



Trademarks

in 43 jurisdictions worldwide

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1 Ownership of marks

Who may apply?

Persons entitled to protection of their trademarks and service marks and thereby qualified to obtain trademark registration are natural or legal persons who are domiciled or who have industrial or commercial establishments within the territory of the Republic of Turkey, or persons entitled to apply according to the provisions of the Paris Convention or the TRIPs Agreement.

On the other hand, persons, other than those mentioned above, who are nationals of states that provide legal or de facto protection to Turkish nationals shall enjoy, according to the principle of reciprocity, trademark protection in Turkey.

2 Scope of trademark

What may and may not be protected and registered as a trademark?

According to article 5 of Decree Law No. 556 on the Protection of Trade and Service Marks, any kind of signs such as words (including personal names) designs, letters, numbers, as well as product shapes and packages, are registrable provided that they are distinctive and are capable of being represented graphically.

The definition of a trademark contained in Decree Law No. 556 is quite broad – the formulation is almost identical to article 2 of the EC Trademark Directive – and there is no numerus clausus as to the kind of sign that may be registered as a trademark. Therefore, theoretically at least, the law does not restrict the registrability of non-conventional marks such as two- or three-dimensional designs, colours, sounds, scents, holograms and animations. In practice, although three-dimensional or slogan marks may be registered, a single colour, whether in abstract or represented in the picture of a two- or three-dimensional object, is not generally registrable according to the established jurisprudence of the Supreme Court. However, it should be noted that the first sound trademark and the first abstract single colour trademark have just achieved registration on June 2008 and August 2008 respectively. Questions about whether other types of non-conventional trademarks are registrable have not yet arisen at an administrative or judicial level.

Signs that cannot be registered on absolute grounds are listed in article 7 of Decree Law No. 556, as follows:

- signs that are devoid of distinctive character;
- signs that are identical or indistinguishable from any prior trademark application or registration covering identical or indistinguishable goods or services (please see question 5);
- signs that serve in trade to indicate the type, characteristics quality, quantity, intended purpose, value, geographical origin of goods or services, or designate the time of production of goods or of provision of services or other characteristics of goods or services (descriptive signs);

- signs used to distinguish specific groups of craftsmen, professions or tradesmen or that have become customary in the current and established practices of the trade (descriptive signs);
- signs giving substantial value or its shape to the product, which shape is a result of the nature of the concerned product or is conditioned by the necessity of obtaining a given technical result;
- signs that are of such a nature as to deceive the public, such as to the nature, quality, place of production or geographical origin of the goods and services;
- signs that are confusingly similar to well-known trademark in the sense of article 6bis of the Paris Convention applied without the prior authorisation of the holder of that trademark;
- signs that refer to religious symbols and values;
- signs that are contrary to public order and to accepted principles of morality; and
- signs in the sense of the first, second and fourth bullet points can be eligible for trademark protection, provided that they have acquired distinctive character in respect of the goods or services for which they are to be registered as of the use made thereof prior to the date of application – according to practice, the prior use should rather be a local use.

On the other hand, apart from ordinary trade and service marks, the trademark law allows registration of guarantee (certification) marks and collective marks for goods and services.

3 Obtaining a trademark

How long does it typically take, and how much does it typically cost to obtain a trademark registration?

The registration of a straightforward trademark application – provided there is no (ex-officio) rejection or (third-party) opposition – may take on average 12 to 15 months.

Upon application, the trademark application is first examined by the Turkish Patent Institute (TPI) for approximately six to eight months within the framework of the absolute grounds for refusal.

In the absence of an ex officio rejection, the trademark will be deemed qualified for registration and will then be published in the Official Trademark Bulletin for the purposes of opposition by third parties. The three-month opposition period runs from the date of the publication in the Bulletin.

After the opposition period, the TPI will require the completion of the registration formalities, such as the payment of the registration fees and submission of outstanding documents, if any, within two months. The registration certificate is issued within three months following the completion of the registration formalities.

Attorneys' and official fees of the application and the registration of a problem-free trademark covering one class amount to €970, and approximately €215 is to be expected for each additional class.

The examination period of the TPI may be shortened even upon payment of an additional official fee, neither on first examination nor on an appeal phase.

4 Classification system

What classification system is followed, and what goods or services may be claimed?

The International Nice Classification System has applied in Turkey since 1995. Currently the ninth edition of the Nice Classification applies in respect of the goods and services for trademark or service mark registration purposes.

Upon ratification of the Nice Classification system, the TPI prepared a national subclassification system on the basis of the Nice Classification. According to the system, the Nice classes are divided into several sub-classes each of which are composed of the list of 'indistinguishably' (please see question 5) similar goods or services.

On the other hand, even though an application can be filed under the Nice class headings, the TPI may request that the general headings be specified under the national subclass headings, the use of which is strongly recommended for this very reason.

5 Conflicts with other trademarks

Are applications examined for conflicts with other trademarks? What is the procedure followed in the Trademark Office?

During the ex officio examination phase on absolute grounds, the TPI examines whether the trademark applied for is in conflict with prior applications or registrations.

In this regard, according to the provisions of article 7/1(b) of Decree Law No. 556, trademarks will be rejected if they are 'identical or indistinguishably similar to a trademark that has been registered or for which a registration application has been made in connection with goods or services that are identical or indistinguishable'.

To be able to determine 'indistinguishably' similar goods or services, the TPI uses the national subclassification system whereby only the goods or services listed in the same subclass are considered as identical or indistinguishable in the sense of absolute grounds for rejection.

The examiner in charge of the file will undertake a search through the TPI's database and will determine the prior trademarks that are identical or almost identical and covering the same class or classes. Once these marks are determined, the examiner rejects the application only for the goods or services falling within the same subclass as those of the prior trademarks.

6 Use of a trademark and registration

Does use of a trademark or service mark have to be claimed before a registration is granted? Does proof of use have to be submitted? If registration is granted without use, is there a time by which use must begin to maintain the registration?

According to trademark law and practice in Turkey, there is no obligation to claim the use of a mark before registration is granted. Furthermore, the submission of proof of use at the end of the grace period (five years) or during the renewal is not requested by the TPI.

According to Decree Law No. 556, if, within a period of five years following registration, the trademark has not been put to use without a justifiable or legitimate reason, or if use has been suspended for five uninterrupted years, the trademark shall be repealed.

However, trademark registration is not automatically invalidated if a mark is not used at the end of the grace period but will be vulnerable to cancellation through a court action on the ground of non-use within the statutory period. The cancellation due to non-use is not within the remit of the TPI and therefore cannot be requested from its end.

7 Appealing a denied application

Is there an appeal process if the application is denied?

If the application is held not to be registrable and is refused on absolute grounds during the ex officio examination phase, it is possible to lodge an objection against the refusal before the Higher Council of Examination and Evaluation (the TPI's appeal body) within two months (this period may not be extended) of notification of that decision.

The Higher Council will re-examine the application and issue its final decision on the objection approximately 10 to 14 months after the objection is lodged. In the event that the Higher Council accepts the objection, the application will be published for opposition purposes. Where the objection is denied and the decision of refusal upheld, a cancellation action against the final decision of refusal may be instituted before the Specialised Ankara Court of Intellectual and Industrial Property Rights.

8 Third parties

May a third party oppose registration or seek cancellation of a trademark or service mark? What are the procedures?

Third parties may oppose a trademark application during the three months following publication in the Official Trademark Bulletin.

An opposition may be filed on the basis of absolute grounds for refusal (see question 2) and or relative grounds for refusal that are set forth in article 8 of Decree Law No. 556, namely:

- the trademark is identical to a prior trademark covering identical goods or services;
- the trademark is similar to a prior trademark covering similar goods or services and there is likelihood of confusion resulting from the similarities;
- the trademark is filed by an agent or a representative of the proprietor of the trademark in his or her own name without the proprietor's consent and without a valid justification;
- a trademark is identical or similar to a prior trademark covering different goods or services but the prior mark has a reputation and, owing to this reputation, the use without due cause of the trademark applied for would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the prior trademark;
- the right to the sign, whether non-registered trademark or another sign used in trade, is acquired prior to the date of filing of the trademark;
- the trademark contains the personal name, photograph, copy-right, or any industrial property rights of third parties;
- the trademark is identical or similar to a collective or a guarantee mark and three years from the date of expiry of the collective or of the guarantee mark have not passed; or
- the trademark is identical or similar to a prior trademark covering identical or similar goods or services, and two years from the date of expiry registration owing to non-renewal have not yet passed.

The opposition should be in writing and must indicate the grounds on which it is based.

Upon admission of the opposition, the TPI may notify the applicant of the opposition by inviting him or her to submit observations. The applicant is not required to file a counterstatement and failure to do so will not adversely affect its rights to object to the decision of the TPI.

The TPI will then decide within approximately six to eight months whether to refuse or accept the opposition. The decision on the opposition may be appealed by either or both the applicant or the opponent through an administrative appeal procedure before the Higher Council within two months.

The Higher Council will re-examine the opposition and issue its definitive decision approximately six to eight months after the appeal is filed.

The parties that are not satisfied by the final decision of the Higher Council may institute an action against this decision within two months of notification of the decision before the Specialised Ankara Court of Intellectual and Industrial Property Rights. However, in cases where the Higher Council rejects the opposition, the application will mature into registration despite an eventual ongoing court action against the TPI.

9 Duration and maintenance of registration

How long does a registration last and what is required to maintain a registration?

A Turkish trademark registration is valid for 10 years from the application date and may be indefinitely renewed for consecutive 10-year periods. The renewals may be filed within the six months prior to the expiration of the 10-year period or during the six months following the expiration of the registration by the payment of a fee.

It is not required to submit proof of use upon renewal.

10 The benefits of registration

What are the benefits of registration?

According to article 6 of Decree Law No. 556, trademark protection is obtained through registration only – that is to say that the registration is constitutive of the right. Therefore, in general, it is necessary to obtain a registration in order to benefit from the protection of the Trademark Law in Turkey.

The law, however, provides two exceptions to this principle whereby it is possible to oppose or institute a cancellation action without registration against an identical or similar registered trademark on the basis of article 42 of Decree Law No. 556, which provides that:

- by virtue of article 8 paragraph 3 of Decree Law No. 556, the proprietor of a non-registered trademark may petition the court to invalidate a registration provided that the rights to the sign were acquired prior to the date of the registration; or
- by virtue of article 7(i) of Decree Law No. 556, owners of well-known trademarks in the sense of article 6bis of the Paris Convention may also may petition the court.

In practice, the TPI, the courts (or both) require that longstanding prior use in Turkey or notoriety with the Turkish consumer, together with worldwide use and reputation, be evidenced substantially on a documentary basis.

11 Assignment

What can be assigned? Trademark with goodwill? Without goodwill? All or some of the goods and services? Must other business assets be assigned to make it a valid transaction?

In accordance with article 16 of Decree Law No. 556, a trademark may be assigned with or without goodwill. The law is silent on the assignment with goodwill or the assignment of the whole business to which it belongs. Accordingly, it is also not mandatory to assign other business assets simultaneously with the trademark and a trademark may be independently assigned to another legal entity. The only restriction in respect of the assignment of a trademark is ruled in article 16 of Decree Law No. 556, according to which trademarks identical to and indistinguishable from the trademark to be assigned, covering overlapping goods or services (according to the national subclassification system), shall be assigned together to the same assignee in order to avoid any confusion of the consumer as to the source and manufacturer or provider of the goods or services.

A trademark may be assigned totally or for a specific group of goods or services. It is important to assign similar and connected

goods, taking into account the nationally applied subclassification system.

There is no time period to be respected for the recordal of the assignment before the Turkish Patent Institute.

12 Assignment documentation

What documents are required?

A deed of assignment is required, containing at least the trademark and the application or registration number of the trademark to be assigned, executed by both the assignor and assignee. The deed also needs to be notarially certified in terms of the authority of the person or persons executing the deed in the capacity of the assignee or assignor party. In the event of a partial assignment, the deed needs also to comprise the specification of goods or services of the trademark or trademarks to be assigned. A power of attorney, simply signed in the name of the assignee, is also required.

It is advisable to also submit the original registration certificate, or renewal certificate of the trademark, in order to have the recordal of assignment endorsed thereon. In the absence of the certificate, the assignment is still completed, with the issuance of an administrative letter by the administration notifying the completion of the assignment.

13 Validity of assignment

Must the assignment be recorded for validity?

The recordal of an assignment is not a condition for the validity of the assignment, which carries legal effect between the parties even if it is not recorded. However, the recordal of the assignment will ensure the legal effect of the agreement against third parties in good faith, as in such case the recordal of assignment is published in the Official Trademark Gazette.

In the event of any infringement of the trademark after the assignment, the court action may only be instituted in the name of registered owner. Also, any opposition procedure against a similar trademark may be lodged in the name of the registered owner of the trademark.

14 Security interests

Are security interests recognised?

It is possible to record security interests on a trademark – independently of the undertaking – with the TPI at the request of one of the parties; the placing of security shall be entered in the register and published, whereas the levy of execution is ex officio published in the Official Trademark Bulletin.

15 Markings

What words or symbols can be used to indicate trademark use or registration? Do these words or symbols have to be used? What are the benefits of using them and the risks of not using them?

The marking of the articles or the packaging for which the concerned trademark is registered is not mandatory since Decree Law No. 556 contains no provisions pertaining to marking requirements. It is, however, still highly advisable to do so as in case of litigation; the marking could constitute the basis of a further claim of unfair competition since the marking of goods or services with signs, trademarks or other rights and titles not owned by the third parties using them on their products is an act of unfair competition according to the general unfair competition provisions of the Turkish Code of Commerce.

It is to be noted that the © sign is widely used in Turkey to indicate a trademark registered in this country. Accordingly, this sign can certainly be used to indicate that a trademark is registered in

this country and under protection as a registered trademark. Please further note that the sign TM standing for *tescilli marka* (registered trademark) is also extensively used in Turkey to designate a registered trademark.

However, the abbreviation ‘TM’ is used also for designating the term *Türk Mali* (made in Turkey). For these reasons we believe it is improper to use the initials ‘TM’ for designating unregistered trademarks in Turkey in the belief that the consumers will understand it as indicating a trademark as being owned but not registered.

16 Trademark enforcement proceedings

What types of legal or administrative proceedings are available to enforce trademark rights against an infringer, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark enforcement?

It is possible to enforce trademark rights against an infringer through civil and criminal proceedings and the suspension of release proceedings before the customs authorities.

Civil actions for trademark infringement are to be filed before the specialised civil courts for intellectual and industrial rights in the cities where they are established, namely Istanbul, Ankara and Izmir. In other Turkish cities, the third criminal or civil court will operate as the specialised court for IP matters. In the scope of this action, it is possible to request an interlocutory injunction to stop the infringing acts and seize the counterfeit products

There is no provision regarding trademark infringement in the Turkish Criminal Code. However, according to the new article 61A of the Turkish Decree Law No. 556 set by the Law No. 5,194 on 26 June 2004, trademark infringement is also a criminal offence to be prosecuted upon request of the rights-holder before the public prosecutor.

The customs authorities can also act *ex officio* in the prevention of probable trademark infringement by importation or exportation of the counterfeit goods or upon request of the rights-holder. However, failure to institute a court action before, and obtaining injunctive relief from, the specialised court for intellectual and industrial rights within 10 days of the notification of the suspension decision of customs authorities, will result in the release of the goods.

Since, presently, there is no central recordal registry with the Customs, the application for customs monitoring shall be separately filed with regard to each of the Customs offices where the counterfeiting goods will probably pass or have reached. Moreover, such applications for customs monitoring are valid only for 30 days as of their filing and are to be renewed thereafter.

17 Procedural format and timing

What is the format of the infringement proceeding? Is discovery allowed? Live testimony? Experts? Who decides the case? How long does the proceeding typically last? If there is a criminal enforcement mechanism, what is that procedure?

Proceedings are initiated by filing the writ of summons including all the claims of the plaintiff to the court, which is notified to the defendant. According to the Turkish Civil Procedural Law, the period set for replying to an action and for instituting any counteraction is 10 days from the notification date of the action to the defendant unless an extension is requested within the same period. The courts regularly accept such requests and extend the deadline.

The second stage of proceedings is the filing of the evidence supporting the claims of the parties to the court. Although the parties may request the court to refer to the live testimony of a witness, it is at the court’s discretion whether it accepts such a request.

One particular characteristic of the civil and criminal proceedings, so far, despite the establishment of the specialised courts on intellectual property, is the overreliance by the courts on expert opinions rendered by expert or panel of experts appointed by the court to report on matters such as determination of infringement, similarity, dilution, bad faith, damages or compensation, etc.

Neither Decree Law No. 556 nor the procedural legislation provides and organises discovery as such. Instead, before instituting the infringement actions, the determination of evidence relating to the infringing acts of the adverse party may be requested by filing a non-adversarial action to determine evidence or facts as to the existence of a situation on the basis of the elements of proof submitted by the plaintiff to the court. Within this context, it is possible to file an action for the declaration of non-infringement for determining that a given act or situation does not constitute an act of trademark infringement.

A trademark infringement action will typically last 18 to 24 months up to a first-instance decision, where the appeal phase before the Supreme Court will then take approximately 12 to 18 months.

However, the length of an enforcement action may be affected by the following factors:

- the workload of the competent court of jurisdiction and the intervals between the hearings; and
- in cases where the defendant is not domiciled in Turkey, the notification of the action through diplomatic channels may take at least six months; and
- the parties are entitled to file their objections to the conclusions of the experts and it is at the court’s discretion to refer back to the experts to establish an additional report, which will obviously lengthen the proceedings.

Criminal proceedings are triggered by a complaint filed before the public prosecutor who, if convinced of the infringement, will refer the complaint to the competent criminal court, which will order a police raid for seizure of the counterfeit goods. Provided that the police raid results in the seizure of counterfeit goods, the public prosecutor may directly institute the criminal action before the criminal court. It should be stressed that the criminal action is a public action and the trademark owner can only be joined to such an action.

18 Burden of proof

What is the burden of proof to establish infringement or dilution?

Article 61 of Decree Law No. 556 determines the different acts that are considered trademark infringement, including the dilution of a trademark. Accordingly, the burden of proof, which as a general rule rests with the plaintiff, varies depending on the nature of the infringing act and the elements of the tort forming each infringing act.

In the case of an infringement action, it is generally necessary to provide the court with documentation evidencing the existence of the trademark right and of the infringing acts of the defendant. Where the infringing act consists of counterfeiting, samples of fake products and the documents attesting their link with the defendant, as well as a sample of the genuine product, are to be submitted to the court.

In cases of dilution where according to article 8, paragraph 4 of Decree Law No. 556, the elements of tort consist of ‘reputation’, ‘unfair advantage’, ‘harm to distinctive character’ and ‘harm to reputation’; in practice, it is mainly required to evidence the notoriety of the infringed trademark. The notoriety of a trademark is to be evidenced on the basis of the list of criteria established by the TPI. The registration of the trademark as a well-known trademark before the TPI may be of determining importance.

There is no established jurisprudence as to how the other elements of tort are to be evidenced in case of dilution. The courts

usually consider these elements upon evidence of the notoriety of a trademark and on the basis of the particulars of each case.

However, the bad faith of the applicant constitutes valuable evidence in attesting the intention to take unfair advantage of reputation. According to the settled case law, the Supreme Court considers that a merchant shall act with professional diligence and care in accordance with the provisions of the Turkish Code of Commerce; it also states that a merchant should have to be aware of any well-known trademarks and all developments in his or her area of business, and that a merchant cannot justify the filing of a well-known trademark by putting forward that he or she was not aware of the existence of such trademark.

It is important to further note that article 65 of Decree Law No. 556 provides an exception to the general principle according to which the burden of proof rests with the plaintiff in that 'the proprietor of a trademark can request from the infringing party the documents related with the use without his consent of the trademark, for the evaluation of the damage suffered resulting from the infringement of the trademark'.

19 Standing

Who may seek a remedy and under what conditions? Who has standing to bring a criminal complaint?

According to article 9 of Decree Law No. 556, the proprietor of a trademark shall be entitled to prevent all third parties not having its consent from using the trademark. Additionally, according to article 21, unless provided otherwise by the contract, the holder of an exclusive licence may, in the case of an infringement of the trademark rights, institute in its own name all legal proceedings that have been made available to the proprietor of the trademark by this Decree Law.

Holders of non-exclusive licences do not have the right to institute legal proceedings. In the case of an infringement, the holder of a (non-exclusive) licence, not having the right to institute proceedings according to paragraph 6, may give notice through a notary public, requesting the trademark owner to institute such proceedings as required. If the owner refuses to initiate or within three months of receipt of the notice fails to institute proceedings, the (non-exclusive) licence holder shall have the right to institute proceedings in his or her own name, by enclosing a notice (to the proprietor) in this regard. The licensee may, in the face of likelihood of serious damages (where elapsing of time cannot be remedied), request the court to issue an injunction for precautionary measures without waiting until the elapsing of the three-month period. The licensee who has instituted proceedings shall notify the proprietor of the trademark that the proceedings have been instituted.

Accordingly, the right to institute the civil and criminal action belongs to the person whose trademark right has been infringed and to the holder of an exclusive licence who is entitled to institute all legal proceedings available under the Turkish Trademark Act and the holder of a non-exclusive licence under special circumstances referred to above.

Additionally, a criminal action may be initiated upon a complaint filed by the TPI or by consumer associations and other bodies such as the Chamber of Commerce and Industry, Chamber of Commerce, the Union of Chambers and Commodity Exchange of Turkey and the Tradesmen and Artisans Association under specific conditions. These include false declarations with respect to the identity of the trademark-holder, of using to the same effect writings, signs or expressions in advertisements and commercials in published and visual media without being the rightful proprietor of the trademark, or after the expiry of the protection term or after the invalidation of the trademark right or after the termination of the trademark right.

20 Foreign activities

Can activities that take place outside the country support a charge of infringement or dilution?

Activities that take place outside the country may not constitute the basis of the infringement or dilution action, but can certainly support such action whether in view of the determination of notoriety or the bad faith of the infringer.

21 Discovery

What discovery devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

As already mentioned in question 17, Turkish trademark and procedural legislation does not provide or organise discovery devices and procedures as such.

Considering that neither does Turkish legislation provide a remedy along the lines of *saisie description* as exists in France for determining and evidencing the infringement in situ, the only remedy available is the action in determination of evidence or fact (*action en constatation, Feststellungsklage*), or negatively, the action for the declaration of non-infringement.

Before instituting the aforementioned main infringement action, the determination of evidence relating to the infringing acts of the opposing party may be requested by filing a specific action in determination of evidence. Within this context, the court would refer the case to the experts for the establishment of a report, which, if affirmative, would serve as evidence within the context of the trademark infringement caused by the opposing party. The court may ask the experts to visit the premises of the infringing party to determine the infringement on site.

Moreover, the police raid that is ordered in the scope of the criminal proceeding provides the possibility of collecting evidence confirming the infringement.

22 Timing

What is the typical time frame for an infringement or dilution action, at the trial level and on appeal?

The time frame for the preparation of a trial for infringement, including the gathering of the necessary information and documentary evidence and the preparation of the initial petition, may vary from a few days to a few months depending on the circumstances and complexity of the case and the availability of the evidence proving the infringement.

The preparation of a dilution action where the information and documents on the notoriety are to be examined and evaluated in advance to determine the chances of success of an action will take at least a month.

Where interlocutory injunctions are required and therefore the supporting documents shall be submitted with the initial petition along with their notarised translations, the time frame for the preparation of the trial may be extended.

The decision of the specialised civil court is not to be expected before 18 to 24 months as of the institution of the action depending on the number of petitions exchanged, the number of experts' reports issued, etc, whereby in case of an appeal before the Supreme Court, another 12 to 18 months is to be considered.

Likewise, the criminal action instituted by the public prosecutor is to be judged within two years of its institution but unlike civil proceedings, previous experience has shown that appeals before the Criminal Chamber of the Supreme Court are not finalised in less than two years.

23 Litigation costs

What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

The typical official costs associated with an infringement (civil) action are:

- Official court fees: the level of these fees depends on the level of the compensation claimed. Please note that 1.35 per cent of the compensation claimed is to be paid to the court as an official fee with the filing of the action
- Expert's fees: these are paid directly to the court and depend on the number of experts nominated by the court. Typically the judge will appoint three experts and the costs would be around 400 new Turkish liras (approximately US\$330) per expert.
- The guarantee payment: the injunctive measures are obtained against a guarantee payment determined by the court at its discretion. It is unfortunately not possible to provide even a rough estimate as the level of the guarantee is directly linked to the possible damages that the defendant may be confronted with. Should the action end in favour of the plaintiff, the guarantee will be released or reimbursed
- Translation and legalisation costs: the supporting documents which are in foreign language shall be submitted to the court together with the notarially legalised Turkish translations
- Attorneys' fees: according to general practice, attorneys' fees in relation to trademark enforcement matters are usually quoted on an hourly basis. Therefore, the attorney fees of a trademark infringement action would greatly depend on the complexity of the subject matter. The attorney cost in a straightforward infringement case would vary between €10,000 to €15,000 up to the first-instance decision and €3,000 to €5,000 for the appeal phase.

24 Appeals

What avenues of appeal are available?

The first-instance decisions of the civil courts concerning trademark infringement and unfair competition, the cancellation of a trademark and the withdrawal of a TPI decision may be appealed to the Supreme Court within 15 days of the notification of the court's decision to the parties. Upon the Supreme Court's decision, the dissatisfied party may request further reconsideration by the Supreme Court within 15 days of the notification of the decision.

Likewise, decisions of the criminal courts concerning the trademark infringement can be appealed before the Supreme Court within seven days of the last hearing wherein the judgment is given.

25 Defences

What defences are available to a charge of infringement or dilution?

In actions concerning similarity, the defendants may argue the dissimilarity of the trademarks or the dissimilarity of the goods covered by the trademarks. In actions based on the notoriety and dilution, where the plaintiff's trademark has not been previously recognised as a well-known trademark either by the TPI or a Turkish court, the defendant can argue that the plaintiff's trademark does not enjoy protection as a well-known mark and may request that this be evidenced before the court.

In infringement actions, should the defendant own a registration for the conflicting trademark, it may ask the court to reject the claims for infringement or compensation in the view of its existing trademark registration since, as a settled practice, the court does not rule on infringement or compensation unless the defendant's registration is duly invalidated through a court action and decision.

If the plaintiff's trademark on which the action is based has not been used within the statutory five-year period, the defendant may ask the court to rule on the invalidation of the plaintiff's trademark by filing a counter-invalidation action.

In actions where the plaintiff institutes the action after a long period of silence, the defendant may claim that the plaintiff has instituted the action after the acquiescence period. The acquiescence period for the cancellation actions based on dilution is five years whereas this term is not applied if the defendant's registration has been obtained in bad faith. Neither the Decree Law nor the case law have specified an acquiescence period for actions instituted on the grounds remaining other than dilution; however, this term is to be determined according to the circumstances of each action.

26 Remedies

What remedies are available to a successful party in an action for infringement or dilution? How is monetary relief apportioned? Is injunctive relief available, preliminarily or permanently, and in what circumstances and under what conditions? What criminal remedies exist?

The owner of a trademark whose rights are infringed may request the following remedies from the court:

- the stopping of the infringing acts;
- compensation for material and moral damages incurred and for damages to the reputation of the trademark;
- confiscation of products, and related equipment and machinery;
- injunctive measures for preventing the continued infringement of rights, and the erasing of the trademark from the products and means or vehicles, or, where inevitable for the preclusion of acts of infringement, the destruction of the products; and
- publication of the verdict.

The plaintiff can ask for the following types of compensation:

- Moral damages may be requested if the infringer commits a heavy fault in the infringement. The court has a discretionary power in the assessment of such damages, it may award such damages or it may lessen the amount requested by the plaintiff.
- Material damages may also be requested. Material damages may be requested in accordance with one of the following criteria cited in Decree Law No. 556:
 - according to the income that the proprietor of the trademark might have possibly generated if the competition of the infringing party did not exist;
 - according to the income generated by the infringing party from the use of the trademark; or
 - according to a licence fee that would have been paid if the party infringing the trademark would have lawfully used the trademark under a licensing contract.
- The plaintiff may request extra damages where the reputation of the trademark is harmed owing to the bad or improper use of the trademark by the infringing party.

It is possible to request injunctive measures within the scope of the civil proceedings by evidencing the danger of (imminent) trademark infringement, which may cause substantial damages and by convincing the court that there is a high probability that such infringement will materialise. The courts are conservative and may refuse to grant injunctive measures and may request the deposition of a guarantee for ordering such injunctions. Injunctive measures may be requested before or simultaneously with the civil action. Should injunctive measures be requested before the institution of the civil action and the court favourably receive this request, the main civil action shall be instituted within 10 days of the date of the injunction order.

Otherwise, the order for will remain without effect. Please note that article 77 of Decree Law No. 556 provides that injunctive measures shall be capable of fully securing the effectiveness of the judgment, and particularly provides the following measures:

- stopping of the acts of infringement of the trademark rights of the plaintiff;
- injunction to seize within the borders of Turkey, wherever they are seen or found, including customs, free ports or free-trade areas, and to keep in judicial custody the goods produced or imported in infringement of trademark rights; and
- ordering the placement of security or a guarantee for damages for the compensation claimed

Injunctive measures can be ordered ab initio with the filing of the action or during the action to determine evidence and facts and if the defendant's objection is not accepted, the injunctive measures will have a permanent effect until the completion of the court action.

As trademark infringement is a criminal offence, in case of a legal prosecution, the infringer can be convicted with imprisonment from two to four years, pecuniary fines from 27,000 to 46,000 new Turkish liras (approximately €14,350 to €24,475), a ban from exercising professional trade activity for one year or the closure of the infringer's premises for one year. Any seized counterfeit items can be confiscated or destroyed by the court at the end of the criminal proceedings.

27 ADR

Are ADR techniques available and commonly used? What are the benefits and risks?

The Turkish legal system does not specifically legislate for ADR. However, the recent changes to the Turkish criminal courts have brought the obligation on the public prosecutors and criminal courts to invite the parties to settle during the criminal proceedings. The parties can reach a settlement at their own discretion because offences concerning the trademark infringement are subject to the rights-holder's complaint, which the rights-holder may withdraw at any stage of the proceedings.

Article 36 of Decree Law No. 556 provides the right to the TPI to invite the parties to settle during the opposition procedure by stating that the 'Institute, if it finds appropriate, may invite the parties to make a settlement'. Likewise, article 213 of the Civil Procedural Law also provides a right to judge to invite the parties to reach an amicable settlement. However, neither article is effectively applied in practice.

In this regard, it is important to also stress that article 35/A of the Attorneys Act provides counsel with the right to reach to a settlement before the institution of a civil action or before the first hearing in the case of an instituted action wherein the articles of the settlement agreement may be registered with the court and be enforceable as a court decision.

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