

## Turkey is Welcoming The Long Awaited Industrial Property Code

The long-awaited Industrial Property Code ("the IP Code") has entered into force as of today, being published in the Official Gazette.

The IP Code replaces the Decree-Laws pertaining to the protection of Trademarks, Patents, Geographical Indications and Industrial Designs, by unifying them into a single code. The Code was prepared to provide compliance with recent developments in EU IP Law, to restore the gaps due to the decisions of the Constitutional Court annulling various provisions of the Decree Laws and to make the relevant regulations clearer, more understandable and more systematic, as stated in its preamble.

The IP Code contains 5 chapters and approximately 200 provisions, with introductory provisions and common provisions. Book 1 of the Code regulates Trademarks, Book 2 regulates Geographical Indications, Book 3 regulates Designs and Book 4 regulates Patents.

The IP Code does not only consolidate the common provisions of the Decree-Laws, but also amends some of them. The following amendments are worth noting:

The name of the Turkish Patent Institute has changed to "Turkish Patent and Trademark Authority".

### Major changes related to Trademarks

- The graphical representation criteria for signs to be registered as a trademark has changed to "signs capable of being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor". So the terminology has been aligned to EU Trademark Directive.
- The "co-existence principle" has been introduced into Turkish Trademark Law. Accordingly, co-existence agreements and letters of consent will be accepted in overcoming senior identical or indistinguishably similar trademarks from being an absolute ground of refusal by the Turkish Patent and Trademark Authority ex-officio.
- During the opposition proceedings before the Turkish Patent and Trademark Authority, opponents have to prove genuine use or provide justified reasons for non-use of their trademarks that are the basis for opposition and registered at least for a duration of five years, if requested by the applicant. The opposition shall be rejected if such use or a justified reason for non-use cannot be proven. This request can also be used as a defense in an infringement action.
- The opposition term has been shortened to two months from three months.
- The protection of well-known trademarks in the meaning of Paris Convention, which was recently cancelled by the Constitutional Court, has been re-introduced as a relative opposition and invalidation ground.
- The bad-faith is set forth as a separate opposition and invalidation ground.
- Signs that contain geographical indications cannot be registered as a trademark.
- The terminology for distinctiveness criteria has been changed to comply with the EU trademark legislation.
- The five-year term for filing an invalidation action is regulated with a separate provision.
- The cancellation actions due to non-use will be dealt by the Turkish Patent and Trademark Authority. However, the enforcement date of this provision has been postponed for 7 years with an additional provision. Therefore, until 2023, the cancellation actions need to be filed before the IP Courts.

### Major changes related to Designs

- The name of the related chapter has been changed from "Industrial Designs" to "Designs" and all designs shall be protected, regardless of being industrial or not.
- Novelty examination has been introduced for design applications. The Turkish Patent and Trademark Authority shall conduct this examination ex-officio and shall decide to publish the application or not.
- The opposition term has been shortened to three months from six months.
- Unregistered designs shall be protected for three years as of becoming publicly available, in line with Article 11 of the Council Regulation regarding community designs.
- The criterion for distinctiveness has been changed to "difference" from "significant difference".
- Unseen parts/devices (e.g. parts of an engine) cannot be registered as designs.
- Opposition grounds have been broadened. The "bad faith" argument and "unauthorized use of an IP right" have also been added as opposition grounds.

### Major changes related to Patents

- A post-grant opposition system has been introduced in line with Article 101 of the EPC. With the introduction of this system, patent owners shall be entitled to amend the patent during the opposition phase, after the first grant decision.
- The Courts cannot rule upon premature invalidity actions - filed after the first grant decision while the opposition is ongoing before the Turkish Patent and Trademark Authority - until the opposition before the Turkish Patent and Trademark Authority is concluded. However, this regulation applies only to national patent applications. As regards to European patents, third parties will be allowed to file invalidation actions before national courts while the EPO is dealing with issues of patentability.
- The vague provisions of the Decree Law on prior user rights, use/work requirement of a patent and service invention have been improved.
- All criminal penalties in case of patent infringement have been removed.
- The grounds for compulsory licensing have been broadened. In particular, the Code introduces the provision that compulsory licensing can be demanded even in case the patent is used but "the use is not sufficient to cover the needs of the national market".

### Common Provisions

- A trademark/patent/design right holder can no longer allege its registered right as a defense in an infringement action filed by a priority right holder. Consequently, having a registration shall not mean that there is no infringement.
- The principle for the national exhaustion of IPRs has been changed to "international exhaustion of IPRs".

The new IP Code is considered a favorable development by the stakeholders in general, as the Turkish Constitutional Court had in fact annulled many provisions of Decree-Laws over the last few years. While there are some intense discussions on some points, the IP Code is expected to resolve some major issues for IP right owners.

The new IP Code has been entered into force today except some of the provisions of which the enforcement has been delayed, however for the trademark, design and patent applications which were filed before the enforcement date of the new IP Code, the former legislation, namely the Decree-Laws pertaining to the protection of Trademarks, Patents and Industrial Designs will still apply until their registration process will be completed.

If you have any queries please contact [gun@gun.av.tr](mailto:gun@gun.av.tr) or liaise directly with your usual contacts.

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