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# Anti-counterfeiting 2015 A Global Guide

**World  
Trademark  
Review**<sup>™</sup>



Gün + Partners is a full-service institutional law firm with a strategic international vision, providing transactional, advisory and dispute resolution services.

We advise a large portfolio of clients in diverse fields of activity, including life sciences, energy, construction & real estate, logistics, technology, media and telecom, automotive, FMCG, chemicals and defence industries.

We are based in Istanbul, with working and correspondent offices in Ankara, Izmir and all other major commercial centres in Turkey.

### Anti-Counterfeiting

We advise brand and IP owners, anti-counterfeit and anti-piracy alliances and associations on all aspects of Turkish anti-counterfeiting, anti-piracy rules, procedures and remedies, on IP related enforcement and Customs enforcement of IP rights.

We enforce our clients' IP rights by commencing and carrying out all available civil, criminal and administrative actions, obtaining search and seizure orders and conducting multiple, serial or individual raids and customs seizures of import, export and transport goods, and represent IP owners before the specialised criminal and civil IP courts. We obtain seizure, confiscation and destruction orders and implement them against counterfeit products.

We develop and conduct anti-counterfeiting campaigns including public awareness initiatives for common interest groups, coordinating civil, criminal and administrative activities against counterfeiting and piracy, also liaising with PR agencies, cooperating with trade and industry associations and NGOs. We also regularly organize seminars, conferences and workshops to contribute to public information and to the training of customs and police officers.

We employ our own private investigators having diverse market and industry backgrounds and provide IP infringement and piracy investigation services throughout Turkey; including to identify and evidence counterfeiting activities, conducting test purchases to collect evidence as well as use and/or non-use researches.



## Authors

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### Legal framework

Turkey is a party to most international IP-related treaties, including the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs), which aims to harmonise the legal framework for anti-counterfeiting and anti-piracy. Accordingly, Trademark Decree-Law 556 is almost fully compliant with TRIPs.

There are specialist civil and criminal IP courts in the three largest Turkish cities (Istanbul, Ankara and Izmir). In other cities the regular civil courts have jurisdiction over IP rights matters. While the judges of the specialist IP courts have deeper IP knowledge, even non-specialist judges now have a broad understanding of intellectual property and its importance.

### Border measures

The availability of preventive measures at Customs is vital in the fight against counterfeiting. In light of this, the Customs Code and the relevant customs regulations have been amended in line with TRIPs.

These now offer rights holders strong protection through Customs.

According to the Customs Code, rights holders may apply to Customs for the seizure of infringing goods through a simple application form covering trademarks, patents, designs, copyright and geographical signs. Customs may also take *ex officio* action and seize suspected goods, after which it will inform the rights holder, invite it to check the relevant shipments and take any necessary action. However, Customs cannot always be relied on to take such steps without a proper application; thus, filing a customs application is highly recommended.

Customs applications are filed with the Directorate General of Customs, which oversees IP rights protection for all local customs administrations. Located in Ankara, the directorate general accepts applications on behalf of all local customs authorities and the information therein is made available to all customs officials on its official website. It is possible to file a customs application for up to one year.



## Turkey has no legislation on private investigators and, under the Constitution and the Criminal Code, privacy is protected as an absolute right

The customs application covers import and export, as well as goods in transit and in free trade zones.

Upon discovering suspected counterfeit goods, Customs will issue a temporary suspension decision and notify the rights holder or its representative. The rights holder must then obtain samples or photos of the seized goods and a preliminary injunction decision or criminal seizure order within 10 working days. The rights holder can seek a 10-day extension of this period if it requires more time (eg, if examination of the samples takes longer than expected).

Further, Article 57(6) of the Customs Code established the simplified destruction procedure, whereby the counterfeit goods can be destroyed by Customs without a court order provided that a consensus is reached between the rights holder and the owner of the goods.

A customs application can be filed for up to one year. Although the Directorate General of Customs has discretion to decide on the period, almost all applications are accepted for one year, as long as the IP rights protection period does not expire during that period. In other words, if at the time of application a trademark registration requires renewal within six months, the customs application will be accepted for six months only and the applicant will have to renew the application thereafter by submitting a copy of the relevant trademark renewal certificate.

In order to file an application, the applicant must submit documents proving

the existence or validity of the registered right; any documents demonstrating ways of distinguishing original goods from fakes are also accepted and welcomed. No official fees are payable.

### Criminal prosecution

Article 61(A) of the Trademark Decree-Law provides that anyone manufacturing, selling or offering for sale goods or service that infringe trademark rights shall be liable to imprisonment for one to three years and a judicial fine of up to 20,000 days. Further, at the end of the criminal proceedings, the court can order the destruction or confiscation of the counterfeit goods.

Since 2009 the wording of Article 61(A) no longer includes acts such as import or export, which can lead to problems, particularly before the non-specialist courts. Thus, efforts to amend the wording in this respect are ongoing. However, the criminal penalties can be enforced against goods suspended at Customs.

When a rights holder files a criminal complaint, the public prosecutor and the criminal judge act *ex officio*; however, continuation of the action depends on the validity of the complaint and if the complaint is withdrawn, the criminal procedure lapses.

The criminal complaint is 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. In this respect, the local prosecutor's office

must be provided with concrete evidence, and therefore advance investigations are vital. Once the court has issued a criminal search and seizure warrant, the police will conduct a raid, preferably with the rights holder's representative in attendance, as well as an expert if so ordered.

Police officers also have the authority to search premises and seize counterfeit goods without an advance order, provided that the official papers documenting the search and seizure are sent to the local criminal court for approval within 24 hours of the search. In this respect, the criminal procedure is highly effective as the search and seizure can be carried out within a couple of hours of filing a valid application.

The prosecutor then conducts his or her own investigation and the matter becomes a criminal case against the accused. The trial process takes around one year at first instance and nearly 90% of cases result in criminal penalties. If the accused has no criminal record, the court can suspend declaration of the verdict under Article 231 of the Code of Criminal Procedure. The accused will be under supervisory control of the local prosecutor's office for five years and the verdict will be declared if he or she commits a new crime within that period. The five-year supervisory control period can be effective in preventing accused parties from committing further infringing acts.

Although the decree-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 implement this clause and its procedures in Turkey. This loophole could even be exploited by some infringers to extend the process as much as possible.

### **Civil enforcement**

The civil remedies set out in the Trademark Decree-Law are designed to prevent violations of IP rights and may be set in motion even before a violation takes place. The purpose of the remedies is to restore the rights holder to the position that it was in before the infringement took place.

The actions for cessation and prevention stop infringing activities, while other actions remedy the impact of the infringement and restore the situation which existed before the infringing activity. An action for damages aims to achieve the same purpose monetarily by compensating any losses incurred by the rights holder and returning any profits made by the infringer to the rights holder. This leads to a situation in which the rights holder profits as if the infringing activity had been carried out with its consent.

A rights holder may rely on its registered trademark and demand cessation of the infringement, as per the Trademark Decree-Law. In order to stop an infringing act immediately while the court action is pending, preliminary injunctions are available. The rights holder can also apply to the civil courts for a determination of the evidence, with or without a request for a preliminary injunction to prevent ongoing infringement. Applications solely for a determination of the evidence may sometimes be rejected by the courts. However, if such applications are filed in conjunction with a request for a preliminary injunction, they are more likely to be accepted and expeditiously processed.

The Turkish IP law requires the courts to issue preliminary injunctions in such a manner as to secure final judgments. Provided that the registered IP rights and the likelihood of infringement or ongoing infringement are proven, the courts are likely to grant a preliminary injunction to prevent an offence or stop infringing activity which is already taking place. Preliminary injunction decisions are enforced by the local enforcement offices on the request of the claimant, which should be filed within one week of the decision. Otherwise, the preliminary injunction decision lapses.

Claimants are usually required to deposit a reasonable guarantee in order to indemnify the defendant and third parties should a preliminary injunction turn out to be unlawful. This guarantee is kept by the court until a final decision has been issued and is repaid to the claimant

if the defendant files no action for its losses. While it is theoretically possible for defendants to submit guarantees to lift precautionary injunctions, the courts rarely allow this in practice.

Rights holders frequently apply for determinative and preliminary injunctions as they provide quick and effective relief against infringing activities. Depending on the workload of the courts and the complexity of the case, the preliminary

measures can be obtained as quickly as within two days of the decision.

**Anti-counterfeiting online  
Unauthorised online commerce**

Counterfeiters increasingly carry out their activities online because they can reach consumers more easily and cover their tracks more effectively. It is not always easy to conduct an internet-based investigation. However, once domicile has



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been established, a rights holder can obtain legal remedies in the usual way through court proceedings.

The Trademark Decree-Law provides that use of a registered trademark as a domain name, router code, descriptor or similar constitutes trademark infringement and the rights holder is entitled to prevent such unauthorised use before the civil courts.

### **Internet security and online investigation strategies**



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Ferman Ufuk Özer is a qualified Turkish lawyer. He graduated from Bilkent University with an LLB and was admitted to the Istanbul Bar Association in 2014. He has worked at Gün + Partners for one year, focusing on the fields of anti-counterfeiting and investigations.

Some private firms now offer investigation services to track firms within the Turkish jurisdiction. One of the techniques that they use is to purchase a suspected product online in order to establish whether it is authentic and track down the source.

In regard 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.

### **ISP liability**

Under general liability rules, an internet service provider (ISP) may be held responsible for aiding an infringer if it is aware of ongoing infringement and is technically able to remove the infringing website or suspend such infringing activities. In addition to IP rights legislation, in 2007 Parliament adopted Law 5651 in order to regulate the online media and combat crimes committed through the Internet. Law 5651 sets down general principles regarding the liability of content providers, hosting providers, ISPs and public use providers, and these principles also apply to acts of counterfeiting and piracy committed online.

### **Preventive measures/strategies**

#### **Use of local counsel and investigators**

When engaging in legal proceedings involving counterfeit products in Turkey, it is essential to make use of specialised local counsel and investigators who are familiar with the local legal rules and experienced in IP matters. This can help to ensure that the relevant processes are dealt with efficiently.

In regard to local investigators, it is vital to exercise control over the investigative activities to an extent, either directly or through local counsel. Turkey has no legislation on private investigators and, under the Constitution and the Criminal Code, privacy is protected as an absolute right. Further, any evidence to be used by public prosecutors and judges in criminal



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matters should be acceptable before the court. Thus, every action taken by a local investigator should be controlled to ensure its validity.

### Licensing to third parties

A rights holder must ensure that it has adequate controls in place for any contractual partners, as this will help to reduce the likelihood of infringement during the contract and following its termination.

### Effective use of technology, authentication and monitoring

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

### Cooperation with national anti-counterfeiting agencies

The police regularly carry out raids to enforce intellectual and industrial property rights, as well as ongoing training for staff. However, counterfeiting is not dealt with in the context of the fight against organised crime and, given the extent of the problem, the capacity of the law enforcement agencies is insufficient. As a result, counterfeiters control a substantial share of the Turkish market for music and films.

Ongoing contact and cooperation with the police can be a determining factor in achieving success in the fight against

counterfeiters. As almost one-third of fake products are purchased from street vendors and another third from street markets, cooperation with the municipal police is crucial.

The Department for Intellectual Property Rights within the Security Department of the police deals mainly with applications for search warrants based on IP rights. To date, branches of the Department for Intellectual Property Rights have been established in Istanbul, Ankara, Izmir, Bursa, Samsun, Adana and Diyarbakir, and are likely to expand to other cities if the need arises. **WTR**

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