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2016 – Study Question (Designs)

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Requirements for protection of designs

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I. Current law and practice

1) Does your Group's current law provide for an intellectual property right (registered or patented) that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

As set out in the Study Guidelines, copyrights and trademarks are not such rights in the context of this Study Question.

yes

Please explain:

2) If yes, what is this right called? (e.g. registered design, design patent, industrial design, industrial design patent)

References to design below are to be read as references to this right, irrespective of what it is called in your jurisdiction.

Industrial Design

3) What are the statutory requirements for such right? Please tick any relevant boxes and explain the basis and application of these requirements.

a) novelty

Yes

b) non-obviousness

c) inventive step

d) individual character

Yes

e) originality

f) aesthetic

g) ornamental

h) other, namely ...

4) Does your Group's current law deny design protection to a design with an appearance that is dictated solely by its function?

yes

Please explain:

5) If yes, what are the relevant factors to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

Functional designs that do not offer any alternative on design related features and elements to designer may not benefit from design protection.

b) whether each portion of the overall appearance is dictated solely by its technical function

According to the current Turkish Law, parts which are in mandatory form and dimension with no alternative appearances are also kept out of protection scope.

c) the availability of alternative appearances that can obtain the same functional result

According to current Turkish law, if it offers freedom to the designer, then alternative appearances that can obtain the same functional result can be protected.

d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

Yes

e) other, namely ...

6) Does your Group's current law deny design protection to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

yes

Please explain:

7) If yes, what are the relevant factors to determine whether or not a portion is deemed functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

Yes

b) the availability of alternative appearances for the portion to obtain the same functional result

Yes

c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

Yes

d) other, namely ...

8) What is the effect on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

If the design of a product only leaves partial option, it is deemed that product design shall benefit from protection; but the part that does not leave any freedom of option to designer shall not constitute basis for allegations of infringement by itself.

b) any portions deemed functional will not be taken into account when assessing validity

If the design of a product only leaves limited options, it is deemed that product design shall benefit from protection; but the part that does not leave any freedom of option to designer shall not constitute basis for allegations of invalidity by itself.

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

While breach evaluation is made, it shall be examined if overall impression of a design on informed user is similar to overall impression created by the previous one, detailed evaluation shall not be made.

Contribution of functional elements included in such design which are kept out of protection scope may be considered on general view.

- d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison

Contribution of functional parts which are included in the design however left out of the scope of protection on the general impression may be considered in validity evaluation.

- e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

- f) the Group's current law is unsettled

- g) other, namely ...

II. Policy considerations and possible improvements to your current law

- 9) How can the following aspects of your Group's current law be improved, if at all?

- a) the definition or meaning of a "design"

Legally, what should be understood from design is product appearance. In draft IP Code, design is described as appearance of all or a part of a product or decoration on it arising from features such as line, figure, form, colour, material or surface tissue.

- b) the requirements for protection of a design

None.

- c) the treatment of functionality in the sense described in paragraph 14) of the Study Guidelines or aspects of such functionality

Functionality should be described clearly at the legislation and its relation between overall impression and degree of the freedom of the designer should be evaluated through case law.

- 10) Are there any other policy considerations and/or proposals for improvement to your current law falling within the scope of this Study Question?

yes

Please explain:

Turkey's Ministry of Science, Industry and Technology circulated a draft IP Code for the opinions of the relevant stakeholders. With this new IP Code that is being discussed, the Turkish Decree-Laws on Trademarks, Patents, Industrial Designs and Geographical Indications have all been consolidated and the draft IP Code amended many provisions thereof in some quite major aspects.

It is seen that in the new draft IP Code, the right is called “design” only, not the “industrial design” as it is used in our current Decree-Law.

III. Proposals for harmonisation

- 11) Does your Group consider that harmonisation in the three areas in question 9) above is desirable?
- If yes to some but not all of those three areas, please state in relation to which of the areas your Group considers harmonisation is desirable.
- If yes in relation to any of those areas, please respond to the following questions without regard to your Group's current law.
- Even if no in relation to any of those areas, please address the following questions to the extent your Group considers your Group's current law could be improved.

yes

Please explain:

- 12) Should there be harmonisation of the definition of an intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

yes

Please explain:

- 13) If so, what should that right be called?

Design.

- 14) What should the requirements for such right be? Please tick any relevant boxes and explain the basis and application of these requirements:

a) novelty

Yes

b) non-obviousness

c) inventive step

d) individual character

Yes

e) originality

f) aesthetic

g) ornamental

h) other, namely ...

15) Should design protection be denied to a design with an appearance that is dictated solely by its function?

yes

Please explain:

If function of a product shapes the product imperatively, it does not leave any option to the designer. Since design with lack of novelty and individual character will emerge, appearance of that product shouldn't be protected with design registration. If design emerges with lack of options rather than talent of designer, such design should be kept out of protection scope.

16) If yes, what should the relevant factors be to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

Yes

b) whether each portion of the overall appearance is dictated solely by its technical function

Yes

c) the availability of alternative appearances that can obtain the same functional result

If there is an alternative appearance to any portion of the overall appearance, we cannot claim that it does not leave any freedom to the designer in developing the design. Thus, if a design that is deemed functional leaves freedom to the designer, it can be protected.

d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

Yes

e) other, namely ...

17) Should design protection be denied to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

yes

Please explain:

18) If yes, what should the relevant factors be to determine whether a portion of a design is functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

Yes

b) the availability of alternative appearances for the portion to obtain the same functional result

Yes, if this leaves degree of freedom to designer in developing the design, benefiting from protection may be possible.

c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

Yes

d) other, namely ...

19) What should the effect be on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

Yes

b) any portions deemed functional will not be taken into account when assessing validity

Yes

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

Yes

d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison

Yes

e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

f) the Group's current law is unsettled

g) other, namely ...

20) If your answer to question 11) is no, is it your Group's view that a (registered or patented) intellectual

property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture should not be available at all?

21) If yes, why?

22) If your answer to question 11) is no in relation to some but not all of the three areas set out in question 9) above, please state why your Group does not consider that harmonisation in that area(s) is desirable.

23) Please comment on any additional issues concerning any aspect of the definition and requirements for protection of designs, or the role of functionality, you consider relevant to this Study Question.

We don't have any additional issues to discuss concerning the definition and requirements of designs or the role of functionality, however we do believe that the issue of "invisible designs" that is closely linked to functionality should be addressed as a separate Study Question.

According to the current Decree Law No.554 in Turkey, there is no clarity whether a design that cannot be seen at the time of normal use remains beyond the scope of protection. According to the draft IP Code, it is provisioned that complex product parts in normal use should be visible and its visible features should meet the requirements of novelty and individual character. It is clearly indicated that "normal use" that is mentioned in the relevant article, denotes use by the end-user.

However, the end-user of invisible designs of the complex products is not the end consumer; the end-user is the person who buys the product that is designed from manufacturer, sells or assembles it. In this respect, it should be reconsidered the definition of "end-user" for designs having characteristics of intermediate products in question.

Please indicate which industry sector views are included in part "**III. Proposals for harmonization**" of this form:

IP firms, University, Home Appliance

Summary

The current law in Turkey in relation to registration of designs deny design protection to designs which results from a technical function and which does not leave to designer any freedom with regard to the characteristics and elements of that design. The conditions which determine that a design is not capable to benefit design protection because of technical function are: the overall appearance dictated solely by its technical function, each portion of the overall appearance dictated solely by its technical function, and the existence of elements, such as compulsory shape and size, which does not leave to designer any freedom.

Turkish Group is of the opinion that design which is created as a result of unavailability of alternative appearances should not be provided protection, and that the current Turkish Law serves this purpose and it is in compliance with design registration procedures of European Union

Turkish Group believes that "non-visible designs" which have links to functionality should be separately studied as a new subject matter of a Study Question.

Yet, the draft IP Code in Turkey requires that the part of a product must be visible in "normal use" in order to benefit from design protection. The "normal use" in the relevant provision is also explained as

“use by end the user” of the complex product. However, “end user” of a non-visible part is not the end user of the complex product but the end user of the part itself. Therefore, the definition of “end user” should be reconsidered in relation to such intermediate products.