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Uğur Aktekin, Özge Atılğan Karakulak and Hande Hançer of **Mehmet Gün & Partners** counter the perception that Turkey's enforcement tools are inefficient, and detail the best ways to tackle infringement

How to combat persistent infringement

As a bridge between Europe and Asia, Turkey's unique geographic location has always been an attractive venue for IP infringers. It is not an exaggeration to say that almost all IP owners could recount at least one infringement experience in Turkey. It is also very common to hear complaints that the enforcement tools are not efficient enough to overcome the persistent activities of the dedicated, and in some cases very creative infringers in Turkey.

While it may be true that in Turkey, IP owners may have experienced the most creative acts of IP infringement, it would not be fair to say that the Turkish Law does not provide effective enforcement tools against such infringements.

Indeed, the Turkish IP Laws, in particular Law 5846 Pertaining to the Protection of the Intellectual and Artistic Works (the Copyright Law), Decree Law 551 Pertaining to the Protection of Patents, Decree Law 554 Pertaining to the Protection of Industrial Designs and Decree Law 556 Pertaining to the Protection of Trademarks, are in compliance with EU legislation in almost all aspects, and provide a strong legal basis. In addition, in Turkey there are 11 specialised civil IP courts and 11 specialised criminal IP courts in Istanbul, Ankara and Izmir.

Turkish IP practice does have sufficient legal foundations, and the legal environment for effective IP enforcement. However, in practice there are some pitfalls, stemming mainly from precedents and the procedural law, which should be carefully considered in adopting and implementing an IP enforcement strategy.

This article aims to briefly inform IP owners about enforcement remedies and give them some tips that will help in determining an effective enforcement strategy in Turkey.

Enforcement remedies

It should be stated that the Turkish Laws mainly offer IP owners with the following remedies: (i) administrative measures (ii) civil court actions and (iii) criminal raids and actions. An effective strategy requires a detailed analysis of the factual circumstances, identifying the applicable courses of action and determining which ones to apply and in which order, by also considering the issues in relation to the specifics of the jurisdiction that actions will take place.

The preparation stage

Before deciding on the actions to be taken there should be a comprehensive and well-managed preparation stage during which the IP right holder gathers information about the infringer and the extent and scope of the infringing acts. These are important to try to guess how aggressive the infringer can be and in particular how the approach of the IP holder should be. In some cases, simple searches on public records and the internet may provide sufficient information, but in most cases it is required to employ professional investigators to collect all the relevant information. For an effective investigation, it is important that the investigator has a basic understanding of the IP rights that he will investigate and the forms of their use

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Uğur Aktekin is a partner and he co-chairs the IP rights department of Mehmet Gün & Partners. His practice concentrates on trade mark, design, copyright, IT, unfair competition, domain names, advertising, media and consumer laws.

Uğur has handled hundreds of both contentious and non-contentious administrative oppositions and litigation actions involving trade marks, copyrights and industrial designs. He provides counsel on legal issues in relation to the administration of trade mark portfolios of various national and multinational companies and represents clients in relation to domain name disputes.

Özge Atılğan Karakulak



Özge Atılğan Karakulak is a partner in the IP and corporate and commercial departments of Mehmet Gün & Partners.

Her practice focuses on IP rights, life sciences, anti-trust and public procurement. Özge has been involved in leading numerous patent infringement actions against generic pharmaceutical companies and initiated with Mehmet Gün the first ever pharmaceutical data protection and exclusivity actions in Turkey. She advises a number multinational life science companies on a wide range of matters including registration procedures, promotion practices, pricing and reimbursement regulations, distribution relationships and co-marketing deals.

Hande Hançer



Hande Hançer is a senior associate in the IP department and works within different specialised practice groups, mainly trade marks and design litigation, copyright and IT, IP opposition and advertisement, and media and consumer protection. She joined the firm in 2005.

She has been involved in numerous projects in all fields of IP. Her involvement includes both contentious and non-contentious matters in relation to trade marks, copyright, industrial designs, domain names and unfair competition. She has an extensive litigation experience and has counseled various clients regarding their IP strategies, legal disputes, licensing and settlement agreements.

by businesses, as well as the relevant business field and products. Another 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, it is important to collect evidence at this stage. This may either be by means of test purchases during the investigation, or by applying to a court for the determination of evidence.

During the preparation stage, it is also necessary to inquire whether the infringer has any rights, in particular trade mark or industrial design applications or registrations which may

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give a justified basis to continue its infringing activities. In Turkey, according to the established precedents of the Court of Appeals, the existence of trade mark or industrial design applications or registrations does grant de facto immunity to the infringers and allow them to safely use the infringing marks until the cancellation of such applications or registrations. For this reason, it is very common for infringers to file trade mark applications or industrial design registrations for marks that would normally be deemed by the court to infringe the rights of IP owners who have senior registered rights, in an aim to obtain registered rights and enjoy such immunity, at least for the period until their registration is cancelled and deleted from the register.

An effective preparation stage will provide the IP owner with a full picture of the case and based on this, an action plan for the enforcement of rights can be adopted.

A combination of measures

In most cases the IP owners first consider whether starting with a cease and desist letter will lead to a positive outcome. Such an approach may be effective if the preparation stage indicates that the infringer has not yet made substantial investments for the infringing products or the infringer is not totally aware of the consequences of his activities. If, however, the factual circumstances show that the infringers have a bad track record in terms of IP infringement, and have acted intentionally, then sending a cease and desist letter would not provide any positive results and might even cause adverse effects.

According to the specifics of the situation, the IP owner may end up choosing one legal action, a combination of legal actions, or indeed, all possible actions.

In some cases the IP owner may need to start with administrative measures. However, it should be stated that administrative measures are usually auxiliary actions, and in most cases should be combined with civil and criminal actions.

In terms of IP-related administrative measures, the most common ones are oppositions before the Turkish Patent Institute which are available for trade marks, patents and industrial designs, as there is no registration system for copyright in Turkey. In addition, the recording of IP rights with Customs is one of the administrative measures that would lead to the seizure of counterfeit or pirated goods by Customs officers. In most infringement cases, 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 trade mark or industrial design which may provide a safe harbour to continue the infringement. Accordingly, in a case where there is a pending trade mark or design application filed by the infringer, the opposition stage would be required to ensure the success of the action plan.

The recording of IP rights with Customs enables IP owners to monitor the entrance of counterfeit or infringing items into Turkish markets. Following the recording of the rights, the Customs authorities detain the suspected products and inform the IP owner. However the detainment of the goods is temporary and the IP owners have to commence civil or criminal proceedings in order to have the counterfeit or infringing goods permanently seized and subsequently destroyed. There is also the simplified destruction procedure that is provided in the Customs Law; this allows the destruction of the counterfeit goods

directly by the Customs administration without a court order, but only if a consensus is reached between the right holder and the owner of the goods. Regarding trade mark, design and copyrights, it would be fair to say that recording IP rights with Customs provides an effective tool for IP owners to monitor the flow of the counterfeiting and infringing goods. However, in terms of patents, the Customs registration system does not have the same power. Indeed, due to the difficulties in analysing the technical aspects, it is difficult for Customs to make an assessment about the possible patent infringement in order to detain the products. In addition, even if the goods are detained by the Customs authorities, it is not easy for the patent owner to start civil proceedings within the temporary detention period, again due to the difficulties of technical analysis. In any case, the patent owner may still use the Customs registration system as a tool to monitor the market activities of the infringers.

In terms of civil court actions, an IP owner may ask the court to determine the infringement and to stop the infringement activities, prevent the continuance of the infringement activities, and enforce compensation of the damages.

The specialised IP Courts have a good record of knowledge and experience as a result of their practice for over a decade. However, another pitfall of the Turkish Procedural Law is that in most cases the courts require an expert examination, and in patent cases, the expert examination is a must as the judges do not have a technical background. Accordingly, the IP owner must ensure that all claims are clear enough to facilitate the expert examination. For patent cases it is also important that the parties have their own technical experts and inform the court and the court-appointed experts about the particular circumstances of the conflict.

It is also possible to file for a preliminary injunction (PI) claims in order to prevent infringing activities immediately and until the substantive action is finalised. The PI has a specific importance in patent and industrial designs, as these rights provide the owner with a monopoly right only for a certain period of time, and the patent or industrial design owner has a limited time to fully exploit its rights.

PI claims can be either filed separately prior to filing the substantive action, or within the substantive civil action. The difference between two procedures resides in the urgency of the threat. Normally, the first option, namely filing a separate PI request before filing the main action, provides a more immediate measure as the court deals with the request without going into the details of the merits of the case, and sometimes by accepting the requests for ex parte proceedings. The second

option also provides an immediate measure, as the court will give priority to the PI request before the merits of the case, (but not as urgently as the first option) and in most cases it will be dealt with inter partes, even if a request for ex parte proceedings is made. In practice, the chance of success of obtaining a PI order depends on the strength of the evidence and preparations. It would be fair to say that if the IP owner is able to present the court with a clear analysis of the likely infringement the chances of success for a PI order would be reasonably high. Indeed, the courts do not expect a complete presentation of the facts, but they require that the right holder provides them with a enough evidence to convince them of a likely infringement. In patent cases, due to the technical aspects, the courts require an expert examination and this may delay the process. But even in patent cases, if the patent owner is well-prepared for the case and informs the court and experts about the particular technical specifications, the chances of success in obtaining a PI order would be good.

In terms of criminal actions, the IP owner is entitled to initiate raid actions following a criminal complaint with the public prosecutors, which would then mature into criminal prosecutions and actions. Currently, criminal actions are not available for patent and industrial design owners as the provisions regarding the criminal sanctions of both Decree Law 551 and Decree Law 554 have been annulled by the Court of Constitution's decision numbers 2005/57 E and 2009/19 K.

The criminal route is very effective as it allows the IP owner to seize the infringing products within a one to two day period. However, the Criminal Law has a very strict approach, and in order to take a successful criminal action the infringing use should be straightforward. Accordingly, where there is a clear-cut infringement which does not require detailed analysis, a

criminal action may be the most effective tool for the IP owner. Depending on the specific circumstances of a given case, criminal action may also be used as an initial step to then be combined with civil proceedings, if the infringing activities have multiple dimensions.

In addition to the remedies available under IP Laws, there may be alternative avenues which the IP owner may consider. In particular, if the products at stake are subject to a specific administrative process in terms of manufacturing, importation and exportation, and if the infringing products do not comply with these administrative requirements, the IP owners may also consider applying to the administrative authorities to prevent the infringing activities.

Close monitoring

In conclusion, Turkish IP Laws do provide a sufficient legal basis for an effective IP enforcement provided that IP owners duly consider the particularities of the Turkish market and IP practice. There are many tools for the IP owner to effectively enforce their rights in Turkey, but an effective action plan requires a well-managed preparation stage. Depending on the particulars of the conflict, the IP owners may also be allowed to consider alternative avenues to fight against the infringers or further strengthen their tools against them.

Finally, in order to avoid the pitfalls of Turkish practice, it is highly recommend that IP owners have their rights registered in Turkey before they enter into the market. In addition, if IP owners have active business in Turkey, they should be monitoring the trade mark and design bulletins to watch for any clues of infringement by competitors or infringers, and they should also apply to Customs for the registration of their IP rights, in order to monitor infringing activities at the borders.

GÜN AVUKATLIK BÜROSU MEHMET GÜN & PARTNERS

Since its establishment in 1986, Mehmet Gün & Partners has been actively involved in all aspects of intellectual property and was among the pioneer contributors to the development of modern Turkish IP law and practice.

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