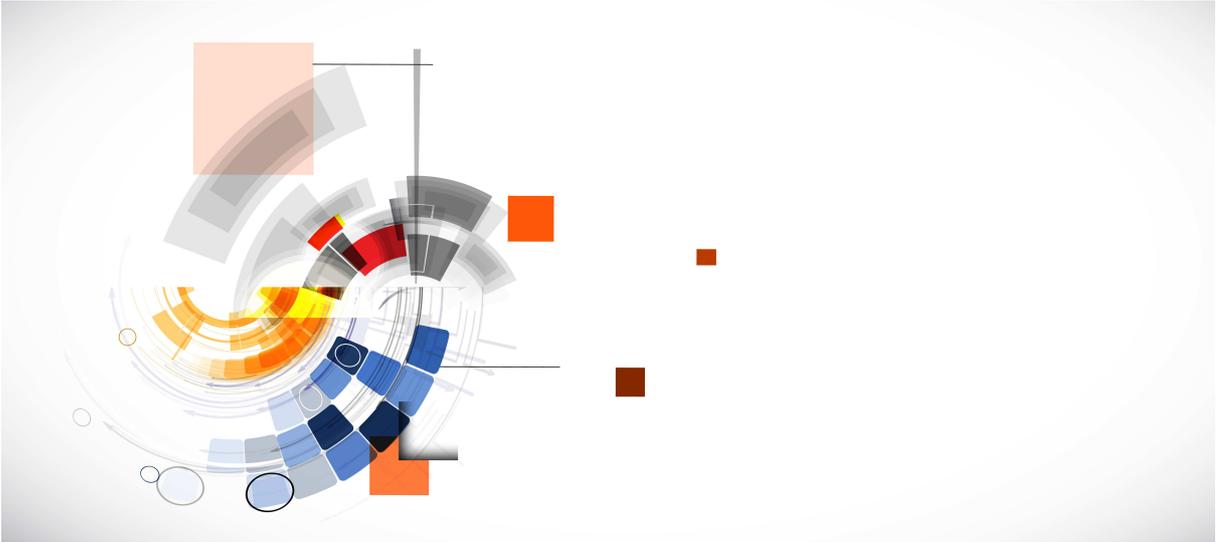


IP Rights- News (*)

Registered IP Rights – No Longer a Valid Defense Against Infringement Claims

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(*) Turkey's new Draft IP Law is before the Parliament

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Current Legislation

The Decree Laws No. 556 for Trademarks and 554 for Industrial Design does not have any provision in this respect whereas the Decree Law No. 551 for Patents, regulates this matter under the heading of “*Effects of Patents of Prior Date*” in Article 78, by stating that the holder of a Patent, cannot invoke the Patent registration in his defense in infringement actions instituted against him based on other Patents that have an earlier date of priority.

Proposed Changes by the Draft IP Law

Article 155 of the Draft states that, the owner of a Trademark, Patent or Industrial Design right cannot invoke these Industrial registration rights as a defense against an infringement action filed by parties, who own a prior right or prior application date.

Comment

Although the Decree Law No. 556 or 554 did not include any regulation in this matter, according to the well established Supreme Court decisions, it was accepted that the Trademark and Industrial Design rights which have been successfully registered before the Turkish Patent Institute would constitute a legitimate right against an infringement claim unless the registered right is cancelled and removed from the Registry. Such case law, caused the preliminary and the permanent injunction requests to be delayed or rejected until the cancellation of the infringer’s trademark or the design right.

The only exception this case law was a relatively recent Supreme Court decision, ruling that the registered Industrial Design right should not constitute a legitimate ground for use, if the registration has been filed in bad-faith.

The Draft IP Law, now aims to codify a common provision by which the registered Trademarks, Patents and Industrial Design registration rights to not constitute a legitimate defense against any infringement claim brought by the owner of the earlier IP right. The provision will evidently require an intensive clearance search – *even in the existence of a registration*- before utilizing any IP right.