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**„ A COMPARISON OF THE RIGHTS GRANTED BY THE REGISTERED
TRADEMARKS AND THE LEGAL REMEDIES IN THE EVENT OF A
VIOLATION OF THESE RIGHTS UNDER TURKISH AND EUROPEAN
UNION TRADEMARK LAW “**

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ABSTRACT

Trademarks, which have become an essential instrument in commerce, are protected globally and substantially under the name Trademark Law. Today, the protections granted to trademarks under Turkish Trademark Law are primarily provided by the Industrial Property Law No. 6269 and the Regulation on the Implementation of the Industrial Property Law, whereas the protections granted to trademarks under European Union Trademark Law are primarily provided by the EU Trademark Directive No. 2015/2436, the EU Trademark Regulation No. 2017/1001 and EU Directive No. 2004/48. This study compares the rights granted by the registered trademarks and the legal remedies in the event of a violation of these rights under Turkish and European Union Trademark Law. After explaining the historical development of Turkish and EU Trademark Law and the current legal regulations in the first section of our study, the second section provides general background information on the topic, with a focus on trademark means, trademark rights, and the acquisition of trademark rights. Comparing the Turkish and EU Trademark Laws, the third section of the study evaluates the acts constituting trademark infringement, and the fourth section assesses the legal remedies that can be applied in the event of trademark infringement. Following that, the fifth segment of the study examines the procedural aspect of trademark infringement cases, and the sixth section discusses trademark infringement offenses.

Key Words: Trademark, European Union Trademark, Registered Trademark, Trademark Right, Trademark Law, European Union Law, Trademark Protection, Trademark Infringement, Trademark Infringement Case

ZUSAMMENFASSUNG

Markenzeichen, die zu einem wesentlichen Instrument im Handel geworden sind, werden weltweit und im Wesentlichen unter dem Namen Markenrecht geschützt. Heute werden die Markenrechte nach dem türkischen Markenrecht hauptsächlich durch das Industrieigentumsrecht Nr. 6269 und die Durchführungsverordnung zum Industrieigentumsrecht gewährt, während die Markenrechte nach dem EU-Markenrecht hauptsächlich durch die EU-Markenrechtsrichtlinie Nr. 2015/2436, die EU-Markenrechtsverordnung Nr. 2017/1001 und die EU-Richtlinie Nr. 2004/48 gewährt werden. Diese Studie vergleicht die Rechte, die durch die eingetragenen Marken gewährt werden, und die rechtlichen Mittel im Falle einer Verletzung dieser Rechte nach dem türkischen und dem EU-Markenrecht. Nach der Darstellung der historischen Entwicklung des türkischen und des EU-Markenrechts und der aktuellen gesetzlichen Bestimmungen im ersten Abschnitt unserer Studie, bietet der zweite Abschnitt allgemeine Hintergrundinformationen zum Thema, mit einem Schwerpunkt auf Markenmittel, Markenrechte und den Erwerb von Markenrechten. Der dritte Abschnitt der Studie vergleicht das türkische und das EU-Markenrecht und bewertet die Handlungen, die eine Markenverletzung darstellen, und der vierte Abschnitt bewertet die rechtlichen Mittel, die im Falle einer Markenverletzung angewendet werden können. Anschließend untersucht der fünfte Abschnitt der Studie den prozeduralen Aspekt von Markenverletzungsfällen, und der sechste Abschnitt diskutiert Markenverletzungsdelikte.

Schlüsselwörter: Marke, Europäische Union Marke, Eingetragene Marke, Markenrecht, Markenrecht, Europäisches Unionsrecht, Markenschutz, Markenverletzung, Markenverletzungsfälle.

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LIST OF ABBREVIATIONS

AdWords	: Advertisement Words
A.D.	: Access Date
CJEU	: Court of Justice of the European Union
EC	: European Commission
EPO	: European Patent Office
EU	: European Union
EUIPO	: European Union Intellectual Property Office
EUTM	: European Union Trademark
p.	: Page
TRIPS	: Agreement on Trade-Related Aspects of Intellectual Property Rights
WIPO	: World Intellectual Property Office
WTO	: World Trade Organization

INTRODUCTION

With the development of economic, commercial, and technological life in the present day, the evolution of the trademark concept has become inevitable. Due to expanding opportunities, production has become more diverse, and the same product is now manufactured in numerous places of business. With this increase in production diversity, the issue of how and on what the manufacturer's product preferences will be based has emerged. Therefore, the concept of trademark was created in order to educate the consumer by differentiating the products and services of one enterprise from those of other enterprises.

Trademarks are a necessary component for companies to maintain their position in both domestic and international markets, to compete with other firms in an equitable way, and to preserve their reputation. As the functions of trademarks expand over time, trademarks have become extremely valuable components. Due to the value of the trademark, there is a need for legal protection of trademarks, and nations have enacted a variety of legal protections for trademarks in their legislation.

In this study, I discuss Turkish Trademark Law and European Union Trademark Law. In Turkish Trademark Law, trademarks are primarily protected by the Industrial Property Law No. 6769 and the Regulation on the Implementation of the Industrial Property Law, whereas in the Trademark Law of the European Union, trademarks are protected by EU Trademark Directive No. 2015/2436, EU Trademark Regulation No. 2017/1001, EU Directive No. 2015/2436 and EU Directive No. 2004/48.

As a consequence of the increasing value of trademarks, the issue of unauthorized use of the trademark and its value by third parties has emerged. These unauthorized uses by third parties, known as trademark infringement, cause economic and reputational damage to the owners of the trademark. For this reason, trademark owners must understand the scope of their rights, which actions comprise an infringement of trademark rights, and the legal recourses available to them in such a situation. In different legal systems, the scope of the trademark right at issue, the acts that infringe on the trademark right, and the available legal remedies may vary. By comparing Turkish and European Union Trademark Law regulations, these issues will be discussed in this research.

In the first section of this study, following an explanation of the historical development of the regulations in Turkish and EU Trademark law, the applicable legal provisions of both legal systems will be discussed. In the second section, general and fundamental trademark and trademark rights information will be provided. In this context, the concept of trademark, trademark right,

trademark right's distinguishing features, and methods for acquiring trademark right will be explained. Then in the third section, the thesis' principal topic will be introduced, and acts that infringe trademark rights will be examined in accordance with Turkish and EU trademark law. In this context, the typical occurrences of trademark infringement as specified by both laws will be included. Then, in the fourth chapter, the legal remedies available to the trademark owner in the event of trademark infringement, which is the subject of the thesis, will be discussed. In this context, the categories of litigation that trademark right holders can submit, the requests they can make to the court, and other issues will be compared between Turkish and European Union trademark law. After that in the fifth section of the study, procedural concerns associated with these legal solutions will be compared. In this context, the case's litigants, the competent and authorized courts, the statute of limitations, and the case's prerequisites will be specified, respectively. In the final section of the research, the criminal aspect of trademark infringement will be discussed briefly.

PART I: LEGAL REGULATIONS REGARDING TRADEMARK LAW

1.1. RESOURCES OF EUROPEAN UNION TRADEMARK LAW

EU Trademark Directive No 2015/2436¹ and the EU Trademark Regulation No 2017/1001² constitutes the most essential legal regulations underlying the European Union Trademark Law. With the EU Trademark Directive, international standards for trademark protection have been established, and it has been requested that the member states' domestic laws be harmonized with this Directive. Some of the rules of the EU Trademark Directive are left up to the discretion of the member states to be implemented, despite the fact that the EU Trademark Directive does include common binding provisions on the protection of trademarks in general.

Issues pertaining to the Community Trademark, which provides a uniform trademark right inside the EU and has the same impact in all member states, are governed with the EU Trademark Regulation. While this EU Trademark Regulation governs the fundamental aspects of a Community trademark, EU Directive No. 2004/48³ governs some of the legal remedies that a trademark right holder may pursue in the event of a trademark infringement.

In the European Union, the double trademark protection system has been adopted. According to this strategy, the trademark registrant can demand trademark protection at both the national and community levels.⁴ If the applicant does not wish to obtain uniform EU protection, he can obtain trademark protection that is valid only in the countries to which he has applied by submitting an application to the Trademark Patent Offices of the countries in which he wishes to claim trademark protection. If the trademark applicant intends to seek protection throughout the EU, he or she must submit an application to the European Union Intellectual Property Office (EUIPO). The application will be registered as European Union Trademark (EUTM) if it is accepted after examination.⁵ In other words, submitting a single application to EUIPO will provide the applicant with uniform trademark protection throughout the EU. The application must be accepted by all member states for the trademark to be registered as an EU Trademark. Otherwise, the trademark

¹ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, Official Journal of the European Union, Legislation 336, 23.12.2015

² Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, Official Journal of the European Union, Legislation 154, 16.06.2017

³ Directive 2004/48 EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights, Official Journal of the European Union, Legislation 157, 30.04.2004

⁴ Onur Sarı, *Trademark Acquisition Process in the Context of Turkish and US Law*, Seçkin Publishing, Ankara 2020, p.40

⁵ Sarı, p.39

owner must convert EU Trademark into a national trademark application in each country where he intends to seek protection.⁶ At this juncture, it is important to note that Article (5) of the EU Trademark Regulation lists the applicants for the EU Trademark, and that these applicants are not limited to citizens of the member states. Since Turkey is a signatory to the Paris Convention and the World Trade Organization Agreement, Turkish nationals are also eligible to register for EU trademarks.⁷

As can be seen, EU Trademark Law contains two trademark registration and protection systems that are not mutually exclusive but are intertwined. Consequently, it is possible to protect a trademark as both a EU Trademark and a national trademark. In the event of a legal conflict between the EU Trademark Regulation, which governs the Community Trademark, and the national law of a member state under national protection, the EU Trademark Regulation will take precedence.⁸

1.2. RESOURCES OF TURKISH TRADEMARK LAW

Today, Turkish Industrial Property Code No. 6769 is the principal legal regulation governing Turkish Trademark Law. Afin de décrire exhaustively the Turkish Trademark protection available within the scope of this law, it is beneficial to discuss the impact of the EU Trademark Law regulations on the legal regulations preceding this regulation.

In 1872, the Nizamme codified the trademark privilege for the first time in Turkish law.⁹ This Regulation was repealed with the Trademarks Law No. 551 dated 03/03/1995 in conjunction with the proclamation of the Republic.¹⁰ Despite the fact that this law was drafted in accordance with the requirements of the age as compared to previous regulations, it has been subject to widespread criticism. It has been decided to make significant changes in the sphere of intellectual property in accordance with the World Trade Organization's TRIPS and the Joint Council Decision No. 1/95 between the European Union and Turkey.¹¹ As a result of economic growth and Turkey's endeavors to join the European Union, it was decided to establish a trademark protection in

⁶ Landy K. Gene & Mastrobattista J. Army, *The IT/Digital Legal Companion: A Comprehensive Business Guide to Software, IT, Internet, Media and IP Law*, Syngress Publishing, Massachusetts 2008, p.87

⁷ Sarı, p.40

⁸ A. Lerzan Yılmaz, *Signs That May Be Registered As Trademarks and Absolute Registration Barriers*, Beta Publishing, İstanbul 2008, p.113; Sarı, p.40

⁹ Çağlar Özel, *Trademark License Agreement*, Seçkin Publishing, Ankara 2015, p.28; Sarı, p.31

¹⁰ Hayri Bozgeyik, *Trademark Protection*, On İki Levha Publishing, İstanbul 2019, p.1; Sarı, p.31

¹¹ M.Mekin Durceylan, *Infringement of Trademark Rights*, Seçkin Publishing, Ankara 2022, p.26; Sarı, p.31

accordance with the law of the union. In this context, the First Council Directive No. 89/104 and the Community Trademark Regulation¹² No. 40/94 served as the basis for the issuance and implementation of Decree Law No. 556 on the Protection of Trademarks. This decree has become one of the most important sources of Turkish Trademark Law, as it contains all the fundamental and procedural regulations regarding the protection of trademarks, taking into consideration the deficiencies of the previous legal regulations. Nonetheless, the regulation of industrial rights by a decree with the force of law attracted criticism, and the Constitutional Court of the Republic of Turkey invalidated the relevant provisions.¹³

During the course of this procedure, it has been determined that a legal framework for controlling industrial rights is necessary, and preliminary studies on drafting such a framework have been initiated. In accordance with the EU Trademark Regulation¹⁴ No. 2015/2424 and the EU New Trademark Directive No. 2015/2436, the Turkish Industrial Property Code No. 6769 has been drafted and entered into force for this purpose.¹⁵ This law was followed by the Turkish Industrial Property Code Implementation Regulation of April 24, 2017. Since the Turkish Industrial Property Code No. 6769 was issued in accordance with the EU Trademark Directive No. 2015/36, there is a general similarity between the EU and Turkish Trademark Laws, with only minor differences.

The trademark protection system obtained pursuant to the Turkish Industrial Property Code No. 6769 is consistent with the national trademark protection system of the European Union. In the event that the examination conducted as a result of the application submitted to the Turkish Patent Office by the trademark applicant who desires to receive trademark protection in Turkey, the trademark applicant will have obtained trademark protection in Turkey. As mentioned previously, according to Article (5) of the EU Trademark Regulation, Turkish citizens can also register for the EU Trademark and will have rights under the international treaties to which Turkey is a party.

¹² First Council Directive No. 89/104/EEC of The Council of the European Communities, 21 December 1988 to approximate the laws of the Member States relating to trade marks, Legislation 40/1, 11 February 1989

¹³ Sarı, p.32

¹⁴ Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs), Legislation 341/21, 24 December 2015

¹⁵ Uğur Çolak, *Turkish Trademark Law*, On İki Levha Publishing, İstanbul 2018, p.4; Durceylan p.27

PART II: GENERAL INFORMATION ABOUT TRADEMARK RIGHTS

2.1. DEFINITION OF TRADEMARK

According to the Turkish Language Association Dictionary, the word marka, which is written as trademark in English, was derived from the Italian and German words marca and mark.¹⁶ It is defined as *"any signs that distinguishes the goods and/or services of one enterprise from those of another enterprise."*¹⁷

In the Turkish Industrial Property Code¹⁸, which governs trademarks in Turkish law, there is no direct definition of a trademark, although it is indicated what can be considered a trademark. In accordance with Article (4) of the relevant law,

*"A trademark may consist of any sign, including personal names, including words, shapes, colors, letters, numbers, sounds, and the form of the goods or packaging, provided that it can be displayed in the register so as to distinguish an entity's goods and services from those of other entities and so as to enable the subject of the protection granted to the trademark holder to be clearly and accurately understood."*¹⁹

Whereas the regulations under Turkish law parallel those of the European Union, this issue is similarly governed by the European Union Trademark Regulation.²⁰ According to Article (4) of the relevant Regulation;

"An EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numbers, colours, the shape of goods or of the packaging of products, or sounds, provided that such signs are capable of:

*(a)distinguishing the goods or services of one enterprise from those of other enterprises;
and*

¹⁶ Önder Ege, *Infringement of Trademark Right and Legal Protection Methods According to the Industrial Property Law No. 6769*, Seçkin Publishing, Ankara 2021, p.17; Turkish Language Association, *Turkish Dictionary*, Volume II, Ankara, 1998, p.1507

¹⁷ Duygu Taşkın, *Trademark Registration and Termination of Trademark Right*, Seçkin Publishing, Ankara 2022, p.19; İlhami Güneş, *Turkish Trademark Law in the Light of Industrial Property Law*, Adalet Publishing, Ankara 2018, p.37; Çolak, p.10

¹⁸ Turkish Industrial Property Code for Trademarks, Geographical Indications and Traditional Specialities, Designs, and Patents, Legislation 6769, 22 December 2016, Official Gazette No.29944, 10 January 2017

¹⁹ Turkish Industrial Property Code for Trademarks, Geographical Indications and Traditional Specialities, Designs, and Patents, Legislation 6769, 22 December 2016, Official Gazette No.29944, 10 January 2017, Article (4)

²⁰ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, Official Journal of the European Union, Legislation 154, 16.06.2017

(b) be represented in the Register of European Union trade marks ('the Register'), in a way that enables the competent authorities and the public to determine the clear and precise subject matter of the protection granted to its owner." ²¹

2.2. TRADEMARK RIGHT

2.2.1. Characteristics of Trademark Right

Trademark right is an industrial right that falls under the subject of Intellectual and Industrial Law. Since it's an industrial right, it is a right involving intangible assets related to business and trade endeavors, as opposed to aesthetic and material assets, such as works. As an industrial right, the right to mark has a variety of aspects.²² These characteristics which are accepted by both Turkish and EU Trademark Law are listed below.

2.2.1.1 Intangible Characteristic

Trademarks are intangible objects with commercial value that serve to differentiate one merchant's products and services from those of another. In other words, they are a representation of the exclusive legal rights that are provided to the owner of a trademark to use the trademark in connection with the owner's goods or services, as well as the right to prevent others from using the same or a similar trademark in a manner that could lead to confusion among customers. Due to this characteristic, the trademark right, which is held accountable for providing financial contributions to the trademark owner, is regarded as one of the trademark owner's assets.²³

2.2.1.2. Monopolistic Condition

With trademark registration, the trademark owner obtains an exclusive right, also known as a monopoly right, on the trademark. This exclusive trademark privilege has both positive and negative aspects.²⁴ Positive aspect is that the trademark right can only be utilized by the trademark owner and those authorized by him. Negatively, no one can benefit from the trademark right except those who have not obtained the trademark owner's assent. If the use of the trademark right is

²¹ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, Official Journal of the European Union, Legislation 154, 16.06.2017, Article (4)

²² Sari, p.56

²³ Hayrettin Çağlar, *Trademark Law*, Adalet Publishing, Ankara 2015, p.34

²⁴ Sari, p.60

contested by parties who have not obtained the trademark owner's permission, the trademark owner may take action to prevent these parties from benefiting.

The exclusive right conferred by the trademark right is restricted to trademark protection only. In other words, the subject of the exclusive right does not include the goods or services that bear the trademark. The products or services bearing the trademark are governed by other areas of the law, such as property law.²⁵

2.2.1.3 Timeliness and Renewability

The trademark right is a time-limited right. The trademark is protected for ten years from the date of registration application. However, this ten-year protection period can be extended in ten-year periods with the request for renewal. There is no maximum protection limit.²⁶ In terms of its renewability and its unlimited number, the right arising from the trademark differs from some other intellectual property rights (patent, utility model, industrial design, etc.).²⁷ In order to address this concern, the Turkish Industrial Property Code and the European Union Trademark Regulation contain provisions that precisely parallel one another.

2.2.1.4. Being Subject to Legal Actions

Similar to other rights under Private Law, the trademark right may be subject to commitment and disposition transactions. Under this framework, the trademark right can be transferred, the pledge right and the usufruct right can be established, it can be inherited, it can be used as capital by a corporation, donated, or seized.²⁸ These legal transactions are provided as examples and are not restricted in quantity.

Trademark transactions can be conducted independently or in conjunction with the enterprise. Both the Turkish Industrial Property Code, the EUTMR and Directive 2015/2436 regulate this subject matter in a clear and uniform manner. In accordance with the Turkish Industrial Property Code, this legal transaction must be documented in writing and recorded in the appropriate registry for it to be binding on third parties.²⁹ According to EU Trademark Law, a general

²⁵ Sarı, p.61; Hüseyin Ülgen & Mehmet Helvacı & Arslan Kaya & N. Füsün Nomer Ertan, *Commercial Business Law*, Vedat Publishing, İstanbul 2019, p.459

²⁶ Sarı, p.63

²⁷ Çağlar, p.35

²⁸ Çağlar, p.35

²⁹ Çolak, p.708; Taşkın, p.62

arrangement has not been created on this subject, and it is left to the discretion of the member states by saying "*Member States may envisage procedures for allowing real rights to be registered in their own registers.*"³⁰ Due to the fact that registration has a national effect, right holders who want protection in other countries must register in each country.³¹

2.2.1.5. Principle Of Territoriality

The principle of territoriality in industrial rights is based on Articles (2) and (3) of the Paris Convention.³² This principle indicates that the protection and privileges obtained with a trademark right are only valid in the nation in which the trademark is registered.³³ Due to the fact that registration has a national effect, right holders who want protection in other countries must register in each country.

In fact, the territoriality principle comprises two pillars. The first of them is that the birth of the industrial right, its termination, and its protection in the event of violation are governed by the law of the nation in which the right is demanded and registered. The second pillar of the territoriality principle is that a recognized industrial right is only valid in the country in which it is recognized; in other words, it cannot be asserted in other nations.³⁴

According to Turkish Trademark Law, trademarks that have been submitted to the Turkish Patent Office, accepted, and registered by the institution will enjoy complete protection within the scope of Turkish law and within the borders of the Turkish Republic. If the applicant wishes to obtain protection in this manner in other countries, he must register his trademark and appeal to each country separately for trademark protection. This is valid for national applications made in other countries. However, within the scope of the trademark registration application submitted by the trademark applicant to EUIPO in order to obtain an EU trademark, if the relevant application satisfies the necessary conditions and there are no other impediments, the EU trademarks registered by EUIPO will receive protection covering all EU members. In other words, a single application will provide the trademark proprietor with comprehensive protection in all EU countries. The

³⁰ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, Official Journal of the European Union, Legislation 336, 23.12.2015

³¹ Barçın Özkan Kıldıl, *Precautionary Measures in Case of Infringement of Trademark Right*, On İki Levha Publishing, İstanbul 2022, p.45

³² Paris Convention for the Protection of Industrial Property (March 20, 1883; effective July 7, 1884, and amended June 2, 1934 and July 14, 1967) (the Paris Convention)

³³ Kıldıl, p.45

³⁴ Kıldıl, p.45

proprietor of a trademark may also apply to WIPO in accordance with the Madrid Protocol³⁵ to obtain international trademark protection. With this application, the applicant can specify the countries in which he desires to obtain trademark protection and can obtain protection in approximately a hundred countries. Upon submission of a singular application to WIPO, the trademark application is forwarded to the national office of each country where protection is sought for evaluation. In countries where the evaluation of the application yields a favorable opinion, the applicant receives a comprehensive trademark protection. This is referred to as bundle of national trademark rights in the doctrine.

It is obvious that the scope of the Principle of Territory will vary based on whether the trademark application is filed under the National, EU or Madrid System. Consequently, the acquisition, scope, and geographic limits of trademark rights will vary. It should be noted, however, that there is an exception to this rule, which is granted to well-known trademarks under the Paris Convention, excluding the EU System and the Madrid System. Within the scope of this exception, the geographical restrictions imposed by this principle will not apply to internationally recognized trademarks.³⁶

2.2.1.6. Based on Voluntariness

The use and registration of the trademark right is optional. Even when public interest is taken into account, trademark usage cannot be made mandatory. The right holder may design and utilize a trademark if he so decides. It can also register this trademark in relation to the products or services it utilizes. He may use his trademark without registering for a trademark if he so wishes. Registration will only create the opportunity to benefit from a number of legal regulations regulated in the applicable law.³⁷

2.2.1.7. Principle of Exhaustion

The principle of extinction was introduced to balance the protection afforded to the beneficiary with free trade or private property and public order. As a result of this principle, once a trademarked product has been introduced to the market, the owner of the trademark cannot prohibit the use of the products or actions associated with them. What is exhausted in this case is not the

³⁵ Protocol Relating to the Madrid Agreement Concerning the International Registration (June 27,1989, and amended October 3, 2006 and November 12, 2007) (the Madrid Protocol)

³⁶ Sami Karahan & Cahit Suluk & Tahir Saraç & Temel Nal, *Principles of Intellectual Property Law*, Seçkin Publishing, Ankara 2013, p.9; Taşkın, p.62

³⁷ Sarı, p.63-64

right, but the right of first sale of the products, or the right to prevent others from using the trademark.³⁸

Regarding the exhaustion principle, three geographical boundaries, namely national, regional, and international, have been incorporated in the doctrine. First, national exhaustion refers to the fact that the trademark proprietor cannot prevent the product registered in his name in a particular country from circulating in that country's market once the product has been introduced to the market in question.³⁹ Regional Exhaustion, on the other hand, is a region in which more than one country is located. In other words, the trademark rights for products released in this region have been exhausted in more than one country. The member states of the European Union recognize the regional exhaustion principle. In accordance with Article (9)(2) of the Customs Union, regional exhaustion has not been recognized for Turkey, despite the fact that Turkey is a member of the Customs Union. International exhaustion occurs when the product is placed on the market anywhere in the world and the market becomes flooded.⁴⁰ If such an exhaustion principle is adopted, permission from the rightful owner is not required for subsequent sales of the product after the initial sale. Prior to the Turkish Industrial Property Code, the principle of territorial exhaustion was recognized in Turkish law, whereas the principle of international exhaustion was accepted with the Turkish Industrial Property Code. Article (152) of the Turkish Industrial Property Code regulates the principle of exhaustion. The pertinent clause is as follows:

“After the products forming the subject of protection of industrial property right are put on the market by right owner or by third parties with his consent, actions related to these products shall remain outside the scope of the right.”⁴¹

As it is apparent from the text of the article, the legislator merely regulated the exhaustion principle generally and implicitly adopted the international exhaustion principle, without imposing any geographical restrictions.⁴²

³⁸ Kıldıl, p.34; Çolak, p.609

³⁹ Kıldıl, p.38; Fahrettin Kayhan, *Parallel Import and Exhaustion of Trademark Rights in Terms of Turkish Trademark Law*, Ankara Bar Association Journal, 2001, V:1, No:1, 51-72, p.63

⁴⁰ Kıldıl, p.38; Bahadır Erdem, *Law Applicable to Protection of Patent Rights and Patent Contracts*, İstanbul 2000, Beta Publishing, p.66

⁴¹ Turkish Industrial Property Code for Trademarks, Geographical Indications and Traditional Specialities, Designs, and Patents, Legislation 6769, 22 December 2016, Official Gazette No.29944, 10 January 2017, Article (152)

⁴² Kıldıl, p.39

2.2.2 The Scope of Trademark Right

Intellectual Property Law, the EU Trademark Regulation, and the EU Trademark Directive have similarly regulated the scope of trademark law by determining how the trademark right can be acquired, when the right of a trademark may be asserted against third parties, the extent of the trademark right, the circumstances in which the proprietor of a trademark may avoid, the situations where the trademark right holder may request the prohibition, the exceptions to the rights of the proprietors of the trademarks and the limits of the right to the holder of the trademark.

Despite the fact that the scope of the trademark right is structurally governed similarly in both legal systems, there is a substantial difference in the essence of the scope of the trademark right due to the expressions used in the pertinent law articles. The second paragraphs of Article (7) of the Turkish Industrial Property Code and Article (9) of the EU Trademark Regulation must be consulted in order to evaluate this difference, which arose as a consequence of the wording of the articles. The relevant provisions of the statute are as follows

“Article 7 (2): Rights arising from trademark registration shall be granted exclusively to the trademark proprietor. The trademark proprietor shall be entitled to claim for prevention, in case of execution without consent, of the acts set out below:

- a) Use of any sign identical with the trademark at goods or services that are in the scope of the registration.*
- b) Use of any sign identical with or similar to a registered trademark and covering identical or similar goods or services with the registered trademark, and is therefore liable to create a likelihood of confusion on the part of the public; including the likelihood of association between the sign and the trademark.*
- c) Use of any sign identical with, or similar to the registered trademark, irrespective of being for identical, similar or different goods or services, where the use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark due to the reputation it has in Turkey.”⁴³*

“Article 9 (2): Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the EU trade mark, the proprietor of that EU trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where:

⁴³ Turkish Industrial Property Code for Trademarks, Geographical Indications and Traditional Specialities, Designs, and Patents, Legislation 6769, 22 December 2016, Official Gazette No.29944, 10 January 2017, Article (152)

- a) *the sign is identical with the EU trade mark and is used in relation to goods or services which are identical with those for which the EU trade mark is registered;*
- b) *the sign is identical with, or similar to, the EU trade mark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the EU trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;*
- c) *the sign is identical with, or similar to, the EU trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to or not similar to those for which the EU trade mark is registered, where the latter has a reputation in the Union and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the EU trade mark."*⁴⁴

The likelihood of confusion issue appears to be the fundamental distinction between the trademark scope provisions of the Turkish Industrial Property Code and the EU Trademark Regulation. This issue is expressed in Article (7)(2) of the Turkish Industrial Property Code as liable to create a likelihood of confusion, whereas Article (9)(2) of the EUTMR states if there is a likelihood of confusion. Although the purpose of protection provided by the articles of both laws is the same, the wordings of likelihood of confusion led to different interpretations of the provisions. Since the likelihood of confusion test functions as a litmus test in the evaluation of acts infringing the trademark right, it is useful to note the different main points of these tests, which resulted from the different interpretations of the relevant phrase by the two legal systems. While the European Union has a likelihood of confusion test Turkey has a possibility of confusion test with a lower threshold. Accordingly, Turkish Trademark Law makes it simpler for the trademark owner to prove that the trademark right has been infringed. It should be noted, however, that member states may impose additional requirements for likelihood of confusion tests in their trademark law systems, so long as they comply with EUTMR provisions.

⁴⁴ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, Official Journal of the European Union, Legislation 154, 16.06.2017, Article (9)

2.3. METHODS OF ACQUISITION OF TRADEMARK RIGHTS

It is essential to define when the trademark right will arise, in order to be able to assert the right against third parties, to determine when the protection against trademark infringement will start and finish, and to establish the extent of the trademark right.⁴⁵ It is generally accepted trademark rights can be obtained in two main ways: through registration and through use.⁴⁶

2.3.1. The Acquisition of The Trademark Right By Way of Use

In order to gain the trademark right, the most natural way is to use it. In some legal systems, it is therefore stated that the trademark right can be acquired through its use.⁴⁷ According to this method, which is also referred to as the Principle of Actual Right Ownership, the owner of the trademark right is the person who ensures that the trademark is selected, used, and recognized to a certain level prior to the creation of the trademark. For this reason, in systems where trademark rights are acquired through use, registration is notifiable.⁴⁸

Under Turkish law, the protection of a trademark is mostly contingent on registration, but the trademark is not wholly unprotected when it is used without registration.⁴⁹ According to the provisions of the Turkish Trade Law on Unfair Competition, unregistered trademarks in this context are afforded a weaker level of protection than registered trademarks.⁵⁰

In extraordinary circumstances, however, unregistered trademarks may also be protected under the Turkish Industrial Property Code restrictions. The first of these exceptions are trademarks that are protected under the Paris Convention even if they are not registered. Thus, the application for registration of another trademark that is identical or extremely similar to the unregistered trademark may be denied following the completion of the requisite examinations.⁵¹ The other exception is the distinctiveness achieved by using a trademark. Article (6)(3) of the Turkish Industrial Property Code grants the right to object to those who have gained rights via the commercial use of their trademark. The trademark application will be denied if Turkish Patent and

⁴⁵ Kıldıl, p.5

⁴⁶ Burak Altın, *The Nature of the Trademark Right and State Intervention on the Trademark*, Seçkin Publishing, Ankara 2020, p. 31; Ünal Tekinalp, *Intellectual Property Law*, Vedat Publishing, İstanbul 2012, p. 24

⁴⁷ Altın, p.31

⁴⁸ Altın, p.3; Sabih Arkan, *Trademark Law*, Ankara University Publishing, Ankara 1997, p.128

⁴⁹ Durceylan, p.48

⁵⁰ Durceylan, p.48

⁵¹ Durceylan, p.48

Trademark Authority decides to accept the trademark owner's objection. The owner of the trademark has conceded the right of objection, although not securing absolute protection, and has secured the ability to protect the unregistered mark in accordance with the Turkish Industrial Property Code.⁵²

The protection afforded to trademarks that have not been formally registered is very analogous to that which is provided under the trademark law of Turkey. The primary protection of unregistered trademarks is governed by Competition Law regulations, as in Turkish law, but EU Trademark Law Regulations include special provisions. As a consequence of the EU's membership in the Paris Convention, all of the EU's legal regulations regarding Trademark Law have been arranged accordingly. Therefore, the first exception mentioned above deriving from the Paris Convention also applies to EU Trademark Law. Article (8)(4) of the EUTMR is another exceptional regulation regarding unregistered trademark protection. Under the conditions of the relevant article of law, as in the Turkish Industrial Property Code, the proprietor of an unregistered trademark retains the right to object to an EU trademark registration.

Article (11) of the introduction to Directive 2015/2436 states that Member States are not prohibited from protecting trademarks acquired through use, despite being subject to the EU's general principles for the protection of unregistered trademarks. Therefore, each member state can establish its own unique requirements for the protection of unregistered trademarks that are not subpar to EU standards. Some member states offer no protection for unregistered trademarks, while others offer protection comparable to that of registered trademarks. Denmark is the member state that provides the most comprehensive protection for unregistered trademarks. Denmark provides protection for unregistered trademarks from the instant of first use and for as long as the use continues uninterruptedly. This protection is equivalent to the protection offered to registered trademarks.⁵³

2.3.2. The Acquisition of The Trademark Right By Way of Use Registration

The trademark right originates within the context of the registration principle when the trademark is selected and registered with the registrar. In this system, where the initial registrant of a trademark right is the owner, no rights are awarded to anyone who uses or makes known the

⁵² Durceylan, p.49

⁵³ Önder Erol Ünsal, *Protection and Scope of Unregistered Trademarks in European Union Member States*, June 2012, A.D. 29 May 2023, <https://iprgezgini.org/2013/12/16/tescilsiz-markalara-avrupa-birligi-uyesi-ulkelerde-saglanan-koruma-ve-kapsami/>

trademark for the first time without registering it. Upon registration, the trademark right becomes enforceable against all parties.⁵⁴ Thus, registration is constitutive in this procedure.

Registration confers complete protection of trademark rights under Turkish law. The exclusive authority in Turkish law is the Turkish Patent and Trademark Authority.⁵⁵ The individual requesting the registration of a trademark must submit the relevant application materials to this authority. The mark is registered if the entity finds no impediments to the registration during the completion of the connected examinations. The trademark registered in this manner is protected for ten years from the date of registration application.⁵⁶ Turkish Industrial Property Code provides protection for these registered trademarks.⁵⁷

Regarding the law that governs trademarks in the EU, there is a similar attitude. Nonetheless, the EU Trademark System and the National Trademark Systems of the Member States should be maintained independently at this time. With a single application under the EU Trademark System, a trademark applicant can obtain a trademark right that is valid in all EU member states and provides complete protection. The Trademark Regulation of the European Union 2017/1001⁵⁸ is the legal legislation that forms the basis of this application. Article (6) of the pertinent regulation stipulates that the EU trademark shall be attained through registration. As can be seen, registration is a crucial part of the process in this system as well. The EUIPO is the authorized body for this registration procedure. If the applicants submit the required registration documents to this institution and there are no obstacles to registration, the registration procedure is conducted. The proprietor of the trademark is afforded ten years of protection as a result of this registration. Nonetheless, there is currently an instance that differs from the Turkish Trademark Law. Article (11) of the EUTMR allows the trademark proprietor to begin using his trademark rights against third parties following the publication of the registration. In other words, trademark protection commences upon publication of trademark registration, contrary to Turkish Trademark Law. Nevertheless, according to paragraph 2 of the relevant article, the trademark owner may seek

⁵⁴ Kıldıl, p.6; Elif Kara, *Real Trademark Ownership Principle in Turkish Trademark Law*, On İki Levha Publishing, İstanbul 2018, p.30; Dilek Cengiz, *Infringement of Trademark Rights Through Confusion and Quotations*, Beta Publishing, İstanbul 1995, p. 38

⁵⁵ Durceylan, p.48; Rıza Ayhan & Mehmet Özdamar & Çağlar Hayrettin, *Commercial Business Law General Principles*, Yetkin Publishing, Ankara 2016, p.348

⁵⁶ Taşkın, p. 48

⁵⁷ Durceylan, p.48; Hayrettin Çağlar & Burçak Yıldız & Dile İmirlioğlu, *Preparation for the Trademark Attorney Exam*, Adalet Publishing, Ankara 2019, p.59

⁵⁸ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, Official Journal of the European Union, Legislation 154, 16.06.2017

reasonable compensation in situations that occur between the publication of the trademark application and the publication of the trademark registration and which will be prohibited after the publication of the trademark registration. The court presiding over a case does not rule on its merits until the record is published. According to the Principle of Proportionality, this gradual protection system implemented by EU Trademark Law is appropriate, and it would be more appropriate for Turkish Trademark Law regulations to adopt this system. On the other hand, the National Trademark Systems of the Member States are the systems created by each Member State in accordance with the provisions of Directive 2015/2436 Harmonizing The Laws of The Member States Pertaining to Trademarks⁵⁹. The applicant for a trademark can obtain trademark protection by filing distinct applications in each country where protection is desired. According to the legal document in question, the structure of the system in each of the Member States is, in general, similar. Therefore, trademark applicants must file an application for registration with the Intellectual Property Offices established in accordance with the Directive by the relevant Member States.

2.3.3. The Acquisition of The Trademark Right Under Turkish and European Union Trademark Law

As described in detail above, the trademark owner acquires the rights deriving from the trademark through registration under both Turkish and EU Trademark Law. The acquisition of trademark rights through use is an extraordinary circumstance. It is essential to note that the period during which trademark rights can be asserted against third parties is governed by Article (7)(4) of the Turkish Industrial Property Code and Article (11) of the EUTMR. According to these provisions, the rights conferred to the trademark owner are effective against third parties as of the date of publication of the trademark registration. However, the applicant is permitted to file a complaint seeking compensation for actions that occurred after the publication of the trademark application in the Bulletin, unless the registration of the trademark has been announced. Prior to the publication of the registration, the court cannot rule on the validity of the claims that have been presented.

⁵⁹ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, Official Journal of the European Union, Legislation 336, 23.12.2015

PART III: INFRINGEMENT OF TRADEMARK RIGHTS

3.1.PREREQUISITE LEGAL CONDITIONS FOR TRADEMARK INFRINGEMENT

In order to talk about an infringement of the right to use a trademark, there needs to be some general and special conditions, in addition to an activity that is regarded to be an infringement. In accordance with EU Trademark Law and Turkish Trademark Law, these conditions are identical, and their justifications are derived from the pertinent legal regulations. It should be noted, however, that these are the minimum requirements imposed by EU regulations, and that each member state may have additional special conditions and evaluation methods.

3.1.1. Use of the Trademark Without the Owner's Consent

In order for an action to be considered an infringement of a trademark right, the first requirement is that the trademark owner must not have given their consent for the act in question. In other words, situations in which the trademark right holder has granted permission do not constitute trademark infringement. The consent may be either explicit or implicit.⁶⁰ The claimant must substantiate the trademark owner's permission in a trademark infringement lawsuit.

3.1.2. Use of the Trademark For Commercial Purposes

The third party's use of the trademark must be commercial in nature in order to constitute an infringement of the trademark right. This condition, which is governed by the German Trademark Law and EU regulation No. 2017/1001, is implicitly mentioned in Articles (9) and (61) of the Turkish Industrial Property Code, despite the fact that this issue is not explicitly addressed in Turkish law.⁶¹

There is no necessity for a monetary benefit in order for there to be a question of economic use. In the context of this discussion, economic usage can also refer to the actions of marketing and advertising carried out by a company. The dictionaries and encyclopedias bearing the registered trademark, whether they are published in print or made available online, are the sole exemption to this general rule.⁶²

⁶⁰ Çağlar, p.108

⁶¹ Durceylan, p.77

⁶² Çağlar, p.108

3.1.3. Use of the Trademark in the Protection of the Trademark

In order for an action to be considered an infringement of a trademark right, the third party's use of the trademark in question must have been done with the intention of financial gain and in conjunction with a sign and products or services that fall under the protection provided by the trademark right. These are the uses that violate the fundamental functions of the trademark, most notably the reference function, which is guaranteed by the trademark's use.⁶³ In the BMW case⁶⁴ and numerous other decisions that followed, the CJEU ruled that the use of a trademark is required to allege trademark infringement.

3.1.4. Use of the trademark Where It Is Registered

The third party's use of the registered trademark in the location where it was registered is a final condition of infringement. This condition is primarily in place to ensure that the trademark proprietor receives comprehensive protection in the geographical area covered by the system's registration. In other words, the trademark proprietor cannot assert his rights in the absence of comprehensive trademark protection. At this juncture, the registration of the trademark owner under the national, European Union or Madrid system is decisive. Under the national system, the trademark owner who registers will receive protection in the relevant country, and in order to discuss infringement of the trademark owner's trademark right, the trademark must be processed within the borders of the country where it was registered. The protection of the trademark proprietor, whose trademark has been registered in the EU trademark system, will be valid within EU borders; therefore, the act of trademark infringement must have occurred within EU borders. Lastly, the trademark registered in accordance with the Madrid System will be protected in the countries chosen by the trademark owner, and for infringement to be noted, an act of infringement must be committed against the trademark within the country protections obtained with the application. It should be noted, however, that there is an exception to this rule, and that exception is the privilege granted to well-known trademarks by the Paris Convention. According to this exception, a well-known trademark will be protected against unjust use in Turkey even if it is not registered there. This pertains to all member nations of the Paris Convention.⁶⁵

⁶³ Çağlar, p.218

⁶⁴ Çağlar, p.216

⁶⁵ Sevilay Uzunallı, *Trademark Law*, Adalet Publishing, Ankara 2021, p.163

3.2. ACTIONS INFRINGING A TRADEMARK RIGHT

In order to identify and compare the acts regarded as infringement of trademark rights under Turkish and EU Trademark Law, it is necessary to examine how this issue is addressed in the relevant legal systems' governing laws. The 2nd and 3rd paragraphs of the Article (9) of the EUTMR, which regulates the EU Trademark in relation to European Union Law, outline the actions that are deemed trademark infringements. While the second paragraph provides a general list of situations constituting trademark infringement, the third paragraph provides a specific list of commercial situations. Since the second paragraph of Article (9) of the EUTMR has already been discussed in the study, it would be appropriate to refer to the third paragraph at this point. This paragraph continues

“ The following, in particular, may be prohibited under paragraph 2:

- (a) affixing the sign to the goods or to the packaging of those goods;*
- (b) offering the goods, putting them on the market, or stocking them for those purposes under the sign, or offering or supplying services thereunder;*
- (c) importing or exporting the goods under the sign;*
- (d) using the sign as a trade or company name or part of a trade or company name;*
- (e) using the sign on business papers and in advertising;*
- (f) using the sign in comparative advertising in a manner that is contrary to Directive 2006/114/EC.”⁶⁶*

Article (10) of the EU Trademark Directive, which aims to harmonize the trademark laws of the member states, is another legal provision that should be mentioned in relation to EU law. As previously stated, this article is essentially governed in the same manner as Article (9) of the EUTMR, and for the purposes of the Directive, Member States are granted discretion as long as they do not fall below the thresholds established by this directive and comply with EU Trademark Law.

On the other hand, it can be observed that the repercussions of trademark infringement acts in Turkish Trademark Law are governed by paragraphs 2 and 3 of Article (7) of the Turkish Industrial Property Code, which closely resemble the structure of Article (9) of the EUTMR and Article (10) of the EU Trademark Directive. The second paragraph of the Turkish Industrial

⁶⁶ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, Official Journal of the European Union, Legislation 154, 16.06.2017, Article (9)

Property Code, like the second paragraph of the EUTMR, lists the situations that comprise an act that is generally regarded as an infringement of the trademark right, whereas the third paragraph lists specifically certain commercial situations. However, there is a point that should be highlighted in terms of the Turkish Industrial Property Code at this time. Article (29) of the Turkish Industrial Property Code contains a distinct regulation pertaining to Article (7) titled *"Actions Considered As Infringement Of Trademark Right."*⁶⁷ The following is the text of this provision:

"(1) The acts below shall be considered as infringement of trademark right;

- a) To use the trademark as set out in Article (7) without the consent of the trademark proprietor;*
- b) To counterfeit the trademark by using the trademark or a confusingly similar trademark without the consent of the trademark proprietor;*
- c) While being aware or should be aware that the trademark is counterfeited by use of the trademark or a confusingly similar trademark, to sell, distribute, put on the market in a different form, possess for commercial purpose, import, export the products carrying infringed trademark or to offer to make a contract related to this product,*
- ç) To broaden or to transfer to third parties, without consent, the rights given by the trademark proprietor through license.*

*(2) Provisions of second paragraph of Article (19) may be used as a defense in infringement proceedings. In this situation, the date of the proceeding shall be taken into account for determining the five-year period related to the use."*⁶⁸

In the doctrine, there are debates regarding the fact that it is superfluous to regulate trademark infringement acts in Article (7) and Article (29) of the Turkish Industrial Property Code separately but in relation to one another. As the Turkish Industrial Property Code No. 6769 was issued in accordance with the regulations of the European Union, it is evident why the legislature enacted a separate provision. As a result of the EU Trademark Directive's authorization to EU Member States, as well as the inclusion of general regulations in the EU Trademark Law Regulations, the legislator felt compelled to enact a separate law for Turkey, despite the fact that it is not a member of the EU. This was done in an effort to find a middle ground in the harmonization

⁶⁷ Turkish Industrial Property Code for Trademarks, Geographical Indications and Traditional Specialities, Designs, and Patents, Legislation 6769, 22 December 2016, Official Gazette No.29944, 10 January 2017, Article (29)

⁶⁸ Turkish Industrial Property Code for Trademarks, Geographical Indications and Traditional Specialities, Designs, and Patents, Legislation 6769, 22 December 2016, Official Gazette No.29944, 10 January 2017, Article (29)

of the EU and Turkey Trademark Law. Although the article of the law provides an appropriate guide by regulating trademark infringement under a separate title and by referencing the general rule, if Turkey joins the EU in the coming years, a simplified and similar legal regulation may be required.

3.2.1. Unauthorized Use of Trademark

The right of the trademark owner to use the trademark is an exclusive right. Therefore, the use of the trademark by third parties without the consent of the trademark owner constitutes an infringement of the trademark right. Article (7)(2) of the Turkish Industrial Property Code and Article (9)(2) of the EUTMR regulate this situation under three different scenarios.

3.2.1.1. Use of a Sign Identical to a Registered Trademark for the Products or Services Covered by the Registration

The first of these scenarios is the use of any sign that is identical to a registered trademark on goods or services within the scope of registration, which is governed by Articles (7)(2)(a) of the Turkish Industrial Property Code and (9)(2)(a) of the EUTMR. This type of trademark infringement, which is governed identically by both provisions, is constituted by the use of the identical trademark. In other words, the trademark should always be utilized in the same manner.⁶⁹ In this context, if a trademark is infringed, it will be evident that the trademark has been infringed without the need for confusion or similarity analyses.⁷⁰ The continued use of a trademark after the termination of a legal relationship, such as a license, agency, or dealership, will be regarded as an infringement of the trademark right under these provisions.

3.2.1.2. The Use of any Sign That Is Identical or Confusingly Similar to the Registered Trademark and That Covers the Same or Similar Goods or Services as the Goods or Services Covered by the Registered Trademark, and Therefore Is Likely To Cause Confusion Among the Public, Including the Possibility of Association With the Registered Trademark.

Despite the fact that this type of trademark infringement is governed similarly by the EUTMR and the Turkish Industrial Property Code, there are some differences in the wording of the relevant articles. Consequently, it is advantageous to mention both provisions of law. First, this form of trademark infringement is governed by EUTMR Article (9)(2)(b) as follows:

⁶⁹ Durceylan, p.79

⁷⁰ Durceylan, p.79

*"the sign is identical with, or similar to, the EU trade mark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the EU trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark"*⁷¹

Therefore, Article (7)(2)(b) of the Turkish Industrial Property Code is governed as follows:

*" Use of any sign identical with or similar to a registered trademark and covering identical or similar goods or services with the registered trademark, and is therefore liable to create a likelihood of confusion on the part of the public; including the likelihood of association between the sign and the trademark"*⁷²

The first point shared by both articles is that there are three potential infractions that fall within the scope of the article. Following is a list of these possibilities:

- 1- Using a similar mark to a registered trademark for the same goods or services,
- 2- Using the same sign as the registered trademark for similar goods or services,
- 3- Using a sign similar to a registered trademark for similar goods or services.⁷³

The type of trademark infringement covered in the preceding title is simpler to identify than the type of trademark infringement discussed in this title. Because the determination of similarity is subject to a transparent evaluation based on objective criteria. Nevertheless, the determination of class similarity and likelihood of confusion within the scope of this article is more relative and challenging. The literal differences between Articles (7)(2)(b) of the Turkish Industrial Property Code and (9)(2)(b) of the EUTMR also result in distinctions between these determinations.

Although neither the Turkish Industrial Property Code nor the EUTMR define the possibility of confusion, the CJEU and the Turkish Supreme Court have established its general framework by introducing certain criteria. These specifications are as follows:

⁷¹ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, Official Journal of the European Union, Legislation 154, 16.06.2017, Article (9)

⁷² Turkish Industrial Property Code for Trademarks, Geographical Indications and Traditional Specialities, Designs, and Patents, Legislation 6769, 22 December 2016, Official Gazette No.29944, 10 January 2017, Article (7)

⁷³ Durceylan, p.83; Tekinalp, p.434

3.2.1.2.1. Similarity of Trademarks

A trademark's similarity can be determined by comparing its visual, auditory, and semantic characteristics. This criterion is utilized by both Turkish and EU Trademark Law, but it is interpreted differently. EU trademark law generally prioritizes overall impression during evaluation, whereas Turkish trademark law emphasizes sign similarity. In other words, while EU law decides based on a general impression of similarity, Turkish law decides based on a similarity in any of the trademark's visual, aural, or semantic factors.⁷⁴

3.2.1.2.2. Similarity Between Trademark Classes

The likelihood of confusion increases when the classes in which the trademarks are registered are the same or similar. Turkey and the European Union both use the Nice Classification system for trademark registration and product classification. The WIPO administers the Nice Classification system, which is an international classification system established by the Nice Agreement and governed by the Nice Classification system. The system classifies products and services into distinct classes for the purposes of trademark registration. According to the Nice Agreement, there are a total of 45 classes, comprised of 34 classes for products and 11 classes for services. Each class represents a distinct type of product or service. It is evident that classes that are similar or identical increase the likelihood of confusion. However, despite the fact that this is not a presumption, it is necessary to evaluate each case based on its particular characteristics.⁷⁵

3.2.1.2.3. Customer Perception

The phrase on the part of the public in both articles of law makes it plain that consumer perception is one of the evaluation criteria. The public in this context refers to intermediate consumers, prospective customers, and the intended audience. If the trademark-bearing product or service is in a technical or special situation, or if the consumer group consists of specialists, the consumer evaluation should be based on the concrete measures applicable to the specific situation.⁷⁶

⁷⁴ Durceylan, p.85; Feray Fırıncıoğlu *Possibility of Confusion within the Framework of Code of Industrial Property No. 6769*, Terazi Law Journal, V:13, No:145, September 2018, p.149; Bozgeyik, p.47,48

⁷⁵ Durceylan, p.86; Fırıncıoğlu, p.150

⁷⁶ Durceylan, p.88; Çolak, p.243; Bozgeyik, p.46

3.2.1.2.4. The Distinctive Power of the Trademark

The greater the trademark's distinctiveness, the greater the likelihood of confusion. Conversely, the lower a trademark's distinctiveness, the lower the likelihood of confusion. EUIPO and CJEU define strong trademarks as those with high distinctiveness and weak trademarks as those with low distinctiveness. It is possible for a trademark's distinctiveness to be feeble from the start or to be weakened over time. Or the trademark with limited initial distinctiveness; it can become a strong trademark through advertising, promotion, or extensive use. Although this criterion is recognized under both laws, it may play a lesser role in the overall likelihood of confusion analysis in Turkey compared to the European Union.⁷⁷

3.2.1.2.5. Likelihood of Association

This criterion is included under the phrase including likelihood of association in both the EUTMR and the Turkish Industrial Property Code. The fundamental reason for this criterion is that even if there is no similarity between the two trademarks, the elements and phrases they contain may evoke and cause confusion between them. Although this criterion is clearly addressed as a criterion in the EU trademark law doctrine, it is not considered a separate criterion in the Turkish trademark law doctrine, i.e., the possibility of association is not considered a determining factor on its own, but rather a secondary factor evaluated in the presence of the possibility of confusion.⁷⁸

3.2.1.2.6. Holistic Evaluation

On the basis of holistic evaluation, it refers to the evaluation of all factors simultaneously, taking into consideration the overall impression left by the trademark on the relevant segment of society and the dominant distinctive elements, which are based on the presence of other factors. As described in greater depth above, there are variations in holistic evaluation due to the fact that factors are weighted differently in EU and Turkish practices. While the similarity of signs is emphasized in Turkish law, the overall impression is emphasized more in the European Union.

Regarding this type of trademark infringement, the provisions of Articles (9)(2) of the EUTMR and (7)(2) of the Turkish Industrial Property Code have been mentioned; however, it is

⁷⁷ Durceylan, p.89; Çolak, p.247; Necati Meran, *Protection of Trademark Rights*, Seçkin Publishing, Ankara 2015, p. 335

⁷⁸ Durceylan, p.89; Çolak, p.247; Tekinalp, p.443

useful to include the provisions of Article (29)(1)(b) of the Turkish Industrial Property Code at this point. The following is the text of this statute:

“ The acts below shall be considered as infringement of trademark right; (....) to counterfeit the trademark by using the trademark or a confusingly similar trademark without the consent of the trademark proprietor”⁷⁹

There are debates in the doctrine over whether this article is a repetition of Article (7). The fundamental reason of these disputes is disagreements over whether the terms sameness, similarity, and indistinguishably similar are overlapping expressions. To put an end to these discussions, I believe that the legislator should reexamine and restructure Articles (7) and (29).

3.2.1.3. Unjustified Use of a Sign That Is Identical or Similar to a Registered Trademark and That Would Gain an Unfair Advantage From the Reputation of the Trademark Due to the Level of Recognition It Has Achieved, or That Would Harm its Reputation or Damage Its Distinctive Character, Regardless of Whether the Goods or Services Are the Same, Similar, or Different

This type of trademark infringement is governed by similar phrases in Articles (7)(2)(c) of the Turkish Industrial Property Code and Article (9)(2)(c) of the EUTMR, and certain conditions must be met for this trademark right to be infringed upon. These conditions tend to involve the following:

3.2.1.3.1. Existence of a Reputable Trademark

For such a trademark infringement to be in question, there must first exist a reputable trademark. Both the EUTMR and the Turkish Industrial Property Code lack a distinct definition of reputation-based trademarks. First, it is beneficial to consider well-known trademarks that have been accepted in accordance with the Paris Convention, as well as other well-known trademarks. According to the Paris Convention, there is a special protection for well-known trademarks, as was mentioned previously. Since both the EU and Turkey are signatories to the Paris Convention, they recognize the extensive protection accorded to well-known trademarks under this pact. However, the well-known trademarks mentioned in this form of trademark infringement fall under the category of other well-known trademarks. While well-known trademarks specified in Article (9)(2)(c) of EUTMR are regulated as trademarks with reputation within the EU, well-known trademarks

⁷⁹ Turkish Industrial Property Code for Trademarks, Geographical Indications and Traditional Specialities, Designs, and Patents, Legislation 6769, 22 December 2016, Official Gazette No.29944, 10 January 2017, Article (29)

specified in Article (7)(2)(c) of Turkish Industrial Property Code are trademarks that have gained reputation within the borders of the Turkish Republic. In other words, a more local scope of recognition is mentioned compared to that of the Paris Convention.

As stated previously, neither the EUTMR nor the Turkish Industrial Property Code define reputation-based trademarks. Nonetheless, both trademarks systems use the 1999 *"WIPO Joint Recommendations"*⁸⁰ as a guide for identifying the well-known trademarks. The criteria introduced in accordance with this decision are:

- "a. The degree of trademark recognition in the relevant segment of society;*
- b. The area where the trademark is used, the duration of use, and the extent of use;*
- c. The target area, duration, and intensity of trademark promotions.*
- d. The size of the geographical area where the trademark is protected by registrations or applications for registration.*
- e. Decisions and practices concerning the approval of the trademark as a well-known trademark by the competent authorities.*
- f. The worth of the trademark"*⁸¹

These WIPO-established criteria are advisory and not binding. In accordance with Article (e) of the relevant criteria, Turkey has enacted two special regulations regarding this issue. The first is the well-known trademark registry maintained in conformance with the Turkish Patent Institute.⁸² The second is the well-known trademark criterias established by the Turkish Patent Institute in accordance with WIPO standards.⁸³ Although these criteria were devised in accordance with those of the WIPO, they are more extensive and exhaustive.

⁸⁰ WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks of The Assembly of the Paris Union for the Protection of Industrial Property and of The General Assembly of the World Intellectual Property Organization (WIPO), Thirty-Fourth Series of Meetings of the Assemblies of the Member States of WIPO September 20 to 29, 1999

⁸¹ Durceylan, p.97; Çolak, p.354-359, Güneş, p.167-168, Arzu Oğuz, *Well-Known Trademarks and Application of Well-Known Trademark Criteria*, *Terazi Law Journal*, V:13, No:140, April 2018, p.41

⁸² Durceylan, p.98; Çolak, p.353

⁸³ Durceylan, p.99; M. Anıl Arslanoğlu & Aksu Dağcı, *Well-known Trademarks*, *Legal Intellectual and Industrial Rights Journal*, No:6, June, 2006

3.2.1.3.2. The Impact of Unauthorized Use on Reputable Trademark

A) Gaining a Unjust Advantage

Gaining an unfair advantage is the illegal use of a later-registered trademark to take advantage of the reputation of a previously-recognized trademark. This will have occurred if the subsequent owner does not have a valid reason for improperly using the reputable trademark.⁸⁴ This could be the case for a different product or service, or it could be the case for the same product or service. While it is evident that the likelihood of unjust advantage will increase as the reputation of the trademark increases, it would be prudent to consider the specifics of the situation when evaluating this issue.

B) Damage to the Reputation of the Trademark

Unauthorized use of a well-known trademark by third parties may harm its reputation. This is especially true if well-known trademark for high-quality products or services are used by third parties to market low-quality, inexpensive products or services. The reason for this is that the injury to the advertising and warranty functions of the well-known trademark has harmed the reputation of the third party.

C) Damage to the Distinctiveness Character of the Trademark

The use of a well-known trademark by third parties may diminish the trademark's distinctiveness. Trademark distinctiveness refers to the integration of the trademark with the goods or services it generates and the consumer's ability to make and receive connections between the products and the trademark. The unauthorized use of a well-known trademark by third parties may create a false impression in the minds of consumers and harm the trademark's commercial effectiveness.⁸⁵

3.2.2. Affixing the Sign to the Goods or to the Packaging of Those Goods

Article (7)(3)(a) of the Turkish Industrial Property Code and Article (9)(3)(a) of the EUTMR use the exact same expressions to regulate the infringement of the trademark right by affixing the sign on the goods or on the packaging. Affixing the trademark on the product or packaging is

⁸⁴ Durceylan, p.103; Çolak, p.387; İfakat Balık, *The Concept of Bad Faith in Trademark Law*, Ankara University Institute of Social Sciences (Private Law), Department of Commercial Law, Master Thesis, Ankara 2013, p.47

⁸⁵ Durceylan p.104; Hamdi Yasaman, *Well-Known Trademarks*, Journal of Galatasaray University Faculty of Law, V:1, No:1, January 2022, p.222

primarily the trademark owner's prerogative. The placement of a trademark on goods or packaging by a third party without the consent of the trademark proprietor and within the scope of trademark protection is an act of trademark infringement. Since the phrase affixing is included in the law's article, it is not sufficient to simply create the sign; it must also be attached to the products or packaging. Placing this mark on the merchandise or packaging; printing, pasting, drawing, hanging, etc. It can be implemented in a manner that establishes a connection between the product and the trademark. By printing, sticking, drawing, or mounting this symbol on the product or packaging, a connection between the product and the trademark can be established.⁸⁶ Both the CJEU and the Turkish Court of Cassation have stated that the act of positioning a third party's trademark on a product or its packaging must be motivated by a desire to market the product. The case Arsenal Football Club v. Matthew Reed⁸⁷ is one of the most significant CJEU decisions on this issue. In this case, the CJEU determined that a trademark owner may prohibit a third party from affixing their trademark to products for the purpose of selling them, even if there is no likelihood of consumer confusion. The court determined that the essential function of a trademark is to guarantee the consumer the origin of the goods or services, and that this function would be compromised if a third party could use an identical sign for identical goods or services, even if there is no likelihood of consumer confusion.

3.2.3. Importing or Exporting Goods Bearing the Registered Trademark or a Similar Mark Without Authorization:

Article (7)(3)(c) of the Code of Industrial Property and Article (9)(3)(c) of the EUTMR govern the acts of trademark infringement committed by importing and exporting commodities bearing the sign. However, this issue has been addressed in various articles of these laws, and protection has been attempted. It is helpful to evaluate the Turkish Industrial Property Code and the EUTMR independently in order to evaluate these regulations regarding this trademark infringement conduct accurately.

In accordance with the Turkish Trademark Law, Law No. 5833, which was in effect prior to the Turkish Industrial Property Code, regulates the action of trademark infringement with the phrase *"Entry of the goods bearing the mark into the customs territory, subjecting it to a customs-approved*

⁸⁶ Durceylan, p.106; Çağlar, p.111; Uzunallı, p.130

⁸⁷ Court of Justice EU, Arsenal Football Club plc v Matthew Reed, C-206/01, 12 November 2002

transaction or use."⁸⁸ Article (7)(3)(c) of the Turkish Industrial Property Code regulates *"Import and export of goods bearing the trademark."*⁸⁹ As can be seen, with the new regulation, customs procedures were precluded from the scope of trademark-infringing acts and were limited to import and export transactions. There is no requirement that the imported and exported products be placed on the market for trademark infringement to occur.⁹⁰ In addition, the fact that the trademark on the imported goods is registered in a foreign country under the name of another individual does not negate the existence of infringement.⁹¹

Article (7)(3)(c) of the Turkish Industrial Property Code mentions the import or export of products bearing the mark, but transit of goods is not regulated. Transit transport is the movement of goods from one nation to another by traversing the customs borders of a third nation. These items are only available at the customs borders of the third nation and are not sold domestically. While the situation in question was governed by the phrase *"a transaction approved by customs"*⁹² under the previous law, the Turkish Industrial Property Code does not address this issue. Article (159)(2)(b) of the Turkish Industrial Property Code grants the trademark proprietor the right to demand measures at customs for infringing goods. This is the only regulation pertaining to this issue. Therefore, although there are differing views in the legal doctrine regarding the status of transit passes, the prevailing view is that transit passes do not infringe upon the trademark right. In fact, the Regional Court of Justice issued the following ruling on March 20, 2018:

*"In Article (7) of Law No. 6769, it is not stated that the goods are subject to any customs regime, that the import or export of the goods is considered an infringement of the trademark right, and that Articles (50) and (60) of the TRIPS agreement, to which Turkey is also a party, do not regulate transit passes, a separate customs regime of the transit regime. It has been determined that there is no evidence in the file that the plaintiff's trademark is registered and valid in Romania, the destination of the goods at issue in the litigation, and that goods in transit cannot be considered an export action."*⁹³

⁸⁸ Turkish Decree-Law on the Protection of Trademarks, Legislation 556, 24 June 1995, Official Gazette No. 22326, 27 June 1995

⁸⁹ Turkish Industrial Property Code for Trademarks, Geographical Indications and Traditional Specialities, Designs, and Patents, Legislation 6769, 22 December 2016, Official Gazette No.29944, 10 January 2017, Article (7)

⁹⁰ Durceylan, p.110; Bozgeyik, p.71

⁹¹ Durceylan, p.110; Bozgeyik, p.71; Uzunallı, p.133

⁹² Turkish Decree-Law on the Protection of Trademarks, Legislation 556, 24 June 1995, Official Gazette No. 22326, 27 June 1995

⁹³ Durceylan, p.111; Istanbul Regional Court of Justice, 16th Civil Chamber, Decision No. 2018/734, 20 March 2018

In the doctrine, this new regulation is criticized on the grounds that it restricts the scope of trademark protection and is incompatible with EU law.⁹⁴ My opinion is that the legislature ought to reconsider this issue in accordance with Article (159).

If the issue is viewed from the perspective of EU law, Article (9)(3)(c) of the EUTMR governs the act of trademark infringement by import and export. This provision protects against the unauthorized importation and exportation of products bearing an EU trademark registration. A company can be held culpable for trademark infringement if it imports or exports products bearing a counterfeit or infringing mark without the owner's permission. This is because it can mislead consumers about the origin, quality, or other characteristics of the products, and it can harm the owner's reputation. Article (9)(4) of the EUTMR makes a distinction between EU and Turkish Trademark Law regarding the act constituting infringement of this trademark right. This provision of the regulation reads as follows:

“Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the EU trade mark, the proprietor of that EU trade mark shall also be entitled to prevent all third parties from bringing goods, in the course of trade, into the Union without being released for free circulation there, where such goods, including packaging, come from third countries and bear without authorization a trade mark which is identical with the EU trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark.”⁹⁵

Article (9)(3)(c) of the EUTMR extends the protection afforded to the trademark holder by including transit transports within the scope of protection. Although there is no specific regulation regarding transit passes in the Turkish Industrial Property Code, Article (9)(4) of the EUTMR addresses this issue clearly. The proprietor of an EU trademark has the right to prevent the import of goods bearing an identical or substantially indistinguishable trademark, even if those goods are not intended for free circulation within the EU, so long as the trademark rights were acquired before the filing date or priority date of the EU trademark.

⁹⁴ Durceylan, p.112; Çolak, p.498

⁹⁵ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, Official Journal of the European Union, Legislation 154, 16.06.2017, Article (9)

3.2.4. Putting the Goods on the Market, Offering Them as Deliverable, or Stocking Them for These Purposes Under the Sign, or Offering or Supplying Services

Numerous violations of trademark rights are governed by Article (7)(3)(b) of the Turkish Industrial Property Code and Article (9)(3)(b) of the EUTMR. The actions of placing the goods or services bearing the trademark enumerated in the articles of this law on the market, offering to deliver them, and stockpiling them for these purposes are primarily under the control of the trademark owner. According to the principle of extinction, it is not feasible for the trademark owner to prevent those who acquire goods bearing the trademark from disposing of them after exercising this right.⁹⁶

The first act of trademark infringement enumerated in the law's article is placing on the market without the trademark owner's consent goods bearing the mark of a third party. Act of placing on the market; putting the products on the commercial field through sale, leasing, distribution, or other similar means. According to the shared opinion of the Turkish Court of Cassation and the CJEU, the execution of these acts without a commercial motive is also regarded as an infringement of the trademark right. As a consequence of the development of technology, goods can be released to the market both online and in person. This industry is known as online marketing.

Infringement of trademark rights through e-commerce sites is actually intertwined with the forms of infringement through internet or sale and infringement included in this study, but it would be appropriate to assess all acts of infringement in this section. The most controversial aspect of trademark infringement through e-commerce is the e-commerce company's responsibility. The e-commerce company's responsibility emerges in both direct and indirect forms. Direct liability is the responsibility that arises when an e-commerce company commits trademark infringement acts directly. Indirect liability, on the other hand, is the responsibility that arises as a result of the e-commerce company's website being utilized by third parties to execute these actions. There is no explicit provision regarding the hosting provider's liability in the Turkish Industrial Property Code and EUTMR. However, the CJEU's decision in *L'Oreal v. The eBay* (2011)⁹⁷ is a precedent under both Turkish and EU trademark law. In this case, the court ruled that online marketplaces such as eBay may be held liable for trademark infringement if they have knowledge of or control over information pertaining to the sale of counterfeit products. In *Coty Germany v. Parfumerie Akzente*

⁹⁶ Durceylan, p.107; Arkan, p.107

⁹⁷ Court of Justice EU, *L'Oreal v. The eBay*, C-324/09, 12 July 2011

(2017)⁹⁸, the CJEU ruled that suppliers can prohibit their authorized distributors from selling their products on Amazon and eBay in order to preserve the luxury image of their products. Evidently, the CJEU has developed rules governing when online hosting providers can be held liable in a variety of circumstances. These precedent principles established by the CJEU have been accepted by the Turkish Supreme Court and cited in numerous cases. This typically depends on the provider's functions and control over the content.

Articles (7)(3)(b) of the Turkish Industrial Property Code and (9)(3)(b) of the EUTMR characterize as trademark infringement the offering for delivery of goods bearing the sign or the offering of services under the sign. In this context, the proposal encompasses both the proposal itself and the invitation to submit it. It does not matter how or to whom the offer is made for the infringement of the trademark in question to occur. The proposition may be made to a particular individual or to a particular or unspecified group of individuals.⁹⁹ Bids may be submitted via radio, television, print media, brochures, and email. In fact, in a decision issued by the Turkish Court of Cassation on March 13, 2006, the act of the defendant presenting the trademarked products to the public with a catalog without the consent of the trademark owner was deemed an infringement of the trademark right. Notably, the offered products do not need to be in stock for the offer to be considered an infringement of a trademark. Because of this, the fact that the infringing products will not be in stock and will be manufactured will not affect the outcome.¹⁰⁰

The final act that should be evaluated in the context of this type of trademark infringement is the stockpiling of products bearing the trademark without the owner's consent, i.e. retaining them for commercial purposes in order to sell them. This trademark infringement will occur if a product bearing the mark is used as a raw material in the production of another product, regardless of whether the goods in stock are released directly to the market. Regarding this issue, it is beneficial to mention a topic from the perspective of the Turkish Trademark Law. Article (29)(1)(c) of the Turkish Industrial Property Code likewise regulates the act of trademark infringement by holding the goods bearing the sign for commercial purposes. This section of the law reads as follows:

“ While being aware or should be aware that the trademark is counterfeited by use of the trademark or a confusingly similar trademark, to sell, distribute, put on the market in a

⁹⁸ Court of Justice EU, *Coty v Parfumerie Akzente*, C-230/16, 6 December 2017

⁹⁹ Uzunallı, p.166

¹⁰⁰ Uzunallı, p.166; Tekinalp, p.42; Karl-Heinz Fezer, *Markenrecht*, 4. Aufl., München 2009, p.850

different form, possess for commercial purpose, import, export the products carrying infringed trademark or to offer to make a contract related to this product”¹⁰¹

As seen in the article of the law, a fault has been sought in order to consider the commercial use of a trademark as an infringement of the trademark right by stating *“While being aware or having reason to be aware.”¹⁰²* Article (7)(3)(b) of the Turkish Industrial Property Code does not mention this defect, however. The subject matter and intent of both statutes are identical. However, this phrase in Article (29)(1)(c) of the doctrine results in controversy. According to the prevailing view in the doctrine, in order to effectively combat the problem of trademark infringement, the contradictory phrase should be removed from the text of the law and no faults should be sought here.¹⁰³

3.2.5. Using the Registered Trademark or a Similar Mark in Advertising, Promotion, or Online Activities

In order to evaluate this form of trademark infringement, it is useful to divide it into two categories: the unauthorized use of the registered trademark in advertisements and the use of the registered trademark in online activities, i.e. on the Internet. The first category is governed identically by Article (7)(3)(c) of the Turkish Industrial Property Code and Article (9)(3)(e) of the EUTMR under the heading *“use of the mark on business paper and in advertising.”¹⁰⁴* The purpose of both articles of law is to prevent the unauthorized use of a registered trademark in business documents and advertisements, and both articles of law contain identical terminology. In article texts, documents such as letters, printed documents, envelopes, telegrams, invoice headings, catalogues, faxes, menus, brochures, price lists, and suggestions are referred to as business documents.¹⁰⁵ In addition, the use of a registered trademark in the form of advertisements on catalogs, billboards, promotional products, and building facades for advertising purposes without the trademark owner's consent will constitute an act of trademark infringement under the terms of

¹⁰¹ Turkish Industrial Property Code for Trademarks, Geographical Indications and Traditional Specialities, Designs, and Patents, Legislation 6769, 22 December 2016, Official Gazette No.29944, 10 January 2017, Article (29)

¹⁰² Turkish Industrial Property Code for Trademarks, Geographical Indications and Traditional Specialities, Designs, and Patents, Legislation 6769, 22 December 2016, Official Gazette No.29944, 10 January 2017, Article (29)

¹⁰³ Uzunallı, p.165; Arkan, p.209

¹⁰⁴ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, Official Journal of the European Union, Legislation 154, 16.06.2017, Article (9)

¹⁰⁵ Durceylan, p.113; Savaş Bozbel, *Industrial Property Law*, On İki Levha Publishing, İstanbul 2015, p.469; Engin Erdil, *Industrial Property Law Lecture Book*, Vedat Publishing, İstanbul 2016, p.154

both legal texts.¹⁰⁶ It is not necessary that the products bearing the registered trademark have been manufactured or even sold for an act of infringement to occur.¹⁰⁷

Use of the registered trademark in unauthorized online activities should also be mentioned in relation to the act of intruding on this trademark right. Although this issue is explicitly addressed in Article (7)(3)(d) of the Turkish Industrial Property Code, the EUTMR is silent on the matter. Nonetheless, it is generally recognized in EU doctrine that offline activities permitted under Article (9) of the EUTMR will constitute trademark infringement if they are conducted online. In fact, the same legal perception is contested under Turkish law, but the legislator wished to safeguard this issue with a separate regulation from the Turkish Industrial Property Code. In reality, the basis of both perspectives is the endeavor to combat situations that arise as a result of the development of technology in accordance with existing legal regulations. Despite the fact that this issue is addressed in a separate section of the Turkish Industrial Property Code, it is evident that a broad scope of protection is intended by including general expressions in the text of the law. According to the language of this statute, there are two prerequisites for trademark infringement to occur. The first of these is that the Internet user of the registered trademark lacks a valid reason for doing so. Another requirement is that the use in question must have a commercial purpose. The use of use in a manner that produces a commercial effect rather than use for commercial purposes is more inclusive than the statement in the section titled *"Common characteristics of prior trademark infringement."*¹⁰⁸ Some non-economic applications are therefore permitted within the scope of the article.¹⁰⁹

In the EU and Turkey, acts of online trademark infringement appear in a variety of forms. The first is the use of the trademark as a domain name. The definition of domain name is names that define the Internet protocol address used to determine the address of websites. Commercial enterprises utilize the Internet domain name not only for the purpose of viewing an electronic address, but also to introduce and differentiate their businesses. The use of the same or a similar trademark as an internet domain name by a third party in a manner that creates a commercial effect without a prior right is an act of trademark infringement. Authorities evaluate whether a domain name infringes on a trademark based on the similarity of the website's message or services to the

¹⁰⁶ Durceylan, p.114; Çağlar, p.114

¹⁰⁷ Durceylan, p.114; Tekinalp, p.448

¹⁰⁸ Turkish Industrial Property Code for Trademarks, Geographical Indications and Traditional Specialities, Designs, and Patents, Legislation 6769, 22 December 2016, Official Gazette No.29944, 10 January 2017, Article (7)

¹⁰⁹ Uzunallı, p.226

trademark. However, if the trademark in question is a well-known trademark, it is acknowledged that trademark infringement has occurred without a comparison.¹¹⁰

The use of the trademark as a keyword is another online trademark infringement. Commercial enterprises pay internet search engines to place their websites at the top of search results when certain keyword indexes are used to place an advertisement. In such instances, the determined word sequences may contain the name of a registered trademark, and thus trademark infringement may occur. In the CJEU's decisions, if the trademark is used exactly in AdWords advertisement, in addition to the signs used for the existence of infringement and class identity, the conditions for this use to be during the trade, to be related to the goods or services for which the trademark is registered, and to damage at least one of the trademark's functions are sought.¹¹¹ Assessing the Turkish Supreme Court's decisions reveals that the use of keywords without a legitimate connection and in a manner that creates a commercial effect is deemed sufficient to constitute trademark infringement. Although Turkish and EU trademark laws are highly compatible, the Turkish judiciary does not consider the EU's additional criteria when assessing trademark infringement. In relation to this type of trademark infringement, it is also essential to consider whether the search engines share responsibility with the trademark user. CJEU stated that for search engines to be held liable in the *Google-Vuitton v. France* case, they must play an active role, be aware of illicit use, and not block access to the content. In contrast, the Turkish Supreme Court ruled that search engines would be held liable if they failed to act after being notified of the illegality of their decisions.¹¹²

The use of the trademark as a guiding code (Meta Tag) is an additional online trademark infringement. Since there are millions of pieces of content on the internet, search engines use the referrer codes of websites to list the content that users are seeking. The unauthorized and unjustified use of the same or similar trademark on the website constitutes an infringement of the trademark right. This is because the third party compromises the trademark's warranty and advertising functions.¹¹³ The use of the trademark by third parties as a referrer code on inappropriate sites or sites offering inferior products or services will also be considered an act of trademark infringement.

¹¹⁰ Durceylan, p.118; Çolak, p.531

¹¹¹ Durceylan, p.122; Zeynep Yasaman Kökçü, *Does The Use In AdWords Ads Of The Same Or Similar Trademark Belonging To Another Person As A "Keyword" Represent An Incentive? Infringement criteria in the light of EU Court decisions*, On İki Levha Publishing, 2017,p.792

¹¹² Turkish Court of Cassation 11th Civil Chamber, Decision No.2007/5531- 2008/7158, 5 September 2008

¹¹³ Durceylan, p.119; Çolak, p.528

Both the Court of Cassation of Turkey and the Court of Justice of the European Union have dealt with this type of trademark infringement in a similar manner.

3.2.6. Use the Sign in Comparative Advertisements

Comparative advertisements that infringe trademark rights are governed by Article (7)(3)(f) of the Turkish Industrial Property Code and Article (9)(3)(f) of the EUTMR. In the EUTMR, the phrase "*Contrary to Directive 2006/114/EC*"¹¹⁴ refers to a specific directive, whereas in the Turkish Industrial Property Code, the phrase "*against the law*"¹¹⁵ refers to a more general arrangement. Directive 2006/114/EC¹¹⁶ regulates comparative advertising in the European Union. Under the terms of this directive, comparative advertising is permitted if certain conditions are fulfilled. Comparative advertising, on the other hand, is governed by both the unjust competition provisions of the Turkish Commercial Code¹¹⁷ and the Commercial Advertisement and Unfair Commercial Practices Regulation¹¹⁸. Article (55) of the Turkish Commercial Code defines unfair competition as "*advertising and sales methods contrary to the rule of honesty.*"¹¹⁹ Similar to Directive 2006/114/EC, the Commercial Advertisement and Unfair Commercial Practices Regulation specifies that comparative advertisements are permitted if certain conditions are fulfilled.

The main point of contention in both legal regulations centered around the restriction of this trademark owner's right by permitting the use of this right in comparative advertising without creating unjust competition. According to the provisions of this law, the use of a registered trademark in comparative advertisements that do not generate unfair competition does not constitute an infringement of the trademark right.¹²⁰ However, if a comparative advertisement does not satisfy the conditions outlined by applicable laws, it could be viewed as deceptive or unjust and might

¹¹⁴ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, Official Journal of the European Union, Legislation 154, 16.06.2017, Article (9)

¹¹⁵ Turkish Industrial Property Code for Trademarks, Geographical Indications and Traditional Specialities, Designs, and Patents, Legislation 6769, 22 December 2016, Official Gazette No.29944, 10 January 2017, Article (7)

¹¹⁶ Directive 2006/114/EC of the European Parliament and of the Council of 12 December 2006 concerning misleading and comparative advertising (codified version), Official Journal of the European Union, Legislation 376/21, 27.12.2006

¹¹⁷ Turkish Commercial Code, Legislation No: 6102, 13 January 2011, Official Gazette No.27846, 14 February 2011

¹¹⁸ Turkish Regulation On The Commercial Advertisement and Unfair Commercial Practices of Turkish Commercial Ministry, Legislation No. 31737, 1 February 2022

¹¹⁹ Turkish Regulation On The Commercial Advertisement and Unfair Commercial Practices of Turkish Commercial Ministry, Legislation No. 31737, 1 February 2022, Article (55)

¹²⁰ Durceylan, p.114; Çağlar, p.114

infringe the trademark rights of a competitor. In this instance, the trademark owner will have the right to prohibit the use of his trademark in comparative advertising.

3.2.7. Use of the Sign as a Trade Name or Company Name

The trade name is the appellation under which the trader conducts business activities.¹²¹ The trade name serves to distinguish the trader from other traders.¹²² Business names, on the other hand, are the names that serve to introduce and differentiate the business from others of a similar nature. The business name describes the organization, while the trade name designates the trader.¹²³ Article (7)(3)(e) of the Turkish Industrial Property Code and Article (9)(3)(d) of the EUTMR regulate the use of a sign as a trade name or business name in the same manner. The purpose of these regulations is to confuse the consumer, which may result from the use of commercial titles or business names outside of their intended purposes, to harm the reputation of the trademark, and thus obtain an unfair advantage. Consequently, if the trade name or business name is used contrary to its intended purpose in accordance with the provisions of this law, the proprietor of the trademark may prohibit these uses. The trademark right will be infringed, however, if the previously registered trademark is a service mark, even if the trade name is used in accordance with its function.

Not every use of a trade name that is similar to a trademark will be considered an infringement, however, as the specifics of each case are extremely essential. The interpretation of these provisions can vary based on a number of factors, such as the notoriety of the trademark, whether the trade name is used for identical or similar goods or services, and the degree of similarity between the trademark and the trade name. For instance, if a registered trademark appears in the names of foundations and associations, these uses will not constitute a violation of the trademark right because they are not commercial in nature. However, trademark infringement will occur if these associations or foundations are used to establish businesses or engage in commercial activities.

¹²¹ Durceylan, p.124; Ülgen, p.391; Fatih Bilgili & Ertan Demirkapı, *Commercial Law Information*, 15th Edition, Dora Publishing, 2019, p.111; Mustafa Çeker, *Commercial Law According to the Law No. 6102*, 5th Edition, Karahan Publishing, Adana 2012, p.119-120

¹²² Durceylan, p.124

¹²³ Durceylan, p.124, Arkan, p.473

3.2.8. Extending or Transferring Rights to Third Parties Without the Licensor's Permission

In both the European Union and Turkey, trademark licensing and infringement are governed by similar general principles. Both jurisdictions have strong legal frameworks for protecting trademarks and regulating the rights and responsibilities of licensees and licensors. This form of trademark infringement is precisely defined in Article (29)(1)(ç) of the Turkish Industrial Property Code, which states, *"To broaden or transfer to third parties, without consent, the rights granted by the trademark owner through license."*¹²⁴ However, the European Union Trade Mark Regulation (EUTMR) lacks a specific article addressing trademark infringement through license agreements. Instead, the EUTMR describes the rights conferred by a European Union trade mark and the legal framework for enforcing those rights, which can be applied in situations involving license agreements. Article (9) of the EUTMR describes the exclusive rights conferred by an EU trade mark and the conditions under which a proprietor may prohibit unauthorized use of the mark by third parties. This article applies to situations in which a licensee infringes on the trademark, such as exceeding the license's scope, failing to maintain the quality of products or services, or sublicensing without permission.

License agreements have the characteristics of a unique type of contract. Typically, a license agreement involves the transmission of an intangible right from the licensor to the licensee for a fee.¹²⁵ According to the Turkish Industrial Property Code, the license agreement must be in writing and registered with the Turkish Patent and Trademark Office in order to be enforceable against third parties. However, this requirement was not included in the EUTMR. Article (25)(5) of the EU Trademark Directive allows member states to impose additional obligations in this regard. A trademark may be licensed for all or a part of the classes for which it is registered. The license agreement can be structured as either a exclusive license or a non-exclusive license.

In accordance with the EUTMR and the Turkish Industrial Property Code, the trademark proprietor may limit the license agreement's rights in terms of time, location, quantity, and/or type of services. The licensee must adhere to the license agreement's terms. Any violation of these restrictions by the licensee constitutes an infringement of the trademark owner's rights. The

¹²⁴ Turkish Industrial Property Code for Trademarks, Geographical Indications and Traditional Specialities, Designs, and Patents, Legislation 6769, 22 December 2016, Official Gazette No.29944, 10 January 2017, Article (29)

¹²⁵ Durceylan, p.140; Saine Oktay Özdemir, *Rights on Intellectual Industrial Values and Legal Character of the License Granted for These*, A Gift to Prof. Dr. Ergun Özsunay, İstanbul 2004, p.586; Özel, p.45

violation of license-granted rights can occur in numerous ways. These instances can be listed in the following manner:

A) Regarding Duration

In the license agreement, the licensor may impose a time limit on the licensee's use of the licensed trademark.¹²⁶ In this case, the licensee's right to use the trademark will expire at the end of this period.¹²⁷ In order for the licensee to continue using the trademark, the license agreement's term must be extended or a new license agreement must be signed. If the licensee does not adhere to this time restriction, the licensee will infringe the trademark owner's rights.

B) Regarding Location

In the license agreement, the licensor may restrict the licensee's use of the trademark in a specific nation, region, or city.¹²⁸ Failure of the licensee to comply with such a restriction constitutes trademark infringement.

C) Regarding Quantity

The licensor may stipulate in the license agreement that the licensee may only use the trademark on a certain number of products.¹²⁹ If the licensee exceeds this limit, there will be trademark infringement.

D) Regarding Products and Services

The trademark of the licensor may be registered in multiple trademark classes. In such instances, the licensor may restrict the licensee to specific trademark classes. The use of the trademark outside of the trademark classes permitted by the licensee constitutes an infringement of the trademark right.¹³⁰

¹²⁶ Durceylan, p.142; Çolak, p.558

¹²⁷ Durceylan, p.143

¹²⁸ Durceylan, p.142; Tekinalp, p.218

¹²⁹ Durceylan, p.143; Çolak, p.560

¹³⁰ Durceylan, p.143; Arkan, p.219

E) Through Sub-Licensing

Sub-licensing is the licensee granting third parties the right to use the trademark in accordance with the terms of the license agreement. Nonetheless, a separate evaluation must be conducted in accordance with two distinct license agreements. If an exclusive license agreement exists, the licensee is permitted to grant sub-license rights to third parties. However, if there is a non-exclusive license agreement, the licensee cannot enter into sub-licensing agreements with third parties. In light of these considerations, the licensee's execution of an unauthorized sub-license agreement will constitute infringement of the trademark right.¹³¹

¹³¹ Durceylan, p.143; Uzunallı, p.149

PART IV: LEGAL REMEDIES FOR THE TRADEMARK OWNER WHOSE RIGHTS HAVE BEEN INFRINGED

According to Article (7)(2) of the Turkish Industrial Property Code and Article (9)(2) of the EUTMR, the owner of a trademark has the right to prevent actions that constitute trademark infringement. This indicates that the trademark owner has the legal right to file a lawsuit for trademark infringement and to bring legal claims.

Article (149) of the Turkish Industrial Property Code specifies the legal remedies that a trademark owner may request from the court in cases of infringement. This provision of the law is governed as follows:

“(1) Right owner whose industrial property right is infringed can claim the following from the court:

- a) To determine the existence of infringement.*
- b) To prevent the possible infringement.*
- c) To stop the infringing actions.*
- ç) To remedy infringement and compensate material and moral damages.*
- d) To seize the products causing infringement or requiring penalty, as well as instruments, such as devices and machine exclusively used in their production, without preventing the production of products other than infringing products.*
- e) To be granted property right on products, devices and machines seized in accordance with subparagraph (d).*
- f) To take measures to prevent the continuity of infringement, in particular at the expense of the infringer to change the shapes of products and instruments such as device and machine seized according to subparagraph (d), to erase the trademarks on them or to destroy them if it is inevitable for preventing the infringement of industrial property rights.*
- g) If there is any justified reason or interest, announcement of the final judgment at the expense of the opposite party fully or in summary through the daily newspapers or other means or notification to relevant parties.”¹³²*

According to the doctrine, each of these requests has been approved as a separate case based on the nature of the request. In EUTMR, on the other hand, a general trademark infringement

¹³² Turkish Industrial Property Code for Trademarks, Geographical Indications and Traditional Specialities, Designs, and Patents, Legislation 6769, 22 December 2016, Official Gazette No.29944, 10 January 2017, Article (149)

complaint that can be filed by the trademark owner pursuant to Article (9)(2) has been regulated, as have the claims that the trademark owner can make against the court in Articles (130) and subsequent articles. Despite the fact that both the EUTMR and the Turkish Industrial Property Code grant trademark owners similar rights, there are differences in certain claims.

4.1. REQUEST FOR DETECTION OF INFRINGEMENT

Article (149)(1)(a) of the Turkish Industrial Property Code permits the owner of a trademark to request a determination as to whether the action taken against his trademark constitutes infringement. This article's objective is to inform the trademark owner on the legal nature of the relevant action and to allow the trademark owner to choose the most suitable next measures. Because of this, it is not essential for the offender to be at fault for the infringement to be determined, therefore the rape action need not continue. In other words, the fact that the perpetrator is blameless and the act has concluded does not preclude the filing of a lawsuit for determination.

In contrast, there is no specific provision in the EUTMR that permits a trademark owner to request a pre-emptive determination or declaratory judgment as to whether particular actions would constitute an infringement of their trademark. Typically, the determination of whether a particular action constitutes trademark infringement occurs in the context of a lawsuit alleging infringement. If someone is using a trademark in a manner that the trademark owner believes violates their rights, the trademark owner can file a lawsuit alleging infringement. Then, it would be the court's responsibility to ascertain whether the actions in question constitute an infringement.

4.2. REQUEST TO PREVENT THE POSSIBILITY INFRINGEMENT

Article (149)(1)(b) of the Turkish Industrial Property Code entitles the owner of a trademark to request the prevention of any potential infringement of the trademark right. This lawsuit can be filed to prevent an infringement that has not yet occurred but is likely to occur, as well as against rapes that have already occurred but are likely to occur again.¹³³ In addition, filing this case is not contingent on the perpetrator's conduct or the trademark owner's loss.

Moreover, under Article (131) of the EUTMR, if there is evidence that an imminent infringement is likely to occur, the trademark proprietor may request a preliminary injunction or other interim measures to prevent the infringement. It should be noted that the owner of an EU

¹³³ Uzunallı, p.185

trademark may petition a court in any EU member state for interim measures to prevent a potential infringement, even if the primary infringement case will be heard in another member state.

4.3. REQUEST TO TERMINATE THE INFRINGEMENT

In the event of a trademark infringement, the owner of the trademark has further options, one of which is to request a halt to the infringement. In accordance with the provisions of subparagraph (c) of Article (149)(1) of the Turkish Industrial Property Code and Article (130)(1) of EUTMR, the proprietor of a trademark who detects that his or her rights have been infringed upon may initiate legal action against the party responsible for the violation of those rights.

Both the owner of the trademark right and the exclusive licensee may seek for the suspension of the infringement. For this case to be filed, it is essential that the alleged rape be concrete and current. Yet, launching a lawsuit is not contingent on the perpetrator's fault or the existence of a loss.¹³⁴

4.4. REQUEST FOR REPRESENTATION OF INFRINGEMENT

In accordance with Article (149)(1)(ç) of the Turkish Industrial Property Code and Article (130)(1) of EUTMR, the owner of a trademark may bring a lawsuit for the removal of the infringement, or, in other words, for the elimination of the infringement. A lawsuit seeking the removal of infringement seeks to abolish or reverse the effects of infringement. Thus, this case may be filed with the condition that a trademark infringement has occurred and that its effects continue. Yet, neither the perpetrator's negligence nor the damage's occurrence are necessary for this case to be initiated.

The trademark owner or exclusive licensee may initiate a lawsuit to have the alleged violation removed. Regardless of who initiated this action, the outcomes sought to be removed will differ depending on the particular circumstances.¹³⁵ Regarding claims regarding the abolition of infringement lawsuits, examples include the removal of these products from the market, their removal from display, and their destruction.¹³⁶

Also, it should be recognized that a case can be filed so long as the effects of infringement persist. The completion of the infringement does not resolve this matter. For the case to stay uncontested, the effects of the infringement must be eliminated entirely.

¹³⁴ Çağlar, p.122; Arkan, s.234.

¹³⁵ Ege, p.81; Çolak, p.601

¹³⁶ Ege, p.81

4.5. REQUEST FOR COMPENSATION

In the event of trademark infringement, one of the rights of the trademark owner is the right to seek compensation under Article (150) of the Turkish Industrial Property Code and Article (13) of the European Union Directive 2004/48/EC. In accordance with this right, the trademark owner may claim material compensation, non-material compensation, and reputational compensation. These compensations may be claimed individually or collectively by the owner of the trademark.

4.5.1. Material Compensation

In the event of trademark infringement, the trademark proprietor may seek compensation for the material damages sustained as a result of the infringement. The primary objective of compensation, which constitutes an equalization service, is to compensate the trademark proprietor for property damages.¹³⁷ Although the material compensation claim of the trademark right holder is explicitly defined in Article (151) of the Turkish Industrial Property Code, this circumstance is not clearly regulated in the EUTMR, but it is explicitly regulated in Article (13) of the European Union Directive 2004/48/EC. The articles of this law, which vary in scope and detail, should be presented. Article (151) of the Turkish Industrial Property Code regulates as follows:

“(1) Damage suffered by the right owner includes actual loss and loss of revenue.

(2) Loss of revenue, depending on the choice of the right owner who suffered damages, shall be calculated according to one of the following evaluation methods:

a) The potential revenue to be gained by right owner if the competition by the person infringing the industrial property right had not existed.

b) The net revenue obtained by the person infringing the industrial property right.

c) License fee to be paid by the person who infringed the industrial property right, if this person used this right through a license agreement in accordance with the law.

(3) In calculation of loss of revenue; factors such as economic importance of industrial property right in particular or the number, time and type of licenses related to industrial property right during infringement action and the nature and size of violation shall be taken into consideration.

¹³⁷ Uzunallı, p.196; Fikret Eren, *Law of Obligations General Provisions*, 12th Edition, İstanbul 2010, p.691

(4) In calculation of loss of revenue; in the event that one of the evaluation methods specified in the subparagraph (a) or (b) of the second paragraph is selected and if court reaches the conclusion that industrial property right has been the determinant factor in creating the demand to that product, then the court shall decide that an equitable share be added in the calculation of revenue.

(5) In case of infringement of patent rights; if the court reaches the conclusion that the patent owner did not fulfil the obligations to use the patent as foreseen by this Code, loss of revenue shall be calculated according to the subparagraph (c) of the second paragraph.

(6) The provisions of this Article shall not be applied in case of infringement of geographical sign or traditional product name.”¹³⁸

The following is Article (13) of the EU Directive 2004/48/EC:

"(1) Member States shall ensure that the competent judicial authorities, on application of the injured party, order the infringer who knowingly, or with reasonable grounds to know, engaged in an infringing activity, to pay the rightholder damages appropriate to the actual prejudice suffered by him/her as a result of the infringement.

When the judicial authorities set the damages:

a) they shall take into account all appropriate aspects, such as the negative economic consequences, including lost profits, which the injured party has suffered, any unfair profits made by the infringer and, in appropriate cases, elements other than economic factors, such as the moral prejudice caused to the rightholder by the infringement; or

b) as an alternative to (a), they may, in appropriate cases, set the damages as a lump sum on the basis of elements such as at least the amount of royalties or fees which would have been due if the infringer had requested authorisation to use the intellectual property right in question.

(2) Where the infringer did not knowingly, or with reasonable grounds know, engage in infringing activity, Member States may lay down that the judicial authorities may order the recovery of profits or the payment of damages, which may be pre-established.”¹³⁹

¹³⁸ Turkish Industrial Property Code for Trademarks, Geographical Indications and Traditional Specialities, Designs, and Patents, Legislation 6769, 22 December 2016, Official Gazette No.29944, 10 January 2017, Article (151)

¹³⁹ Directive 2004/48 EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights, Official Journal of the European Union, Legislation, 157, 30.04.2004, Article (13)

As can be seen, both of the articles regulate essentially the same issues, but Article (151) of the Turkish Industrial Property Code is more specific. This article describes in detail the categories of damages that can be asserted for material damages, as well as the valuation methods and effective factors. However, Article (13) of EU Directive 2004/48/EC generally includes a regulation and leaves the details to the discretion of the member states.

Article (3) of EU Directive 2004/48/EC stipulates that legal measures must be equitable, effective, proportionate, and dissuasive. Therefore, the compensation demanded by the trademark owner for trademark infringement should not exceed the actual damage. In the event of a trademark infringement, this damage comprises of both tangible loss and lost profits. This issue is addressed in both articles.

Firstly, the tangible loss encompasses all costs incurred by the trademark proprietor to prevent the infringement of that trademark right. These expenses can be categorized as litigation expenses and costs incurred to clarify up market confusion. In addition, the deprived gain is the loss that results from the fact that the trademark right holder's transactions with actual or potential customers or suppliers are not realized or are not realized in sufficient quantities due to the act of trademark infringement. The trademark proprietor has the right to seek compensation for these two damages under both articles of law.

Although determining and calculating the material damage is straightforward and simple, determining and calculating the lost income is not. As a result unlike the actual loss, the loss is calculated hypothetically, since the probable gain is subtracted from the deprivation gain.¹⁴⁰ Consequently, despite the fact that valuation methods are not expressly included in EU Directive 2004/48/EC, three different valuation methods are enumerated in Article (151)(2) of the Turkish Industrial Property Code. These valuation techniques are distinct calculation techniques with the same foundation. The evaluation method to be used in calculating the lost income is left to the discretion of the trademark right owner, who may select only one. However, it is impossible to choose a distinct evaluation method from those listed.

It should be noted, however, that both Article (151) of the Turkish Industrial Property Code and Article (13) of EU Directive 2004/48/EC require a causal relation between the lost income and the compensation. In other words, the trademark owner claiming compensation must establish the connection of cause and effect in addition to negligence and damage. Turkish, Swiss, and German

¹⁴⁰ Uzunallı, p.202

law recognize the appropriate link between cause and effect theory.¹⁴¹ In accordance with this theory, a causal relationship is presumed to exist if the behavior of the trademark infringer is consistent with the harm to the trademark proprietor in the ordinary course of the concrete event. In assessing the adequacy of the causal connection, the judge's discretion is primarily decisive.¹⁴²

Last but not least, the appropriate compensation for the damage determined and calculated using the preceding information must be determined. Damage imposes a maximum limit on the quantity of compensation to be determined. In determining the quantity of compensation, it is possible to cover the damage in full or in part. Special circumstances relating to the specific event may also result in deductions from the compensation, resulting in the compensation amount being less than the damage.

4.5.2. Non-Material Compensation

In accordance with Turkish trademark law, in addition to monetary compensation, the trademark owner may seek non-monetary damages under certain conditions. In fact, the aforementioned situation is stated quite plainly under the Article (149)(ç) of Turkish Industrial Property Code and Article (130) of EUTMR.

The goal of the legislation on non-pecuniary damages is to safeguard the personal status of the trademark owner. In other words, it is to eradicate the moral damage that the trademark owner has endured for many years as a result of the damage to the trademark's image and the loss of consumer trust caused by the trademark infringement.¹⁴³

The right to claim damages that are not monetary belongs to the owner of the trademark or to any successors that he may have. According to Turkish Industrial Property Code, the licensee lacks the authority to perform this sort of action.¹⁴⁴ Nevertheless, under the EUTMR, a licensee who is entitled to initiate an infringement action may also be able to seek damages, which may include compensation for non-monetary damages. Moreover, the fact that the trademark owner is a legal entity does not preclude the owner from claiming non-monetary damages.

Lastly, it should be highlighted that since the request for non-pecuniary damages cannot be used as a method of enrichment, the amount to be awarded should be as much as is required to

¹⁴¹ Uzunallı, p.201

¹⁴² Uzunallı, p.201; Theo Fischer, *Schadenberechnung Im Gewerblichen Rechtsschutz*, Urheberrecht und Unlauteren Wettbewerb, Basel 1961, p.6

¹⁴³ Uzunallı p.219; Tekinalp, p.52

¹⁴⁴ Ege, p.88; İbrahim Yarar, *Trademark Law*, Seçkin Publishing, Ankara 2020, p.253; Çağlar, p.130

achieve the desired impact of satisfaction.¹⁴⁵ The calculation of such damages can be complicated and will depend on the particulars of the case, such as the nature of the harm caused and the laws and procedures of the EU member state where the case is heard.

4.5.3. Reputation Compensation

Reputation compensation was transferred to Turkish Trademark Law from the Spanish Patent Law and regulated in the Turkish Industrial Property Code in the same way as the Spanish Patent Law. It is recognized that harming the reputation of a trademark causes property damage. Thus, the purpose of the legal requirements governing reputation compensation is to recompense the loss of property of the trademark owner.¹⁴⁶

In accordance with paragraph two of Article (150) of the Turkish Industrial Property Code, the proprietor of a trademark has the legal right to sue for monetary compensation in the event that the infringement of that trademark results in reputational harm to the trademark. As is apparent from the provision's language, the claim for reputation compensation is subject to certain particular conditions. First of all, the reputation of the trademark must have suffered as a result of the act of trademark infringement. Hence, the concept of trademark reputation refers to the image associated with the trademark, whereas reputational damage refers to the diminution or destruction of this image. In addition, the reputational damage must have resulted from the improper use and presentation of the trademark.

In accordance with Article (9)(2) and (130) of the EUTMR, the owner of a trademark is also entitled to nominal compensation in this circumstance. Nonetheless, it should be noted that this issue, which is generally governed by these articles, may be subject to specific conditions in the trademark laws of individual member states. When calculating damages, the court may consider a variety of factors, including any damage caused to the trademark's reputation. If a court determines that the trademark infringement caused damage to the reputation of the mark, it can grant compensation.

It should be highlighted, however, that in practice, proving and calculating reputation compensation is rather challenging. In the event that a trademark owner seeks reputational restitution, the judge must analyze and examine the pertinent facts. This issue comes to the forefront in international trademark disputes due to this aspect of reputation compensation.

¹⁴⁵ Uzunallı, p. 220

¹⁴⁶ Uzunallı, p.216; Ansgar Ohly, *Schadenersatzansprüche Wegen Rufschädigung Und Verwässerung Im Marken Und Lauterkeitsrecht*, GRUR 2007, p.934; Paul Ströbe & Franz Hacker, *Markengesetz Kommentar*, 9 Aufl., Köln 2009, p.383

4.6. ADDITIONAL CLAIMS THAT MAY BE MADE BY THE TRADEMARK OWNER

4.6.1. Confiscation Of Products and Other Properties

According to Article (149)(1)(d) of the Turkish Industrial Property Code and Article (9)(1) (b) of EU Directive 2004/48, the trademark owner may request seizure of infringing products in the event of trademark infringement. Nonetheless, it is beneficial to mention a matter that is not specified in EU Directive 2004/48 but is explicitly stated in Article (149)(1)(d) of Turkish Industrial Property Code. In accordance with this law's article, the trademark owner may demand the seizure of the tools, such as devices and machinery, used exclusively in the production of the infringing products, as well as the products constituting the infringement, and the recognition of the right of ownership over the seized products, devices, and machinery. Adding the condition "*seizure in a manner that does not impede the production of other products*"¹⁴⁷, the legislator stipulated that this seizure request must be proportional and in accordance with the economic life order. Despite the fact that the seizure and transfer of ownership of vehicles used in production are not expressly regulated in EU Directive 2004/48, it is feasible for member states to consider such a measure in accordance with Article (16) of that directive.

4.6.2. Request To Take the Necessary Measures To Prevent the Continuation of Infringement

Article (149)(1)(f) of the Turkish Industrial Property Code and Article (10) of EU Directive 2004/48 permits the owner of a trademark to request that certain measures be taken to prevent the continuance of trademark infringement. In this regard, the court does not have the authority to determine ex officio; but, if the right holder makes a clear request in this regard, the court may decide accordingly.¹⁴⁸ Article (10)(2) of EU Directive 2004/48 requires the judicial authorities to order that these measures be carried out at the expense of the infringer, unless exceptional circumstances exist.

Although these characteristics of the aforementioned legal provisions are identical, their scopes differ. According to Article (149)(1)(f) of the Turkish Industrial Property Code, if it is necessary to prevent infringement, the trademark proprietor may demand that the confiscated goods

¹⁴⁷ Turkish Industrial Property Code for Trademarks, Geographical Indications and Traditional Specialities, Designs, and Patents, Legislation 6769, 22 December 2016, Official Gazette No.29944, 10 January 2017, Article (149)

¹⁴⁸ Ege, p.107; Necati Meran, *Trademark Rights and Protection of Trademark Rights*, Seçkin Publishing, p.488; Turkish Court of Cassation 11th Civil Chamber, Decision No.3824/8955, 6 November 2000

be altered that the trademarks be removed, or that the goods be destroyed. Article (10) of EU Directive 2004/48 stipulates that the trademark owner, recall from the channels of commerce, removal from the channels of commerce permanently, or annihilation. Despite the fact that both articles regulate essentially the same issues, Article (149)(1)(f) of the Turkish Industrial Property Code also addresses alterations. Although this issue is not expressly addressed in EU Directive 2004/48, member states may regulate such a measure pursuant to Article (16), in my opinion. It should be noted, however, that pursuant to Article (149)(1)(f) of the Turkish Industrial Property Code and Article (10)(3) of EU Directive 2004/48, the court must consider the Principle of Proportionality when making a decision regarding this matter, and the destruction of the products should be a last resort.¹⁴⁹

4.6.3 Announcement of the Ruling and notification to related parties

In accordance with Article (149)(1)(g) of the Turkish Industrial Property Code, if there is a justifiable reason or interest, the owner of the trademark right may request that the final decision be announced in a daily newspaper or similar form of media or notified to the relevant parties, at the expense of the other party. According to generally established Turkish Law jurisprudence, this right of claim applies not only to the trademark owner, but also to the defendant if he prevails in the action brought against him.

On the other hand, it is essential to note that the interpretation adopted by the law of the European Union differs from the interpretation accepted by the law of Turkey. Likewise, Article (15) of EU Directive 2004/48¹⁵⁰ of the European Union grants this right only to the owner of the trademark right, and the existence of a legitimate cause or interest on the part of the right owner is not required for the assertion of this right.¹⁵¹

In the implementation of this legal issue, however, Turkish law and EU law have commonalities. For the applicable court or institution to decide on this matter, the holder of the right must first submit a request. In order to reach a resolution on this matter, a lawsuit must be filed in accordance with the trademark laws of both legal systems, and the verdict must be final.¹⁵²

¹⁴⁹ Uzunallı, p.222

¹⁵⁰ Directive 2004/48 EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights, Official Journal of the European Union, Legislation, 157, 30.04.2004

¹⁵¹ Uzunallı, p.222

¹⁵² Uzunallı, p.224

4.6.4. Interim Measures and Customs Seizure

4.6.4.1 Interim Measures

The precautionary measure is an additional legal remedy that may be utilized in the event of trademark infringement. This is a temporary protection that can also be used in trademark law, and its purpose is to protect the trademark owner's rights swiftly and effectively. This issue is explicitly addressed in Article (159) of the Turkish Industrial Property Code, and the trademark the owner is afforded this opportunity. Nonetheless, despite the fact that this issue is not governed by the EUTMR, this right has been conferred to the owner of the trademark right by way of Article (9) of EU Directive 2004/48. In accordance with Article (159)(3) of the Turkish Industrial Property Code, the specifics of this issue, which is governed more comprehensively by Article (9) of EU Directive 2004/48, are governed by reference to the provisions of Civil Procedure Law No. 6100.

On the basis of these articles, the request for interim injunction may be made prior to the filing of the lawsuit, concurrently with the lawsuit, or after the lawsuit has been filed. The person requesting an interim injunction must explicitly state the grounds and type of injunction, as well as demonstrate his /her standpoint on the case's merits.¹⁵³ This request may pertain to the prevention and cessation of acts comprising an infringement, the confiscation of products and vehicles, and the provision of a guarantee for the compensation of any damages. This request is evaluated by the court independently of the case's subject matter, and the court considers the Principle of Proportionality when making a determination on this matter.¹⁵⁴ Although it is customary for the opposing party to be heard before a judge decides on a request for an interim injunction, if it is necessary to promptly protect the requester's rights, the judge may decide on the measure without hearing the opposing party.¹⁵⁵

The most essential aspect of this issue to note is the assurance provided to the defendant by these laws' provisions. In most cases, Turkish courts require the party requesting an interim measure to post a surety. This is intended to cover any potential damages incurred by the defendant in the event that it is subsequently determined that the interim measure was improperly granted. On the other hand, the EU Enforcement Directive does not require such a bond, but it does permit compensation to the defendant in Article (9)(7) if the interim measures are revoked or lapse due to

¹⁵³ Turkish Code of Civil Procedure, Legislation 6100, 12 January 2011, Official Gazette No. 27836, 4 February 2011, Article (390)(3)

¹⁵⁴ Uzunallı, p.224

¹⁵⁵ Turkish Code of Civil Procedure, Legislation 6100, 12 January 2011, Official Gazette No. 27836, 4 February 2011, Article (390)(2)

an act or omission by the applicant, or if it is later determined that there was no infringement or threat of infringement.

4.6.4.2. Customs Seizure

Due to its character, the interim order of protection includes customs seizure and storage procedures. The seizure measure at customs is an essential measure in terms of cross-border commercial activities that infringe the trademark right. This legal protection measure enables the trademark owner to more effectively secure his rights by intervening prior to the distribution of infringing products.¹⁵⁶ In fact, this issue is governed by Article (9) of the Paris Convention¹⁵⁷ and Article (50) of the Agreement for the Protection of Intellectual Property Rights (TRIPS)¹⁵⁸, which state that products unlawfully bearing a trademark can be seized at customs to prevent imports.

As stated previously, under Article (159)(2)(b) of the Turkish Industrial Property Code, the trademark proprietor has the right to file a claim regarding this matter. Although this is the general provision regarding seizure at customs, details are outlined in Article (57) of Act No. 4458 on Customs¹⁵⁹. The seizure is carried out by the relevant customs directors upon request, in accordance with the law in force. If neither a lawsuit nor a precautionary court decision is filed within ten days of notification of the seizure decision, the seizure decision will be canceled.

A trademark owner also has the right to take action against counterfeit products entering the European Union under the EUTMR. This may involve requesting that customs authorities seize allegedly counterfeit goods. The EU Regulation No 608/2013¹⁶⁰ concerns the customs enforcement of intellectual property rights and outlines the procedure for action by customs authorities where goods are suspected of infringing certain intellectual property rights as well as the measures to be taken against goods found to have infringed such rights. To exercise this privilege, the proprietor of the trademark must submit an application for action to the customs authorities in the EU member

¹⁵⁶ Çağlar, p.141

¹⁵⁷ Paris Convention for the Protection of Industrial Property (March 20, 1883; effective July 7, 1884, and amended June 2, 1934 and July 14, 1967) (the Paris Convention)

¹⁵⁸ Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr.15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994).

¹⁵⁹ Turkish Customs Code, Legislation 4458, 27 October 1999, Official Gazette No.23866, 4 November 1999, Article (57)

¹⁶⁰ Regulation (EU) No 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights and repealing Council Regulation (EC) No 1383/2003, Official Journal of the European Union, Legislation 181/15, 29.6.2013

state where the application is to be active. If approved, customs authorities are authorized to seize commodities suspected of trademark infringement.

Transit goods constitutes one of the most significant distinctions between Turkish and EU Trademark Law in terms of seizure and preservation at customs. Although there is no explicit legal regulation on this issue in Turkish law, it is generally accepted that transit goods cannot be seized. In fact, in a decision of the 11th Civil Chamber of the Turkish Court of Cassation¹⁶¹, the local court determined that it was appropriate to deny the claimant's request for seizure and preservation at customs, as the claimant had failed to demonstrate that the cigarettes at issue were in the Mersin Free Zone, had the characteristics of transit goods, and would be sold on the domestic market. In accordance with Articles (8) and (9) of the Paris Convention, counterfeit products can be seized even if they are in transit, according to authors with opposing views on the doctrine.¹⁶²

Contrary to what is generally accepted under Turkish law, it is generally accepted under European Union law that counterfeit products can be seized and held at customs even if they are in transit. In the POLO case, the Court of Justice of the European Union decided to apply Regulation No. 3295/94¹⁶³ to counterfeit products that are not Union property but are passing through the Union en route to another country.¹⁶⁴ As a result, in the aforementioned case, a provision has been made allowing the confiscation of products crossing the union's borders on the basis that they may be reintroduced to the market in EU countries through fraudulent means.¹⁶⁵ The perspective of the European Union Law on transit goods and its regulation on this issue are, in my opinion, appropriate, and it would be reasonable to adopt and apply this issue in Turkish Trademark Law as well.

¹⁶¹ Ege, p.67; Erdal Noyan, Trademark Law, Adalet Publishing, Ankara 2009, p.612, Turkish Court of Cassation 11th Civil Chamber, Decision No.2003/2043-8219, 23.09.2003

¹⁶² Ege, p.67; Kutlu Oytaç, *Trademark Law*, Beta Publishing, İstanbul 1999, p.347

¹⁶³ Council Regulation (EC) No 3295/94 of 22 December 1994 laying down measures to prohibit the release for free circulation, export, re-export or entry for a suspensive procedure of counterfeit and pirated goods, Official Journal of the European Communities, Legislation 341/8, 30.12.1994

¹⁶⁴ Ege, p.69; Oytaç, p.348

¹⁶⁵ Ege, p.69; Oytaç, p.348

PART V: PROCEDURAL ASPECTS OF TRADEMARK INFRINGEMENT CASES

5.1. PARTIES TO THE ACTION OF TRADEMARK INFRINGEMENT

5.1.1. Complainant

5.1.1.1. The Owner of the Trademark

The owner of a trademark has the legal right to initiate legal action in the event of alleged trademark infringement. The trademark owner is the natural or legal person for whom the trademark was registered.¹⁶⁶

In the event of a violation of the trademark right that is the subject of ownership in the case of participation, the owners should often file a joint lawsuit. This issue is regulated both in Article (7) of the Turkish Industrial Property Code and in Article (9) of the EUTMR. In contrast, in the case of a joint trademark, the trademark owners should be permitted to launch a separate lawsuit against them, since they are permitted to individually utilize the joint trademark.¹⁶⁷

According to both EUTMR and Turkish Industrial Property Code, the rights granted by a trademark are effective against third parties as of the date of publication of the trademark registration. Unless the registration of the trademark is publicized in accordance with this provision, it is often impossible for the trademark owner to bring the lawsuits and indemnification lawsuits due to infringement of the trademark right.¹⁶⁸

5.1.1.2. Licensee

In accordance with the legal regulations in both Turkish Law and European Union Law regarding Trademark Law, the trademark right may be the subject of a license agreement for some or all of the goods or services for which it is registered. For this reason, the conditions under which the licensee can file a lawsuit in case of infringement of the trademark right are regulated in Article (158) of Turkish Industrial Property Code and Article (25)(3) of EUTMR. In both articles of the law, the licensee's ability to file a lawsuit for trademark infringement is governed, but under distinct conditions. Therefore, mentioning the articles of the law is worthwhile. According to Article (158) of the Turkish Industrial Property Code:

¹⁶⁶ Çağlar, p.192; Ege, p.114

¹⁶⁷ Ege, p114; Noyan, s.608; Engin Erdil, *Industrial Property Law*, Vedat Publishing, İstanbul 2016, p.309

¹⁶⁸ Uzunallı, p.227

“(1) Unless otherwise agreed in the contract, person who has an exclusive license, in case of infringement of industrial property right by a third party, may institute legal proceeding on his own, which may be filed by the right owner in line with this Code.

(2) Person who has non-exclusive license, if right to institute a legal proceeding due to infringement of industrial property right is not expressly limited in the contract, with a notification, shall request the right owner to institute the required legal proceeding. In case the right holder does not accept this request or does not file the requested legal proceeding within three months, licensee may institute the legal proceeding in its own name and to the extent of his own interests. Licensee who institutes a legal proceeding according this paragraph shall notify the legal proceeding to right owner.

(3) The licensee, in the presence of serious damage risk and before the expiration of the relevant period, may request the court to order an interlocutory injunction. In cases where court orders an interlocutory injunction, licensee shall be authorized to institute a legal proceeding. In such case, terms specified in the second paragraph shall be completed while trial continues.”¹⁶⁹

Article (25)(3) of the EUTMR, on the other hand, is as follows:

“Without prejudice to the provisions of the licensing contract, the licensee may bring proceedings for infringement of an EU trade mark only if its proprietor consents thereto. However, the holder of an exclusive licence may bring such proceedings if the proprietor of the trade mark, after formal notice, does not himself bring infringement proceedings within an appropriate period.”¹⁷⁰

5.1.1.2.1. Non- Exclusive Licensee

According to Article (158) of the Turkish Industrial Property Code in circumstances when the license is not exclusive, as a rule, the licensee does not have the right to file a lawsuit against trademark infringements. In the case of trademark infringement, the simple licensee requests the trademark owner to file a lawsuit with a notary public notice. If the trademark owner accepts this request, he can initiate trademark infringement cases and seek compensation. However, if the

¹⁶⁹ Turkish Industrial Property Code for Trademarks, Geographical Indications and Traditional Specialities, Designs, and Patents, Legislation 6769, 22 December 2016, Official Gazette No.29944, 10 January 2017, Article (158)

¹⁷⁰ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, Official Journal of the European Union, Legislation 154, 16.06.2017, Article (25)

trademark owner does not accept this request within three months, the simple licensee may file the required lawsuits by including the notification he has provided.¹⁷¹ However, it should be noted that since the provision is not mandatory, the simple licensee may be authorized to sue under a contract.¹⁷²

In contrast, under Article (25)(3) of the EUTMR, non-exclusive licensees need the trademark owner's consent to initiate infringement proceedings. The procedure that became a requirement under the Turkish Industrial Property Code was not governed by the EUTMR, and a straightforward consent was deemed sufficient. It should be noted, however, that the licensor and the non-exclusive licensee may, as per the Turkish Industrial Property Code, stipulate a different procedure in the license agreement.

5.1.1.2.2. Exclusive Licensee

According to Article (158) of the Turkish Industrial Property Code, unless otherwise specified in the agreement, the exclusive licensee may initiate lawsuits on behalf of the trademark owner in the event of a third party's infringement of the trademark owner's rights resulting from the trademark.¹⁷³ The exclusive licensee's right to litigate is not contingent on the trademark owner's permission. Notably, allowing the exclusive licensee the power to litigate on his own behalf does not affect the trademark owner's legal rights.¹⁷⁴

On the other hand, according to Article (25)(3) of the EUTMR, the exclusive licensee, like the non-exclusive licensee, must obtain permission from the licensor before filing a lawsuit for trademark infringement. Nevertheless, if the trademark proprietor fails to initiate proceedings following formal notice, the non-exclusive licensee may be permitted to do so.

5.1.1.3. Owner of the trademark as exclusive licensor

As described in the preceding section, the exclusive licensee's right to sue in the event of trademark infringement does not prevent the owner of the trademark as exclusive licensor from asserting trademark infringement claims. This includes instances in which the licensee is not adequately protecting the trademark or where the infringement is so pervasive that it threatens the

¹⁷¹ Uzunallı, p.231, 232; Ege, p.114

¹⁷² Uzunallı, p.232

¹⁷³ Uzunallı, p.231

¹⁷⁴ Uzunallı, p.231; Burak Ongan, *Legal Status of the Parties in License Agreements for Industrial Property Rights*, Seçkin Publishing, Ankara 2007, p.130

overall value of the trademark. Hence, as an exclusive licensor, the trademark owner has the right to bring a lawsuit for damages to remedy trademark infringement situations and his own harm.¹⁷⁵

5.1.1.4. Lienor

As a result of the essential characteristics of the trademark right, it may be subject to legal proceedings. One of these legal transactions is pledge. This issue is explicitly regulated in Article (148)(1) of the Turkish Industrial Property Code. This article of the law is governed as follows:

“The industrial property right may be transferred, inherited, become the subject of license; put in pledge; shown as collateral, seized or become the subject of other legal actions.”¹⁷⁶

In principle, if a lien has been placed on a trademark, the lienor has a legal claim on the trademark as protection for a debt. Therefore, if the infringed trademark is pledged, the pledgee may file a lawsuit to protect its rights arising from the trademark. The reason for this is the pledgee's desire to safeguard the trademark's collateral value.¹⁷⁷ It should be underlined, however, that if the pledge is not on the trademark but on the commercial enterprise, then, unless otherwise agreed, the trademark will be included in the scope of the pledge on the commercial enterprise, and the pledgee may initiate a lawsuit.¹⁷⁸

EUTMR, on the other hand, does not address the rights of a lienor to file a trademark infringement case. Consequently, the particulars can be contingent on the provisions of the agreement between the lienor and the trademark owner, as well as the laws of the various EU member states. In general, however, this circumstance was viewed as the exception, not the rule.

5.1.1.5. Owner of a Well-Known Trademark Under the Paris Convention

Article (1)(6) of the Paris Agreement allows the owner of a well-known trademark within the sense of the Paris Agreement to assert claims recognized by the applicable legal norms in the event of violation of the trademark right, without registering the trademark. In this context, the owner of a recognized trademark as defined by the Paris Agreement may pursue litigation both in

¹⁷⁵ Uzunallı, p.229

¹⁷⁶ Turkish Industrial Property Code for Trademarks, Geographical Indications and Traditional Specialities, Designs, and Patents, Legislation 6769, 22 December 2016, Official Gazette No.29944, 10 January 2017, Article (148)

¹⁷⁷ Uzunallı, p.235

¹⁷⁸ Ege, p.115; Meran, p.503

Turkey and EU for the prevention of infringement, the suspension of infringement, and compensation for unfair use.¹⁷⁹

5.2. Defendant

5.2.1. Real or Legal Person Performing Prohibited Actions of Infringement

In accordance with the laws of the Turkish Industrial Property Code and EUTMR, if a trademark right is infringed by a third party, the owner of the trademark right may initiate a lawsuit against the infringer. By using the term all third parties in both laws, the trademark owner is granted broad authority in this regard. Therefore, it is recognized that the person committing acts of trademark infringement can be either a natural or legal person. A legal person in this context refers to an entity with legal rights and obligations, such as a corporation, partnership, or government agency. The procedure for initiating a dispute against a legal entity can vary depending on the laws of the individual EU member states and the particulars of each case.

5.2.2. Licensee

As previously stated, if the licensee extends its rights without the licensor's permission, there will be an infringement of the trademark right. Both the Turkish Industrial Property Code and the EUTMR have adopted it. Therefore, if an exclusive or non-exclusive licensee infringes on the trademark by exceeding the boundaries of the licensee agreement, the licensor may assert the same claims against the licensee as he would in cases of trademark infringement.¹⁸⁰

5.2.3. Those Who Participate in, Assist in, Encounter or Facilitate Infringement

Article (61) of the Turkish Code of Obligations allows the trademark owner to file trademark infringement cases against people who participate in, help, or encourage illegal trademark infringement, such as the production or sale of products bearing the trademark. These persons, together with the original person who committed the act of infringement, are jointly liable for the damages suffered by the trademark owner.¹⁸¹ In a judgement on this matter, the Turkish Supreme Court declared that the person who actually performs the activities in his father-in-law's winery but who looks to be an employee on paper, is likewise liable to the plaintiff.¹⁸²

¹⁷⁹ Uzunallı, p.229

¹⁸⁰ Uzunallı, p.236

¹⁸¹ Uzunallı, p.236

¹⁸² Ege, p.115; Meran, p.504; Turkish Court of Cassation 11th Civil Chamber, Decision No.6886/9744, 10.12.2001

In EU law, this issue is not explicitly regulated in the EUTMR, and member states have the authority to regulate it. In case law, however, the general rule is that anyone who uses a trademark without the owner's permission and in a manner that violates the owner's rights can potentially be held liable for trademark infringement. This may include not only the primary infringer, but also anyone who contributes to, aids, or facilitates the infringement. It is important to note that the specifics can vary depending on the regulations of each EU member state and the particulars of each case.

5.2.4 Persons Who Cannot Be Claimed due to Infringement of the Trademark

More than one article of both the EUTMR and the Turkish Industrial Property Code should be cited when designating individuals who cannot be sued for trademark infringement. Initially, it is beneficial to note the limitations on the effect of the trademark right as set forth in Articles (7)(5) of the Turkish Industrial Property Code and Article (14) of the EUTMR. These are governed by three headings in both articles. The first of these is when third parties use a trademark to designate their own name or address. Therefore, using one's own name or address in the conduct of business may not constitute trademark infringement if done in accordance with honest practices in industrial or commercial matters. The other is the use of the trademark by a third party to describe the nature, quality, quantity, intended use, price, geographical origin, time of production and presentation, or other characteristics of the goods or services. In other words, if a trademark consists of signs or indications that are descriptive of the commodities or services, their characteristics, or their intended use, third parties may use these signs or indications in accordance with honest industrial or commercial practices. Lastly, it is the use of a third party's trademark to indicate the intended use of a product or service, particularly in the case of accessories, spare parts, or similar products. Similarly, if this use falls within the scope of goodwill and is consistent with the commercial flow, there will be no trademark infringement. In light of these explanations, the owner of the trademark right will not be able to file trademark infringement lawsuits against third parties who violated the trademark right in the instance of these usage patterns.

The use of the trademark for non-economic purpose by third parties is a second issue associated with this particular instance. Although this circumstance is addressed in Article (153)(1) of the Turkish Industrial Property Code, the EUTMR is silent on the matter. Article (153)(1) of this Turkish Industrial Property Code reads as follows:

“Owner of industrial property right may not institute civil proceedings indicated in this Code or file a complaint for a criminal proceeding against persons who retain or use for their personal needs the products put on the market by the infringer.”¹⁸³

Article (9)(2) of the EUTMR, which provides the proprietor of an EU trademark with certain exclusive rights, the vast majority of which are expressly related to commercial activities, also suggests that non-commercial use of a trademark may not constitute an infringement. Therefore, under both legal systems, it should be recognized that the trademark owner cannot sue for trademark infringement if third parties use the trademark for non-economic activities.

The Exhaustion Principle, which states that the trademark right holder's rights have been exhausted and they are no longer permitted to sue for trademark infringement, is another matter that must be addressed. Despite the fact that this policy has been discussed in great detail previously, the trademark owner's rights are considered exhausted once the products or services covered by the trademark have been made available for sale by the trademark owner or with their permission. Although Turkish and EU trademark laws define market differently in this context, the fundamental concept is the same. This means that as long as the quality of the goods or services has not been altered or diminished, third parties may resell, distribute, or use the branded goods or services without infringing on the rights of the owner.

Additionally, the comparative advertising issue under this topic should be mentioned. Comparative advertising is governed by Article (9)(3)(f) of the EUTMR and Article (7)(3)(f) of the Turkish Industrial Property Code, despite having been discussed in detail previously. In these articles, if it does not conform with the relevant legal regulations, it is considered an act of trademark infringement, whereas if it complies with the relevant legal regulations, it is not considered an act of trademark infringement. In accordance with the applicable law, the use of a competitor's trademark for comparative advertising purposes may be permitted under certain conditions, provided that the use is fair and not deceptive. Therefore, it will be impossible to file trademark infringement lawsuits against the pertinent third parties of the trademark owner in these instances.

Use of trademark in the context of freedom of expression and artistic expression is the final point that should be emphasized regarding this topic. This fundamental right is outlined as follows in Article (10) of the European Convention on Human Rights:

¹⁸³ Turkish Industrial Property Code for Trademarks, Geographical Indications and Traditional Specialities, Designs, and Patents, Legislation 6769, 22 December 2016, Official Gazette No.29944, 10 January 2017, Article (153)

“(1)Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers. This article shall not prevent States from requiring the licensing of broadcasting, television or cinema enterprises.

(2) The exercise of these freedoms, since it carries with it duties and responsibilities, may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society, in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation or rights of others, for preventing the disclosure of information received in confidence, or for maintaining the authority and impartiality of the judiciary.”¹⁸⁴

Even though this issue is not explicitly addressed in the EUTMR or Turkish Industrial Property Code, case law has recognized it. This refers to striking a balance between trademark rights and the fundamental rights of free speech and artistic expression. Nonetheless, the manner in which this balance is struck can differ depending on the specifics of each case and the interpretation of the applicable laws and regulations, which can vary across jurisdictions. In the EU, the CJEU has acknowledged in its case law that the EU's fundamental rights, including freedom of expression, must be considered when administering the EUTMR. This means that a third party may be able to use a trademark in their artwork if the artistic expression justifies the use and it does not prejudice the trademark owner's interests unduly. On the other hand, the Turkish Constitution protects freedom of expression and artistic creativity, and these rights must be balanced against the rights of trademark owners. The Turkish courts may consider whether the use of the trademark is essential to the artistic work and whether it harms the trademark owner's economic or reputational interests.

5.2. COMPETENT COURTS IN CASE OF TRADEMARK INFRINGEMENT

In accordance with Article (156) of the Turkish Industrial Property Code, the Civil Court of Intellectual and Industrial Property Rights and the Criminal Court of Intellectual and Industrial Property Rights are the competent courts in Turkey for trademark infringement lawsuits filed under Turkish law. In provinces where the Intellectual and Industrial Property Rights Civil Court and the Intellectual and Industrial Property Rights Criminal Court have not been established, the Civil

¹⁸⁴ Council of Europe, European Convention for the Protection of Human Rights and Fundamental Freedoms, as amended by Protocols Nos. 11 and 14, 4 November 1950, ETS 5, Article (10), available at: <https://www.refworld.org/docid/3ae6b3b04.html> [accessed 29 May 2023]

Courts of First Instance and the Criminal Courts of First Instance handle cases and matters falling under this court's competence. Nonetheless, it is important to note that lawsuits that may be filed due to trademark infringement are a legal field in which the parties are allowed to freely dispose of, and the parties may also seek to have the matter arbitrated if they so want.¹⁸⁵

A European Union Trademark, on the other hand, is protected in all EU member states. Therefore, when it comes to litigation involving the infringement of an EUTM, these cases are typically heard by the European Union Trademark Courts. The precise structure of these courts varies from country to country within the European Union. Each EU member state has designated them to deal with EUTM infringement and validity issues. However, if the trademark application is made at the national level in the member states, the Trademark Law Courts of the country where the pertinent protection is valid will be the competent court in the event of a trademark infringement.

In accordance with the Turkish Industrial Property Code and the Code of Civil Procedure, the Turkish Trademark Law specifies the tribunals authorized to hear trademark infringement cases. Article (6) of the Code of Civil Procedure governs the operation of tribunals of general jurisdiction. According to this provision, the general jurisdictional court is the court of the defendant's place of residence at the time of the lawsuit. According to Article (156)(3) of the Turkish Industrial Property Code, those who have jurisdiction in cases of trademark infringement are the courts of the plaintiff's place of domicile, the place where the unlawful act occurred, or the place where the effects of these unlawful acts can be observed. According to Article (156)(4) of the Turkish Industrial Property Code, if the plaintiff's place of residence is outside the Republic of Turkey, the proper judiciary is the court where the plaintiff's legal representation has a registered office. In the event that this registry office record has been removed from the registry, the courts at the location of the Turkish Patent Institute's headquarters are authorized to hear the case.

The jurisdiction for European Union Trade Mark infringement cases is defined in the European Union Trade Mark Regulation and the Brussels I Regulation¹⁸⁶, if this issue is evaluated under EU Trademark Law. The European Union Intellectual Property Office is responsible for the registration of EUTMs under the EUTMR. However, the EUIPO has no authority over cases of infringement. EUTM infringement cases are adjudicated by national courts of EU member states designated as EU Trademark Courts. The Brussels I Regulation, which governs jurisdiction and the

¹⁸⁵ Uzunallı, p.239; Yüksel Bozkurt & Ebru Armağan, *Methods of Resolving Patent Disputes International Arbitration and State Jurisdiction*, Yetkin Publishing, Ankara 2009, p.183; Tahir Saraç; *Infringement of Rights arising from Patent and Protection of Right*, Seçkin Publishing, Ankara 2003, p.313

¹⁸⁶ Regulation (EU) No 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (recast), Official Journal of the European Union, Legislation 351/1, 20.12.2012

enforcement of judgments in civil and commercial matters, stipulates as a general rule that a defendant should be sued in the courts of their country of residence. To commit a tort, delict, or quasi-delict, a defendant may also be sued in the local court where the detrimental event occurred or may occur. This is typically interpreted in the context of an EUTM infringement as either the EU member state where the act of infringement occurred or the EU member state where the injury occurred. Notably, an EU Trade Mark Court in any EU member state can issue judgments that are applicable and enforceable throughout the EU, although the practical enforcement of such judgments may require additional steps under the national laws of the other EU member states.

5.3. STATUTE OF LIMITATIONS

Article (157) of the Turkish Industrial Property Code stipulates that the provisions of the Turkish Code of Obligations dated 11.01.2011 and numbered 6908 concerning the statute of limitations apply to the trademark right holder's private law claims. The relevant provisions of the Turkish Code of Obligations prescribe a two-year and a ten-year statute of limitations. As evidenced by Turkish Supreme Court decisions¹⁸⁷, the statute of limitations does not start expiring so long as the act of infringement continues.

In case of infringement of a well-known trademark, there is no time limit for the lawsuits filed by the trademark owner against the registered trademark.¹⁸⁸ Within five years, the recognized trademark owner must file a lawsuit against the trademark registrant. This case has no timeline unless the opposing side acted in bad faith.¹⁸⁹

On the other hand, the EUTMR does not expressly stipulate a time limit for commencing an action for trademark infringement. Typically, national laws of the EU member state where the action is initiated govern the time limits for bringing infringement proceedings. As each EU member state has its own implementation of EU directives and its own legal statutes, there can be variations from country to country. For instance, the Trademark Act of Germany refers to the Civil Code's general provisions governing limitation periods. The statute of limitations for trademark infringement claims is typically three years. This period commences at the end of the year in which the claim arose and the trade mark owner either obtained knowledge of the infringement or was

¹⁸⁷ Ege, p.109; Tekinalp, p.517; Turkish Supreme Court of Appeals General Assembly, Decision No.1996/130, 19.02.1969; Turkish Court of Cassation 11th Civil Chamber, Decision No.3188/3826, 24.06.1996

¹⁸⁸ Ege, p.112; Adem Yıldız, *Trademark Lawsuits*, Turkish Patent Institute, Department of Trademarks, Specialization Thesis, Ankara 2005, p.103.

¹⁸⁹ Ege, p.112

exceedingly negligent in failing to do so. Regardless of knowledge or egregious negligence in failing to obtain knowledge, claims become statute-barred ten years after their occurrence.

5.4. MEDIATION REQUIREMENT PRIOR TO FILING A LAWSUIT IN COURT

Article (5)(A) of the Turkish Commercial Code, which entered into force on January 1, 2019, requires a mediation obligation for the cases specified in Article (4) of the relevant statute. According to Article (4)(d) of the Turkish Commercial Code, civil cases stemming from issues specified in intellectual property law legislation are commercial litigation. Thus, in terms of trademark law, mediation as a prerequisite of proceeding will be contested in compensation claims and claims resulting from contractual relationships. In such instances, prior to filing a lawsuit, the plaintiff must submit an application to the mediator, obtain a report stating that the dispute cannot be addressed through mediation, and attach the report to the petition.¹⁹⁰ In the event that a lawsuit is filed without first submitting an application to a mediator in mandatory circumstances, the lawsuit will be dismissed procedurally, as the mandatory mediation requirement is not a requirement that can be fulfilled in the future.¹⁹¹

This obligatory mediation requirement in Turkish law is not specified by EU regulations. In the majority of European legal systems, mediation is a voluntary process that aims to promote the discovery of creative solutions between the parties to a conflict through the use of a non-binding, impartial third party in order to reach a mutually acceptable resolution, to foster mutual understanding, and to facilitate the exchange of information. defined as a procedure-based. Although this is the general consensus at the EU level, there are instances in which some member states differentiate between mandatory and voluntary mediation, and in some instances require mandatory mediation.

According to article (15)(a) of the German Code of Civil Procedure, an alternative dispute resolution method must be utilized in *"compensation cases related to defamation, disputes related to neighborhood law, compensation cases related to violation of the principle of equality, and disputes with a case value of up to 750 Euros."*¹⁹² Similarly, in Italy, *"in cases involving immovable property, immovable ownership cases in partnership, disputes related to family company agreements, cases involving the distribution of assets and inheritance, cases involving immovable*

¹⁹⁰ Ege, p.118

¹⁹¹ Ege, p.119; Serdar Kale, *Trial Procedure in Trademark Lawsuits*, Adalet Publishing, Ankara 2020, p.44

¹⁹² Hasan Yıldırımoglu, *Commercial mediation practices in European countries*, Istanbul Commerce University Journal of Social Sciences Law Issue, 21(44), 2022, p.953

rent and commercial lease, malpractice cases, defamation cases, and finally insurance contracts, it is mandatory to resort to mediation."¹⁹³ As can be seen, however, these requirements typically pertain to specific areas of law, such as family law or consumer disputes, and not intellectual property disputes such as trademark infringement.

¹⁹³ Yıldırımoglu, p.956

PART VI: CRIMES INVOLVING TRADEMARKS AS A RESULT OF TRADEMARK INFRINGEMENT

In terms of Turkish Law, the crimes envisaged due to trademark infringement are regulated in Article (30) of the Turkish Industrial Property Code. According to this provision, *"A person who produces or provides goods or services, offers for sale or sells, imports or exports, purchases for commercial purposes, keeps, transports, or stores infringing another's trademark right by citation or confusion shall be sentenced to imprisonment from one to three years and fined up to twenty thousand days."*¹⁹⁴

The investigation and prosecution of such offences are contingent on the trademark's registration in Turkey and the trademark owner's complaint. The person who has registered as the owner of the trademark in the trademark registry has the right to file a complaint in trademark infringement cases. The complaint is the individual whose rights regarding trademark protection have been infringed.¹⁹⁵ The perpetrator is the person who commits the acts mentioned in this provision. Regarding this provision, it should also be underlined that effective repentance is anticipated for the criminal. Effective repentance is attainable prior to the verdict being pronounced.

In case the trademark offense is committed within the framework of the activity of a legal person, additional security measures specific to these shall be imposed. While Article (30) of the Turkish Industrial Property Code does not address search, seizure, and confiscation in relation to these offenses, the relevant provisions of the Turkish Criminal Code and the Turkish Criminal Procedure Code are applied.¹⁹⁶

EU Trademark law, on the other hand, classifies trademark infringement as a civil offense rather than a criminal offense. In certain EU member states, however, certain acts related to trademark infringement may also fall under criminal law. As national laws are responsible for criminal matters, the specific criminal offenses associated with trademark infringement may vary between member states. In EU member states, however, counterfeiting, trademark forgery, trademark dilution and trademark fraud are generally recognized as trademark infringement crimes. It is essential to notice that the criminal enforcement of trademark infringement varies among EU member states, as do the penalties and legal procedures.

¹⁹⁴ Turkish Industrial Property Code for Trademarks, Geographical Indications and Traditional Specialities, Designs, and Patents, Legislation 6769, 22 December 2016, Official Gazette No.29944, 10 January 2017, Article (30)

¹⁹⁵ Ege, p.126; Yıldız, p.104

¹⁹⁶ Uzunallı, p. 245

CONCLUSION

The trademark, which is used to distinguish a company's products and services from those of its competitors, is a concept with commercial and legal significance nowadays. In 1882, the Nizamme granted trademark protection for the first time under Turkish law. The Nizamme, which remained in effect until the Republican period, was repealed by Trademarks Law No. 551. Despite the fact that this law has been criticized in numerous ways, I believe it is appropriate and sufficient given the circumstances of the period in question. With the development of commercial life and the influence of international law, this law became inadequate, and Decree Law No. 556 was enacted to rectify the situation.

Although it is compatible with contemporary and international law, the Constitutional Court struck down a few of its articles because some issues were governed by decree law rather than statute, which was improper. The Industrial Property Law No. 6769 was issued and put into effect in order to increase compliance with this constitutional concern and international law. This law was drafted concurrently with the EU Trademark Law regulations in an effort to increase the harmonization with EU Law during Turkey's accession efforts. The Industrial Property Law No. 6769, which is still in effect, and the Implementation Regulation of the Industrial Property Law are the cornerstones of the Turkish Trademark Law.

Since the European Union consists of numerous countries, its trademark law is governed by a variety of regulations. Today, EU Trademark Directive No 2015/2436, EU Trademark Regulation No 2017/1001 and EU Directive No. 2004/48 are the pillars of the European Union Trademark Law. It represents 2004/48. With the EU Trademark Directive, international standards for trademark protection have been established, and member states are required to harmonize their national laws with this Directive. Despite the fact that the EU Trademark Directive includes common binding provisions on the protection of trademarks in general, the implementation of some of its rules is left to the discretion of the member states. The EU Trademark Regulation governs issues pertinent to the Community Trademark, which provides a uniform trademark within the EU and has the same effect in all member states. While this EU Trademark Regulation governs the fundamental aspects of a Community trademark, EU Directive No. 2004/48 regulates certain legal remedies that a trademark right holder may pursue in the event of a trademark infringement.

The proprietor of a trademark is afforded comprehensive protection under the Turkish and EU Trademark Laws, whose structures and contents are essentially comparable. In order to determine when the protection against trademark infringement will begin and end, as well as to

establish the scope of the trademark right, it is essential to define when the trademark right will arise. It is generally recognized that trademark rights can be attained through two primary means: registration and use. Through registration under both Turkish and EU Trademark Law, the owner of the trademark acquires the rights deriving from it. The acquisition of trademark rights via use is an exceptional occurrence. Article (7)(4) of the Turkish Industrial Property Code and Article (11) of the EUTMR regulate the time period during which trademark rights may be asserted against third parties. According to these provisions, the trademark owner's rights become effective against third parties upon publication of the trademark registration. However, the applicant may file a complaint seeking compensation for actions that occurred subsequent to the publication of the trademark application in the Bulletin, unless the registration of the trademark has been announced. Prior to the dissemination of the registration, the court is unable to adjudicate on the validity of the presented claims.

The trademark right provides the owner with numerous privileges. One of these privileges is the authority to prohibit the use of the trademark without the owner's consent. The use of third parties without the owner's consent is regarded as an infringement of trademark rights. The concept of trademark infringement is recognized in both Turkish and EU Trademark Law. Both legal systems require the existence of certain conditions for an act to qualify as trademark infringement. Both legal systems recognize the following terms: use of the trademark without the owner's permission, use of the trademark for commercial purposes, use of the trademark in the protection of the trademark, and use of the trademark where it has been registered.

There are numerous methods in which an infringement of trademark rights can occur. Both the Turkish Trademark Law and the EU Trademark Law have evaluated potential scenarios and incorporated the categories of conduct that may constitute an infringement of trademark rights into their respective legal frameworks. In EU law, acts constituting trademark infringement are governed by Article (9) of the EUTMR and Article (10) of the EU Trademark Directive, whereas in Turkish law, they are governed by Article (7) and Article (29) of the Turkish Industrial Property Code. Although the subject and scope of the aforementioned articles of law are comparable, there are significant procedural and interpretive differences between them.

The issue of likelihood of confusion appears to be the primary distinction between the trademark scope provisions of the Turkish Industrial Property Code and those of the EU Trademark Regulation. Article (7)(2) of the Turkish Industrial Property Code states that this issue might generate a likelihood of confusion, whereas Article (9)(2) of the EUTMR states if a likelihood of confusion exists. Although the purpose of protection provided by the articles of both laws is

identical, the various interpretations of the provisions resulted from the wording of the likelihood of confusion. Since the likelihood of confusion test serves as a litmus test in the evaluation of acts infringing the trademark right, it is beneficial to note the different primary points of these tests, which resulted from the two legal systems' distinct interpretations of the relevant phrase. In contrast to the European Union's likelihood of confusion test, Turkey's possibility of confusion test has a lesser threshold. Accordingly, the Turkish Trademark Law facilitates the trademark owner's ability to demonstrate trademark infringement. Notably, member states may impose additional requirements for likelihood of confusion assessments within their trademark law systems, so long as they comply with EUTMR provisions.

The evaluation of online trademark infringement via the use of the trademark as a keyword is conducted using distinct criteria in Turkey and EU. In accordance with EU Trademark Law, if the trademark is used precisely in an AdWords advertisement, in addition to the signs used for the existence of infringement and class identity, the conditions for this use to be during the trade, to be related to the goods or services for which the trademark is registered, and to harm at least one of the trademark's functions are sought. Although Turkish and European Union trademark laws are extremely compatible, the Turkish judiciary does not take the EU's additional criteria into account when assessing trademark infringement.

Another distinction between the EU and Turkey relates to trademark infringements committed through comparative advertising. The distinction is a result of the wording of the laws. While the EU Brand Regulation recognizes that trademark infringement occurs when comparative advertisements violate Directive 2006/114/EC, the Industrial Property Law No. 6769 states that trademark infringement occurs when comparative advertisements violate the law. The Turkish Trademark Law, which provides a broader level of protection, encompasses all legal regulations, including the Turkish Commercial Code and the Commercial Advertisement and Unfair Commercial Practices Regulation.

Another distinction is the infringement of the licensees' trademark rights in order to extend the license agreements. This act of trademark infringement is expressly regulated by Article (29)(1) (c) of the Industrial Property Law, but the European Union Trade Mark Regulation (EUTMR) lacks a specific article addressing trademark infringement via license agreements. Instead, the EUTMR outlines the rights conferred by a European Union trade mark and the legal framework for enforcing those rights, which can be applied in license agreement situations. Article (9) of the EUTMR defines the exclusive rights conferred by an EU trade mark as well as the circumstances under which a proprietor may prohibit unauthorized use of the mark by third parties. This article pertains

to situations in which a licensee infringes on the trademark, including exceeding the extent of the license, failing to maintain the quality of products or services, and sublicensing without permission. The procedural validity conditions of license agreements should also be mentioned. To be enforceable against third parties, the Turkish Code of Industrial Property stipulates that the license agreement must be in writing and registered with the Turkish Patent and Trademark Office. This requirement is not, however, included in the EUTMR. The EU Trademark Directive's Article (25) (5) permits member states to impose additional obligations in this regard.

According to both Industrial Property and EUTMR, the owner of a trademark has the right to prevent actions that constitute trademark infringement. This indicates that the trademark owner has the legal right to file a lawsuit for trademark infringement and to bring legal claims. While this is explicitly regulated in a legally enforceable manner by the Industrial Property Law, it is also jointly regulated by the EUTMR and EU Directive 2004/48. In cases of trademark infringement, both legal systems provide similar legal remedies to the trademark proprietor, but there are procedural differences.

The first legal remedy afforded to the holder of a trademark right in the event of trademark infringement is a request for the detection of the infringement. Although this issue is explicitly addressed in Article (149)(1)(a) of the Turkish Industrial Property Code, EUTMR does not contain a corresponding provision. While this issue has been regulated as a separate lawsuit request and lawsuit in the Turkish Industrial Property Code, EUTMR has accepted it as an issue to be evaluated within the scope of the primary trademark infringement litigation.

Although there is no definitive trademark infringement, the trademark owner has the right to request the prevention of potential trademark infringement if there is significant evidence that the infringement will occur. This privilege is granted by Article 149(1)(b) of the Turkish Industrial Property Code and Article (131) of the EUTMR to the owner of the trademark. Notably, the owner of an EU trademark may petition a court in any EU member state to prevent a prospective infringement, even if the principal infringement case will be heard in another member state.

In the event of a trademark infringement, the trademark proprietor has additional options, one of which is requesting that the infringement terminate. In accordance with the provisions of subparagraph (c) of Article (149)(1) of the Turkish Industrial Property Code and Article (130)(1) of EUTMR, the owner of a trademark who discovers an infringement of his or her rights may initiate legal action against the party responsible for the infringement.

According to Article (149)(1)(c) of the Turkish Industrial Property Code and Article (130) (1) of the EUTMR, the owner of a trademark may file a request for the removal of the infringement,

or, in other words, for the elimination of the infringement. The objective of a lawsuit pursuing the eradication of infringement is to eliminate or reverse the effects of infringement. Thus, this case may be filed if a trademark infringement has occurred and its effects persist.

In the event of trademark infringement, the trademark owner also has the right to ask for compensation under Article (150) of the Turkish Industrial Property Code and Article (13) of Directive 2004/48/EC of the European Union. In accordance with this right, the trademark owner may seek material, non-material, and reputational compensation. These reimbursements may be claimed individually or collectively by the trademark owner.

Although this privilege is governed similarly by the Turkish Industrial Property Code and EU Directive 2004/48/EC, there are some methodical and procedural differences. The first of these concerns the right to seek material damage compensation. Both articles regulate the same issues, but Article (151) of the Turkish Industrial Property Code is more specific than Article (13) of the EUTMR. This article describes in detail the types of damages that can be claimed for material damages, along with the valuation methods and effective factors. Article (13) of EU Directive 2004/48/EC leaves the particulars to the discretion of individual member states. In addition, despite the fact that valuation methods are not expressly included in EU Directive 2004/48/EC, Article (151)(2) of the Turkish Industrial Property Code lists three distinct valuation methods. These valuation techniques are distinct calculation methods that share the same basis. The method for calculating lost income is left to the discretion of the owner of the trademark right, who may choose only one. However, it is impossible to select a unique evaluation method from the options provided. Another distinction relates to the claim for non-material damages. The right to bring an action for non-monetary damages pertains to the owner of the trademark or his potential successors. According to the Turkish Industrial Property Code, the licensee lacks the authority to engage in such conduct. Nonetheless, under the EUTMR, a licensee who has standing to initiate an infringement action may also be able to pursue damages, which may include non-monetary compensation.

In the event of trademark infringement, the trademark owner may also request seizure of infringing products. Both the Turkish Industrial Property Code and EU Directive 2004/48/EC grant this privilege to the owner of a trademark. Contrary to EU Directive 2004/48/EC, the trademark owner may, under the Turkish Industrial Property Code, demand the seizure of the tools, such as devices and machinery, used exclusively in the production of the infringing products, as well as the infringing products themselves, and the recognition of the right of ownership over the seized

products, devices, and machinery. It should be noted, however, that although this issue is not regulated by EU Directive 2004/48, member states can regulate it.

In addition, Article (149)(1)(f) of the Turkish Industrial Property Code and Article (10) of EU Directive 2004/48 allow the owner of a trademark to request certain measures to prevent the continuation of trademark infringement. Despite the fact that these characteristics of the aforementioned legal provisions are identical, their scopes are distinct. As an addition to Article (10) of EU Directive 2004/48, Article (149)(1)(f) of the Turkish Industrial Property Code regulates the alteration. Although this issue is not expressly addressed in EU Directive 2004/48, member states may regulate such a measure in accordance with Article (16).

The owner of a trademark may also request that the court's decision be made open to the public. Both the Turkish Industrial Property Code and EU Directive 2004/48 provide the trademark owner with the aforementioned privilege. In contrast to the Turkish Industrial Property Code, which provides this opportunity to both the trademark owner and the defendant, EU Directive 2004/48 only grants this right to the trademark owner.

The precautionary measure is an additional legal recourse available in the event of trademark infringement. This issue is addressed explicitly in Article (159) of the Turkish Industrial Property Code and Article (9) of EU Directive 2004/48. The specifics of this issue, which is regulated more comprehensively by Article (9) of EU Directive 2004/48, are governed by reference to the provisions of Civil Procedure Law No. 6100, per Article (159)(3) of the Turkish Industrial Property Code.

Finally, custom seizure is one of the legal remedies available to the proprietor of a trademark. The trademark owner has been granted the aforementioned right under both the Turkish Industrial Property Code and the EUTMR. In Turkish law, this issue is governed by Law No. 4458 on Customs, while in EU law, it is governed by EU Regulation No. 608/201. Transit products represents one of the most significant differences between Turkish and EU Trademark Law in terms of seizure and preservation at customs in relation to this generally regulated right. Although there is no explicit legal regulation regarding this issue in Turkish law, it is generally acknowledged that transit goods cannot be seized. Contrary to Turkish law, it is generally accepted under European Union law that counterfeit products can be detained and held at customs even if they are in transit.

After examining the fundamental aspects of trademark infringement, it is beneficial to address the procedural aspects. Within the procedural scope of a lawsuit for trademark infringement are the parties, the competent and authorized court, and the conditions to be resolved prior to filing

suit. Despite the fact that these issues are governed similarly by Turkish and EU Trademark Law, there are differences in the particulars.

The trademark right holder, licensee, trademark owner as licensor, lienor and well-known trademark owners can all be plaintiffs in trademark infringement cases. The first difference between Turkish and EU Trademark Law is the licensee's ability to file a lawsuit. First, the non-exclusive licensee was not permitted by the Turkish Industrial Property Code to file a lawsuit for trademark infringement. In the event of trademark infringement, the non-exclusive licensee will notify the licensor through a public notary, and if the licensor accepts this request, a lawsuit will be filed. However, if the licensor does not respond within three months to the licensee's offer, the non-exclusive licensee may file a lawsuit. On the other hand, despite the absence of such a comprehensive procedural requirement in the EUTMR, the non-exclusive licensee is permitted to file a lawsuit if it obtains the licensor's simple consent. In terms of the exclusive licensee, in accordance with the Turkish Industrial Property Code, the exclusive licensee is entitled to file a lawsuit without the need for any permission of the licensor. However, in accordance with EUTMR, the exclusive licensee must obtain permission from the licensor, just like the non-exclusive licensee, in order to file a lawsuit. The ability of the pledgee to file a complaint is an additional aspect that differs between Turkish and EU Trademark Law. While Article (148)(1) of Turkish Industrial Property Code expressly permits the pledgee to take legal action, EUTMR does not address the lienor's right to file a trademark infringement suit. Consequently, the specifics may depend on the terms of the agreement between the lienor and the trademark owner, as well as the laws of the various EU member states. In general, this situation was regarded as the exception, not the norm.

In trademark infringement cases, a defendant may be an actual or legal person committing prohibited acts of infringement, a licensee or those who participate in, assist, encounter or facilitate infringement. The difference between Turkish and EU Trademark Law regarding the title of defendant relates to the individuals who participated in the act of trademark infringement. Article (61) of the Turkish Code of Obligations permits the owner of a trademark to submit trademark infringement cases against those who participate in, aid, or promote unlawful trademark infringement, such as the production or sale of products bearing the trademark. On the other hand, this issue is not expressly addressed in the EUTMR, and member states have the authority to address it. The general rule in case law, however, is that anyone who uses a trademark without the owner's permission and in a manner that violates the owner's rights may be held culpable for trademark infringement. This may include not only the primary infringer, but also anyone who assists, contributes, or facilitates the infringement.

In trademark infringement cases, the competent and authorized court is an additional crucial procedural factor that should be mentioned. According to Turkish law, the Civil Court of Intellectual and Industrial Property Rights and the Criminal Court of Intellectual and Industrial Property Rights are the competent Turkish tribunals for trademark infringement cases submitted under Turkish law. Typically, the European Union Trademark Courts adjudicate disputes involving the infringement of an EUTM. Within the European Union, the precise structure of these tribunals differs from country to country. They have been designated by each EU member state to handle EUTM infringement and validity issues. In the event of a trademark infringement, the Trademark Law Courts of the country where the relevant protection is valid will have jurisdiction. In addition, Turkish law categorizes the competent tribunals as either general or special. Specially authorized courts in cases of trademark infringement are the courts of the plaintiff's place of residence, the place where the unlawful act occurred, or the place where the effects of these unlawful acts can be observed. The general jurisdictional court is the court of the defendant's place of residence at the time of the lawsuit. In contrast, according to EU law, the EUIPO has no authority over infringement cases, despite being responsible for the registration of EU trademarks. EUTM infringement cases are adjudicated by national tribunals designated as EU Trademark tribunals in EU member states. As the EU member state where the act of infringement occurred or the EU member state where the damage occurred.

In trademark infringement cases, the statute of limitations is another crucial procedural issue. Although Article (157) of the Turkish Industrial Property Code explicitly regulates the statute of limitations in trademark infringement cases, the EUTMR has remained reticent on this issue. In this provision of the law, a two-year and ten-year statute of limitations is specified, and it is stipulated that the statute of limitations will not begin to run as long as the trademark infringement persists. In contrast, national laws of the EU member state where the action is initiated typically regulate the time limits for instituting infringement proceedings. Due to the fact that each EU member state has its own implementation of EU directives and its own legal statutes, there can be differences between countries.

Mandatory mediation is the most significant procedural distinction between Turkish and EU Trademark Law. According to Article (5)(A) of the Turkish Commercial Code, mediation as a prerequisite to proceeding will be challenged in compensation claims and contractual claims. Prior to filing a litigation, the plaintiff must submit an application to the mediator, obtain a report stating that the dispute cannot be resolved through mediation, and attach the report to the petition in accordance with trademark law. In the event that a litigation is filed without first submitting an application to a mediator in mandatory circumstances, the argument will be procedurally dismissed

because the mandatory mediation requirement cannot be satisfied in the future. On the other hand, the EU regulations do not specify this mandatory mediation requirement in Turkish law. In the majority of European legal systems, mediation is a voluntary process that aims to promote the discovery of creative solutions between the parties to a conflict through the use of a neutral, non-binding third party to reach a mutually acceptable resolution, foster mutual understanding, and facilitate the exchange of information. characterized as procedure-based. Although this is the general consensus at the EU level, there are instances in which some member states distinguish between mandatory and voluntary mediation, and require mandatory mediation in some instances.

The final point to be addressed is trademark infringement offenses. According to common knowledge, trademark infringement has both legal and criminal aspects. While the legal aspect is heavily emphasized in this study, the criminal aspect is additionally dealt with in the final section. This issue is explicitly addressed in Article (30) of the Turkish Industrial Property Code, which regulates both the legal and criminal implications. In contrast, trademark infringement is considered a civil offense rather than a criminal offense under EU trademark law. In certain EU member states, however, trademark infringement-related activities may also be punishable by criminal law. As criminal matters fall under the jurisdiction of national laws, the specific criminal offenses associated with trademark infringement may vary between member states.

As can be seen from the entirety of this research, although the Turkish and EU Trademark Laws are structured similarly, there are procedural and specific differences. One of the primary reasons for this is that the EU Trademark Law serves as a guide by providing a general and basic regulation to the trademark laws of the countries within the community. Since the EU is comprised of many countries, and some issues are left to the discretion of the individual member states, the EU Trademark Law serves as a general and basic regulation. The Turkish Industrial Property Code, which is the cornerstone of Turkish trademark law, contains parallel regulations to the EU's regulations, but also regulates issues that the EU leaves to the discretion of the member states in accordance with the Turkish legal system. Adhering to my criticisms in the study, it would be advantageous to bring future trademark law regulations of Turkish law closer to the EU Trademark Law by contemplating these differences.

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