

The Legal 500 Intellectual Property Comparative Guide 2021 – Turkey Chapter

5 Jul 2021

IP In association with Gordon Harris & Mathilda Davidson of Gowling WLG

Intellectual Property Comparative Guide: Questions

A. Types of IP Rights

- What different types of intellectual property rights exist in your jurisdiction to protect:

(a) Inventions (e.g. patents, supplementary protection certificates, rights in trade secrets, confidential information and/or know-how);

- Patents
- Utility models
- Trade secrets, know-how

(b) Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees);

- Registered trademarks
- Unregistered trademarks
- Business names: trade names and company names are protected by IP Law and Commercial Law
- Geographical indications, and traditional product names

(c) Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how).

- Registered design rights;
- Unregistered design rights;
- Copyright, software, computer programs, database rights (original database and sui generis right);
- Integrated circuit topography rights;
- Plant Breeders' rights;
- Confidential know-how and business information (trade secrets).

- What is the duration of each of these intellectual property rights? What procedures exist to extend the life of registered rights in appropriate circumstances?

- (a) Patents** - Patents are protected for 20 years; protection starts from the filing date, subject to payment of the annuity fees starting from the end of the second year following the filing date.
- (b) Utility models** - Utility Models are protected for 10 years; protection starts from the filing date, subject to payment of the annuity fees starting from the end of the second year following the filing date.
- (c) Trade secrets, know-how** - are protected as long as they meet the requirements in the Commercial Law.
- (d) Registered trademarks** - Trademark registrations last 10 years, starting from the application date. The trademark can be renewed indefinitely for further ten-year periods.
- (e) Geographical indications, and traditional product names** - There is no specific validity period for geographical signs. Since there is no protection period, there is no renewal **period as there is for trademark protection**.
- (f) Registered design rights** - Industrial designs receive protection for 5 years from the application date. The protection period can be extended up to 25 years through renewal every five years.
- (g) Unregistered design rights - Unregistered** industrial designs receive protection for 3 years from the date of disclosure to the public in Turkey.
- (h) Copyright, software, computer programs, original databases** - protection runs for the lifetime of the author, plus 70 years after the author's death. A sui generis database right lasts 15 years from the date it was disclosed to the public.
- (i) Integrated circuit topography rights** are protected for 10 years starting from the application date; if the application has been commercialized and the application was filed within the ensuing 2 years, protection starts from the commercialization date. Even if it has not been commercialized and no application has been filed within 15 years from the date it was designed, it is not possible to enjoy protection. Renewal of the protection of integrated circuit topography is not possible and after ten years the subject matter of the right becomes public property.
- (j) Plant Breeders' rights** are protected for 25 years from the date of grant of the right. For trees, grapevine and potatoes, this period is 30 years.
- (k) Confidential know-how and business information (trade secrets)** are protected as long as they meet the requirements in the Commercial Law.

- **Who is the first owner of each of these intellectual property rights and is this different for rights created in the course of employment or under a commission?**

(a) Patents/Utility models

In principle the owner is the inventor; in any case independently from any authority to patent the invention, the inventor keeps his/her right to be named as the inventor.

Any invention that is created by an employee during the activity he/she is obliged to carry out at the workplace or that is created largely based on the experience and works of the business/workplace is a "service invention". Any other invention created is a "free invention".

There is a notification obligation on the employee with respect to service inventions. If these notification proceedings are carried out properly and the employer claims rights to the invention, the employer becomes the owner of the rights to the invention. If the employer does not claim rights, the invention becomes a "free invention", meaning the employee can register it in their own name.

(b) Trademarks and business names

Turkey is a first-to-file country. The first owner of a registered trademark is the applicant in whose name the trademark is registered. For unregistered trademarks, the first owner is the person who first started to use the trademark in Turkey.

(c) Geographical indications, and traditional product names

Producer groups, public institutions and organizations as well as professional organizations accepted as public institutions regarding the product or geographical area of the product, associations, foundations and cooperatives operating for public interest in relation to the product or authorized to protect the economic interests of their members, or the relevant manufacturer can be the owner of a geographical indication or a traditional product name.

(d) Registered/unregistered designs

In principle the owner is the designer; in any case independently from any authority to file the design application, the designer keeps his/her right to be named as the designer.

Unless otherwise provided by contract between the parties or the nature of the work, employee designs (which an employee creates within the scope of the activity he/she is obliged to carry out at the workplace or which are created by the employee during the work relation largely based on the experience and works of the business/workplace) are automatically owned by the employers.

Any other design than those mentioned above, which is created by the employee by using instruments or information that are subject to the general operation of the workplace, is owned by the employer upon request.

The right owner of a design that is created outside of the scope of a contract of employment but within the scope of a work agreement is determined by the provisions in the agreement between the parties.

(e) Copyright/Software/Databases:

The owner is the author.

Unless otherwise provided by contract between the parties or the nature of the business/work, employers are entitled to use the material rights in officers' and workers' artistic works. This does not mean transfer of the rights.

On the other hand, moral rights are governed by the creators of the works.

Third-party works: The right owner of a work/software/database, which is created outside of the scope of a contract of employment but within the scope of a contract, is determined by the provisions of the agreement between the parties.

If a work/software/database is created by more than one person, the right in the work/software/database is being used by the legal entity that gathers the creators. This rule is not applicable to cinematic works. Where an author has created the work in the fulfilment of obligations resulting from an employment or service relationship, the copyright is with the author, unless otherwise provided in accordance with the terms or nature of the employment relationship. Where a computer program is created by an employee in the execution of his/her duties or following the instructions of his/her employer, the employer shall exclusively be entitled (licensed) to exercise all economic rights in the computer program, unless otherwise agreed.

(f) Integrated Circuit Topography rights

Rights arising from an integrated circuit topography belong to the designers.

Unless otherwise provided by the contract between the parties; topographies which are designed by employees during their work are automatically owned by the employer.

Even if it is not decided on in the agreement, any integrated circuit topography created by an officer or employee by using (or benefiting from) the instruments or information of the workplace is protected/governed by the employer.

Commissioned works: Unless otherwise provided by the contract between the parties; the rights arising from the protection of the integrated circuit topography are used by those parties.

(g) Plant Breeders' Rights

The rights arising from the plant variety belong to its breeder.

Unless otherwise provided by the contract between the parties, the variety rights which are developed by employees during their work are automatically owned by the employer.

Even if it is not decided on in the agreement, any variety developed by the employee by using (or benefiting from) instruments or information of the workplace is protected/governed by the employer.

Commissioned works: unless otherwise provided by the contract between the parties, the rights arising from the protection of the plant variety are used by those parties.

B. Registration

- **Which of the intellectual property rights described in section A are registered rights?**

Patents, utility models, integrated circuit topography rights, registered trademarks, registered designs, geographical indications, trade names and plant variety rights.

- **Who can apply for registration of these intellectual property rights and, briefly, what is the procedure for registration?**

(a) Patents, utility models, Integrated circuit topography, designs

In principle the inventor/designer and its successors are entitled to file the application. The Turkish Patent and Trademark Office (TPTO) does not examine the applicant's authority to file an application. Any claims regarding not having the right to file are not heard by the office but are subject to a court action.

(b) Trademarks

In general, it is the same for trademarks as for the rights mentioned above. However, guarantee trademarks can only be applied for by incorporated associations.

During opposition proceedings, parties can file oppositions based on arguments arising from the ownership of acquired and actual rights. If the authorized body is satisfied, the trademark application is rejected but ownership of the trademark is not transferred to the opponent automatically.

(c) Geographical indications

Producer groups, public institutions, and organizations as well as professional organizations accepted as public institutions regarding the product or geographical area of the product, associations, foundations, and cooperatives operating for public interest in relation to the product or authorized to protect the economic interests of their members, or the relevant manufacturer can be the applicant for a geographical indication.

(d) Plant variety rights

The developer is entitled to file an application. During the opposition proceedings, parties can file oppositions based on the arguments arising from the ownership of acquired and actual rights. If the office is satisfied with the evidence, the application is rejected.

(e) Procedure for registration

The TPTO is entitled to handle these proceedings other than for plant variety rights. Plant variety registrations are carried out by the authorized body of the Agriculture and Forestry Ministry.

All the applications must meet the formal requirements set out in the relevant laws. When the application form is filed and application fee deposited, the application is formally recorded. The Office / the Authorized Body of the Ministry examines the application in accordance with the legal requirements for each IP right. If all these requirements are met, a registration is granted.

- **How long does the registration procedure usually take?**

In a smooth-running proceeding, obtaining a patent takes approximately 30-36 months after filing an application. The procedure for the registration of utility models is quicker and takes approximately 8-10 months.

In a problem-free scenario, for trademarks/designs it takes 6-8 months.

Integrated Circuit topography registration proceedings again take 10-12 months.

Geographical indication registration procedure takes 10-12 months in general.

For a plant variety, the registration procedure takes approximately 12 to 24 months.

Due to the Covid 19 break, temporary delays may arise in registration procedures state above.

- **Do third parties have the right to take part in or comment on the registration process?**

Any third party can oppose a **patent** within 6 months following publication of the grant of the patent.

Third party oppositions are not possible for **utility models**, but third-party opinions can be filed.

Any third party can oppose a **trademark** application within 2 months of the publication. Furthermore, third party observations can be filed based on absolute refusal grounds (excluding the refusal ground for the existence of a same or indistinguishably similar trademark) unlike the opposition process mentioned above, these third parties are not a party to the proceedings before the TPTO.

Any third party can oppose a **design** within 3 months following publication of the grant of the patent.

Any third party can oppose the registration of an **integrated circuit topography** within 3 months following the date when the decision to grant the design is published.

Any third party can oppose the application of a **plant variety** in the 3 months following publication of the application.

- **What (if any) steps can the applicant take if registration is refused?**

For the refusal decisions rendered by TPTO, the relevant parties are entitled to file cancellation actions before the Ankara IP Courts within two months following the notification of the refusal for patents, utility models, trademarks, geographical indications, and designs. This period is 60 days for integrated circuit topography refusals. A

cancellation action for a plant variety needs to be filed within 30 days.

- **What are the current application and renewal fees for each of these intellectual property rights?**

(a) Patents

Official fee for filing a patent is 55 TL; the annual fees for maintaining the patent range from 390 TL for the second year to 3370 TL for the 20th year.

(b) Utility models

Official fee for filing a utility model is 55 TL; the annual fees for maintaining the utility model range from 300 TL for the second year to 895 TL for the 10th year.

(c) Trademarks

Official fee for filing a trademark application covering one class is 280 TL; each additional class is 280 TL. Renewal fee is 940 TL, late renewal fee is 1840 TL.

(d) Designs

Official fee for filing a design application is 200 TL; each additional design is 90 TL. Renewal fee is 600 TL, it is 80 TL for each additional design. Late renewal fee is 1150 TL, it is 150 TL for each additional design.

(e) Integrated Circuit Topography rights

The application fee for the topography rights is 575 TL

(f) Plant variety rights

The application fee is 1430 TL; annuity fees start from 366 TL to 405 TL (depending on the type of plant), and gradually increase for each year.

- **What are the consequences of a failure to pay any renewal fees and what (if any) steps can be taken to remedy a failure to pay renewal fees?**

If the annuity fees or renewals are not paid within the timeframes (due or late), the IP rights become invalid.

For patents and utility models late payment (6 months following the due date) is possible (surcharged) and, in case of non-payment, the office revokes the patent and informs the holder. The holder has another 2 months to make a recovery payment (surcharged).

For trademarks and designs late renewals are possible within the 6 months following the due dates (surcharged).

C. Assignment

- **What are the requirements to assign ownership of each of the intellectual property rights described in section A?**

Patents, utility models, trademarks, designs, integrated circuit topography rights and plant variety rights can be freely assigned to any third party. The assignment agreement needs to be in writing. Assignment agreements should be signed before a Turkish notary, or before a foreign notary. An agreement signed before a foreign notary should be Apostilled.

For copyrights the moral rights cannot be assigned to a third party, only the authority to use can be transferred. The financial rights can be transferred but each of the rights is required to be named one by one in the agreement. The assignment of rights before the creation of the work is not valid.

Trade names cannot be transferred independently, unless otherwise provided by contract and the transfer of the company includes the name.

- **Is there a requirement to register an assignment of any of these intellectual property rights and, if so, what is the consequence of failing to register?**

Records does not affect the validity of an assignment and it is optional. However, in case of non-recorded assignment, bona fide third parties' acts based on their trust in the registry are protected.

D. Licensing

- **What are the requirements to licence a third party to use each of the intellectual property rights described in section A?**

For licensing of patents, utility models, trademarks, copyrights, designs, integrated circuit topography rights the agreements must be in writing.

It is possible to license trade secrets and know-how by agreement. There is no specific regulation on this, and the licence agreement is subject to general law provisions.

- **Is there a requirement to register a licence of any of these intellectual property rights and, if so, what is the consequence of failing to register?**

Records does not affect the validity of a licence and it is optional. However, in case of non-recorded licence, bona fide third parties' acts based on their trust in the registry are protected.

- **Are exclusive and non-exclusive licensees given different rights in respect of the enforcement of the licensed IP, and if so, how do those rights differ?**

Unless otherwise provided by a contract between the parties, non-exclusive licensees generally need the consent of the rights owner to initiate legal proceedings.

An exclusive licensee has the right to initiate legal proceedings against infringers without seeking the consent of right owners unless otherwise provided in the licence.

E. Enforcement

- **Are there criminal sanctions for infringement of any intellectual property rights, and if so, what are they and how are they invoked?**

Criminal actions are only possible for the infringements of trademark, copyright, and plant variety rights. A criminal action can be based on unfair competition rules if the conditions are met and the evidence is sufficient.

The result is imprisonment for up to three years (up to two years for plant variety rights or up to four years for the granting of a licence to/assigning of a trademark by a person who is not entitled to do so) or a fine. Generally, the punishments are suspended if the accused does not have any convictions.

- **What other enforcement options are available in your jurisdiction for each of the intellectual property rights described in section A? For example, civil court proceedings, intellectual property office proceedings, administrative proceedings, alternative dispute resolution.**

It is possible to file a civil action against an infringement of IP rights. Lawsuits for infringement, non-infringement, invalidation, and cancellation claims are possible. Within the scope of these proceedings, preliminary injunctions are possible. Dispute resolution is another option; however, it does not have any effect for invalidation proceedings.

The TPTO is only entitled to take care of the Office decisions and some invalidation actions in exceptional cases.

Rights owners can monitor for infringements through Customs, by filing an application based on registered trademarks, patents, or industrial designs. The monitoring procedure covers both imported and exported goods. After detecting infringement, rights owners have a right to take civil and criminal actions.

- **What is the length and cost of such procedures?**

The length of the lawsuits varies depending on the nature of the IP rights, the substance of the conflict and whether it is complex, intercontinental etc.

Also, there is a two-level appellate system in Turkey. Getting a decision from a First Instance Court takes around 1.5 to 2 years; getting through both levels of the appellate system takes 3 to 5 years.

Total judicial costs are approximately €1,000 to €2,000 in straightforward cases without compensation claims. Professional attorneys' fees will vary depending on the complexity of a case.

- **Where court action is available, please provide details of which court(s) have jurisdiction, how to start proceedings, the basics of the procedure, the time to trial, the format of the trial, the time to judgment and award of relief and whether any appeal is available.**

The specialised IP courts can handle IP-related lawsuits. However, IP courts exist only in larger cities (ie, Istanbul, Ankara and Izmir). If there is no IP court in a city, the Third Chamber of the Civil Courts of First Instance (or the First Chamber where fewer than three chambers exist) is entitled to handle such lawsuits.

Civil procedure in Turkey is mainly based on writing and there is no jury trial. Civil proceedings are initiated by the plaintiff submitting a petition to the court. If there is a preliminary injunction request, the court evaluates this request as a first step and generally schedules a hearing. These initial examinations are followed by the exchange of petition phase. Upon the end of the exchange of petition phase, the preliminary examination phase starts. During the preliminary examination, the court examines the conditions of the conflict between the parties. This examination is considered as a preparation for the analysis of the merits of the case. After the preliminary examination phase, the investigation phase starts. The court evaluates evidence that is submitted by the parties and investigates the accuracy of the facts alleged by the parties. For the purpose of examining the accuracy of the submitted documents, the court may decide to confer with an expert witness. Even though it is at the court's sole discretion to choose not to seek an expert examination for cases that can be handled using their own knowledge as an IP court, a technical evaluation is accepted as compulsory in patent/utility model and design cases as the judges do not have a technical background. Witness testimony is also possible in infringement cases.

After conclusion of the investigation phase, the judgment phase starts. Hearings are held approximately every 2 to 3 months during the judgment phase. It takes between 1.5 and 2 years to receive the decision of the first-instance court depending on the complexity of the case.

During this final phase, the judge renders a decision after the examination of the accuracy of the claims.

Remedies available include injunctive relief, determination evidence and site investigation.

Injunctions can be obtained either before or during a trial. To obtain an injunction the requesting party must prove to the court's satisfaction that either:

- Irreparable harm will arise if the injunction is not granted, or

- The outcome which the requesting party seeks in its main action will be unlikely unless the injunction is granted.

Mediation is mandatory for IP-related disputes including receivables and compensation claims as of 1 January 2019. Though, recently, 11th Civil Chamber of Court of Cassation stated that applying to mediation is a condition of lawsuits for monetary claims. Nevertheless, in terms of collection cases filed together with a lawsuit that is not subject to mediation, it has ruled that applying for mediation will no longer be a condition for the case. Although the practice on the subject will be formed by the case law, if the approach of the 11th Civil Chamber of the Court of Cassation is adopted, especially in cases related to intellectual and industrial property rights, considering that the claim for compensation is mostly filed with the request for the determination of infringement, the possibility of losing the function of the mediation practice in this field may come on the agenda.

Civil actions take around 1.5 to 2 years until the First Instance Court renders its decision. The parties then have the right to appeal the decision before the Regional Court. Any decision of the Regional Court can be challenged before the Supreme Court. The appeal procedure including the appeal procedure before the Regional Court takes around 1 to 1.5 years. The appeal procedure before the Supreme Court also takes 1 to 1.5 years. Consequently, civil actions take around 3.5 to 5 years until they are finalized.

For criminal proceedings, a complaint must be filed against the infringer before the Public Prosecutor. If the complaint is accepted by the Public Prosecutor, it will be then referred to the Criminal Court for the issuance of a search and seizure warrant which will enable the police to search for and seize the counterfeit products. The search and seizure requests are evaluated by a Judge of the General Criminal Court. The request might be accepted by the General Criminal Court if there is reasonable doubt in respect of the infringing activities. Criminal cases that are initiated as a result of search and seizure are handled by the IP Criminal Court or, if there is no specialized IP Criminal Court, by the General Criminal Court.

- **What customs procedures are available to stop the import and/or export of infringing goods?**

Customs procedures are available in IP Law. It is possible to file a Customs watch application based on registered trademarks, patents, or industrial designs for monitoring the flow of goods into and out of the country. After detecting an infringement, rights owners have a right to take civil and criminal actions (except for patents and industrial designs).

- **Are any non-court enforcement options or dispute resolution mechanisms mandatory in respect of intellectual property disputes in any circumstances? If so, please provide details.**

Non-court enforcements might be possible only if the conflict also has public health, smuggling, tax or competition aspects.

In our procedural law, mediation is a prerequisite to filing a lawsuit in commercial disputes, including IP disputes concerning monetary claims. Therefore, if a monetary claim is included, mandatory mediation proceedings should be started first. Though, recently, 11th Civil Chamber of Court of Cassation stated that applying to mediation is a condition of lawsuits for monetary claims. Nevertheless, in terms of collection cases filed together with a lawsuit that is not subject to mediation, it has ruled that applying for mediation will no longer be a condition for the case. Although the practice on the subject will be formed by the case law, if the approach of the 11th Civil Chamber of the Court of Cassation is adopted, especially in cases related to intellectual and industrial property rights, considering that the claim for compensation is mostly filed with the request for the determination of infringement, the possibility of losing the function of the mediation practice in this field may come on the agenda.

Sending a warning letter and requesting that the infringer cease and desist the infringement can be used as to argue for the award of costs.

- **What options are available to settle intellectual property disputes in your jurisdiction?**

According to the Civil Procedural Law, settlement is possible within the scope of an ongoing court action as a part of the court proceedings and the judge is entitled to invite the parties to reach a settlement (if necessary). Furthermore, the parties can settle the disputes outside of the court proceedings by signing a settlement agreement any time.

Also, mediation is an option for the conflicts involving monetary claims. Therefore, in case compensation request is involved, mediation proceedings can be triggered.

F. Establishing infringement or liability

- **What is required to establish infringement of each of the intellectual property rights described in section A? What evidence is necessary in this context?**

The following actions are considered **patent/utility model infringement** under Turkish law:

- Imitating an invention by producing a product in whole or in part, without the patent holder's consent.
- Where the person concerned knows (or should know) that such products are infringements in whole or in part, but is nevertheless involved in: selling, distributing, or commercialising products in any other way (as well as importing for such purposes); possessing products for commercial purposes; or using them by applying products that were manufactured as the result of an infringement.
- Without the patent holder's consent: using a patented process; selling, distributing, or commercialising a product in any other way (as well as importing for such purposes); using by applying products directly obtained through a patented process.
- Unlawful claiming of the patent right.
- Enlarging the scope of the rights granted by the patent holder on the basis of a licence agreement or grant of a compulsory licence or transferring such rights to third persons, without permission.

The following actions are considered **trademark infringement** under Turkish law:

- Unauthorised use of any sign which is identical to a registered trademark in relation to goods and services which are identical to those for which the trademark is registered.
- Unauthorised use of any sign which is identical or similar to a registered trademark for identical or similar goods or services for which the trademark is registered and which creates a likelihood of confusion.
- Unauthorised use of any sign which is identical or similar to a well-known registered trademark for goods or services not covered by the trademark, which would take unfair advantage of or damage the distinctive character or well-known status of the trademark.
- Imitating a registered trademark by using a mark, which is identical or indistinguishably similar, without the trademark owner's consent.
- Selling, distributing or otherwise trading products bearing the trademark, or indistinguishably similar marks in violation of trademark rights, or placing such products in the Turkish customs territory, which are known (or should have been known) to be produced in violation of a trademark.
- Expanding the scope of rights acquired by a trademark licence contract, or transferring them to third parties.

Trade names are protected by Commercial Law; unauthorized use of any trade name is accepted as infringement.

The following actions are considered **design infringement** under Turkish law:

- Without the right holder's consent, making, producing, putting on the market, offering, selling, putting to use, importing, or keeping in stock for these purposes an identical or significantly similar design.
- Transferring to third parties or expanding rights acquired through a licensing contract.
- Unlawful Wrongful claiming of the design right
- An unregistered design infringement action can be brought on the grounds that the unregistered design has been copied identically or significantly.

The following actions are considered **copyright infringement** under Turkish law:

- Unauthorised reproduction, distribution or communication of the work.

- Unauthorised adaptation of the work (derivative works).
- Breach of the author's moral rights:
 - to disclose the work;
 - of attribution to the work;
 - to the integrity of the work.

The following actions are considered **geographical indications infringement** under Turkish law:

- Direct or indirect unauthorized use of the GI in the course of trade, on products which do not bear the features of the product that is subject to the GI application, for taking advantage of the fame of the GI or being associated with the GI.
- Giving falsified information on the packaging or promotional materials of the products bearing the GI.
- Using the GI in a manner to mislead consumers
- Using the GI in an abusive way even though it is used as the origin of the product, or a translation of the GI, or using wording imitating and resembling the GI for example in style, process or methods.

The following actions are considered **integrated circuit topography infringement** under Turkish law:

- Reproducing the topography and offering, putting on the market or distributing, or importing for such purposes, the topography product containing the topography.

The following actions are considered **plant variety rights infringement** under Turkish law:

- Unauthorized production, reproduction, conditioning for the purpose of propagation, offer for sale, sales or marketing, import and export or stocking.
- Where the person concerned knows (or should know) that the products are violating the rights of PVR holder, but is nevertheless involved in; selling, distributing, or commercialising products in any other way (as well as importing for such purposes); possessing products for commercial purposes; or using by applying products which were manufactured as a result of an infringement.
- Enlarging the scope of the rights granted by the patent holder on the basis of a licence agreement or granted by compulsory licence or transferring such rights to third persons, without permission.
- Wrongful claiming of the design right.
- Participating or assisting in, or encouraging or promoting, the acts referred to above in any way.
- Omitting the correct use of a variety denomination or failing to use the denomination of the protected variety while selling or otherwise exploiting the propagating material of the protected variety.
- Refraining from declaring the source and manner of obtaining products found in a party's possession, which were unlawfully manufactured or commercialised.

The burden of proof is on the plaintiff, and any evidence proving the ownership of the right and the infringing activities of the defendant can be brought to prove the infringing acts.

- **How does the court acquire any necessary information (fact or technical) and in what circumstances does it do so? In particular -**

1. **Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties' expert witness evidence?**

For the purpose of examining the accuracy of the submitted documents, the court decides to confer with an expert witness. After the expert witness report is delivered to the parties, the parties are entitled to file comments/objections to the report. Prior to the court's decision, the court evaluates the report and the parties' comments. If the court deems the report is sufficient, it does not ask for an explanation and concludes the investigation phase. However, if the report is not sufficient, further explanation can be requested from the expert, or other experts can be appointed.

According to the Turkish Code of Civil Procedure, only the court can decide to proceed with an expert witness examination. In other words, it is in the judge's own discretion to decide whether to confer with an expert witness or

not. Under the applicable law, if the parties can agree on an expert, the court appoints the chosen expert. However, if the parties cannot agree on an expert, the court ex officio appoints one or a maximum of three experts for the submission of a report.

1. What mechanisms are available for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?

There is no discovery and disclosure procedure; the collection of evidence is monitored and executed by the court during examination by its own motion or the request of the parties.

Normally, all documents submitted to the court file are open to the counterparty, and parties are entitled to obtain copies of the documents. If a party requests confidentiality, the judge takes this request into consideration initially. If such a request is accepted, the relevant document is kept in the court's safe, and may only be examined by the counterparty with the judge's permission at the court's premises and limited to the scope of due process, i.e. for ensuring the right to a defence.

• How is information and evidence submitted to the court scrutinised? For example, is cross-examination available and if so, how frequently is it employed in practice?

Generally, the courts scrutinise the evidence with the help of expert witnesses, especially technical issues. Also, the Courts can order the parties to attend the examination hearing to hear the parties and/or witnesses. While cross-examination is not available, the court can in principle allow the parties to address questions to the counterparty through the Court.

• What defences to infringement are available?

The valid defences IP rights infringement actions are listed below:

- invalidity of the IP right
- prior user's right.
- non-infringement,
- descriptive use, fair use,
- non-use of the IP right
- experimental use,
- use for making an application for market authorisation,
- non-commercial use,
- statutes of limitation,
- Competition law defence.
- IP right has expired.
- exhaustion of owner's right
- personal/non-commercial use.
- Bolar Exemption (in pharma patent litigation)

G. Challenges to intellectual Property

• Who can challenge each of the intellectual property rights described in section A?

Owners of prior rights can file infringement actions. Furthermore, any party who has a benefit is entitled to request the invalidation of the IP right described in section A.

• When may a challenge to these intellectual property rights be made (e.g. during any registration process or at any time during the subsistence of the right)?

Within the time limits, they can be argued both before the TPTO and in administrative proceedings in the scope of oppositions and appeals. Moreover, following registration, invalidation and cancellation claims can be initiated before the courts. Also, it is possible to raise a counter claim in infringement actions.

- **Briefly, what is the forum and the procedure for challenging each of these intellectual property rights and what are the grounds for a finding of invalidity of each of these intellectual property rights?**

IP rights can be challenged before the TPTO, which is entitled to grant the right, and/or before IP Courts. Grounds for invalidity include non-eligibility for protection, well-known character of an earlier trademark, existence of likelihood confusion, non-use of a trademark or registration in bad faith.

- **Are there any other methods to remove or limit the effect of any of the intellectual property rights described in section A, for example, declaratory relief or licences of right?**

Declaratory-judgment actions of non-infringement are possible for securing future commercial activities.

Also, under certain conditions, it is possible to apply for a compulsory licence for patents, plant varieties, utility models, copyrights and integrated circuit topographies.

Exhaustion of IP rights is accepted in the IP Law with the doctrine of international exhaustion applying.

According to the IP Law, prior use may also be used as a defence against infringement claims. If third persons have been using the patent/design/trademark in Turkey or taken real and serious measures in good faith at or prior to the time of the application date, the right holder cannot prevent such activities. Such activities should always be proportionate and cannot be extended to harm the rights of the owner.

Under certain conditions, it is possible to apply for the granting of a compulsory licence on a patent right to use a patented invention without the authorization of the right holder.

According to the Bolar Exemption used especially in pharma litigation, a patent owner cannot prevent third parties' experimental activities. These activities include doing experiments with an invention that is subject to a patent, licensing of pharmaceuticals, performing all necessary tests and experiments.

Additionally, farmers are allowed to use production materials resulting from production performed on land if they have themselves cultivated with a patented product that is: sold by the patent owner, used with its permission and obtained through other commercial means. Farmers can also use patented breeding or other animal reproduction materials sold by the patent owner or used with its permission or obtained through other commercial means for agricultural purposes.

H. REMEDIES

- **What remedies (both interim and final) are available for infringement of each of the intellectual property rights described in section A?**

According to the Turkish IP law, the following remedies are available:

- Preliminary injunctions to prevent the infringing act,
- Determination of infringement/unfair competition,
- Cessation and prevention of infringement/unfair competition,
- Elimination of infringement/unfair competition,
- Compensation for damages:
 - Actual loss
 - Material damages

- Immaterial damages
 - The disclosure of the court's judgment by means of publication to the public, costs of which are to be met by the defendant party
 - Handing over documents in the possession or property of the infringer,
 - Delivery up / destruction of infringing products,
 - Recall of infringing products and removal from the market,
 - Reimbursement of the official court expenditures and fees for bringing the action.
- **What are the costs of enforcement proceedings and is any kind of costs recovery available for successful parties? Is there a procedural mechanism enabling or requiring security for costs?**

Total judicial costs are approximately €1,000 to €2,000 in straightforward cases without compensation claims. Professional attorneys' fees may vary depending on the complexity of a case.

According to the Turkish Procedural Law, the plaintiff bears the costs of the proceedings. Once a final verdict has been delivered by the court, the costs of the legal proceedings are paid by the losing party to the adverse party. In the event of a partial loss/win, the costs will be split accordingly. The reimbursement does not include professional attorneys' fees which are agreed between the client and attorney.

Additional Question:

33. **Has the COVID-19 pandemic caused any changes (temporary or permanent) to the protection or enforcement of intellectual property? For example, changes to deadlines, filing or evidence requirements or court processes.**

On 26 March 2020, the Law on Amending Several Laws numbered 7226 was published in the Official Gazette numbered 31080 to address the concerns of professionals missing and/or meeting any legal deadlines during this pandemic. According to the law, in order to prevent any loss of rights amid COVID-19 spread, all deadlines have been suspended as of 13 March 2020 retrospectively until 15 June 2020 for all civil, criminal and administrative legal proceedings with limited exemptions.

As the seizure before the customs is ensured by a preliminary injunction decision from a civil court or a seizure decision from the criminal courts (classified as protective measure), the deadline of IPR holders continued running even during the suspension period foreseen by the Law.

The suspensions, remote working status, and partial workings cause temporary delays on proceedings before the governmental bodies and the courts.

**This content was originally published in [The Legal 500 Intellectual Property Comparative Guide 2021 - Turkey Chapter](#).*

Related Practices

- [Trademarks](#)
- [IP Licensing](#)
- [IP Litigation](#)
- [Patents and Utility Models](#)
- [Anti-Counterfeiting](#)
- [Unfair Trade Practices](#)

Related Attorneys

- İ?İK ÖZDO?AN, LL.M.
- GÖKÇE ?ZG?, LL.M.
- EZG? BAKLACI GÜLKOKAR, LL.M.
- YONCA ÇELEB?