

A New Era for Design Rights in Turkey

20 Jan 2017

Major changes have been introduced to Turkey's Intellectual and Industrial Property regime, including design rights. Indications suggest the new legislative regime will serve an increased scope of design-related disciplines, in a wider manner. Notable changes include introducing ex office novelty examination and protections for unregistered designs.

The long-awaited Turkish Industrial Property Law numbered 6769 ("IP Law") was published in Official Gazette number 29944 on 10 January 2017, with the majority of provisions entering into effect on the same date.

The IP Law (primary legislation) supersedes a system of separate Decree Laws (secondary legislation). The new legislation unifies provisions for prosecution and enforcement of trademarks, patents, designs and geographical indications into a single instrument.

Significant headline changes for design rights include:

Protecting Unregistered Designs

Unregistered designs will now be protected for three years, provided they are being made available to the public for the first time in Turkey. The three-year protection term runs from the design's disclosure date. Previously, unregistered design rights were protected indirectly via general provisions in a range of legislation.

According to the IP Law, owners of unregistered designs can initiate infringement actions regarding use of the subject design. Unlike the registered design protection mechanism, the owner of an unregistered design can only prevent third parties directly using an identical or confusingly similar design.

In certain circumstances, applicants can choose to suspend publishing their application, to protect confidentiality. In such cases, design applications will still be protected as unregistered designs during the suspension term.

Novelty Criteria Introduced at Preliminary Examination Stage

Novelty is introduced as an ex officio examination criteria at the preliminary examination stage and the Turkish Patent and Trademark Institute ("TPTI") can now refuse applications based on lack of novelty.

Previously, neither an application's novelty nor individual character would not be examined once it had been filed. Although novelty and individual character were (and continue to be) required for design protection, applications were previously published without a substantial examination of these elements. Novelty would previously only be considered if a third party filed an opposition against the application.

Protection for Parts of Joint Products

Parts of joint products can now also enjoy design protection if they are:

- Visible during normal use by the final consumer, and
- Meet the requirements of novelty and individual character.

Equivalent Parts Used for Repair Purposes

Similar to the prior Decree Law regime, the IP Law provides an exception to the scope of design rights. In principle, after a subject design has been disclosed for three years and provided consumers are not misled about the source, use of the visible parts of joint products by third parties for repair purposes does not constitute infringement.

Under the IP Law though, equivalent parts announced by the Ministry of Science, Industry and Technology can also be used within the three-year period, without being deemed to be infringement.

Changes to the Application Process

- A written description of the design is not compulsory during applications.
- Designers can now request their identity be kept confidential.
- The TPTI will refuse applications at the preliminary examination stage if they include:
 - Improper use of state emblems mentioned in article 6ter of Paris Convention,
 - Other signatures which are not permitted by the authorities.

Opposition Process

Applicants can now appeal the TPTI's preliminary examination decisions within two months of the notification date. Third parties can also file oppositions against published design applications. The IP Law reduces the opposition period from six months to three months, running from the publication date.

The grounds for such an opposition are that the application:

- Is not design or a product.
- Does not meet the novelty and/or individual character criteria.
- Is not sufficiently disclosed.
- Is not filed by an authorized person.
- Is filed in bad faith.

Bad Faith as a Cancellation Ground

The IP Law removes uncertainty by specifically including bad faith as an individual cancellation ground. Although some precedents had considered and accepted bad faith as a cancellation ground, it was not previously listed among as a cancellation grounds in the relevant Decree Law.

Scope of Appropriation of Design Rights

The IP Law expands the scope for protections against design right appropriation. Parallel to reforms which protect unregistered designs, unauthorized disclosure of unregistered designs will now also be deemed to be an appropriation of design rights.

The available period to claim such an appropriation is extended from two to three years. However, no time limit will apply if bad faith exists.

Designs by Scientific Staff at Universities:

According to the IP Law, designs made by scientific staff (including regular students) while at work will now automatically belong to the university. The Decree Law previously stated that designs by scientific staff in universities and other higher education institutions were free. Therefore, the staff member would own the design rights, rather than the university.

However, employees (including scientific staff and interns) who made the relevant design are now entitled to request a price from the university. The price refunded to the designer must be at least half of the design's total income.

Actions against Design Infringement:

As with the prior legislative regime, the IP Law continues to not include criminal provisions for design infringements. While the new legislation introduces criminal provisions for trademark infringements, infringing acts against designs can only be protected via civil actions.

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With its ex office novelty examination and protections for unregistered designs, the IP Law introduces major changes for designs in Turkey.

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