

International report - Patent and utility model prosecution under the new Industrial Property Law

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The Industrial Property Law came in force on January 10 2017. It introduces new provisions to encourage filing national applications before the Turkish Patent and Trademark Office (TPTO) by setting out a standardised procedure which can be completed in a shorter time.

The new law reduces the number of requirements for filing an application to make it easier to obtain a filing date. Under the new regime, a request for a patent or utility model which includes the applicant's identity and contact information, along with a description or reference to an earlier application, is sufficient. The abstract, claims, figures (if any) and fee for filing the application can be submitted without further notification within two months; the description can also be amended within the same two-month period. To speed up the granting procedure, the search request must be filed within 12 months from the filing date or at the time of filing by paying the search fee without notification.

The so-called 'non-examined' patent system, which allows patents to be granted without a substantive examination for a protection period of seven years, has been removed entirely – such patents were widely considered abusive.

The substantive examination procedure for patent applications before the TPTO has also been modified, with the new law providing only one examination report instead of the three established by the previous system. In addition, the patent applicant and examiner are limited to only three communications. In terms of procedure, an applicant need request examination only once by paying an examination fee. It also has the right to submit an opinion in response to the examiner's assessment – which is notified to the applicant as a first communication – and can amend the application provided that it does not exceed its scope. An applicant's replies to the examiner's assessment give it the opportunity to explain its invention in further detail and negotiate. The application will be granted or rejected based on the examiner's decision, which will then be published in the *Official Patent Bulletin*.

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The applicant's rights are supported by provisions which establish further processing and re-establishment of rights in case of any non-compliance with deadlines during procedures. The vast majority of non-compliance results from the late payment of annuity fees. Article 101(4) of the new law thus establishes a compensation fee which applicants or right holders who have failed to pay an annuity fee can pay to revive their application or patent. Rights holders have a six-month grace period in which to make this late payment, along with a surcharge. If the fee is still not paid within this time, the patent right is terminated and the decision published in the *Official Patent Bulletin*.

Another major change relates to annuity fees, with the payment of renewal fees now falling due in the third year, instead of the second, and then each subsequent year. In line with this, the Industrial Property Law also sets out the continuation of suspended procedures. Under this, the applicant must submit a request for continuation within two months of being notified of the consequences of non-compliance, with a deadline established once the necessary fee has been paid. If such a request is accepted, the legal consequences of non-compliance with the deadline will no longer apply. Provided that an applicant fully complies with all the conditions of the application procedure, it is still possible to file a request to re-establish rights should the application be rejected or considered withdrawn or the patent be considered invalid or any other loss of rights due to not meeting deadlines. Such a request must be filed within two months of removal of the obstacle causing the non-compliance and at the latest within one year after the initial failed deadline along with payment of a fee. If such a request is approved, then the legal consequences arising from not obeying to the deadlines are considered inapplicable.

The new Article 99 introduces a post-grant opposition system, according to which third parties can oppose a patent within six months of publication of the grant decision in the bulletin. The scope of objections can include:

- lack of patentability criteria according to Articles 82 and 83;
- lack of sufficient information about the invention with respect to Articles 92(1) to (3); and
- that the patent exceeds the scope of the initial application.

If any third party files an opposition, the patentee is notified and allowed to amend the patent after grant and state its opinion within three months of the objection's notification date. Oppositions are examined by the board in view of the patentee's submissions and amendments, if any. If the board decides that the patent conforms with the Industrial Property Law in its current or amended state, it will be maintained. However, if it decides otherwise then the patent will be declared null and void, which has a retroactive effect.

Last but not least, when it comes to utility model applications the new Industrial Property Law introduces another important amendment with regard to prosecution, which now obliges a novelty search for grant. This new provision strengthens the content of utility model applications and prevents arbitrary filings. There is no post-grant opposition system for utility models.

The new law aims to provide a prosecution system with improved standards in terms of applicants' rights – almost parallel to procedures before the European Patent Office – and fulfils a long-term need for legislation enacted by Parliament. However, there are already indications that the examination procedure still needs further improvements given that examiner notifications are limited to three and the limits on the patent once the procedure before TPTO is completed (ie, in case of an invalidation action) are still not defined in the new law.

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