

Turkey: Bated Breath Following IP Law Consultation

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The Turkish Patent Institute (TPI) opened the Draft Industrial Property Law for public consultation and that period closed on March 4. The draft law contains provisions on trademarks, patents, industrial designs and geographical indications, all of which are currently addressed by separate decree laws.

Turkey's current laws comply with most of the international treaties and conventions to which Turkey is a signatory. However, the draft law aims to comply with the Trademark Law Treaty (1994) and also introduces new provisions in light of amendments in 2015 to the TRIPS Agreement and the EU trademarks directive and regulation.

The draft law would introduce promising improvements to the Turkish system, clarifying grey areas which tend to cause problems in practice. A major improvement is that the draft law accepts consent letters based on the existence of an earlier trademark as an available method to overcome a provisional refusal. The current law does not accept consent letters, co-existence agreements and sister company arrangements as overcoming such provisional refusals by the TPI.

Currently, even if the prior registration owner consents to the later trademark, the TPI will not cancel its provisional refusal. The draft law would allow a provisional refusal to be overcome by submitting a notarised letter of consent from the earlier trademark owner. The legislature aims to protect applicants which are economically or otherwise related and intend to co-exist in the market.

The draft law clarifies and enacts some practices which are currently accepted by the courts and TPI on the basis of precedent. Bad faith is included as a ground for refusal/cancellation. Although not previously listed among the grounds for refusal, in light of a recent Court of Appeal decision, bad faith has been accepted in practice as a ground for refusal.

Five years for non-use

The draft law clearly defines the start date for the five-year non-use grace period as being the date on which the registration was published. Additionally, the draft law accepts that goods and services covered by the same or different classes do not necessarily result in trademarks being similar or different.

Another significant improvement in the draft law is that if the non-use grace period is over, an applicant can request the opponent to prove use of the trademark which forms the basis of an opposition. The draft law would require the opponent to demonstrate serious use of the trademark in the Turkish market. Alternatively, the opponent could argue that justifiable reasons for non-use in the Turkish market exist.

The TPI will reject the opposition if the opponent does not provide such proof (or an acceptable justification). Alternatively, the TPI will partially accept the opposition if the opponent demonstrates use for a certain portion of the goods and services covered by the mark.

Additionally, the draft law clarifies a practical communication problem between the World Intellectual Property Organization (WIPO) and the TPI. The problem causes Madrid System extensions to be refused based on the existence of national applications which are filed after the international application but recorded earlier in the TPI's system. The draft law clearly accepts that earlier international applications cannot be rejected based on the existence of a national mark which was filed after the international trademark's application (or priority) date.

The draft law clarifies that the two-month period for contesting the TPI's decisions on international applications begins at the end of the 15th day after WIPO notifies the owner (or its representative).

It also reduces the design law's opposition period from six to three months, starting from the publication date. It appears to change the three-year repair period clause in the current design law. The draft law does not foresee any exclusive term for design owners to prevent against the use of a design by third parties as long as it constitutes a component of a complex product in order to restore its original appearance.

The proposed improvements and clarifications are promising consideration of the practical grey areas which currently exist. Local practitioners are holding their breath now that the public consultation period is over. Turkey has long been waiting for intellectual property legislation which is accepted as 'law', rather than a 'by law'.

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