

The Criminal Court of Ankara of Intellectual and Industrial Rights instituted a request before the Constitutional Court for the cancellation of Article no. 9/1(b), 9/2 (b), 61 (a) and 61 (c)¹ of the Decree Law no.556 on the Protection of Trademarks on grounds that the content of a penal provision should be clear and understandable by the public without getting a legal assistance, that a provision regulating a criminal sanction shall be established through an Act of Parliament, that the principle of proportion of the sanction shall be in line with criminality punishable act and that the sanction arising from civil responsibility is different than the sanction arising from criminal responsibility.

The Criminal Court of Ankara of Intellectual and Industrial Rights claimed that the content of the sanction has been regulated through a Code, the definition of the infringing act (the material element of the criminal act) has been set in the Article 9 of the Decree Law, that the Article 61/A 1b and 2b of the Decree Law are not as of nature of being understandable and clear, that the determination of the infringing character of the act shall be evaluated upon civil court action, that the sanction arising from the civil responsibility is different than the sanction arising from the criminal responsibility, that an *inter partes* trial shall be instituted for the determination of “risk of confusion between trademarks” and “the well-known character of a trademark” and that the punishments issued upon a criminal act are rather considerable in the view of the principle of proportionability of Criminal Law.

The Constitutional Court held that the principle of State of Law has a constitutional character, that fundamental rights and liberty should be protected with Criminal Code, that the provisions for the criminal sanctions shall be regulated with a Code (not a Decree Law), that such regulation is a constitutional necessity, that Law maker must consider basic principles of being a State of Law, that sanction arising from the civil responsibility is different than the sanction arising from the criminal responsibility, that especially the penal provisions shall be understandable and clear for the public without having the necessity for appointing an attorney, the determination of act and the definition of the infringing act (the material element of the criminal act) shall be regulated through an Act of Parliament . The Constitutional Court further held that the sanctions are in line with the infringing acts.

¹ Article 9/1 (b): *The proprietor of a trademark shall be entitled to prevent all third parties not having his consent from using the trademark under the situations described hereunder: “use of any sign where, because of its identity with or similarity to the registered trademark and identity or similarity of the goods or services covered by the registered trademark and sign, there exists a likelihood of confusion on the part of the public including the likelihood of association between the sign and the trademark”*

Article 9/2 (b): The following may be prohibited according to the first paragraph, offering the goods, putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder,

Article 61 (a): Following act shall be considered infringement of a trademark:

- a) violations of Article 9,
- c) selling, distributing or putting in commerce under any form or importing for these purposes or keeping in possession for commercial purposes the goods carrying the infringed trademark where the person concerned knows or should know that a trademark is infringed by using the same or a confusingly similar mark

The Constitutional Court has accepted the request and decided the cancellation of Articles 9/1(b), 9/2 (b), 61 (a) and 61 (c) of the Decree Law no.556².

² Criminal Court of Ankara vs. Constitutional Court, Case No.2005/15, Decision no.2008/2 (July 5, 2008). The decision will be effective as from 05.01.2009.