

INVALIDITY OF GEOGRAPHICAL INDICATIONS UNDER TURKISH LAW*

Türk Hukukunda Coğrafi İşaretlerin Hükümsüzlüğü

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ABSTRACT

With the entry into force of the Industrial Property Code no. 6769 in 2017 (IPC), the Decree Law No. 555 on the Protection of Geographical Indications was repealed. Geographical indications are regulated between the articles 33-54 of IPC. These regulations are prepared under the effect of the international regulations such as the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) and the EU Regulation No 1151/2012 on Quality Schemes for Agricultural Products and Foodstuffs. In the presence of certain conditions, the invalidity, which is explained as the legal protection provided by this Code for the registered geographical sign shall be deemed not to have arisen, is regulated in the art. 50 and 51 of IPC. In this article, invalidity request, grounds for invalidity and effects of invalidity on geographical indications will be explained under Turkish law with the light of court decisions and aforementioned international regulations about geographical indications.

Key Words: Geographical Indications, Appellation of Origin, Designation of Origin, Invalidity.

ÖZET

2017'de 6769 sayılı Sınai Mülkiyet Kanunu'nun (SMK) yürürlüğe girmesiyle Coğrafi İşaretlerin Korunması Hakkındaki 555 sayılı Kanun Hükmünde Kararname yürürlükten kaldırılmıştır. Coğrafi işaretler bu Kanun'un 33 ila 54. maddelerinde düzenlenmiştir. Söz konusu hükümlerin hazırlanmasında Ticaretle Bağlantılı Fikri Mülkiyet Anlaşması (TRIPs) ile Avrupa Birliği'nin Tarım Ürünleri ve Gıda Maddelerinde Kalite Planlamasına İlişkin 1151/2012 sayılı Tüzük hükümlerinden yararlanılmıştır. Belirli koşulların varlığı halinde, tescil edilen coğrafi işarete bu Kanun ile sağlanan hukuki korumanın hiç doğmamış sayılacağı şeklinde açıklanan hükümsüzlük, SMK m. 50 ve

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51’de düzenlenmiştir. Bu çalışmada, hükümsüzlük talebi, hükümsüzlük nedenleri ve hükümsüzlüğün coğrafi işaretler üzerindeki etkileri, mahkeme kararları ve coğrafi işaretlerle ilgili yukarıda belirtilen uluslararası düzenlemeler ışığında açıklanacaktır.

Anahtar Kelimeler: Coğrafi İşaretler, Menşe Adı, Mahreç İşareti, Hükümsüzlük.

I. Invalidity Request

According to art. 50.1 of Industrial Property Code no. 6769 (IPC)¹, invalidity of a geographical indication may be requested from the court by people who have interest. In other words, people with an interest are eligible to be claimant of invalidity action without any restriction. On the other hand, contrary to repealed decree-law no. 555 it is clearly regulated in the IPC that legal proceeding concerning the invalidity of geographical indication shall be instituted against the person who is recorded in the register as the registrant (IPC art. 50.3). However, in such proceeding, the Turkish Patent and Trade Mark Office (PTO) shall not be addressed as a party to these proceedings. It should also be noted that invalidity action is not only a declaratory action but also an action for performance. Namely, in this action, not only is it determined that the geographical indication is invalid, but also the geographical indication whose invalidity has been decided is canceled from the registry.

The courts commissioned for legal proceedings regarding invalidity of a geographical indication shall be civil courts of intellectual and industrial property rights and criminal courts of intellectual and industrial property rights (IPC art. 156.1²). In legal proceedings to be instituted against third parties by the owner of industrial property right, competent court shall be the court where plaintiff is domiciled or where the action violating the law has taken place or where the impacts of this action are observed (IPC art. 156.3). In legal proceedings to be instituted against the owner of industrial property right by third parties, competent court is the court where the defendant is domiciled (IPC art. 156.5). In case the plaintiff does not have domicile in Turkey, competent court shall be the court where, at the instituting date of the legal proceeding, the business place of the attorney registered in registry is located, and if the record of the attorney has been deleted, competent court is the court where the headquarters of the Office is located (IPC art. 156.4, also see IPC art. 156.5).

¹ Official Journal, 10.01.2017, No. 29944 <<https://www.resmigazete.gov.tr/eskiler/2017/01/20170110-9.htm>> accessed on 12 April 2023.

² Art. 156 is one of the common provisions that is eligible to be applied for all of the industrial property rights which are regulated in IPC. Therefore unless otherwise indicated, it is possible to apply common provisions of IPC for geographical indications, see. Hayrettin Çağlar, Burçak Yıldız and Dilek İmirlioğlu, *6769 sayılı Sınai Mülkiyet Kanununa Göre Marka Vekilliği Smavına Hazırlık* (2 nd edn, Adalet 2019) 263.

It should also be emphasized that contrary to invalidity of trade marks³, designs⁴, patents⁵ and utility models⁶, a term of litigation is not regulated for an invalidity request regarding geographical indications in the IPC. In other words, there is no time limit for invalidity request regarding geographical indications in the IPC.

II. Grounds for Invalidity

A. The register is not in compliance with any one of the conditions set out in the Articles 33, 34, 35, 37 or 39 of IPC

Geographical indications are regulated between the articles 33 and 54 of IPC (in the Second Book) with Traditional Speciality Guaranteed protection. According to art. 33, food, agricultural, mining, handicraft and industrial products resulting from unification of natural and human factors, which comply with the provisions in the second book of IPC, shall be entitled to geographical indication protection provided that they are registered. Geographical indication is the sign indicating a product that has become associated with a locality, area, region or country where it originates due to an apparent characteristic, its reputation or other features (IPC art. 34.1). Accordingly, for a geographical indication, there must first be an area with defined geographical boundaries means “soil” and a “product” originating from the natural and human elements belonging to this restricted area⁷.

According to art. 34 of IPC, geographical indications are divided into two subcategory: Appellation of origin and designation of origin⁸. The names that identify products, which originate from a locality, region or in exceptional cases a country with designated geographical boundaries; that derive their all or principal characteristics from the natural or human factors exclusively attributed to this

³ See IPC art. 25.6.

⁴ See IPC art. 78.3.

⁵ See IPC art. 138.5.

⁶ See IPC art. 144.3.

⁷ Gonca İlçali, “Coğrafi İşaretlere İlişkin Temel Yenilikler ve Geleneksel Ürün Adları” [Fundamental Improves About Geographical Indications and Traditional Speciality Guaranteed] (6769 sayılı Sınai Mülkiyet Kanunu Sempozyumu 9-10 Mart 2017, Banka ve Ticaret Hukuku Araştırma Enstitüsü, 2017) 224.

⁸ For the usage of the terms geographical indications, appellation of origin and designation of origin with a comparative perspective regarding the Turkish geographical indication law see: Burçak Yıldız, “Coğrafi İşaretlere ve Coğrafi Köken Gösteren Diğer İşaretlere İlişkin Olarak Uluslararası Sözleşmelerde ve Avrupa Birliği Hukukunda Kullanılan Kavramların Kapsamı ile Bu Kavramların Hukukumuzaya Uyarlanması Sorunu” [The Scope of the Concepts Used in International Treaties and European Union Law Regarding Geographical Indications and Other Indications of Geographical Origin and the Adoption Problem of these Concepts to Turkish Law] (FMR 2007/4) 33-95.

geographical area where their production, processing and all other operations take place, are appellation of origin. Namely, if the production, processing and other operations of the product take place *completely* in the said area, the geographical indications in this situation are called *appellation of origin*. In the case of appellation of origin, products take their “*all or essential characteristics*” from the geographical area from which they originate [e.g. Bordeaux Wine, Cuban Cigar, Antep (a city in the south east of Turkey) Pistachio⁹]¹⁰.

The names identifying products, which originate from a locality, region or in exceptional cases a country with designated geographical boundaries; that is associated with this region due to an apparent characteristic, its reputation or other features; where at least one of the steps from production, processing or other operations take place within the boundaries of the designated geographical area, are designation of origin. Namely, if *at least one* of the production, processing and other operations of the product takes place in this area, the geographical signs in this situation are called *designation of origin*. In the case of designation of origin, the products take their “*distinctive -not all-quality, reputation or other characteristics*” from the geographical area they originate from [e.g. Adana (a city in the south of Turkey) Kebab, Bafra (a town in the north of Turkey) Pita].

In summary, the appellation of origins are able to be used by the producers of a certain region, while the designation of origins are eligible to be used by anyone who produces according to the method of the relevant region, regardless of whether she/he is a producer of that region or not¹¹. Also, names that are traditionally used to designate products which fulfil the conditions stated in the first paragraph of IPC art. 34.1, which are used in daily language and do not contain a geographical name may also be considered as appellation of origin or designation of origin even if those names do not include a geographical name¹².

Names that are not within above mentioned scope are not eligible to be registered as geographical indication. Nevertheless, if there are signs that are somehow registered as geographical indications, it is possible to request the invalidation of these signs. Except this, names that have become generic names of products¹³; plant species and varieties or animal breeds or other similar

⁹ Siirt (a city in the south east of Turkey) Pistachio is not eligible to be registered as geographical indication because it is one of the five types of Antep Pistachio, 11. Civil Chamber of Turkish Court of Cassation, decision no. 2018/6588 dated on 23 October 2018 (Banking and Commercial Law Journal, 2018/4) 381.

¹⁰ Ilıcalı (n 7) 224.

¹¹ Cahit Suluk, Rauf Karasu and Temel Nal, Fikri Mülkiyet Hukuku [Intellectual Property Law] (3 rd edn, Seçkin, 2019) 344.

¹² This exception was acceptable only for appellation of origin in the repealed decree-law no. 555 regarding geographical indications, Ilıcalı (n 7) 224.

¹³ e.g. Cheddar cheese, Eau de Cologne, Çağlar and others 208.

names, which may mislead the public as to the true origin of the product; names contrary to public order or general principles of morality; names that are not protected, whose duration of protection have expired or not used in their own country although having been applied by persons fulfilling the conditions set out in article 3 of IPC and names that are wholly or partially homonymic with a name that is registered or has already been filed, and which may mislead the public are subject of the invalidation request of a geographical indication (IPC art. 35.1).

In addition, it is possible to request the invalidity of the geographical indications in the absence of some of the geographical indication application documents counted in art. 37 of IPC. These documents are: Application form that contains information on the identity of the applicant and which category he is associated with concerning the persons with the right to apply within the meaning of Article 36 of IPC; in case the applying natural or legal entity is the only producer of the product, information and documents proving this case; the name of the geographical indication requested to be registered, information and documents about the eligibility of the product as an appellation of origin or as a designation of origin, the product group¹⁴ that it belongs to, and its compliance with the definition of geographical indication; description of the product; technical information and documents describing the physical, chemical, microbiological and organoleptic properties of the product, and if necessary its raw materials; information and documents clearly identifying and designating the boundaries of the geographical area; information and documents regarding the production method of the product, and if relevant, local production techniques, practices and traditions which give the product its speciality; information and documents proving the link between the characteristics, reputation or other features of the product subject to the registration within the meaning of geographical indication definition and the defined geographical area; information and documents related to the historical background of the product in the specified geographical area; information and documents explaining the control procedures in detail in accordance with the provisions of Article 49 of IPC; information explaining the use of geographical indication, and if any, the procedures on labeling and packaging; information that the application fee has been paid. In addition to these conditions, it is possible to request the invalidity of geographical indications of which applications originating from foreign countries under the conditions regulated in the art. 39 of IPC.

¹⁴ The term product group is used to obtain statistical information by classifying the products subject to geographical indication application and cannot be used to determine the scope of the right arising from registration, *ibid* 226.



B. The registration has not been made by those who have right to apply in line with the Article 36 of IPC

Producer groups; public institutions and organizations as well as Professional organizations accepted as public institutions related with the product or geographical area of the product; associations, foundations and cooperatives operating for public interest in relation to the product or authorized to protect the economic interests of their members and the relevant producer in case the product is produced only by a single producer, provided that he proves this case shall have the right to apply for registration of a geographical sign (IPC art. 36). As a result of that and as regulated in IPC art. 50.2 (b), it shall be accepted as a ground for invalidity whether the registration has not been made by one of these.

C. Controls are not carried out as set out in Article 49 of IPC

According to art. 49 of IPC¹⁵, control of use of geographical indications shall cover; any type of operation related to controlling the conformity of their use to the specifications indicated in the register during production, marketing or distribution stages or their use in the market. In general, the inspection is carried out within the framework of the geographical boundary, raw material, production method and all other information in the registration certificate of the relevant product¹⁶. It is necessary to use the registered geographical indication together with the product to consider the product to be controlled¹⁷. When the relevant product is not used with the registered geographical indication, the control of the product in question is outside the scope of the industrial property law¹⁸.

Control shall be carried out by the control authority specified in the application and whose competence has been approved by the Office. The control authority is the authority that is determined under the title of control in each registration document and is obliged to perform the control of the registered geographical

¹⁵ For the control of use also see art. 45 of the Bylaw on the Application of the Industrial Property Code, Official Journal, 24.4.2017, No. 30047 <<https://www.mevzuat.gov.tr/mevzuat?MevzuatNo=23528&MevzuatTur=7&MevzuatTertip=5>> accessed on 12 April 2023.

¹⁶ Türk Patent ve Marka Kurumu, Coğrafi İşaretler ve Geleneksel Ürün Adları Denetim Raporu Hazırlama Kılavuzu [Turkish Patent and Trade Mark Office, Geographical Indications and Traditional Specialties Guaranteed Control Report Preparation Guide], 1 < <https://www.turkpatent.gov.tr/TURKPATENT/resources/temp/065ECF3E-E235-4AAE-BD97-C2918E916653.pdf>> accessed on 12 April 2023.

¹⁷ ibid 1.

¹⁸ ibid 1. For example, when the words “Malatya (a city in the east of Turkey) Apricot” is not used with the product when an apricot produced in Malatya is put on the market, this product does not need to be subject to control.

indication¹⁹. The applicant is responsible for establishing a control authority consisting of specialized institutions and organizations in order to carry out the control process and to carry out the control duly²⁰. The control authority must consist of objective institutions or organizations that are experts in their fields with commitments in the registration application²¹. The control authority is eligible to consist of any association, union, similar organization or company regardless of the legal form of establishment²². Namely, control authority is able to be a public or private legal person²³. Change of the control authority stated in the register may be made upon approval of the Office.

The control authority should have sufficient personnel, equipment and other facilities to perform the control effectively. In addition to the production stages, the control authority is able to control also in case of complaint²⁴.

Control reports shall be submitted to the Office once a year after registration is published in the Bulletin. However, in case of complaints, the Office may request earlier submission of the reports. Whether a deficiency is found upon examination of the control reports, the registrant shall be notified and asked to correct the deficiencies within six months. Whether the deficiency is not remedied within the prescribed period or it is determined that control activities were not carried out in line with the procedure, the provisions of art. 43 of IPC shall be applied.

The registrant may claim the costs related to the controls from the parties subject to those controls. Procedure and rules for control shall be determined by the implementing regulation. The control stated in this (second) book covers the controls made by the control authority established by the applicant and shall not prejudice the provisions of the Code on Veterinary Services Plant Health Food and Feed dated 11.06.2010 numbered 5996 and other codes related to the control of geographical indications.

¹⁹ ibid 1.

²⁰ Türk Patent ve Marka Kurumu, Coğrafi İşaret Tescil Başvurusu Hazırlama ve İnceleme Esasları, [Turkish Patent and Trade Mark Office, Preparation and Examination Principles of Geographical Indication Registration Application] 4 < <https://www.turkpatent.gov.tr/TURKPATENT/resources/temp/533E7857-C773-461F-B8DF-CD2BA8AA76B5.pdf> > accessed on 12 April 2023; Türk Patent ve Marka Kurumu, Coğrafi İşaretler ve Geleneksel Ürün Adları Başvuru Kılavuzu, [Turkish Patent and Trade Mark Office, Application Guide of Geographical Indications and Traditional Specialties Guaranteed] 14 < <https://www.turkpatent.gov.tr/TURKPATENT/resources/temp/6B3F914C-E72C-437C-8A30-F50C51DE0A23.pdf> > accessed on 12 April 2023.

²¹ Application Guide (n 20) 15.

²² Çağlar and others (n 2) 254.

²³ ibid 254.

²⁴ Application Guide (n 20) 15.

In case the control procedures are not carried out as specified or the deficiencies are not completed within the given time, it is possible to be decided to deem the registered geographical indication invalid²⁵.

III. Effects of Invalidity (IPC art. 51)

In case a geographical indication has been decided as invalid by the court, the legal protection provided by IPC for the registered geographical sign shall be deemed not to have arisen. Without prejudice to claims of compensation by persons having the right to use a registered geographical sign for damages caused by bad faith, the retroactive effects of invalidity shall not extend to the following:

- a. Any final judgements for infringement of registration rights reached and enforced prior to the decision of invalidity;
- b. Contracts concluded and executed prior to the decision of invalidity.

However, partial or total reimbursement of sums paid under the contracts may be claimed on grounds of equity, in scope of contracts concluded and executed prior to the decision of invalidity. Final court decision shall be notified to the Office by the Court *ex officio*. The geographical sign deemed as invalid, shall be cancelled from the register and information regarding the cancellation is published in the Bulletin. Where invalidity of a geographical indication is claimed, decisions in legal proceedings may not be executed until the final verdict and verdict annexes (IPC art. 162).

CONCLUSION

According to art. 50 and 51 of the IPC, it is possible to request the invalidation of a geographical indication in the presence of certain conditions. First of all, according to art. 50.1 of IPC, invalidity of a geographical indication may be requested from the court by people who have interest. The courts commissioned for legal proceedings regarding invalidity of a geographical indication shall be civil courts of intellectual and industrial property rights and criminal courts of intellectual and industrial property rights (IPC art. 156.1). It should also be emphasized that contrary to invalidity of trade marks, designs, patents and utility models, a term of litigation is not regulated for an invalidity request regarding geographical indications in the IPC. In other words, there is no time limit for invalidity request regarding geographical indications in the IPC. Grounds for invalidity of geographical indications are regulated in art. 50.2 of IPC. According to this article, the court shall decide the registered geographical indication or traditional specialty guaranteed invalid, in case, the register is not in compliance with any one of the conditions set out in the art.

²⁵ *ibid* 15.

33, 34, 35, 37 or 39; the registration has not been made by those who have right to apply in line with the art. 36; controls are not carried out as set out in art. 49 of IPC. In case a geographical indication has been decided as invalid by the court, the legal protection provided by IPC for the registered geographical sign shall be deemed not to have arisen (art. 51.1 of IPC). In principle, invalidity decision of a geographical indication has a retroactive effect. However, any final judgements for infringement of registration rights reached and enforced prior to the decision of invalidity and contracts concluded and executed prior to the decision of invalidity are exceptions of this retroactive effect. Finally, where invalidity of a geographical indication is claimed, decisions in legal proceedings may not be executed until the final verdict and verdict annexes (IPC art. 162).

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