

client alert

INTELLECTUAL PROPERTY | TURKEY |

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PATENT AND UTILITY MODEL REGULATION UNDER NEW INDUSTRIAL PROPERTY LAW

As announced in our previous newsletter, the new Industrial Property Law No. 6769 (the “**IP Law**”), came into effect by repealing Decree Law No. 556 on the Protection of Trademarks, Decree Law No. 551 on the Protection of Patents and Utility Models (the “**Decree Law**”), Decree Law No. 554 on the Protection of Industrial Designs, and Decree Law No. 555 on the Protection of Geographical Indications (they will hereinafter be jointly referred to as the “**Decree Laws**”).

In our previous Client Alert, we informed you of new developments in relation to Trademark Protection. This Client Alert focuses on changes in relation to patents and utility models. Our next issue will review industrial designs, as impacted by the new IP Law.

Most provisions of the Decree Laws have been upheld in the IP Law, with some amendments as described below. The following sections cover the main changes that came into force with the new IP Law in relation to the protection of patents and utility models.

POST-GRANT OPPOSITION SYSTEM

Under the abolished Decree Laws, third parties did not have a right to file opposition further to its publication, but had to file nullity action before IP Courts. The new IP Law now allows for opposition to be filed against a granted patent within six months from its publication in the official TPI patent bulletin. Where an opposition is filed, the applicant will have the right to file a response or amend the patent application. Where an amendment or opposition is filed by the patentee, proceedings will be led by the TPI board.

EXAMINED PATENT SYSTEM & REMOVAL OF SHORT-TERM (SEVEN-YEAR) PATENTS

The new IP Law has removed the unexamined patent system. Accordingly, the seven-year short-term patent is no longer applicable. From now on, any novelties or specialities of an invention will be examined by the TPI.

UNIVERSITY EMPLOYEE INVENTIONS

According to the new IP Law, universities will have power of disposition on the inventions of scientific staff within the University organisation. The inventor must inform the higher education institution in writing, without delay, and the University must make a patent application if it requests a right on the invention. The invention will otherwise be accepted as a free invention.

CRIMINAL REMEDIES

Conversely to the articles for trademark protection, the new IP Law remains silent as regards criminal sanctions for patent infringements. Civil remedies are applied with the common provisions covering patents, and criminal provisions are therefore not regulated for patents.

SENDING NOTICE BEFORE FILING DECLARATORY ACTION IS NO LONGER COMPULSORY

The wording of the appropriate articles rendered the Decree Laws open to different interpretations by IP Courts in relation to the necessity of sending a notice to the patent owner before filing an action for declaratory judgement of non-infringement. Some courts were thus requesting such a notice letter as a pre-requisite of the action. The new IP Law has removed all doubt by clearly stating that the notice letter is not compulsory.

BURDEN OF PROOF FOR PROCESS PATENTS

Under the Decree Laws, IP Courts had different interpretations as regards the burden of proof within process patent infringement matters. The wording of the new IP Law is clear and provides that the burden of proof lies with the defendant where a new product is created by the infringed patent process. In contrary situations, the burden of proof continues to lie with the claimant.

SECOND MEDICAL USE PATENTS

Although the new IP Law brings about some changes and developments in relation to patent protection, second medical use is not one of them. In Turkey, second medical use is protected by some courts in application of the European Patent Convention, but the new IP Law does not regulate the patentability of second medical use. The lack of such clarification creates serious problems when some Courts do not accept the second medical use claims granted by the EPO if they were registered before the EPC came into force. Considering the reaction of the industry, we may assume that discussions pertaining to second medical use will continue for some time.

EXPANSION OF COMPULSORY LICENSING PROVISIONS

Conditions for compulsory licence are broadened under the new IP Law. Under the Decree Laws, non-use of patent, public interest and dependency of patents were requested for a compulsory licence. The new IP Law adds the following conditions:

- export of pharmaceutical products to cover public health issues in other countries if they meet the conditions set out in the Protocol amending the Convention on Trade Related Intellectual Property Rights,
- the need for plant breeders to develop a new plant variety, where such development is not possible without infringing a previous patent,
- the patent holder's anticompetitive, destructive or restrictive activities while using the patent.

CHANGES TO THE UTILITY MODEL SYSTEM

Although post-grant opposition is still not possible for utility models under the new IP Law, one of the most important changes is the introduction of compulsory novelty search. Applicants are also able to amend their application during the registration process.

Additionally, the following inventions can no longer be considered as utility models:

- biotechnological inventions;
- inventions relating to chemical and biological substances or chemical and biological processes or products obtained therefrom;
- inventions relating to pharmaceutical substances or pharmaceutical processes or products obtained therefrom;
- inventions relating to processes or products obtained from these processes.

In compliance with Turkish bar regulations, information relating to Turkish law matters which are included in this client alert are given by Özdirekcan Dündar Şenocak Avukatlık Ortaklığı, a Turkish law firm acting as correspondent firm of Gide Loyrette Nouel in Turkey.

CONTACTS

ESRA DÜNDAR LOISEAU
dundar@odsavukatlik.com

ARZU BEKEM
bekem@odsavukatlik.com

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