

TÜRKIYE

Ahmet Akgülođlu, Gizem Akgülođlu, Zeliha Özpınar

(ATG Law Firm)

LEGAL FRAMEWORK

Domestic law

1. What is the primary legislation governing trademarks in your jurisdiction?

The Industrial Property Law (IP Law) numbered 6769 is the main legislation governing trademarks in Türkiye, with the Regulation on the Implementation of the IP Law (published on 24 April 2017) as the general secondary legislation for all industrial property rights, while national and international trademark applications filed before 10 January 2017, namely, the effective date of the IP Law, are examined in accordance with Trademark Decree-Law numbered 566, which was effective on the date of their application according to provisional article 1 of the IP Law.

International law

2. Which international trademark agreements has your jurisdiction signed?

Some of the main international trademark agreements to which Türkiye is a party are as follows:

- the Paris Convention for the Protection of Industrial Property of 1883;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS);
- the Madrid Protocol Relating to the Madrid Agreement (Madrid Agreement Concerning the International Registration of Marks of 1891) of 1989;

- the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks;
- the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks of 1973; and
- the Trademark Law Treaty (TLT).

Regulators

3. Which government bodies regulate trademark law?

The Turkish Grand National Assembly regulate trademark law in Türkiye. In addition, the Turkish Patent and Trademark Office (TPTO) has authorization to do so in line with the legal power given.

REGISTRATION AND USE

Ownership of marks

4. Who may apply for registration?

According to article 3 of the Industrial Property Law (IP Law), the following are entitled to trademark ownership:

- citizens of Türkiye;
- natural or legal persons who are domiciled or who have commercial establishments within the territory of Türkiye;
- persons who have application rights arising from the terms of the Paris Agreement and the Agreement Establishing the World Trade Organization dated 15 April 1994; and
- in line with reciprocity principles, nationals of states that provide industrial property rights to nationals of Türkiye.

Scope of trademark

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

According to article 4 of the IP Law, trademarks should distinguish one enterprise's goods and services from another's and should explicitly define the protections and rights granted to the trademark owner by being registered.

Trademarks can include names of persons, other words, colors, figures (including 3D figures), motions, symbols, letters, numbers, sounds and packaging. In addition, the IP Law defines the registration of guarantee marks and joint marks. Though it is not clear whether smells can be registered in Türkiye, the Turkish Patent and Trademark Office (TPTO) indicates in their guide that these types of marks do not meet the criteria for being a trademark.

Article 5 of the IP Law defines signs and symbols that cannot be registered as trademarks:

- signs which are not distinctive;
- signs that provide the type, kind, qualification, amount, purpose, value or geographical source, that provide the time of production of the goods or the time when the service is provided, or signs that include other qualifications of the goods or services exclusively or as their essential part;
- trademarks that consist exclusively of signs or indications that serve in trade to indicate the kind, characteristics, quality, intended purpose, value or geographical origin, or designate the time of production of the goods or of rendering of the service or other characteristics of goods or services;
- signs that exclusively or as a main element include signs and names that are generally used by all in the trade or that distinguish those that are subject to a specific profession, art or trade group;
- signs containing the shape of the product resulting from the nature of the

product, which is necessary to obtain a technical result or which gives substantial value to the product;

- signs that will confuse the public regarding the qualification, quality and geographical source of the goods and services, place of production or geographical origin of the goods and services;
- signs that are to be refused pursuant to article 6-bis-2 of the Paris Convention;
- trademarks containing badges, emblems or escutcheons other than those covered by article 6-bis-2 of the Paris Convention that have not been authorized by the competent authorities and are of particular historical and cultural public interest;
- signs that contain religious symbols;
- signs that are contrary to public order and morality; and
- signs that consist of or include registered geographical indications.

Unregistered trademarks

6. Can trademark rights be established without registration?

Trademark protection provided by the IP Law can only be acquired through registration. In other words, the trademark ownership is determined on a first-to-use basis. However, a trademark must be registered in Türkiye or must be published in the Official Trademark Bulletin if it is not registered yet to enjoy the protection provided by the IP Law, with some exceptions like provisions regarding real right of ownership or bad faith. It is possible for the unregistered trademark owner to file an opposition against third-party applications before the TPTO based on real right of ownership, bad faith and other applicable provisions as well as claiming the invalidation of the trademarks. In addition, trademark infringements against non-registered

trademarks are protected under the Turkish Commercial Code by articles regulating unfair competition.

Famous foreign trademarks

7. Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What proof is required? What protection is provided?

The IP Law protects well-known trademarks in the context of article 6-bis-1 of the Paris Convention even if the trademarks are not put into use or registered in Türkiye. Such protection has been regulated as a relative ground for refusal in subsection 4 of article 6 of the IP Law.

Moreover, there is a record of well-known trademarks established by the TPTO although there is a court decision stating that the TPTO is not entitled to do so, and registration in this record is made according to the standards of the WIPO Committee of Experts. However, registration in the record does not constitute absolute proof of the trademark's well-known status, although it is considered important evidence.

To benefit from the protection regulated under article 6-bis-1 of the Paris Convention, the following must be proved:

- how long and where the trademark has been in use;
- distribution of countries around the world where the trademark is registered;
- distinctive features of the trademark; and
- promotion activities and market share in related sectors.

In addition, the owners of a famous foreign trademark may challenge a copy of their trademarks based on the article related to bad faith, without having a registration or using their trademark in Türkiye.

The benefits of registration

8. What are the benefits of registration?

A trademark must be registered in Türkiye or application of a trademark must be published in the Official Trademark Bulletin if it is not registered yet to enjoy the protection provided by the IP Law. There are, however, some exceptions, such as the provisions regarding real right of ownership or bad faith. In these exceptional situations, it becomes crucial to prove the claims, which can be quite difficult compared to having a trademark registration certificate. Besides, although trademark infringements against non-registered trademarks are protected under the Turkish Commercial Code by articles regulating unfair competition, the commercial courts would hear such cases, instead of specialized IP Courts. Moreover, to take legal action against trademark infringement based on the criminal provisions of the IP Law, apart from the above-mentioned benefits of a civil lawsuit, the registration of trademarks is obligatory. Apart from these, registration of IP rights before the General Customs Directorate for border enforcement mechanisms is only available for trademarks registered before the TPTO.

Filing procedure and documentation

9. What documentation is needed to file a trademark application?

What rules govern the representation of the mark in the application? Is electronic filing available? Are trademark searches available or required before filing? If so, what procedures and fees apply?

It is not required to submit a power of attorney document during the application process. Accordingly, additional document submission is not required.

The representation of the trademark application must clearly and precisely display the subject matter of the protection. If the trademark contains any logo or device element, a sample of the logo in jpeg, 591 x 591 pixels and 300 DPI format must be submitted to the TPTO. For word marks without a logo, it is

sufficient to specify only the word in the application.

Trademark applications must be filed electronically before the TPTO..

Trademark searches are not required and can be optionally conducted before filing. The TPTO can conduct trademark searches through its affiliated company, TÜRKSMİD, both for word marks and device marks. Fees for a search of one word in one class is 920 Turkish liras, 1380 Turkish liras for the second class and 460 Turkish liras for each additional class as from the third class, excluding taxes. Alternatively, third-party databases can also be used for trademark searches by trademark professionals.

Registration time frame and cost

10. How long does it typically take, and how much does it typically cost, to obtain a trademark registration? When does registration formally come into effect? What circumstances would increase the estimated time and cost of filing a trademark application and receiving a registration?

The period of trademark registration begins with the application for registration and ends with the issuance of the registration document. Accordingly, the average trademark registration may take up to six to nine months, in cases of a smooth registration process. If the TPTO decides to register a trademark after a smooth registration process, or after examining the oppositions and appeals and rejecting them, the TPTO notifies the applicant of their decision regarding the registration of the trademark and gives two months to the applicant to pay the registration fees. After the registration fee is paid, the certificate of registration is sent to the applicant and the trademark application process is completed. The registration formally comes into effect as of the registration date, with the protection date established from the application or priority date, if any.

The official cost for filing an application for trademarks with a single class of goods or services is 1498.24 Turkish Liras without claiming priority. The fees remain the same for the additional second class and are 1610.11 Turkish Liras

for the third class.

Classification system

11. What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed? Are multi-class applications available and what are the estimated cost savings?

Türkiye became a party to the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks as of 12 July 1995 with Decision No. 95/7094 of the Board of Ministers. The agreement came into force on 1 January 1996. Türkiye has signed the revised Geneva version dated 1997.

The TPTO classifies goods and services in accordance with the Nice Agreement and publishes communiqués accordingly. The Communiqué on the Classification of Goods and Services for Trademark Registration Applications entered into force on 1 January 2017 as the most recent communiqué.

Turkish trademark law allows multi-class trademark applications.

Examination procedure

12. What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? Are letters of consent accepted to overcome an objection based on a third-party mark? May applicants respond to rejections by the trademark office?

The trademark application process consists of a formal examination, search of absolute grounds for rejection, opposition to decision of the TPTO and opposition to publication of an application, assessment of the views and oppositions of third parties, responses of the applicants and evaluation of the evidence in case of a non-use defence, if any, and the final part of the process is

registration of the trademark.

To duly claim registration, the application submitted to the TPTO must be subjected to formal examination. If any deficiencies are found during the formal examination, then the applicant shall be informed regarding these deficiencies or mistakes and be given a period of two months to remedy the deficiencies. As the law points out, if the formal requirements have not been met during the two-month period, the requests are either dropped or only partially accepted.

Once the formal examination is finalized, absolute reasons for rejection are evaluated by experts also by considering the type of the goods and services. If any of the circumstances listed in article 5 of the IP Law are found in part or whole, then the application will be partially or wholly rejected on the grounds of absolute rejection defined in article 5.

Pursuant to article 5/3 of the IP Law, letters of consent are currently enforceable, and allows the applicants to overcome the absolute grounds of rejection (ex officio refusal grounds) by obtaining the prior right owner's consent.

The applicant has the right to appeal against the decision of the TPTO within a period of two months.

Applications that have been duly submitted, that have not been rejected on the above grounds, or that have not been appealed or else have been appealed and accepted by the TPTO shall be published in the Official Trademark Bulletin. Oppositions made in relation to article 5 and article 6 of the IP Law to the publications in the Official Trademark Bulletin may be proposed by any whom it may concern within a period of two months. The applicant may respond to the opposition within a month as of the notification date and may also allege non-use defence regarding the opposing party's trademarks that have been registered for more than five years, if the opposing party claimed that there is a

likelihood of confusion between the marks.

The application is registered and published in the Official Trademark Bulletin in the following circumstances:

- if the application has satisfied all relevant criteria or has done so within any additional period available;
- if any oppositions have been ultimately rejected by the TPTO; and
- if the registration fee has been paid.

Use of a trademark and registration

13. Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

Use of trademarks before the application is not required for the applications to be filed in Türkiye and renewal of trademarks does not require any documents indicating active use of the trademark. However, there is a grace period of five years as of the registration date granted to the trademark owners, regardless of whether their trademark is national or international, and the owner must establish a genuine use of their trademark in Türkiye within this time limit and must be able to prove it when necessary. Otherwise, when the cancellation of the trademark is requested due to non-use, it may be canceled.

In the case of opposition made on the grounds of the likelihood of confusion by a registered trademark owner, the applicant may allege non-use regarding the trademarks, which serves as a basis to the opposition and are for registered more than five years. In this case, the trademark owner opposing the application must be able to submit evidence proving that the goods or services

subject to the non-use claim have been widely and genuinely used in Türkiye for five consecutive years or propose justifiable reasons regarding the non-use of the trademark within a period of five years prior to the application date of the opposing trademark. The opposition shall be rejected in terms of the likelihood of confusion claims if the opposition cannot submit any contrary evidence suggesting otherwise.

In addition, the non-use defence may also be used in legal actions. Once a trademark invalidation and/or trademark infringement action is filed, the defendant of these lawsuits may allege that the claimant's trademarks (which serves basis to the lawsuit and registered more than five years) are not used as prescribed by the IP Law.

Markings

14. What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

The rights holder of a registered trademark may use the symbols ® or ™ as the rights holder wishes. However, this use is not legally obligatory.

The use of the above-mentioned symbols helps the registered trademark to become recognized by third parties and informs them regarding the registered status of the marks as a precaution against potential trademark infringement. The use of the symbols may also inform these parties of the mark and its registered status, which may be useful as supporting evidence to overcome defenses arguing that the infringer is not aware of the registered trademark or that the trademark has become generic for the registered goods or services due to trademark owner's actions or as a consequence of necessary measures not taken by them.

In conclusion, the use of these symbols has no positive or negative influence legally; however, there may be benefits of using them.

Appealing a denied application

15. Is there an appeal process if the application is denied?

Applicants may submit a written and reasoned appeal against the decisions of the TPTO's Trademark Department within a period of two months starting from the date of notification. Appeals submitted to the TPTO are reviewed by the Re-examination and Evaluation Board of the TPTO, as the second and the last step before the TPTO. Applicants may initiate a cancellation action before the specialized IP Courts in Ankara against the final decisions given by the board. If a cancellation action filed against the TPTO's decisions were rejected by the courts of first instance, this decision may also be appealed before the Regional Court and Supreme Court of Appeal.

Third-party opposition

16. Are applications published for opposition? May a third party oppose an application prior to registration, or seek cancellation of a trademark or service mark after registration? What are the primary bases of such challenges, and what are the procedures? May a brand owner oppose a bad-faith application for its mark in a jurisdiction in which it does not have protection? What is the typical range of costs associated with a third-party opposition or cancellation proceeding?

Duly made applications and applications that have not been rejected by the TPTO are published in the Official Trademark Bulletin.

Oppositions may be brought within a two-month period on the basis of the relative grounds set out in article 6 of the IP Law as well as the absolute grounds set out in Article 5 of the IP Law.

Third parties who did not oppose the publication within the given period of two months may file an invalidation action based on the same opposition grounds if the trademarks are registered.

One of the listed reasons for opposition under article 6 of the IP Law is bad faith. The TPTO demands substantial and concrete evidence explicitly showing the bad faith of the applicant. The owners of a famous foreign trademark may challenge a copy of their trademarks, based on the article related to bad faith, without having a registration of or using their trademark in Türkiye. As mentioned, it is possible for the unregistered trademark owner to file an opposition against third-party applications before the TPTO based on real right of ownership and other applicable provisions.

The official fee for filing an opposition against the Official Trademark Bulletin is 406.78 Turkish Liras.

Duration and maintenance of registration

17. How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

Trademark protection begins with the application and is granted for 10-year periods. Every 10 years the renewal of the trademark registration provides for the continuation of protection. Applications for renewal (partially or as a whole) shall be made within six months starting from the end date of the 10-year period of protection, otherwise, they will be lapsed. The request of any one of the companies included in the group shall be sufficient for the renewal of a collective trademark. It should be noted that there is a late renewal period which corresponds to six months from the expiration, namely, the renewal date. Renewal of trademarks does not require any documents indicating active use of the trademark and is filed through the electronic systems as with all other procedures.

Surrender

18. What is the procedure for surrendering a trademark registration?

A written request must be submitted to the TPTO along with a form for surrendering a trademark registration, which can be for all the goods or services, or a part of them. If the request is submitted by a trademark agent, a notarized and legalized power of attorney that explicitly contains an authorization for surrendering the trademark is required. The trademark owner may not surrender their trademark right without the consent of the licensees and rights owners recorded in the register. If right ownership on the trademark has been claimed by a third party and a preliminary injunction has been rendered on this matter and recorded to the registry, rights arising from a trademark may not be surrendered without the consent of that party. In terms of collective marks, all enterprises in the group must act collectively for the surrender of the collective mark right, as in the registration of collective mark. The expiration of the trademark right due to surrender is published in the Official Trademark Bulletin by the TPTO after the examination of the request and required documents and it becomes effective as of the date of registration in the trademark registry.

Related IP rights

19. Can trademarks be protected under other IP rights?

Trademarks cannot be protected under other IP rights. However, it should be noted that, for example, if a trademark has been designed in a way that a copyright claim may also be asserted based on the trademark or consist of a design such as a bottle design or another packaging, the relevant articles of copyright or design may be applicable as well.

Trademarks online and domain names

20. What regime governs the protection of trademarks online and domain names?

According to the IP Law, using identical or similar signs on internet media, like a domain name, router code, keyword or in similar manner with a commercial

impression unless having a right or legitimate connection for the use of that sign, also constitutes trademark infringement. In addition to the IP Law, infringing use of trademarks on the internet and as domain names can be prevented according to the Turkish Commercial Code as well as general provisions of the Turkish Code of Obligations.

Furthermore, the Regulation on Internet Domain Names and relevant legal regulations prescribe an alternative dispute resolution mechanism for the settlement of disputes related to domain names with ‘tr’ extensions. On the other hand, the necessary steps for the removal of illegal content from electronic commerce can also be taken in line with the Law on the Regulation of Internet Broadcasts and Prevention of Crimes Committed Through These Broadcasts, the Law on the Regulation of Electronic Commerce, the Regulation on Electronic Commerce Intermediary Service Providers and Electronic Commerce Service Providers and relevant legal regulations.

LICENSING AND ASSIGNMENT

Licences

21. May a licence be recorded against a mark in the jurisdiction? How? Are there any benefits to doing so or detriments to not doing so? What provisions are typically included in a licensing agreement?

It is possible to register licences at the registry of the Turkish Patent and Trademark Office (TPTO). Registration of licences is important as it enables allegations to be made against third parties; however, it is not legally mandatory in principle. As an exception, the licence regarding a joint mark will not be valid unless the licence agreements are recorded to the registry of the TPTO.

For the registration of license, a request must be submitted to the TPTO together with a form that includes the registration number and name of the trademark, and the official fees for the recordation must be paid. In addition to

these, licence registration requires the licence agreement that includes the signatures and statements of the licensee and licensor, the goods or services subject to the licence, registration number of the trademark and trademark, the licence fee and time limit. If the licence agreement is not in Turkish, a Turkish translation approved by a sworn translator must also be submitted to the TPTO. If the licence is not registered at the trademark registry, rights relating to licences can only be secured against third parties after a notification declaring the licence right has been sent.

In a licence agreement, the parties typically include provisions regarding the type of licence (exclusive or non-exclusive), goods and services to be subject of the licence, time limit, licence fee, obligations of both parties including the ones ensuring the validity of the agreement under the specified conditions, such as using the mark or ensuring the quality of the goods and services or informing each other in case of an infringement and results of failing to fulfil the obligations, and governing laws.

Assignment

22. What can be assigned?

Trademarks may be transferred including all goods or services or only part of them. On the other hand, it has been foreseen that trademarks may be transferred with or independently from the business.

Assignment documentation

23. What documents are required for assignment and what form must they take? What procedures apply?

Trademark assignments shall be valid only if they have been signed before and approved by a notary public in Türkiye. In the agreement a notarized and legalized power of attorney (PoA) in which the authority to assign or take over the right and sign an assignment agreement is clearly stated. If the assignment

agreement is executed abroad, the signatures on the agreement should be clearly approved by a notary public that they belong to the authorized persons and this agreement should also be legalized with an apostille. If the agreement is not in Turkish, regardless of where it is signed, its Turkish translation approved by a sworn translator is required as well. The assignment must contain the trademark registration number and the name of the trademark as well as the parties and it must be indicated whether the trademark will be assigned as a whole or partially.

For the registration of the assignment, a request must be submitted to the TPTO together with a form that includes the registration number and name of the trademark, and the official fees for the recordation must be paid. If the request is submitted by a trademark agent, a PoA should also be submitted to the TPTO.

Validity of assignment

24. Must the assignment be recorded for purposes of its validity?

It is possible to record the assignment agreement in the registry of the TPTO. Record of the assignment only acts as explanatory information, not as a requirement for the validity of the assignment in principle, except the assignment of guarantee marks and joint marks which will not be valid unless the assignment is recorded to the registry. However, in the cases where the recordation is not obligatory, the rights transferred cannot be secured in relation to bona fide third parties unless the assignment agreement has been recorded. For this reason, it is highly recommended that the assignment agreements be recorded in such cases.

Security interests

25. Are security interests recognized and what form must they take? Must the security interest be recorded for purposes of its validity or enforceability?

Trademarks can be pledged independently from the business and can be given as security. Both pledge and security procedures may be registered in the registry and published in the Official Trademark Bulletin following the request of one of the parties.

The following documents need to be submitted with a form for registration and publishing of the pledge:

- a pledge agreement containing the registration number and name of the trademark; and
- if the agreement is not in Turkish, its Turkish translation approved by a sworn translator must also be submitted to the TPTO.

The official fees for recordation must also be paid.

ENFORCEMENT

Trademark enforcement proceedings

26. What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions? Are there specialized courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

The Industrial Property Law (IP Law) gives the trademark holder the right to file a civil lawsuit and, if necessary, the right to carry out criminal proceedings if their trademark is infringed.

Determination of evidence, prevention and ending of infringement, preventing the sale of products that are the source of infringement and requesting both material and immaterial compensation are all within the scope of civil lawsuits. In addition, a preliminary injunction may be requested from the courts before

or during the lawsuit. This request may include ceasing actions constituting infringement by confiscation of goods, collection of all types of advertising material (catalogues, signboards, business cards, etc) and prevention of access to related websites. There are specialized IP courts in the cities of Istanbul, Ankara and Izmir. In other cities, the third chamber of the first-instance civil courts or, if there are less than three chambers, the first chamber adjudicates intellectual property cases.

With regard to criminal lawsuits, the trademark rights holder has the right to file a criminal complaint with the public prosecutor and to demand the filing of a criminal lawsuit against infringing parties. There are specialized criminal IP courts in the cities of Istanbul, Ankara and Izmir. In other cities, the criminal courts of first instance are on duty.

In addition, according to the Customs Law and customs regulations, a trademark rights holder has the right to apply to customs to stop and prevent further import, export and transportation related to the products causing infringement and, if necessary, can request confiscation of such products.

Procedural format and timing

27. What is the format of the infringement proceeding?

Civil lawsuits

The claimant may request determination of evidence from the court before filing the actual civil lawsuit. This determination of evidence may be carried out in the workplace or warehouse of the defendant or the website or social media accounts belonging to the defendant, depending on the case. In practice, the court instructs an expert in the related field to carry out the examination and later the expert submits a report to the court. Since this determination process is carried out without making a prior notification to the defendant, it brings about successful results for determination of the infringement action.

In relation to infringement lawsuits, IP courts are authorized, and in places without IP courts, civil courts of first instance are on duty. The geographically authorized courts are determined by:

- the defendant's domicile;
- the place in which the infringement occurred or its results were seen; and
- if the claimant's domicile is abroad, the workplace of the trademark attorney (who must be registered with the Turkish Patent and Trademark Office (TPTO)) at the time of filing the case.

Preliminary injunction decisions are given before or during the lawsuit against infringement actions and include the prevention, cessation of infringement, the seizure of products that are the source of infringement, seizure of all types of advertising material (signboards, business cards, catalogues, etc), and prevention of access to certain websites and social media accounts in relation to the infringement. The IP courts tend to be in favour of giving preliminary injunction decisions and usually, a security deposit is requested from the claimant.

The lawsuit petition given by the claimant is notified to the defendant and the defendant is given two weeks' notice to respond by a written petition and to submit its responses and relevant evidence to the court. Following the petitions submitted by both parties, the parties are given the opportunity to submit one more petition each. After the procedure of exchanging petitions, the court assigns a date for a preliminary hearing. During the preliminary hearing, the claims and defenses of both parties are heard and it is decided whether the parties can come to an agreement before continuing with the trial. If the parties are unable to come to an agreement, the court moves on to the inquiry stage. At this stage, the court will request an examination report from an independent expert or a panel of experts. This is the most important point of the lawsuit. The experts shall base its report on the evidence and the claims of both parties

that have been added to the lawsuit file. Both parties are entitled to object to the experts' report within two weeks. The court shall evaluate the objections and if the court does not find any deficiencies, the objections will be disregarded. If the court does find deficiencies in the experts' report, the experts may be asked to re-evaluate their findings or the court might assign a different expert or panel of experts to perform the task. Both parties are entitled to appeal the court's decision within two weeks starting from the day of notification.

Civil lawsuits heard in courts of first instance are usually finalized in 18 to 36 months. The appeal stages may take up to around 24 to 36 months to be finalized.

Criminal lawsuits

The criminal procedure begins with the rights holder filing a criminal complaint to the prosecutor. The rights holder usually requests a search and confiscation decision when filing the criminal complaint. The request of the prosecutor, the search and confiscation decisions are given by the judge of the criminal court and are executed by the police department. The goods are seized and later destroyed at the end of the trial. Fast destruction before the finalization of the case may also be possible if the relevant conditions are met.

The prosecutor usually requests an expert report in relation to the confiscated goods. With the detection of infringement by the expert, lawsuits are filed in the criminal courts against the suspects. After the suspects are heard at the criminal trial, the lawsuit file is sent again to the expert. The expert analyses the file and, with the expert's final report, the court decides either to punish the suspects or to acquit them.

In Türkiye, criminal cases are usually the most effective way to prevent the production, distribution and sale of infringing products and are also a lot less costly when compared with civil lawsuits.

Burden of proof

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

In terms of civil cases, in principle, the burden of proof is on the party making claims, and it bears the burden of proof most of the time thereof. However, this should not be interpreted as the defendants not needing to prove their claims and sometimes proving the defenses may be crucial (eg, in case of a due cause). The court examines and evaluates the evidence submitted by both parties. If all the facts have been established by the evidence submitted by both parties, then there is no point in defining who bears the burden of proof. However, if the evidence submitted was not sufficient for the court to come to an opinion on the case, then determination of which party has the burden of proof needs to be made. In the criminal procedures, the aim is to reach the truth. In this respect, the public prosecutor and judges also ex-officio collect evidence that they deem necessary.

Standing

29. Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

Following publication of the trademark in the Official Trademark Bulletin, the applicant acquires the right to file all types of civil and criminal lawsuits, to demand determination of evidence and preliminary injunctions, to address complaints to the prosecutor and to demand search, confiscation and collection decisions. However, if the legal action has been made in relation to a trademark application rather than registration, then the court must wait until the decision in relation to the trademark application has been made.

The rights holder of an exclusive licence may also take precautionary legal measures against infringement.

In addition, if the right to initiate a legal proceeding due to the infringement of IP right is not expressly limited in the licence contract, the right holders of a non-exclusive license can request the right owner to initiate the required legal

proceeding with a notification to be made to the right owner. In case the right owner does not accept this request or does not file the requested legal proceeding within three months, the licensee may initiate the legal proceeding in their own name and to the extent of their own interests. The licensee who initiates a legal proceeding according to this provision must notify the legal proceeding to the right owner.

Border enforcement and foreign activities

30. What border enforcement measures are available to halt the import and export of infringing goods? Can activities that take place outside the country of registration support a charge of infringement or dilution?

Trademarks can be registered before the General Customs Directorate by filing an application via their e-filing system based on the registered trademark before the TPTO. If the nature of the goods is suspect, as a result of the examination carried out at the customs, the import or export can be prevented by civil or criminal actions taken according to each specific case and following a notification made to the rights owner or representative by customs. In detail, infringing goods might be detained for three business days for perishable goods and 10 business days for non-perishable goods by customs if the rights owner has a valid customs application. If the rights owner has no valid customs application at the time of the detention of the goods, customs allows three business days to file a valid customs application, regardless of whether the goods are perishable or not. Once in possession of a valid customs application, the customs authority grants three business days for perishable goods and 10 business days for non-perishable goods to the rights owners to examine the detained products and provide a seizure decision or preliminary injunction obtained from the relevant courts. Upon the request of the rights owner, customs may grant an extension of 10 additional business days. It is at the customs' discretion whether to accept such a request. Apart from these, in the case of the owner of the goods and the rights owner settling the matter within

the detention period, a procedure called ‘simplified destruction’ may take place. Turkish courts are only competent to hear cases regarding infringements that have taken place within the Turkish borders.

Discovery

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

The trademark rights holder may demand determination of evidence from the court before filing the actual lawsuit. This determination of evidence may be carried out in the workplace or warehouse of the adverse party. In general, a site visit can be conducted by court-appointed experts with or without a judge at the premises of the adverse parties. During the site visit, the experts detect the existing situation, namely the scope and method of the unlawful use, by photographing and taking notes and submit a report to the court. Product samples or documents such as catalogues may also be obtained during the process if the court accepts this request. This action can be also used to determine the adverse parties’ online use by the experts. Although this process does not result in the prevention of the adverse parties’ unlawful actions, it can be useful when sending a cease-and-desist letter to them or requesting a preliminary injunction that most courts require to issue an injunction and also demonstrate the unlawful acts of the adverse party in a potential infringement action.

As another option, discovery during the lawsuit, either upon the request of the parties or ex officio decision of the court, is also possible for the observation of the existing situation by the judge themselves with or without the help of the experts according to the nature of the conflict.

In criminal proceedings, similar to the function of the preliminary injunctions, with search or seizure decisions granted by the criminal courts and enforced by

the police department, infringing goods or their materials can be determined or seized.

Timing

32. What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

Civil lawsuits filed at courts of first instance are usually finalized within 18 to 24 months. The appeal stages both before the Regional Courts of Appeal and Supreme Court of Appeal may be finalized within 24 to 36 months. In this context, the average civil lawsuit takes five to seven years to be finalized.

Criminal lawsuits filed in courts of first instance are usually finalized within 12 to 24 months. The appeal stage may be finalized in 18 to 36 months.

Limitation period

33. What is the limitation period for filing an infringement action?

As long as the infringement continues, the rights owner can take legal steps against these acts. If damages will be requested, the limitation period for making the relevant requests is two years from the date on which the trademark owner became aware of the damage and the party that caused the damage, and 10 years from the date on which the infringing act was committed (for the last time). If the infringing acts also constitute a crime, the longer criminal statute of limitations will be applied.

Litigation costs

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

Expenses from the beginning to the end of a lawsuit should be examined in two separate categories:

- expenses in relation to the lawsuit (case fee, expert fee, etc), for which the court decides that the defendant be held responsible; and
- expenses in addition to court expenses (transport, accommodation, etc), which cannot be compensated, and therefore each party pays its own expenses in this category.

Expenses in a lawsuit amount to an average of 40 to 50,000 Turkish liras. If each of the two parties is partially right in the case, the court will split the costs.

According to the Turkish Civil Procedure Code, in principle, the cost of legal proceedings shall be borne by the party against whom the judgment has been rendered. The court also decides on a fee that needs to be paid to the defendant to cover attorneys' fees. This fee cannot be above the yearly maximum limit that is announced each year by the Turkish Bar Association. For IP courts the fee set for 2023 is approximately 25,500 Turkish liras. For the avoidance of doubt, professional attorney fees that are agreed independently by the client and the attorney are not reimbursed by the losing party.

The claimant may demand the costs made and the fee given to the attorney to be paid by the defendant by filing a separate lawsuit.

Appeals

35. What avenues of appeal are available?

With the Law of Civil Procedure that came into force in 2016, the appeal system has been transformed into a two-stage system: Regional Courts of Appeal and Supreme Court of Appeals.

Defenses

36. What defenses are available to a charge of infringement or dilution, or any related action?

Possible defence arguments to be raised in an infringement lawsuit are listed

below:

- parallel import;
- fair use in trade;
- legitimate use;
- permitted use;
- personal use or non-commercial use;
- real ownership and prior use;
- non-use;
- invalid or expired right;
- exhaustion of the right;
- trademark has become generic and is used to define a type of product;
- true ownership of rights; and
- defence of acquiescence or loss of rights owing to silence.

Remedies

37. What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?

The remedies available in case of the infringement of the IP rights are as follows:

- preliminary injunctions (before or during the infringement action to be valid until the end of the lawsuit unless revoked and to be permanent in case of a finalized favourable ruling);
- prevention and determination of the infringement;

- cessation of the infringing actions;
- compensation of material and moral damages;
- seizing of the products causing infringement or requiring penalty, as well as instruments, such as devices and machines exclusively used in their production, without preventing the production of products other than infringing products;
- requesting property right on products, devices and machines seized;
- to take measures to prevent the continuity of infringement, in particular at the expense of the infringer to change the shapes of products and instruments such as devices and machines seized, to erase the trademarks on them or to destroy them if it is inevitable for preventing the infringement of industrial property rights;
- announcement of the final judgment through the daily newspapers or other means or notification to relevant parties; and
- criminal remedies such as penalties including imprisonment and fines.

ADR

38. Are ADR techniques available, commonly used and enforceable?

What are the benefits and risks?

Although ADR methods, such as specialized arbitration and mediation centers, are available, these methods are typically not preferred in Turkish practice. However, it may be beneficial if the right owner is able to settle the matter without initiating legal actions before the courts, which can be more costly. If the right owner tries to settle the matter amicably but does not take any further action for an extended period of time, the adverse party may allege that the rights owner has lost their right due to remaining silent, regardless of the limitation period for the damages. In addition, there is a mandatory mediation

process that must take place before initiating civil actions for commercial disputes, and monetary claims with regard to IP rights are also considered one of them. It should also be noted that there are still unclear points in practice concerning the implementation of the related provision. In detail, there are contradictory decisions as to whether applying the mediation process is mandatory if the case is filed with other claims such as determination or prevention of the infringement that is not subject to the mandatory mediation, in addition to the monetary claims. In the majority of decisions, it is stated that mediation is not mandatory in case of multiple claims.

For the criminal proceeding initiated upon a complaint relating to trademarks, there is a conciliation process at the end of the investigation phase and before the investigation turns into a criminal prosecution. Accordingly, an officially appointed conciliator contacts the parties separately and asks them whether they wish to settle the matter. If both parties would like to consider the settlement option, the conciliator assists the parties while they are conveying their request to the other party. As might be expected, the will of the complainant is crucial and decisive during the process.

UPDATE AND TRENDS

Key developments of the past year

39. Are there any emerging trends, notable court rulings, or hot topics in the law of trademark infringement or dilution in your jurisdiction?

As stated, the Industrial Property Law (IP Law) entered into force on 10 January 2017. As per the IP Law, the article related to cancellation claims including non-use claims shall enter into force after seven years from said date and until that date, the authority of cancellation shall be exercised by the courts. Since the authority to evaluate and conclude the cancellation claims has been transferred to the Turkish Patent and Trademark Office on 10 January 2024, the Turkish IP Community now looks forward to the arrangements on

this matter as well as the practice of the Turkish Patent and Trademark Office.

In parallel to the rest of the world, AI and NFT-related topics are still one of the hot topics in Türkiye, which are yet unclear.

As an important court ruling, the Turkish Constitutional Court annulled the relevant provisions of the Code of Criminal Procedures that regulates the deferment of the announcement of a verdict, and this decision will be effective as of 1 June 2024. As a result of the annulment, it is evaluated that the legal barrier to the infringers being directly punished with their first infringing act based on the provisions in question and repeating their actions will be removed, which indicates a crucial step on the deterrent effect of the criminal provisions of the IP Law.

**** The information in this chapter was accurate as at January 2024.***