

Interim injunctions are an effective way to protect IP rights in Turkey but they can be hard to get. By **Okan Can** of **Deris Patents & Trade Mark Agency** and **Deris Law Firm**

# How to obtain an interlocutory injunction

**T**he Turkish legal system has greatly improved and extended the enforcement of IP rights, especially since the enactment in 1995 of an entirely new series of Decree Laws for the protection of patents, utility models, trade/service marks, industrial designs and geographical indications. In 2004, Turkey also introduced the Act for the Protection of Breeder's Rights for Plant Varieties and the Act for the Protection of Integrated Circuit (chip) Topographies. Turkey has harmonized its legislation not only with the European Community legislation but also with the international conventions of which Turkey is signatory, such as the Paris Convention, and the GATT and TRIPs Agreements.

Turkey has enacted a fully integrated and coherent body of industrial property legislation. Acts have parallel structures and provisions, particularly as to enforcement matters such as litigation procedure, jurisdiction, compensation, injunctive relief and border measures.

In compliance with the new Decree Laws and Acts, specialized criminal and civil courts of intellectual and industrial property rights have been established in the cities of Istanbul, Ankara and Izmir to hear cases in all IP matters, including enforcement. In the remaining cities of Turkey the Third Civil and Criminal Courts in each city have been determined to serve as the specialized court in all IP matters.

## Criminal proceedings

The Turkish IP legislation contains various criminal sanctions for violation of protected IP rights, such as imprisonment, pecuniary fines, a ban on exercising professional activities and closure of the infringer's premises.

Criminal proceedings are initiated upon a complaint filed with the Public Prosecutor by the IP rightholder. It is possible to request the seizure of counterfeit goods through a police raid and to institute criminal proceedings based on the unauthorized use of an IP right. Criminal action is usually instituted on the condition that counterfeits are found and seized on the premises during the police raid organized upon the Public Prosecutor's order.

## Action to determine evidence

Before the institution of the main civil action, a specific action for determination of evidence and facts can be instituted before the Specialized Court of Intellectual and Industrial Property Rights. It is a non-adversarial action that can be conducted *ex parte*. If the decision of the action is affirmative, it will serve as evidence within the context of the main civil/criminal action that follows. A request for interlocutory injunction can be made within the context of this specific action for determination of evidence and facts. The specialized courts are rather reluctant about these actions and refrain from accepting them unless there is a strong imminent risk of evidence being destroyed.

## Civil action

It is possible to directly institute a civil action (main action) before the Court of Intellectual and Industrial Property Rights. In civil proceedings it is possible to claim that infringing acts be stopped or compensation for damages and to request for an interlocutory injunction within the context of the action.

It usually takes about 14 to 24 months to obtain a verdict. So, it is of crucial importance for the plaintiff to take quick and effective measures at the beginning of or during the proceedings. The right to request interlocutory injunctions avoids the negative results that the plaintiff may encounter during such lengthy civil proceedings.

## Interlocutory injunctions

Turkey, like most jurisdictions, has empowered the civil courts to order preliminary or interlocutory injunctions within civil proceedings.

As a general provision, the Turkish Civil Procedural Law provides that the rightholder is entitled to ask for an interlocutory injunction order if there is an imminent threat of serious or irreparable damage.

Due to the importance of interlocutory injunctions in providing an effective and quick way to stop IP infringement, the Decree Laws for the protection of patents, utility models, trade/service marks, industrial designs and geographical indications contain a more detailed provision in this respect. It provides that:

"Interlocutory Injunctions shall be in nature to enable securing fully the effectiveness of the judgement and particularly provide the following measures:

- a) stopping of the acts of infringement of the trade mark rights of the plaintiff;
- b) injunction to seize within the borders of Turkey wherever they are seen/found, including Customs, free ports or free trade areas and keep in custody the goods produced or imported trade mark rights;
- c) ordering the placement of security/guarantee for damages to be compensated."

This provision also enables the rightholder to ask for an interlocutory injunction to secure the effectiveness of the judgment, to render the verdict fully enforceable at the end of the proceedings. Based on this provision, the rightholder can ask for a permanent injunction to stop the unauthorized use of IP rights in an advertisement or in any other promotional material, or in the sale, offer for sale, use, storage and import/export of counterfeits.

The rightholder is also entitled to ask the court to order the defendant to provide a guarantee during the proceedings to secure its compensation claim. This injunction request is specific only to IP rights infringements in Turkey. However, despite this legal provision, the courts are reluctant to order this type of injunction.

Turkish courts refuse outright requests for injunctive relief when the defendant holds a trade mark, industrial design or patent registration in its own name because, according to Supreme Court case law, the use of this registration is not deemed to be an infringement unless and until the registration is cancelled upon a court's decision. However, the plaintiff can ask the court to order the prevention of the assignment of the defendant's registration in the cancellation action to preserve the *status quo* until the action is finalized. The courts usually grant injunctions to prevent assignment to third parties, to avoid the action remaining without subject due to assignment of the subject registration in the course of the proceedings.

### Procedure

Interlocutory injunctions can be requested at the outset of the main civil action or at any time during the civil proceedings. The plaintiff must first prove the existence of its protected IP right and submit documents that show that risk is imminent and that a possible delay could cause irreparable damage. Upon the rightholder's application for an injunction order, the court is entitled to notify the defendant, to give them the opportunity to present their arguments by scheduling a hearing with a near date. In urgent cases, or where there is strong evidence that a defendant is acting in blatant bad faith and that they would destroy evidence, the interlocutory injunction order can also be rendered *ex parte*, without hearing the defendant at the beginning of the action. The defendant, regardless of whether the interlocutory injunction is granted *ex parte* or not, is entitled to object to the interlocutory injunction and can ask for the release of the injunction by submitting substantial evidence. The court, upon an objection, can release the interlocutory injunction with or without requesting the defendant to provide a guarantee.

Although the injunction order can be contested during the proceedings before the first instance court, cannot be appealed directly before the Supreme Court, unless the court of first instance renders its final decision on the matter.

Injunction orders can also be requested within the scope of the *ex parte* action in determination of evidence so that, if favourably received, the rightholder will institute the main civil action within 10 days of the interlocutory injunction decision being delivered. Failure to institute the action within 10 days results in the release of the interlocutory injunction.

The courts are known to be quite conservative in ordering injunctions even when all legal requirements seem to be met, as they have discretionary competence in the matter. If the court rejects the request for injunctive relief, the request can be renewed during the proceedings until the final decision.

### Guarantee

The courts also have discretion to order a guarantee to meet the possible damages a defendant could sustain due an unjustified interlocutory injunction. The guarantee amount depends on the circumstances of each action. However, in recent decisions the specialized courts have tended to request high amounts as a guarantee. The guarantee can either be deposited with the court or can be filed in the form of a bank guarantee letter. Under the Turkish Civil Procedural Law, the court can refuse to request a guarantee if there are is clear evidence as to the infringement and the bad faith of the defendant.

### Orders against moving counterfeits

The IP legislation in Turkey clearly provides the possibility to request interlocutory injunctions against counterfeit goods held in Customs, free ports and free trade areas bound for import or export. However, the case law with respect to the implementation

of this provision was not settled until 2004, due to debate as to whether the interlocutory injunctions would apply to transiting counterfeits or counterfeits within free trade zones.

The initial decision with respect to this matter was ruled in the matter of Bahman-branded cigarettes originating in Bulgaria, where the Bahman trade mark was registered in the name of the defendant, that were kept in the Mersin/Turkey free zone, where the Bahman trade mark was registered in the name of the plaintiff (11th Civil Chamber of the Supreme Court, Decision 1999/4928-1999/7026, September 23 1999). The court rejected the plaintiff's seizure request because the trade mark for Bahman was registered in the country of origin (Bulgaria), it was not possible to claim that the goods were purely counterfeit and because the plaintiff failed to prove that there was an attempt to import the goods from the free zones into Turkey. This decision was criticized in that allowing the trading of the transit passing counterfeits or allowing them to be kept in the free trade areas was not compatible with Turkey's obligations under the TRIPs Agreement. However, the Supreme Court changed its case law in a series of decisions (11th Civil Chamber of the Supreme Court Case 2003/13968 – Decision 2004/1201, February 13 2004) issued with respect to other counterfeit cigarette matters in 2004 and has clearly ruled that the provisions of the Decree Law 556 for the enforcement of the trade mark rights applies to the free zones areas, even in respect of transiting counterfeit goods. The court has stated that holding the counterfeit goods in the free zones area would constitute a trade mark infringement by referring to the doctrine and the provisions of the TRIPs Agreement, that is Articles 41, 46 and 51 and the obligations to avoid the distribution of counterfeits in local trade channels.

Case law has evolved to enable the rightholder to extend IP protection to cover transiting counterfeits or counterfeits that are kept in free zones area even if the infringer does not intend to distribute the goods through Turkish local trade channels.

### Goods before Customs

The suspension of release procedure is an effective measure to combat counterfeits both during their import and their export.

Turkey has not enacted a specific Act regarding border measures, but the IP legislation discussed above and the Customs Act 4458 (Article 57) include specific and parallel provisions for border measures, according to which the rightholder may ask the relevant Customs authorities to suspend the release of counterfeit or pirated goods bound for import or export. Customs is also empowered to *ex officio* suspend the formalities for the release of goods that are found or thought to be counterfeit or pirated during the routine Custom clearance formalities. In situations where the Customs suspends the release of the goods, whether upon the rightholder's application or *ex officio*, it is mandatory for the rightholder to institute an infringement action and/or obtain from an order for interlocutory injunction the court. Failure to institute the court action or obtain the judicial injunctive measure within 10 days from the notification of the Customs decision will result in the release of the goods from Customs' custody, as the suspension of release decision will cease to have effect.

### Useful, but tricky

Interlocutory injunction orders have so far been one of the most effective legal means for rightholders in civil proceedings, and can also have a compelling effect on the infringer to agree to a settlement. However, at the same time they are also challenging, as the courts have a wide discretion and the plaintiff will need to convince the court with substantial evidence that they are the rightholder and that they face imminent risk and/or irreparable harm.