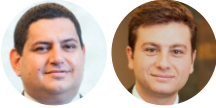


TURKEY

Brand owners must be careful about bringing criminal action for infringement

Gün + Partners
Istanbul



Barış Kalaycı and Talat Yörük

The enforcement of trademark infringement crimes is not ex-officio in Turkey. In other words, trademark owners have to file a criminal complaint to start criminal IP proceedings for each and every case. Thus trademark owners have to take into consideration beforehand, all possible risks that might occur in a worst case scenario, especially counterclaims which could include damages figures put forward by infringers if no fake products can be seized during an actual raid or even worse, if original products are seized during a raid instead of fakes.

A strategic approach to being prepared for such circumstances would be collecting all available concrete pieces of evidence relating to the criminal activity during the investigation phase, especially official ones such as notarised undercover test purchases etc. if it would not be possible to conduct a purchase with an invoice or a receipt which includes a clear definition of the fake products.

The recent ruling of the Court of Appeals which points out that “a person, the criminal IP case of whom was found groundless, would himself be considered to have created unfair competition” is a clear message for brand owners to take such incidents more seriously than ever.

In this specific case, the brand owner filed a criminal complaint and had a seizure conducted at the suspect’s address. The court-appointed expert determined that the seized products were originals. Upon his acquittal, the suspect started civil proceedings against the brand owner asking for a ruling of unfair competition, in addition to a claim for damages. The local court found the brand owner’s acts an exercise of legal rights and dismissed all claims. However, the Court of Appeals

overturned that decision, pointing out that the criminal complaint was not filed in good faith and its filing constituted excessive use of rights and thus, should be construed contrary to the rule of honesty. The Court of Appeals added that the brand owner could have taken alternative ways (e.g. filing a civil case) without leaving the plaintiff under the stress of criminal consequences and decided to overturn the dismissal decision which was rendered by the local court.

This recent precedent emphasises the importance of having all available concrete pieces of evidence at hand prior to starting criminal proceedings as well as how crucial the expert’s examinations can be in criminal proceedings. Moreover, brand owners could expect more compensation claims to be filed by suspects with whom they have had similar experiences before. This decision may also affect pending cases started after unsuccessful criminal raids, as the local courts might be more inclined to accept this type of claims in favour of suspects in the future.

Thus, brand owners not only should collect all available concrete pieces of evidence as to criminal activities prior to filing criminal complaints (such as notarised test purchases) but also try their best to conduct raids with the help of an expert so that they could reduce such risks and make sure that fake products are actually seized during the raid. For instance, even if no fake products can be found during the raid, a recent notarised test purchase proving that the infringer had sold a fake product which is also sealed and attached to that purchase’s minutes by the notary, would surely justify the raid conducted by the brand owner and block any counterclaim filed by the suspect.

Finally, it is advisable to use criminal IP litigation against identical infringements and civil IP litigation for matters that include a simpler level of similarity.