

TURKEY

Registration no longer constitutes legitimate use defence in Turkey

Gün + Partners

Istanbul



Hande Hançar Çelik and Berrin Dinçer

Turkey has welcomed the new Intellectual Property Code (the IP Code) numbered 6769. This came into force on January 10 2017.

One of the major changes in the new IP Code is an explicit provision in Article 155 preventing later dated IP registrations being submitted as a defence in infringement actions.

Before the IP Code, there was established case law from the Court of Appeals stating that use of a registered IP right could not be prevented until the invalidation of the right was obtained. This case law resulted in de facto immunity for infringers allowing them to safely continue their infringements. In particular, the design registration system (which is rather quick as there was no ex-officio examination) was severely abused by infringers, and they obtained design registrations for the infringing packaging or infringing products. These registrations allowed them to safely use the infringing items until the end of the invalidation proceedings (at the minimum between one and two years).

As a result of the difficulties posed by case law for an effective fight against infringers, Article 155 of the IP Code has been welcomed.

So far, the courts have been hesitant when it comes to decisions, particularly in matters concerning preliminary injunction (PI) requests in infringement actions where the defendant holds a registered IP right. Interpretation of this Article by first instance courts has been rather strict for PI requests, and they have been rejected simply due to the need for an examination on the merits of the file which has resulted in continued use by infringers even in obvious cases of bad faith registrations. Recently the Bakırköy

IP Court refused a PI request on the same ground, and this was appealed before the district court. The district court, by clearly referring to Article 155 of the IP Code, revoked the decision of the first instance court and rendered a PI order where the defendant was clearly acting in bad faith. We believe that this decision will guide first instance courts on the interpretation of the Article when it comes to PI requests and will allow trade mark owners to protect their trade marks against infringers by obtaining a PI order, even when a registered IP right exists.

Nevertheless, there will need to be a balance in the implementation of the regulation since the change introduced into the new IP Code rule also means that the risk of an infringement claim exists for trade marks which were registered in good faith.