

Question Q236

National Group: Turkish Group

Title: Relief in IP proceedings other than injunctions or damages

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Questions

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

I. Analysis of current law and case law

1) What forms of Additional Relief are available in IP proceedings?

Types of applicable additional relief available in IP proceedings in Turkey are declaratory relief, delivery up/destruction, rectification, alteration due to infringing, corrective advertising, publication of judgement, order to provide information, accounts of profit, reasonable royalty and reparation, which are mentioned in the chart and reputational damages which are not mentioned in the chart.

2) Are those forms of Additional Relief available for all types of IPRs? If not, please indicate what types of Additional Relief are available for what types of IPRs.

Not all types of additional relief are available for all types of IPRs. Please find below the chart showing which forms of additional relief are available for which types of IPRs;

relief	patent	trademark	copyright	design	Unfair competition.
Declaratory relief	yes	yes	no	yes	yes
Delivery up/destruction	yes	yes	yes	yes	yes

Rectification	no	no	yes	no	no
seizure of entitlement	no	no	no	yes	no
Alteration due to inf.	yes	yes	yes	yes	yes
Modification of technology	no	no	no	no	no
Corrective advertising	no	no	yes	no	yes
Publication of judgment	yes	yes	yes	yes	yes
Order to provide information	yes	yes	no	yes	no
Account of profits	yes	yes	yes	yes	yes
Reasonably royalty	yes	yes	no	yes	no
reparation	no	no	yes	no	no
Reputational damages	yes	yes	yes	yes	no

- 3) Having regard to the types of Additional Relief available addressed by questions 1 and 2, what are the criteria for the grant of that relief? There may be different criteria for the different types of Additional Relief identified. Hence, the Groups are asked to address the individual criteria for each type of Additional Relief that is available in IP proceedings in their country.

Declaratory relief

Unfair competition : A person/company who/which believes that his/their rights, customers, professional reputation, economic benefits are being harmed by third party actions can request from the Court by filing lawsuit to determine whether these third party actions are unfair or not.

Patent, Trademark, Design: Any interested person can institute proceedings against the proprietor of a patent to obtain a judgment of non-infringement of rights conferred by the patent/trademark/design. Prior to the institution of proceedings, a notice shall be served through a notary public to the attention of the proprietor of the patent/trademark/design. Where the proprietor of the patent/trademark/design upon receiving such notice does not respond within one month from receiving the notice, or the content of the response is not found acceptable by the interested person, he shall have the right to institute proceedings according to the first paragraph. Persons, against whom action of infringement has been instituted in respect of the patent/trademark/design right, cannot institute the above mentioned proceedings. Institution of proceedings shall be notified to all right holders registered before the Patent/Trademark/Design Registry. The actions can also be instituted jointly with an action claiming invalidity.

Delivery up / Destruction

Patent, Trademark, Design, Unfair competition: The right owner who filed an infringement action or an unfair competition action before the Court can request from the Court to order the destruction of the infringing products and utilities which facilitate the infringing actions.

Copyright : In case a work is used by way of unauthorized duplication and the duplicated copies have not been marketed, the owner of the work who filed an infringement action before the Court may demand the destruction of the duplicated copies and the films, shapes and similar devices used for duplication or the delivery of the duplicated copies and the films, shapes and similar devices used for duplication against a suitable value not to exceed the actual cost.

Rectification

Copyright: Upon the request of the owner of the work can request amendment of the registry of the professional associations as an additional relief from the Court. The decision of the Court binds the third parties which are the member of the professional associations. In addition to that in case the creator of a work is disputed or any person claims that he is the owner of the work, the original owner may request the establishment of his right from the court.

Alteration due to infringement

Patent : The right owner who filed an infringement action before the Court can request from the Court to order modification of the shapes of the products.

Trademark : The right owner who filed an infringement action before the Court can request from the Court to order the removal of the infringing trademark from the products.

Copyright : In case the name of the owner has not been placed at all on the work or placed wrongly or the name placed might lead to confusion and the owner of the work has requested the elimination of the violation from the Court by filing an infringement action, if the Court decides in favour of the plaintiff, the other side is obliged to inscribe the name of the owner of the work on both the original and the duplicated copies in circulation.

Design: The right owner who filed an infringement action before the Court can request from the Court to order alteration on the infringing products and equipments.

Unfair competition : The right owner who filed an unfair competition action before the Court can request from the Court to order alteration on the violating products and equipments.

Corrective advertising

Patent : x

Trademark : x

Copyright : The owner of the work can demand the prohibition of the duplication, promulgation, performance and radio broadcasting of the modified work and the violator to correct the modifications in the duplicated copies in circulation or to restore them in an infringement action. If the modification has taken place during the promulgation of the work through newspapers, periodicals or radio, the owner of the work can also demand from all

the newspaper, periodical and radio administrations that have promulgated the modified work to correct the modification by way of announcement at the cost of the violator.

Design : x

Unfair competition : If an unfair competition is caused by false statements, the right owner can request the correction of these false statements in an unfair competition action.

Publication of Judgement

Patent, Trademark, Design, Copyright : Where a court judgment becomes finalized, the successful party can request the publication, in full or in summary, of the final judgment in a daily paper, or by similar means, the costs of which are to be met by the violator. The nature and extent of the publication shall be determined in the judgment. The right of publication shall be void, if not exercised within three months after the judgment becomes finalized.

Unfair competition : Where a court judgment becomes finalized, the successful party can request the publication, in full or in summary, of the final judgment in a daily paper, or by similar means, the costs of which are to be met by the other party. The nature and extent of the publication shall be determined in the judgment.

Order to provide information :

Patent, Trademark, Design: By filing a civil court action the right holder can request from the infringing party the documents related with the use of the patent/trademark/design without his consent, for calculation of the damage/prejudice suffered as a result of the infringement.

Accounts of Profits:

Patent, Trademark, Design, Copyright: In an infringement action the right holder can request from the Court to calculate the loss of profit according to the income generated by the infringing party from the use of the patent/trademark/design/work.

Unfair competition: In an unfair competition action the right holder can request from the Court to calculate the loss of profit according to the income generated by the infringing party as a result of the unfair competition.

Reasonable royalty

Patent, Trademark, Design: In an infringement action the right holder can request from the Court to calculate the reasonable royalty according to a license fee that would have been paid if the party, infringing the patent/trademark/design right, would have lawfully utilized the patent/trademark/design under a licensing contract

Reparation

Copyright : In cases of fine arts, the owner of the work can demand in an infringement action that a modification or deletion was not made by himself or his name was changed on the work. In case reparation is possible and the removal of the modification does not substantially damage the interests of the public or of the owner, the owner of the work can restore the work.

Reputational damages

Patent, Trademark, Design, Copyright: The proprietor of a patent/trademark/design/work can request in an infringement action extra damages where the reputation of the invention/trademark/design/work, is harmed/prejudiced by manufacturing in a bad or marketing in an improper manner, by the party violating the rights conferred by the patent trademark/design/work.

- 4) Is there any element of judicial discretion in relation to the grant of any form of Additional Relief addressed in questions 1 and 2? If so, how is that discretion applied?

If a court has decided on the existence of infringement or unfair competition, the additional relief/ relieves requested by the right owner in the initial brief when filing the lawsuit would be expected to be granted.

For some particular additional relieves the court has the discretion on determining the extent or the amount of the relief to be provided. Regarding “corrective advertising”, “reasonable royalty”, “reputational damages” and “account of profits” it is in Court’s discretion to decide on the extent or the amount of the relief. Under the Civil code regulating use of discretion by the judges, a judge must apply his discretion based on the rules of justice and equity and taking into account the specific particulars of each case.

- 5) Are any particular forms of Additional Relief invariably ordered in certain circumstances? If so, what types of Additional Relief and in what circumstances? Does that occur pursuant to mandatory statutory regulation, or by reason of the practice of the relevant court (or applicable administrative body)?

If the right owner has properly demanded an additional relief in the initial brief when filing the lawsuit and if the existence of infringement or unfair competition is determined, where the criteria set by the relevant law as explained in detail under Question 2 above are met, a court would order the grant of an additional relief.

- 6) Are there any specific considerations relevant to particular IPR holders? If so, what considerations are relevant and in respect of what IPR holders?

No, there are not any specific considerations relevant to particular IPR holders.

However, according to the relevant Decree-Laws, IPRs may be licenced and a licence may be exclusive or non-exclusive. There are specific considerations relevant to licensees. Unless otherwise provided in the contract, the holder of an exclusive licence may, in the event of infringement of the IPRs, institute in his own name all legal proceedings available to the IPR holder under relevant Decree-Laws. Accordingly, in the case of infringement the Court may grant additional reliefs on behalf of the holder of an exclusive licence. However, holders of non-exclusive licences shall not have the right to institute legal proceedings.

In Turkish copyright law, according to the relevant Law, the authority to merely exercise the financial rights may be licenced and a licence may be simple (non-exclusive) or full (exclusive). There is no specific provision responding the fact whether the holder of licence has the right to institute a court action against the infringement of their rights or not.

In the doctrine, it has been stated that the holder of the licence may institute legal proceedings in the event of infringement by oneself. Similarly, the Court may grant additional reliefs on behalf of the holder of a licence in the event of infringement.

Moreover, the related right owners may also institute legal proceeding and claim additional reliefs in the event of infringement.

- 7) Can a court (or applicable administrative body) order any form of Additional Relief directly against a non-party to an IP proceeding?

Under the procedural and enforcement rule that a judgement is effective and enforceable only between the parties, it is not possible to say that a court can order any form of additional relief directly against a non-party to an IP proceeding. However, there is an exception under the provisions of the Turkish Commercial Code regulating unfair competition. The exception is that, if prevention and correction of unfair competition necessitates, a judgement can be enforced against third parties who have directly or indirectly obtained the goods produced as a result of unfair competition. It should be noted that although it may be enforceable against a third party, the judgement would not address a third party directly.

- 8) If yes to question 7:

- a) in what circumstances;

A judgment can be enforceable against a third party in cases of unfair competition and for ensuring prevention and/ or correction of unfair competition.

- b) what forms of Additional Relief may be ordered; and

The additional relief that may be enforced against non-parties under unfair competition law would be; delivery up/ destruction, alteration due to infringement and corrective advertising.

- c) in respect of what types of IPR infringement?

Unfair competition including trade secrets, confidential information and trade names.

- 9) Is a court (or applicable administrative body), in making an order for Additional Relief against an IPR infringer who is a party to the IP proceeding, obliged to consider the impact of such order on any non-party? If so, how does the court (or applicable administrative body) fulfil that obligation?

No. However, regarding the additional reliefs where the judge has discretion in issuing, a judge would be expected to consider all aspects including the impact of the order on non-parties.

- 10) If yes to question 7 or 9, is the court (or applicable administrative body) obliged to give any relevant non-party an opportunity to be heard? If so, how is that effected?

No, the court is not obliged to hear any non-party.

II. Proposals for harmonisation

Groups are invited to put forward proposals for the adoption of harmonised rules in relation to Additional Relief in IP proceedings. More specifically, the Groups are invited to answer the following questions:

- 11) What forms of Additional Relief should be available in IP proceedings, and for what types of IPRs?

The Turkish Group believes that the additional relieves provide to IPR Holders are quite sufficient and extensive. The Turkish Group however believes that in cases of patent, trademark and design infringement corrective advertising should be an available remedy as in copyright infringement. Corrective advertising may be a deterrent remedy for infringers and may be an effective remedy in cases of infringement.

- 12) What should the criteria be for the grant of the types of Additional Relief identified in response to question 11?

The criteria for corrective advertising in copyright infringement may be applied to patent, trademark, design infringement where possible.

- 13) Should there be any specific considerations relevant to particular IPR holders? If so, what should those considerations be and in respect of which IPR holders?

The Turkish Group believes that making any distinction between particular IPR holders may impose certain risks and therefore there should not be any distinction between certain IPR Holders.

- 14) Should any particular form of Additional Relief be mandatory in certain circumstances? If so, what types of Additional Relief and in what circumstances

The Turkish Group does not have any proposals in this respect.

- 15) Should a court (or applicable administrative body) be empowered to order any form of Additional Relief directly against a non-party to an IP proceeding?

No. Under the constitutional right and the fundamental procedural rule of being legally heard and the rule of a judgment being enforceable between the parties we do not believe that a judge should be empowered to order any form of additional relief against a non-party.

- 16) If yes, to question 15:

a) in what circumstances;

b) what forms of Additional Relief should a court (or applicable administrative body) be empowered to order; and

c) in respect of what types of IPR infringement?

- 17) Should a court (or applicable administrative body), in making an order against an IPR infringer who is a party to the proceeding, be obliged to consider the impact of such order on any non-party? If yes, how should the court (or applicable administrative

body) fulfil that obligation?

With respect to the additional relieves where the judge has the discretion in issuing, the judge should be expected to consider the impact of such order on any non-party.

- 18) If yes to question 15 or 17, should the court (or applicable administrative body) be obliged to give any relevant non-party an opportunity to be heard? If so, how should that be effected?
- 19) Please provide any other proposals in respect of harmonisation as to the types of Additional Relief that should be available in IP proceedings and the conditions in which such relief should be ordered.

SUMMARY

There is a large number of additional relieves available in IP proceedings under Turkish Law, including but not limited to delivery up and destruction, rectification, publication of judgment and account of profits. All types of additional relieves are not available for all types of IP Rights. The specific laws on specific IP Rights provide different types of additional relief. The general criteria for all types of additional relief can be set as existence of infringement and a claim made by the IPR holder. Other than these two criteria there are specific criteria for specific types of IPR's. Judges do have the discretion on whether or not to grant an additional relief. With respect to some types of additional relief, such as the reputational damages and reasonable royalty, a judge has the discretion as to the amount of damages and as to the extent of the additional relief to be granted. The Turkish Law does not make a distinction between particular IPR Holders in terms of additional relieves available. A court cannot order any form of additional relief directly against a non-party however, in cases of unfair competition an order may be enforced against a non-party under certain circumstances. There is no obligation on a judge to consider the impact of an order for additional relief on a non-party however, in cases where the judge has discretion in granting a relief or on the extent of the relief, a judge would take into account the impact of the order on all relevant parties. Overall, the Turkish Group believes that the additional relieves available to IPR Holders can be considered to be satisfactory for holding the balance between protection of IPR's and the public interest in general. Although there is no urgent need for principal changes in that respect, in near future, we may need adaptations and amendments in law in order to keep up with the fast developments in technology and especially in the information technologies.

ZUSAMMENFASSUNG

Im Türkischen Recht stehen eine große Anzahl von zusätzlichen Entlastungen bei den Verfahren bezüglich der Rechte des geistigen Eigentums (IP-Rechte) zur Verfügung, einschliesslich der Verkündigung und Destruktion, Berichtigung sowie Veröffentlichung des Urteils und Berechnung des Gewinns, aber es ist mit diesen nicht begrenzt, Jede Arten von zusätzlichen Erleichterungen sind jedoch für jede Arten von geistigen Eigentumsrechten nicht verfügbar. Die bestimmten Gesetze zu bestimmten IP-Rechten liefern verschiedene Arten von zusätzlichen Entlastungen.

Die allgemeinen Kriterien für alle Arten von zusätzlichen Entlastungen können als Existenz von Rechtsverletzung festgesetzt werden und ein Anspruch durch Inhaber des geistigen Eigentums wird erhoben. Anders als diese zwei Kriterien gibt es spezifische Kriterien für bestimmte Arten von IP-Rechten. Es steht nach Ermessen der Richter zu, ob eine zusätzliche Entlastung zu gewähren ist oder nicht. Mit Bezug auf einige Arten von zusätzlichen Entlastungen, wie Rufschädigungen und angemessene Lizenzgebühr, handelt ein Richter nach eigenem Ermessen betreffend die Höhe des Schadens sowie den Umfang der zu bewilligenden Entlastung. Das türkische Recht macht keinen Unterschied zwischen bestimmten IP-Recht-Inhabern bezüglich der zur Verfügung stehenden zusätzlichen Entlastungen. Ein Gericht kann irgendeine Form von zusätzlichen Entlastungen unmittelbar gegen eine Unparteiliche nicht anordnen; im Falle des unlauteren Wettbewerbs jedoch kann unter bestimmten Umständen eine Anordnung gegen eine Unparteiliche erzwungen werden. Es besteht für einen Richter keine Verpflichtung, die Auswirkung einer Anordnung für zusätzliche Entlastung auf eine Unparteiliche zu berücksichtigen; in Fällen jedoch, in denen die Bewilligung einer Entlastung bzw. der Umfang der Entlastung nach Ermessen des Richters zusteht, würde der Richter die Auswirkung der Anordnung auf alle zutreffende Parteien in Betracht ziehen. Insgesamt glaubt die Türkische Gruppe, dass die zusätzliche Entlastungen, die für IP-Recht-Inhaber verfügbar sind, können als Gleichgewicht zwischen dem Schutz des IP-Recht-Inhabern und dem öffentlichen Interesse ganz allgemein angesehen werden. Obwohl es in dieser Hinsicht kein dringendes Bedürfnis für hauptsächliche Änderungen gibt, könnten wir in naher Zukunft Anpassungen und Verbesserungen in der Gesetzgebung brauchen, um mit den raschen Entwicklungen in der Technologie, vor allem aber in der Informationstechnik Schritt zu halten.

RÉSUMÉ

Il ya un grand nombre de remèdes/secours supplémentaires disponibles dans les procédures de propriété intellectuelle en vertu du Droit Turc, y compris mais non limité à la remise et la destruction, la rectification, la publication du jugement et le calcul des profits. Tous les types de remèdes supplémentaires ne sont pas disponibles pour tous les types de droits de propriété intellectuelle. Les lois spécifiques sur les droits de propriété intellectuelle stipulent différents types de remèdes supplémentaires. Les critères généraux pour tous les types de remèdes supplémentaires peuvent être définis comme l'existence de l'infraction et une réclamation faite par le titulaire de droits de propriété intellectuelle. En dehors de ces deux critères, il ya des critères spécifiques pour les types spécifiques de droits de propriété intellectuelle. Les juges ont la discrétion pour accorder ou non un remède supplémentaire. En ce qui concerne certains types de remèdes supplémentaires tels que les dommages pour la réputation et la redevance raisonnable, le juge a la discrétion quant au montant des dommages et quant à l'étendue du remède supplémentaire à accorder. Le Droit Turc ne fait pas de distinction entre les titulaires particuliers de droits de propriété intellectuelle en termes de remèdes supplémentaires disponibles. Un tribunal ne peut pas ordonner toute forme de remède supplémentaire directement contre une non-partie cependant, en cas de concurrence déloyale une ordonnance pourrait être exécutée contre une non-partie sous certaines circonstances. Il n'ya aucune obligation pour un juge de considérer l'impact d'une ordonnance pour un remède supplémentaire sur une non-partie cependant, dans les cas où le juge a la discrétion dans l'octroi d'un remède ou dans l'étendue du remède, un juge tiendra compte de l'impact de l'ordonnance sur toutes les parties concernées. Dans l'ensemble, le Groupe Turc estime que les remèdes supplémentaires disponibles aux titulaires de droits de propriété intellectuelle peuvent être considérés satisfaisants pour la tenue de l'équilibre entre la protection des droits

de propriété intellectuelle and l'intérêt public en général. Bien qu'il n'ya pas de besoin urgent pour de principaux changements à cet égard, dans un proche avenir, nous pourrions avoir besoin à des adaptations et des modifications en loi afin de faire face aux développements rapides en technologies et particulièrement en technologies d'information.