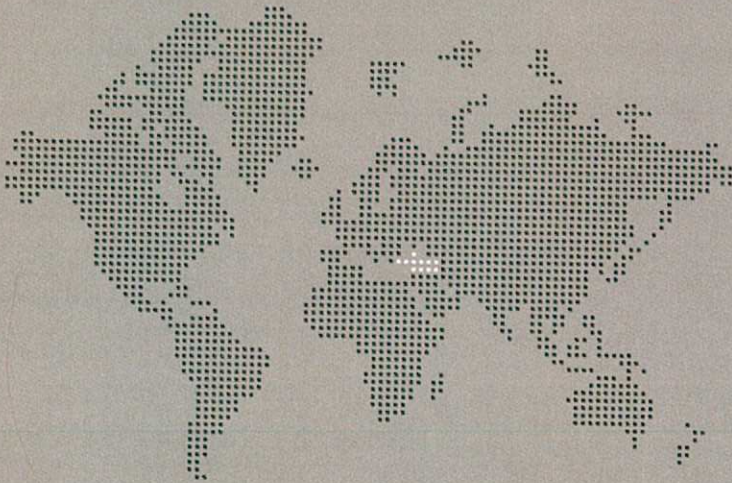


Turkey

Contributing firm
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Legal framework

Turkey has closely followed international developments and has acceded to almost all IP-related international treaties, in particular the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs), which aims to harmonize the legal framework on anti-counterfeiting and anti-piracy among World Trade Organization members.

Following Decision 1/95 of the EC-Turkey Association Council on implementing the final phase of the Customs Union and EU Directive 89/101, Turkey harmonized its trademark law with EU standards. Today, Turkish Trademark Decree-Law 556 and Copyright Law 5846 and related laws are in almost complete compliance with TRIPs.

The decision of the Turkish Constitutional Court, regarding the annulment of certain criminal provisions of the Trademark Decree Law, entered into force on January 5 2009. The Turkish Parliament has enacted Law 5833,

which amends Decree Law 556, and new provisions entered into force on January 28 2009 which are similar to the cancelled provisions. Although the doctrine clearly stated that trademark infringers in cases commenced before January 28 2009 could be penalized under the criminal provisions of the Commercial Code, which penalize acts of unfair competition, the Court of Appeals has issued a decision that such trademark infringers should be acquitted as trademark infringements cannot yet be punished and the unfair competition provisions are not applicable to such cases. The chief prosecutor of the Court of Appeals is expected to file a further appeal against the decision, which is the only procedure that could prevent the decision becoming binding precedent on all first instance judges. If the prosecutor decides not to challenge the decision or the General Assembly of Court of Appeals rejects the appeal then, due to Parliament's belated enactment of the changes, thousands of ongoing criminal prosecutions could be dropped and seized goods could be returned to infringers in Turkey.

Border measures

Because Turkey is an entry point to European markets, its border detention measures are very important for tracking the flow of counterfeit goods into Europe. Thus, the Turkish Customs Code and relevant customs regulations were also amended in line with the TRIPs provisions.

Customs procedures for the protection of IP rights in Turkey are quite effective, and counterfeit goods can be stopped on the submission of an application to Customs on application by the rights holder or its representative or *ex officio* by the customs authorities themselves. However, there must be clear evidence proving that the goods at issue are falsely marked or are imitations of goods which are subject to copyright. An application by the rights holder or its representative will be valid for a maximum of 30 days.

Customs cannot itself destroy infringing goods, but it can suspend them for three days to allow the rights holder to file an application, if one has not been filed previously. Customs can also suspend

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normal customs procedures for 10 days to enable the applicant to obtain an interim injunction from the court; and this will then be followed by civil or criminal court proceedings.

Criminal prosecution

The major difference between civil proceedings and criminal prosecution is that in the latter the public prosecutor and criminal judge act *ex officio*, following a criminal complaint filed by the trademark owner. The injured party does not have to file documentary evidence or briefs. The process is also deemed to be straightforward and cost effective.

Key points

Pursuant to Article 61/A of the Trademark Decree Law amended on January 28 2009, the production, offer for sale and sale of fake goods shall be punished by between one and three years’ imprisonment and a considerable fine. As the new legislation does not expressly include importing and exporting, it will be harder to enforce the criminal provisions against fake products detected at Customs.

Although the new law also introduced an impunity clause, which enables a suspected infringer to avoid punishment if he or she reveals the source of the counterfeit goods and facilitates the seizure of such goods, it is extremely difficult to carry out such procedures in Turkey and in practice it will be hard to reach producers. This loophole could even be exploited by some infringers to extend the process as much as possible.

The Copyright Law stipulates two to four years’ imprisonment and/or criminal fines for the sale and distribution of illegal reproductions of works that are subject to copyright protection.

Preliminary measures

When an infringer is identified as dealing with counterfeit goods, a complaint can be filed with the local public prosecutor’s office, which may then order the police to carry out a criminal search and seizure under a search warrant obtained from the local criminal court. Police officers have the authority to search premises and seize any counterfeit goods, provided the official papers documenting the search and seizure are sent to the local criminal court for approval within 24 hours of the search. Criminal procedure is very effective, as the search and seizure can be carried out within a couple of hours of filing a well-founded application.

Remedies

The applicable remedies take the form of imprisonment, the order of security measures and fines from TL100 up to TL2 million for offences laid down by the Trademark Decree-Law, and between TL10 million and TL150 million for offences within the ambit of the Copyright Law. Moreover, the court may order the destruction of the infringing counterfeit products at the end of the criminal proceedings.

Criminal remedies for infringements of registered IP rights are intended to act as a deterrent to future infringing activities and to alleviate the damage caused by the IP rights violation at issue.

A criminal remedy will be issued only if the legitimate holder of a relevant IP right files a formal complaint.

Civil enforcement

The Turkish Ministry of Justice has established specialized criminal and civil IP courts in Istanbul, Ankara and Izmir. As a result, it is now easier to access judges with detailed IP knowledge.

Key points

The protection of a trademark can be based both on the Trademark Decree-Law and the unfair competition provisions of the Commercial Code. Such protection is afforded in the event of an act which damages a third party’s goodwill, namely an attempt to create confusion:

- regarding the third party’s goods, products, activities and commercial enterprise; or
- by abusing the names, marks, signs and similar promotional material used by a third party.

A trademark owner may rely on its registered trademark and demand the cessation of its infringement. If the trademark is not registered, the owner may file an unfair competition action.

Preliminary measures

Rights holders are entitled to apply to the court for preliminary measures for the protection of IP rights. They can also apply for a determination of evidence, with or without a request for a precautionary injunction to prevent ongoing infringements.

Applications solely for discovery of evidence are often rejected by the courts. However, such applications filed in conjunction with a precautionary injunction are more likely to be accepted and expeditiously processed.

Turkish IP laws set out specific provisions which require courts to issue precautionary injunctions in such a manner as to secure a final judgment. Provided that the registered IP rights and the likelihood of infringement or ongoing infringement are proven, the specialized IP courts are likely to grant a precautionary injunction to prevent an offence, or to put a stop to an

infringing activity which is already taking place. Claimants are usually required to deposit a reasonable guarantee to indemnify the defendant and third parties in the event that a precautionary injunction is obtained in circumstances where no offence is being committed. While it is theoretically possible for defendants to submit guarantees to lift precautionary injunctions, this practice is rarely allowed by the courts.

Rights holders frequently apply for discovery and precautionary injunctions, as they provide quick and effective relief against infringing activities. Depending on the workload of the courts and the complexity of the circumstances in issue, these preliminary measures can be carried out within a period of a couple of days to a couple of weeks.

Remedies

Civil remedies under Turkish IP laws are designed to prevent violations of IP rights and may be resorted to even before a violation takes place. The ultimate purpose of the remedies is to restore the rights holder to the position it was in before the infringement took place.

Actions for the cessation and prevention of an infringement stop the infringing activity, while actions to restore the position of the parties aim to eliminate all the results of the infringement and to restore the situation which existed prior to the infringing activity.

An action for damages aims to achieve the same purpose monetarily. It aims to compensate any losses incurred by the rights holder, while also returning any profits made by the infringer to the rights holder. This results in a situation where the rights holder profits as if the infringing activity had been carried out with his consent.

Anti-counterfeiting online

Unauthorized internet commerce

The advent of the information society and the Internet have facilitated a growing trade in counterfeit products and created new opportunities for the manufacturing and circulation of fake goods.

Counterfeiters increasingly carry out their activities over the Internet, because they are able to reach consumers more easily. Moreover, the use of the Internet makes it difficult for the authorities to track them down, as it is not always easy to establish the domicile of the infringer in internet-based investigations. However, once domicile is established, it is then possible

to obtain legal remedies in the normal way through court proceedings. The new provisions enacted on January 28 2009 provide that usage of the registered trademark as a domain name, router code, descriptor or similar forms will be deemed in the scope of trademark infringement and the proprietor of a trademark will be entitled to prevent such unauthorized usage before the civil courts.

Internet security and online investigation strategies

Some private firms now offer investigation services to track firms within the Turkish jurisdiction. One technique they use is to order a suspected product online, so as to establish whether it is authentic and to track down relevant sources.

When it comes to domain names, those in the '.tr' country-code domain space are fairly difficult for counterfeiters to obtain, as this designation is granted by the Middle East Technical University, which applies strict rules and requires precise and detailed documentation for proof of genuine rights ownership.

Preventive measures/strategies

Use of local counsel and investigators

When engaging in legal proceedings relating to counterfeit products in Turkey, it is essential to make at least some use of specialized local counsel and investigators who are familiar with local legal rules and experienced in IP matters. Such use will help to ensure that relevant processes are efficiently dealt with.

Controlling contractual relationships with third parties

Adequate control for contractual partners is a fundamental issue as this will help to reduce the likelihood of infringement during the course of the contract and following termination.

It should be noted that, due to the newly enacted Article 61(d) of the decree law, "transferring to third parties or expanding rights acquired by a licensing contract" shall also be construed as trademark infringement.

Effective use of technology, authentication and monitoring

Given the accelerating pace of technological developments, it may be advantageous to take advantage of all available authentication and monitoring tools, with the aim of differentiating original goods from counterfeits and to ensure that the customs process runs effectively.

Cooperation with national anti-counterfeiting agencies

The national police force regularly carries out raids to enforce intellectual and industrial property rights and carries out ongoing training for its staff. However, counterfeiting is not addressed in the context of the fight against organized crime and, given the current extent of counterfeiting, the overall capacity of the law enforcement agencies is insufficient. As a result, pirate traders control a substantial share of the Turkish market for music and film.

Bearing in mind that 31% of fake products are purchased from street vendors and 38% from street markets, cooperation with the municipal police, in particular, is crucial in the fight against counterfeiting.

On the other hand, the Security Department of the Police Headquarters has recently formed elite squads to engage in action. These form the Department for Intellectual Property Rights, which deals mainly with applications for search warrants based on IP rights.

Thus, regular contact and cooperation with police departments can be a determining factor in achieving success in the fight against counterfeiters. Branches of the Department for Intellectual Property Rights have so far been established in Istanbul, Ankara, Izmir, Bursa, Samsun, Adana and Diyarbakir, and they are likely to expand to other cities if the need arises. [IPPI](#)

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Mr Aktekin speaks and writes frequently on IP issues. He has been repeatedly recognized and recommended in various professional listings in relation to his trademark work.



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