



# TALKING TURKEY

Mutlu Yıldırım Köse examines how a proposed change to Turkish IP Law will affect trade marks and designs

In order to comply with the codification system of the Turkish law further to the decisions of the Constitutional Court, a draft IP law (the Draft Law) has been prepared by the Turkish Patent Institute (TPI) relating to all IP rights other than copyrights. On 24 February 2016, The Ministry of Science, Industry and Technology circulated the Draft Law on the TPI's website, with the consultation ending on 4 March 2016.

When enacted, the Draft Law will replace the decree-laws pertaining to the protection of trade marks, patents, geographical indications and designs, all of which date back to 1995, by bringing them together under one collective statute. It consists of five chapters and approximately 200 provisions, with definition provisions at the beginning and common provisions at the end. It incorporates

the provisions already contained in the existing decree-laws, while introducing some new ones as well.

The Draft Law uses the term "industrial property" and is named The Industrial Property Law. The term "intellectual property" is considered to be more comprehensive and in compliance with international notions. Therefore, it is hoped that, in line with the comments and suggestions, the name of the Draft Law will be changed to The Intellectual Property Law before the draft code is sent to the Council of Ministers.

The aim of the proposed revisions to the trade mark and design chapters is to accommodate some problematic areas experienced during the implementation of the previous decree-laws, filling the gaps that emerged due to the decisions of the Constitutional Court and

becoming further compliant with EU directives.

## TRADE MARK SPECIFICS

Importantly, the terminology for the distinctiveness of a trade mark has changed. Accordingly, signs to be registered as trade marks are regulated in the Draft Law as follows: "A trade mark, provided that it is capable of distinguishing the goods and services of one undertaking from the goods and services of other undertakings, and can be shown in the Registry, ensuring that the subject of the protection provided to the trade mark owner is clearly and precisely understandable, may consist of all kinds of signs, such as words, including personal names, designs, colours, letters, numerals, sounds and shapes of the goods or their packaging." Therefore, as under the new EU Trade Mark Directive, to be counted a trade mark, it would be

sufficient if the subject matter of protection is clearly and precisely understood.

Another notable change is that the Draft Law introduces the principle of coexistence into Turkish trade mark law. Accordingly, letters of consent from senior trade mark owners or application owners, or coexistence agreements, shall be acceptable in overcoming the citations of earlier, senior, identical or indistinguishably similar trade marks by the TPI as an *ex officio* refusal ground. This is an important change, which overcomes the present *ex officio* refusal that prevents the registration of many new trade marks.

## IP IMPACTS

Furthermore, the term for opposition for trade marks has been shortened to two months from three. It is also worth noting that the TPI's Trademarks and Industrial Design Bulletins will now be published twice monthly, rather than once a month, following a recent decision by the TPI.

Another change that will directly affect IP practice is that, during the opposition proceedings before the TPI, opponents will have to prove genuine use, or produce justified reasons for non-use within the past five years, of trade marks that they cite as grounds for the opposition, if so requested by the applicant. Accordingly, if the opponent cannot prove genuine use or produce justified reasons for non-use, the opposition will be rejected. There is a similar provision for infringement actions as well. Thus, non-use of a trade mark cited as grounds for an infringement



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action can also be cited in defence in an infringement action.

As the Draft Law gives the TPI the task of reviewing evidence filed relating to the genuine use of the relevant trade mark(s) during opposition proceedings, when the first version of the Draft Law was shared by the TPI, a discussion followed about whether or not claims for annulment of registered trade marks due to non-use should also be handled by the TPI (instead of by civil courts). Following the consultation on the draft, a provision was added stating that the right to invalidate a trade mark on grounds of non-use rests with the TPI. However, the enforcement date of this provision has been postponed for seven years.

## MAJOR AMENDMENTS

Other main amendments contained in the Draft Law with regards to trade marks are:

- signs containing geographical indications cannot be registered as trade marks;
- bad faith has been added as a separate ground for opposition and cancellation;
- the five-year period for filing a cancellation action has been regulated under a separate provision; and
- the holder of a trade mark will not be able to argue that it has a registered right, and that its use of a registered

right cannot constitute infringement of an earlier mark.

The design chapter of the Draft Law also includes changes that achieve greater compliance with the relevant EU directives. First of all, the name of the chapter has been changed from Industrial Designs to Designs and, regardless of whether they are industrial or not, all designs will be protected. Further, the provisions regarding spare parts have been harmonised with EU law; unseen parts/devices (eg parts of an engine) cannot be registered as designs.

Another change is that novelty examination has been introduced for design applications. Therefore, if the Draft Law enters into force, the TPI will review the novelty of designs, which will give it another task to handle. Further, the criterion for distinctiveness has been changed to "difference" from "significant difference". The opposition term has also been shortened to three months from six months.

The Draft Law is deemed to be a favourable development and it is expected to resolve some major issues for IP rights-holders. It will be finalised after receiving the opinions of stakeholders. It will then be sent to the Turkish Parliament for discussion and enactment. It is expected to enter into force later in 2016. ■



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