Turkey - The New IP Code  
(Law on Industrial Property No. 6769 in force since 10 January 2017)

The new IP Landscape in Turkey is determined by the new IP Code as well as the establishment of mid-level appellate courts.

The new IP Code has a wide-ranging impact:

- at the legislative level
  - with the legislation of IPRs regarding:
    - establishment/prosecution
    - maintenance
    - enforcement

- at the administrative level
  - with the changes on the Administrative Structure and function of the Turkish Patent and Trademark Office (T.P.T. Office) (previously named the Turkish Patent Institute)

- at the professional level
  - with new rules regarding the organization and exercise of the profession of Patent and Trademark Attorneys, especially from a disciplinary stand point.

- at the judiciary level
  - in addition, the legislation on IPRs gives the T.P.T. Office competences which are in nature “judicial”: such as cancellation of trademark registrations on ground of non-use

Establishment of Mid-Level Appellate Courts

On July 20, 2016 Turkey added a new layer to its court system – the appellate courts, between the first-instance courts and the Supreme Court (Court of Cassation). The objective is to reduce the caseload of the Supreme Court and achieve quicker, consistent, higher-quality jurisprudence. Figure 1 shows the present litigation procedure incorporating the new appellate courts.

Regarding IPRs, the new IP Code aims:

- to replace the following repealed Decree-Laws with an act of parliament:
  - Patents and Utility Model - Decree-Law No. 551
  - Designs - Decree-Law No. 554
  - Trademarks - Decree-Law No. 556
  - Geographical Indications - Decree-Law No. 555

- to further harmonization
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- with the EU legislation for trademarks:
  - EU Regulation No. 2015/2424 on Community Trademark
  - EU Directive No. 2015/2436 to approximate the Laws of the member states relating to trademarks

- with the EU legislation for designs:

- with the International Conventions of which Turkey is signatory

  - to simplify and accelerate the prosecution with a view to shorten the timeline until registration
  - to bring structural changes regarding instruments and requirements of protection, and of invalidity

In respect of the IP legislation, the new IP Code has been prepared by taking as basis the provisions of the repealed Decree-Laws.

Accordingly, the coherent and integrated body of Industrial Property legislation that Turkey has enjoyed with the repealed Decree-Laws since 27 June 1995, finds itself in the new IP Code with the amendments brought to it.

The continuity and amendments brought with a view to further harmonization denote in fact the intention of the Country to keep modernizing and adapting its IP legislation and institutions/bodies.
Historical Context

From the presentation made on 04 October 2008 in PTMG Conference – Istanbul

Current Legislation on IPRs
Patents/Utility Models, Trade/Service Marks, Industrial Designs, Geographical Indications/Signs

* Unlike many countries, instead of amending gradually its IP legislation, Turkey has enacted on 27 June 1995 an entirely new series of Decree-Laws No. 551 for the protection of patents/utility models, No. 556 trade/service marks, No. 554 industrial designs and No. 555 geographical indications/signs, with a view to prepare for its European Union Candidacy, to address the needs of its varied and expanding industry and economy and to fully harmonize its IP legislation not only wit the legislation of the European Union but also with the international Conventions of which it is signatory.

* The Decree-Law No. 556 on Trade/Service Marks is in conformity with the Directive No. 89/104 regarding the harmonization of EU member countries trademark legislation and with the council regulation No. 40/94 concerning the community trademark.

Current Legislation on IPRs

* Common characteristic of the currently in force Decree-Laws, is that they are similar in their structures and that some of their provisions are similar/identical such as: -the necessity of obtaining a registration for benefiting from the protection provided by the act - persons entitled to obtain protection in Turkey, -priority, -exhaustion of rights, -status changes, -litigation, -compensation, -competent courts, -infringement evidence, -establishment of experts’ opinion through the court in determination of evidence/facts of infringement, the declaration of non-infringement/similarity, -injunctive relief upon court order, -procedural law, -border measures. With said Decree-Laws, Turkey has enacted a fully integrated and coherent body of industrial property legislation with acts having parallel structures and provisions.
Current Legislation on IPRs

Drafts of new laws for repealing and replacing the currently in force Decree-Laws.

* It must be said that the series of Decree-Laws enacted on 27 June 1995 have been rushed through to meet the deadline originating from the Customs Union formed in 1995 between Turkey and EU with the intention to enact the respective laws through the Parliament at a later date to replace the Decree-Laws. At the moment the situation is unchanged as the Decree-Laws in question continue to be in force.

* In this regard the drafts prepared by the TPI for the new laws on Patents/Utility Models, on Trade/Service Marks, on Design Patents and on Geographical Indications to repeal and replace the respective Decree-Laws are waiting their turn before the parliamentary commission.
The New IP Code consists of:

- **Introductory General-Purpose Articles:**
  - Article (1) Purpose and Scope
  - Article (2) Definitions
  - Article (3) Those who will benefit from Protection

- **Book One – Trademarks**
  - Articles (4) to (32) - 29 Articles

- **Book Two – Geographical Indication and Traditional Product Name**
  - Articles (33) to (54) - 22 Articles

- **Book Three – Designs**
  - Articles (55) to (81) - 27 Articles

- **Book Four – Patents and Utility Model**
  - Articles (82) to (145) - 64 Articles

- **Book Five – Common and Other Provisions**
  - **Section One – Common Provisions**
    - (applicable to patents, designs, trademarks and geographical names)
    - Articles (146) to (165) - 20 Articles
    - Article (146) Terms and notifications
    - Article (147) Mutual representative
    - Article (148) Legal procedures
    - Article (149) The requests that may be put forward by the owner of rights whose industrial property right is infringed
    - Article (150) Indemnification
    - Article (151) Non-realized income
    - Article (152) Exhaustion of right
    - Article (153) Non-prosecutable persons
    - Article (154) Actions with regard to nonexistence of infringement and conditions therefor
    - Article (155) Effect of previous rights
    - Article (156) Competent Court
    - Article (157) Prescription of time limit
    - Article (158) Actions to be filed by licensee and conditions therefor
    - Article (159) Request for interim injunction and nature thereof
    - Article (160) Persons authorized to act and notification
    - Article (161) Fees, periods of payment and effects thereof
    - Article (162) Execution of decisions
    - Article (163) Prompt destruction procedure
    - Article (164) Provisions to be applied to traditional product names
    - Article (165) Regulations
Section Two – Other Provisions

- Articles (166) to (180) - 15 Articles
  Concern the internal organization of the Turkish Patent and Trademark Office
  These provisions bring structural changes to the organization of the T.P.T. Office by amending the Law No. 5000 of 06.11.2003 on the establishment and duties of the Turkish Patent Institute (by its former name) such as the setting up of “Intellectual Property Academy and Educational Center of Industrial Property Rights” (Art. 168) and of the “Department of Geographical Indications”.

- Articles (181) to (182) – 2 Articles
  Concern the Profession of Patent and Trademark Attorneys
  - Adoption of professional rules of conduct (specified under an ad hoc regulation).
  - Adoption of sanctions against breach of professional rules of conduct.
  - Establishment of a new disciplinary board under the aegis of the Office with power to sanction breach of professional rules of conduct.

- Articles (183) to (193) - 11 Articles
  Concern the internal staff needs, titles and structure of the Office
  Also concern the repealed legislation as well as transitional provisions.
Common Provisions
(Commonly applicable to Patents/Utility Models, Designs, Trademarks and Geographical Indications)

1/1- Adoption of “international exhaustion of rights” (Art. 152/1)

“National Exhaustion” was retained under the repealed Decree-Laws No. 551, 554, 556

However, the Supreme Court rendered decisions accepting the international exhaustion of rights despite the text of the repealed Decree-Law.

The New IP Code removed this contradiction and introduced the international exhaustion of rights principle, to replace the existing national exhaustion principle.

1/2- For trademarks only, the rights holder may stop the commercial use of products which have been altered or deteriorated (Art. 152/2)

2- New form and (electronic) means of notification proprietary to the Office (Art. 160/6)

According to this provision, the Office will not be subject to follow the rules of electronic notification as provided by the “Notification Law” No. 7201 of 11.02.1959.

3- Prompt Destruction procedure (Art. 163)

Concerns goods seized and placed under judicial custody

4/1- No criminal sanctions for infringement of:

- Patents and Utility Models
- Design Patents
- Geographical Indications
  - The repealed Decree-Laws No. 551 on Patents and No. 554 on Design Patents and No. 555 on Geographical Indications provided criminal sanctions which were cancelled by Constitutional Court decisions on grounds that criminally punishable acts and criminal sanctions cannot be provided by Decree-Laws but only by acts of Parliament.

4/2- Criminal Sanctions only for trademark infringement (Art. 30)

Important to note that Law No. 5833 of 28.01.2009 on Criminal Sanctions regarding trademark infringements having not been repealed also continues to be in force.

5- Registered IP Rights No Longer a Valid Defence against Infringement Claims (Art.155/1)

- The registered trademarks, patents and industrial design registration rights do not constitute a legitimate defence against an infringement claim put forward by the owner of the earlier IP right. This provision will evidently require an intensive clearance search—even in case of a registration—before utilizing any IP right.
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The case law according to the repealed legislation accepted that trademark and industrial design rights registered with the T.P.T. Office constituted a legitimate defence against infringement claims, unless and until the registered right is cancelled and removed from the register. This case law caused preliminary and permanent injunction requests to be delayed or rejected until cancellation of the infringer’s trademark or the design right.

6- Earlier clause on “benefiting from more favourable provision” removed from the new IP Code

The following provision of Art. 4 of Decree-Laws No. 551 on Patents/Utility Models, No. 554 on Design Patents and No. 556 on Trademarks has not been included in the new IP Code.

This provision has apparently been excluded to avoid duplication with Art. 90 of the Constitution which concerns the hierarchy of norms in the sense that the international conventions override the national laws with respect to the hierarchy of norms, as they are deemed above the national laws.

Priority of Application of International Agreements

Article 4:

Where International Agreements having entered into force according to the laws of the Republic of Turkey, contain provisions which are preferential/more favourable to those of this present Decree-Law, the persons referred to in Article 2 may request to benefit from such preferential/more favourable provisions.

The above provision would have permitted to claim the application of Art. 54/4 + 54/5 of EPC for filing a patent application regarding “second medical use” in this country whereas, because of the silence of the new IP Code on the issue, in case such a request is not favourably received, the only alternative would be to challenge the administrative decision on this point through the court.

7- Suspensive effect of the appeal on first instance or appellate court decisions.

The new Turkish IP Code provides under the Chapter "Common Provisions" in Article 162 that "in court actions instituted against the decisions of the "Higher Council of Examination and Evaluation" (of the T.P.T. Office) as well as in invalidation actions, the decision of the court shall not be executable until it becomes finalized”. In other words, for all such cases the appeal shall automatically have suspensive effect on the first instance or the appellate court decision until the date when the case is finalized.

This new provision introduces yet another regime in respect of the Civil Procedural Law (Art. 367) for the cases involving invalidation and for the cases instituted against Office actions such as decisions of refusal or Office decisions/actions regarding post-grant oppositions in patent and design patent matters.
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Turkey – Patents

I- Structural Changes

Repealed Decree-Law No. 551 on Patents and Utility Models provided:

- a choice between 3 instruments of protection
  - short term patent of 7 years with State-of-the-Art Search Report
  - Utility Model of 10 years with optional State-of-the-Art Search Report
- with the possibility of branching out (to/from) between the 3 instruments:
- no post-grant opposition for patents and Utility Model
- but third parties can file opinions upon the publication of State-of-the-Art Search Report

1st Level Structural Change - Abolition of the short-term patent of 7 years

- The choice is now between 2 instruments
  - Full term patent of 20 years with mandatory substantive examination
  - Utility Model of 10 years with mandatory State-of-the-Art Search Report
- The branching out (to/from) is maintained (Art. 104)

2nd Level Structural Change - Introduction of Past-Grand Opposition (for patents only) (Section III/Art. 99 + 100) 6 months from the publication of the decision to grant

- Important impact at the Administrative Level – Setting up and operation of the Appeal Board with the T.P.T. Office

3rd Level Structural Change - Concerns Utility Models

- New requirement of mandatory State-of-the-Art Search Report
  - criteria of novelty and industrial applicability (Art. 142/1) maintained unchanged,
  - no opposition for Utility Model (Art. 143/11),
  - applicant can raise objection to the State-of-the-Art Search Report with the possibility to bring amendments,
  - third parties can file opinions upon the publication of the State-of-the-Art Search Report

- More explicit definition of matter excluded from Utility Model protection
  - in addition to those cited under Art. 82 (2) (non-patent eligible subject matter) and Art. 82 (3) (non-patentable subject matter)
  - chemical and biological substances or processes or products obtained by such processes (Art. 142/3-a),
  - pharmaceutical process and substances or pharmaceutical products obtained by such processes (Art. 142/3-b),
  - biotechnological inventions (Art. 142/3-c),
  - processes or products obtained by such processes (Art. 142/3-ç),

II- No mention in the new IP Code of:

- Second medical use patents.
  - The new IP Code is silent on the subject despite the recent Supreme Court case law ruling that the second medical use inventions are patentable.
  - However, Turkey affords protection to second medical use patents validated through the European Patent Convention of which Turkey is signatory.
- Supplementary Protection Certificates (SPC) - No protection afforded in Turkey
III- Biotech Patents (Arts 82/3-b-ç & d + 82/5)

These provisions cite “the non-patentable biotechnological inventions” as outlined in the following comparative table showing the related articles of EPC, Rules and the New IP Code.


Article 82 concerning “Patentable inventions and exceptions to patentability” cites under paragraphs 3/b-c-ç-d and 5 the “non-patentable biotechnological inventions” so as to mirror the provisions of:

- EPC Article 53/b-c concerning “Exceptions patentability” and
- EPO Guideline Rule 28 (a), (b), (c), (d) concerning “exceptions to patentability, EP shall not be granted in respect of biotechnological inventions, which in particular concern …” and Rule 29 concerning “the human body and its elements”. Accordingly, what is not expressly excluded remains patentable.

It is to be noted that the motivation of the new IP Code clearly frames biotech areas/subject matter qualifying for patent protection. In fact it reflects biotechnological subject matter retained as patent eligible according to EPO Enlarged Board of Appeal decisions. As no definition of “biotechnological invention” is provided in the act this issue will have to be shaped by case law.

The Turkish Intellectual Property Court recently ruled that a claimed probe and method for detecting nucleic acids are patentable as long as the patentability requirement of novelty and inventive step are met, whereas the court in the same decision ruled to the fact that gene sequences are deemed to be non-patentable. The decision is still pending before the Supreme Court.

| Comparative Table of related provisions of EPC, Rules and the New IP Code in relation "Biotechnological Inventions" |
|-------------------------------------------------|-------------------------------------------------|
| EPC                                             | Code of Industrial Property 6769                |
| Article 53 Exceptions to Patentability           | ARTICLE 82 - Patentable inventions and exceptions to patentability |
| (b) plant or animal varieties or essentially biological processes for the production of plants or animals; this provision shall not apply to microbiological processes or the products thereof; | (3) Patent shall not be granted for the following inventions: b) Plant or animal varieties or essentially biological processes for the production of plants or animals, excluding microbiological processes or the products thereof; (5) Microbiological process mentioned in subparagraph (b) of paragraph three means any process involving or performed upon or resulting in microbiological material; essentially biological process means the production |
## Comparative Table of related provisions of EPC, Rules and the New IP Code in relation "Biotechnological Inventions"

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<tr>
<th>EPC</th>
<th>Code of Industrial Property 6769</th>
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<td>Article 53 (c) methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body; this provision shall not apply to products, in particular substances or compositions, for use in any of these methods.</td>
<td>Article 82 (3) Patent shall not be granted for the following inventions: c) All therapeutic methods including diagnostic methods and surgical methods to be applied on human or animal body.</td>
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### Rule 28 Exceptions to patentability

European patents shall not be granted in respect of biotechnological inventions which, in particular, concern the following:

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<th>Article 82</th>
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<td>(a) processes for cloning human beings;</td>
<td>(3) Patent shall not be granted for the following inventions: d) Processes for cloning human beings;</td>
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<td>(b) processes for modifying the germ line genetic identity of human beings;</td>
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<td>(c) uses of human embryos for industrial or commercial purposes;</td>
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<tr>
<td>(d) processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes.</td>
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### Rule 29 The human body and its elements

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<td>(1) The human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions.</td>
<td>(3) Patent shall not be granted for the following inventions: ç) The human body including the human body at the various stages of its formation and development and the simple discovery of one of its elements, including the sequence or partial sequence of a gene.</td>
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<td>(2) An element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention.</td>
<td>There is no article or clause that corresponds to Rule 29 Paragraphs (2 &amp; 3). But the motivation of Article 83 comprises exact phrases that covers the patentable inventions within the context of Rule 29 Paragraphs (2 &amp; 3). In Turkish</td>
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Comparative Table of related provisions of EPC, Rules and the New IP Code in relation "Biotechnological Inventions"

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<td>even if the structure of that element is identical to that of a</td>
<td>Law, motivation of articles constitutes an indivisible and integrated part of the Articles of a Code. Therefore, Rule 29 Paragraphs (2 &amp; 3) find their way, so as to say in referential way, in new Turkish Code of Industrial Property.</td>
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<td>natural element.</td>
<td>(3) The industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application.</td>
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IV- Enforcement: Reversal of burden of proof regarding Process Patents (Art. 141/2)

- The new text aims to remove room for interpretation by retaining that:
  - “Where the patented process results in a new product or substance, those claiming the contrary in respect of products or substances having the same characteristics, shall have to bring evidence thereof”.
  - “Where the products or substances are the same as those obtained by the patented process the court has discretionary competence to ask the defendant to bring evidence that said products/substances are obtained by a process which is different to the patented one”.

V- Requirement of Use (Art. 130/2) – Introduction of the “application date” as an alternative date for putting the patent to use

- Statutory time period for putting the patent to use as amended is:
  - 3 years from publication of the decision to grant, or
  - 4 years from application date, whichever is later (newly introduced), or
  - “Discontinuing use without a justifiable reason for an uninterrupted period of 3 years”

- The time period for putting the patent to use may in fact be much longer than the above referred 3 or 4 years as Art 130/2 provides that “use as of the date when the compulsory license request has been made is to be evidenced”. In other words, any use made after the above deadlines but before the request of compulsory license, will undo the negative effects of non-use [i.e. heal / cure non-use] after the above deadlines until the date when the request for compulsory license is made. This increases flexibility in favour of the patentee.

- As a result of this amendment it becomes possible
  - to offer for licence a patent application (Art. 128/1)
  - to request a compulsory licence for a patent application (Art. 130/2)
- No cancellation of patent on grounds of non-use
- Sole sanction for non-use: compulsory licence

VI- Filing with the office of declaration and evidence of use is discontinued

- Under the former Decree-Law No. 551 use needed to be reported to the Office (T.P.T. Office) by filing appropriate declaration(s) and documentary evidence(s) to such effect.
Turkey – The New IP Code

- The new Law No. 6769 is silent on the issue as it contains no provision for continuing to report use to the Office and to file with the Office declaration and documentary evidence(s) regarding use of patents.
- Hence the prosecution of filing with the Office of declarations and other documentary evidence with respect to the use of patents is discontinued.
- Consequently, no action needs to be taken with the Office for reporting and evidencing the working of patent(s) in this country as from 10 January 2017.
- This is a welcome development as it streamlines the procedure by seriously simplifying and reducing the cost of the prosecution regarding the maintenance and working of patents in this country.

VII- Compulsory licence maintained by introduction of:

- New grounds for requesting compulsory licence
  - For acts/behaviour resulting in a restriction or breach of competition rules (Art. 129/1-e) (Under the repealed Decree-Law No. 551 it was question of “unfair competition” (Art. 93))
  - For exportation of pharmaceutical products for addressing public health needs in other countries. This requirement is introduced on the basis of the Protocol amending the TRIPs Agreement – Additional Art 31 bis
    - Voted on 6 December 2005
    - Amendment took effect on 23 January 2017
    - TURKEY’s Acceptance – 14 May 2014
  - For being unable to develop a new plant variety without infringing a patent
- A new body, the “Competition Board”
  The “Competition Board” is introduced alongside the courts/judiciary when the ground for requesting “compulsory licence” is the restriction or breach of competition rules. (Art. 129/2)

VIII- Adoption of Reinstatement - Restitutio in Integrum- (Art. 107/2)

IX- Employee Inventions for:

This is one of main areas of intervention of the new IP Code. This chapter has undergone substantial structural modifications with resulting interpretative uncertainties.

The new IP Code provides in fact 3 tracks/regimes for “Employee Inventions”.
- for “patentable inventions” according to their being “service inventions” benefiting the employer or “free inventions” benefiting the inventor,
- for inventions made in “High Education Bodies” (Art. 121)
- for inventions made under project supported/financed by Public Bodies (Art. 122)
- For service inventions for which the Employer claims full ownership, “the Employer is under the obligation to file the first patent application before the T.P.T. Office”. (Art. 116/1)

Under the repealed Decree-Law No. 551, the Employer had “the right” to apply to the T.P.T. Office for a patent (Art. 26/1) and “could also file” a patent application in a foreign country. (Art. 27/1)

- Inventions made in High Education Bodies (Universities), including those under the Ministries of Defence and Interior. (Art. 121)
  - Abolition of the so-called “professors’ privilege” on the ownership of the inventions they make while performing their functions.
According to new IP Code, all inventions made by scientific staff (including regular (PhD) students as well as interns in the course of their functions) are deemed to belong to the concerned High Education Body (University) with the proviso that in reply to the declaration of invention (to be) made by the inventor, the concerned body/university makes a formal request of ownership on the invention which is tied to the obligation to file a patent application which in turn if it does not materialise renders the invention “free” to the benefit of the inventor.

- According to Art. 121/1 “all inventions made in High Education Bodies (Universities) including those under the Ministries of Defence and of Interior are subject to the provisions on “Employee Inventions”, to the exception of the provisions provided under special laws or of this present Article which are reserved”.
- According to Art. 121/5 the provisions of Articles 115, 116, 118 and 119/4 shall not be applicable to inventions made in High Education Bodies/Universities).

- **Inventions made under project supported/financed by public bodies/institutions** (Art. 122)
  - New set of provisions/rules for such inventions
  - Within one year from the declaration of invention the inventor is to make, the latter is to inform the public body in writing whether or not he/she claims ownership of the invention. In the case of failure of the inventor to timely claim ownership of the invention, the public body may decide to own the invention.

- **No mention of non-patentable “technical improvements” as a result of which “employee inventions” in the new IP Code are restricted to “patentable inventions” only.** (Art. 113/1)
  - The repealed Decree-Law No. 551 made a distinction between “patentable inventions” and “non-patentable technical improvements” (Art. 16/1+2 – Art. 33) within the Context of Employee Inventions

**X- Filing in any official language becomes possible (Art. 90/2)**

The description, claims, abstracts and drawings, if any, can be filed under the official language of any country signatory of the Paris Convention or TRIPs or the language of any other country subject to reciprocity.

(Under the repealed Decree-Law No. 551 this was limited to only English, French and German. (Art. 42/4).

**XI- Mandatory declaration in the application of “genetic resources” and of “traditional knowledge based on genetic resources” (Art. 90/4).**

- This requirement is introduced on the basis of Turkey’s membership of the Convention on Biological Diversity and of the Cartagena Convention on Biosafety.
- No need to make this declaration for patents validated in Turkey through the European Patent Convention.
XII- Introduction of “Farmer exception” to the provision regarding the “Scope of Patent Right” in respect of:

- **The New Plant Varieties** – The use of production material originating from such New Plant Varieties is subject to the Law No. 5042 on Plant Breeder’s Rights. (Art. 85/4).
- **Patented animal breeding material** – The farmer has the right to use such material in its operation. Such rights shall be used in compliance with the regulation. (Art. 85/5).

XIII- - Cancellation of an independent claim causes the cancellation of the dependent claim(s) “with the proviso that each dependent claim, on its own, does not meet the patentability criteria” (Art. 138/4 last sentence):

- Accordingly, the dependent claims meeting the patentability criteria, independently from each other, shall survive.
- In this regard, it is important to note that the new IP Code noes not provide for the possibility of amending the claims by bringing them together so as to overcome their cancellation. This stance conforms to the practice of the courts so far in retaining or rejecting the claims in their entirety. It is regretful that the new IP Code has refrained to organize the amendment of claims in the course of invalidity actions.

XIV- Deadline for requesting the State-of-the-Art Search Report shortened to 12 months from the filing date of the application (Art. 96/1) (Priority date not retained)

- Under the repealed Decree-Law No. 551, this deadline was 15 months from the application date or priority date (Art. 56/1+2)

XV- Possibility to amend and to comment on official communications of the Examiner before the substantive examination report is issued is limited to 3 submissions

- According to this provision a single Substantive Examination report will issue whereas under the earlier practice up to 3 Examination reports were allowed.
- This provision materializes the longstanding Office practice under the earlier practice limiting to 3 the number of replies and amendments allowed against office actions concerning substantive examination report(s).

XVI- No yearly annuity fee to be paid for the 2nd annuity. (Art. 101/2)

The yearly fees are due to be paid as from “the end of the second year from the date of filing”.
Turkey - Industrial Designs

I- Extension of – Protection to non-registered Designs (Art. 55/4)

- The rights derived from design protection can be used for non-registered designs to prevent use by third parties of designs, which are identical or similar to non-registered designs.
  - Term of protection – 3 years from the date when the design was first made available to the public in Turkey
  - Condition of protection – first disclosure to be made in Turkey
  - Enforcement against unauthorized use when
    - Identity or similarity with the non-registered design
    - Unregistered design obtained “by means of copying” (Art. 59/2)

II- Opposition Period Shortened to 3 months (Art. 67/2)

- Halving the opposition period from 6 to 3 months from the publication of the decision to grant aims to reduce the time line until the issuance of the registration certificate to less than a year.

III- Introduction of Ex-Officio “Novelty Examination” for Industrial Designs (Art. 64/6/d)

- The design application will be subject to Ex-officio “Novelty Examination”
- which is to be conducted within the formal examination phase of the design application.
IV- Description of the Designs becomes optional (Art. 61/3)

The filing of the description of the designs is no longer a mandatory requirement for prosecution purposes and the information provided therein shall not affect the scope of protection.

This is a welcome change as it will have the effect of substantially simplifying the filing and prosecution requirements of design applications without adversely affecting the scope of protection.
V - Scope of protection explicitly restricted to Visible Parts of a Complex Product

- “Invisible Parts” explicitly excluded from protection (Art. 56/2-a)
  - According to this provision, only part(s) which are visible “under normal operation/use of the complex product upon which it has been incorporated” shall be afforded protection provided such part(s) meet the criteria of novelty and individual character.
  - This provision in fact mirrors the case law decisions according to which no protection shall be afforded to “invisible parts” under normal operation/use of the complex product.

Complex Products

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<td>Designs of products which are parts of complex items shall be protected if and when the design of the part is in itself new and has individual character.</td>
</tr>
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<tr>
<th>New Legislation</th>
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<tbody>
<tr>
<td>The part of the complex product, once it has been incorporated into the complex product, if remains visible during normal operation/use of the latter and meets in itself novelty and individual character requirements can be registered.</td>
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<tr>
<th>The Amendment</th>
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<tbody>
<tr>
<td>The part of the complex product which is invisible under normal operation/use, can not be protected as an industrial design.</td>
</tr>
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</table>

Complex product is a product which is composed of parts that can be replaced or renewed by means of disassembly and re-assembly.
VI. - The derogation of 3 years for asserting the design right on Spare Parts of a Complex Product used for repairing purposes
- Becomes not applicable to listed “Equivalent Parts” which are thereby excluded from protection (Art. 59)
  - According to Art. 59/4, three (3) years after the design has first been made available to the public, the owner of a registered design cannot assert its rights regarding a visible part of a complex product provided that the visible part is used for the purpose of repair and that the visible part is not deceptive as to the origin of the product (Art. 59/4).
  - The repealed Decree-Law No.554 on Designs contained a similar provision under Art.22.
  - While keeping the above provision the new IP Code has extended the derogation (Art. 59/5) by ruling that the period of three (3) years shall not be applicable when the protected spare part design is mentioned among the list of “equivalent parts” issued by the Ministry of Science, Industry and Technology. This new provision has the effect to exclude from protection the “listed equivalent parts” which aim to cover the so-called “must match parts”.

**The Exception of Spare Parts and Equivalent Parts**

**RULE:** Design of a component part of a complex product can be protected by registration; if it is visible during normal use of the complex product and fulfills the requirements as to novelty and individual character.

**SPARE PART EXCEPTION:**
1. Dependant to appearance of complex product
2. For the purpose of repair of the complex product
3. Provided that the public is not misled as to the origin of the product

**EQUIVALENT PARTS EXCEPTION:**
Spare part designs taking part in List of Equivalent Spare Parts which is issued by Ministry of Science, Industry and Technology cannot enforced against spare parts manufacturers

**Protection by design registration for 25 years for the whole appearance of complex product and spare parts against OEM**

**No design infringement can be claimed against spare parts manufacturers after the expiration of a period of 3 years as of the first disclosure date of the spare parts design.**

**No infringement can be claimed against spare part manufacturers for spare part designs listed in the official List of Equivalent Spare Parts**
### VII- Ownership - Abolition of the exception benefiting the “teaching staff” to own the designs they develop in the exercise of their function (Art. 73/3)

- The University will be the owner of such designs developed by the “teaching staff” in the exercise of their function, subjecting it to the general rule according to which the employer shall own the design developed by the employee unless the contrary derives from the special/private contact or the nature of the work. (Art. 73/1)
- For the service contracts the presumption, under the repealed Decree-Law (Art. 16) according to which the design developed will be owned by the designer has been removed. For all such designs, the terms of the contract will determine the ownership. (Art. 73/4)
### VIII- Introduction of “Divisional Application” for an application filed for multiple designs (Art. 61/9)

The T.P.T. Office may request the filing of a divisional application by keeping the first filing date.

- When the designs, to the exception of ornamentations, filed with the application do not embody products within the same class (Art. 61/7 + 61/9)
- When the number of the designs filed with the application exceed the number of designs allowed by the regulation. (The draft regulation considers a maximum of 100 designs per application.)
IX- Distinctiveness – Amendment of criterion

From the “(date) when made available to the market” to the “(date) when made available to the public”. (Art. 56/4 (b) + 56/5 (b))

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| A design shall be considered new if before the date of reference no identical design has been made available to the market in the world. | A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public;  
  - In the case of a registered design, before the date of application or priority,  
  - In the case of an unregistered design, before the date on which the design has first been made available to the public. | The expression of “has been made available to the market” has been amended to “has been made available to the public”  
This examination will only be effected based on an opposition. |
Turkey - Trademarks

Extension of Scope of protection to Colours, Motion and Sound Marks (Art.4/1)

- Colours and sound marks have been explicitly included in the definition of signs which may be protected as a trademark. “All signs including designs, colours, numerals, letters, sound and the shape of goods and their packaging” (Art. 4/1)
- More importantly, the requirement of capability to be represented graphically and reproduced by printing is removed in view of existing electronic means, in order to pave the way for motion marks.

Signs which can be a trademark
Color, Sound and Motion Trademarks are now possible on the condition that they are:

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<tr>
<td>Capable of being:</td>
<td>- Capable of being: recorded / inscribed on the Register so as to render clearly and unequivocally understandable the object of protection benefiting the trademark holder.</td>
<td>Protection has been brought to trademarks expressed electronically</td>
</tr>
<tr>
<td>Represented graphically and reproduced by printing</td>
<td></td>
<td>- New frame for assessing the registrability of non-conventional marks</td>
</tr>
</tbody>
</table>

II- Amendment of trademark registrability requirement (Art.4/1)

New frame for assessing the registrability of non-conventional marks.
- New requirement:
  - “Capable of being recorded/inscribed on the register
  - so as to render clearly and unequivocally understandable the object of protection benefiting the trademark holder”
- The earlier requirement under the repealed Decree-Law “capable of being represented graphically and reproduced by printing” is removed.
- The amended requirement constitutes the new frame for assessing the registrability of non-conventional marks.
Turkey – The New IP Code

III- Registered Geographical Indications Cited Among the Absolute Grounds of Refusal (Art. 4/1-i)

- Ex-officio refusal at the examination phase, by the T.P.T. Office of trademark applications consisting solely of or identically comprising the registered geographical indication on absolute grounds.
- In fact, this provision aims to strengthen the protection of Geographical Indications and Traditional Product Names against ill-willed trademark applicants.

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<thead>
<tr>
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<tr>
<td>Trademarks identical or (almost) identical to the point of being undistinguishably similar</td>
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<tr>
<td>Being distinctive; not referring to the kind, characteristics quality, quantity, intended purpose, value, geographical origin; not used in the commercial field by everyone; not being deceptive</td>
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</tr>
<tr>
<td>Trademarks protected according to Art. 6ter Paris Convention; not being contrary to public order and to accepted principles of morality; not containing any reference to religious symbols and values.</td>
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- Well-known Trademark according to Art. 6bis of the Paris Convention Article 7/(i) of the repealed Decree Law (Cancelled with the 27/5/2015 dated and Official filing no E.: 2015/33, K.: 2015/50 decision of Constitutional Court) | Trademarks consisting of or including registered Geographical indications can not be registered.
IV- Introduction of Consent Letters-New Exception to Absolute Grounds for Refusal – (Art. 4/3)

The new IP Code Law introduces the Letter of Consent, by which the owner of an earlier trademark may consent to the registration and the use of an identical or similar trademark, later filed for the same or similar goods or services.

A Letter of Consent should be notarized and submitted to the T.P.T. Office either simultaneously with the filing of the trademark application or upon refusal.

New Exception to Absolute Grounds of Refusal: Letter of Consent (LOC)

RULE: Trademarks identical or (almost) identical to the point of being undistinguishably similar to a prior trademark registration or application in respect of good(s) or service(s) whether identical or of identical nature/type, can not be registered.

EXCEPTION

* Providing the applicant files a written and notarized Letter of Consent which
* Can be submitted with the application or during the prosecution period or objection procedure before the Higher Council of Examination and Evaluation of T.P.T.O.
* The parties may execute an agreement
* T.P.T.O. may set a formal form

Chemicals used in horticulture and forestry (01.01)

Chemicals used in photography (01.01)
V- Opposition Period of 2 months as of Publication Date in the Official Trademark Bulletin (Art. 18/1)

- The opposition period - which used to be 3 months - has been shortened to 2 months, still calculated as of the publication date of the application in the official Trademark Bulletin.
- This provision aims to shorten the time line for registration.

VI- Bad Faith Cited as an Explicit Ground for Opposition and Invalidity (Art. 6/9 + 25/1)

- The act explicitly cites “bad faith” among the relative grounds for opposition (Art. 6/9) and among invalidation grounds (Art. 25/1).
- In the practice under the repealed Decree-Law the “bad faith” issue was considered by the T.P.T. Office in opposition matters and by the Courts in invalidity actions. With the new IP Code, the practice and act become harmonized.

VII- Preferential Treatment of Madrid Protocol Trademark Applications’ as to the Filing Time (Art. 14/1)

The trademark applications filed via the Madrid Protocol system and designating Turkey will be deemed to have been filed at the first hour and minute of the day received by the office, thereby getting ahead of any national trademark being filed on the same day.

VIII- Counter Claims of Non-use by the Applicant During Opposition (Art. 19/2)

- The new IP Code enables the applicant of the opposed trademark to require, from the opponent, evidence of the use of the trademark on which the opposition is based, if the opponent’s trademark has completed the 5 years of grace period for non-use.
- The examination of the opposition will be limited to the goods/services for which the opponent has evidenced use.
- Failure of the opponent to evidence use will result in rejection of the opposition.

IX- Mediation During Opposition Proceedings (Art. 19/4)

The Institute, in an effort to encourage mediation, will be entitled to invite parties to settle the oppositions through mediation as per the Mediation Law on Legal Conflicts No. 6325.

X- Institution of administrative cancellation proceedings through

T.P.T. Office (applicable after 10 January 2024) (Art. 26/1)

- The T.P.T. Office will implement administrative cancellation proceedings after a transition period of 7 years from the entry into force of the new IP Code, that is after 10 January 2024. (Art. 192/1)
- Until then, the cancellation actions will have to be instituted before the Courts. (Transitional Art. 4/1)
- The cancellation request can be made to the T.P.T. Office on the following grounds.
  1. non-use
  2. becoming generic (on the products / services on which the trademark is used),
  3. deceiving public (as to the characteristics, quality or geographical source)
  4. use of guarantee trademark contrary to the technical regulation.
XI- “Fair Use” Clause Broadened (Art. 7/5)

The “fair use” definition has been broadened whereby the rights holder shall not be able to prohibit a third party from using a trademark, in the normal course of trade, for the purpose of identifying or referring to goods or services, where the use of that trademark is necessary to indicate the intended purpose of those goods or services, particularly in respect of accessories, spare parts or equivalent parts.

XII- Partial Renewal of Trademarks for Limited Classes/Goods (Art. 23/3)

The new IP Code permits partial renewal of a trademark for limited classes or specification of goods/services.

- The Implementing Regulations will determine the new practice. A simplified procedure is expected to permit the trademark owner to opt for the classes and/or goods/services to be renewed.
- Under the earlier practice, there is only one option, which is the submission of an independent request for limitation of the trademark to be effected before the renewal.

XIII- Extension of Acts of Trademark Infringement with the aim to strengthen protection (Art. 7/3 + 8/1)

Unlike repealed Decree-Law, the new IP Code specifically provides that the use of a trademark may be prohibited when it is used:

- as an essential part of a company/establishment name (Art. 7/3-e)
- unlawfully in comparative advertisements (Art. 7/3-f)
- in the internet environment as a domain name, keyword, directing code or in similar ways (Art. 7/3-d)
- so as to give the impression of generic use, under printed or electronic environment, in dictionaries, encyclopaedia or other works of reference. (Art. 8/1)

XIV- Counter Claims of Non-Use by the Defendant in Cancellation and Infringement Actions (Art. 25/7 & 29/2)

- The new IP Code rules that during the examination of a cancellation action instituted on the basis of similarity and risk of confusion between the trademarks, the non-use of the trademark on which the cancellation action is based can be asserted as a counter-claim by the defendant in relation the relative grounds of refusal as of Art. 6/1 (Art. 25/7)
- The non-use counter-claim can be put forward in the trademark infringement actions by the defendant (Art. 29/2)
- The newly instituted counter-claims produces effect only for defensive purposes but does not lead to the cancellation of the plaintiff’s non-used trademark.

XV- Differentiation between grounds of Invalidity vs. Cancellation (Art. 25/1 + 26/1)

- The repealed Decree Law refers only to the grounds of invalidity with retroactive effect whereas the current established case law makes a distinction between grounds for cancellation and invalidity.
- The new IP Code, in line with current practice and case law, differentiates between the absolute and relative grounds of refusal with reference to Art. 5 + 6 as grounds of invalidity while another set of grounds, such as genericness, deceptiveness, failure to use guarantee marks/collective marks according to the technical regulations and non-use, are stated to be grounds of cancellation.
XVI- Explicit rule on Acquiescence (Art. 25/6)

The new IP Code explicitly rules that “where the trademark owner has known or should have known about the use of a later date infringing trademark” but did not take action against such use for more than 5 uninterrupted years, the trademark owner will not be able to claim the cancellation of the later date infringing trademark on ground of its prior trademark registration, unless “the later date trademark is registered in bad faith”.
Turkey - Geographical Indications & Traditional Product Names

Geographical Indications & Traditional Product Name

An Overall view of changes affecting Geographical Indications

<table>
<thead>
<tr>
<th>Previous Legislation</th>
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<tbody>
<tr>
<td><strong>Instruments</strong></td>
<td><strong>3 instruments</strong></td>
<td><strong>New ad hoc protection instrument with “Traditional Product Names”</strong></td>
</tr>
<tr>
<td>- Designations of origin (Pamianese Cheese)</td>
<td>- Designations of origin</td>
<td><strong>Opposition term (halved)</strong></td>
</tr>
<tr>
<td>- Appellations of origin (Hereke Carpet)</td>
<td>- Appellations of origin and</td>
<td><strong>Publication in the Official T.P.T.O. Bulletin</strong></td>
</tr>
<tr>
<td>- Traditional product names</td>
<td>Traditional product names have been newly included in the definition of Geographical Names. (Art. 34/3)</td>
<td><strong>Controls tightened</strong></td>
</tr>
<tr>
<td><strong>Opposition term 6 months</strong></td>
<td><strong>Opposition term 3 months</strong></td>
<td><strong>New marking requirement</strong></td>
</tr>
<tr>
<td><strong>Publication in the Official Gazette and regional and national newspapers</strong></td>
<td><strong>Mandatory surveying reports shall be submitted to the Office annually</strong></td>
<td><strong>Strengthened protection of Geographical Indications and Traditional Product Names in relation to trademarks</strong></td>
</tr>
<tr>
<td><strong>Surveying reports shall be submitted to the Office decennially (10 years)</strong></td>
<td><strong>Mandatory use of the emblem/sign to be adopted by the T.P.T.O.</strong></td>
<td><strong>Protection of the rights benefiting the prior trademark registrant or user in good faith</strong></td>
</tr>
<tr>
<td></td>
<td><strong>Art. 5/1(i) on Trademarks, cited “registered Geographical Indications and Traditional Product Names as ground for absolute refusal” of a trademark application containing it</strong></td>
<td></td>
</tr>
<tr>
<td></td>
<td><strong>Protection ensured for prior trademark registrants or users in good faith against later geographical indication registrants/applicants</strong></td>
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I- Structural Change – Institution of a new ad hoc protection instrument under “Traditional Product Names” (Art. 34/2 + 34/3)

- The new IP Code Provides 3 Instruments of protection under Geographical Names
  - Designations of origin (Art. 34/1 (a))
  - Appellations of origin (Art. 34/1 (b))
  - Traditional Product Names (Art. 34/3)

- Traditional product names have been newly included in the definition of Geographical Names. (Art. 34/3)
Geographical Indications
Designations of Origin – Appellations of Origin

Designations of origin (Art. 34/1-b)
- Originating from a specific region, area or a country having determined geographical borders
- All or essential characteristics of the product are due to the inherent natural and human factors originating from that particular geographical area
- The production/processing/preparation and all other processes must take place in said specified geographical area.

The products, can not be produced in an area other than the specified geographical area.

Appellations of Origin (Art. 34/1-b)
- Originating from a specific region, area or a country having determined the geographical borders
- A specific quality: renown or other characteristics of the products are attributable to that geographical area.
- At least one of the steps during the production/processing/preparation of the product must take place in the specified geographical area.

It is necessary that the production methods of the specified geographical area are identically applied and the quality of the product is kept identical.

- A traditional product name is defined as a product proven to be traditionally used in the market to identify the concerned good for at least 30 years provided it is made of traditional raw material or ingredients and provided it is produced by using traditional mode of production or processing or traditional compositions.

New ad hoc protection instrument

Traditional Product Names
- Names which do not fall under the scope of designations of origin or appellations of origin
- proven to be traditionally used in order to designate a product
- proven to be traditionally used on the domestic market for a period of at least thirty years
- produced by using a traditional mode of production or processing or traditional composition(s)
- Produced from traditional raw materials or ingredients

Anyone who produces the products according to registered conditions can use the geographical indication and the Traditional Product Name to designate a product.

II- Tightening of disciplinary controls

Mandatory annual surveying and reporting on the use of Geographical Indication and Traditional Product Names (Art. 49/1+49/3)
- The submission of the survey report shall be effected annually as from the publication date of the registration in the official Bulletin.
- This term was every 10 years under the repealed Decree-Law.
- Mandatory annual disciplinary surveying and reporting shall cover “the production, offer for sale or distribution and use in the market” (Art.49/1)
  o The controls shall be carried out by the control authority indicated in the application the competence of which is to be approved by the T.P.T. Office.
  o The control authority and its remit can only be changed with the permission of the T.P.T. Office.
  o Control reports shall be submitted to the T.P.T. Office annually as of the date of publication of the registration in the Bulletin. However, if there is a complaint, the T.P.T. Office may request to receive the control reports sooner.
  o The Geographical Indication registrant may request that the surveying and reporting expenses be met by those who have been surveyed. (Art. 49/5)

III- The New Marking requirement instituted for information on the regulatory function of T.P.T. Office

- Mandatory use of the T.P.T. Office Emblem/Sign (Art. 46/2 + 46/3)

The use of the emblem/sign, to be adopted by the T.P.T. Office is mandatory on the product and/or its packaging.
  o The T.P.T. Office emblem/sign is to be used in conjunction with the Geographical Indication and Traditional Product Name.

IV- Opposition period shortened to 3 months (Art. 40/2)

  o Halving the opposition period term from 6 months to 3 months from the publication of the application aims to reduce the time-line for registration.

V- Simplification of the publication regime

- Application published in the Official Bulletin of T.P.T. Office (Art. 38/5)

This is a welcome change as it simplifies and streamlines the laborious and expensive publication regime under the repealed Decree-Law (Art. 9/3) according to which the application is published in the Official Gazette where texts of legislation are published as well as in local newspaper(s) and with notices published in newspapers with nationwide coverage.

VI/1- Protection of registered Geographical Indication and Traditional Product Name strengthened in relation to trademarks

Art. 5/1(i) concerning the absolute grounds for refusal of trademark applications cites among such grounds “the signs which consist of or which include a registered Geographical Indication”.

According to this provision a sign containing, even as a secondary element, a registered geographical indication shall be ex-officio refused for registration as a trademark.
VI/2 - Protection ensured for prior trademark registrants or users in good faith against later geographical indication registrants/applicants Geographical Indication – Trademark Relation (Art. 48)

- Where a trademark identical or similar to a geographical indication, has been registered in good faith prior to the geographical indication or where the right to use it has been obtained in good faith, the rights afforded to the geographical indication registrant cannot be asserted against said prior trademark registrant or use made of it in good faith. (Art. 48/2)

- Upon the opposition of the prior trademark registrant and also by taking into account the reputation, notoriety and usage period of the prior registered trademark; the registration of a geographical indication or Traditional Product Name which is identical or closely similar to it will not be allowed if there is a risk of harming the existence of the prior trademark registration or may be misleading as to the origin thereof. (Art. 48/3)

M. N. Aydın Deriş
President of Board/Yönetim Kurulu Başkanı
Deriş Patents and Trademarks Agency A.Ş.
FICPI Member – Turkey

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