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Registered designs are effective tools for protecting and enforcing rights arising from the ornamental or aesthetic appeal of an article, excluding its functional features – from architectural structures to furniture, medical instruments to household appliances, and visual creations of fashion industry to cartoons – where copyright protection often remains ineffective.

Turkey receives almost 8,500 (multiple) design applications (including over 41,000 designs) annually, increasing by an average of 10% for each of the past three years. With these filing numbers, Turkey is one of the top three in the European design filings league.

Legal framework

Decree-Law 554 on the Protection of Industrial Designs, which entered into force in 1995, is the main statute protecting new and distinctive designs and aesthetic creations. The decree-law was subsequently amended by Laws 4128 and 5194.

A new draft IP law to tackle some of the

deficiencies in the existing legislation, which would also eliminate the legal gap in criminal enforcement, has been awaiting approval for a long time and is expected take effect soon. With regard to designs in general, Turkey is a party to:

- the Paris Convention on the Protection of Industrial Property (1925);
- the Berne Convention for the Protection of Literary and Artistic Works (1952);
- the Convention Establishing the World Trade Organisation (1995);
- the Locarno Agreement Establishing an International Classification for Industrial Designs (1998); and
- the Hague Agreement for the International Registration of Industrial Designs (2005).

Unregistered designs

Unregistered designs can be protected under the unfair competition provisions of the Turkish Code of Commerce, and in some cases under the individual rights provisions under the Law on Works of Art and Intellect (Law 5846, as amended by Law 4110 in 1995) and the Civil Law, and the tort provisions of the Code of Obligations.

If the relevant conditions apply, the rights holder can use some or all of this legislation, in addition to the legislation applicable to designs, unless the particular provision inures to the benefit of the other party.

Under Turkish law, fewer conditions apply to the protection of unregistered designs than to registered designs, taking into account the existing regulation. Provided that a design is novel and original – and such novelty need not be absolute – it shall be protected by the unfair competition provisions, even if it is not of an individual character. In this context, ‘originality’ is understood as the originality that relates to intellectual and artistic works. However, designs that are within the scope of the protection exception cannot also be protected as unregistered designs.

Nevertheless, registration is still recommended in order to secure a design on the Design Register and to enforce the design right more efficiently, since unregistered designs are protected only against copycats and the infringer’s negligence must also be proven. The registration is also presumptive evidence of the validity of the design and the owner’s right to use such design.

Registered designs

Any natural or legal person whose domicile, principal place of business or real and effective industrial or commercial establishment is in Turkey, or any natural or legal person entitled to file an application under the Paris or Berne Conventions or the Agreement Establishing the World Trade Organisation, may register a design. A foreign applicant should be represented by a Turkish patent or trademark attorney before the Turkish Patent Institute.

A novel design of “distinctive/individual character” can be protected in Turkey for a maximum duration of 25 years, subject to the payment of renewal fees every five years. In general, worldwide novelty is required and a design is regarded as having individual character if it produces a different overall impression on an informed user from that produced by any previous design. An industrial design is primarily of an aesthetic nature and does not protect the technical features of the article to which it is applied.

A wide range of characteristics can be protected by a registered design, including lines, contours, shapes, colours, textures, materials,

elasticity or other characteristics perceived by the senses of the appearance of whole or part of a product or its ornamentation.

In this context, a ‘product’ means any industrial or handicraft item, parts of a complex system, sets, compositions of items, packaging, get-up, graphic symbols and typefaces, with the exception of computer programs and semiconductor products. Designs resulting from a technical function which leave the designer no freedom in the design characteristics and elements, and designs which are contrary to public order or acceptable principles of morality, are not eligible for protection.

On the other hand, designs that are capable of protection can include logos, stylised words, labels, cartoons and the appearance of packaging as a useful supplement or alternative to trademark protection, where the latter may be difficult to obtain or cannot be secured without extensive use (ie, use within five years of the registration date).

Designs of ‘must-fit’ parts are not protected. With regard to spare parts, such designs are granted limited protection of three years, but may even enjoy 25 years’ protection if a spare part (eg, the seat or mirror design of an automobile) has novel and individual character.

The most popular areas of design applications (according to the Locarno Classification) are furnishing (Class 6), surface patterns, ornamentation and logos (Class 32), household goods (Class 7), packages (Class 9) and clothing (Class 2). Design applications in these five classes represented around 60% of all design applications received in 2002.

The total cost of a design application is complicated and changes depending on:

- the number of designs to be included in one file (ie, single or multiple);
- whether a design is black and white or in colour;
- additional pictures of each design (eg, front view, perspective);
- any priority claim;
- the design attorney’s charging policy; and
- any opposition from third parties during the publication stage.

Procedures

It is possible to file in a single application all designs falling into the same Locarno class.

In this way, all designs for a target group of articles, such as a range of similar products, can be filed in one application and for a much lower fee compared to filing individual applications.

There is no deadline for filing an application, provided that the design has never been made public or offered for commercial use. Novelty is to be assessed on a worldwide basis, but is not destroyed where disclosure of the design has been made by the rights holder in the 12 months before the application or the priority date, if any. The priority term is six months from the priority date. Protection can be obtained only by a conventional application at the Turkish Patent Institute or an international application through the Hague System.

The application should include information about the applicant, the designer and the type of application, as well as the payment details and a drawing, painting, graphic, photograph or similar representation of the design that is suitable for reproduction and that reflects all of its specific features. Design representations must be clear, supported by different views if necessary, and should show clearly the parts for which protection is claimed and not claimed. The application should contain a list of the products in which the design is intended to be used and a written description of the original features of the design, explaining the visual aspects only (ie, the shape, pattern and ornamentation), without explanation as to how the article functions or performs.

The identity of the designer should be cited in the application form. If the applicant is not the designer or the sole designer, it must include a declaration of assignment on how the right to apply for registration has been obtained.

Foreign applicants must appoint a professional representative to file the design application and a power of attorney signed by the applicant should also be submitted.

All design applications are formally examined on the availability of filing requirements and entitlement only – that is, no novelty search or substantive examination is carried out. The application is then registered and published for six months. The time taken to register a design application and issue the certificate is about 10 to 12 months, unless an opposition is filed during the publication period (under the post-grant opposition system). If an

opposition is filed by any interested party, the Turkish Patent Institute invites the applicant to submit observations and the Board of Appeal then examines the application for novelty, distinctiveness and other possible grounds raised by the opponent. The Board of Appeal's decision can be further appealed before the IP Court in Ankara.

It is possible to delay registration in order to allow time to market or file designs outside Turkey and to keep them confidential. This option can be selected at the time of filing the design application; if it is, publication of the design can be delayed for up to 30 months from the filing date.

Enforcement

Registration gives the rights holder the exclusive right to protect an industrial design. A third party cannot produce, market, sell, import or enter into a contract using the design, use the design for commercial purposes or withhold the registered design without the rights holder's permission.

Design litigation can be classified into five basic categories:

- civil actions due to infringement of registered rights;
- criminal actions;
- invalidation actions against registered rights;
- actions for stating or determining non-infringement; and
- annulment actions against Turkish Patent Institute decisions.

Civil actions may include requests for determination of infringement, cessation of acts of infringement, seizure of counterfeit goods and compensation for damages. Criminal actions may attract penalties including imprisonment, pecuniary punishment, closure of premises and prohibition of commerce. However, compensation for damages is not available in criminal actions.

Preliminary injunctions to stop the infringement and seize infringing products can be claimed, but only before or alongside civil proceedings.

Turkey has 23 specialised IP courts in cities including Ankara, Istanbul and Izmir; in other cities, only appointed ordinary civil courts can

hear IP matters. Civil and criminal proceedings cannot be heard by the same court. For criminal proceedings, the rights holder must file a complaint against the infringer with the public prosecutor. Although at present there is a legal void in criminal enforcement, it is hoped that this will soon be eliminated once the new draft law has been approved by the Senate.

In infringement proceedings, courts will deem the design to be valid unless the defendant challenges its validity via a separate court case. There are no separate specialised courts for validity and infringement cases in Turkey. The burden of proof rests with the plaintiff. Both types of proceeding are generally joined and dealt with simultaneously in the first-instance court where the first action is lodged.

The disclosure of evidence is the first step of infringement proceedings. In the absence of sufficient evidence of infringement, the plaintiff can initiate a separate lawsuit before the civil court to find and secure evidence of infringing acts. The judge then appoints a panel of experts and may assess the infringing acts without notifying the infringer (*ex parte* proceedings). The expert report is strong evidence of infringement and can be used later for the main civil or criminal proceedings.

The first-instance decision may not be issued for as long as 18 to 24 months after the action is begun, depending on the number of petitions exchanged, the defences and evidence collected, the number of expert reports issued and the number of hearings. An appeal before the Supreme Court takes another 12 to 16 months.

Only the first-instance court takes into consideration the legal and technical facts of the case in depth. Expert reports are generally trusted by the judge, and generally two expert reports are prepared at first instance, as the first is usually opposed by one of the parties. The appeal court reviews the basic legal arguments without considering technical details. Therefore, the parties are bound by the arguments submitted at first instance – additional arguments are not permitted before the appeal court.

Turkey's customs measures are in line with the EU Customs Regulation, which deals with *ex officio* and export controls. Turkey provides for a simplified procedure and a centralised system,

which allows applications for action to be filed with a single authority throughout Turkey. Customs can suspend normal procedures for 10 days in order to enable the applicant to take advantage of simplified destruction procedures or to obtain an interim injunction from a court; the latter can be followed by civil or criminal court proceedings.

Ownership changes and rights transfers

The owner of a design can assign its rights in the design. It can also grant licence agreements concerning the design.

A transfer concerning a registered design need not be recorded at the Turkish Patent Institute to be valid between the parties. However, recordal is required in order to make the transfer public and to have effect with regard to third parties. In addition, foreign rights holders should note that the courts will issue a notice of invitation directly to the registered address (ie, if a trademark cancellation lawsuit based on non-use is filed there).

Related rights

Turkish law adopts the principle of cumulative protection in terms of the protection of designs. In that sense, designs can be protected through the intellectual and artistic works legislation and the unfair competition provisions of the Commercial Law, as well as the design legislation mentioned above.

Moreover, the design of a product protected through a utility model certificate shall enjoy design protection provided that it has novel technical features and is applicable in industry. A sign of distinctive character can be protected both as a trademark and as a design.

However, if the particular provision inures to the benefit of the other party, the general provision cannot be relied on. For example, Decree-Law 554 envisages the three-year protection of spare part designs, so the designer will be unable to rely on the unfair competition provisions which offer unlimited protection. [WTR](#)

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