

Turkey

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Against the odds: the fundamentals of design protection in Turkey

Although registered and unregistered designs enjoy various forms of protection in Turkey, in practice, the hurdles to obtain such rights can be difficult to overcome, meaning manufacturers – especially in the spare-parts industry – should consider alternative solutions

In Turkish practice, a design is expected to be novel, distinctive and producible with industrial means to benefit from registration. Each of these three criteria is *ex officio* examined by the Turkish Patent and Trademark Office (TPTO) during its initial evaluation based on absolute grounds.

Registration can be obtained via the TPTO national filing system or internationally through WIPO. In both cases, the registrant can claim priority based on its earlier national, regional or international design filings or launch of the design at exhibitions dating back up to six months before the date of filing in Turkey.

Single and multiple filing options are available and each multiple filing can cover up to 100 designs provided that they all fall under the same Locarno class.

Once a design has successfully passed *ex officio* examination it is registered and published for three months to allow for third-party oppositions. Oppositions may be based on: inappropriateness of the applied design to the registrability conditions and general moral principles; bad faith of the applicant; or unauthorised use of any IP right belonging to another party.

The decision issued in response to a third-party opposition is administratively final and can only be challenged by filing a cancellation action before the Ankara Civil IP Court.

Registration of a design grants 25 years' protection, provided that it is duly renewed every five years. This entitles the rights holder to manufacture, sell, import, export, stock and commercially use the registered product and prevents third parties from performing such actions in connection with the related design.

Whether intentional or not, unauthorised use of a registered design is

considered infringement and is prohibited by the Turkish IP Law (6769). In such cases, registrants can apply to the Civil IP Courts of First Instance to claim termination of the infringement, compensation for their damages and loss of profit, and reimbursement for their expenses.

Unregistered designs

Unregistered designs that were released first in Turkey are protected for three years as of their first release date, provided that they are novel, distinctive and producible via industrial means.

Such restricted protection is enforceable against third parties only when an infringement is intentional. As such, clear bad faith ("certain intent to copy") is required to bring claims against a third party using an unregistered design without authorisation.

Certain intent to copy an unregistered design can be proved with solid evidence of intent or the infringer's ability to be aware of the release of the unregistered design in the market. Use of trademarks, promotional materials or any other type of work belonging to the owner of the unregistered design in marketing the product constitutes solid evidence of the infringer's "certain intent to copy" the design. Moreover, being a competitor in the same industry is considered sufficient proof that the infringer could have been aware of the release of the unregistered design in the market.

In case of infringement of an unregistered design, rights holders can apply to the Civil IP Courts of First Instance to claim termination of the infringement, compensation for any damages and loss of profit, and reimbursement for their expenses.

Trademark protection for designs

A design may benefit from wider and indefinite trademark protection in accordance with the cumulative protection principle provided that it is demonstrable in the registry and meets the registrability criteria of trademarks. However, in practice, applicants must overcome formidable obstacles to acquire this cumulative protection.

Article 5 of the IP Law rules that signs "designating kind, type, characteristics, quality, quantity, intended purpose, value, geographical origin of the products" and "consisting exclusively of the shape resulting from nature of the goods or being mandatory to obtain a technical result or to give substantial value to the goods" cannot be registered as trademarks.

Since the TPTO applies this article in the strictest possible way, it tends not to grant cumulative protection even to the designs that deserve it the most. In a recent TPTO Re-Examination and Evaluation Board decision, a trademark application filed for the 3D shape of a unique and famous footwear design, which has been available in the Turkish market for many years, was rejected on the grounds that the shape resulted "from the nature of the related product". The appeal arguments based on the unique and distinctive characteristics of the 3D shape, its reputation and the distinctiveness acquired through extensive use and promotion were also rejected.

Such a strict approach, which blocks industrial designs from enjoying cumulative protection, could be defeated by combining the design with an additional element such as a word or a logo, but this would seemingly limit or even destroy the benefits of cumulative protection.



Unfair competition

Deceptive and dishonest acts affecting the business relationships between competitors, suppliers and customers are recognised as unfair competition.

A party that is exposed to unfair competition is entitled to apply to the Civil IP Courts of First Instance to claim termination of the unlawful acts, compensation for any damages and loss of profit, and reimbursement for its expenses, as well as to Criminal IP Courts of First Instance to have the defendant penalised through imprisonment and/or a judicial fine.

Infringement of registered and unregistered designs may constitute unfair competition against the rights holder under specific conditions.

During the design protection period (three years for unregistered designs and up to 25 years for registered designs), incidental protection against unfair competition resulting from design infringement also arises; this then becomes much stricter after the expiration of such period. Unfair competition can be claimed against design infringement taking place during the protection period only if it can be proved that such actions may also harm fair competition between the parties.

It becomes much harder to claim unfair competition once the design protection period has expired or if the registration is lost due to non-renewal. In such cases, the rights holder must prove that there is clear bad faith and an intent to copy on the part of the infringer.

Designs that are not registered and do not meet the conditions of unregistered design protection cannot be protected under unfair competition rules. However, iconic designs that do not meet these conditions but are recognised and identified with their owners thanks to long-lasting availability and fame in the market are protected against unfair competition, provided that the copying behaviour grants unfair benefits to the infringers due to the reputation of the original design, harms the distinctiveness of the original design or causes damages to the rights holder.

The outcast: spare parts

Spare parts are removable parts of a product that can replace original parts



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in cases of wear, abrasion or impact. The spare-parts industry is the most striking area in design law, since rights holders face numerous exceptions limiting their ability to benefit from design protection.

Having restricted protection in terms of Turkish design rules, spare parts cannot benefit from cumulative protection (eg, trademark and unfair competition) in practice, either. Instead, they may only benefit from design protection under exceptional conditions.

Functionally independent spare parts

If a spare part does not depend on the appearance of the composite product, but is functionally independent from it, it can be registered and can benefit from design protection for up to 25 years. Interior mirrors, steering wheels and seats do not depend on the overall appearance of a vehicle and are classified under this group.

Invisible spare parts

Invisible parts of designs are not protected under Article 56/2 of the IP Law, regardless of how unique they are and whether they meet the novelty and distinctiveness criteria. The Supreme Court has ruled that the 'chassis profile' of bus seats, which cannot be seen during ordinary use of the composite design, is not protectable itself as a design even though it is highly distinctive.

Must-fit spare parts

Again, regardless of how novel or distinctive they are, spare parts that



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must be manufactured to a certain size and shape due to their technical features cannot be protected as a design under Article 58/4 of the IP Law. The Supreme Court has ruled that tyre studs on automobiles are must-fit spare parts and a typical example of non-protectable designs in Turkish practice.

Must-match spare parts

Under Article 59/4 of the IP Law, spare parts of which designs depend on the general appearance of the composite product and which are related to aesthetic concerns, rather than technical necessity, can be protected for three years as of their first release date to the public anywhere in the world. After three years they are then free to be manufactured by third parties without limitation.

However, must-match spare parts that also feature in the equivalent parts list of the Turkish Science, Industry and Technology Ministry cannot benefit from such limited protection and can be manufactured freely by third parties.

The exceptional protection possibility for spare parts negatively affects various industries, but the worst affected are automotive and vehicle, and machinery industries. While no critical or effective change is expected to take place in practice, original spare-part manufacturers will keep seeking alternative solutions to protect themselves against low-quality sub-industry products. **WTR**