

The First Industrial Property Law of Turkey

January 2017

Authors: [Özlem Kızıl Voyvoda](#), [Gülşen Engin](#), [Ayşenaz Tahmaz](#)

For the first time in the history of Turkey, industrial property rights are gathered under the same roof by means of the Industrial Property Law No.6769 ("Law") which was adopted on 22 December 2016 by the Turkish Parliament and entered into force by its publication in the Official Gazette No. 29944 dated 10 January 2017. The Law consists of 199 articles, six of which are provisional. Prior to adoption of the Law, each of the intellectual property rights was regulated under separate statutory decrees, and such system was diminishing the efficiency and conformity of these rules. These decrees had been adopted more than twenty years ago as a band-aid solution, and it was obvious for some time that they could no longer shoulder the current problems in this area. Since intellectual property rights are one of the core elements of the commercial life, their emerging significance and the requirement of harmonization with the European Union ("EU") regulations, have inspired creation of a legal basis protecting these rights and accordingly, led to adoption of a single and comprehensive Law.

As it is stated in Article 191 of the Law, with its entry into force, relevant provisions of Law No. 5000 on Establishment and Functions of the Turkish Patent Institute and Law No.5147 on Protection of Integrated Circuits, and the entirety of the Decree No. 556 on Protection of Trademarks (the "Trademark Decree"), Decree No. 554 on Protection of Industrial Designs (the "Industrial Design Decree"), Decree No. 555 Protection of Geographical Signs (the "Geographical Sign Decree"), and Decree No. 551 Protection of Patent Rights (the "Patent Decree") and Decree No. 566 Amending the Decree No. 551 Protection of Patent Rights have been repealed.

Thanks to the Law, intellectual property rights are now regulated substantially in line with the EU regulations and current demands of the system. It would not be wrong to remark that the legal environment in this area is now more protective, secured and most importantly in a framework that can better fulfil the expectations of the right owners.

As on the secondary legislation, the draft of implementation regulation was also published on the Turkish Patent Authority's website for the comments and review of the public until 10th of January; and is expected to enter into force shortly.

Main Features of the Law

1. Objective

The objective of the Law is defined under Article 1 as "*The protection of the rights with regard to trademark, geographical sign, design, patent, utility model and traditional product name and contributing to the technologic, economic and social development.*" The Law establishes effective solutions for disputes and registrations, introduces shorter periods for registrations and creates a qualified and up to date structure for the whole procedure. It is expected that the Law will achieve its objective in a short time, and bring a long awaited standard to the intellectual property system in line with both recent court decisions of Turkey and EU practice.

2. The Role of Turkish Patent Institute

The main authority in the area of the intellectual property has been the Turkish Patent Institute since 1994. The Law introduces a new title for the Turkish Patent Institute which is "Turkish Patent and Trademark Office" ("Turkish Patent Authority"); and strengthens its role as per Article 26 of the Law, by authorizing the Turkish Patent, upon a request, to cancel a trademark if and when the conditions set forth under the Law exists. However pursuant to the effectiveness article of the Law, Article 26 will become effective after 7 years following the publication date of the Law. Hence such cancellation authority shall remain with the Turkish courts as per the principles set forth under Article 26 for the next 7 years.

3. Amendments with regard to the Trademarks

The Law introduces brand new regulations in relation to trademarks including the following:

- Under the Trademark Decree, a trademark was eligible for registration only if it could be "represented graphically". However, with the Law, the concept of trademark has been revised in accordance with Article 15 of the Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPS") and EU practices; and its definition has been broadened to numerals, colors and sounds eligible to indicate a clear and certain understanding of the subject matter of the protection which is provided to the owner.
- As one of the novelties and in line with the international practice, letters of consent and co-existence agreements have been accepted under the Law as conclusive documents in evaluation of applications for registration. Under the repealed Trade Mark Decree, those documents had no such power in preventing refusals due to existence of identical or similar trademarks. However, as per Article 5(3) of the Law, upon the submission of a letter or agreement evidencing that the consent of the existing right owner on the registration of the same or similar trademark of the applicant, the application must be accepted and can no longer be refused in the context of identical or similar goods and services.
- Being identical or similar with the well-known trademarks within the scope of Paris Agreement for the identical or similar goods and services has been regulated as a "relative ground for refusal" (*nisbi ret nedeni*) under the Law; while it was an "absolute ground for refusal" (*mutlak ret nedeni*) in the repealed Trademark Decree. Accordingly, such an application will only be refused if an objection is raised. This constitutes a compatible amendment with the international precedents. In addition, breach of good faith obligation has also been established as a relative ground for refusal under the Law in line with the current practice.
- The Law shortens the period of opposition and creates a more effective and prompt process for the registration of trademarks. The existing right holders can defend their rights by opposing the relevant trademark application within two months (which was previously three months) following its publication date.
- As mentioned above Article 26 of the Law, which will be effective in 2024, regulates cancellation of trademarks upon the request of third parties by the Turkish Patent Authority whereas Turkish courts remains as the venue for the nullity requests.
- Pursuant to Article 9 of the Law, a trademark that has not been genuinely used or ceased to be used for successive five years with respect to goods and services that it is registered for, will be cancelled.
- As per Article 14 of the Law, an application made within the context of the Protocol relating to Madrid Agreement Concerning the International Registration of Marks will have the same consequences as if the application has directly been made to the Turkish Patent Authority.
- The Law also includes provisions related to infringement of industrial property rights; and envisages imprisonment only for trademark infringements whereas Infringements of other industrial property rights are subject to other legal sanctions. Since application of imprisonment sanctions provided under the former decrees were challenged several times before the Turkish Constitutional Court due to the fact that they were limiting the fundamental rights which can only be made by laws, those provisions under the Law put an end on those discussions and brought a well-grounded and more effective mechanism against trademark infringements.

4. Geographical Signs and Traditional Product Name

The Law regulates the geographical signs together with the traditional product names. This concept allows for the protection of the traditional product names by means of their registration along with the geographical signs.

As a new concept under the Law, applicants are entitled to object to the rejection of their application by the Turkish Patent Authority within two months following the notification date of the decision. Also, registration process has been shortened from six months to three months, and eased with the decrease in the number of the requirements.

The Law, as one of the important novelties, provides that audit reports to be prepared by the approved institutions must be submitted to the Turkish Patent Authority annually rather than once in a ten year period as used to be under the Implementation Regulation of the Geographical Sign Decree.

5. “Design” instead of “Industrial Design”

Under the Law, a design may be subject to protection regardless of the industrial character of it; and accordingly, uses the “Design” title instead of “Industrial Design”.

Among the other rejection reasons, pursuant to the Law design registration applications which are not compatible with the definition of design or product; or which are against the public order and public morality; or not novel shall also be rejected by the Turkish Patent Authority.

Similar to the provisions regarding other property rights, the registration process for designs has been shortened from six months to three months.

6. Goodbye to the System of Granting Patent without Substantive Examination

As one of the heavily criticized matters, under the Patent Decree, it was possible to register a patent without any substantial examination. However with the enactment of the Law, an invention may only be registered as a patent if it (i) is new, (ii) involves an inventive step, and (iii) has an industrial application.

7. Overall Consideration

Since intellectual property rights are inseparable part of the commercial life, effective and accurate regulation of those rights is essential. Compared to the former legislation comprising of several pieces of decrees and provisions provided in different laws, the Law now offers a hope for the industrial property system in Turkey to fulfill the demands of the right owners and be in line with the international regulations. Almost all of the amendments therein have the same objective which is to provide simplicity on the proceedings, strengthen the legal grounds of these rights and create a legal environment appropriate for the emerging needs of the market.

Çakmak Avukatlık Bürosu

Piyade Sokak, No. 18
C Blok, Kat:3, 06550
Çankaya, Ankara - Turkey

T +90 312 442 4680

This information is provided for your convenience and does not constitute legal advice. It is prepared for the general information of our clients and other interested persons. This should not be acted upon in any specific situation without appropriate legal advice and it may include links to websites other than the website.

Çakmak Avukatlık Bürosu has no responsibility for any websites other than its own and does not endorse the information, content, presentation or accuracy, or make any warranty, express or implied, regarding any other website.

This information is protected by copyright and may not be reproduced or translated without the prior written permission of Çakmak Avukatlık Bürosu.