



**SECOND RESPONSE / REJOINDER
&
COMMENTS TO THE EXPERT REPORT**

by

DEFENDANTS / COUNTER PLAINTIFF

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**OUR RESPONSES TO THE PETITION OF PLAINTIFF
AND COUNTER-DEFENDANT («PLAINTIFF»)**

REGARDING THE MAIN ACTION – Article 155 of IPL

Although it has been claimed by the plaintiff that it is not possible for the design owner defendant to allege the design registration as a defense under Article 155 of IP Code;

It is clear that the allegation regarding the non-protection of proprietary right – which was originally obtained before the entrance of IPL into force – will constitute a violation of the constitutional right and will undermine legal certainty.

Again, within this scope, the use of the client's rights derived from the registration cannot be prevented.



OUR RESPONSES TO THE PETITION OF PLAINTIFF

REGARDING THE MAIN ACTION – *Non-use Plea*

Although it has been claimed by the plaintiff that the trademarks based on the action are used in our country;

No evidence has been presented for this use. We do not accept the evidence as to the awareness of the brand, where there is no actual use of the marks in Turkey.

Within this scope, a decision shall be made for the acceptance of non-use plea with regard to original action and the rejection of all claims based on IP Code.



OUR RESPONSES TO THE PETITION OF PLAINTIFF

REGARDING THE MAIN ACTION – *Lack of Hostility*

Although it has been claimed by the counter party that:

- Muhterem Kabaran's lack of hostility plea should be rejected as the defendant party is responsible for the actions subject to the case and continue the sales despite the warning letter sent to them,

It is clear that on March 17, 2018, - in other words, three days prior to the filing of the case- this defendant completely removed the relevant virtual workplace from the site. The plaintiff could not submit any evidence regarding the continuance of the sales as of the date of the case, their allegations are unsubstantial, and therefore the case shall be dismissed because of lack of hostility.

Again within this scope, the decision of the Esteemed Court to prevent the access to the client's web-site will also constitute an excess of power and be contrary to the law.



**OUR RESPONSES TO THE PETITION OF PLAINTIFF
AND COUNTER-DEFENDANT («COUNTER DEFENDANT»)**

REGARDING THE COUNTER ACTION – Non-use - I

Although it has been claimed by the counter party that:

- There is use in our country;

No evidence have been presented regarding this use.

- Although it is claimed that the obligation of the trademark proprietor to put the relevant trademark to use took effect on **10.01.2017** due to the 4-day period between promulgation date (**06.01.2017**) of the decision rendered by the Constitutional Court, which revoked Article 14 of the Decree Law No. 556 regulating revocation of a trademark due to non-use and the date on which the IP Code entered into force (10.01.2017) and no lawsuit shall be brought for a period of five years starting from the referred date;

This claim must be dismissed.

That is to say;

**OUR RESPONSES TO THE PETITION OF COUNTER
DEFENDANT**

REGARDING THE COUNTER ACTION – Non-use - II

Article 9 of IPL

(1) The trademark which is not seriously used in Turkey by the proprietor of the trademark in terms of the goods or services in which it is registered without a valid ground within five years as of the registration date or where its use is interrupted continuously for a period of five years, shall be annulled.

Article 26 of IPL

Cases of annulment and request for annulment

(1) The Institute shall decide for the annulment of the trademark upon request in the following cases;

a) The presence of the conditions stipulated in clause one of article 9,

Provisional Article 4 of IPL

Exercise of the cancellation power by courts

(1) Until the effective date of provisions of article 26, the power of cancellation shall be exercised by courts in accordance with the principles and procedures laid out in the said article.



**OUR RESPONSES TO THE PETITION OF COUNTER
DEFENDANT**

REGARDING THE COUNTER ACTION – Non-use - III

Under the conventions to which it is a party, Turkey has undertaken the obligation that the non-use of a registered trademark will have a negative effect on its owner and established the trademark law accordingly, before entry into force of the IP Code.

Inclusion of a provision foreseeing cancellation of trademarks which are not used in the IP Code explicitly reveals that the referred 4-day «legal gap» is not intentional and it is not the law-maker's will to grant the trademarks which are not in use, to be valid for another five years.

Both wording and spirit of the aforementioned provisions of the IP Code stipulate that one of the consequences of non-use of a trademark shall be annulment of the relevant trademark and legal proceedings to be conducted by the competent Courts pursuant to provisions of the IP Code.

Provisions of the IP Code are directly applicable.



OUR RESPONSES TO THE PETITION OF THE COUNTER DEFENDANT

REGARDING THE COUNTER ACTION – [Non-use- III](#)

As is known, Article 1 of the Civil Code reads as follows:

A. Application of the Law and Its Sources

The Law, is applied in all matters which refers with its wording and spirit.

Where no provision is applicable, the judge decides in accordance with customary law, and if that is also non-existent, he/she decides as if he/she were the legislator.

The judge, benefits from scientific opinions and judicial decisions while deciding.



OUR RESPONSES TO THE PETITION OF THE COUNTER DEFENDANT

REGARDING THE COUNTER ACTION – Non-Use- IV

The Courts of First Instance have been conducting the legal proceedings without facing any problem within the scope of the actions filed since January 10, 2017 when the IP Code entered into force.

The discussions which took place in the “PANEL OF CURRENT DEVELOPMENTS AND PROBLEMS OBSERVED WITH RESPECT OF CANCELLATIONS DUE TO NON-USE OF TRADEMARKS”, which was organized by the AIPPI Turkey (International Association for Protection of Intellectual Property Rights) have also revealed that teachings and the opinions of practitioners of law are mostly in parallel.

That is to say;

**OUR RESPONSES TO THE PETITION OF COUNTER
DEFENDANT**

REGARDING THE COUNTER ACTION – Non-use - V

- Considering the obligations arising from TRIPs, Paris Convention and other international agreements to which Turkey is a party and judge's law-making authority in accordance with Article 1 of Civil Code, majority opinion is in the direction that the IPL can be implemented directly.

Pursuant to **Prof. Dr. Tekin Memiş**, Provisional Article 4 of IP Code set forth the purpose of the law-maker; a direct judgment will be made during the action for annulment that has been filed/ to be filed pursuant IPL for the reason of non-use. **Prof. Dr. Hamdi Yasaman** also agrees with this opinion.

- Judge of Ankara 2nd Civil Court for Intellectual and Industrial Property Rights Mr. **Fethi Merdivan** also argued that an action can be directly filed for cancellation of the subject matter trademark within the framework of provisions of the IP Code regardless of its registration date if the trademark has not been in use for the last five years.

OUR RESPONSES TO THE PETITION OF COUNTER DEFENDANT

REGARDING THE COUNTER ACTION – Non-use -VI

- According to **Asst. Prof. Dr. Tamer Pekdiñer**; the Constitutional Court annulled Article 14 not for a reason on the merits, instead the law-maker intends to foresee a consequence for non-use of a trademark as it was in the case when the Decree Law No. 556 was in effect and similar consequences have been introduced under all provisions of the IP Code. In this respect, the lawsuits to be brought shall be heard by the Courts without any problem.
- According to retired Ankara Civil IP Court Judge **Adv. Türkey Alıca**, there is no obstacle for cancellation to be applied directly. If the purpose of the IP Code were a 5-year adjournment, the law-maker would clearly set it forward accordingly..
- As regards the subject, **Ass. Prof. Dr. Rabia Eda**, an action for annulment can be filed on the ground of non-use based on IP Code.

OUR RESPONSES TO THE PETITION OF COUNTER DEFENDANT

REGARDING THE COUNTER ACTION – *Well-known Status Defense*

Although it has been claimed by the counter party that:

- Their trademarks have the well-known status;

It has not been understood how these trademarks, which have no use in our country, can be regarded as “well-known” in Turkey.



**OUR RESPONSES TO THE PETITION OF COUNTER
DEFENDANT**

REGARDING THE COUNTER ACTION – Defense of Distinctiveness

Although it has been claimed by the counter party that:

- The Plaintiff 's trademarks fulfill the criteria of (i) pointing the source and (ii) distinguishing one enterprise from the other;

It has not been explained how these three-dimensional figures, which are re-placed in below, point to the plaintiff or their trademarks.





OUR STATEMENTS TO THE EXPORT REPORT

- WE DO NOT ACCEPT THE MATTERS THAT ARE ON OUR DISFAVOR. Within this scope;
 - The determination that the plaintiff's design has the characteristic of a work was not justified.
 - The client's commercial books was not reviewed as necessary, and products bearing other brands were included in the account.
The report says that between March 10, 2017- 2018, 120.000 pieces of product have been sold, - meaning that 394.73 pieces of shoes have been sold in each business day – which is not at all usual.
In this direction, the resulting hypothetical license fee is also extortionate..
 - The materials that the clients use in the production are extremely qualified.

- We have no objections to the determinations of the experts that the plaintiff's trademark have no use in Turkey and that the related product and the page have been removed from the defendant Muhterem Kabaran's website before the filing of the action.

CLAIM AND CONCLUSION

We hereby kindly request a decision to be rendered for:

- Dismissal of the action filed by the plaintiff in respect of both the defendant-counter plaintiff USSAIN SUMOLOV and the defendant MUHTEREM KABARAN;
- Acceptance of the counter-action filed by the defendant-counter plaintiff Client USSAIN SUMOLOV.

Respectfully,

Adv. Zeynep Seda Alhas

Adv. Evrim Kaşlıoğlu