

Significant Reforms to Turkish Industrial Property Laws

23 Jan 2017

Comprehensive changes have been introduced to Turkey's Intellectual and Industrial Property regime. New legislation has been eagerly awaited in Turkey, which now unifies provisions for prosecution and enforcement of rights into a single Law (primary legislation) which includes trademarks, patents, utility models, designs and geographical indications.

The 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 new regime reconciles provisions were previously addressed by separate pieces of Decree Laws (secondary legislation). However, Decree Laws will continue to apply to application procedure for trademarks, patents, designs and geographical indications made before 10 January 2017.

The Turkish Patent Institute's name has also changed, to now become the Turkish Patent and Trademark Institution ("**TPTI**").

Significant Changes for Common Provisions:

- **Fixed time periods:** Unless otherwise stated, all time periods become two months. For trademarks, the opposition period is shortened from three months to two months. For designs and geographical indications, this period will be three months.
- **Registration is no longer a defense in infringement actions:** Infringing third parties will not be able to use their registrations as a defense.
- **Compensation and Seizure:** Right holders cannot raise infringement and seizure complaints against third parties if they already obtained compensation from a counterparty for damages, but failed to seize the offending goods.
- **International Exhaustion:** The international exhaustion principle is specifically stated to apply.
- **Right Ownership in Universities:** All patents/designs invented/ made by scientific staff (including regular students) while at work will belong to the university.
- **Lack of Criminal Provisions:** While providing the right to take criminal actions against trademark infringements, The IP Law does not include criminal provisions for patents, industrial designs and geographical indications.

Specific Changes for Trademarks:

- **Co-existence:** Consent letters are now accepted as a legitimate method to overcome a provisional refusal decision, based on the existence of an earlier trademark.

- **Non-use defense:** In opposition proceedings based on similarity, where the opponent's trademark is registered for five or more years, the TPTI is now entitled to ask (at the applicant's request) for proof of the use, as of the filing date or date of priority of the later trademark application. Likewise, during cancellation proceedings based on similarity, defendants can now request proof of use.
- **Ex-officio cancellation:** The TPTI becomes the authorized body to consider and determine requests for revocation of trademarks based on non-use as well as the claims about generic and misleading trademarks. The TPTI will begin accepting these claims seven years after the IP Law comes into force (10 January 2024).
- **Loss of Right Due to Remaining Silent:** The IP Law defines the silence period as being five years, running from when the senior right holder knows (or is deemed to be informed) about use of the trademark and has not taken any action within that period.

Specific Changes for Patents:

- **Post-Grant Opposition System:** The IP Law introduces a post-grant opposition system, whereby third parties can now oppose a patent within six months of publishing the decision stating that the patent is granted.
- **Compulsory License Criteria Expanded:** In addition to the criteria listed in Decree Law, The IP Law introduces the following grounds for compulsory license:
 - Export of pharmaceutical products in case of public health in other countries, in line with the TRIPS Agreement.
 - Plant breeders which cannot develop a new breed without infringing a patent.
 - Patent owners which behave in a manner to restrict, prevent or damage market competition.
- **Omission of Protection for Patents Granted Without Substantive Examination:** It is now compulsory to request a substantive examination within three months of notification of the search report.
- **Non-Patentable Biotechnological Inventions:** The scope of non-patentable inventions is expanded. Accordingly, biological processes regarding plant or animal varieties (or production thereof) are considered non-patentable. An exception applies to the microbiological process or products obtained by means of such process.
- **Reviving Abandoned Patents Due To Non-Payment of Maintenance Fees:** Patent holders can revive a patent which has lapsed due to failure to pay the annual maintenance fee in time.

Specific Changes for Designs:

- **Protecting Unregistered Designs:** Unregistered designs will be protected for three years, provided they are being made available to the public for the first time in Turkey. Novelty Criteria for Preliminary Examination: Among other ex officio examination criteria, novelty is also introduced as a criteria for the preliminary examination step.
- **Use of Equivalent Parts:** The use of the equivalent parts which are confirmed and published by Ministry of Science, Industry and Technology will not constitute design infringement.
- **Bad Faith:** Bad faith will be a ground for oppositions and cancellation actions.
- **Protection for Parts of Joint Products:** Visible parts of joint products can also enjoy design protection if they meet the requirements.

Specific Geographical Indications:

- **Traditional Product Names:** Parallel to EU regulations, protection is extended to traditional product names which do not fall under the scope of geographical indications.
- **Producer groups as Applicants:** Regardless of their legal entity, producer groups will also be entitled to file applications.
- **Publication by TPTI:** Applications will now be published in the Official TPTI Bulletin, instead of the Official Gazette or local newspapers.
- **Amendment requests:** If a change occurs within the scope of a registered geographical indication, the relevant parties will be able to request an amendment. The application process will apply to these requests.
- **Short Control Periods:** The control period for use of geographical indications is reduced from every ten years to now be annual.

Please see this [link](#) for full text of the IP Law (only available in Turkish).

Related Practices

- [Anti-Counterfeiting](#)

Related Attorneys

- [IŞIK ÖZDOĞAN, LL.M.](#)