



FICPI Turkey - Seminar on Amendments on the Trademark and Patent Registration Procedures Brought by the IP Code and Their Implementations

04th April, 2019

FICPI - TURKEY Board of Directors decided as the subject of this year's seminar amendments to the trademark and patent registration procedures by the IP Code and their implementation. The seminar was held in İstanbul on October 26, 2018 and there were around 75 participants in addition to the speakers and FICPI - TURKEY members.

At the first session on patents, the speakers discussed amendments on the provisions as to compulsory licenses and proof of use; and at the second session on trademarks, new provisions as to the proof of use defence in oppositions and letters of consent were discussed.

The aim of this seminar was to bring Office Examiners and Practitioners together to discuss problematic issues. This kind of event also increases the interests of Turkish Attorneys in FICPI and the number of candidates for membership. This was supported by observations during the seminar and feedback following the event.

FICPI - TURKEY finalized its events for the year 2018 with this seminar following four roundtable meetings and intends to continue organizing similar events in future.

The Industrial Property Code No. 6769 ("the IP Code") entered into force in Turkey on January 10, 2017 having been prepared to adapt with the recent developments in EU IP law, and to abolish the IP related Decree-laws, some of the provisions of which had already been annulled by the Constitutional Court. This new code has brought new provisions to the Turkish IP Law, which had never been implemented before, such as letters of consent, and the proof of use defense in trademark oppositions, as well as amendments to some patent related provisions, such as proof of use and compulsory licenses.

FICPI - TURKEY Board of Directors decided as the subject of this year seminar these amendments and their implementations. This topic has drawn the attention of most patent and trademark attorneys as, despite the time having passed as from the effective date of the IP Code, some ambiguities still exist on the implementation. In this regard, considering that keeping patent and trademark attorneys up-to-date on such matters has been the most important one of FICPI - TURKEY's aims and duties, the Board decided to organize a seminar, where these ambiguities could be discussed together with both practitioners and examiners.

The seminar was held in İstanbul on October 26, 2018 and there were around 75 participants in addition to the speakers and FICPI - TURKEY members. The seminar was also attended by Prof. Dr. Gül Okutan Nilsson, from İstanbul Bilgi University, who made the opening speech before the opening speech made by Mr. Uğur Aktekin, the President of FICPI - TURKEY.

At the first session on patents, which was moderated by Mr. Erkan Sevinç, who is a FICPI - TURKEY member and Turkish and European Patent Attorney, the first speaker Patent Examiner Serkan Özkan from the Turkish Patent and Trademark Office (the Office), started his speech providing some basic information on the patent system and discussing the balance between interests of the inventor and society. Afterwards, he provided information on the limitations and exceptions of patent right and compulsory license referring to the relevant articles of the IP Code and, also Paris Convention and TRIPS Agreement. Then, he passed onto the subject of compulsory license due to non-use and stated that the only difference between the abolished Decree Law and the current IP Code is that while the Office used to request submission of proof of use documents before, now it finds it sufficient to provide only one statement as to the use. He added that this is only a formal requirement and it is the courts that will determine whether a patent is used or not. Mr. Özkan also stated that while the period for

the use of the patent used to start only as from the date the patent was published on the bulletin, now this period might be started also from the application date of the patent if it lasts later. As a final note, he shared some statistical information as to the submissions of proof of use document during former Decree Law and use statements submitted during the current IP Code.

The second speaker of the first session, Mr. Aydın Mutlu, who is a FICPI - TURKEY member and Turkish and European Patent Attorney, started his speech providing information on conditions and methods for granting compulsory license, and compulsory license on plant variety rights, referring to the relevant articles of the IP Code. Then he mentioned the compulsory license due to non-use, dependency of the patent subjects and public interest and also limitations and cancellation of compulsory license. In conclusion, he mentioned, as an example, a recent decision of the German Federal Court of Justice relating to a compulsory license.

Following the speeches, the participants asked questions especially on the submission of statement on use and its periods and Mr. Özkan stated that there is not a clear evaluation as to this period for European Patents, as to whether the EP bulletin or Turkish bulletin would be considered. It was further discussed the contents of license agreement, to which extend the conditions of the agreement could be interfered, and as to whether it should be discussed within the scope of liberty of contract. Some questions were raised also on the Article 129/e of the IP Code, which mentions the conditions of compulsory license, namely "if a patent owner uses a patent a way that constitutes limitation or obstruction of competition" and it was discussed which activities might be considered as obstructing or limiting the competition. When it was considered that the relevant article charges the Competition Board, it was concluded that the activities of the patent owner should be evaluated within the scope of the forbidden acts as per the Law on the Protection of Competition.

The second session of the seminar on trademarks was moderated by Ms. Yasemin Kenaroğlu, who is a Member of the Board of FICPI - TURKEY and a Trademark and Patent Attorney, and the first speaker Ms. Deniz Merve Ersoy Pinar, who is a trademark attorney, started on the topic of letter of consent. She firstly provided some basic information as to the formal requirements, referring to the relevant articles on the EU Trademark Directive and IP Code. She mentioned some ambiguities and problems on the implementation, such as the possibility of the owner of the former trademark registration that granted the letter of consent to file an opposition against the publication of the said application and also to file an invalidation action against this trademark following its registration. Ms. Pinar passed onto the subject of proof of use defence in oppositions, providing info on how a genuine use should be, how and which documents should be submitted. She mentioned that the most important deficiency for this implementation is that as the opposition is not notified officially for the international registration extensions, the applicants of IRs might not be entitled to demand proof of use documents. She finally added that the similarity examination as to the goods/services might be narrow in this concept.

The second speaker of the second session, Mr. Mustafa Kubilay Güzel, the Head of Trademarks Department of the Office, started his speech on the subject of proof of use defence providing info on how the form should be completed for a proper demand. He added that they encountered several incorrect demands; however considering this is a new implementation, they did take into account these demands, while they would be stricter on the review of the forms after a while. Then he mentioned the points that would be considered for the review of proof of use documents, where those documents should prove that the trademark should be used in the manner of a trademark use. However, he emphasized that these evidences should not be as broad as those that prove genuine right ownership, considering there is already a registered trademark. As for letters of consent, he mentioned the risks and benefits of co-existence and following some basic information as to the letter of consent forms, he mentioned that letter of consent would abolish only the refusal risk based on the Article 5/1 (ç) of the IP Code, thus it is not an obstacle against the rights of the former trademark owner to file an opposition following the publication of the said application and an invalidation action following the registration.

Following these sessions, the participants asked questions on letters of consent and Mr. Güzel emphasized again that oppositions and invalidations actions are possible even after a letter of consent is granted and these will be examined by the Office and courts; thus it will be useful for both sides to execute also another agreement. As for the proof of use document, he stated that narrower evaluation of the goods/services on this

implementation is wrong and it should be same as in the evaluation as per the Article 6/1 of the IP Code. As a conclusion, he stated that they are creating a database at the Office that will provide consistency for the decisions granted following oppositions as per the Article 6/1 of the IP Code.

The participants showed great interest to the seminar and interactively took part with their questions and discussions at the break and the question answer session. The aim of this seminar was to bring Office Examiners and Trademark and Patent Attorneys together so that the problematic issues could be discussed together. This kind of event also increases the interests of Turkish Attorneys in FICPI and the number of candidates for membership. This was supported by observations during the seminar and feedback following the event.

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