

## Further Details Announced for How Turkey's New Industrial Property Regime Will Operate

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In January 2017, Turkey announced a long-awaited legislative overhaul for its intellectual property regime. Since then, local practitioners and right holders have waited patiently for related secondary regulations to be released, which would reveal more insight into how the new regime would operate in practice. Accordingly, the Regulation of the Industrial Rights Law ("**Regulation**") entered into effect on 24 April 2017, bringing with it a range of reforms and clarifications for how Turkey's new intellectual property processes will work.

Notable details announced by the Regulation include the following.

### The Turkish Patent Institute (Türk Patent Enstitüsü) becomes "TÜRKPATENT"

The Turkish Patent Institute has changed its name to the 'Turkish Patent and Trademark Office ("TÜRKPATENT").

### Power of Attorney requirements significantly loosened

Strict power of attorney requirement have been largely loosened or removed completely. TÜRKPATENT no longer requires trademark representatives to submit a power of attorney from their client, empowering the representative to undertake certain actions before TÜRKPATENT. Trademark representatives can now undertake most actions before TÜRKPATENT without submitting a power of attorney at all.

Exceptions are the following actions, which require a signed power of attorney (although not fully notarized/legalized as previously):

- Recordal of changes of a trademark/ design owner.
- Withdrawal / partial withdrawal of a trademark/ design.
- Partial renewal of a trademark/ design.

### Clarified rules for non-conventional trademarks

The Regulation clarifies certain application rules and restrictions for non-conventional trademarks, such as 3D marks, sound marks, colour marks and motion marks.

Notable aspects include:

- **3D marks:** applications should include up to six visuals, which clearly and specifically show the mark's scope of protection.
- **Sound marks:** applications should include an audio recording which can be accessed and saved electronically. Applicants can also submit notations of the sounds if this is possible.
- **Colour marks:** applications should include a visual, indicating the recognized colour code. Registrations are not permitted for colours which will be used in combination with other elements such as figures, pictures or wording.

- **Motion marks:** applications should include a series of drawings or a visual (such as a gif) showing the motion. All of the visuals must be integrated with the trademark.

## Consent letters now permitted, via a standardized form

One major improvement in the new intellectual property regime is that consent letters can now be used to overcome a provisional refusal decision, where the decision was based on an earlier trademark existing. The Regulation clarifies the process. Accordingly, to record a letter of consent before TÜRKPATENT, the consenting party should sign and notarize a standardized template consent letter, which is available on TÜRKPATENT's website.

Consent must be unconditional and unlimited. Once submitted to TÜRKPATENT, consent cannot be revoked. Consent letters in the standard form must also be submitted for any recorded licensees.

Consent letters must include certain information. However, applicants receive two months to submit missing information, if necessary. If the information is not supplied by then, the request will be disregarded.

Consent letters can either be submitted with the trademark application (at the filing stage) or at any time before an Office decision (if there is opposition by an earlier trademark owner). If consent is received, but the parties do not submit the consent letter, TÜRKPATENT will not issue any notification in this regard and the request will be disregarded.

## Partial trademark renewals now possible

Trademark owners can now choose to renew their registered trademarks for specific (but not all) goods and/or services. A power of attorney is required for partial renewal requests.

## Processes for proving an opponent's trademark use during opposition proceedings based on similarity

In opposition proceedings based on similarity, where the opponent's trademark is registered for five or more years, TÜRKPATENT can now ask (at the applicant's request) for proof of the opponent's use, as of the filing date or date of priority of the later trademark application. If the opponent does not prove its use, the opposition will not be accepted. If the use only covers some goods and services for which the basis trademark is registered, the opposition will only be examined in terms of these limited goods and services.

If TÜRKPATENT requests proof of use, opponents must provide information within one month of submitting responses to the opposition.

An applicant's request to TÜRKPATENT must be explicit, clear and unconditional, including trademark registration numbers. If they wish, applicants can withdraw their request and it will be disregarded.

Opponents receive one month to prove their genuine use of base trademark(s) in Turkey or provide a valid reason for not to use the trademark(s). TÜRKPATENT will reject the opposition if the opponent fails to do so. TÜRKPATENT can respond if it deems necessary.

Opponents may submit their proof of use evidence or valid reason for non-use along with the opposition petition. If TÜRKPATENT considers the documents sufficient, it will begin examining the opposition.

All types of material can be submitted as proof of the opponent's use, such as packaging, labels, catalogs, invoices, newspaper advertisements, or tariffs. Documents and materials should be reliable and clearly show use of the base trademark(s), together with information about the date and place.

If evidence is in a foreign language, the opponent will be given two months to submit a Turkish translation, prepared by a certified translator. Otherwise, TÜRKPATENT will not consider the evidence during its examination.

## Mediation

If TÜRKPATENT considers necessary, it can encourage parties to compromise during examination of oppositions or appeals. Parties should submit a written statement to TÜRKPATENT within a month, outlining whether they agree to participate in mediation or not. If one of the parties does not respond to the mediation request, TÜRKPATENT will continue its examination.

If parties have trademark representatives, the representatives are responsible for notifying their clients about the mediation.

If parties agree to mediation and inform TÜRKPATENT, the examination will be postponed for three months. The parties can also request an additional three months' extension to such period.

Once the mediation process is completed, an original or notarized copy of the official mediation report should be submitted to TÜRKPATENT within one month. Otherwise, TÜRKPATENT will continue its examination.

## Written design specification now optional

Design specifications have now become optional for design applications, whereas previously these were compulsory.

Specimens now optional for 2D designs

For applications regarding 2D designs, if a deferred publication is requested, applicants can now choose to submit a 20 x 30 cm specimen/sample of the design or product, rather than submitting images of the design.

If the applicant does not submit the specimen, they will receive a notification from TÜRKPATENT and are then permitted two months from the notification date to supply the information.

## Novelty now formally considered for design applications

TÜRKPATENT has begun examining novelty for design applications and this is now a refusal ground for design applications.

## Appeal and opposition period for designs

Applicants can appeal Office decision within two months of being notified of a refusal or partial refusal.

The publication period for design applications has reduced from six to three months. Hence, third parties can oppose published designs within three months of their publication.

## Time frames shortened for patent processes

Almost all time frames have been shortened for patent processes. The most notable changes:

- Completing the requested documents, fees and information: Now two months from the notification date.
- Request for carrying out a state-of-the-art search: Now 12 months from the application's filing date or the priority date (if priority is claimed).
- Request for examination: Now three months from the date of receiving the search report.

# Genetic and biotechnological inventions

The new Regulation includes the patentability requirements for genetic and biotechnology inventions.

Applications for genetic patents should describe the patent's industrial applicability and function in the specification or claims. If there is a nucleotide list or an amino acid list is described, the specification should also include a list which is compiled with WIPO norms. Lists provided after the application date are not considered as part of the description.

If the patent application is related to a biological material which is not publicly available and cannot be described in a patent application sufficiently to enable the invention to be applied by a relevant technical expert, it must meet the following conditions:

- An example of biological material must be provided to authorize depositary establishment approved by the Budapest Treaty or recognized by the Institution at (or prior to) the application date.
- The applicant must have information on the characteristic features of the biological material at the application date.
- The patent application should state the name of the depositary establishment and the access number of the biological material which is given by the establishment.

## Annual patent fees

If the renewal fee is paid within two months of notification of a patent right expiring, the patent right will now become effective again on the date the required fee is paid.

## Continued operations and reinstatement of rights

If an applicant fails to comply with processing deadlines for a patent application, the applicant can request the proceedings be continued within two months of being notified of the non-compliance. The applicant must pay the required fee and take the necessary action.

However, deadlines are sharp and cannot be extended for applications under the Paris Convention and World Trade Organization agreement, annual fees, patent rights arising from judicial processes, obtaining search reports, employment inventions, nor amendments made during the opposition period.

A patent applicant/owner can request reinstatement of rights if they meet the requirements of the patent process but their failures to meet the required time period cause loss of rights for the patent application.

Reinstatement of rights can be requested within one year of passing the deadline, or within two months of the suspension date, by paying the required fee. However, if the 12-month priority deadline is exceeded, reinstatement of rights can only be requested within two months of the priority deadline.

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In summary, practitioners welcome the wave of details for how the new regime should operate. The near future will reveal how these provisions are applied and interpreted in practice and whether they achieve their objectives.

## Related Practices

- [Patents and Utility Models](#)

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