. Following the definitions and descriptions on Turkish legislation and international treaties, also provided above, it can be seen that the common part is that it can be “any” sign, provided it has the capability to differentiate commodities and services of one business from others.

In Turkish Industrial Property Code, Article 4, some examples are provided as to what type of signs may be selected and accepted to be a trademark. While these examples contain traditional marks such as words, names, shapes, letters, numbers, colors, product shape or packaging, it can be said that this list is non-exhaustive. The trademark application may be consisted of just one of these types of signs or a combination of them. The format of the application shall be important regarding the protection scope trademark will get upon registration.

The emphasis of “any” here clearly states that the signs which may be considered as a trademark are not *numerus clausus*. As the very nature of trademark law requires a dynamic process which is constantly changing, the evolution of new types of marks are inevitable as well. This brought forward the concept of non-traditional marks, or to put it another way, non-conventional trademarks. Visible signs such as three-dimensional marks, motion, position, holograms, slogan or multimedia signs, gesture marks, and non-visible signs such as sound, taste, scent marks and texture marks are some of the examples of non-traditional marks.⁹

⁹ WIPO, STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS, New Types of Marks, September 1, 2006.

The evaluation of these type of marks will and must constantly change in time as well, due to their unique nature. With regards to how to clearly represent non-visual signs, such as scent marks, one of the landmark decisions which is referred often is “*Ralf Sieckmann v Deutsches Patent und Markenamt*” case.¹⁰ The applicant wished to register “methyl cinnamate” scent as a trademark, and chemical name, chemical formula, description, and samples were also provided with the application. However, the Court ruled that, this scent mark application would not be able to be registered for several reasons and the most important one is that it was not possible to graphically represent it exactly.

The Court referred to First Council Directive 89/104/EEC,¹¹ Article 2, as being represented graphically was a requirement at the time of the ruling according to the Directive. This ruling is also significant because it laid out seven criteria for the requirements of representation, which was also known as “*Sieckmann Criteria*” afterwards. These are being represented as: “*clear, precise, self-contained, easily accessible, intelligible, durable, and objective*”.¹² These criteria have been used as a reference point in the cases which follow with regards to the representation.

However, with the new EU Directive 2015/2436¹³, the requirement of the graphical representation for the registration has been removed. The removal of this requirement has definitely opened the way for the non-conventional marks and scent marks in specific.¹⁴ As for the United States, this approach has been followed long before EU and it is clearly expressed that this kind of marks does not have to

¹⁰ CJEU, *Sieckmann v German Patent and Trademark Office* (case C-273/00) issued on December 12, 2002, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A62000CJ0273> (online on 01.06.2022)

¹¹ See. Article 2 of Directive 1989/104 - First Council Directive 89/104/EEC to approximate the laws of the Member States relating to trade marks.

¹² CJEU, *Ralf Sieckmann v Deutsches Patent- und Markenamt* (Judgement of 12-Dec-2002, C-273/00)

¹³ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks

¹⁴ See. European Commission Implementing Regulation 2018/626 related to European trademarks, Article 3, “Representation of the trade mark” for more information. <https://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32018R0626&from=EN> (online on 25.10.2021)

be represented visually, in US Trademark Act.¹⁵ So it can be said that these types of marks have been registered for many years by USPTO. However, it should be noted this form of sign (scent) is not recognized in Turkish Trademark Law, as of now.

Another one of the recent and interesting examples of this is the “NUSR-ET” case, which was a great illustration of a “motion” mark. This application was also important on acquiring distinctiveness through use claim of the applicant and the different approach EU and US take with regards to registration.

In order to bring up this case, it must be briefly explained that Nusret Gökçe is a very famous Turkish steakhouse chains owner. However, as it is known, he is not only well-known in Türkiye, but he is widely known globally, mostly due to the influence of social media where he gained the nickname of “Salt Bae” for his iconic salt sprinkle motion when his videos went viral. In 2017, he applied to register this iconic motion as a motion trademark to EUIPO (European Union Intellectual Property Office) for three different classes: 25, 30 and 43¹⁶.

However, the application was rejected with regards to Class 43 which involves food and drink services, because the examiner found that this motion lacked distinctiveness, and was not completely convinced that it had indeed become distinctive through use as a motion mark. The verdict has been appealed by the applicant of course, arguing that it had acquired distinctiveness and most of the evidence was based on social media and internet presence.

Nevertheless, EU’s Fifth Board of Appeal still ruled that this sign cannot be registered as a motion mark for Class 43 and did not give too much importance on

¹⁵ Danciu, Victor. *The Scent of a Trademark: Removal of Graphic Representability Requirement - Trademark - European Union*, 8 Mar. 2019, <https://www.mondaq.com/trademark/788476/the-scent-of-a-trademark-removal-of-graphic-representability-requirement>. (accessed on 25.10.2021)

¹⁶ See. Nice Agreement dated 15 June 1957 regarding International Classification of Goods and Services for the Purposes of the Registration of Marks for the classes mentioned.

the social media evidence.¹⁷ This has brought up some criticism, especially considering that much more abstract motion marks were accepted before, such as Microsoft's two flared segments.¹⁸ Though, with contrast to EU, Nusret was actually able to get this motion sign registered for the Classes 25 and 43 in the United States in July 2018. Due to this, all in all it can be said that this may count as a great example for the effect of internet and new type of evaluation methods and new type of signs.

1.2.2. Concept of Distinctiveness

One of the most important elements which constitutes a trademark is its distinctiveness, which is essential in differentiating the commodities and services of an enterprise from others.¹⁹ Turkish legislation emphasizes on this qualification greatly in Turkish Industrial Property Code²⁰, as it states that signs that are lacking any distinctive character would not be registrable as a trademark, and it is among absolute grounds for rejection in trademark registration.

This is also referred in Code while describing trademark²¹, as it is stated that the sign which will be represented in the registry must deliver a "*clear and precise*" understanding of the protection's extent.

On that note, it must be stated once again that distinctiveness and non-descriptiveness are qualities which conduct the very basis of requirements of a trademark. Since trademark registering's purpose is to secure protection for said mark; it cannot be emphasized enough that more distinct a mark is, the greater the

¹⁷ Fifth Board of Appeal Ruling dated 8 June 2018, Case R 2661/2017-5, *D ET VE ET ÜRÜNLERİ GIDA PAZARLAMA TİCARET ANONİM ŞİRKETİ*.

¹⁸ See. <https://euipo.europa.eu/eSearch/#details/trademarks/005338629> (online on 25.10.2021)

¹⁹ Karasu, Rauf, et al. *Fikri Mülkiyet Hukuku*. p. 152.

²⁰ See, Turkish Industrial Property Code No. 6769 Article 5 (1). It is stated that if a sign is lacking distinctive character, it will not be considered as a trademark and therefore it will not be possible for it to be registered as a trademark as well.

²¹ See, Turkish Industrial Property Code No. 6769 Article 4/1. This Article offers a non-exhaustive list of the signs which may constitute a trademark, such as words, names, shapes, colors, letters, numbers, sounds. However, it is also stated in the Article that these signs must be able to present the extent of protection which is granted by the registration clearly and accurately.

trademark protection shall be.²² Source designation and distinctiveness are the defining qualities of the trademarks which may be protected, because one of trademark law's primary purposes would be safeguarding the integrity of source indicators.²³ It serves the purpose of distinguishing the mark from other marks that identify goods and services because of its uniqueness, thus, making it a vital requirement for a trademark.

As to how to determine whether this qualification is met, EUIPO (European Intellectual Property Office) guidelines provide some examples. In cases with non-distinctive words and combination of these words with descriptive signs; it is stated that terms which purely represent a certain positive or attractive characteristic or purpose of the commodities and services must not be accepted in case it is either applied for on its own or in combination with the other terms which are considered descriptive.²⁴

The distinctive feature of the trademark should be measured with regards to the commodities or services reflecting the observation of an "*average consumer*" of products and services in question. This term refers to a consumer who is moderately knowledgeable and reasonably attentive. The case law demonstrates that the Courts have traditionally used a grouping system in order to measure the distinctiveness of word marks. Four categories have been established and the placement has been made by defining the meaning of the term which is the subject of dispute in the context it is used. These categories are: (i) generic, (ii) descriptive, (iii) suggestive, or (iv) arbitrary/fanciful, with ascending order depending on the distinctiveness.²⁵

²² Ward, Francine. *Staying Legal: A Guide to Copyright and Trademark Use*. American Society for Training and Development, 2007, p. 41.

²³ McKenna, Mark. "Teaching Trademark Theory Through the Lens of Distinctiveness." *Social Science Research Network*, 2008, p. 847. law.slu.edu/sites/default/files/Journals/mark_mckenna_article.pdf.

²⁴ European Intellectual Property Office Guidelines, Chapter 3 Non-distinctive trademarks.

²⁵ McKenna, Mark P. p. 848.

In the evaluation of the distinctive characteristic of a mark, the overall impression should be considered. In fact, the average consumer, which was also mentioned above, comprehends the mark as a whole and does not typically consider the specifics of the trademark.²⁶ However, this also depends on the type of products and targeted consumer group. For instance, while consumers who buy high technology are expected to pay more attention to details²⁷, the same attention to detail cannot be expected for an average customer who purchases a food product. Therefore, this should also be taken into consideration case-by-case.

Other than non-distinctive words as explained above, as we know shapes, colors, figurative elements may be acknowledged as a registerable trademark as well thus they should also comply with the requirements regarding distinctiveness. For instance, plain geometric shapes like lines, squares, circles and rectangles will not be able to deliver any form of message which may be remembered by the consumers. Due to this, it will also be very difficult for them to be perceived as a trademark by the consumers.²⁸ Therefore, this type of signs will not be considered registrable as a trademark.

In conclusion, in case of non-distinctiveness, a mark cannot be registered and would be rejected by TURKPATENT & Trademark Offices. However, there is an exception which would allow the sign in question to overcome this ground, provided the candidate can demonstrate that applied sign has developed distinctiveness before the date of the application due to a constant and extensive use which occurred over the course of many years.²⁹ It will be explained in more detail below.

1.2.2.1. Acquiring Distinctiveness Through Use

²⁶ CJEU, 7 October 2004, *Mag Instrument/OHIM*, C136/02 P, p. 20.

²⁷ TÜRKPATENT, Guidelines Concerning Proceedings Before the Turkish Patent Institute, 2011.

²⁸ European Intellectual Property Office Guidelines, Chapter 3 Non-distinctive trademarks (Article 7(1)(b) EUTMR)

²⁹ Tekinalp, Ünal. *Fikir Mülkiyet Hukuku*. p. 365.; Arkan, Sabih. *Marka Hukuku*. V. I. p.36.

Acquiring distinctiveness through usage may occur in cases where an unregistered mark gains distinctiveness and develops into a trademark which the public associates with a particular set of services and goods.³⁰ Therefore, it can be said that a consistent use may strengthen the trademark's character and relatively weak signs, such as descriptive marks, may have the opportunity to acquire distinctiveness through use and obtain trademark characteristics, which make it possible to register and defend such signs as a protectable sign. In cases like these, evidence of use becomes very important to the proprietor of a trademark if his/her trademark is not undoubtedly distinctive.

In order for the trademark holders to prove that their sign gained distinctiveness through use, it will be obligatory for them to gather sufficient evidence which shows acquired distinctiveness based on at least five years of use up to the date which the claim is made.³¹

While the evidence list is non-exhaustive, EUIPO Trademark Guidelines provide some examples on what they may be, such as advertisements, invoices, annual reports, opinion polls, surveys etc. This evidence may also be collected from independent trade associations, consumer organizations and competitors.³²

As for the number of required years varies on each individual case, and it might be possible having usage proof dating to less than five years before the registering application. However, the evidence may nevertheless be able to demonstrate sufficient distribution or advertising for the mark to become distinctive through use. There are some examples provided below in order to demonstrate this situation better.

³⁰ EUIPO Trademark Guidelines, Chapter 14/1

<https://guidelines.euipo.europa.eu/1803468/1787924/trade-mark-guidelines/1-introduction> (accessed on 28.06.2022)

³¹ "Trademark Distinctiveness Can Be Established through Use." Tilleke & Gibbins, 12 Jan. 2021, <https://www.tilleke.com/insights/trademark-distinctiveness-can-be-established-through-use/>

³² EUIPO Trademark Guidelines, Chapter 14/8

<https://guidelines.euipo.europa.eu/1922895/1788538/trade-mark-guidelines/8-3-declarations--affidavits-and-written-statements> (accessed on 28.06.2022)

Some examples of descriptive signs which has acquired distinctiveness through use: *BEST BUY*, *BRITISH AIRWAYS*,³³ *WINDOWS*, *DOLLAR A DAY*³⁴

All of the trademarks listed above normally can be categorized as descriptive marks and therefore would not be able to be protected as a trademark. However, through years of use, they have acquired “secondary meaning”,³⁵ which is developed through significant advertising budget, and as a result of this investment, they were able to be registered as a trademark and legally protected as one.

1.2.2.1.1. Baby-Dry & Doublemint Case

Regarding the registration of marks which seems non-distinctive and descriptive at first sight, there is a controversial and famous case called “Baby-Dry”,³⁶ which is evaluated according to the UK Law but still holds a significant place in Trademark Law in general in terms of distinctiveness and descriptiveness. On 3 April 1996 the US Company, Procter & Gamble, filed an application OHIM for registering Baby-Dry term as Community Trademark, with regards to disposable diapers created from paper, cellulose, or textile.³⁷

The OHIM declined the registration application for the term “*Baby-Dry*” due to the fact the examiner deemed the mark was not registrable within Council Regulation Art. 7/1³⁸ on the grounds that the term was descriptive of the products for which registration has been requested.

³³ “What is distinctive about ‘distinctive character’ and who decides?” Stobbs, Julius, 05 Jan. 2015, <https://www.worldtrademarkreview.com/article/what-distinctive-about-distinctive-character-and-who-decides>

³⁴ “The More Distinctive the Trademark, the Greater the Protection.” Dimitri, Mackenzie L., 01 Apr. 2016, <https://ed-lawfirm.com/business-blog/the-more-distinctive-the-trademark-the-greater-the-protection/>

³⁵ McKenna, Mark P. p. 848.

³⁶ *OHIM v. Wm. Wrigley Jr. Company*, Case C-191/01.

³⁷ Ólafsdóttir, Hafdís. “Descriptive Marks and the Notion of Distinctiveness Absolute Grounds for Refusal According to Article 7 of Council Regulation (EC) No 40/94 on the Community Trade Mark.” *Faculty of Law University of Lund*, 2005, p. 18.

³⁸ EC No 40/94, dated 20/12/1993 on the Community Trademark, Article 7/1(c).

The term Baby-Dry could not be registered as a trademark because the words described the category, value, or intended aim of products and services to which they would be used in everyday language. The Board also refused to consider the evidence for acquired distinctiveness of the proposed trademark on the grounds that this argument had not been raised before the examiner. After this, upon Procter & Gamble's appeal, Court concluded that considering the objective of diapers is being absorbent in order to keep babies dry; the term "*Baby-Dry*" did not add anything to the equation but it simply expressed to the consumers the intended goal of the product in question. Though, the Court still terminated the Board's ruling in order to allow the applicant to present their arguments within the extent of Regulation Art. 7/3 regarding acquisition of distinctive quality through actual use.³⁹

Nevertheless, CJEU chose to take a separate approach to the conflict. CJEU ruled that even though the words "BABY" and "DRY" are descriptive separately, as a whole, it is distinctive as a trademark therefore allowing the sign to be registered. CJEU found that due to "*syntactically unusual juxtaposition*" of 'baby' and 'dry' words, "*BABY-DRY*" is actually not a common phrase which is used in English for describing a diaper or to explain its indispensable attributes. Therefore, the combination of "Baby" and "Dry" has been assessed as "*lexical invention bestowing distinctive power on the mark so formed*". Following this case, similar applications were made and one of them was "Doublemint" case.

However, in the DOUBLEMINT case of 2003, the CJEU ruled that DOUBLEMINT was purely descriptive of chewing gum, stating that just because combination of the words 'DOUBLE' and 'MINT' may possibly lead to a variety of potential meanings, this did not automatically mean that the words were not descriptive.⁴⁰

³⁹ Ólafsdóttir, Hafdís. p. 19.

⁴⁰ CJEU/03/95, 23 October 2003, Case of C-191/01 *OHIM v Wm. Wrigley Jr. Company*.

Therefore, even though following this case there were many similar applications for registration of such nature, CJEU did not classify the following cases the same as Baby-Dry case. While some scholars deduced that this decision would lead an overflow of registration of descriptive signs that was not the case. In accordance with BABYDRY decision of CJEU, multiple signs lacking in distinctive character can still bring forward a distinctive sign when combined; however, a sign such as BACONCHIPS would be deemed as lacking distinctive quality, since combination of words still do not result in a distinctive sign.⁴¹ In conclusion, while these cases light the way, there is no single rule regarding this matter, and judgments shall be made case-by-case.

1.2.3. Clarity and Preciseness

Article 4 of IPC requires that protection awarded to mark's proprietor to be exhibited clearly and precisely, and this is the restriction in terms of signs which may be used. The old legislation, which is Decree Law 556 actually required the mark to be expressed in a graphical manner and "clarity and preciseness" as an essential aspect of the trademark has been adopted by the introduction of Turkish Industrial Property Code instead of that condition. This certain change aided in ensuring the harmonization between the Turkish legislation and European Union legislation.⁴²

1.3. FUNCTIONS OF TRADEMARK

There are different approaches regarding the functions of trademarks and "function theory" in general in different legal systems and doctrine. In this thesis, I will be evaluating the functions of trademark in accordance with the CJEU classification.⁴³

⁴¹ Duyan, Damla. *A Guide to Turkish Trademark Office Action and Opposition System - Trademark – Türkiye*. Grup Ofis Marka Patent A.S., 10 Dec. 2019, <https://www.mondaq.com/Türkiye/trademark/873212/a-guide-to-turkish-trademark-office-action-and-opposition-system>.

⁴² Karasu, Rauf, et al. *Fikri Mülkiyet Hukuku*. p. 153-154.

⁴³ See CJEU, 25/03/2010, BergSpechte (C-278/08), CJEU, 08/07/2010, Portakabin (C-558/08), CJEU, 22/09/2011, Interflora (C-323/09), CJEU, 18/06/2009, L'Oréal/Bellure (C-487/07)

1.3.1. Origin Function

One of trademark's major objectives would be serving in identifying source or the origin of commodities or services as it has been stressed on several occasions EU Directives and CJEU rulings.⁴⁴

It can be said that trademark's originating role is its primary function, since only if mark's source indication function has been fulfilled, which is differentiating trademarked merchandises from products of different origin, it may then serve its important mission as a device of sales, promotion, and consumer information. Addition to that, it can only then accomplish its purpose of protecting the trademark owner against harm to the repute of their trademark.⁴⁵ CJEU also emphasizes this on *Arsenal V Reed* judgement, stating that principal role of trademark is to identify the source of the products or services.⁴⁶

The impact and consideration of origin function in the evaluation of trademark infringement cases is also explained in one of the rulings of Turkish High Court.⁴⁷ The origin function, and by association, quality guarantee and advertising functions are connected to "likelihood of confusion" evaluation on infringement cases. The concept will be explained in detail afterwards.

Therefore, it is safe to assume that the trademark's crucial objective is ensuring the "*badge of origin*" of commodities or services and separating from the products or services of other competitors in the marketplace, thus helping the

⁴⁴ Çolak, Uğur. *Türk Marka Hukuku*. p.13.; CJEU C-39/97, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*; C-324/09, *L'Oréal SA v eBay International AG*.

⁴⁵ Memorandum on the creation of an EEC Trade Mark, adopted by the Commission on 6 July 1976, Bulletin of the European Communities, Supplement 8/76, para. 68.

⁴⁶ *Arsenal Football Club v Matthew Reed* [2003] RPC 39, [2003] 3 All ER 865. "*The essential function of a trademark is to guarantee the identity of origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin.*"

⁴⁷ Turkish High Court, 11th Civil Chamber, No. 2003/5034 - 2004/127; Korkusuz, M. Refik, and Özgür Arıkan. "Intellectual Property Law." *Turkish Private Law*, Seçkin Yayıncılık, 2018, p.358.

customer to overcome confusion and protect them by enabling them to distinguish the products as well.⁴⁸

The origin function can be perceived in two ways: one is the physical origin of the products, the other one is identity of product's origin. The actual physical origin approach dates way back to the ancient times. However, this approach of origin became impractical in modern trading, and due to this, the second approach was widely adopted from the beginning of the 20th century.⁴⁹

The conditions of the modern trade made outsourcing and licensing agreements a necessity, thus making the first approach out-of-date.⁵⁰ As the identifying the origin of the commodities approach has a wider take on the subject, it includes the goods and products which originate under the command of a single undertaking. Therefore, CJEU also embraces this method on their decisions. (*Unilever plc v. OHIM*)⁵¹

As stated above, there are several purposes of trademarks apart from its origin/source function, like quality guarantee, however these functions are directly associated to the origin function as well. These functions will also be discussed below in detail.

1.3.2. Quality Guarantee Function

Origin, along with quality guarantee functions are essential in giving assurance to the customers after the launching of the commodities and services which belongs to the trademark in question. Quality guarantee function also builds brand

⁴⁸ Aristidou, Christiana, *Cyprus: Trade Mark Infringement On The Internet: Current Issues And Concerns In Europe (Sponsored Links, Search Engines And Shopping On The Internet) - Part 1*. 20.12.2011. <https://www.mondaq.com/cyprus/trademark/157742/trade-mark-infringement-on-the-internet-current-issues-and-concerns-in-europe-sponsored-links-search-engines-and-shopping-on-the-internet-part-1>. (online on 13.08.2022)

⁴⁹ Zografos, Daphine. *Intellectual Property and Traditional Cultural Expressions*. Edward Elgar Publishing, 2010. p. 52.

⁵⁰ Tekinalp, Ünal. *Fikri Mülkiyet Hukuku*. p. 378.

⁵¹ Zografos, Daphine. p. 52.

reputation and a relationship of trust with the customer, thus ensuring the stability of its commercial life. Due to this function of trademarks, the customer may still prefer a certain brand even if the companies that provide goods and / or services or the place of production change, all thanks to the perception of the quality for those products.⁵²

This function is even more critical for well-known trademarks because there is no denying that the customers trust well known trademarks' guarantee/quality significantly more compared to the other brands.⁵³ It builds a strong bond based on expectation of certain quality and standard, which is one of the key elements for a well-known trademark. Therefore, it is seen that this bond of trust ensures that the commodities and services which are delivered by the well-known trademark are preferable compared to the other marks, even if it is more expensive in comparison.

However, while this function seems to be protecting the customer against deception, it must be noted that even if the expected quality of the products were no longer matched by the brand, it is not possible to protect the expectations of the customer as a right in trademark law against mark's proprietor. ⁵⁴ Therefore, while trademarks indeed have functions of guarantee of merchandise quality, trademark law does not enforce a certain level of quality actively or keeping a specific standard during the usage of the trademark. ⁵⁵ Protection against deceptive behavior and matters of compensation are related to other laws and this quality

⁵² Doğan, Eylül Bahar. "Tescil Edilmiş Markanın Kullanılmamasının Hukuki Sonuçları." *İstanbul Ticaret Üniversitesi*, 2019, p.9.

⁵³ Ersoy, Ali F. Et Al. "Üniversite Öğrencilerinin Giysi ve Ayakkabı Tüketiminde Markaya yönelik Davranış ve Tercihleri." *Gazi Üniversitesi Endüstriyel Sanatlar Eğitim Fakültesi Dergisi*, No.14, pp.1-14, 2004, p.10.

⁵⁴ Beier, Friedrich-Karl. *Territoriality of Trade mark Law and International Trade*, 1 IIC 48 – 72, 1970. p.64; Tam, Phan Ngoc. "Well-Known Trademark Protection. A Comparative Study between the Laws of the European Union and Vietnam." *Lund University Faculty of Law*, 2011, p. 32.

⁵⁵ Strasser, Mathias. "The Rational Basis of Trademark Protection Revisited: Putting the Dilution Doctrine into Context." *Fordham Intellectual Property, Media and Entertainment Law Journal*, Vol. 10, No. 2, 2011, p. 418.

guarantee established by the trademark is more of an economic one and it has no legal consequences in terms of trademark law from a consumer perspective.⁵⁶

Nevertheless, trademark owner shall have the right to ask for compensation in case there is a damage to mark's reputation within trademark law's extent. This is also regulated in Turkish Law, No. 6769 Turkish Industrial Property Code, Law No. 6769. On Article 150/2, this right to compensation is explained this way: *"...In case industrial property right is infringed, additional compensation may be claimed if reputation of industrial property right suffers damage because the products or services forming the subject of the right are used or produced in an inferior manner; or such products produced in this way are made available or launched to the market in an improper manner..."* This right given to mark's proprietor is closely connected with quality guarantee function of trademarks. Quality guarantee function is also the foundation for the exception of *"exhaustion of rights"* stated on Art. 152.

Normally, industrial property right is exhausted when products are brought to market by right owner or third persons with right holder's approval. According to Art. 152 second clause, the mark's owner will still have the right of stopping commercial use by third persons who modify or deteriorate the products.

Subsequently, it can be said that even though the customers do not have a right within the range of trademark law to enforce their expectations, the trademark owner has the means to keep a certain standard and is able to take legal action in case of damage of reputation arises due to the actions of a third party and this is helpful in practice to give the customer reassurance with regards to the quality and trust to the brand.

1.3.3. Functions of Advertising, Communication, and Investment

⁵⁶ Tekinalp, Ünal. *Fikri Mülkiyet Hukuku*. p. 378.

As mentioned in indication of source function section, in early times of trademark law, it was thought that the trademark's only function was indicating the commodities and services' source. According to the physical origin approach, the function of advertising can be seen as informing the purchasers concerning the product's origin too. However, as the market changed the brands themselves became an asset, sometimes becoming the most valuable asset, subsequently the functions and the approaches in trademark law developed as well.⁵⁷

This development eventually brought forward the functions of advertising, communication, and investment, in addition to their origin function and these functions were first officially recognized in "*L'Oreal V Bellure*"⁵⁸ case.⁵⁹ It can be argued that the scope of protection has been broadened,⁶⁰ and CJEU made it clear in this case that these functions are also protected under Article 5/1(a) of TMD.⁶¹ The recognition of these functions and the scope of protection may offer another perspective on what can be considered infringement as well.

CJEU elaborates on advertising function on "*Google V Louis Vuitton*"⁶² case, stating that the only aim of mark's proprietor is not only indicating its commodities and services' source, but using it for the purposes of advertising devised for informing and persuading the purchasers as well. As for the investment function,

⁵⁷ Rea, Alison. *UK: Brand Value & The Communication/ Advertising/ Investment Functions: An Irrational Basis For Trade Mark Protection?*, 29 November 2011 <https://www.mondaq.com/uk/trademark/154714/brand-value-the-communication-advertising-investment-functions-an-irrational-basis-for-trade-mark-protection> (online on 07.10.2021)

⁵⁸ See. CJEU, *L'Oreal V Bellure* (C-487/07), 18/06/2009: "...these functions include not only the essential function of the trade mark, which is to guarantee to consumers the origin of the goods and services, but also its other functions, in particular that of guaranteeing the quality of the goods or services in question and those of communication, investment or advertising..."

⁵⁹ Wright, Sarah and Mattila, Kaisa. "Has the ECJ's expanded list of functions widened the scope of trademark protection?" *World Trademark Review*, December/January 2014, p.79.

⁶⁰ Senftleben, Martin. "Function Theory, and International Exhaustion-Why It Is Wise to Confine the Double Identity Rule to Cases Affecting the Origin Function." *European Intellectual Property Review*, 2013, p. 5.

⁶¹ See. Trade marks Directive Article 5 "A trade mark shall not be registered or, if registered, shall be liable to be declared invalid where: (a) it is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for or is registered are identical with the goods or services for which the earlier trade mark is protected;"

⁶² CJEU, 23/03/2010, cases C-236/08-238/08, *Google France and Google v Louis Vuitton*.

CJEU defines it as the usage of the mark “to acquire or preserve a reputation capable of attracting consumers and retaining their loyalty” on *Interflora V Marks & Spencer* case.⁶³

It can be said that a powerful bond is formed between the brand and the consumer over time mostly thanks to the advertising function of trademark, in the most traditional manner. This perception of brand by the customer is initially created by the efforts of the trademark owner, thus via investment and advertising. Also, it must not be neglected that, advertising is, in the simplest sense, a tool to communicate with the consumer and the consumer recognizes the goods and services and purchase them through trademark.⁶⁴ Therefore, by definition, the brand image is formed by the hybrid teamwork of these functions and these further functions are usually fulfilled by while not necessarily well-known marks, however, by marks with a repute.

As a result of this brand image formed, the consumers no longer just purchase the goods and services, but they also purchase the brand image, the experience, and in some instances, a certain lifestyle that comes with the trademark. Thus, needless to say, these functions and the protection which comes with it are essential for the modern trademark law in modern day market which a trademark is no longer just an origin/source identifier.⁶⁵ Connection amongst functions of trademark and infringement and dilution of trademarks which is mentioned here will be elaborated later in other sections.

2. WELL-KNOWN TRADEMARKS

2.1. Concept of Well-Known Mark

While there is no simple definition to well-known mark, it may be said these marks are those that are recognized as belonging to a specific trademark owner even if they are not necessarily registered in their respective countries.⁶⁶ Well-

⁶³ CJEU, 22/09/2011, case C-323/09, *Interflora v Marks & Spencer*.

⁶⁴ Arkan, Sabih. *Marka Hukuku*. V I, p. 39.

⁶⁵ Senftleben, Martin. “Trade Mark Protection - A Black Hole in the Intellectual Property Galaxy.” *International Review of Intellectual Property and Competition Law*, Vol. 42, No. 4, 2011, pp. 383–387.

⁶⁶ World Trade Organization, Module III, Trademarks, p.64.

known trademarks do not have a direct definition either on Turkish legislation or international treaties, however, the elements which compose a well-known trademark and the criteria used to describe it will be explained below in more detail in the light of legislation in force, doctrine, international agreements and organizations.

Whereas well-known marks, or famous marks, were used in practice and had an effect in the public eye and in the market for the longest time, it was not until Paris Convention that the concept was acknowledged legally. The concept of “well-known trademark” as a legal term was firstly recognized on Paris Convention dated 1883. Afterwards, it was also addressed by other international treaties and organizations such as TRIPS and WIPO as well.

The reason that there is no clear and direct definition in various legal contexts is that the evaluation and determination of these trademarks heavily vary case-by-case, therefore there is a great risk of the concept being greatly narrowed or enlarged if the practice is applied as a pattern. There is a risk that the well-known marks would not be protected fairly in this case.⁶⁷

Due to this, there is no united standard which is used to identify what exactly may be considered as a well-known trademark, however there are some commonly recognized qualities which are possessed by well-known trademarks.

Perhaps the most significant characteristic of the well-known marks is that protection level in this type of trademarks is greater in comparison to ordinary marks due to their relatively high reputation.⁶⁸ This is also the most crucial and desired result of gaining well-known mark status legally since this status brings forward exceptional protection and other benefits whether the mark is registered or not.

However, it can be said that this is also a natural outcome of a greater need for protection when it comes to well-known trademarks. With that said, the concept,

⁶⁷ Dirikkan, Hanife. *Tanınmış Markanın Korunması*. Seçkin Yayıncılık, 2003. p. 87-88.

⁶⁸ Ercan, Tayfun, and Nebile Teke Akbulut. *Tanınmış Marka Kavramı, Hukukten Korunması Ve Uluslararası Ticaretteki İşlevi*. Adalet Yayınevi, 2020, p. 35.

the criteria, and well-known trademarks' protection scope shall be discussed more in detail below, according to various legislations, case law and specifically doctrine as direct definition cannot be found of well-known marks within relevant regulations.

2.2. Well-Known Marks within the Context of Paris Convention for the Protection of Industrial Property (1883)

2.2.1. Historical Aspect and Legal Structure of Paris Convention

This convention for the protection of industrial property rights has originally been signed by 11 parties,⁶⁹ on 20th of March 1883, in Paris.⁷⁰ Türkiye was not one of the original parties which has signed this treaty, however the pact came into force in 1930 in Türkiye too. As of 2022, Paris Convention has been signed by 179 countries, which makes it one of the most significant pacts for intellectual property rights worldwide.

It also bears importance as it is one of the first treaties as well, which is formed due to the intellectual property right protection necessity internationally. Right owners faced a lot of difficulty in protecting these rights globally as the laws regarding the protection of these rights are diverse and application for registration had to be made accordingly in various countries. The need for some sort of standard and harmonization for the protection of intellectual property has increased even more mostly due to the progress in industrial production and the growth in international trade, making a regulation a necessity at this point.⁷¹ Paris

⁶⁹ The original signing members are Belgium, Brazil, France, Guatemala, Italy, the Netherlands, Portugal, El Salvador, Kingdom of Serbia, Spain, Switzerland.

⁷⁰ Paris Convention for the protection of industrial property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967. <https://treaties.un.org/Pages/showDetails.aspx?objid=080000028011642b&clang=en> (online on 01.02.2022)

⁷¹ WIPO National Seminar on Intellectual Property for Faculty Members and Students of Ajman University, *The International Protection of Industrial Property: From the Paris Convention to The Agreement on Trade-Related Aspects of Intellectual Property Rights (The TRIPS Agreement)*. Lecture prepared by Dr. Michael Blakeney, Director, Queen Mary Intellectual Property Research Institute, Center for Commercial Law Studies, University of London, London, 2004.

Convention is a result of this necessity finally taking form as an international treaty.

The Convention is mainly composed of three parts, which are: “*national treatment, right of priority, and common rules*”. National treatment has been regulated within Art. 2 and Art. 3, it essentially means that the member countries shall provide equal protection for other member countries’ nationals like their own, with regards to intellectual property rights.⁷²

Right of priority was regulated on Article 4 of the Convention.⁷³ This priority right has been acknowledged not only for trademarks, but also for patents, utility innovations, industrial designs as well. According to this regulation, the applicant who applies in one of the member states may claim protection in any other contracting state within 12 months for patents and utility models, and 6 months for industrial designs and trademarks.⁷⁴

Consequently, the second submission is going to be considered as to have been made on the same date as the first submission. These principles may be considered as milestones in trademark protection, ensuring Paris Convention’s great role in bringing an international standard and unification.

In addition to this, it is important to specify that treaty is also a milestone regarding well-known mark conception and well-known mark protection within a worldwide setting. To recap, “well-known mark” legal term was acknowledged and used in Paris Convention for the first time. However, well-known trademarks do not have a direct definition in Paris Convention, similar with other legislations.

⁷² See. Article 2 of Paris Convention for the Protection of Industrial Property, National Treatment for Nationals of Countries of the Union.

⁷³ See. Article 4 of Paris Convention for the details regarding Right of Priority.

⁷⁴ Tekinalp, Ünal. *Fikir Mülkiyet Hukuku*. p. 384; Gökmen, Özlem. “Marka Hukukunda Rüçhan Hakkı.” *Çankaya Üniversitesi*, 2015, p. 12.

This is mostly due to the circumstances surrounding well-known marks, bearing in mind that the aspects to consider change case by case and the fact that it will not be appropriate to restrain it by stating a clear and direct definition.⁷⁵

2.2.2. Well-Known Marks in Accordance with Article 6bis

Provisions regarding well-known trademarks have been regulated in Art. 6bis, which was added in 1925 on The Hague Revision Conference.⁷⁶ Afterwards, it has been amended in 1934 with Sixth Conference of Revision in London, and again in 1958, with Seventh Revision Conference in Lisbon.

According to Art. 6bis, requirements for protecting reputed trademarks are as follows: The mark should be well-known in relevant state which the protection is requested and the decision of whether it is well-known or not shall be made by member state's establishments where protection has been pursued. It will be deemed enough for the trademark to be well-known in the relevant country, and the protection shall be provided even if it is not necessarily used in that country. Therefore, protection shall also be provided to reputed marks that have not been recorded in the relevant state protection has been requested in.⁷⁷

Arkan states that within Convention Art. 6bis' context, it will be adequate that relevant trademark is recognized in a large portion of Türkiye as belonging to

⁷⁵ Özdemir, Kubilay. "Tanınmış Marka Kavramı ve Ulusal Uluslararası Uygulamaları." *Türk Patent Enstitüsü Markalar Dairesi Başkanlığı*, 2008, p.7-8.

⁷⁶ Dirikkan, Hanife. p. 51.

⁷⁷ Paris Convention, Article 6bis <https://wipolex.wipo.int/en/text/288514> (online on 14.11.2021) Article 6bis

Marks: Well-Known Marks

(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

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

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

the persons who are eligible to the protection granted by the Convention. However, he claims that in order to acknowledge the mark in question as well-known, it will be obligatory that mark which has become a symbol of quality to be recognized in outside of the relevant circle as well, thus by persons who are not related to the commodities and services bearing the mark.⁷⁸

Similarly, Tekinalp also adopts this view and states that well-known marks within Turkish trademark law context and marks referred in Article 6bis of Paris Convention are different concepts. He expresses that the term in the Convention refers to the trademarks which are recognized domestically or in abroad, even if not worldwide, and belonging to a citizen of Convention's member states or to persons residing in one of those countries or owning a commercial or industrial enterprise in those countries. Therefore, well-known trademark under Paris Conv. context, which is also referred as "*notorisch bekannte Marken*" in German trademark law doctrine, and well-known mark convey different notions.⁷⁹

It will not be a necessity for well-known trademarks within Convention's framework to be registered or even actively used in Türkiye to be entitled to the rights granted by the Convention. However, it is argued that concerned mark should at least be acknowledged in Türkiye.⁸⁰

Turkish High Court also expresses this matter clearly in several decisions. In decision no. 2004/12103, it is stated: "...it has long been adopted that a well-known trademark registered in a country that is a party to the Paris Convention and products bearing this trademark will be protected in domestic law pursuant to the Article 6bis of the Convention, even if it is not known in our country..."⁸¹

⁷⁸ Arkan, Sabih. *Marka Hukuku*, VI. p.93.

⁷⁹ Tekinalp, Ünal. "Yeni Marka Hukukunda Tescil İlkesi ve Tescilsiz İşaretlerin Hukuki Durumu." *Kenan Tunçomağ'a Armağan*, 1997, p. 472.

⁸⁰ Tekinalp, Ünal. p. 473.; Ocak, Nazmi. "Markalarda Tescilin Sağladığı Korumanın Kapsamı." *Ali Bozer'e Armağan*, 1988, p. 284.; Yasaman, Hamdi. "Paris Anlaşması Anlamında Tanınmış Markalar." *GSÜHF Dergisi*, Vol. 2, 2002, p. 304-305.

⁸¹ Turkish High Court, 11th Civil Chamber, No. 2004/1146 - 2004/12103, d. 09/12/2004.

Similarly, in another ruling, it has been expressed by the High Court: *"...according to the established practice, even if the well-known trademark and the goods belonging to the proprietor of this mark registered in a country that is a party to the Paris Convention, to which Türkiye is also a party, have never been brought to Türkiye, they will be protected in our country in accordance with Article 6bis of the said Convention..."*⁸²

In spite of these rulings, several scholars, such as Ocak as mentioned above and Suluk have argued that recognition in Türkiye must also be sought in the protection within the framework of Convention's Art. 6bis.⁸³

Nevertheless, it would be essential to state protection is only provided for the registration of the same or similar commodities and services. There is no regulation in the Convention regarding the protection for the registration of the different commodities and services.⁸⁴

Delivering minimum protection according to Paris Conv. Art. 6bis is necessary for member states, however it is very well possible for member states to legalize a broader protective framework for reputed trademarks than it is regulated in the Convention.⁸⁵

In conclusion, it can be said that while Paris Convention has done the framework for well-known trademarks, and their protection within a global sense (for the member states), it leaves room for the execution and exact implementation of its regulations regarding protection and recognition of trademarks as a well-known trademark.

⁸² Turkish High Court, 11th Civil Chamber, No. 1999/9678 - 2000/30001, d. 13/04/2000.

⁸³ Suluk, Cahit and Kenaroğlu, Yasemin. *Türk Fikri Mülkiyet Hukukunda Güncel Gelişmeler*. İstanbul Ticaret Odası Yayınları, No: 2011-32, 2012, p. 56.

⁸⁴ Şaban, Kayıhan. "Yargıtay Kararları Işığında Tanınmış Marka." *Erzincan Hukuk Fakültesi Dergisi*, Vol. 7, No. 1 –2, 2003, p. 427; Ercan, Tayfun, and Nebile Teke Akbulut. *Tanınmış Marka Kavramı, Hukukten Korunması Ve Uluslararası Ticaretteki İşlevi*. Adalet Yayınevi, 2020, p. 42; Gürbüz Güngör, Esin. "Paris Sözleşmesi Kapsamında Tanınmış Markaların Sınai Mülkiyet Kanunu'na Göre Korunması." *International Journal of Economic and Administrative Studies*, 2017, p. 297.

⁸⁵ Dirikkan, Hanife. *Tanınmış Markanın Korunması*. Seçkin Yayıncılık, 2003, p. 52; Ercan, Tayfun, and Nebile Teke Akbulut. p. 42.

2.3. Well-Known Marks within the Context of Trade-Related Aspects of Intellectual Property Rights Agreement

2.3.1. Historical Aspect of TRIPS Agreement

It would be necessary to have similar legal protection system for ensuring intellectual property rights protection within a global setting. Trade-Related Aspects of Intellectual Property Rights, also known as TRIPS, is a treaty that came into force as an extension to the Agreement Establishing the World Trade Organization, due to this necessity in 1995. This treaty was signed by all the member countries, including Türkiye, and it can be considered as the framework regarding intellectual property right protection worldwide.⁸⁶ To be more specific, Paris Conv. Art. 6bis along with TRIPS Art. 16 provide global principles for protecting reputed and famous marks.

The article (Article 16) which regulates protecting well-known marks actually originated from the exposure draft prepared in 1990, by U.S. This particular draft proposed that the parties of the agreement may refuse the registration requests of marks that can generate confusion risk with the reputed marks, prevent such parties' activities, and it will be possible to invalidate these trademarks, if they have been registered already. It also established that the extent of the geographical area which the trademark is being used and the international promotional activities regarding the trademark must be considered for determining well-known trademarks. Aside from "geographical area extent" part, the draft is mostly matching to the relevant provision in TRIPS Agreement.⁸⁷

2.3.2. Comparison of Article 6bis of Paris Convention and Article 16 of TRIPS with Regards to Well-Known Marks

⁸⁶ Bozbel, Savaş. *Fikri Mülkiyet Hukuku*. Oniki Levha Yayınları, 2015, p. 23.

⁸⁷ Dilmaç Şule. *Uluslararası Metinlerde tanınmış Marka Ve Markanın Sulandırılması*. Seçkin Yayıncılık, 2014. p. 103; Carvalho, Nuno Pires De. *The TRIPS Regime of Patent Rights*. Kluwer Law International, 2010, p. 274.

Similar to Paris Convention, TRIPS only exhibits the minimum criteria that should be complied by member states as well, even though it provides significant protection on trademarks, and it includes the definition of trademarks, rights which can be used upon registration of trademarks, measures which may be enforced in case of infringement, exceptions and the scope and term of this protection.

Indisputably, TRIPS has a wider approach on protecting intellectual property rights, specifically regarding trademarks, when compared with Paris Convention Article 6.⁸⁸ Most significant differences are that it extended Paris Conv. Art. 6bis by including service marks. Additionally, it provided that member countries must also consider if a trademark is reputed in a specific sector, even without country wide acknowledgement. It also provided that the publicity and advertising of the trademark will be shown regard to as well, irrelevant to the actual use.⁸⁹

As clearly observed on the provision, TRIPS Art. 16/3 significantly increases the protection granted to the reputed marks by Paris Conv. Art. 6bis regarding commodities and services not similar the trademark is registered granted that this kind of use indicates some kind of connection to the well-known mark in question, and this association damages well-known mark owner's

⁸⁸ World Trade Organization / Documents / Legal Texts / TRIPS

https://www.wto.org/english/docs_e/legal_e/27-trips_04_e.htm (online on 16.05.2022)

"Article 16

Rights Conferred

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

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

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

⁸⁹ USPTO, Trademark Policy, Well-known Marks <https://www.uspto.gov/ip-policy/trademark-policy/well-known-marks> (online on 16.05.2022)

interests. It would be accurate noting inclusion of protecting well-known mark concerning different products and services in TRIPS Agreement was a consequence of influence by the dilution doctrine.⁹⁰

In conclusion, inclusion of the service marks with regards to trademark protection, consideration of trademark's public acknowledgement in related market due to promotional activities in establishing a well-known trademark, and lastly, protecting well-known trademarks for commodities and services that are not same as or related to the ones which the mark is registered for are the most significant novelties brought up by TRIPS. Therefore, it is worth noting TRIPS Agreement was and still is a landmark for protecting well-known marks worldwide as it greatly extended the protection required by Paris Convention to all World Trade Organization countries.⁹¹

2.4. Well-Known Marks within the Context of Turkish Trademark and Case Law

Well-known trademark as a concept and legal term is referred both in court decisions and Turkish legislation as well. This is no surprise as Türkiye is a party in Paris Conv. and TRIPS as well.

Turkish High Court describes well-known trademark in one of their rulings as *"...an association of guarantee, quality, strong advertising, which are connected to a widespread distribution system, and which emerges as a reflex by people in the same environment, regardless of geographical border, culture, age, whether it be a customer, relative, friend or enemy (towards to a person or enterprise) ..."*.⁹²

The High Court also expresses in another decision in case a mark has been recorded in more than one state, it will automatically gain well-known trademark

⁹⁰ Çolak, Uğur. "Paris Sözleşmesi 6bis Maddesi Anlamında Tanınmış Markalar Bu Tanınmışlığın Nasıl Belirleneceği Sorunu ve WIPO Kriterleri." *Ankara Barosu FMR Dergisi*, 2004/2, p.24-25.

⁹¹ Tam, Phan Ngoc. p. 76-77.

⁹² Turkish High Court 11th Civil Chamber, No. 1997/5647 - 1998/1704, 13/03/1998.

status in Türkiye as well and it ruled that the matter of recognition within the relevant circle should be investigated beforehand.⁹³

The Court adopts this principle in the following rulings as well. It is stated in decision no. 1999/136: “...the plaintiff's trademark has been registered in more than one hundred countries since 1983, thus it is considered as well-known mark worldwide...”⁹⁴

Likewise, in decision no. 1998/5146, it was expressed that the defendant's claim that the registration in Türkiye was made due to not being aware of said well-known trademark, which has been registered in 22 countries was not accepted as a justification by the Court considering they are in the relevant business circle.⁹⁵

Meanwhile in Turkish doctrine, well-known mark was described by Yasaman as a trademark, which belongs to a member state citizen within the Convention or to persons residing in one of those countries or persons which own an industrial enterprise in said countries, and a mark at least acknowledged by related circles domestically or abroad even without global recognition.⁹⁶

Similarly, Tekinalp also refers to Paris Convention when describing well-known marks, stating that the notion of well-known trademark indicates the trademarks which are renowned by the related circles domestically & abroad, even if not worldwide; and not just renowned in one or couple of provinces in a country, and belonging to the citizens of one of the member states of the Convention or to persons who are resident in one of those countries or who have a commercial or industrial enterprise.⁹⁷

Arkan describes well-known marks as trademarks which are not only known by the related trade circles or consumers of the commodities and services belonging to the proprietor of that mark, but also by those who are unrelated to

⁹³ Turkish High Court, 11th Civil Chamber, No. 1997/2708, 10/04/1997.

⁹⁴ Turkish High Court, 11th Civil Chamber, No. 1999/5162 - 1999/136; Yasa Dergisi V. XIX/221, p. 590-591.

⁹⁵ Turkish High Court, 11th Civil Chamber, No. 1998/1734 - 1998/5146.

⁹⁶ Yasaman, Hamdi. “Tanınmış Marka Kriterleri ve İspatı Sorunu.” *Prof. Dr. Hüseyin Ülgen’e Armağan*, Vol. I, 2007, p. 1189; Aktekin, Uğur; Alkan, Güldeniz Doğan; Sayar, İbrahim Barış. “Türk Hukuku Uygulamasında Tanınmış Marka Kavramı ve Koruma Kapsamı.” *Ticaret ve Fikri Mülkiyet Hukuku Dergisi*, Vol.2, No.2, 2016, p. 3.

⁹⁷ Tekinalp, Ünal. *Fikri Mülkiyet Hukuku*, p. 411.

products or services bearing that sign. He also expresses that these types of marks have already exceeded the scope of their registered commodities and services and have become an advertising tool as a quality symbol in their own right.⁹⁸

Well-known mark concept is regulated in Turkish IPC Law, numbered 6769, dated 22/12/2016. The most important provision regarding the subject is Article 6/4, which regulates that “*Trademark applications that are identical or similar to the well-known marks within the context of Article 6bis of the Paris Convention, shall be refused upon opposition in respect of the identical and similar goods or services.*” under the section relative reasons for refusing to register.⁹⁹

As it is understood, there is no definition in the Article in question as well, but a referral to Paris Convention. The fifth paragraph of the same Article also regulates the well-known trademarks registered in Türkiye, by using "due to the level of recognition it has reached in Türkiye" expression.¹⁰⁰

This “recognition” referred in the provision does not necessarily have to be nation-wide. It should be understood that this phrase indicates that depending on the circumstances, it will be enough that the trademark in question is recognized by the relevant consumer segment in a significant part of Türkiye.

As stated in the justification of the law, this regulation has ensured that Turkish legislation is in compliance with European Union law and international practices. Especially fifth paragraph is extremely important, considering well-known mark dilution and gaining unfair advantage from such marks conditions are regulated on this provision in accordance with TRIPS and 2015/2424 EU Trademark Directive.¹⁰¹

2.5. Well-Known Marks in Accordance with TÜRKPATENT

⁹⁸ Arkan, Sabih. *Ticari İşletme Hukuku*. Banka ve Ticaret Hukuku Araştırma Enstitüsü, 2020, p. 265.

⁹⁹ The old legislation, Decree-Laws No. 556, had this as an absolute ground for refusal in trademark registration. This was one of the main differences regarding registration process with EU practice.

¹⁰⁰ Gürbüz Güngör, Esin. “Paris Sözleşmesi Kapsamında Tanınmış Markaların Sinai Mülkiyet Kanunu’na Göre Korunması.” *International Journal of Economic and Administrative Studies*, 2017, p. 294.

¹⁰¹ Law on Industrial Property Draft <https://www5.tbmm.gov.tr/sirasayi/donem26/yil01/ss341.pdf> (online on 22.01.2022)

TÜRKPATENT is authorized, alongside with Turkish Courts for recording and acknowledgement of the well-known marks.¹⁰² The Office published the well-known trademark list determined until that date with the "Well-known Marks Bulletin" in 1997, and it has continued to issue several bulletins ever since. While there have been contrasting decisions of Turkish Supreme Court in the recent years, TÜRKPATENT still continues on receiving applications to this date.¹⁰³

Similarly, while there is no clear definition of well-known mark by TÜRKPATENT, there are of course some criteria the Office uses when considering the applications of trademark owners to be registered. Some of the criteria which are taken into account during the registration assessment are as follows:

- Detailed information about the history of the trademark, such as length of use and registration.
- The geographical area and scope of the trademark's registration both in Türkiye and abroad.
- Promotion activities of the trademark in question, geographical area, and scope of these promotion activities, if there are any other activities which involve promotion other than advertising, such as displaying of the goods of the said brand at fairs etc.
- If there's a court ruling which demonstrates or accepts the mark's well-known nature, or if mark's holder demonstrated active effort on protecting this trademark, such as legal procedures, seizures, injunctions, unfair competition claims.
- Distinctive quality of the said trademark.
- Surveys and polls which are done regarding the recognition level of the trademark in public.

¹⁰² See. Turkish High Court 11th Civil Chamber, *Saray Milkinis v. Milka Milkinis*.

¹⁰³ See. Turkish High Court 11th Civil Chamber, No. 2019/2980.-2020/991, d. 05/02/2020.

- Information regarding the trademark holder (firm), such as number of employees, size of the firm, turnover, paid-in capital, branches, service network.
- Trademark's association with the goods and service category it applies to, whether the public/consumers instantly recognize and associate the text/shape trademark owner uses with a certain type of product.
- Any type of awards or quality guarantee certificates which mark's possessor or commodities or services of trademark's holder received.
- Knowledge regarding the importation and exportation of the products which carries the trademark in question and its distribution channels.
- Information on whether the trademark has ever been subject to a purchase and in its assessed valuation.
- Extent of recognition of said trademark by public and period of such acknowledgment.
- Extent of portfolio and categories of the commodities or services included on recording.
- Information regarding trademark infringement occurring resulting from the mark's well-known quality, and the infringement's impact on the trademark holder.
- Any kind of document which may be used to prove the criteria stated above and well-known aspect of the trademark.¹⁰⁴

While the criteria expressed in the list above is in no way exhaustive, they are actively used for determining if a mark is a well-known mark, and subsequently whether it can be registered as such and enjoy this type of protection granted to reputed trademarks.

¹⁰⁴ TÜRKPATENT, Trademark Bulletin No. 109, 17.09.2004.

2.6. Well-Known Marks in Accordance with The World Intellectual Property Organization

2.6.1. Historical Aspect and Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks

Paris Conv. and TRIPS, while establishing a legal framework for international intellectual property protection, only served as declaration of the minimum requirements which must be followed by member states. With the purpose of stipulating a standard in details and particulars of how to exactly implement the principles for the members, considering the law in their respective countries greatly vary, WIPO formed a Committee of Experts on Well-known Trademarks in 1995.¹⁰⁵

Subsequently in 1999, WIPO, along with Paris Union issued a Joint Recommendation,¹⁰⁶ providing suggestions concerning well-known mark protection, taking provisions in Convention into consideration and thus providing a global standard on how to implement the requirements set by the Convention and TRIPS Agreement.

This Joint Recommendation also serves as a guideline as it includes recommendations regarding the standards which may be used in the determining of well-known marks. As it is stated, these are merely suggestions and member states may benefit from these provisions as their authorized institutions or competent judicial authorities determine well-known marks. For Türkiye, it is accepted that Turkish Courts and Turkish Patent and Trademark Office are authorized regarding determining of reputed marks.¹⁰⁷ As it was explained with

¹⁰⁵ Tam, Phan Ngoc, "Well-known trademark protection. A comparative study between the laws of the European Union and Vietnam." *The Faculty of Law, Lund University*, 2011, p. 79.

¹⁰⁶ The Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization Joint Recommendation <https://www.wipo.int/edocs/pubdocs/en/marks/833/pub833.pdf> (online on 15.08.2022)

¹⁰⁷ Dilmaç, Şule. p. 56.

more details above, the criteria implemented by TÜRKPATENT is similar to those of WIPO.

2.6.2. Criteria in Joint Recommendation on Determining the Well-Known Marks

Joint Recommendation provides several criteria on determining if a trademark may be considered well-known. Member States, however, are free to benefit from these guidelines. The criteria stated in Joint Recommendation are as follows¹⁰⁸:

- Trademark's recognition and knowledge level within related part of public.
- Period, geographical region and level of trademark's usage.
- Period, geographical region, and the extent of promotions, advertisements, presentation at the exhibition or fairs, of products or services that trademark is recorded for.
- Period and geographical coverage of other recordings or registration submissions which affect the trademark's usage or knowledge.
- Any type of documents which demonstrate active effort on protecting the trademark in question, and specifically the recognition level of the mark by the proficient authorized institutions or judicial authorities.
- The trademark's scale of recognition by the competitors and its place in the market.
- The value linked with the trademark.

The standards which may be used in determining of a well-known mark are certainly not restricted to the ones stated above. As there are other factors which may be considered as well, it is very well possible that only few of these criteria will be deemed enough.¹⁰⁹ Turkish High Court refers to Joint Recommendation in

¹⁰⁸ See Article 2/1 of the Joint Recommendations.

¹⁰⁹ Dilmaç Şule. p. 57.

its rulings as well and it can be said that these criteria are actively used in determining reputed trademarks within Turkish litigation law.¹¹⁰

Lastly, it might be also important mentioning that WIPO has adopted the approach that the trademark in question shall be acknowledged as a reputed trademark provided it is recognized in at least one related sector. “Relevant sector” here refers to the existing, or potential consumers, the persons responsible for the distribution channels, and related work circles of the commodities and services which the trademark applies to, however this list is not exhaustive either.¹¹¹

3. DILUTION

3.1. Concept and Historical Aspect of Dilution

The origins of the dilution as a legal concept date back to the United States, specifically to “*The Rational Basis of Trademark Protection*” article written by Frank Schechter in 1927.¹¹² It brought forward a new type of protection concept for the trademarks based on the distinctive quality of the trademark rather than the traditional approach which focuses on the likelihood of confusion in infringement.¹¹³

With that said, similar protection policies have been put in practice in courts even long before this article, such as Germany, England, and United States.¹¹⁴ “ODOL” case of Germany in 1924 is a great example of it. “ODOL” is a famous mark for mouthwash product and in this particular case, German Court ruled that

¹¹⁰ Turkish High Court, General Assembly of Civil Chambers, No. 2005/11-476 - 2005/483, d. 21/09/2005; Orhan, Ali. *Yargıtay Kararları Işığında Tanınmış Markalar*. Arıkan Yayıncılık, 2007, p.20.

¹¹¹ See Article 2/2 of the Joint Recommendations.

¹¹² Schechter, Frank I. “The Rational Basis of Trademark Protection.” *Harvard Law Review*, Vol. 40, No. 6, 1927, p. 813.

¹¹³ Fhima, Ilanah Simon. *Trademark Dilution in Europe and the United States*. Oxford University Press, 2011, p. 4.

¹¹⁴ Bowen, Terry R. “The Federal Trademark Dilution Act of 1995--Does It Address the Dilution Doctrine's Most Serious Problems?” *DePaul Journal of Art, Technology & Intellectual Property Law*, Vol. 7, 1996, p. 3; Schechter, Frank I. “The Rational Basis of Trademark Protection.” *Harvard Law Review*, Vol. 40, No. 6, 1927, p. 813.

famous trademark's possessor would have the right for asking cancellation of "ODOL" mark registered for steel products. The reasoning behind this ruling was that the mark would "...lose in selling power if everyone used it as the designation of his goods..." taking into consideration that the famous mark holder had every right to take action in order to make sure its mark is not diluted.¹¹⁵ This case is also important due to the fact that the term "dilution" is used for the first time in a court ruling.¹¹⁶

The need for this kind of protection has arisen due to the fact that even though at times the consumer is aware that this second mark, which is used in unrelated products or services, is not exactly same with this famous trademark, it is still possible that the way this second mark is used to cause harm to well-known trademark's repute and dilute the trademark's distinguishing nature. It is very important for the well-known mark that this type of use, which is not an "infringement" in the traditional sense, to be preventable by law. This necessity brought forward the notion of "dilution".

Traditional trademark infringement and trademark dilution is different in the way on the claim for dilution, misperception risk for consumers is not an obligation. The other vital factor to consider is that the main interest which is protected in trademark dilution is the distinctive nature of the trademark with a repute. Dilution theory was acknowledged considering that using well-known marks on different products and services to cause lessening their distinctiveness quality or harm to famous mark's repute, even if there is no possibility of confusion for the consumer.¹¹⁷

¹¹⁵ Alexander, Miles J. and Heilbronner, Michael K. "Dilution Under Section 43(C) of the Lanham Act." *Law and Contemporary Problems*, 1996, p. 96.

¹¹⁶ Originally referred as "Verwässerung" (dilution).

¹¹⁷ Yasaman, Hamdi. *Marka Hukuku ile İlgili Makaleler Hukuki Mütalaalar Bilirkişi Raporları*. Vol II, 2005, p. 24; Dilmaç Şule. p. 113.

In case of trademark infringement claims, in principle, mark's proprietor should clearly show possibility of confusion risk in public. However, even if trademark infringement is proven, it does not necessarily mean that the trademark is diluted, and vice versa. Therefore, these two claims must be examined separately and the conditions which are considered are different.

The unique nature of the protection against dilution is that well-known trademark's owner shall acquire the right asking for protection against dilution even if the other party's mark is not used in similar goods and services, which means there is no element of competition between two parties. Thus, it is safe to say that the subject of the protection in this case is the mark's proprietor, and not the consumer's interest, like it is in the traditional trademark protection.¹¹⁸ Dilution theory has been criticized by many based on this, it was also noted that this type of approach did not protect the trade, but rather trademark itself, thus in a way, undermining the basis of the trademark law.¹¹⁹

However, despite all the criticism, with case law dating back to the end of 1800's and Schechter's article as a beginning of the legal discussion, the global trade and developments in intellectual property law made it a necessity to finally recognize this type of mark protection. As a natural result, the protection against dilution had to be regulated in a way that both national and international protection can be fulfilled through legislation and international treaties.

While Paris Convention is among the most significant treaties regarding reputed trademark protection, it did not explicitly regulate protection against dilution, or even used the term. Paris Conv. Art. 6bis regulated that such protection is only provided for the registration of same or related products or services, thus,

¹¹⁸ Fhima, Ilanah Simon. *Trademark Dilution in Europe and the United States*. Oxford University Press, 2011, p. 3; Schechter, Frank I. *The Rational Basis of Trademark Protection*. p. 830-833; Welkowitz, David S. "Reexamining Trademark Dilution." *Vanderbilt Law Review*, 1991, p. 535.

¹¹⁹ Middleton, George. "Some Reflections on Dilution." *Trademark Reporter*, Vol. 42, 1952, p.175-179.; Welkowitz, David S. "Reexamining Trademark Dilution." *Vanderbilt Law Review*, 1991, p. 535.

did not include protection for different goods and services. As it is known, TRIPS Agreement expanded the protection range regarding reputed marks in comparison with Paris Conv. It is stated within Art. 16/3 of TRIPS Agreement that the protection established in Paris Conv. Art. 6bis may be applied to different good and services as well, provided the conditions in Paris Convention Art. 6bis are met. One might argue this regulation was highly influenced by dilution theory, which originated from the United States trademark law, as it expanded the protection for different goods and services.¹²⁰

Considering it was originated from the United States, dilution protection was regulated in several legislations there and following these, there have been similar regulations in EU and Türkiye as well. However, the concept, classification, and conditions for protection against dilution are not regulated completely same in every legal system. While there are several different practices around the world, only the main regulations regarding the matter in the US, EU, and Türkiye will be discussed below more in detail.

As also mentioned briefly above, it is commonly accepted that trademark dilution may occur in two ways: diminishing of the distinctive character and harming of the reputation. These are also referred as *blurring* and *tarnishment*, respectively. Together with blurring and tarnishment, “*gaining unjust advantage*” has been included as well within regulations regarding protection against trademark dilution in EU and Türkiye legislation, unlike the United States. There are several interpretations in doctrine on whether taking unfair advantage can also be considered as dilution, however, it will be discussed in more detail afterwards.

3.2. Comparison of Trademark Dilution with Other Types of Violation of Trademark Rights

3.2.1. Concept of Likelihood of Confusion

¹²⁰ Çolak, Uğur. “Paris Sözleşmesi 6bis Maddesi Anlamında Tanınmış Markalar.” *Ankara Barosu FMR Dergisi*, 2004, p.24-25; Dilmaç, Şule. p. 106.

One of the acts which constitute trademark infringement is using of a sign which is identical with or similar to previous mark, and the sameness or resemblance of products and services covered by the marks, in such manner which cause a misperception risk on public, including possibility of association with the formerly registered mark. This confusion here indicates the misperception to origins/sources of the commodities and services.¹²¹

Misperception risk is also a relative cause for rejection in EU Directive, EU Regulation, and Turkish Industrial Property Code,¹²² which give the prior mark's owner a right to resist the registering, and therefore enable to avoid the infringement before the recording of latter trademark.

A direct definition or a description of what must considered in establishing or associating cannot be provided for likelihood of confusion within the legislation. However, doctrine, litigation law, and EUIPO guidelines provide some descriptions as to understand the notion better. The likelihood of misperception idea from customer perspective in its essence is that it occurs when the consumer face with the risk of purchasing an identical or similar good or service of a different enterprise, assuming that they indeed purchased the goods or services from the enterprise they intended to purchase from, because of the identity or resemblance of trademarks in conflict.¹²³

3.2.1.1. The Scope of Likelihood of Confusion

It has been also established by the litigation law that likelihood of misperception occurs on cases where either people directly confuse conflicting trademarks, mistaking one for another, or indirectly by creating a link between the

¹²¹ Küçükali, Canan. *Marka Hukukunda Karıştırma Tehlikesi*. Seçkin Yayıncılık, 2019, p. 66.

¹²² Article 6 of Turkish Industrial Property Code regulates relative grounds for refusal in registration for the trademarks, Article 6/1 describes likelihood of confusion or association as one of these grounds.

¹²³ Küçükali, Canan. p. 18; Tekinalp, Ünal. *Fikri Mülkiyet Hukuku*. p. 439; Yasaman, Hamdi. *Marka Hukuku*. Vol. I, p.400.

conflicting marks and assuming the commodities and services are related as in from the same or economically associated enterprises.

The second case, where the confusion occurs indirectly by the association is also called “likelihood of association.”¹²⁴ However, it is essential to note conception of possibility of association is not different from likelihood of confusion, or an alternative to it, as affirmed by Court on “*Sabel v. Puma*”.¹²⁵ Instead, it may be considered as a way of defining the scope of possibility of misperception.¹²⁶

“*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*”¹²⁷ judgement examines the scope to this confusion even further, explaining that misperception risk may occur although the public assumes that production place is different for the products and services, as long as the perception is that the products and services have been devised under the supervision of a sole entity.¹²⁸

3.2.1.2. The Criteria in Determining Likelihood of Confusion

Criteria in determining misperception risk can be found within case law. An important case for likelihood of confusion, this time from the US is “*Louis Vuitton Malletier v. Haute Diggity*”,¹²⁹ which will also be examined for parodying use in the following chapters.

United States Court of Appeals presented several factors to be considered in establishing the likelihood of confusion: “(1) *the strength or distinctiveness of the plaintiffs mark*; (2) *the similarity of the two marks*; (3) *the similarity of the goods or services the marks identify*; (4) *the similarity of the facilities the two parties use in their businesses*;

¹²⁴ EUIPO Trademark Guidelines, C.3.1.

¹²⁵ C-251/95 - *SABEL v Puma, Rudolf Dassler Sport*, ECLI:EU:C:1997:528.

¹²⁶ *SABEL*, para. 18.

¹²⁷ C-39/97, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*, ECLI:EU:C:1998:442.

¹²⁸ *Canon*, para 29-30.

¹²⁹ *Louis Vuitton Malletier v. Haute Diggity*, 507 F.3d 252 (4th Cir. 2007).

(5) the similarity of the advertising used by the two parties; (6) the defendant's intent; and (7) actual confusion.”¹³⁰

“Distinctiveness” concept, which is referred in *Louis Vuitton* case, is equally important in establishing likelihood of confusion for CJEU as well. The Court expresses clearly in *Sabel* case that grander the distinctiveness is, the grander shall be the probability of confusion for previous mark.¹³¹ As discussed within “Distinctiveness” section, the distinctive nature of a trademark has a great influence on the extent of protection as well for the mark in question. Consequently, degree of distinctiveness may become a deciding factor in evaluating likelihood of confusion. This factor actually applies to trademark dilution as well, even if the protection against trademark dilution shall just be applicable concerning reputed trademarks.

Similarity of the two marks must be examined on each case based on if there is a confusion with reference to overall look, esthetics, visuals, shade, structure, volume, and shape.¹³² In addition to trademarks’ resemblance, the similarity for commodities and services these marks are registered in or used in must be taken into account as well. This must not be confused with double identity rule, which is an absolute ground for refusal in registration. An ordinary likeness in the signs and commodities shall be deemed enough when assessing if infringement has occurred through likelihood of confusion.

Turkish High Court expresses that establishment of any sort of connection between the conflicting marks in the public eye shall be deemed enough in deciding the likelihood of confusion.¹³³ This public eye refers to the perception of

¹³⁰ *Louis Vuitton Malletier v. Haute Diggity*, 259.

¹³¹ *SABEL*, para. 24.

¹³² Dönmez, İrfan. *En Son İçtihatlarla Açıklamalı Markalar ve Haksız Rekabet Davaları*. Seçkin Kitabevi, 1987, p. 85.

¹³³ Turkish High Court, 11th Civil Chamber, No. 2003/4003, 2003/10839 D., 13/11/2003.

“average consumer”,¹³⁴ which represents a hypothetical model of consumer with average knowledge, ability and understanding.¹³⁵ However, this model is assessed based on the commodities and services involved since the typical model of the consumer segment addressed by each type of product may differ from one other. Therefore, the evaluation regarding the consumer perception must be made case by case in determining the likelihood of confusion.¹³⁶

3.2.1.3. Double Identity Rule and Comparison of Concepts of Double Identity and Likelihood of Confusion

Art. 7/2 of IPC and Art. 5/1 of EU Directive¹³⁷ regulate the double identity rule which refers to exclusive rights granted to proprietors of registered trademarks on using the mark along with preventing uses by a third party with the same mark on same products and services.¹³⁸ Double identity is established when both the conflicting signs and products or services are the same, or identically alike.¹³⁹

This infringement type occurs in case of direct confusion concerning the identical sign and commodities and services in the extent protected by registering, whereas likelihood of confusion refers to same or related sign along with same or related commodities and services protected by registration. There will be no requirement for discussion on misperception risk or association for double identity and it will be considered as trademark infringement and as absolute ground for refusal in registration.¹⁴⁰

¹³⁴ Turkish High Court, 11th Civil Chamber, No. 2015/11795, 2016/8786 D., 14/11/2016.; Turkish High Court, 11th Civil Chamber, No. 2015/2975, 2015/8058 D., 10/06/2015.; Karaaslan, Pelin. “Markaların Kapsadığı Ürünler Arasındaki Benzerlik İncelemesinde Lisans Uygulamalarının Rolü.” *SÜHFD.*, C. 28, S. 3, 2020, p. 894-895.

¹³⁵ Case C-120/04, *Medion AG v Thomson*, Judgement of the Court (Second Chamber), 6 October 2005.

¹³⁶ Arkan, Sabih. *Marka Hukuku* Vol. I., p. 103.

¹³⁷ EU Directive no 2015/2436.

¹³⁸ Arıkan, Özgür. “Unsettled Matter of European Trade Mark Law: Double Identity Rule -Burden of Proof Issue-.” *İstanbul Medeniyet Üniversitesi Hukuk Fakültesi Dergisi* 1, 2016, p.179.

¹³⁹ EUIPO, Trademark Guidelines 2.1.

¹⁴⁰ Arkan, Sabih. *Marka Hukuku*, Vol. I. p. 97.

3.3. Comparison of Concepts of Dilution and Likelihood of Confusion

Although, while there are some common elements, infringement which occurs by likelihood of confusion and infringement which occurs by dilution are in contrast in their essences. Likelihood of confusion concept depends on misperception threat which can occur on a segment of society, and this is the core of what establishes the infringement. However, in trademark dilution, the confusion for purchasers on the commodities and services' origin/source does not matter. Dilution may be established even in nonexistence of misperception danger, and anti-dilutive policies protect other functions of the trademark, rather than its origin function unlike traditional trademark protection.

One of the most important differences between the two types of infringement is that in the protection against dilution, although it may be considered as a factor, it is not a necessity for products and services which conflicting trademarks being used for being identical/alike.¹⁴¹ Considering the extent of this protection, only marks with a repute will have the opportunity of benefiting from anti-dilution protection, whereas in the traditional trademark protection with regards to likelihood of confusion, it is deemed enough that only a portion of the consumer group is affected for the infringement to occur.¹⁴² Trademark dilution and the scope of protection will be explained in more detail below to understand the concept better.

3.4. Types of Dilution

3.4.1. Dilution by Blurring

The dilution theory has been known to acknowledge dilution by *blurring* both in the US and EU doctrine. The concept is also recognized and considered as a type

¹⁴¹ Welkowitz, David S. "Reexamining Trademark Dilution." p. 535.

¹⁴² Bilge, Mehmet Emin. "Marka ve Ticaret Unvanı Arasındaki İltibas." *Ticaret ve Fikri Mülkiyet Hukuku Dergisi*, 2015, p. 10.

of harm in Türkiye, by extension. Dilution by blurring occurs in cases where trademark's distinctive nature is damaged, more specifically, it occurs through a use which causes damage to reputed, or famous trademark's distinctiveness quality.

Detriment to the distinctive character may be described as weakening or declining of earlier registered trademark's capability in distinguishing commodities or services for that it is registered and used on, through by using latter trademark thusly which causes the former mark's strength to stimulate instantaneous correlation with commodities or services it is registered in to be severed.¹⁴³

As pointed out on several occasions in the rulings of CJEU, it is necessary that there is at least a similarity to a degree between the prior and later mark in a way which the related consumer group or a particular segment of public presume some relation amongst the marks in question. However, this connection does not refer to the likelihood of confusion, but rather formation of a link between the marks even without confusion.¹⁴⁴

Origins of dilution by blurring can be once again traced back to Schechter, as he describes detriment to the distinctive character on the article, "*The Rational Basis of Trademark Protection*". Schechter firstly emphasizes on the mark's distinctiveness, as he deduced that the more distinctive or unusual the trademarks are, their effect on public awareness shall be just as deep. This will result in a necessity for greater protection against dissociation from products and services associated with it. This dissociation, put differently blurring, is described by Schechter as: "*the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name by its use upon noncompeting goods.*"

¹⁴³ Case C-252/07 *Intel Corporation Inc. v CPM United Kingdom Ltd.* [2008] ECLI:EU:C: 2008:655, para 29.

¹⁴⁴ See. Case C-408/01, *Adidas-Salomon AG, formerly Adidas AG, Adidas Benelux BV v Fitnessworld Trading Ltd.*, C-102/07 - *Adidas and adidas Benelux v Marca Mode CV and Others.*, Case C-252/07 *Intel Corporation Inc. v CPM United Kingdom Ltd.*

This article is certainly important in laying forward the basis for the dilution by blurring concept, however, not all of the requirements which Schechter has sought for is still relevant. As he stated, “distinctiveness” of the character is definitely a vital point, and the concept was expressed in detail in “Concept of Distinctiveness” subsection. However, it can be said that “uniqueness” is no longer considered as a necessity in deciding the damage to trademark’s distinctiveness. This is mostly because even descriptive or suggestive marks may enjoy the perks of protection against dilution, provided the marks in question obtained distinctiveness through use or acquired a secondary meaning.¹⁴⁵

The terminology used in EU regulation for dilution by blurring is “detriment to the distinctiveness”, as stated in Art. 8/5 & 9/1. Similarly, legislation in Türkiye also uses “...be detrimental to the distinctive character...”, as stated in Turkish Industrial Property Code, following closely the wording used by EU regulations and directives in not explicitly using blurring.

As for the US, the situation is slightly different in comparison. The Lanham Act, which is also known as Trademark Act of 1946, explicitly uses the term “blurring” under injunctive relief and it even offers a definition specifically for it. Blurring is defined as an association which arises due to the resemblance concerning a famous trademark and another mark or trade names which spoils the famed trademark’s distinctive quality. It also stipulates a list of elements which the court may account on deciding if the trademark in question has a risk of causing dilution by blurring.¹⁴⁶

However, it should be noted that not every single of the factors listed must be sought in determining a trademark’s risk of causing dilution by blurring and in some instances several factors may be deemed as sufficient.¹⁴⁷ The term is also used in the amendments made to the Act, such as Trademark Dilution Revision Act Of

¹⁴⁵ Shchetinina, Alina. p.41.

¹⁴⁶ 15 U.S.C. §1125 (Section 43 of the Lanham Act): False Designations of Origin, False Descriptions, and Dilution Forbidden.

¹⁴⁷ *Louis Vuitton Malletier S A v Haute Diggity Dog LLC* 507 F.3d 252 (2007) US App, s III (A)

2006. Therefore, it can be said that the US legislation is more thorough and clear in this aspect, providing clear definitions regarding dilution types.

It is also critical to look into the court decisions as they provide some definitions along with descriptions as well regarding dilution by blurring. “*HOLLYWOOD*” ruling of EUIPO describes blurring as a classic type of dilution and it states that this form of dilution arises when the mark’s capability to distinguish a single originating undertaking concerning the products or services’ origin without any likelihood of confusion or any type of contractual and equivalent relations amongst the right owners is diluted. These types of third-party uses will cause mark’s distinctive character to weaken or reduce.¹⁴⁸

Another rather famous decision which includes dilution by blurring is *Tiffany & Co. v. Boston Club* case of July 2, 1964, from the US. United States District Court D. Massachusetts states in this case that this type of using of *Tiffany* trademark as the name of a restaurant by the defendant, which is normally a well-known mark in jewelry products, will result for the mark to become less and less likely to the cause instant association in public mind with the plaintiff’s jewelry products. It is also stated in the ruling that “*The risk of detraction may be a risk of an erosion of the public’s identification of this very strong mark with the plaintiff alone, thus diminishing its distinctiveness, uniqueness, effectiveness, and prestigious connotations.*”¹⁴⁹ In other words, the Court specifically emphasized that as the trademark is or will be linked with unrelated products or services in the related consumer group’s mind, its connection and strong bond which is built over time with the previous goods and/or services shall decrease, which makes it a classic example of blurring by dilution and understanding the concept.

3.4.2. Dilution by Tarnishment

¹⁴⁸ Case R 283/1999-3, dated 25 April 2001, *Hollywood S.A.S v. Souza Cruz S.A.*, para. 105.

¹⁴⁹ US District Court for the District of Massachusetts, *Tiffany & Co. v. Boston Club, Inc.*, 231 F. Supp. 836 (D. Mass. 1964)

Similar to blurring subtype, dilution through tarnishment has been commonly recognized by dilution theory as well. It is a classic form of dilution which has been either regulated directly or described in the US, EU and Turkish trademark law. Tarnishment in the simplest sense is using a well-known mark in such fashion which involves inappropriate or derogatory connotations and reduces its distinctiveness. It is either known as dilution by tarnishment, or “detriment to repute”, or both, depending on the legal system.

It can be said that tarnishment as a form of dilution occurs on cases where earlier reputed mark’s unauthorized using depreciates either prestige or image of reputed mark.¹⁵⁰ Therefore, this dilution category assumes that trademark which has been diluted has a positive image in public to begin with, aside from the obvious function of distinguishing the goods and services.¹⁵¹

Tarnishment has also been thought as a subgroup of dilution by blurring in some cases, as it also reduces or weakens the distinctive quality of the trademark.¹⁵² As a result of it, of course, the common requirements which are sought for the protection against trademark dilution shall be applied in dilution by tarnishment as well.

The term “tarnishment” is explicitly used in the US legislation, unlike EU and Türkiye. Lanham Act, and subsequently its amendment Revision Act regulate tarnishment under injunctive relief and provides a definition stating that it is an association which arises due to the similarities between a famous mark and a mark or a trade name which damages famous mark’s repute. Tarnishment typically is the most obvious when famous trademark is used with respect to the illegal activities such as drugs, violence, pornography just to name a few.¹⁵³

¹⁵⁰ Guidelines on Trade Marks with Reputation, para 3.4.3.3.

¹⁵¹ Hacıömeroğlu, A. Oğuzhan and İnce, Zeliha. “Ulusal ve Uluslararası Düzenlemeler ile Yargı Kararları Işığında Tanınmış Markanın Sulandırılması.” *Ticaret ve Fikri Mülkiyet Hukuku Dergisi*, Vol. 6, No. 1, 2020, p. 99.

¹⁵² *TY INC., v. PERRYMAN*, No.02-1771, October 4, 2002.

¹⁵³ Shchetinina, Alina. p.49.

However, establishment of the dilution by tarnishment is not this apparent in all cases as connection with poor quality products may also be considered as tarnishment. “*Rosetta Stone Ltd v Google Inc*” ruling emphasized this as well, stating that in case of association of the famous trademark with lower quality merchandises or in an unsavory or unpleasant context by public will cause tarnishment as well, even though the goods may be unrelated.¹⁵⁴

As for the wording preferred, EU regulation is slightly different than the US. Similar to blurring, dilution by tarnishment was never explicitly written in directive and regulations. This notion is regulated in EU Regulation Art. 8/5 and Art. 9/1 as the *detriment to the repute* of the earlier mark. Likewise, Turkish Industrial Property Code also uses the phrase “*be detrimental to the repute of the earlier trademark*” following terminology used by EU regulations and directives closely.

The concept of tarnishment is firstly addressed in EU case law in “*Claeryn v. Klarein*” ruling of 1975 by the Benelux Court. In this case, plaintiff “*Claeryn*” was a famous mark which is used in Dutch gin, on the other hand the defendant *Klarein* trademark was used for detergent products thus making this decision also a landmark in the protection of the marks with regards to products used in not similar goods and services in EU. The Court describes tarnishment as damage to reputation of the trademark that arises on cases where the products and services the conflicting mark has been used, shift people's perceptions by such manner which the trademark with a repute's attracting quality is affected negatively.¹⁵⁵

To be more precise in this specific case, the claimant's trademark would be diluted considering while it is a famous mark which has strong association exclusively with gin product in the public eye, due to the respondent's trademark, it may now also get associated with toilet cleaning products, thus making latter mark's usage damaging to former mark's reputation.

¹⁵⁴ *Rosetta Stone Ltd v Google Inc* 676 F.3d 144 (2012) 4th Cir, s VI.

¹⁵⁵ BIE 1975/9 at 183, *Claeryn v. Klarein*.

EUIPO provides some examples on cases which dilution by tarnishment claim is acknowledged. One example which may be useful in explaining the concept further is the dispute on the mark KAPPA. As known by many, KAPPA is a trademark with a repute which is used in sportswear products. Latter application of the mark KAPPA for EUTM was made for Class 34, which is filed for tobacco products, cigarettes, and other related products.¹⁵⁶ Since smoking tobacco and other products associated with it have a negative connotation in public, due to the fact that it is acknowledged by science that it is an extremely harmful habit and may cause addiction, the former mark with a repute, which is KAPPA of sportswear products, would be affected in a negative way by this registration. It is directly in conflict with the healthy lifestyle the mark is trying to promote thus causing a detriment mark's reputation, more precisely, causing tarnishment by dilution.¹⁵⁷

In conclusion, it is acknowledged in both the US and EU, by extension Türkiye, in order for dilution by tarnishment to occur, in addition to the other common requirements for dilution such as being a reputed or famous trademark, an association between conflicting marks etc., the usage by such disputing trademark must affect the repute of the trademark in a negative way, instead of lessening of distinctive character, thus diluting by harming the reputation.

3.4.3. Concept of Free Riding

The provisions provided in EU and Turkish legislation regarding the protection against trademark dilution, which are EUTMD Article 5/3(a) and 10/2(c); Turkish Intellectual Property Code Article 6/5 and 7/2(c), include "*taking unfair advantage of*" as well in addition to damage to distinctive quality along with harm to reputation. However, in US' case, provisions which regulated trademark dilution protection in Lanham Act of 1946 or any of the amendments which

¹⁵⁶ 12/03/2012, R 297/2011-5, *KAPPA / KAPPAI*.

¹⁵⁷ EUIPO Guidelines on Trade Marks with Reputation, para 3.4.3.3.

follows, such as FTDA and TDRA do not include taking unfair advantage of or free riding. Therefore, free riding, or taking unfair advantage of is not considered as a form dilution in US doctrine and legislation and it will be mostly examined based on the situation in EU and Türkiye.

There are several opinions in the doctrine on the standing of free riding whether it can be considered as dilution. Some scholars, including Gordon, defined notion of free riding as a sister doctrine to the dilution.¹⁵⁸ There are others, however, which described dilution as a property right and required holder of the to demonstrate that trademark was harmed due to third party's use.¹⁵⁹ Since the harm to the mark in question is not a requirement for free riding, this theory does not include gaining unjust benefits from reputed trademark within forms of dilution.

EUIPO trademark guidelines describe the concept free riding as a case which occurs when the latter mark profits from the reputation and/or brand image of the earlier trademark, which has great attractive power and very well known in the market, by using an identical or related trademark for its products and services, thus gaining advantage from its repute or distinctiveness. This situation may also be considered as "commercial parasitism", as the holder of the conflicting latter mark *free rides* on the investment, promotion and all the effort made by the holder of reputed trademark to build up goodwill through the time without any type of compensation.¹⁶⁰

One of the important cases which can be discussed for free riding and dilution in general is "*Intel Corporation Inc v. CPM United Kingdom Ltd*".¹⁶¹ Former reputed

¹⁵⁸ Gordon, W. J. "On owning information: Intellectual property and the restitutionary impulse." *Virginia Law Review*, Vol. 78, No. 1, 1992, p. 152-153; Büyükkılıç, Gül. *Marka Hukukunda Tanınmış Markanın Sulandırmaya Karşı Korunması*. Oniki Levha Yayıncılık, 2019, p. 405.

¹⁵⁹ Callmann, Rudolf. "Unfair Competition Without Competition? The Importance of the Property Concept in the Law of Trade-Marks." *University of Pennsylvania Law Review*, Vol. 95, No.4, 1947, p. 443.; Fhima, Simon. "Dilution by Blurring: A Conceptual Roadmap." *Intellectual Property Quarterly*, Vol. 44, 2010, p.11.

¹⁶⁰ EUIPO Guidelines on Trade Marks with Reputation, para 3.4.3.1.

¹⁶¹ Case C-252/07, *Intel Corporation Inc v. CPM United Kingdom Ltd*, Judgment of the Court (First Chamber) of 27 November 2008.

software trademark “INTEL” which is registered for computers along with related commodities and services ¹⁶² , claimed that conflicting mark’s using as “INTELMARK” takes unjust advantage of or cause harm to mark’s distinct quality or reputation.

Establishment of such link¹⁶³ between conflicting marks has been examined in this case and CJEU deduced that if latter trademark revokes former reputed trademark in the perspective of related consumer, it shall be deemed enough to consider such a link exists. However, acknowledging of the link amongst trademarks in dispute, in addition to other requirements such as:

- (i) Being a mark with a repute in a specific type of products and services.
- (ii) The products and services that conflicting marks are registered for being either unrelated or different on some level.
- (iii) Prior registered trademark being particular with reference to any product and service is not sufficient to deduce free riding has been established.

The Court concluded that in order to establish that using by later trademark would initiate harm to distinctiveness/reputation of prior trademark or gain benefits from former trademark’s repute/distinctiveness, proof to significant difference or a risk of significant difference in financial behavior of usual purchaser of products/services prior trademark is registered in following the use of the later mark. Therefore, the criteria which must be bear in mind here is not essentially the harm done to prior reputed mark, but rather, benefits to latter mark, which is one of the major differences in comparison with other dilution types. ¹⁶⁴

“*L’Oréal SA v Bellure NV*” is an important decision to be noted for free riding. The Court deduced that in cases that the later mark tries through usage of an identical or alike sign to a reputed mark in order to free ride on coattails of that mark for:

¹⁶² The mark has been registered on Classes 9, 16, 38 and 42.

¹⁶³ “Link” here is assessed within the meaning of Case C-408/01 *Adidas-Salomon and Adidas Benelux*.

¹⁶⁴ Case C-252/07, *Intel Corporation Inc v. CPM United Kingdom Ltd*, [2009] E.T.M.R.13.

- (i) Profiting from the mark's magnetism power, its repute along with status.
- (ii) Exploiting it without having to pay any financial reimbursement.
- (iii) Benefiting from the advertisement and promotion effort expended by the holder of the mark with a repute.
- (iv) Establishing and preserving the brand image of that mark without making any effort on its own, it must be acknowledged that the advantage resulting from these types of use will be considered as obtaining unjust benefit from the mark's distinctive quality or recognition.¹⁶⁵

As evident from the cases above, which discuss the requirements for free riding, the intent of the third party, or in other words the intent of the holder of the later mark, will not be a criterion which must be assessed in order to establish the existence of free riding. Art. 8/5 of EUTMR simply stipulates "unfair" trait of such benefit, it does not require the third party to act in bad faith. However, it will be considered as a clear indicator of unfair advantage in case it is evident that the third party which is the proprietor of latter trademark acted with bad intent.¹⁶⁶

In conclusion, notion of free riding has been regulated with other types of dilution in EU and by extension Türkiye, however in the US dilution doctrine, it is clear that it is not considered as a form of dilution, and it is not regulated in the related provisions. The concept of free riding or taking advantage of which is referred in the relevant provisions may be established on its own independent of the other dilution forms if other requirements explained above are fulfilled. In other words, a harm to distinctiveness or reputation of a trademark will not be a factor in establishing free riding and the focus will be in "unjust" advantage the latter mark benefits from.

3.4.3.1. Free-Riding within the Context of Unfair Competition

¹⁶⁵ Case C-487/07: Judgment of the Court (First Chamber) of 18 June 2009 (Reference for a preliminary ruling from the Court of Appeal (England and Wales) (Civil Division) — United Kingdom — *L'Oréal SA, Lancôme parfums et beauté & Cie SNC, Laboratoire Garnier & Cie v Bellure NV, Malaika Investments Ltd.*

¹⁶⁶ EUIPO Guidelines on Trade Marks with Reputation, para 3.4.3.1.

Provisions regarding unfair competition are regulated in Turkish law within the scope of the Turkish Commercial Code.¹⁶⁷ Deceptive or dishonest conduct and business practices affecting relationships between competitors or between suppliers and customers can be considered as unfair competition. These practices may demonstrate itself through imitation, false allegations, creating confusion, disparagement, or, free-riding.¹⁶⁸

The acts in question may be subject to both trademark law and unfair competition provisions, such as consciously or unconsciously marketing products under the same or similar mark as trademarks belonging to others. This may create a possibility of confusion and cause a situation of unfairly benefiting from the labor of others.¹⁶⁹

With the adoption of the regulations regarding industrial property rights, interests previously protected by the provisions on unfair competition are now protected within the framework of intellectual property rights. Therefore, the scope of application of the provisions regarding unfair competition is narrowed down with the acceptance and expansion of industrial property rights in a way.¹⁷⁰ However, considering registration requirement for protection principle in trademark law, it is also helpful to state that unregistered trademarks may be protected under unfair competition provisions under right conditions.¹⁷¹

It can be observed in Turkish case law, even for the registered marks, the plaintiffs tend to claim trademark infringement, unfair competition, and

¹⁶⁷ Turkish Commercial Code No. 6102, Chapter IV – Unfair Competition.

¹⁶⁸ Turkish Commercial Code Article 55:

“(1) The cases listed below are the main cases of unfair competition:

... 5. In a way that misrepresents himself, his goods, work products, activities, prices, untrue, misleading, unduly disparaging his competitor or unduly taking advantage of his reputation; to compare goods, work products or prices with others, or to put the third party ahead in similar ways...”

¹⁶⁹ Güneş, İlhami. *Uygulamada Fikri ve Sınai Mülkiyet Hakları ve Haksız Rekabet Davaları*. Seçkin Yayıncılık, 2021, p.399.

¹⁷⁰ Aksoy, Mehmet A. “Haksız Rekabet Halleri ve Haksız Rekabetin Tespiti.” *Gazi Üniversitesi*, 2011, p. 15-16.

¹⁷¹ Çelik, Nazlı Hilal. “Haksız Rekabet.” *Prof. Dr. Duygun Yarsuvat’a Armağan, Yeditepe Üniversitesi Hukuk Fakültesi Dergisi*, Vol. 9, 2012, p. 675.

trademark dilution cumulatively. However, existence of “unfair advantage”, in other words free-riding within the scope of IPC Art. 6/5 which regulates dilution does not necessarily mean unfair competition claim will be acknowledged by the Court.¹⁷²

Turkish High Court states in its *SIEMED* decision “...Since the reputation of the plaintiff's trademark in the society is high not only in the field of medical imaging devices but in every field where technology is used, the registration of the defendant in the specified classes will result in unfair exploitation of the reputation of the plaintiff's trademark within Decree Law 8/4... The case is partially accepted on the grounds that since the defendant's use was based on her/his registered trademark, this use would not constitute trademark infringement and unfair competition...” It can be observed here conclusion of free-riding in terms of registered well-known marks would not constitute unfair competition within the meaning of Turkish Commercial Code on every case.

On the other hand, there are also decisions of 11th Civil Chamber of Turkish High Court where trademark infringement, trademark dilution, and unfair competition claims are cumulatively accepted.¹⁷³ However, this practice of Supreme Court changed with the decision number 2019/5189 - 2022/1852 in 2022. The Court took a different approach and concluded that trademarks are already protected by the provisions of IPC No. 6769 (Decree Law No. 556), which is its own particular law, trademark infringement acts are protected cumulatively in line with the relevant provisions of the abrogated TCC No. 6762 (old TCC), and Article 55/1-a-4 of the Turkish Commercial Code No. 6102 (new TCC) acknowledges “the goods, work products of others, taking measures that cause confusion with its activities or business” as unfair competition, but the concepts of “name, title and trademark” were deliberately not included in the new regulation, and since

¹⁷² Turkish High Court, 11th Civil Chamber, No. 2020/314 - 2021/4256, d. 29/04/2021.

¹⁷³ Turkish High Court, 11th Civil Chamber, 2015/1198 - 2015/5865, d. 27/04/2015.

trademarks are protected under the IPC, it is unnecessary to protect them once again with the unfair competition provisions of the new TCC.¹⁷⁴

This recent ruling had a major influence for the ongoing cases regarding cumulative protection within trademark law and unfair competition provisions.¹⁷⁵ However, subsequently in December 2022, 11th Civil Chamber acknowledged cumulative protection for trademark infringement under IPC and unfair competition under TCC.¹⁷⁶ Bearing in mind the contradictory decisions of Turkish High Court, it is difficult to make a clear judgement on if cumulative protection is possible in cases where free-riding is involved especially for registered well-known marks.

¹⁷⁴ Turkish High Court, 11th Civil Chamber, 2019/5189 - 2022/1852, d. 14/03/2022.

¹⁷⁵ Bezek, Irem, and Feride Utku. "Regulation of Unfair Competition and Trademark Infringement Clauses: Can Right Owners Enjoy Cumulative Protection in Turkey?" *Lexology*, Deriş Patents and Trademarks Agency, 20 Dec. 2023, www.lexology.com/library/detail.aspx?g=c3c97f8e-ace1-446c-8ce1-e365d5899c42.

¹⁷⁶ Turkish High Court, 11th Civil Chamber, 2021/4883 - 2022/9613, d. 28/12/2022.

CHAPTER II

INTERNATIONAL REGULATIONS ON TRADEMARK DILUTION AND PROTECTION OF WELL-KNOWN TRADEMARKS AGAINST DILUTION IN THE UNITED STATES AND EUROPEAN UNION

1. INTERNATIONAL REGULATIONS ON TRADEMARK DILUTION

1.1. Paris Convention

Paris Convention, which has been signed by Türkiye in 1925, is unarguably one of the most important international agreements to this day concerning well-known trademarks globally as previously explained thoroughly under “Well-Known Marks within the Context of Paris Convention for the Protection of Industrial Property (1883)” subsection, and it is considered as a landmark in international trademark law protection.

Art. 6bis regulates party states to undertake refusing or cancelling the registration, and prohibiting using of a trademark that may be considered as an imitation or replication of a reputed mark or in a way which may cause confusion. It can be said this protection is a protection against typical trademark infringement which is based on confusion.¹⁷⁷ However, the protection granted with this provision only includes same or similar type of good and services. It does not cover reputed mark protection in different type of commodities and services and in this sense the Convention does not regulate a specific type of protection against trademark dilution.

¹⁷⁷ Hacıömeroğlu, A. Oğuzhan and İnce, Zeliha. “Ulusal ve Uluslararası Düzenlemeler ile Yargı Kararları Işığında Tanınmış Markanın Sulandırılması.” *Ticaret ve Fikri Mülkiyet Hukuku Dergisi*, Vol. 6, No. 1, 2020, p. 81.

Furthermore, Art. 10bis regulates protection against unfair competition which includes all kind of acts which might initiate confusion with the competitor's products and services or activities; acts which disrepute the competitor's goods, services, or activities in any way with false claims and deceiving public regarding the features or any qualities of products. This provision may imply anti-dilution protection as well according to some scholars.¹⁷⁸ There have been many discussions and attempts on adding a provision which expands the protection range to different commodities or services, which supports this view.

On Lisbon Conference in 1958, there have been some proposals on regulating protection against dilution in a clear sense, such as protection against lessening of well-known mark's distinctive nature, however ultimately no such provision was included as a revision to Convention.¹⁷⁹

1.2. Trade-Related Aspects of Intellectual Property Rights Agreement

Trade-Related Aspects of Intellectual Property Rights Agreement dated 1995, which is also referred as "TRIPS Agreement", is likewise a quite significant global treaty on regulating several aspects of intellectual property protection globally just like Paris Convention as expressed on Well-Known Marks subchapter in more detail. Türkiye is also one the parties to TRIPS. It is observed that the protection scope especially for reputed marks has been extended with this Agreement when compared to Paris Convention and it sets forth a similar type of protection to protection against trademark dilution.¹⁸⁰

¹⁷⁸ Callman, Rudolf. *The Law of Unfair Competition, Trademarks and Monopolies*, Thompson Reuters, 1994, para. 2610; Kaseke, Elson. "Trademark Dilution: A Comparative Analysis, University of South Africa." University of South Africa, 2006, p. 82.

¹⁷⁹ Kaseke, p. 83; Proposition of International Association for the Protection of Industrial Property (AIPPI).

¹⁸⁰ Hacıömeroğlu, A. Oğuzhan and İnce, Zeliha. p. 82.

While Article 15, 16 and 21 of the Agreement include provisions regarding trademark in general, especially Article 16 holds a special place for well-known marks. Article 16/2 is the first international regulation to introduce various criteria for determining the level of recognition necessary and sufficient for acknowledging a reputed mark.¹⁸¹

Moreover, Article 16/3 is the provision to look out for in terms of protection against dilution considering that it expands the scope protection granted by Paris Convention greatly. This provision regulates that a reputed mark can enjoy the perks from trademark protection for commodities and services that are dissimilar provided that this use *“would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use”*.

It is argued that while the phrasing “connection” in this provision makes it possible for it to be used a legal ground on traditional trademark infringement which is based on likelihood of confusion; there may also be a possibility of taking legal action for trademark dilution based on this article, provided that there is a sort of association amongst the reputed mark and the commodities and services of conflicting mark holder, even if there is no confusion.¹⁸²

The other condition is the possibility of such use resulting in hurting the interests of reputed mark owner. Consequently, proving actual damage will not be a necessity and only a likelihood of damage will be deemed enough concerning protection, providing other conditions are also met. While establishing some sort of “connection” and possibility of harm to registered reputed mark owner’s interests by such use are conditions which must be met together based on this Article, it is entirely possible for member states to regulate granting trademark protection to the registered or unregistered well-known marks in dissimilar

¹⁸¹ Büyükkılıç, Gül. p. 82.; Hacıömeroğlu, A. Oğuzhan and İnce, Zeliha. p. 82.

¹⁸² Mostert, Frederick W. “Well-Known and Famous Marks: Is Harmony Possible in the Global Village?” *Trademark Reporter*. Vol. 86, International Trademark Association, 1996, at 130.; Kaseke, p. 90.

products and services even if these requirements are not fulfilled completely.¹⁸³ This can be possible since TRIPS Treaty in its essence only provides minimum protection, and gives opportunity to member states for regulating a more comprehensive trademark protection.¹⁸⁴

In conclusion, it can be said that TRIPS agreement is quite important in well-known mark protection in particular, because this was the initial international agreement that attempted on defining the well-known concept and it set forth relevant criteria while also extending the protection regulated on Paris Convention Art. 6bis in a way that would include the uses of reputed marks in question in dissimilar commodities and services. Prohibition of such use would occur in cases where there is an indication of some sort of connection between the conflicting use and the registered well-known mark. Therefore, while the protection granted by TRIPS Agreement is similar to protection against dilutive use, it is not exactly the same and “dilution” expression has not been openly specified within these provisions.¹⁸⁵

1.3. Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks

Inconsistencies observed in national regulations regarding well-known marks’ protection, and developments in information technology triggered a need for harmonization and determination of international principles for protecting well-known trademarks. Responding these concerns, a Joint Recommendation has been adopted by Paris Union along with WIPO in 1999.¹⁸⁶ While it is not a binding treaty, this Joint Recommendation provides clear guidelines on matters such as

¹⁸³ Kaseke, p. 90.; Baeumer, Ludwig. *International Legislative History within the Framework of WIPO, and the Recognition and Protection of Famous and Well-Known Marks* in Mostert, Frederick W. *Famous and Well-Known Marks*. Chapter 3, Part IIB, 2004, at 3 – 10.

¹⁸⁴ TRIPS Agreement, Article 1.

¹⁸⁵ Kaseke, p. 93-94.

¹⁸⁶ Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO) at the Thirty-Fourth Series of Meetings of the Assemblies of the Member States of WIPO September 20 to 29, 1999.

well-known mark criteria, determination, and protection with the aim of harmonization.¹⁸⁷

Unlike its predecessors “Paris Convention” and “TRIPS Agreement”, Joint Recommendation explicitly used the wording “dilute”¹⁸⁸, thus it becomes the first international legal text to clearly state the protection of the well-known marks against dilution. This heavily implies that the protection intended to be regulated on Art. 16/2 of TRIPS being anti-dilution protection as well, however it is clear that the protection presumed in the Joint Recommendation exceeds the protection scope regulated in other global regulation and treaties.¹⁸⁹

Article 4 of Joint Recommendation titled “Conflicting Marks” explains certain situations & uses where a well-known mark will be presumed as conflicting with the trademark. Art. 4/b states three types of use which will be considered as conflicting with a well-known mark. These three circumstances are exceptionally significant with regards to anti-dilution protection. It concerns to all categories of commodities and services as it is not a necessity for them to be identical or alike. Article 4/b provides that it shall be deemed enough to be considered as conflicting if:

(I) The use implies a ‘connection’ to well-known trademark provided it will possibly harm that mark’s interests.

(II) Such use will possibly dilute or weaken well-known mark’s distinctive nature.

(III) Unjust benefits are obtained from using that mark.

The first condition stated in Art. 4/1/b/i, uses identical phrasing with TRIPS Agreement Art. 16/3. The second one explicitly sets out trademark dilution by both using the term and by description; it indicates dilution by blurring and by

¹⁸⁷ Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, 1999, Preface.

¹⁸⁸ Joint Recommendation, Article 4/1/b/ii.

¹⁸⁹ Fhima, I. Simon. “Dilution in the US, Europe, and Beyond: International Obligations and Basic Definitions.” *Journal of Intellectual Property Law & Practice*, Vol. 1/6, p. 408; Hacıömeroğlu, A. Oğuzhan and İnce, Zeliha. p. 84.

tarnishment. The third one refers to free-riding concept, where the use is evaluated as obtaining unjust advantage from well-known trademark's goodwill. This is explicitly stated on Explanatory Notes drafted by International Bureau.¹⁹⁰ Overall, it could be said while the Joint Recommendation outlines clear guidelines but also extends the privileges granted to well-known trademarks. Moreover, it aspires to preserve distinctive nature along with well-known mark's goodwill by preventing dilutive acts which makes it a quite significant legal document concerning anti-dilution well-known trademark protection in a global context.

2. PROTECTION AGAINST DILUTION IN THE UNITED STATES

2.1. Relevant Legislation and Dilution Concept in US

As referred previously, protection against dilution was first proposed in Schechter's article which has been published in 1927.¹⁹¹ However, one of the major obstacles to the adoption of anti-dilution protection has been that this model would be fundamentally in conflict with the basic principles of US case law, considering that in US law trademark protection is based on the notion misleading consumers regarding origins of a product or service.¹⁹²

Afterwards, The Lanham Act was enacted as the first regulation regarding well-known mark protection in 1946. Nevertheless, Act did not include the term "dilution", or any description of well-known mark protection against dilutive uses. However, subsequently several states from the US have legislated statutes for protection against dilution, starting with Massachusetts in 1947, soon to be followed by the States of Illinois, New York, and Georgia.¹⁹³ In the federal scope, Federal Trademark Act which came into force in 1995 became the first legislation

¹⁹⁰ Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks Explanatory Notes 4.5 on Article 4, drafted by International Bureau of the World Intellectual Property Organization.; Kaseke, p. 107.

¹⁹¹ Schechter, Frank I. "The Rational Basis of Trademark Protection." *Harvard Law Review*, Vol. 40, No. 6, 1927, pp. 813–33.

¹⁹² Büyükkılıç, Gül. p. 35.

¹⁹³ Kaseke, p. 212.

to officially recognize protection against dilution with an amendment. It will be explained in more details below.

2.1.2. Lanham Act and Federal Trademark Dilution Act

Federal Trademark Dilution Act of 1995 (FTDA) describes dilution as "*the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of competition between the owner of the famous mark and other parties, or likelihood of confusion.*".¹⁹⁴

This act is an amendment to the section 43 of Lanham Act, which is referred as Trademark Act of 1946 as well, and main purpose for this provision is to provide a remedy for well-known mark dilution, or rather "famous" trademarks as the way it is stated in the legislation. FTDA specifically holds a special place among the legislation related to well-known mark protection. Because the right of protection against dilution for well-known trademark owners was granted for the first time by a regulation within the scope of the law.

This Act also provides eight criteria for determining if a trademark is "famous" and "distinctive", which may be taken into consideration by courts.¹⁹⁵ These were particularly important on seeking protection against dilution based on FTDA since the act clearly stated that the trademark in question must be considered as famous. In addition to this condition, this Act also required "commercial use" of famous trademark (same or alike) by defendant which means non-commercial using by same of similar trademark is nonactionable under this Act. This type of commercial use in question is usually apparent in cases of using trademark as an internet address or domain name, a concept also known as

¹⁹⁴ Public Law 104 - 98 - Federal Trademark Dilution Act of 1995. An act to amend the Trademark Act of 1946 to make certain revisions relating to the protection of famous marks. <https://www.govinfo.gov/content/pkg/PLAW-104publ98/pdf/PLAW-104publ98.pdf> (online on 06.06.2022)

¹⁹⁵ Lanham Act, The new subsection (c)(1).

“cybersquatting”.¹⁹⁶ In some cases courts expanded the protection granted by FTDA to cybersquatting as well in order to prohibit this type of use.

However, it can be said that not all courts acknowledge right to injunction under the provisions of this act may be applied for this use. It should be also pointed out non-commercial usage which may be considered as fair use such as comparison of the mark with of others with accurate data in news or advertisements will not be subject to the injunctions granted by the Act either. The main reasoning behind these exceptions lies in constitutional right of speech and freedom, which will be examined more in detail under due cause chapter.¹⁹⁷

Nevertheless, later on, this act was not considered enough due to some uncertainties in its application which were triggered by the ruling of the United States Supreme Court in 2003.¹⁹⁸ As known by many, the lingerie brand Victoria’s Secret, filed a lawsuit against Victor and Cathy Mosley which own a retail store that goes by the label “Victor’s Little Secret”. This department store also sold underwear and adult products as well, such as adult videos and sex toys.

Victoria Secret claimed that this name blurs the distinctiveness and tarnishes the reputation of its trademarks and sued them based on the rights granted by FTDA for trademark infringement and trademark dilution. However, Court ruled that in the end, the “possibility” of dilution is not enough to violate the trademark protection. The Court decision showed that for the rights and remedies granted by FTDA to be used, there must be concrete proof that the dilution actually occurred rather than likelihood or risk of dilution. As a result of this, the need for a new legislation has arisen and Trademark Dilution Revision

¹⁹⁶ See. The Anticybersquatting Consumer Protection Act (a.k.a. ACPA) for more information. <https://www.govinfo.gov/content/pkg/CRPT-106srpt140/html/CRPT-106srpt140.htm> (online on 11.09.2022)

¹⁹⁷ Pote, Daniel R. “A Domain by Any Other Name: The Federal Trademark Dilution Act of 1995 Applied to Internet Domain Names.” *Jurimetrics*, Vol. 37, No. 3, 1997, p. 301; Brookman, Adam L. *Trademark Law: Protection, Enforcement, and Licensing*. Wolters Kluwer Law & Business, 2020, 11-10, 11-34.; Dilmaç, Şule. *Uluslararası Metinlerde Tanınmış Marka ve Markanın Sulandırılması*. 2014, p. 121.

¹⁹⁸ *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003).

Act¹⁹⁹ became effective in 2006.²⁰⁰ All in all, considering the dilution doctrine across the world, not just the United States, FTDA is definitely one of the most significant regulations and it lighted the way for the further developments to come afterwards.

2.1.3. Trademark Dilution Revision Act

Trademark Dilution Revision Act is also an amendment to the Trademark Act of 1946, and subsequently to FTDA and it overturned Supreme Court's "*Moseley v. V Secret Catalogue, Inc.*" ruling which has been explained above.²⁰¹ One of the most important novelties which has been brought by this act which came into force in 2006 is that it made it clear that there is no need for the proof of actual dilution, such as demonstrating the actual harm done by the diluting use, and the famous trademark owners shall be able to exercise their rights based on "likelihood of dilution".²⁰²

It also clarified that dilution provisions may be applied to not only essentially distinctive marks but also to trademarks which developed distinctiveness by usage and secondary meaning as well. In addition to this, it defined blurring as a type of dilution as well, which will be discussed in more detail later in its section. In conclusion, this act brought forward a greater protection against dilution and clarified the uncertainties in prior regulations. However, at the same time, it became more difficult for marks to achieve this protection because the requirements for a mark to be considered as a famous trademark have become stricter as well. It was regulated that to be considered as a famous mark, the

¹⁹⁹ PUBLIC LAW 109-312—OCT. 6, 2006, Trademark Dilution Revision Act, <https://www.govinfo.gov/content/pkg/PLAW-109publ312/pdf/PLAW-109publ312.pdf> (online on 07.06.2022)

²⁰⁰ Fhima, Ilanah Simon. *Trademark Dilution in Europe and the United States*, p. 9.

²⁰¹ *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003).

²⁰² PUBLIC LAW 109-312—OCT. 6, 2006. TRADEMARK DILUTION REVISION ACT OF 2006 SEC. 3. CONFORMING AMENDMENTS. - (c) CANCELLATION:

"Section 14 of the Trademark Act of 1946 (15 U.S.C. 1064) is amended, in the matter preceding paragraph (1) by striking "including as a result of dilution under section 43(c)," and inserting "including as a result of a likelihood of dilution by blurring or dilution by tarnishment under section 43(c)."

trademark in question must be commonly recognizable by overall consumer population of US contrary to prior court decisions.

3. PROTECTION AGAINST DILUTION IN EUROPEAN UNION

3.1. Overview

There are two main sources which may be examined in European Union laws regarding well-known trademarks and dilution of such marks. First one is Directive 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks, which may also be referred as EUTMD no. 2015/2436.²⁰³ EU Directive 2008/95/EC has been actually interchanged with EUTMD 2015/2436, deeming the former invalid, thus it is no longer in force.

The second and the other significant regulation is Regulation 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark, which is also referred as EUTMR no. 2017/1001 shortly.²⁰⁴ It is important to note both legislations are highly under influence of Benelux trademark law.

3.2. Regulation 2017/1001 of the European Parliament and of the Council and Directive 2015/2436 of the European Parliament and of the Council

As explained briefly above, EUTMR and EUTMD are the main regulations which are currently effective concerning trademark dilution protection in European Union. Art. 9 and 10 of the Regulation refer to European Union Trademarks and Art. 10 and 11 of the Directive refer to Member States. These provisions are almost identical except for the fact the Regulation includes EU trademarks and Directive relates to Member States.

²⁰³ EU Directive No. 2015/2436 <https://eur-lex.europa.eu/eli/dir/2015/2436/2015-12-23> (online on 08.06.2022)

²⁰⁴ EU Regulation No. 2017/1001 <http://data.europa.eu/eli/reg/2017/1001/oj> (online on 08.06.2022)

Art. 9/2-c of EUTMR is parallel to Art. 10/2-c of EUTMD no. 2015/2436. Directive regulates that the well-known mark owner would have the right to prohibit the use of a sign that is identical or similar. Moreover, this is the case even if it is used on dissimilar commodities or services. However, it would need to have a repute in the Member States.²⁰⁵

Same provision was structured for EU trademarks in Article 9/2-c of EUTMR, as this provision is regarding trademarks in Member States.²⁰⁶ It can be said that this provision is an amended and updated version of Article 5/2 of EU Directives 89/104/EEC and 2008/95/EC.²⁰⁷

²⁰⁵ EU Directive No. 2015/2436

Article 10/2:

“Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trade mark, the proprietor of that registered trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where:

(a) the sign is identical with the trade mark and is used in relation to goods or services which are identical with those for which the trade mark is registered;

(b) the sign is identical with, or similar to, the trade mark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;

(c) the sign is identical with, or similar to, the trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to, or not similar to, those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.”

²⁰⁶ EU Regulation No. 2017/1001

Article 9/2

“Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the EU trade mark, the proprietor of that EU trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where:

(a) the sign is identical with the EU trade mark and is used in relation to goods or services which are identical with those for which the EU trade mark is registered;

(b) the sign is identical with, or similar to, the EU trade mark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the EU trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;

(c) the sign is identical with, or similar to, the EU trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to or not similar to those for which the EU trade mark is registered, where the latter has a reputation in the Union and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the EU trade mark.”

²⁰⁷ Büyükkılıç, Gül. p. 114-115.

“Dilution” phrase has not been clearly specified under any of these legislations. However, both in EUTMR no. 2017/1001 and EUTMD no. 2015/2436, use of the signs with reputation without due cause that is harmful to distinctive nature, or repute of mark has been mentioned within rights granted to an EU trademark.²⁰⁸ This phrasing is important as the dilution is described to occur as such in CJEU ruling.²⁰⁹ It has been stated in “*Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd.*” judgement dated 23/10/2003 that *Directive*²¹⁰ Art. 5/2 involves protection against using of marks that are alike to trademark with a repute, to such an extent that the use in question either concerns possibility of dilution, or injury to repute of the trademark involved.²¹¹

Similar with the US practice, one of the main conditions sought for the protection against dilution is for the trademark to be well-known, or, as it is phrased as in relevant EU legislations, to be a mark with a “reputation”. In order for a trademark to be considered as a mark with a repute, it will be deemed necessary for it to be recognized by a noteworthy segment of consumers within considerable segment of EU or one of the Members States.²¹²

One of the characteristics of this type of marks is that they have a strong influence in public and a brand image which can trigger *association*. Some of the criteria which are used to assess the association were stated in “*Intel Corporation Inc. v CPM United Kingdom Ltd.*”,²¹³ for instance the resemblance level amongst the opposing trademarks, and the characteristics of products or services they are registered for, likelihood of confusion etc. Association arising from this similarity may create a linkage amongst the opposing trademarks. However, establishment

²⁰⁸ See. EU Regulation No. 2017/1001 of 14 June 2017, Section 2, Effects of an EU trade mark, Article 9/2/c.

²⁰⁹ Shchetinina, Alina. “The Dilution of a Trademark: A Comparative Study on EU and U.S. Law.” *Stanford-Vienna TTLF Working Papers*, No. 35, Stanford Law School, 2018, p. 6.

²¹⁰ The “Directive” here refers to Article 5(2) of First Council Directive No. 89/104/EEC, dated 21 December 1988.

²¹¹ Case C-408/01, *Adidas_Salomon AG v Fitnessworld Trading Ltd* [2003] ECLI:EU:C: 2003:582.

²¹² Shchetinina, Alina. p. 27.

²¹³ Case C-252/07 *Intel Corporation Inc. v CPM United Kingdom Ltd*, para 42.

of link is just beginning of the process; and it does not automatically prove the dilution in such cases.²¹⁴

Furthermore, it is essential to highlight both within EUTMR and EUTMD, protection against dilution is provided for the use in commodities and services that are identical or alike which the mark is registered in as well, in addition to use with connection to a commodity or service that is not alike at all. Nevertheless, this legislation is important as it became possible to avoid risks which may arise in cases wherever the commodities and services of parties involved are not related enough for claiming infringement grounded on misperception threat, since the similarity level which will be considered shall be different in case of a dilution claim and achieve trademark protection as a whole.²¹⁵

Therefore, it can be said that the degree of similarity which will be assessed will be different in dilution and confusion cases as the legislation provides that the trademark's holder shall demonstrate the resemblance level amongst the marks in their claim, whether it is on the grounds of dilution or likelihood of confusion.²¹⁶

Last but not the least, one of the main things to take into account when assessing dilution is the harm or potential harm which arise due to the use which may be considered as dilution.²¹⁷ Unlike the US, it can be put in three categories: blurring, tarnishment, and, taking unfair advantage, which is also known as free riding.²¹⁸ These terms are used as equivalents of the terms stated within Art. 8/5 of EUTMR which are "detriment to distinctiveness", "detriment to repute" and "unfair advantage", respectively.²¹⁹ All of these acts shall be considered as dilution

²¹⁴ Shchetinina, Alina. p. 37.

²¹⁵ Büyükkılıç, Gül. p. 118.

²¹⁶ Shchetinina, Alina. p. 32.

²¹⁷ *ibid*, p. 39.

²¹⁸ EUIPO, Guidelines on Trade Marks with Reputation, para 3.4.3.

²¹⁹ Regulation (EU) 2017/1001 of the European Parliament and of The Council of 14 June 2017 on the European Union trademark, Article 8/5.

in accordance with EU Trademark Law, provided other conditions stated in relevant legislation are fulfilled as well.

4. COMPARISON OF DILUTION CONCEPT AND REGULATIONS ON TRADEMARK DILUTION IN THE UNITED STATES AND EUROPEAN UNION

Although US legal system is similar to EU legal system concerning well-known trademarks' protection and protection against trademark infringement overall, there are some differences in terms of scope and conditions required for this protection. Both systems follow the minimum obligations which have been set out in the international regulations, such as Paris Convention and TRIPs Agreement.²²⁰

Protection against trademark dilution is regulated irregardless of product or service category that the trademark is used in for both EU and US. Dilution by "blurring", and dilution by "tarnishment" are stated as dilution subtypes on TDRA and these are also recognized as types of dilutive use on EU legislation although the phrasing is different considering the terms are not explicitly stated. Another one of the common elements is that in both legal systems, protection against dilution is only granted to trademarks with a certain level of recognition.²²¹

As for the United States, Trademark Dilution Revision Act provides protection only for "famous" marks, which in comparison with the EU Directive, requires a greater recognition in public. As a natural result of this, a greater portion of the trademarks are able to take advantage of the protection against trademark dilution in EU legislation, including the trademarks that have been only recognized in an exclusive marketplace as well. Therefore, range of trademarks which can be protected under anti-dilution protection is limited in US when

²²⁰ Malliaris, Stylianos. "Protecting Famous Trademarks: Comparative Analysis of US and EU Diverging Approaches - The Battle Between Legislatures And The Judiciary Who Is The Ultimate Judge?." *Chicago-Kent Journal of Intellectual Property*, 2010, p. 58.

²²¹ Büyükkılıç, Gül. p.124.

compared to EU, however for protection against traditional trademark infringement which is based on likelihood of confusion, US trademark law provides a wider protection. It can be argued that it was reasonable to aim to avoid any legal gap which may arise due to this by broadening extent of protection against dilution in EU, and protection against confusion possibility within US.²²²

All in all, whether the requirement for the trademark is to be well-known, famous, or to be a mark with a reputation, it is always sought the mark to be acknowledged to a degree in order to possess the perks to protection against dilution. This applies to Turkish trademark law as well and the degree of fame required for dilution protection is similar to its EU counterpart.

It can be said that another difference between the two systems is the assessment of “free riding” notion within trademark dilution framework. While expression used is different, free riding as a concept has been included in the EU Directive in the same provision which regulates anti-dilution protection by stating use of the trademark that might be considered as “gaining unfair advantage” is also subject to protection. US legislation only recognizes blurring and tarnishment as a dilution type.

It would be noteworthy to mention as it has been explained under Trademark Dilution Revision Act subchapter, TDRA has made it clear that proof of actual dilution will not be sought for the protection granted under this Act. As for EU legislation, there is no provision which regulates that whether it shall be deemed enough that there is possibility of dilution. It can be said that EU case law takes a different approach regarding this issue as it was seen on CJEU’s *Intel* judgement.²²³

²²² Büyükkılıç, Gül. p. 125; Luepke, Marcus. “Taking Unfair Advantage or Diluting a Famous Mark: A 20/20 Perspective on the Blurred Differences Between U.S. and E.U. Dilution Law”. *Trademark Reporter*, 2008, Vol. 98, No.3, p.789-791.

²²³ Malliaris, Stylianos. p. 59.

In conclusion, while there are certainly common elements with regards to well-known trademarks' protection generally and trademark dilution in both systems, there are still significant differences on the scope of this protection and assessment of dilution as briefly explained above. It is important to understand the roots and how the concept evolved in US as it is a concept which unarguably originated from there.²²⁴ The legalization and assessment in the Turkish law is more similar to EU compared to US, as it strictly followed the footsteps of EU with regards to trademark law in general.

²²⁴ Malliaris, Stylianos. p. 58.

CHAPTER III

PROTECTION OF WELL-KNOWN TRADEMARKS AGAINST DILUTION IN TURKISH LAW AND EXCEPTIONS

1. OVERVIEW

In order to thoroughly understand the concept of dilution in Turkish Trademark Law, it is necessary to first explore the relevant legal regulations in a historical context. Article 4/3 of EC-Türkiye Association Council's Decision Numbered 1/95 regulates that Turkish Trademark Law shall be in compliance with EU Directive 89/104/EEC.²²⁵²²⁶

The EC-Türkiye Association Council has agreed on the decision in question on 6 March 1995, thus making the Directive 89/104/EEC the regulation effective at the time of this decision. Central drive behind this provision was to ensure EU candidate states to be in compliance with EU Directives, and as Türkiye has been recognized as an EU candidate state by EU Helsinki Council, it became extremely essential to comply its legislation with EU trademark law with the purpose of becoming a full member. Therefore, even though the provision stated has not been amended ever since, it would be significant noting due to the circumstance of EU Directive 89/104/EEC no longer being in force, it must be assumed that any sort

²²⁵First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trademarks <http://data.europa.eu/eli/dir/1989/104/oj> (online on 15.08.2022)

²²⁶ Decision No 1/95 of THE EC-TÜRKİYE ASSOCIATION COUNCIL dated 22 December 1995 Article 4/3: *"Before the entry into force of this Decision, Türkiye shall adopt domestic legislation in the following areas which is equivalent to the legislation adopted in the Community or its Member States: ...3. Trade and service marks legislation in line with Council Directive 89/104/EEC (OJ No L 40 of 11 February 1989)"*

of regulation in Türkiye on trademarks shall be in compliance with Directive No. 2015/2436 instead.²²⁷

With that said, the main legislation on trademarks and other industrial property rights which is in force is Law No. 6769, Turkish Industrial Property Code of December 22, 2016, revoking Decree Laws No. 551, 554, 555 and 556. It could be easily argued that this new legislation follows EU regulations closely, as harmonization was specifically considered as well as fulfilling the requirements of international treaties when it was first drafted. Therefore, it is no surprise that the regulations regarding dilution in Türkiye is similar to its EU counterparts. Article 6/5 and Article 7/2 of Turkish Industrial Property Code regulate protection against for trademark dilution, however, these provisions do not explicitly state the term “dilution” either. On the other hand, there are quite a few instances that the term “dilution” is used and described as a concept in Turkish Case law. These cases shall be examined in the following chapters.

2. RELEVANT LEGISLATION IN TURKISH LAW

2.1. The Decree Laws

It can be said that dilution is relatively a new concept in Turkish law when compared with EU and the US and the first regulation to ever include provisions related to protection against trademark dilution is Decree Law No. 556 which came into force in 1995. Although it was not adequate in every aspect, the purpose of the Decree was to ensuring compliance with EU legislation.²²⁸

Decree Law No. 556, Art. 8 sets out relative grounds for denial in trademarks’ registration process.²²⁹ Protection of the well-known marks in different goods and

²²⁷ Büyükkılıç, Gül. p. 127.

²²⁸ Hacıömeroğlu, A. Oğuzhan and İnce, Zeliha. “Ulusal ve Uluslararası Düzenlemeler ile Yargı Kararları Işığında Tanınmış Markanın Sulandırılması.” *Ticaret ve Fikri Mülkiyet Dergisi*, 2020, p.90.

²²⁹ Decree-Law No. 556 of June 24, 1995, Article 8:

services are ensured in cases where there is a possibility of harm to repute or distinctiveness of trademark in question, or likelihood of taking unfair advantage of the mark with repute in Art. 8/4. Identical expression is used once again within Article 9 which regulates the scope of rights that arises due to the registration of trademarks and well-known marks are clearly protected against dilution with these provisions, although the term is not used explicitly.²³⁰

2.2. Industrial Property Code No. 6769

Turkish Industrial Property Code No. 6769 is highly influenced by its EU counterparts, due to the fact that one of its aims was to harmonize the trademark

“On opposition from the proprietor of a trademark registration application or registered trademark, the trademark registration applied for shall not be granted under the following circumstances:

(a) if the trademark filed for registration is identical to a registered trademark or to a trademark that has an earlier application date, and the protection is sought for identical goods or services;

(b) if, because of its identicalness or similarity to a trademark that has an earlier application date or to a registered trademark and because of the identicalness or similarity of the goods and services covered by the trademarks, there exists a risk of confusion on the part of the public and that risk of confusion includes the likelihood of association with the registered trademark or with the trademark that has an earlier application date.

On opposition from the proprietor of a trademark, a trademark shall not be registered where an agent or representative of the proprietor of the trademark has applied for such registration in his own name without the proprietor’s consent and without valid justification. On opposition from the proprietor of an unregistered trademark or of another sign used in the course of trade, the trademark registration applied for shall not be granted where:

(a) the rights in the sign were acquired prior to the date of the trademark registration application, or the priority date claimed for the said application;

(b) the sign confers on its proprietor the right to prohibit the use of a subsequent trademark.

A trademark filed for registration that is identical or similar to a registered trademark or to a trademark with an earlier application date may be used for different goods and services. However, where a registered trademark or a trademark with an earlier application date has a reputation, and where the use without due cause of the trademark filed for registration would take unfair advantage of or be detrimental to the distinctive character or reputation of the registered trademark or of the trademark with an earlier application date, on opposition from the proprietor of the earlier trademark the trademark applied for shall not be registered, even for use in connection with goods or services that are not similar to those for which the earlier trademark is registered. On opposition from the holder of the relevant rights, the trademark filed for registration shall not be registered if it contains the name or photograph or infringes the copyright or any industrial property rights of third parties. On opposition, a trademark filed for registration that is identical or similar to a collective or guarantee mark shall not be registered for three years following the expiry date of the collective or guarantee mark. A trademark filed for registration that is identical or similar to a trademark the registration of which has not been renewed, and which is to be registered for identical or similar goods and services, on opposition, shall not be registered for two years following the expiry date.”

²³⁰ Decree-Law No. 556 of June 24, 1995, Article 9/c:

“...using any sign that is identical or similar to the registered trademark in relation to goods or services that are not similar to those for which the trademark is registered, but where the use of that sign without due cause takes unfair advantage of or is detrimental to the distinctive character or reputation of the registered trademark...”

legislation with EU trademark law, as a candidate state. Therefore, IPC Art. 6/5 can be seen as a parallel to Article 5/3(a) of Directive No. 2015/2436.²³¹ The provision in question is as it follows:

“Relative grounds for refusal in trademark registration

ARTICLE 6- (5) *A trademark application which is identical with, or similar to, an earlier registered trademark or trademark application, irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the latter trademark is applied for, and the use of the latter trademark without due cause would take unfair advantage of, or be detrimental to the distinctive character or the repute of the earlier trademark due to the reputation the earlier trademark has in Türkiye, will be refused upon opposition made by the proprietor of the earlier trademark.”*

This article may be considered as the heart of protection against dilution in Türkiye and it describes three types of harm for the earlier registered trademark, similar to its EU counterpart. These are “harm to distinctiveness”, “harm to repute” and “unfair advantage”. As stated before, just like this article, there is no provision in Turkish legislation which explicitly states dilution as a term. However, dilution was included in the justification of Article 6, thus making it the first legal document in Türkiye which actually uses this term. It specifically states that the dilution of well-known trademarks and taking unfair advantage of such marks issue have been regulated in the fifth paragraph of the article, in accordance with TRIPS agreement and EU Trademark Regulation No. 2015/2424.²³²

The other provision which regulates dilution is Article 7/2(c) of Turkish Industrial Property Code, which can be considered as a parallel to Art. 10/2(c) of Directive No. 2015/2436.

²³¹ Büyükkılıç, Gül. p. 128.

²³² Sınai Mülkiyet Kanunu Tasarısı (1/699) ve Sanayi, Ticaret, Enerji, Tabii Kaynaklar, Bilgi ve Teknoloji Komisyonu Raporu, p.12. <https://www.tbmm.gov.tr/sirasayi/donem26/yil01/ss341.pdf> (online on 15.09.2022)

“Scope of rights conferred by a trademark and its exceptions

ARTICLE 7-2(c) *Use of any sign which are identical with, or similar to the registered trademark, irrespective of being for identical, similar or not similar goods or services, where the use of that sign without due cause will take unfair advantage of or is detrimental to the distinctive character or the repute of the trademark due to the reputation it has in Türkiye.”*

Based on the articles referred, one of the conditions sought for in the protection against trademark dilution is for it to be a trademark with a reputation, or as stated in the provision, for it to have a reputation in Türkiye. The level of reputation which is required in this case is not necessarily for it be recognized in all of Türkiye, but rather in a significant part of Türkiye by the relevant consumer group.²³³

The scope of protection based on the recognition level is wider compared to the US in this context, just like EU regulation. As for how to assess whether the condition of reputation is fulfilled, principles which are paid regard to by Turkish Patent and Trademark Office is explained in detail under “Well-known Trademark” section.

2.2.1. Trademark Infringement within the Context of Article 7 of Intellectual Property Code

Infringement of trademarks is regulated under Turkish Industrial Property Code No. 6769 in Turkish legislation. Article 7 and Article 29 of the Code include acts which may be considered as trademark infringement. These provisions include trademark infringement and infringement of well-known marks which is in essence protection against trademark dilution. Trademark dilution is a notion

²³³ Sınai Mülkiyet Kanunu Tasarısı (1/699) ve Sanayi, Ticaret, Enerji, Tabii Kaynaklar, Bilgi ve Teknoloji Komisyonu Raporu, p.12. <https://www.tbmm.gov.tr/sirasayi/donem26/yil01/ss341.pdf> (online on 15.09.2022)

which is specific to well-known marks. Terminology used in the US strictly distinguishes these two concepts and trademark infringement claim does not necessarily include dilution, vice versa. However, in EU and by extension Türkiye, trademark dilution is usually referred as a type of infringement as well. Therefore, in order to understand how the trademark dilution is regulated within protection against infringement in Turkish law, these two provisions should be examined as well.

Article 29 of IPC firstly refers to the uses lacking the authorization of the proprietor of the trademark set forth in Article 7 stating that these acts will be considered as trademark infringement as well. The acts in question which are listed in Article 7/2 are as follows:

- “a) To use any sign which is identical with the trademark used in relation to goods or services that are in the scope of the registration.*
- b) To use of any sign which is identical with, or similar to, a registered trademark and covering identical or similar goods and services with the registered trademark and is therefore liable to generate a likelihood of confusion on public, including the likelihood of association between the sign and the trademark.*
- c) To use of any sign which is identical with, or similar to the registered trademark, irrespective of being for identical, similar or dissimilar goods or services, where the use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark due to the reputation it has in Türkiye.”*

Art. 7/2(a) covers the use of the earlier registered mark of an identical or similar sign with the earlier registered mark in identical or similar goods and services with the earlier registered mark which refers to the concept of double identity.

Article 7/2(b) regulates such use which causes trademark infringement by likelihood of confusion that refers to unauthorized use of an identical or similar

sign with the earlier registered mark in identical or similar goods and services with the earlier registered mark, just like the Decree Law 556, Article 9/1.²³⁴

On the other hand, Article 7/2(c) regulates infringement of well-known marks, which refers a particular protection form only granted to trademarks with a repute and it is also known as trademark dilution as it has been explained previously.

In addition to these, Article 7/3 provides another list of acts which may constitute trademark infringement, provided the mark is used in a commercial context.²³⁵ Putting or affixing the mark to the products or to the packaging is a right which is exclusively granted to the proprietor of the trademark.²³⁶ The provision provides that in order for a breach to arise, registered trademark should be actively used which means it shall not be deemed enough that the identical or similar mark is produced, it must also be put to the goods belonging to the proprietor of the trademark.²³⁷

Furthermore, the other acts counted in the provision, such as importing, exporting of products underneath that symbol, using as trade name and in comparative advertising unlawfully shall be considered as trademark infringement and shall be actionable under the same Law, irrespective of the mark being well-known or not.

2.2.2. Trademark Infringement within the Context of Article 29 of Intellectual Property Code

Turkish Industrial Property Code No. 6769, Article 29 provides a list for the acts which shall constitute trademark infringement, although this list is not

²³⁴ Arkan, Sabih. *Marka Hukuku*. Vol. II, p. 210.

²³⁵ Turkish Industrial Property Code No. 6769, Article 7/3.

²³⁶ Arkan, Sabih. *Marka Hukuku*. Vol II, p. 211.

²³⁷ Arkan, Sabih. *Marka Hukuku*. Vol II, p. 211.

exhaustive.²³⁸ These acts will be considered as trademark infringement, provided it is done in the absence of permission of proprietor of the registered trademark:

- (i) Counterfeiting of the trademark by using the identical or a misleadingly similar mark,
- (ii) Selling, distributing, demonstrating on the market in a different form, possessing for commercial purposes, importing, exporting the goods which carry the infringed trademark or offering to make a contract with regards to these goods, provided it is known or should be known that the trademark is counterfeited by using an identical or a misleadingly similar mark,
- (iii) Extending the scope of or transferring the rights granted by the holder of the trademark through license to the third parties.²³⁹

It is important to note that, while all of the acts above are actionable also regarding the infringement of the well-known marks, for marks without a repute it is necessary to be registered in order to enforce the rights stated in provisions above. However, this is not necessary for well-known marks in every situation. Article 6/4 of IPC simply asserts that trademark applications which go against Paris Treaty Art. 6*bis*' scope will be declined if opposed for identical or related products and services, which makes it a relative ground for refusal. While it is not regulated under "Trademark Infringement" provision, well-known marks have the right to prevent this type of registration which may cause infringement, even if it is unregistered itself, in contrast to other marks.

3. DILUTION IN TURKISH CASE LAW

As previously indicated, despite the fact that the expression of "dilution" has not been explicitly specified within legal regulations concerning Turkish

²³⁸ Dirikkan, Hanife. *Tanınmış Markanın Korunması*. p. 266.

²³⁹ Dirikkan, Hanife. p. 268.

Trademark Law, dilution as a term is acknowledged, explicitly stated, and described in many Turkish court rulings. Turkish High Court Assembly of Civil Chambers stated in the ruling of no. 2013/11-1885, 2015/1161 and date 8.4.2015: *"...in other words, even if it is not the group of commodities which are not identical or similar, there is no doubt that in case of registration of a trademark which is in conflict with the well-known mark, the defendant trademark owner will have the opportunity to take unfair advantage of the reputation of the well-known trademark, it will damage the reputation of the well-known trademark and dilute its distinctive quality with the goods and services it produces and offers..."*

It is also stated in the exact judgment by the Court that: *"The use of a trademark in more than one mark may cause to lessening of a well-known trademark's strength and its area of influence. This is known as dilution of a trademark."*²⁴⁰ As seen clearly, while the concept dilution is only described in the relevant legislation, the term is unreservedly expressed in case law and justification of the Law No. 6769.

Another one of the landmark decisions that highlights significant aspects to the concept of dilution even before the enactment of Law No. 6769 is the "DERBY" case of Supreme Court Assembly of Civil Chambers ruling of no. 2013/656, dec. 2014/427, dated 2.4.2014. It is explained in this ruling that dilution occurs in cases where the well-known trademark's reputation may be damaged, its distinctive character may be potentially harmed, or well-known trademark may be taken unfair advantage of due to its level of recognition accomplished within the society by the application made for different goods or services.²⁴¹

This decision is significant also for its inclusion and explanation of the concept and term of "tarnishment", a subtype of dilution. It is stated that harming well-known trademark's repute is referred as tarnishment in doctrine and it occurs in cases where the mark has been used on products and services which are

²⁴⁰ Turkish High Court, Assembly of Civil Chambers, No. 2013/11-1885, dec. 2015/1161, 08/04/2015.

²⁴¹ The Court refers to: Yasaman, Hamdi. *Marka Hukuku – 556 Sayılı KHK Şerhi*. Vol I, Vedat Kitapçılık, 2004, p.415.

derogatory and image-damaging in a manner which harms well-known mark's reputation.²⁴²

There is no doubt that dilution notion is often referred and explicitly used in many of the Court rulings, and some cases such as "DERBY" case, the subtypes of dilution are mentioned. However, it can be seen that in the majority of Turkish Court rulings the three different types of dilution evaluated all together in an abstract way, and it is not concretely stated how an unfair exploitation would occur, why the mark's reputation would get impaired or why the mark's distinctive character will be damaged, and there are no criteria provided for each of these conditions.²⁴³

This conceptual vagueness can be observed in General Assembly of Civil Chamber approved "CROCODILE" ruling of Turkish High Court, 11th Chamber, which is an important decision due to the fact it described dilution, as it is stated above as well. However, it states that *"...Even if the goods and services are dissimilar, it should be acknowledged that the defendant application with the phrase "CROCODILE" will provide an unfair advantage against the plaintiff's trademark in the class of goods and services for which registration is requested, it may damage the reputation of the trademark or allow it to damage its distinctive character. In other words, even if there is no overlapping or similar commodity group, there is no doubt that the defendant trademark owner will find the opportunity to benefit unfairly from the reputation of the well-known trademark, damage the reputation of the well-known trademark with the products it produces, damage and dilute its distinctive character..."*.²⁴⁴

Another similar ruling of 11th Chamber expresses that: *"...The plaintiff's trademarks with the phrase "..." are well-known in the hotel management and pastry shop sectors, and in the examination made in this respect, the defendant company's application in terms of "37. Construction services", one of the services included in the defendant*

²⁴² Çolak, Uğur. *Türk Marka Hukuku*. p. 340.

²⁴³ Çolak, Uğur. *Türk Marka Hukuku*. p. 333.

²⁴⁴ Turkish High Court, Assembly of Civil Chambers, No. 2013/11-1885, dec. 2015/1161, 08/04/2015.

*company's trademark registration application, may provide unfair benefit from the recognition of the plaintiff's trademarks, may damage the recognition of the plaintiff's trademarks, and may have consequences that damage their distinctiveness..."*²⁴⁵

Same approach is observed on a more recent ruling of 11th Chamber: *"...Decision of acceptance of the lawsuit on the grounds that the defendant's trademark application is in the nature of trying to infiltrate between the plaintiff's serial trademarks and considering the possibility that "the trademark application made may provide unfair benefit from the recognition of the other party, damage its reputation or have consequences that damage its distinctive character", and that the condition of the recognition obstacle regulated in Article 8/4 of the Decree Law No. 556 is fulfilled..."*²⁴⁶

As can be seen from the decisions provided above and many of the High Court rulings which are based on Decree Law 556 Article 8/4, most of the time these three cases provided in the provision can be grouped together.²⁴⁷ Considering in fact all these different conditions do not have to be present together and the presence of only one condition would be sufficient for dilution to occur,²⁴⁸ it would be more accurate to differentiate these three types and make more concrete assessments on how each one occurred/did not occur/*can occur in the future*²⁴⁹ based on the case. With regards to the issue of proof in dilution claims, practice in Turkish case law is similar to EU and the US. While in principle, the claimant shall be obliged to prove their claim, there is no necessity to prove that actual harm has occurred, simply proving that there is a risk of possible or foreseeable harm is sufficient, provided other requirements foreseen in relevant regulation are fulfilled.²⁵⁰

²⁴⁵ Turkish High Court, 11th Civil Chamber, No. 2017/2792 - 2019/13, d. 07.01.2019.

²⁴⁶ Turkish High Court, 11th Civil Chamber, No. 2020/157 - 2020/4019 K., d. 12.10.2020.

²⁴⁷ Also see. Turkish High Court, 11th Chamber rulings of: No. 2010/5673 – 2012/5220 d. 03.04.2012 & No. 2011/8943 – 2012/17000, d. 31.10.2012.

²⁴⁸ Çolak, Uğur. p. 333.

²⁴⁹ CJEU C-100/11, *L'Oréal SA*, para. 93.

²⁵⁰ Seker, Emriye Ozlem. "A Comparison of Trademark Laws in European Union and Türkiye on Protection against Dilution of Trademarks." *Ankara Bar Review*, Vol. 6, No. 1, 2013, p.104.

In addition to these independent conditions not being assessed separately, it can also be seen that in some of the rulings in the past, they have not been considered at all. Being well-known has been deemed enough to be a ground for refusal for registration and a reason for invalidity for other classes within Decree Law Art. 8/4's scope, which regulated dilution, by Turkish High Court on some occasions. Turkish High Court 11th Civil Chamber concluded in its "DESA" ruling dated 14/02/2008 that "DESA" trademark is a well-known mark, and therefore it constitutes a ground for refusal registration in terms of dissimilar goods and services. The Court has not made any assessments on whether any requirements on Art. 8/4 is relevant at all and being well-known has been deemed enough.²⁵¹

A related approach of the High Court to this which has been rightly highly criticized is that in almost all its decisions is that the Court automatically admits that if the well-known mark has been used with a different product or service, the reputation created by this trademark in the public is benefited from and thus provides an unfair advantage. This has been subject to criticism, which is rightfully in my opinion, expressing that it must be examined separately in each specific case, and it should not be a generally accepted assumption.²⁵²

Fortunately, the High Court took a different approach in the following years, emphasizing that simply a mark being well-known would not be considered enough for it to be granted protection in dissimilar goods and services. In "NİVA" ruling, General Assembly of Civil Chambers states that: "...In order to prevent the registration of trademarks in different classes based on the fact that the plaintiff's trademark is well-known, it is necessary to discuss and evaluate the conditions of obtaining an unfair benefit from the recognition of the trademark, damaging the reputation of the trademark, and damaging the distinctive character of the trademark specified in Decree Law Numbered 556, Art. 8/4 separately for each concrete dispute..."²⁵³

²⁵¹ Çolak, Uğur. *Türk Marka Hukuku*. p. 342.

²⁵² Dural, Ali. "Yargıtay 11. Hukuk Dairesi'nin Tanınmış Markalara İlişkin 8.6.2000 Tarihli Kararı Hakkında Düşünceler." *Galatasaray Üniversitesi Hukuk Fakültesi Dergisi*, Vol. 1, No. 1, 2002, p. 865.

²⁵³ Turkish General Assembly of Civil Chambers, No. 2017/18 - 2021/532, d. 27.04.2021.

Another interesting thing that sparks attention in evaluation of dilution on Turkish case law is that, even though possibility of misperception is not something essential for application of anti-dilution protection, on some cases protection against dilution, there are some assessments which seemed to take likelihood of confusion into account as well. This is apparent on the dissenting opinion of General Assembly of Civil Chambers ruling of no. 2015/11-3127 - 2016/114, d. 29.01.2016, it has been noted that “...Even if the same or similar trademark is used in different goods/services, it will arouse the feeling in third parties that these products are produced by the trademark owner who produces the well-known trademark...” which results in protection founded on the confusion risk being intermingled and, within terms of dilution, such impression has been created as if that confusion or at least a possibility of it may be requirement.²⁵⁴

Similar approach is seen on 11th Chamber’s “UNO” decision as well, the Court concluded that consumers would not think that they were buying a product manufactured by the plaintiff when purchasing the defendant's "UNO" branded products, and there was no possibility of connection of disputing parties' trademarks in consumers’ mind that occurs because of the recognition of claimant's "UNO" mark, and therefore, situations provided in Decree Law Art. 8/4 could not occur.²⁵⁵

To summarize, Turkish case law demonstrates that similar to EU, it would be deemed enough to have simply one of the conditions stated on Article 6/5 of IPC which regulate dilution in order to be granted protection. These three acts include obtaining unjust advantage from trademark’s recognition, damaging distinctive nature of trademark, and harming relevant trademark’s reputation. Though occurrence of only one of the conditions would be sufficient, there is no necessity to prove that dilution have actually taken place. However, evidence must be

²⁵⁴ Büyükkılıç, Gül. p. 325.

²⁵⁵ Turkish High Court, 11th Chamber, No. 2011/798 - 2012/7525, d. 10.05.2012.; Noyan, Erdal and Güneş, İlhami. *Marka Hukuku*. Adalet Yayınevi, 2015, p. 216-217.

presented in respect of the danger of dilution in question.²⁵⁶ Turkish High Court also takes the commonality of the targeted segments of the public and the similarity of the marks into consideration of in determining dilution.²⁵⁷

It is generally acknowledged that possibility of confusion is not a requirement and similarity of the marks to some degree would suffice, however there are some cases as explained above that intermingles trademark dilution and likelihood of confusion which may result in conceptual misperception. This vagueness may also be observed in the Court's general tendency of combining the three subtypes of together without having to assess each of them separately.²⁵⁸ Considering all of the factors argued, I presume it should be accurate claiming that a more thorough explanation of the criteria for the assessment of each different condition in dilution may be necessary in Turkish case law.

4. THE SCOPE AND CONDITIONS OF PROTECTION AGAINST DILUTION

4.1. Earlier Mark Being Well-Known

Reputation, or being well-known is the essence of the dilution concept as it can be argued that anti-dilution protection serves the purpose of rewarding the trademark owner for their investments used in differentiating their marks from other trademarks by gaining recognition.²⁵⁹ Whether under international treaties, or under EU, US, and Turkish law, only trademarks with certain recognition levels in consumer's eyes can benefit from the protection against dilution. Paris Convention Art. 6bis and TRIPS Art. 16/2-3 use the term "*well-known mark*", on the other hand US Revision Act preferred the phrase "*famous mark*". The relevant

²⁵⁶ Yasaman, Hamdi. *Sınai Mülkiyet Kanunu Şerhi II md. 6-9*. p. 1092.

²⁵⁷ Turkish High Court, 11th Civil Chamber, No. 2019/2823 - 2020/840, d. 03.02.2020.

²⁵⁸ Yasaman, Hamdi. *Sınai Mülkiyet Kanunu Şerhi II md. 6-9*. p. 1092.

²⁵⁹ Hacıömeroğlu, A. Oğuzhan and İnce, Zeliha. p. 93.

provisions regulating protection against dilution on EUTMD²⁶⁰ and EUTMR²⁶¹ refers to trademarks that has reputation. In Article 7/2 of IPC, which is the provision that provides anti-dilution protection in Türkiye, trademarks which *“have reached to a certain level of recognition in Türkiye”* phrasing is used.²⁶²

While several terminologies are set forth in different legislations, it would be reasonable to say that within the context of dilution protection, “well-known mark” is an umbrella term which includes all of them.²⁶³ All of the trademark which are expressed in diverse terminology are based on recognition and the only difference in their essence is that they refer to different levels in terms of recognition they have.²⁶⁴ For instance, the degree of recognition that is deemed enough to be considered as “famous” trademark within US trademark law context is not the same as with the trademark that has reached to a certain level of recognition in Türkiye; a higher degree shall be required for a famous mark.

As it has been previously explained on Well-Known Marks within the Context of Turkish Trademark and Case Law & TURKPATENT, there are several criteria which is laid out on determining for trademarks to be in fact recognized as a well-known trademark by TURKPATENT and there have been many descriptions of what may constitute as a well-known mark on doctrine and case law. Since it has been explained in detail on “Well-known Mark” chapter, it will only be briefly mentioned in this chapter. Turkish High Court states in several of its rulings that well-known trademark does not have any precise definition, and the determination will be case-by-case according to the circumstances.²⁶⁵ The Court

²⁶⁰ Directive (EU) 2015/2436 of The European Parliament and of The Council of 16 December 2015, Article 5/3 and 10/2.

²⁶¹ Regulation (EU) 2017/1001 of The European Parliament and of The Council of 14 June 2017, Article 8/5 and 9/2.

²⁶² Büyükkılıç, Gül. p. 185-186.

²⁶³ Kaseke, p. 83. Büyükkılıç, Gül. p. 186.

²⁶⁴ Çolak, Uğur. *Marka Hukuku*. p. 319-320.

²⁶⁵ Turkish High Court, 11th Civil Chamber, 14/07/2011 No. 2009/9530 - 2011/8923.

also expresses that a well-known mark is a notion that has a great economic value for the owner and expresses a new function for the public.²⁶⁶

However, in the past, it can be seen that Turkish High Court 11th Civil Chamber considered a mark being registered in many states sufficient on being categorized as a well-known trademark in Decree Law 556 Art. 8/4 context, which is the previous provision that regulated anti-dilution protection. This approach has been criticized on the grounds the criteria should be level of acknowledgement the trademark has achieved in society.²⁶⁷

Nevertheless, main question is what we need to consider as “well-known” or “with a reputation” in terms of protection against dilution. “*Chevy*” ruling of CJEU became a landmark on determining this notion with regards to dilution.²⁶⁸ The Court ruled that the previous mark owner may benefit from protection against dilution if the products or services bearing that trademark are known by a large part of consumer group to which the products or services are directed.²⁶⁹

4.2. Association Between the Marks

Dilution is rooted in the psychological connection which purchasers create amongst the well-known trademark and conflicting sign as it arises from a change in consumer perception of the trademark. Therefore, some sort of connection, or association should exist between the previous and subsequent marks for the former trademark to be entitled to anti-dilution protection.²⁷⁰

US legislation explicitly states connection among such marks as a condition within TDRA. Conversely, EU and Turkish legislation do not necessarily regulate

²⁶⁶ Turkish High Court, 11th Civil Chamber, 14/07/2011 No. 2009/9530 - 2011/8923; Büyükkılıç, Gül. p. 189.

²⁶⁷ Dural, Ali. “Yargıtay 11. Hukuk Dairesi’nin Tanınmış Markalara İlişkin 8.6.2000 Tarihli Kararı Hakkında Düşünceler.” *Galatasaray Üniversitesi Hukuk Fakültesi Dergisi*, Vol. 1, No. 1, 2002, p. 861.

²⁶⁸ CJEU, Case C-375/97, *General Motors Corporation v. Yplon SA*. 14/09/1999.

²⁶⁹ *General Motors v. Yplon*, para. 31.

²⁷⁰ Büyükkılıç, Gül. p. 266.

this as a condition for anti-dilution protection. However, it is widely acknowledged in case law as a requirement for protection.²⁷¹

“INTEL” ruling of CJEU²⁷², which has been discussed before in free-riding subchapter, deliberates on this notion with referral to “Adidas”²⁷³ decision of CJEU. It is deduced that in cases where the subsequent mark revokes the well-known trademark concerned in the eyes of associated customer, a link, or in other words, a connection shall be considered as established. In this ruling, Sharpston, argued that this "connection" is basically a mental state above awareness, a vague, indefinable, transient sensation, or a subconscious impact.²⁷⁴

It must be emphasized that in order to establish a link or assumption of a connection, possibility of misperception amongst conflicting signs will not be needed.²⁷⁵ Once again, US legislation clearly expresses this in the relevant provision, while it is not included in EU and Turkish legislation. Nevertheless, this is pointed out in many CJEU cases, such as *Intel* and *Adidas*. In a more recent ruling, *St. Joseph v. Jägermeister* case, EUIPO’s Board of Appeal deduced that the conflicting marks have a low level of similarity between them and that would suffice according to EUTMR Art. 8/5, which is the provision for protection of dilution and refers to *Coffee Rocks v. Starbucks*²⁷⁶ case, recording that this degree of similarity may be deemed enough in the assumption of a connection based on the Article in question, depending to level of acknowledgement of previous mark.²⁷⁷ Consequently, while resemblance amongst marks is one condition in protection against dilution, it is not necessarily a requirement for this similarity to be on the degree required for likelihood of confusion claim.

²⁷¹ Büyükkılıç, Gül. p. 267.

²⁷² Case C-252/07, *Intel Corporation Inc v. CPM United Kingdom Ltd*, Judgment of the Court (First Chamber) of 27 November 2008.

²⁷³ Case C-408/01 *Adidas-Salomon and Adidas Benelux*.

²⁷⁴ *Intel*, para. 46.

²⁷⁵ *Adidas*, para. 27.

²⁷⁶ T-398/16, *Coffee Rocks v. Starbucks Coffee*, 16/01/2018.

²⁷⁷ R 1952/2022-1, *ST. JOSEPH v. Jägermeister*, 20/06/2023.

Connection requirement in terms of dilution is also referred on Turkish case law, however it is not as extensive as it is on EU case law. It can be said that the concept of link within the context of dilution and the association within the context of likelihood are not exactly defined separately which may result in some conceptual confusion in practice. As a matter of fact, on “*DERBY*” case Turkish High Court concluded that the positive image of the well-known “Derby” trademark in razor blades would not be damaged by the subsequent “Derbytech” trademark application. Because the trademark in question is used in industrial and industrial tools and machines, the condition for “connection” between the prior mark and subsequent mark would not be met due to the fact that the products of the conflicting marks are quite distant from each other, thus the reputation of the “Derby” trademark would not be damaged, and dilution would not occur in this case.²⁷⁸ While this ruling is important as it clearly showcased association as a requirement for anti-dilution protection, it only explains this association based on similarity between products and services that marks are used in. Similarity evaluation amongst products of conflicting signs for establishing a link has also been used on “*Intel*” ruling of CJEU and “*Focus*” decision of EUIPO.²⁷⁹ I believe that this principle adopted for determination of a link may be contradictory in well-known mark production in dissimilar products since this may limit the scope of protection against dilution in practice, even though it is explicitly regulated it would include different products or services.

Distinctiveness of prior trademark is also a criterion used by the Courts in determining the connection between the marks. This is no surprise as the more distinctive a mark is, it would be much more possible for it to be recalled by the consumer when encountered with the latter mark.²⁸⁰ Therefore, creation of a link would be more likely for a distinctive trademark in terms of dilution and it may

²⁷⁸ Turkish High Court General Civil Assembly, No. 2013/11-656 - 2014/427, 02/04/2014.

²⁷⁹ EUIPO, Decision of 27 January 2009, R 1497/2007-4, *Focus / Focus et al.* para. 30-32.

²⁸⁰ *Intel*, para. 54.

affect the evaluation of other criteria used in determining the association as well, such as level of similarity between the marks.

4.3. Earlier Mark Being Registered or Applied for Registration

The protection against dilution is only granted to marks which had been registered or applied for registration at the opposition stage, and only to the registered trademarks at the time of violation.²⁸¹ It is the norm in trademark law that protection shall be granted to registered trademarks.²⁸² This principle's legal basis is EUTMD Article 1 and IPC Article 7/1 for Turkish law.

The motive behind enabling the trademarks which have been applied for registration to be subject to anti-dilution protection lies within the reasoning that the trademark may have started to be used and even become well-known already, but the registration process is delayed for some reason. This is specially the case for the marks that are registered abroad. Therefore, it is necessary to be able to report a conflict grounded on dilution to subsequent registration application even if the previous trademark is at the registration application stage in order to avoid any loss of rights.²⁸³

While the main principle is that protection begins with the registration, there are of course exceptions to this, such as protecting unregistered well-known trademarks in Paris Convention's scope and IPC Article 6/4. However, this does not cover anti-dilution protection. This approach and limitation of scope of protection in a way that would only include registered marks have faced some criticism.²⁸⁴ Nevertheless, it can be said that it has been reasonable to limit the protection to registered marks due to the uncertain nature of the scope and limits of the protection against dilution. Turkish High Court also states this explicitly on

²⁸¹ Büyükkılıç, Gül. p. 329.

²⁸² Tekinalp, Ünal. *Fikri Mülkiyet Hukuku*, p. 381.

²⁸³ Büyükkılıç, Gül. p. 329.

²⁸⁴ Gruson, Sebastian. *Die Verwässerungsschutzwürdige Marke*. Stämpfli, 2013, p. 6-7.

“NATURLAND” decision, deducing in order for the plaintiff to claim invalidity based on the registered trademark right and the claim of being a mark with a reputation, the registration registered in its name in the trademark registration must exist until the conclusion of the lawsuit.²⁸⁵

4.4. Trademark Use

A common principle in Turkish, EU, and US law is that it is required for signs being used as “mark” for them to be protected against dilution. However, if one examines the legislation, it would be seen that while the earlier sign must be a trademark, it is seen that such an obligation is not explicitly required for the later sign, and this brings forward the subject if trademark use on latter sign is compulsory in anti-dilution protection.²⁸⁶

Trademark use or using the sign as a mark can be described as using the trademark as a sign for specifying source or funding of its commodities and services.²⁸⁷ Tekinalp also followed a similar approach, expressing that this notion refers to using trademark that allows commodities or services to be distinguished by their source.²⁸⁸ However, this approach is criticized by scholars considering that nowadays, other functions of the trademark have become at least as important as origin indication function.²⁸⁹ CJEU also acknowledged this stating that other purposes of trademarks, for example investment, communication, advertising are also within scope of protection.²⁹⁰

There have been different opinions and arguments on whether trademark use of later mark is absolutely necessary on dilution lawsuits. In US law, while some

²⁸⁵ Yasaman, Hamdi. *Sınai Mülkiyet Kanunu Şerhi II md. 6-9*. p. 1062.

²⁸⁶ Büyükkılıç, Gül. p. 333.

²⁸⁷ Dogan, Stacey and Lemley, Mark. “Grounding Trademark Law Through Trademark Use.” *92 Iowa Law Review*, 2007, supra note 1, at 1670; Barrett, Margreth. “Internet Trademark Suits and the Demise of “Trademark Use.” *UC Davis Law Review*, Vol. 39, No. 2, 2006, p. 386.

²⁸⁸ Tekinalp, Ünal. *Fikri Mülkiyet Hukuku*, p. 433-434.

²⁸⁹ Büyükkılıç, Gül. p. 354.

²⁹⁰ C-487/07, *L’Oréal v Bellure*, para. 58.

scholars argued that there is no requirement based on unclarity on legislation, such as FTDA and TDRA;²⁹¹ on *Tiffany* case Court of Appeals deduced that the existence of trademark use is an obligation to confer protection against dilution.²⁹² Similarly in EU, it can be seen that while on some cases the Court has held that trademark use is not necessary, on some other cases it has taken the opposite approach.²⁹³

In Turkish legislation, just like its EU counterpart, it can be seen that the provision which regulate protection against dilution ²⁹⁴ stipulated that the subsequent use may be occur by means of any sign. However, there is no clarity on if such usage of sign should be “*trademark use*”. There are many opposing views on this matter on Turkish doctrine²⁹⁵. Essentially, Tekinalp concluded in the event trademark use is acknowledged as a requirement, since using a subsequent sign as part of a trade name, business name or domain name would not constitute as trademark use, trademark protection would be insufficient and incomplete especially in case of domain names. However, it is widely recognized that trademark use is a requirement on dilution claims. Turkish High Court also tends to seek out trademark use on all types of trademark infringement cases.²⁹⁶

In order to gain some clarence, it may be a solution to explicitly regulate whether trademark use is an obligation within IPC Art. 7/2/c protection context. Regarding concerns which may occur due to these restrictions, it may be reasonable to interpret the scope of trademark use more broadly, such as also including the trademark's communication, investment, and advertising functions in the scope of evaluation.²⁹⁷

²⁹¹ Fhima, Simon. *Trade Mark Dilution*. p. 245

²⁹² *Tiffany (NJ) Inc and Tiffany and Company v eBay Inc.*, 600 F.3d 93, 111.

²⁹³ On Case C-17/06, *Céline SARL v Céline SA*, the sign being used in the course of trade and some kind of connection between the sign and the goods or services being established in the eyes of consumer have been considered enough.

²⁹⁴ IPC Article 7/2/c.

²⁹⁵ Tekinalp, Ünal. *Fikri Mülkiyet Hukuku*, p. 433-434.

²⁹⁶ See. Turkish High Court, 11th Civil Chamber, No. 2020/2187 - 2021/2143; Turkish High Court, 11th Civil Chamber, No. 2014/12037 - 2014/19704. Turkish High Court, 11th Civil Chamber, 2013/16785 - 2014/6143.

²⁹⁷ Arkan, Sabih. “Marka Hakkına Tecavüz - İşaretin Markasal Olarak Kullanılması Zorunluluğu?” *Banka ve Ticaret Hukuku Dergisi*, Vol. 20, n.3, 2000, p. 11.

4.5. Use Without Due Cause

Although the conditions of reputation, association, registration, and trademark use are deemed enough for the mark to be protected against trademark dilution, it is also necessary for the dilutive use occurring “without due cause”. This term is used both in EU and Turkish trademark legislation in the provision regulating dilution, although it has only been introduced with IPC in Türkiye and it was not included in the previous legislation, such as Decree Law 556.

Even if a duplicate or resembling sign to well-known mark is used on commodities and services related to commodities and services for that well-known mark is registered, if there is a "due cause", well-known trademark holder must tolerate this use. Accordingly, this is the case even if the use in question would normally be considered as dilutive. Therefore, for the usage being without due cause is also an obligation on anti-dilution protection covering well-known marks. Due cause concept and other exceptions which limits the scope of protection will be explained in detail below.

5. DEFENSES AND EXCEPTIONS TO PROTECTION OF TRADEMARKS AGAINST DILUTION

5.1. Overview

It must be addressed that it is possible at the same for the trademarks, specifically well-known trademarks being protected by law against infringing usage, but also for them to be used by third parties in such a manner which may normally be considered as infringement or dilution. Specifically, the abstract nature of the dilution concept taken into account, it would be no surprise that it may cause conflict of interest in many cases.²⁹⁸ Considering the balance which

²⁹⁸ Büyükkılıç, Gül. p. 579.

needs to be preserved between the rights of well-known marks owners with third parties, dilution concept gave birth to its own exclusive defenses.

There are several exceptions on well-known trademark protection and its extent. Some legal defenses may be put forward against trademark infringement claim, however due to the nature of dilution not all of those defenses may be put forward against trademark dilution claims as well. In this part, only the main defenses which may be used against dilution claims, such as due cause, based on the regulations in EU, the US and Türkiye shall be examined.

5.2. Exceptions Within the Context of Article 7 of Intellectual Property Code

As it has been previously explained, Article 7 of IPC regulates the acts which can be considered as infringing use and the scope of rights based on the trademark protection in general that is granted within the context of this Code. However, this Article also limits the extent of protection which is granted to the registered trademarks in this Code. Article 7/5 sets out three cases where mark proprietor cannot prohibit such use based on their rights which came with the registration of their mark, provided that such use is “honest” and during trade.²⁹⁹ Although this provision was also included in the Decree Law 556 as well, it is stated in the justification of this Article that the previous provision lacked clarity due to its phrasing.³⁰⁰ This Article corresponds to Article 14 of EU Directive and Article 12 of EU Regulation thus making it in compliance with EU trademark law.

It is provided that under any manner, right owner will not have an opportunity to prevent third parties from:

(i) Using their name, surname, and address, provided the third party is a natural person.

²⁹⁹ Arkan, Sabih. *Marka Hukuku*. Vol. II, p. 132.

³⁰⁰ Tekinalp, Ünal; Çamoğlu, Ersin. *Sınai Mülkiyet Kanunu*. Vedat Kitapçılık, 2017. p. 26-27.

(ii) Using the sign which describe commodities or services' category, quality, amount, envisioned usage, worth, geographical source, time of production, delivery, or further features.

(iii) Using such sign on merchandises or when essential in identifying planned purpose to that service especially on cases like accessories, replacement parts or equivalent parts.³⁰¹

To specify an example for the second provision, it can be said that the right owner of the "Lux" trademark cannot prevent third parties from using "lux" or "luxurious" to portray quality of products or services they provide.³⁰²

What must be noted is that these circumstances apply to all trademarks provided that the conditions presumed on the provision are fulfilled, and not specific to well-known marks. Unlike US, there is no specific provision which specifies legal defenses which may be used against trademark dilution claim in Türkiye or EU. However, the provisions which regulate and describe dilution explicitly states that the well-known mark owner may only enjoy certain perks to anti-dilution protection unless there is a "due cause".

5.3. Concept of Due Cause Within the Context of European Union and Turkish Law

Concept of due cause with regards to trademark law in its essence may be described as a legal defense which the defendant may put forward as a justification for using former trademark that may otherwise either bring forth harm to distinctiveness, reputation or take unjust advantage of the former mark which has a repute.

³⁰¹ IPC, Article 7/5.

³⁰² Arkan, Sabih. *Marka Hukuku*. Vol. II, p. 132.; Tekinalp, Ünal. "Markanın Üçüncü Kişi Tarafından Kullanılması." *Prof. Dr. O. İmregün'e Armağan*, 1998, p.633-634.

This notion as a legal concept is included in EU legislation and it was regulated in Regulation Art. 8/5 and Directive Art. 9/2/c, Art. 5/3/a and Art. 10/2/c which are also the provisions regarding dilution of well-known marks. Yet, on Turkish trademark law counterpart, this defense was not explicitly regulated in the Decree 556 and thus it was not in compliance with the legislation in EU. Therefore, one of the significant novelties which was regulated with the new Turkish Industrial Property Code in my opinion is the fact that “due cause” has been explicitly stated in the relevant provision, consequently helping in ensuring the harmonization with EU trademark legislation which was one of the aims of the new Code. Due cause is regulated in Turkish Industrial Property Code Art. 6(5) and similar to its EU counterpart, this provision is also the main provision with regarding dilution of well-known marks.

As stated above, “due cause” in principle is a defense which may be used in opposition, and in our case, it may be used against the trademark dilution claim. Although it must be noted that none of the articles provided above explicitly states that the due cause which is stated in the provision refers to the “defense” the way it is interpreted as a legal term in Turkish doctrine.³⁰³ It may be argued that within this context, it would be possible for the judge freely exercise discretionary power over conflicts where “due cause” is claimed as a legal defense.³⁰⁴ Due to this, some scholars disputed that due cause or justified reasons within the context of IPC Art. 6/5 is already one of the main principles of law, and therefore it is not quite clear whether this circumstance must be necessarily specified within the provision.³⁰⁵ Regardless, it will still be referred as a defense in this thesis with regards to the terminology used in EU doctrine.

³⁰³ Büyükkılıç, Gül. p. 585.

³⁰⁴ Turkish Civil Code, Article 4:

“III. Judge’s discretion

The judge decides in accordance with the law and equity in matters that the law gives discretionary power or orders to consider the requirements of the situation or justified reasons.” Within the context of this Article, “due cause” may also refer to “justified reasons” provided in the provision.

³⁰⁵ Çağlar, Hayrettin. “Sınai Mülkiyet Kanununun Marka Hukuku Alanında Getirdiği Önemli Yenilikler.” *Başkent Üniversitesi Hukuk Fakültesi Dergisi*, Vol. 3, No. 1, 2017, p. 145.

It is important to emphasize that just as the plaintiff must prove the existence of actual dilution or risk of dilution, the defendant must also prove the existence of the due cause in case this legal defense is put forward. This principle is with regards to the “*qui affirmat incumbit probatio*” rule, which may be roughly translated to “the one who claims must prove”.³⁰⁶

The case law evidently applies this principle with regards to the due cause, such as *Jackson International v OHMI - Royal Shakespeare*³⁰⁷ and *Intel Corporation Inc. v CPM United Kingdom Ltd.*³⁰⁸ rulings, which deduced that in case that holder of the prior mark shows evidence on that there is an actual harm by detriment to the distinctiveness, to repute or free riding, or that there is high risk of such injury occurring. Nonetheless, the subsequent disputed trademark’s holder will have to demonstrate evidence that usage in question was with due cause. The holder of the prior mark with a repute does not have to show evidence on use by conflicting mark’s holder was without due cause.³⁰⁹ This notion naturally results in that in case it has been demonstrated that there is an actual or high risk of injury to the earlier mark with a repute, it shall be presumed that the use in question was made without due cause, until proven otherwise.³¹⁰

Meaning of “due cause” within the context of legislation on dilution in EU and Türkiye is not completely and undoubtedly clear.³¹¹ This may lead to the argument that there is no necessity to find “due cause” just within the context of legislation referring to trademark law, thus it may be found on other branches of law.³¹² This gap on defining what due cause refers to has been somewhat filled with case law as some examples will be provided below.

³⁰⁶ 01/03/2004, R 145/2003-2, *T CARD OLYMPICS v. OLYMPIC*, § 23.

³⁰⁷ T-60/10 - *Jackson International v OHMI - Royal Shakespeare* 06/07/2012, EU: T:2012:348, § 67.

³⁰⁸ Case C-252/07, *Intel Corporation Inc v. CPM United Kingdom Ltd*, [2009] E.T.M.R.13.

³⁰⁹ EUIPO Guidelines on Trade Marks with Reputation, para 3.5.

³¹⁰ T-369/10 - *You-Q v OHMI - Apple Corps (BEATLE)* 29/03/2012, EU: T:2012:177, § 76.

³¹¹ Çolak, Uğur. *Marka Hukuku*. p. 331.

³¹² Cataldo, Vincenzo. “The Trade Mark with a Reputation in EU Law - Some Remarks on the Negative Condition “Without Due Cause.”” *IIC; international review of industrial property and copyright law journal*, Vol. 42, 2011, p. 837.

CJEU's *Interflora v. Marks & Spencer* ruling is an interesting case on what type of use can be considered as a due cause.³¹³ CJEU states that in the event of advertising on the internet by using keywords (in this case, *Google AdWords*) that are the same as the well-known mark; if this use is without imitating the goods or services, damaging the reputation or affecting distinctive power of that mark and in case it is not damaging the other functions of the trademark, it can be said that this would be a fair competition with regards to the goods and services in question. Therefore, it can be concluded that this use would not be considered as "without due cause".³¹⁴

EUIPO Guidelines provide several examples on the cases where the due cause defense was accepted. In *MARTINI fratelli v. MARTINI*³¹⁵ conflict, the Board has acknowledged the due cause defense of the applicant for two reasons. Firstly, the applicant company's founder's last name is also "Martini". Second of all, the parties signed a "co-existence agreement" in 1990. The existence of these two conditions together was deemed enough in this case.³¹⁶

However, it is not enough that the conflicting identical or similar mark includes the applicant's first or family name for it to be considered as a due cause in every instance. In *Kenzo Tsujimoto v KENZO*³¹⁷ case, the appellant argued that the use of their forename "Kenzo" as a component of their mark "KENZO ESTATE", would constitute due cause. Nevertheless, the Court ruled that considering the extended protection granted to the marks with a reputation and weighing the interests of the parties involved, this use could not be able to be considered as due cause merely based on to the fact the mark is the appellant's forename.

³¹³ CJEU Case C-323/09, *Interflora Inc., Interflora British Unit v Marks & Spencer plc, Flowers Direct Online Ltd.* dated 22/10/2011.

³¹⁴ Bailey, Andrew. "Trade Mark Functions And Protection For Marks With A Reputation." *Journal of Intellectual Property Law & Practice*, Vol. 8, 2013. p. 874.; Oğuz, Arzu. "Yargı Kararları Işığında Tanınmış Marka İtirazında Haklı Sebep Kavramı." *İnönü Üniversitesi Hukuk Fakültesi Dergisi*, Vol.9/1, 2018, p. 433.

³¹⁵ 30/07/2007, R 1244/2006-1, *MARTINI fratelli (fig.) / MARTINI*.

³¹⁶ EUIPO Guidelines on Trade Marks with Reputation, para 3.5.1.1.

³¹⁷ *Kenzo Tsujimoto v Kenzo*, Joined Cases of C-85/16 P and C-86/16 P, JUDGMENT OF THE COURT (Tenth Chamber), 30 May 2018.

There is a case where freedom of artistic or political expression and parodying use have also been recognized as due cause within the context of EUTMR 10/2(c) by the national court of Germany which bring the “fair use” concept in mind, it will be examined in detail later. Although this type of defense in scope of due cause is not something that often occurs and accepted in CJEU or Turkish case law, in case of “*Lila Postkarte*”, Milka’s famous purple shade, its renowned mountain & cow imagery have been used in the defendant’s products, including a sarcastic poem parodying Milka. German Court acknowledged that usage as “trademark use”. However, it also accepted the defense that it is an artistic expression and therefore can be considered as use with a due cause.³¹⁸

In conclusion, it would be fair to say that initial aim of the due cause concept is not just limiting the scope of rights granted to trademark’s holder. On the contrary, it would be rather serving establishing a balance between the interests in question and ensuring fair competition purpose.³¹⁹ Considering the nature of the notion, it is a natural outcome that due cause shall be considered case-by-case as it is an abstract concept.

5.4 Exceptions Specifically Regulated for Trademark Dilution

5.4.1. Fair Use

Meanwhile, the situation in the US regarding the implementation of the exception defense with regards to non-authorized using of famous trademark, and terminology is slightly different in comparison with EU and Türkiye. First of all, the wording and terminology are completely different in the US regulations. Instead of “due cause”, *fair use* term is used in the relevant provisions and US trademark doctrine, however this term does not exactly cover it, but rather it can

³¹⁸ Yasaman, Hamdi. *Sınai Mülkiyet Kanunu Şerhi II md. 6-9*. p. 1668.; Senftleben, Martin. “Keyword Advertising in Europe - How the Internet Challengers Recent Expansions of EU Trademark Protection.” *Connecticut Journal of International Law*, Vol. 2012, No. 27, 2012, p. 50.

³¹⁹ Oğuz, Arzu. p. 433.; Çolak, Uğur. *Türk Marka Hukuku*. p. 331.

be considered as a ground. Fair use exemption regarding using of famous marks is regulated in Revision Act, under “Exclusions” (§ 43/c-3).³²⁰

Due cause, or fair use in this case is not simply just referred as the way it is in EU and Turkish legislation. Instead, the legal defenses which may be put forward against trademark dilution claim have been comprehensively regulated in a separate provision and fair use exception is simply one of these defenses. However, it must be noted that, due to the fact that “taking unfair advantage of” or in other words free riding is not included in the provisions related to dilution under the US trademark law, the defenses regulated including fair use shall apply to blurring and tarnishment only.

According to relevant provisions in Revision Act, any form of fair use, including “nominative” and “descriptive” uses by a third party excluding as a designation of source for the person’s own goods or services will not be actionable as dilution by blurring or tarnishment. The same article provides a list of exemplary uses which may be considered as fair use; however, this list is not exhaustive. The first example for fair use is stated as “*advertising or promotion that permits consumers to compare goods or services*”, which refers to the concept of comparative advertising.

The second example and which may be considered as a tricky one is “*identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner*”, which is also closely related to freedom of speech. These two cases will be explained in more detail below in their subsection.

5.4.1.1.Nominative Fair Use

³²⁰ Trademark Dilution Revision Act of 2006. Public Law 109–312 109th Congress an Act To amend the Trademark Act of 1946 with respect to dilution by blurring or tarnishment.

The first notion which will be briefly explained as a form of fair use is nominative fair use. This category refers to using of trademark by third parties for identifying/representing commodities and services which belongs to proprietor of the protected trademark. "*New Kids on the Block v. News Am. Publ'g, Inc.*" case explores this notion within Lanham Act. Court states there are three conditions which must be met in order to consider a nominative use as a fair use:

- (i) The goods and services must not be readily describable without using the protected trademark.
- (ii) The trademark may only be used to a degree which would be relatively crucial for recognizing products and services.
- (iii) The user must not do anything in conjunction with the trademark as to indicate endorsement by the proprietor of the protected trademark.³²¹

These standards which have been put forward by The Ninth Circuit have been adopted in other cases as well. These requirements are referred as the nominative use test.³²² It must be noted that some scholars also added a fourth requirement to this list, reasoning that the trademark must not be used in a degrading and humiliating way, exceeding the limits of criticism.³²³

5.4.1.2. Descriptive Fair Use

Another type which is acknowledged is descriptive fair use. The main difference between the nominative fair use and descriptive main use is that this time the aim in protected trademark's use by third parties is identifying or representing goods and services which belonging third parties, instead of

³²¹ *New Kids on the Block v. News America Pub., Inc.*, 745 F. Supp. 1540 (C.D. Cal. 1990) - 745 F. Supp. 1540, September 7, 1990.

³²² Westberg, Derek J. "Intellectual Property Law - *New Kids on the Block v. News America Publishing, Inc.*: New Nominative Use Defense Increases the Likelihood of Confusion Surrounding the Fair Use Defense to Trademark Infringement." *Golden Gate University Law Review*, Vol. 24/8, 1994, p.698.

³²³ Fhima, Ilanah Simon. p. 226.; Büyükkılıç, Gül. p. 601.

protected trademark's holder. In order to use this defense, the mark must be used in a descriptive manner in the commodities and services that later trademark is used for.

*"Zatarains, Inc. v. Oak Grove Smokehouse, Inc."*³²⁴ case is a great example of a descriptive fair use defense. US Appeal Court stated this defense may only be applied in cases the descriptive terms are used in a descriptive manner, instead of as a trademark in its ruling. Therefore, this defense prevents a protectable descriptive mark's owner to obtain exclusive privilege for using a descriptive term in its primary meaning and restraining others from using it, provided such use does not result with consumer misperception to origin/source of commodities and services.³²⁵

In conclusion, there are two matters which must be factored in when evaluating descriptive fair use defense based on the Court decisions. First one is for the descriptive mark to be actually used in a descriptive manner, and not in a trademark sense. On *"Venetianaire Corp. of America v. A & P Import CO."*³²⁶ case, the defendant's descriptive fair use defense was not accepted due to the use of the mark in a trademark sense.³²⁷ Second and another matter which must be considered is that there is no likelihood of confusion as to the source of the goods and services the mark is used in due to such use in a descriptive manner.

5.4.1.3. Advertising or Promotion That Permits Consumers to Compare Goods or Services

Trademark Dilution Revision Act, as stated above, provides a list which includes examples of fair use in the "Exclusions" provision. One of them is as the

³²⁴ *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786 (5th Cir. 1983).

³²⁵ *Zatarains*, 698 F.2d at 791.

³²⁶ *Venetianaire Corporation of America v. a & P IMPORT CO.*, 302 F. Supp. 156 (S.D.N.Y. 1969).

³²⁷ Westberg, Derek J. "Intellectual Property Law - New Kids on the Block v. News America Publishing, Inc.: New Nominative Use Defense Increases the Likelihood of Confusion Surrounding the Fair Use Defense to Trademark Infringement." *Golden Gate University Law Review*, Vol. 24/8, 1994, p.695.

way it was worded in the article is advertising or promotion which enables consumers to compare commodities and services, which refers to comparative advertising notion.

Trick issue to be considered here is that using of protected trademark within comparative advertising should be in an honest manner. In order to make issue of what this refers to in use of the mark in comparative advertising clear, "*Deere & Co. v. MTD Products, Inc.*"³²⁸ decision must be evaluated. In this case, comparative commercial included the plaintiff Deere's logo, which is a leaping deer. However, the defendant used the logo of the famous mark in an altered form. The Court deduced that while not all alterations shall cause trademark dilution, some alterations, including satiric alterations, are considered to have the power to lessen the selling power of a distinctive trademark.³²⁹ It is also important expressing that content of such comparative advertising must not include disinformation intentionally, especially in case of ill intent, it will not be possible to depend on fair use defense.

While there is no specific regulation for this exception in the provisions which regulates trademark dilution and due cause in EU and Türkiye law, EU Directive of Comparative Advertising (CAD)³³⁰ sets out the specifics which must be met in a comparative advert. Article 4 of the Directive lists several conditions for comparative advertising to be permitted, such as not being misleading, not discrediting the trademarks etc. CJEU ruled that in cases comparative advertising have been permitted under conditions stated within this Directive, it shall also mean that the use of such comparative advertising may also be considered as fair use in "*O2 Holdings Limited and O2 (UK) Limited v Hutchison 3G UK Limited*"³³¹

³²⁸ *Deere & Co. v. MTD Products, Inc., U.S.*, District Court for the Southern District of New York - 860 F. Supp. 113 (S.D.N.Y. 1994), August 11, 1994.

³²⁹ 41 F.3d at 45.

³³⁰ Directive 2006/114/EC of the European Parliament and of the Council of 12 December 2006 concerning misleading and comparative advertising.

³³¹ C-533/06 - *O2 Holdings Limited and O2 (UK) Limited v Hutchison 3G UK Limited*, Judgment of the Court (First Chamber) of 12 June 2008.

decision. However, this does not mean that the reverse is automatically acknowledged as well. The fact that a comparative advertising was not permitted due to it not complying with the requirements stated in Article 4 will not mean that such use will cause trademark dilution, as it is a matter which must be assessed independently.³³²

5.4.1.4. Identifying and Parodying, Criticizing, or Commenting upon the Famous Mark Owner or the Goods or Services of the Famous Mark Owner

Another one of the examples for which is stated in the Act for fair use is “*identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner*”. This type of use aims to criticize, comment on, or convey a message through parody or a humorous way. The concept of parody may actually include commentary and criticism as well; therefore, it is important to understand the notion well in order to apply fair use defense.

In “*L.L. Bean, Inc. v. Drake Publishers, Inc.*”³³³ case, US Appeals Court, First Circuit describes parody as “humorous social commentary” and “literary criticism” type which goes back to ancient Greek. Not only that, but it is also a type of artistic expression which the copyright protection may be applied, provided other conditions are met.³³⁴ The important aspect of this use is to find balance amongst the privileges granted to protected mark with interests of the later user regarding freedom of speech.³³⁵

In “*Louis Vuitton Malletier S.A. v. Haute Diggity Dog*”³³⁶ case, plaintiff Louis Vuitton, which is a famous and globally known mark has claimed that the use of its mark, famous design, and patterns by the defendant Haute Diggity causes

³³² C-533/06 - *O2 Holdings Limited and O2 (UK) Limited v Hutchison 3G UK Limited*, para.69.

³³³ *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 28 (1st Cir. 1987).

³³⁴ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

³³⁵ Büyükkılıç, Gül. p. 612.

³³⁶ *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (2007), Nov. 13, 2007.

trademark dilution, trademark infringement and copyright infringement. The defendant launched a new dog toy product called “Chewy Vuitton”, which imitated the famous mark in shape, color, and design as well, in addition to the name of the brand. The Court applied the PETA criteria³³⁷ in establishing whether the fair use defense based on parody may be accepted here. The Court expresses that while no one can deny that Louis Vuitton handbags are the imitation target for Chewy Vuitton dog toy product, it is also a fact that the aim here is not to convey the “idealized image” created by the plaintiff. It is apparent that the product does not belong to Louis Vuitton brand, and rather a clever satire.

Another successfully accepted, important and rather recent parody defense, ironically enough, is a case featuring Louis Vuitton brand again. “*Louis Vuitton v. My Other Bag*” case features a dispute of a famous mark and a less significant mark, however, regarding similar goods and services this time. As it is known, Louis Vuitton is a luxury brand specifically famous for their handbags, which use a very specific repeating pattern of L & V letters and flower pedals.

The defendant My Other Bag also promotes handbags and some of them undoubtedly resemble the products of Louis Vuitton, in terms of design. The only difference is that this brand uses its own initial or name, instead of L & W letters. The intent of humorous imitation is also acknowledged by the mark itself, as they promote these bags by stating they use the high-end loved brands in a humorous way. At the same time, even “My Other Bag” phrase is a proof that the product does not intent to present its product as a Louis Vuitton product. In conclusion, the Second Circuit established that defendant’s use falls under exclusion of fair use, also referring to PETA criteria.³³⁸

³³⁷ See. *People for the Ethical Treatment of Animals v. Doughney* (“PETA”), 263 F.3d 359, 366 (4th Cir.2001). The Court provides two criteria for parody: “A parody must convey two simultaneous — and contradictory — messages: that it is the original, but also that it is not the original and is instead a parody.”

³³⁸ *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 18-293-cv (2d Cir. Mar. 15, 2019).

However, it is important to specify fair use defense under parody cannot be applied to demeaning, insulting or humiliating uses. Another situation where the fair use defense may not apply is when the use exceeds the purposes of parodying the mark and causing risk of confusion or dilution by going beyond what was necessary in achieving its goals.³³⁹

Meanwhile, unlike the US, parody, criticism, or commentary are not regulated under any provisions in EU and Turkish trademark legislation. As for the EU counterpart, the credit must be given as freedom of speech is mostly prioritized in comparison to the interests of holder of the trademarks. Therefore, the context in these disputes, if there are any, is based on the constitutional right of freedom of speech. As for Türkiye however, unfortunately, this matter is not evaluated the same way it is in EU or the US, as stated before. There is no regulation regarding to parody, commentary, or criticism of the protected trademark and most of the cases are related to the criticism of the trademarks rather than parody.³⁴⁰

It can be said that The Supreme Court in Türkiye recognizes the right to criticize as well, excluding the insulting uses, however there is still a gap regarding use of the marks as a parody. Although there are a few instances where the Court accepted parody defense with regards to copyright claims,³⁴¹ there is not a single case which acknowledged parody exemption to dilution of well-known marks in Turkish case law. I believe that securing these rights, parody, commentary, and criticism in a legal ground, granting it a specific provision will fill any legal gaps which may occur and advance the rights related to trademark law as well while harmonizing the legislation in a global sense.

5.4.2. All Forms of News Reporting and News Commentary

³³⁹ Dogan, Stacey and Lemley, Mark. "Parody as Brand." 47 *U.C. Davis Law Review*, 473, 2013, p. 510.

³⁴⁰ Büyükkılıç, Gül. p. 618.

³⁴¹ Turkish Hight Court, 11th Chamber, No. 2020/5318 - 2021/3809, d. 19.04.2021.

Using a protected trademark in a news reporting or commentary manner is a specific legal defense which has been regulated in Trademark Dilution Revision Act. This type of use is only secured in an Article under US trademark law, and it can be confidently said that the scope of this defense is wide, considering the wording which specifically states that the provision shall be applied to “all forms” of this use.

*Bidzirk, LLC v. Smith*³⁴² demonstrates the scope of this provision in a way, as to what is included in “any form” of news reporting/commentary. Court concluded defendant was entitled to news commentary or news reporting defense, considering the defendant is publishing a website called “*www.jackwhispers.blogspot.com*” and used the plaintiff’s mark in that blog. As it can be clearly seen from this decision, this legal defense may be applied to any type of media and any form of commentary.

This type of legal defense is not regulated under either EU or Turkish trademark law. As for EU, similar to the situation in parody, usually constitutional right of freedom of speech is prioritized thus not deeming this type of defense to be regulated necessary in a sense. As for Türkiye, while there is no regulation regarding the matter, there is also no case which this defense is referred clearly.³⁴³

5.4.3. Any Noncommercial Use of Mark

Parallel to news reporting or commentary exclusion, noncommercial use of a mark defense has been regulated within Trademark Dilution Revision Act. The wording preferred in this Article, which is “any”, has been added with this Act and it can be said that it increased the scope of the defense in the context of this provision. The Senate expresses clearly that this exemption aims to acknowledge that use of the trademarks in specific forms of artistic and expressive speech shall

³⁴² *Bidzirk, LLC v. Smith*, United States District Court, D. South Carolina, Greenville Division, Civil Action No. 6:06-0109-HMH-WMC (D.S.C. May. 7, 2007)

³⁴³ Büyükkılıç, Gül. p. 621.

be protected by the First Amendment.³⁴⁴ Therefore, noncommercial use referred in the Article may also overlap with other type of defenses which has been explained above and which is stated in the Article, especially with criticizing, commenting and parodying uses.

*Mattel, Inc. v. MCA Records, Inc.*³⁴⁵ may be confidently considered as an important case regarding noncommercial use and what it exactly refers to. As known globally, “Barbie” is the name one of the most famous dolls and is an iconic toy which had a great influence in public which the holder of trademark in question is the plaintiff. As for defendant, the record company represented a band called “Aqua”, which has also become incredibly famous for their track “Barbie Girl”, that is the exact subject of this dispute. The scope of noncommercial use exemption was a subject of discussion for this case. Court expressed that if such speech actually does more than just proposing a commercial transaction, in other words, if it is not “purely commercial”, the noncommercial use exemption may be applied.³⁴⁶ In this case the song “Barbie Girl” while there are obvious commercial purposes, it also included a parodying and expressive use.³⁴⁷

*American Family Life Insurance v. Hagan*³⁴⁸ case also provides a similar approach to *Mattel, Inc. v. MCA Records, Inc.* regarding noncommercial use exemption. This case involved a political campaign which includes advertisements. The Court found that while advertising is commercial in its essence, it is considered as political speech thus establishing noncommercial use.³⁴⁹

³⁴⁴ 141 Cong. Rec. S19306-10, S19311 (daily ed. Dec. 29, 1995).

³⁴⁵ *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002).

³⁴⁶ “*Mattel*, 296 F.3d at 905-06, 16.” *American Family Life Ins. v. Hagan*, Case No. 1:02-CV-1791, (N.D. Ohio Oct. 25, 2002)

³⁴⁷ “Indeed, in *Mattel*, Judge Kozinski concluded that the “noncommercial use” exemption applied to the sale of the song “Barbie Girl,” despite the song’s obvious commercial purpose, because use of the otherwise protected trademark in the song had an expressive purpose as well.” *American Family Life Ins. v. Hagan*, Case No. 1:02-CV-1791, n.16 (N.D. Ohio Oct. 25, 2002)

³⁴⁸ *American Family Life Ins. v. Hagan*, Case No. 1:02-CV-1791 (N.D. Ohio Oct. 25, 2002).

³⁴⁹ Cendali, Dale M. and Schriefer, Bonnie L. “The Trademark Dilution Revision Act of 2006: A Welcome—and Needed—Change.” *Michigan Law Review*, Vol. 105, 2006, p.110.

Noncommercial use as a legal defense or as an exemption against trademark dilution is not included in the provisions regulating dilution in EU and Türkiye trademark legislation. Therefore, the notion is only briefly explained with regards to the US trademark law and case law.

CONCLUSION

Trademark law may be considered among the more dynamic areas of law which is constantly evolving due to the developments in the technology and international trade by extension. Traditional approaches to the signs which may be recognized as marks, functions of trademark, concept of well-known marks, infringement of this type of marks, and exemptions to the scope of protection are slowly shifting and adapting a more modern attitude. Turkish trademark legislation and case law, while closely following its European Union counterpart, do not necessarily demonstrate these novelties which may result in certain harmonization issues in the near future, such as adaptation of scent marks and motion marks.

It may be argued that, specifically in terms of well-known marks, a trademark's greatest function and aim is no longer simply serving as a badge of origin and further purposes including quality assurance, advertising and communication functions are equally important due to the impact and influence of these marks in the public. Well-known marks establish a brand image, a reputation through effort and investment and in some cases promotes a certain lifestyle. Well-known marks also possess distinctive character which creates an instant link or association with its goods and products they are used in. Therefore, traditional trademark infringement claims based on possibility of misperception which consider the confusion threat within some parts of the public do not cover damages done to distinct nature or reputation of that mark or such cases where a subsequent mark free rides the reputation of the well-known mark even without misperception threat. "Dilution" concept, and anti-dilution protection rose with regards to this necessity, and it flourished in the US. Even though dilution concept is recognized in both EU and Türkiye, the term is not stated explicitly in the legislations, and it is not thoroughly regulated unlike the US. For instance, while exemptions of anti-dilution protection and legal defenses which may be put forward specifically against trademark dilution claims are listed in the legislation

which consist of trademark dilution in the US, only the concept of “due cause” is referred in the provisions in the EU and Türkiye. “Due cause” was adopted with Turkish Industrial Property Code 6769, and it has been a positive step in harmonization and filling the gap regarding the matter, however as to what may constitute due cause, the provision does not really provide any information and it is unclear whether due cause actually refers to “defense” as a legal term within the context of Turkish Law. On the other hand, defenses which may only be put forward against trademark dilution claims are regulated explicitly in the US, including the concept of fair use, which includes parodying and commentary uses. The fact that these grounds are not regulated specifically is not a big concern for the practice in EU because most of this type uses does not turn into a subject of conflict, and it is protected strongly under freedom of speech as a constitutional right. However, it would be a bit too optimistic to state that these sorts of uses do not need a legal ground, or any type of special protection granted in Türkiye. Regulating the scope of due cause and granting an exclusion on parody, criticism, and commentaries taking freedom of speech into account in particular would elevate Turkish trademark law and it may prevent any conflicts which may occur due to the gaps in the current legislation, at the same assisting on bringing a global standard to the factors considered in well-known trademark infringements.

Furthermore, the conceptual ambiguity and lack of concrete assessments of dilution in Turkish case law may create a certain inconsistency between trademark rights holders and the judiciary. Particularly, the abstract co-evaluation of three different types of dilution in the Turkish High Court judgements creates uncertainty. To be more precise, in most of the decisions of the Turkish High Court 11th Civil Chamber, the conditions of obtaining an unjust advantage, damaging the trademark’s reputation, and damaging its distinctive nature, which are sub-types of dilution, are generally evaluated together, and it is clearly seen that this situation creates a deficiency in the necessity of a more concrete and separate evaluation. In addition, it also must be noted in dilution cases that it should not be a generally accepted rule that the reputation created by well-known marks automatically

provides an advantage and constitutes an unfair advantage in the use of trademarks in different products. There should be a clearer structure for protection regarding well-known marks, as each circumstance must be assessed separately and concretely, and the actual existence or possibility of dilution must be proved.

In conclusion, there is a need to establish a clear and concrete assessment guideline for the determination and exemptions of dilution in Turkish case law. A separate, independent examination of each dilution element and a more concrete legal framework may help to create a fairer and more consistent approach for trademark owners and the courts. This may contribute to reducing the uncertainties on dilution and provide a clearer roadmap in trademark law.

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