

Entry into force of new Regulation on the Implementation of the Industrial Property Code  
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May 05 2017

## Industrial Property Code

The Industrial Property Code 6769, which abolishes previous IP-related decree-laws and unites all IP rights, including trademarks, patents, industrial designs, utility models, geographical indications and traditional product names, was published in the *Official Gazette* and entered into force on January 10 2017 (see "[New IP Code enters into force: 2017 will be the year of IP rights](#)").

According to provisional Article 2 of the Industrial Property Code, until the effective date of the regulation foreseen in the code, prior regulations which do not contradict the code will remain applicable. However, there has been an immediate need for regulation for the implementation of the new provisions, as the implementation regulations in force contain no provisions regarding these.

## Regulation on the Implementation of the Industrial Property Code

On January 6 2017 the Turkish Patent and Trademark Office (TPTO) prepared the draft regulation and shared this on its website. The draft regulation was circulated for a period of consultation which finished on January 26 2017. A few changes were made to the draft during this stage, and the Regulation on the Implementation of the Industrial Property Code entered into force on April 24 2017 following its publication in the *Official Gazette*.

The new regulation abolishes previous regulations on the implementation of IP-related decree-laws and unites all relevant provisions into a single regulation. It consists of five chapters, 140 articles and three provisional articles, and details provisions on the implementation of the Industrial Property Code. .

## Non-traditional marks

Under the Industrial Property Code, signs must be registered as 'trademarks' in line with Article 3 of EU Directive 2015/2436. According to Article 7 of the Regulation on the Implementation of the Industrial Property Code:

- Recordings of sound suitable for listening and storing in electronic form must be submitted to the TPTO for sound trademark applications.
- Representation of the mark, including a view from one side or multiple angles as to provide a clear and precise understanding of the subject of protection, must be submitted for three-dimensional (3D) trademark applications.
- Colour images and indication of the colour code accepted by the TPTO must be submitted for colour trademark applications.
- Images describing the trademark's motion or a motionless or moving image sequence must be submitted for motion trademark applications.

The regulation is now in line with the EU Trademark Implementing Regulation (2868/95) regarding the representation of trademarks. This is significant progress regarding non-traditional marks, since the abolished Regulation on the Implementation of Decree-Law 556 did not include provisions for sound, motion, colour or 3D marks.

The new regulation now clearly explains what must be submitted for the registration of different kind of trademark and reduces the lengthy procedures thereof. Under the former legislation, registration of motion trademarks was not possible and extensive evidence had to be submitted sufficient to prove acquired distinctiveness through use for registration of single colour marks. The TPTO perceived 3D trademark applications as simple device trademarks and provided insufficient protection to these rights holders. For sound trademarks, the graphic representation of the sound mark with a sheet music form or stave had to be submitted to the TPTO, along with a recording of the sound.

As well as the above, applicants may submit a written statement for the representation of their trademark. If the TPTO deems that the representation is not clear, certain or understandable, it may request additional information, documents or statements related to the applied mark. Further, it is clearly regulated that the above mentioned articles can also be applied to the representation of marks not listed in Article 7, to the extent applicable to the mark's nature. In this case, applicants may submit visual representations through images, figures, lines or characters, electronic records, written explanations or any other representation that

they deem appropriate. This is compatible with the Industrial Property Code since it does not limit trademarks to the mentioned signs. Applications for registration of trademarks other than word or simple device marks are expected to increase in the near future.

### ***Co-existence principle***

The Industrial Property Code also introduces the co-existence principle into Turkish trademark law. According to Article 10 of the regulation, a letter of consent must be arranged in the form approved by the TPTO and be notarised. The letter of consent must be unconditional and cannot be retrieved once it has been submitted. Separate letters of consent must be submitted for each trademark application.

According to Article 19 of the regulation, partial renewal of a trademark registration is now possible. Trademark owners may renew their registered trademarks for only some of the goods and services within their scope. Previously, only total renewal of trademark registrations was possible, but rights holders can now renew their trademarks for only the goods or services in which they are intended for use.

### ***Counter non-use claims***

The Industrial Property Code brings counter non-use claims as a defence in trademark opposition proceedings and invalidation or infringement actions. According to Article 28 of the regulation, the TPTO must notify an applicant of an opposition and the applicant must submit its response within one month of the notification date. According to Article 29 of the regulation, the applicant must notify the TPTO of its request for proof of use within the timeframe required to submit its response against the opposition (ie, one month).

Requests for proof of use must be clear, unconditional and explicit, and must include the trademark numbers for which the proof of use is requested. Applicants can also withdraw their requests for proof of use. The TPTO will grant the opponent a one-month period to submit evidence of genuine use of its trademark in Turkey. The opponent's evidence must be sent to the applicant if the TPTO deems that it is necessary. In this case, the applicant may submit its opinion on the opponent's evidence within a one-month period. If the applicant does not submit a response, the TPTO will examine the opposition within the scope of the existing evidence.

If the opponent fails to prove use of its trademark or the evidence submitted is unrelated to its use, and if there are no other grounds for claims, the TPTO will refuse the opposition. The opponent may also submit evidence with the opposition form. If the applicant requests proof of use and the submitted evidence is sufficient proof of use, the TPTO will examine the opposition without granting a response period to the opponent. However, if the TPTO deems that the submitted evidence is insufficient, a one-month period will be granted to the opponent to submit additional evidence. Submitting evidence of use with the opposition is sensible for rights holders, as it saves considerable time before obtaining a decision on the opposition.

According to Article 30 of the regulation, submitted evidence must contain sufficient information on the nature, location, time, scope and use of the trademark in relation to the goods and services in its scope of registration. Evidence may include:

- packaging;
- labelling;
- price lists;
- catalogues;
- invoices;
- photographs; and
- newspaper advertisements.

Evidence must be submitted in writing, showing clearly which evidence pertains to which fact. Evidence submitted after the period provided in Article 29 will not be taken into consideration. If the submitted evidence is in a foreign language, a two-month period may be granted for submission of a Turkish translation approved by a certified translator. If the submitted evidence cannot be clearly understood with respect to its nature, content or connection to the trademark, or if it is not legible, regularly classified or listed and cannot be associated with the claims, a one-month period will be granted to remedy these deficiencies. If such deficiencies are not remedied, the evidence will not be taken into consideration.

The TPTO will soon implement the counter non-use claim and, while the proportion of accepted oppositions is expected to decrease, the timeframe for the TPTO to examine oppositions and the size of its workload are expected to increase.

### ***Reconciliation***

According to Article 32 of the regulation, the TPTO may invite the parties for reconciliation during the examination of oppositions if it deems this necessary. In this case, the parties will have the right to submit their written statements on the reconciliation within one month of notification by the TPTO. Attorneys must also inform the rights holders immediately of the TPTO's reconciliation offer.

### **Power of attorney**

According to Article 124 of the regulation, if a valid power of attorney has already been submitted to the TPTO, attorneys need not submit copies of the power of attorney for each transaction before the TPTO; it is now sufficient to refer to the previously submitted copy. This will reduce TPTO paperwork and help attorneys. The motivation behind the removal of this necessity is that the Industrial Property Code brings disciplinary penalties for patent and trademark attorneys. Accordingly, both the code and the regulation aim to improve patent and trademark attorney professionalism. The TPTO can request the original or notarised copy of the power of attorney at any time. If the attorney fails to provide a copy to the TPTO upon its request, he or she may face a serious penalty.

One of the regulation's most significant reforms is that a notarised power of attorney need not be submitted, which previously cost time and money for both rights holders and practitioners for the total or partial withdrawal of trademarks and oppositions or appeals. It is now sufficient to submit a simply signed power of attorney, including clear authorisation for the withdrawal of the specific marks, oppositions or appeals.

The Industrial Property Code has brought complete or partial solutions to some of the problems in Turkish IP law practice, and the new regulation includes detailed provisions on its implementation. We will now observe this implementation by the TPTO.

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