

### Istanbul District Court Granted Preliminary Injunction Against the Use of a Registered Trademark

The new IP Code which entered into force on January 10, 2017 - abolishing Trademark Decree Law no.556 – introduced an important change to Turkish trademark law with its article 155 ruling that “a trademark, patent or industrial design holder cannot rely on its registered right as a defense in an infringement action filed by a priority right holder.” This means that having a valid registration will no longer create an immunity for its holder, who will no longer be able to set it forth as a defense against infringement claims.

Before the enactment of the IP Code, having a registered IP right – even a published application - would mean immunity against infringement claims. The Court of Appeals precedents did set forth that the use of a registered right would not create infringement, would constitute a legitimate defense against infringement claims unless and until the registered right was duly invalidated. Although being seriously criticized, this was the settled precedent and caused serious delays in prevention of infringements, as the preliminary injunction (“PI”) demands and infringement cases had to be delayed until the actual cancellation of the registered right from the registry. Infringers abused this precedent by obtaining registrations in bad-faith and using those as leverage against the senior right holders who will not be able to prevent the use - or obtain a compensation for the term the IPR was registered, even though it was eventually cancelled.

Since the IP Code is recently enacted and this was a big change in the settled practice, we experienced for a while that the first instance courts, even the specialized ones, abstained from broader implementation of this new rule – i.e. while the infringement actions were heard, the PI claims were almost directly rejected.

Istanbul District Court 16th Civil Chamber, in its very recent decision dated March 14, 2018, implemented the new ruling of the IP Code to the pending conflict and clearly held in its reasoned decision that a registration will not create an immunity to its owner against infringement and PI claims and granted the PI in favor of the claimant, simply confirming that the use of a registered trademark can be prevented.

The District Court's above referenced decision was rendered upon appeal of a decision by Bakırköy Civil IP Court, in relation to the refusal of the PI demand for prevention of the use of the defendant's challenged trademark, in an trademark invalidation (based on the claimant's earlier marks) and infringement case. The specialized civil IP court grounded its dismissal of the PI demand on registered trademark of the defendant, but the District Court overturned this decision implementing the new ruling of the IP Code without hesitation preventing the use of the defendant's registered trademark.

This recent decision of the District Court constitutes one of the most significant practical impacts of the new IP Code so far and is very important, since it reaffirms that the registrations can no longer be used as leverage against brand owners.



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