

Question Q219

National Group: Turkish Group

Title: **The availability of injunctions in cases of infringement of IPRs**

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Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Availability:

1. *Are injunctions for infringement of an IPR available on a provisional/preliminary basis?*

Yes, they are available.

2. *Are injunctions for infringement of an IPR available on a permanent basis?*

Yes, they are available.

Criteria:

3. *If yes to question 1, what are the criteria for the grant of an injunction on a provisional/preliminary basis?*

Criteria for the grant of an injunction on a provisional/preliminary basis –*merely granted in a provisional proceeding initiated prior to filing the main action for the security and assessment of evidences and provision of preliminary injunction-* are as follows:

- a. An injunction should be claimed in writing from the court.
- b. Claimed type of injunction should be specifically mentioned in the brief.
- c. The claimant should have a legitimate right and benefit to demand preliminary injunction...
- d. There should be a cause to request an injunction. This cause has been defined in IP Law as a situation "... in the face of serious damage where elapsing of time cannot be remedied...." In this case, the most significant point is the existence of an urgent need and securing fully the effectiveness of the judgement.
- e. There should be an actual or a potential (risk-danger of) infringement. Accordingly, IP right in question shall be used without the prior consent of its right owner or a serious and vigorous attempts and/or preparations for the exploitation of that IP right has to be conducted by the alleged infringer.
- f. Finally, balance of interests of the parties shall be taken into account.

4. *If yes to question 2, what are the criteria for the grant of an injunction on a permanent basis?*

The criteria for the grant of an injunction on a provisional/preliminary basis are also applicable for the grant of an injunction on a permanent basis.

5. *If not addressed in answering questions 3 and 4, does the criteria for the grant of an injunction differ depending on whether the injunction sought is on a provisional/preliminary or permanent basis? If so, how?*

Due to the nature of the provisional/preliminary and permanent injunctions, in the provisional/preliminary injunction the judge should be of the opinion that there is an infringement or potential (risk-danger of) infringement prima facie; however, in the permanent injunction, since the injunction would be decided as one of the final judgements in the verdict, the infringement should be proven during the trial.

6. *Are the criteria for the grant of an injunction equally applicable to infringement of all IPRs?*

No, it is not.

7. *If no to 6, are there any specific criteria or considerations for the grant of an injunction for particular IPRs? If so, what criteria apply and to which IPRs?*

There is a specific consideration for the grant of an injunction for patent applications with substantive examination. Contrary to the common practice, the owner of a patent application with substantive examination is entitled to demand preliminary injunction against an actual or potential infringement immediately after the publication of its application.

8. *Are there any specific criteria or considerations for particular subject matter, for example, pharmaceutical patents? If so, what criteria or considerations apply to what subject matter?*

There is not any specific criteria but some considerations for pharmaceutical patents of which shall be taken into account before the initiation of injunction proceedings. Accordingly, some activities related to medicinal products fall outside the scope of patent protection. These activities are:

a. Instant preparations of pharmaceuticals in pharmacies involving no serial production (or production in industrial scale) and carried out solely preparing the prescription and acts related to the pharmaceuticals thus prepared for the prescription;

c. All experimental activities regarding the registration of pharmaceuticals, including tests and experiments necessary for this registration.

Furthermore, know-how and trade secrets of both parties (especially the innovative drug company's) are of significance in the evaluation course of injunction demands especially regarding pharmaceutical patents. Accordingly, protection of know-how and trade secrets of both parties during the trial, in view of balancing the interests, is always considered by the judges.

9. *Are there any specific considerations relevant to particular IP holders, for example, NPEs? If so, what considerations are relevant and to what IPR holders?*

No, there is not.

Discretion:

10. *Is there any element of judicial discretion in relation to the grant of an injunction for infringement of IPRs? If so, how does the discretion apply?*

Except for the regulation as explained under Question 11, the grant of an injunction is within the discretion of the Court and there is not any obligatory situation in which the court has to grant an injunction.

In Turkish jurisprudence, any person entitled legally to bring an action as prescribed by the relevant IP legislation in Turkey, having the power of law, may demand from the Court to order precautionary measures provided that they can prove the existence of acts of actual use of the relevant IP right or serious and effective preparations to use the IP which would constitute an infringement. This statement constitutes the other limitation of discretion of the court. In Turkish IP Law, the court is bound by the demand of the IPR holder while granting an injunction. According to this principle, the court can not exceed the scope of the demand whereas it can rule the less.

In Turkish IP Law, the preliminary/provisional injunctions shall be in nature to enable of securing fully the effectiveness of the judgment and particularly provide the followings:

a. Cessation of the acts infringing the rights of the right owner/holder

b. injunction to seize within the borders of Turkey, wherever they are seen/found including the customs, free ports or free trade areas and keep in custody the goods produced or imported in infringement of rights conferred by IPRs,

c. ordering the placement of security/guarantee for damages to be compensated.

The above injunctive remedies are not subject to the *principle of numerus clausus*; therefore court can rule different types of injunctions to ensure the efficiency of the judgment. For instance, the seizure of the devices/materials/vehicles which are used in the manufacture of the infringing goods could be another sample of injunction. This is also a proof of existence of judicial discretion of the court in relation to the grant of an injunction. However; in the course of assessment of the scope of injunction, the Court should consider the principle of proportionality and should ensure the balance of interests between the parts.

While deciding on the type of an injunction, the court should consider whether the danger could be eliminated by a less strong injunction. For instance, if the guarantee is adequate ensuring the efficiency of the judgment then the seizure of the infringing goods should not be granted as an injunction because the action may be dismissed at the end.

The Court also has judicial discretion on whether compensation will be ordered against the damages to be sustained and whether the defendant or the plaintiff will undertake the compensation to be determined. As an example, the industrial design registration can be obtained upon a procedural examination in Turkey without seeking substantial examination as regards the novelty and individual character criteria. If the judge considers that the design subject to the injunction is not a strong design, he generally orders the defendant to provide a guaranty so that the defendant shall continue to use the said design, which is called reverse injunction in the practice.

11. *Are there any circumstances in which a court must grant an injunction for infringement of an IPR? If so, in what circumstances?*

In Turkey, as a rule, it is discretionary to grant an injunction; except the specific stipulation envisaged for utility models in Patent Decree-Law No.551. According to the said Decree Law, the holder of the utility model registration may not invoke rights conferred by the registration against third parties until the invalidation action initiated against him is finalized. Respectively, in Turkish jurisprudence, the plaintiff who files an invalidation action against a

utility model owner demands so-called “negative/statutory injunction” in the beginning of the invalidation action in order to prevent any potential legal attempt to be initiated by the utility model owner and the Courts grants the said statutory injunction in due respect without questioning as to whether or not the pre-conditions of an ordinary injunction is fulfilled.

12. *Are there any circumstances where infringement of an IPR is proved and no permanent injunction is available? If so, in what circumstances?*

There is no specific circumstance arranged in civil law and practice where infringement of an IPR is proved and no permanent injunction is available. It is necessarily accepted that the judicial discretion of the court is available in the cited situation as well.

13. *Is an injunction granted only against named parties to the infringement proceeding, or is an injunction available more broadly against potential infringers such as customers or manufacturers who are not parties to the proceeding?*

According to Turkish Law both preliminary and permanent injunctions are available only against named parties to the infringement proceeding.

14. *Is there a specific form of words used by your courts to describe the scope of the grant of an injunction? If so, what is the 'formula'?*

No, there is not a specific form of words used by Turkish courts to describe the scope of the grant of an injunction.

However, the judge should specify the points herein below mentioned in preliminary injunction decision that can not be defined with a formula.

a. Type of the injunction (For instance, injunctions for the seizure and confiscation, for placement of guarantee for the damages to be sustained etc.),

b. The form and the amount of the guarantee, if the grant of an injunction is conditioned to a guarantee,

c. The scope and objective of the injunction should be drawn explicitly in the decision for the bailiff to execute the injunction,

d. If an expert is inducted for the execution of the injunction, the name of the expert should be specified.

15. Is the grant of an injunction referable to the item(s) alleged to infringe the relevant IPR, or may the grant of an injunction be broader in scope? If it may be broader, what is the permissible scope of the injunction?

The grant of an injunction must be referable to the items alleged to infringe the relevant IPR. Judges may not grant a decision about the case deprived of both parties' demands. Courts apply that rule, for both preliminary injunction and permanent injunction.

Judicial trends and practice:

16. Is there any discernible trend in your country as to the willingness or otherwise of courts to grant or refuse injunctions for particular IPRs or in relation to particular subject matter?

The judges try to provide the balance of interests among the parties to grant an injunction. For instance, while judges are granting an injunction, in some cases, the necessity to procure the balance of interests may be raised as a necessity to protect rights of the other party. In that point, judge orders the deposition of a guarantee by the plaintiff in return for injunction for the procurement of the balance of interests.

On the other hand, with the aim of providing the balance among the parties, the judge sometimes rejects the demand for an injunction of the plaintiff. but orders the counter party guarantee in order to let the counter party continue its business.

17. What, if any, has been the impact of the *eBay v Merc-Exchange* decision or any tendency of the courts in your jurisdiction to treat final injunctions as discretionary? Please explain whether the *eBay v Merc-Exchange* decision has been relied on or cited by your courts, and in what circumstances. Alternatively, or in addition, has there been any legal commentary on any potential implications of the *eBay v Merc-Exchange* decision in your jurisdiction?

There is no impact of the e-Bay, Merc-Exchange decision in our jurisdiction yet.

II. Proposals for harmonisation

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to injunctions for infringement of IPRs. More specifically, the Groups are invited to answer the following questions:

Availability of provisional/preliminary injunctions:

18. *Should there be a test or criteria for the grant of a provisional/preliminary injunction for the infringement of an IPR? If yes, what should that test or those criteria be?*

Yes, there should be some criteria for the grant of a provisional/preliminary injunction for the infringement of an IPR, because injunctions are applied in specific circumstances where the serious damage is caused and not remedied due to lapse of time. Accordingly, in addition to the above-mentioned criteria in question 3, the balance of interest should always be considered.

Furthermore, considering the technical character of the patents and the difficulty of giving a decision regarding the infringement in patents, we think that in addition to the reference of the patent claims, a quick expert witness examination could minimize the procurement of false judgements.

In addition, there is not any Decree Law in Turkey adopted the Article 43 of the TRIPs Agreement. There are some difficulties in provision of the necessary evidence to the

evaluation of the judges. Accordingly, in an infringement case where the seizure of relevant commercial books of one of the parties is necessary, authorizing the judge directly by the law to seize the relevant documents, would avoid these problems.

19. *If no, what principles should be considered in determining whether to grant an provisional/preliminary injunction?*

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Availability of permanent injunctions:

20. *Should there be a test for the grant of a permanent injunction for the infringement of an IPR? If yes, what should that test be?*

No, there should not be any test for the grant of a permanent injunction for the infringement of an IPR, because there could be some different conditions in every infringement which should be considered. Accordingly, Turkish Group considers that a specific and strict test should not be applied.

21. *If no, what principles should be considered in determining whether to grant a permanent injunction?*

The principles/criteria for granting an injunction which are mentioned above in the relevant questions should be applied within the scope of the judicial discretion.

Discretion:

22. *In what circumstances, if any, should the grant of an injunction automatically follow a finding of infringement of an IPR?*

In correspondence with the reply of the question 20, since the concrete conditions of each infringement may differ, the grant of a preliminary injunction should not automatically follow a

finding of infringement. The circumstances for granting an injunction which are mentioned above in the relevant questions should be applied within the scope of the judicial discretion.

23. *In what circumstances, if any, should the grant of an injunction be denied notwithstanding a finding of infringement of an IPR?*

In this situation as well, the grant of injunction should depend on the conditions of the case but especially for some cases, for instance, in the event (a) alleged infringer acts unintentionally and without negligence, (b) execution of the precautionary measures in question would cause him/her disproportionate harm and (c) pecuniary compensation to the injured party appears reasonably satisfactory, the grant of injunction should be denied correspondingly with the Article 12 of Directive 2004/48/EC

Differences between IPRs:

24. *Should the above test/principles apply equally to all IPRs?*

No.

25. *If no, what should any differences be and why?*

In parallel with the questions/replies above, a specific and strict test should not be applied. Infringement actions should be evaluated to the speciality of the concrete case.

Scope:

26. *Should an injunction be granted only against named parties to infringement proceeding, or should an injunction be available more broadly against potential infringers such as customers or manufacturers who are not parties to the proceeding?*

An injunction should also be available broadly against potential infringers who are not parties to the proceeding, on condition that the plaintiff specifies it amongst his demands. In order prevent the infringer from delivering the goods to the third parties with bad faith prior to the grant or execution of an injunction, an injunction should be available more broadly against potential infringers. In the contrary case, it would be difficult to grant an enforceable injunction decision.

27. What is the appropriate scope of an injunction prohibiting an infringer from committing further infringing acts? For example, should the injunction relate simply to the IP the subject of the allegation of infringement, or should the injunction be broader in scope? If broader, what is the permissible or desirable scope?

An injunction should relate simply to the IP right that is the subject of the allegation of infringement. It should not be broader in scope. For instance, granting an injunction about a trademark which is not made subject to an infringing act goes beyond the basic purpose of the institution of an injunction.

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Note: It will be helpful and appreciated if the Groups follow the order of the questions in their Reports and use the questions and numbers for each answer. If possible type your answers in a different colour. Thank you for your assistance.

SUMMARY

Both preliminary/provisional and permanent injunctions are applied in Turkey. Accordingly, there is not any specific rule/test for the grant of an injunction; however, there are some criteria considered by the judicial authorities.

The grant of an injunction is within the discretion of the Court except for the utility models. However; the court should consider the principle of proportionality and should ensure the balance of interests between the parts in the course of assessment of the scope and objective of the injunction.

Furthermore, according to Turkish IP Law, injunctions are available only against the named parties to the infringement proceeding. There is not a specific form of words used by our courts to describe the content of an injunction within the scope of the legislation. However, the judge should specify some significant points in his decision. In correspondence with the most important factor "the consideration and procurement of balance of interests", judges also have to protect rights of the counter-party for some cases.

RÉSUMÉ

Des mesures préliminaires/provisoires ainsi que celles permanentes sont appliquées en Turquie. Par conséquent, il n'existe pas de règle/examen spécifique pour l'obtention d'une mesure. Cependant, certains critères sont pris en compte par les autorités judiciaires.

La décision des mesures conservatoires est laissée à la discrétion des juges à l'exception de ce qui concerne les modèles d'utilité. En revanche, le tribunal doit tenir compte du principe de proportionnalité et doit assurer l'équilibre des intérêts entre les parties au cours de l'évaluation de la portée et du but de la mesure.

En outre, selon les dispositions en matière de propriété intellectuelle en Turquie, des mesures peuvent être prises uniquement contre les parties citées dans le cadre d'une procédure de contrefaçon. Aucun terme spécifique décrivant la teneur d'une mesure, n'existe dans la législation turque. Cependant, le juge doit préciser certains points importants dans sa décision. Dans certains cas, les juges doivent également protéger les droits des parties adversaires conformément à l'élément le plus important qui est "la prise en considération et l'obtention de l'équilibre des intérêts".

ZUSAMMENFASSUNG

Sowohl die vorläufigen/provisorischen als auch die dauerhaften einstweiligen Verfügungen werden in der Türkei angewendet. Demzufolge gibt es keine besondere Regel/ Prüfung für Erteilung einer einstweiligen Verfügung, doch aber einige Maßstäbe, die von den Justizbehörden berücksichtigt werden sollten.

Gewährung einer einstweiligen Verfügung steht im Ermessen des Gerichts, allerdings mit Ausnahme von Gebrauchsmustern. Das Gericht soll aber die Grundsätze der Verhältnismäßigkeit in Erwägung ziehen und das Gleichgewicht der Interessen zwischen den Parteien, und zwar im Zuge der Beurteilung des Umfangs sowie der Zielsetzung der einstweiligen Verfügung gewährleisten.

Darüber hinaus stehen die einstweiligen Verfügungen gemäß dem türkischen geistigen Eigentumsrecht nur gegen benannte Parteien des Verletzungsverfahrens zur Verfügung. Es gibt keine spezifische Form von Worten, die von unseren Gerichten verwendet werden sollten, um den Inhalt einer einstweiligen Verfügung im Rahmen der Gesetzgebung zu beschreiben; der Richter soll jedoch in seiner Entscheidung einige wichtige Punkte angeben. Dementsprechend sollte der Richter in einigen Fällen, in Übereinstimmung mit dem wichtigsten Faktor "Berücksichtigung und Beschaffung des Ausgleichs der Interessen" auch die Rechte der Gegenpartei schützen.