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ANALYSIS OF THE LEGAL REMEDIES IN COMBATING TRADEMARK INFRINGEMENT

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After a series of legislative efforts in the mid and late 1990s, all of Turkey's IP related laws and regulations, including the Decree Law No. 556 Pertaining to the Protection of Trademarks have become compliant in almost all aspects with EU legislation. In addition to such major amendments in the laws and regulations, establishment of specialized IP Courts in major cities and structural changes within enforcement authorities and customs have enhanced the implementation of the laws in practice.

While the legal environment is sufficient, there are some pitfalls in practice stemming mainly from precedents and the procedural law which should be carefully considered when adopting and implementing effective trademark enforcement actions.

The Turkish Laws entitle the trademark owners mainly to the following legal remedies: (1) Administrative measures (2) Civil court actions and (3) Criminal raids and actions. An effective strategy in adopting any of these actions requires a detailed analysis of the factual circumstances, identifying the applicable courses of actions and determining which one(s) to apply and in which order by also considering the issues in relation to the specifics of the jurisdiction that actions will be taken. For this reason, before deciding on possible legal actions, there should be a preparation stage to gather information about the infringer and the extent and scope of the infringing acts. In some cases simple searches of public records and the internet may provide sufficient information. However, in most cases it is required to employ professional investigators to collect all the

relevant information. An important issue during this stage is collection of evidence, as there is always the risk that the infringers may try to obscure the evidence or be alarmed about possible actions.

During the preparation stage it is also important to inquire if the infringer has any trademark or industrial design applications / registrations. This is because one of the pitfalls of Turkish practice is that the Court of Appeals grants "de facto immunity" to infringers who hold trademark and/or industrial design applications/ registrations and allow them to safely use the infringing signs until the cancellation of such applications/registrations. For this reason it is very common for the infringers to file trademark applications and/or industrial design registrations for the signs that would normally constitute trademark infringement so that they can enjoy such "immunity" for their infringing use until their registration is cancelled and deleted from the register.

In terms of trademark related administrative measures, the most common one is oppositions before the Turkish Patent Institute. In addition to these oppositions, the recording of trademark rights with customs is also one of the administrative measures that would lead to the seizure of counterfeit or pirated goods by the customs officials. In most infringement cases the administrative actions are auxiliary actions and should be combined with other remedies in an effective action plan.

For instance, the opposition stage before the TPI would help the IP owner to prevent the infringer from obtaining any registered trademark/industrial design which may otherwise provide the infringer a safe harbor to continue the infringement. Accordingly, in a given case where there is a pending trademark/design application filed by the infringer the opposition stage would be required to ensure the success of the action plan.

The recording of a trademark with Customs enables the trademark owners to monitor the entrance of counterfeit and/or infringing items to Turkish markets. Following the recording of the trademark, the Customs authorities temporarily detain the suspected products and inform the trademark owner so that the trademark owners can initiate civil or criminal proceedings in order to have the counterfeit / infringing goods permanently seized and subsequently destroyed.

In terms of civil court actions, a trademark owner may ask the Court to determine the infringement and to stop the infringement activities, to prevent the continuance of the infringement activities and to compensate the damages.

As a result of their established practice for over a decade, the specialized IP Courts have a good record of knowledge and experience. However one of the pitfalls of Turkish Procedural Law is that in most cases the Courts require an expert examination. Accordingly, the trademark owner must ensure that all claims are clear enough to facilitate the expert examination. It is also possible to file for a preliminary injunction claim aiming to prevent infringing activities immediately and effectively until the substantive action finalizes.

In terms of criminal actions, trademark owners are entitled to initiate raid actions following a criminal complaint to Public Prosecutors, which would then mature into criminal prosecutions and actions. The criminal route is very effective - where there is a clear cut infringement - as it allows the trademark owner to seize the infringing products within a 1-2 day period.

In conclusion, Turkish trademark laws provide sufficient legal basis for enforcement provided that the trademark owners duly consider the particularities of the Turkish market, as well as the Turkish trademark practice. In order to avoid the pitfalls, it is highly recommended that trademark owners have their rights registered in Turkey before they enter into the market. Additionally, trademark owners are advised to monitor the Bulletins to watch any infringing applications by the competitors or infringers and to apply to the Customs Authority for recording of their trademarks in order to benefit from border detention measures.



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