

ASSESSMENT OF NOVELTY AND
DISTINCTIVE CHARACTER
IN INDUSTRIAL DESIGN PROTECTION IN TURKEY

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**ASSESSMENT OF NOVELTY AND DISTINCTIVE CHARACTER IN
INDUSTRIAL DESIGN PROTECTION IN TURKEY**

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ABSTRACT

ASSESSMENT OF NOVELTY AND DISTINCTIVE CHARACTER IN INDUSTRIAL DESIGN PROTECTION IN TURKEY

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Novelty and distinctive character are the conditions of protection for a registered design in Turkey. This study investigates the ways in which novelty and distinctive character are interpreted and assessed by the parties actively involved in the assessment process –judges, court experts, the Turkish Patent Institute experts, attorneys and design agents. The face-to-face interviews conducted with 51 participants from the parties involved indicate that the assessment of distinctive character presents more challenges than the assessment of novelty. Not being exactly the same with a previous design is the main consideration in the assessment of novelty. The assessment of distinctive character is primarily identified with the comparison of designs' overall impressions whereas designer's degree of freedom remains as the least mentioned consideration. The study suggests that being subject to protection of designs not fulfilling the conditions of protection coupled with the uncertainties in the assessment of novelty and distinctive character, which may have a negative impact on the public trust in the design registration system. The study concludes with a set of suggestions for developing an assessment guide for the design registration system in Turkey.

Keywords: Legal protection of designs, industrial design registration, novelty, distinctive character.

ÖZ

TÜRKİYE’DE ENDÜSTRİYEL TASARIM TESCİLİNDE YENİLİK VE AYIRT EDİCİ NİTELİK DEĞERLENDİRMESİ

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Türkiye’de tescilli bir tasarımın koruma şartları yenilik ve ayırt edici niteliklidir. Bu çalışma, yenilik ve ayırt edici niteliğin, değerlendirme sürecine etkin olarak katılan taraflarca – hakimler, bilirkişiler, Türk Patent Enstitüsü’nde görev yapan uzmanlar, avukatlar ve vekiller– nasıl yorumlandığını ve değerlendirildiğini araştırmaktadır. Söz konusu tarafların dahil edildiği 51 katılımcı ile gerçekleştirilen yüz yüze görüşmeler, ayırt edici nitelik değerlendirmesinin, yenilik değerlendirmesine kıyasla daha fazla zorluk içerdiğini göstermektedir. Önceki bir tasarımın bire bir aynısı olmamak, yenilik değerlendirmesinin en önemli unsuru olarak görülmüştür. Ayırt edici nitelik değerlendirmesi öncelikle, tasarımların genel izlenimlerinin karşılaştırılması ile ilişkilendirilmiş; tasarımcının seçenek özgürlüğü bu değerlendirmede en az değinilen unsur olmuştur. Araştırma, koruma şartlarını sağlamayan tasarımların korumaya konu olması ile yenilik ve ayırt edici nitelik değerlendirmesindeki belirsizliklerin, tasarım tescil sistemine duyulan güveni olumsuz yönde etkileyebileceğini göstermektedir. Çalışma, Türkiye’deki tescil sistemi için geliştirilecek bir değerlendirme kılavuzuna yönelik önerilerle sonlanmaktadır.

Anahtar Kelimeler: Tasarımların korunması, endüstriyel tasarım tescili, yenilik, ayırt edici nitelik.

“to all my grandparents...”

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LIST OF ABBREVIATIONS

ALRC – Australian Law Reform Commission

EC – European Council

ETMK – Endüstriyel Tasarımcılar Meslek Kuruluşu (Industrial Designers Society of Turkey)

EU – European Union

ICSID – International Council of Societies of Industrial Design

ILO – International Law Office

IPRs – Intellectual Property Rights

MPI – Max Planck Institute

OAMI – see OHIM

OHIM – The Office of Harmonization for the Internal Market

RCD – Registered Community Design

TPI – Turkish Patent Institute

TRIPs – Trade Related Aspects of Intellectual Property Rights

UCD – Unregistered Community Design

WIPO – World Intellectual Property Organization

WOS – Web of Science

WTO – World Trade Organization

YÖK – Yükseköğretim Kurulu

CHAPTER 1

INTRODUCTION

1.1 Motivation

As the world economy has become more global towards the end of the 20th century, protection of intellectual property rights has gained a special importance for the free movement of goods. Intellectual property, in its simplest form, can involve whatever a person creates using his/her intellect. The Convention Establishing the World Intellectual Property Organization (1967) provides a list of the subject matter protected by intellectual property rights (WIPO 2011):

- literary, artistic and scientific works
- performances of performing artists, phonograms, and broadcasts
- inventions in all fields of human endeavour
- scientific discoveries
- industrial designs
- trademarks, service marks, and commercial names and designations
- protection against unfair competition
- all other rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields.

The subject matter listed above is generally organized into two categories: Copyright and industrial property. Copyright refers to the rights related to artistic and literary works whereas industrial property primarily refers to inventions, trademarks and industrial designs.

Designs are intellectual outputs embodying both artistic and technical qualities, and cannot be treated as possessing purely technical or purely artistic aspects. In other words, it is not sufficient to assess designs focusing only on technical or artistic criteria. Therefore, assessment of designs presents different challenges in comparison to other types of intellectual property such as inventions, trademarks or artistic works.

Currently, the Turkish Patent Institute (TPI) is the authority responsible for the registration of industrial property in Turkey. Registered designs are protected in accordance with the Decree-Law no 554 which put into force in 1995. According to the Decree-Law, “novelty” and “distinctive character” are the conditions of protection for a registered design. In other words, a design is protected as a registered design only if it is new and if it has distinctive character. The design registration system in Turkey does not involve an examination regarding the conditions of protection; it involves a formal examination and publication-opposition process managed by TPI. Thus, the registration-without-examination system may sometimes be abused by infringers. A design may get registered although it does not meet the conditions of protection, or an infringement claim may be raised. In such cases, the parties in disagreement may file an opposition to registration with TPI, or may file an invalidity case with the specialized courts. An assessment of novelty and distinctive character is made when either of these situations occurs. Consequently, when an opposition is filed, the claims and evidence concerning the novelty and individual character are usually presented by the agents, and the decision is taken by the experts working at TPI, or when an invalidity case filed, judges, court experts and attorneys are involved in the assessment of disputed designs. Considering that the parties involved in the assessment process are from different backgrounds, and represent different roles and interests, the conditions of protection (novelty and distinctive character) may not always be interpreted and assessed in the same manner by all the parties; this observation, as well as the subjective aspects involved in the assessment, constituted the starting points of this study.

1.2 Aim, scope and research questions

The aim of this study is to investigate the ways in which novelty and distinctive character are interpreted and assessed by the parties actively involved in the assessment process –judges, court experts, the TPI experts, attorneys and design agents– in the context of design registration system in Turkey. The research questions identified for the study are as follows:

- How is the assessment of “novelty” and “distinctive character” made?
- Which considerations are taken into account in the assessment of “novelty” and “distinctive character”?
- What are the challenges and difficulties faced in the assessment of “novelty” and “distinctive character”?
- What are the similarities and differences among the assessment perspectives of the parties involved?
- Considering the similarities and differences among the assessment perspectives, what is the relevance of a common guideline or some guiding principles to the assessment process?

1.3 Structure of the thesis

This study consists of five chapters, with the inclusion of two main chapters based on a literature survey and a field study.

In the introductory chapter, the reasons for undertaking this study were explained. The aim of the study and the questions that the thesis tries to find answers were also noted. Besides, the definitions of the significant terms which used in the thesis were given.

The second chapter involves a literature survey, which forms the basis of the field study. In the first part of this chapter, the literature search strategies are explained. In the latter part, design protection systems in some foreign countries and in Turkey

were explained. In the next part, the assessment processes of novelty and distinctive character were explained in terms of current practices in Turkey.

The field study was undertaken in the third chapter. In the first part of this chapter, the methodology was explained. Data collection and analysis processes were brought out in the latter parts.

Chapter four presented the findings part, in which the results of the field study were mentioned and discussed.

In the last -concluding- chapter, the results of the field study were concluded and some suggestions were made for the framework of an assessment guide which may further be used for the assessment of novelty and distinctive character in industrial design registrations.

1.4 Significant terms used in the thesis

Design law is a relatively new field of study in Turkey, and some terms used in legal documents and regulations present challenges both at national and international levels. This section clarifies some uncertainties related to the terms significant for the whole study.

Abbreviated terms. The term “Decree-Law” will be used for the “Decree-Law No. 554 Pertaining to the Protection of Industrial Designs, in force as from June 27, 1995 (Turkey)”. In 1995 several decree-laws concerning the industrial property rights were put in force in Turkey as part of the preparations for the customs union between Turkey and the European Union (EU).

The term “Directive” will be used for the “Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs”.

The term “Regulation” will be used for the “Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs”.

Design. In this study, “industrial design” as an industrial property is the main subject. From a professional perspective, industrial design is an interdisciplinary field which involves many considerations including form, structure, function, durability, safety, usability and marketability of a product. In this study, the main concern will be “designs” in a legal sense, as defined in the Decree-Law. Thus, the term “design” shall generally be used for a design subject to protection.

Distinctive character. The term “distinctive character” refers to one of the conditions of protection, and is a quality whose existence is accepted when there is a significant difference between the overall impression that a design creates on the informed user and the overall impression created by a previous design. A similar quality is referred to as “individual character” in the EU Community Design Regulation¹. As it was mentioned before, the first specific legal regulation regarding the protection of industrial designs in Turkey has entered into force in 1995, when the EU Community Design Regulation was in draft form. As the term used in the EU draft regulation for expressing the above mentioned protection condition was “distinctive character”, it was this term and the definition in the draft which were adopted in the Decree-Law. The term was translated into Turkish as “*ayrı edici nitelik*”. Although later on a different term, “individual character” was adopted in the EU legislations (the Directive and the Regulation). No changes were made in the Decree-Law concerning the term or its definition.

In this study, the term “distinctive character” was preferred since it was considered to be reflecting the Turkish term “*ayrı edici nitelik*” and its slightly different definition better.

¹ Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs

CHAPTER 2

LITERATURE SURVEY

2.1 Literature survey strategy

This study investigates the assessment of novelty and distinctive character in industrial design registration in Turkey. For this purpose, a preliminary research about the subject in question was made. This was the first step towards the determination of the keywords for the literature survey.

As an initial resource, the classification of intellectual property rights was explored and some relevant keywords were selected from the terms involved. The keywords were searched in an hierarchical order from specific to general. The keywords and their searching combinations were as follows:

- Novelty
- Distinctive character
- Novelty + distinctive character
- Individual character (considering the terminological disunity)
- Novelty + individual character
- Industrial design
- Industrial design + registration
- Design protection
- Industrial property
- Intellectual property
- Intellectual property + rights
- Design

Searches within several resources were made by using these keywords. These resources are shown in Table 1.

Table 1 Principal resources utilized during the literature survey

Resources	Electronic resources	Search engines	Google Yahoo		
		E-databases	National	YÖK, METU, Bilkent Univesity, Hacettepe University	
			International	Proquest, Jstor, WOS, EBSCOhost, Science Direct, Wiley Interscience	
		Web sites	National	Turkish Republic Ministry of Justice, Courts, Administrations of Justice (Ankara and Istanbul), Turkish Patent Institute	
			International	ILO OHIM (OAMI) WIPO	
	Libraries	METU Bilkent University Hacettepe University TPI			
	Other resources	Court archives Expert reports Court decisions			

As it was mentioned before, a preliminary research was made in order to determine the key concepts and to conceive the legal process basically. In this first step, relevant books and the web sites of relevant institutions (national and international) such as TPI, OHIM and WIPO were reviewed. Search engines were also used in this step. After gathering particular information about the registration process and the

legal arrangements, the subject in question was explored in more detail by using the resources given in Table 1.

2.2 Design protection

Design legislations aim to protect the investment made on novelty, innovation and creativity. With the protection legislations, the distinctive character that is brought in the design is protected, not the product itself.

Anyon (2003, 7-8) states that “if the visual appearance of a product is a key selling point, a registered design is a shrewd investment”, and she adds:

“when considering patent, trade mark or design registration, a thorough search needs to be undertaken to uncover what is already in the marketplace. This should be carried out during the development of a product to prevent wasting time and money developing a product already in existence, or inadvertently giving a product a similar ‘look and feel’ to that of another”.

Also, the strictness threshold of the protection has been discussed for years. In other words, the appropriate mode and level of protection for (especially functional) industrial designs has been a matter of controversy (Carty and Hodkinson 1989, 374). According to Helpman (1993, 1249),

“supporters of tighter intellectual property rights (IPRs) in less developed countries employ the argument that lax IPRs reduce the innovative effort in developed countries and thereby hurt all countries that participate in the world's trading system”.

On the other hand, countries may differ in their capacities for innovation. Also, in open economies, the benefits of innovation may be expanded beyond national boundaries by international trade. Thus, a country would not reap all of the global benefits within its borders (Grossman and Lai 2004, 1635).

“In practical terms the distinguishing factor among nations in the protection of intellectual property rights will be in how they enforce those laws. The enforcement of intellectual property laws has been a critical issue, particularly in trade relations between developed and developing countries” (Ostergard 2000, 349).

Also, according to Reichman (1992, 283), lacking proper legal protection for industrial designs negatively influences the industries willing and able to strengthen their domestic and international competitiveness by risking substantial investment in design innovation.

“Intellectual property is inextricably linked with both the public interest and knowledge transfer. It has a role to play in fostering innovation, in protecting the public and in disseminating knowledge” (Hill-King 2007, 39).

2.2.1 Historical background

2.2.1.1 The history of design protection in reference protection systems

The protection of intellectual property was provided by concessions in the 15th and 16th centuries. The legal arrangements started to be used for this purpose in the 19th century, after the industrial revolution.

It has been known that the protection of intellectual property was first seen in Venice in 1443. The first patent law, which constituted the basis of today’s approaches, was put in force in Venice in the year 1474 (Suluk 2003, 97; Hill-King 2007, 35).

Another view was that the earliest English patent was granted in 1449 by Henry VI for 20 years to John of Utynam for the making of stained glass, which had not been practiced until that day, and required for the windows of Eton College (Hill-King 2007, 35).

Some other countries, including Great Britain, United States, France and Switzerland followed this system with national patent laws. In the late 1700s, Germany and some other European countries also put similar arrangements in force (Suluk 2003, 97).

Industrial design is a notion which is related with the industrial revolution, and the contemporary approach of industrial design coincides with the industrial revolution which occurred in England in the 1770s. Great reforms emerged in design field concurrently with the competition, the increasing number of innovations, mass production and with the changes in consumption patterns (Suluk 2003, 98). According to Hill-King (2007, 36), industrial designs in UK date back to 1787, after the introduction of powered cloth making equipment.

The design protection in actual meaning eventuated in the 19th century. The modern arrangements related with designs date back to 1806 in France, to 1839 and 1842 in England, to 1876 in Germany and to 1889 in Switzerland (Suthersanen 2000; Suluk 2003, 101).

In the latter part of the 19th Century, developments and international treaties that lay the foundations for convenient cross-border intellectual property rights came to the fore. Meanwhile, globalization began and urbanization of the population was underway (Hill-King 2007, 37).

The infringements, directed to the intellectual property rights without considering the local boundaries, have brought out the necessity of international protection. Thus, besides many agreements in other intellectual property rights, some international agreements concerning industrial designs were also accepted.

The Paris Convention –March 20, 1883- set out the agreement for international patent filings. Three years later, the Berne Convention for the Protection of Literary and Artistic Works -September 9, 1886- took place. Prior to the Berne convention a work copyrighted in one country could be freely copied and used in another (Hill-King 2007, 37). By the Berne Copyright Convention, contracting states were constituted into a union for the protection of the rights of authors (Carty and Hodkinson 1989, 369). Soon after, Madrid convention for the international registration of marks took place on April 14, 1891 (Hill-King 2007, 37).

Following these, Hague Agreement ² (1925) and Locarno Agreement (1968)³ for the classification of the products were constituted for international registration.

The Hague Agreement was put in force in 1928, and it has been revised several times. The Hague Agreement provides protection in a number of countries by a simple procedure, involving an application filed with WIPO or the national offices of member states. “The system bypasses the need to make individual applications in each country where protection is sought, avoiding disparate national procedures, renewal dates, currencies and language considerations” (Hering 2004, 12).

Also, certain types of industrial design, for instance, those with visual appeal, whose shape is not dictated solely by function, started to be capable of being registered under the Registered Designs Act 1949 in the United Kingdom (Carty and Hodgkinson 1989, 374).

“During the 1980s and early 1990s, the United States and several European countries expressed strong dissatisfaction with what they deemed to be inadequate protection of intellectual property in many developing countries” (Grossman and Lai 2004, 1635). The developed countries continued to work on the issue of protection of intellectual property rights during the Uruguay Round of trade talks in 1993, and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) was approved as part of the Final Act of the Uruguay Round (Grossman and Lai 2004, 1635).

The “Final Act” signed in Marrakesh in 1994 is like a cover note; and the Agreement Establishing the WTO (World Trade Organization) serves as an umbrella agreement. The TRIPS Agreement is the Annex 1C of the Marrakesh Agreement Establishing

² WIPO. (1925). *Hague Agreement Concerning the International Registration of Industrial Designs*.

³ WIPO. (1968). *Locarno Agreement Establishing an International Classification for Industrial Designs*, signed at Locarno on October 8.

the World Trade Organization, signed in Marrakesh, Morocco on 15 April 1994 (www.wto.org).

The emergence of the WTO Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPs)

“has revolutionized the conventional attributes of intellectual property rights (IPR) and triggered rapid evolution of the political ecology of the North–South relations. Since then, the IPR protection has been managed in an accelerated standardization process across the world, with developing nations being ardent participators” (Shi 2010, 455).

TRIPs establishes minimum standards of protection for several categories of intellectual property. For instance, in the area of new technology, it harmonizes patent policies by encouraging countries to grant patents to a broad class of innovations and to treat foreign and domestic applicants in the same way (Grossman and Lai 2004, 1635).

However, TRIPs adopts a universal standard of harmonization of intellectual property, but does not define standards and procedures to be followed on an ad hoc basis (Shi 2010, 455). Therefore, TRIPS Agreement standardizes intellectual property content and format; and facilitates dispute resolution (Hill-King 2007,32).

Max Planck Institute (MPI) made a suggestion for the Community Design in the year 1990. As a requirement of the Common Market, this topic had come up in 1991 with the Green Paper compiled by the Commission for the European Communities (Suluk 2002, 20).

The Commission brought out the proposals⁴ for the Directive and the Regulation. These proposals had two objectives: to provide a forceful legal protection for designs

⁴ *Proposal for a European Parliament and Council Directive on the Legal Protection of Designs (93/C 345/09)COM(93) 344 final-COD 464. (1993). and Proposal for a Regulation on Community Design. (1993).*

and to harmonize the arrangements related to designs in the Community. The Commission brought about a change in the proposal for the Directive in the year 1996⁵. Thus, the Council (European Council) stated its position related with the Directive in 1997⁶. Subsequently, the Directive was accepted in 1998. After several changes, the Regulation came into force in 2002. Today, both of these arrangements are in force with parallel judgements (Suluk 2002, 21).

With the Regulation on Community Designs dated 2002 in the Community Law, a new right type was constituted: *Community Design*. Community Design can be considered as a mile stone for the international protection of designs. With this enforcement, designs have started to be protected in all member countries.

However, the legislations of member countries differ in enforcement, and harmonisation actions were interrupted for a period of time. According to Miniotas (2005, 5), “harmonization of Design Law has been the slowest of the three⁷”. He interprets the cause of this delay as follows: “patent and trade mark legislations have been a priority over the design legislation in the early years of the Community and this is most likely to be the cause of the delay”.

Nevertheless, the Registered Community Design (RCD) in today’s structure, suggests a fast, efficient, and inexpensive way for designers and design-inventing industries trading in the European Union so as to protect their creations in the European market.

The European Commission adopted the Regulations which are required for the access of the European Community to the World Intellectual Property Organization’s (WIPO’s) Geneva Act of the Hague Agreement regarding the International Registration of Industrial Designs, (EC) No 2242/2002 and (EC) No 2246/2002 on July 24, 2007, and the accession eventuated on September 24, 2007. Dating from

⁵ Official Journal of the European Communities. (1996). v 145. 114.5.1996. COM(96) 66 final

⁶ Official Journal of the European Communities. (1997). v 237. 4.8.1997.

⁷ Patents, trademarks and designs

January 1, 2008, the applicants, by means of a single application, started to obtain protection of their designs throughout the EU -via the Community Design system- and in the countries that are member of the Geneva Act. Contracting parties of the Geneva Act can also have their designs protected under the European Union's RCD system (Beschorner 2009, 9).

Today, the applications and registration processes of Community Designs have been carried out by OHIM (The Office of Harmonization for the Internal Market), which was established in Alicante, Spain.

2.2.1.2 The history of design protection system in Turkey

The first national legislations concerning intellectual property rights were the Ottoman patent system, "*İhtirâ Beratı* (in Turkish)" (1879), (which was the sixth⁸ patent law in the world), and the trade mark regulation "*Alâmet-i Fârika Nizamnamesi* (in Turkish)" (1871) (Kala 2008, 15).

Turkish Law started to deal with the international protection of designs after the Paris Agreement (1883). Later, Ernst E. Hirsch conducted some studies on the legal protection of designs (Suluk 2003, 102), but the first legal arrangement regarding intellectual property in the history of Turkish Republic, "5846 sayılı Fikir ve Sanat Eserleri Kanunu" (in Turkish) entered into force in 1952.

First Turkish design legislation was arranged in the period of joining in the Customs Union, in order to be in accordance with the European Community legislations.

Almost no renewals were made on these systems in time, except for contracting some agreements such as TRIPs (Agreement on Trade Related Aspects of Intellectual Property Rights, Including Trade in Counterfeited Goods) and Locarno (Suluk 2003, 97).

⁸ Suluk 2003,97

In 1994, Turkish Patent Institute (*Türk Patent Enstitüsü*), which, at present, carries out the application and registration processes, was established within the structure of Republic of Turkey Ministry of Industry and Trade (*Türkiye Cumhuriyeti Sanayi ve Ticaret Bakanlığı*). Consequently, in Turkey, the first national arrangement, Decree-Law No. 554 Pertaining to the Protection of Industrial Designs, was put in force in 1995. In the same year, different decree-laws related to patents, trademarks and appellations of origin were put in force.

Several drafts were suggested for these Decree-Laws. The draft design law, which was prepared by Turkish Patent Institute was submitted to relevant foundations and institutions for agreement in May 2005, and the reviewed second draft was submitted to the agents of shareholders in January 2006 (Korkut et al. 2006, 384).

Industrial Designers Society of Turkey (ETMK) also made some additional suggestions about this draft. Encouragement of “novelty” was emphasized as well as creativity, and some important definitions like ‘design’, ‘product’ and ‘informed user’ were reviewed within the framework of the EC Directive and the Regulation (ETMK 2006).

Turkey, today, is party to many international agreements as shown in Table 2.

Table 2 The agreements to which Turkey is a party (TPI 2011)

Name	Establishment Date	Number of Parties	Last Developments and Participation
Convention Establishing World Intellectual Property Organization	1967	182	1976
Paris Convention for the Protection of Industrial Property	1883	169	Stockholm Act . Article (1/13) Since 1995.
Patent Cooperation Treaty (PCT)	1970	128	01.01.1996
Nice Agreement Concerning the International Classification of Goods and services for the Purposes of Registration of Marks	1957	76	01.01.1996
Vienna Agreement Concerning International Classification of the Figurative Elements of Marks	1973	20	01.01.1996
Strasbourg Agreement Concerning the International Patent Classification (IPC)	1971	55	01.10.1996
Budapest Agreement of the International Registration of the Deposit of Micro-Organisms for the Purposes of Patent Procedure	1977	61	30.11.1998
Locarno Agreement Establishing an International Classification for Industrial Designs	1968	45	30.11.1998
Protocol Relating to Madrid Agreement	1989	66	01.01.1999
The Hague Agreement Concerning the International Deposit of Industrial Designs (Geneva Act.)	1999	42	01.01.2005
Trademark Law Treaty (TLT)	1994	33	01.01.2005
European Patent Convention	1973	31	01.11.2000
Agreement Establishing World Trade Organization (WTO)	1995	148	26.03.1995

2.2.2 Current design protection system in Turkey within the context of reference protection systems

The classification of intellectual property which was made by WIPO is as follows:

a) Industrial property

- patents
- utility model
- trademarks
- industrial designs
- appellations of origin

b) Copyright

- scientific, literary, musical, artistic, photographic and cinematographic works etc.

As Anyon (2003, 7) explains, “design registration is used to protect the way a product looks. This is different to a patent as a patent protects the way a product works”.

It is possible to state that designs were neglected for a long time, within the framework of intellectual property rights. Today, the registered industrial designs are protected by the Decree-Law no 554 in Turkey, while they can also be protected internationally; for instance, as a Community Design.

The term “design” in a legal sense, has been defined in various legislations. For instance, the Directive⁹ defines design as

“the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation”.

The Turkish legislation (Decree-Law no 554), employs a similar definition, however, it provides a wider frame and uses the expression “features perceived by the human senses”¹⁰, instead of referring solely to appearance.

Here, it is necessary to emphasize the difference between the notions of “design” and “product”. In the Directive, “product” is defined as

“any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs”¹¹.

The Decree-Law also involves a similar definition.

⁹ DIRECTIVE 98/71/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 13 October 1998 on the legal protection of designs, Article 1/a

¹⁰ Decree-Law, Article 3/a

¹¹ Directive, Article 1/b

Thus, it is possible to state that *design* is applied to a *product*. Protection does not deal with the product itself, since the *design* of a product is the only quality to be protected by an industrial design registration.

ICSID (International Council of Societies of Industrial Design) makes a definition as follows:

“design is the central factor of innovative humanization of technologies and the crucial factor of cultural and economic exchange”, “the adjective ‘industrial’ put to design must be related to the term industry or in its meaning of sector of production or in its ancient meaning of ‘industrious activity’ ”.

WIPO defines industrial design as

“the ornamental or aesthetic aspect of an article”, and adds “to be protected under most national laws, an industrial design must appeal to the eye. This means that an industrial design is primarily of an aesthetic nature, and does not protect any technical features of the article to which it is applied”.

Various definitions of designs result in an overlap with other intellectual property laws, such as copyright, unfair competition, utility model and trademark laws. According to the EU design laws, *design* stands for any aspect of a product which promotes the marketability of that product, while TRIPs adopts both Paris and Berne positions and obliges Members to provide a minimum standard of protection without specifying the nature of protection (UNCTAD 2004, 323). Article 25.1 of the TRIPs Agreement provides the requirements for the protection of an *independently created* industrial design: being *new* or *original*.

Community Design Law requires two conditions in order to register a design as a Community Design: *novelty* and *individual character*. Thus, the assertions of novelty and individual (or distinctive) character are in relation to “design”, not “product”.

Designs, which are registered by OHIM, in accordance with the Regulation¹², are protected as Registered Community Designs. The designs, which meet the requirements of the Regulation, but are not being registered, are protected as Unregistered Community Designs.

The protection of an Unregistered Community Design (UCD) starts when the design is made available to the public. UCDs are protected for 3 years. “This type of protection was favoured by several industries where the lifespan of the products is relatively short and quantities of designed products are big” (Miniotas 2005, 8).

According to the Regulation, Registered Community Designs are protected for 5 years. This term is renewable for one or more periods of five years, up to 25 years. The holder of a Registered Community Design has the exclusive rights over the use of the design, in particular, making, offering, putting on the market, importing, exporting, using or stockpiling.

The law maker in the Community Law considers the design as a whole and takes up the Community geography as a single country. Community Design generates a *uniform effect* for the Community. In fact, according to the Article 27 of the Regulation, Community Design is considered as a national design in the Community, as a rule (Suluk 2002, 38).

As the Community Law constitutes the source of the protection system in Turkey, the designs which are *new* and which have *distinctive character*¹³ can be protected as Registered Industrial Designs, by the Decree-Law no 554, are now protected up to 25 years by the extension of 5 years periods; and the TPI (Turkish Patent Institute) is the institute which carries out the application and registration processes in Turkey.

¹² COUNCIL REGULATION (EC) No 6/2002 of 12 December 2001 on Community designs

¹³ this term is to be used instead of “individual character” throughout the study regarding the mentioned explanations in section 1.4

It is known that, there have been some guidelines developed by several organisations. For instance, OHIM presents three types of guidelines for the examination of Community designs, for the Proceedings relating to a declaration of invalidity of a registered Community design and for the Registered Community design renewals, which serve various parties. Similarly, Australia offers design manuals for examiners, including parts related to the formalities and examination process, in which, *newness* and *distinctiveness* are dealt.

Negotiations on intellectual property rights have been taking place between EU and Turkey since 2005. The idea of a guideline for industrial designs was concretely spoken first within the scope of the “Supporting Turkey for Enhancing Implementation and Enforcement of Industrial Property Rights Project”¹⁴ which has still been carried out by the German International Legal Cooperation Institute and in cooperation of Turkish Patent Institute; and the development progress of a design guideline is still in progress.

2.3 Assessment of novelty and distinctive character

2.3.1 Notions of novelty and distinctive character

Protection of designs has been one of the most debated questions within intellectual property rights. “Novelty” and “distinctive character” are the conditions of protection for an industrial design both in Turkey and in several international protection systems such as Community Design system, as it was mentioned before.

Novelty

In some legislations, *novelty* is considered as a threshold, in order for a design to be protected legally. Novelty requires a design not to be identical with the others, which have been made available to the public.

Max Planck Institute proposed the following definitions for ‘novelty’ and ‘distinctiveness’ in ALRC (Australian Law Reform Commission) (1995, 62):

¹⁴ details about this project is available at <http://www.tpe.gov.tr>

“An industrial design shall not be considered to be new if it was anticipated by the appearance of a product which, by publication or by public use, has been made accessible to interested business circles in the European Community before the relevant priority date. An industrial design is distinctive if it has an overall appearance which distinguishes it from any subject matter known at the relevant priority date by the different impression which it gives.”

The definitions of novelty bear resemblance in current legislations (Table 3).

Table 3 Definitions of novelty

Directive	“a design shall be considered new if no identical design has been made available to the public before the date of filing of the application for registration or, if priority is claimed, the date of priority” (Article 4)
Regulation	“a design shall be considered new if before the date of reference no identical design has been made available to the public” (Article 5)
Decree-Law (Turkey)	“a design shall be considered new if before the date of reference no identical design has been made available to the public in the world. Designs differing only in immaterial details shall be deemed to be identical. To make available to the public shall cover all actions of sale, use, publication, publicity, exhibiting, or such similar activities” (Article 6)

As it can be seen in Table 3, the most important aspect is being *not identical* with the former designs. The Decree-Law clarifies this assessment by providing an additional remark, “Designs differing only in immaterial details shall be deemed to be identical”.

Both the assessments of novelty and distinctive character are based on the comparison of designs. During the assessment, the similarities should be considered as well as differences. Besides, the designs might have been applied to different product categories; this may change the result of the assessment. Nonetheless, if a design is not new, it cannot have distinctive character.

Distinctive character

As it was cited in ALRC (1994), in one case¹⁵ it was said that,

¹⁵ Dart Industries Inc. & Anor v The Decor Corporation Pty Limited. (1989). AIPC 90-569. 38. 975.

“for a design to be protected there must be a special or distinctive appearance, something in the design which captures and appeals to the eye. To have that effect, the design must be noticeable and have some perceptible appearance of an individual character”.

In the light of the common definitions given in Table 4, we can say that the major concern is the *overall impression* of the design. The overall impression of the assessed design should be different from the others’ that have been made available to the public before.

Table 4 Definitions related to distinctive/individual character

Directive	“a design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing of the application for registration or, if priority is claimed, the date of priority. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration” (Article 5).
Regulation	“1. A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public: in the case of an unregistered Community design, before the date to which the design for which protection is claimed has first been made available to the public; in case of a registered Community design, before the date of filing the application for registration or, if a priority is claimed, the date of priority. 2. In assessing the individual character, the degree of freedom of the designer in developing the design shall be taken into consideration” (Article 6).
Decree-Law (Turkey)	a design shall be understood to have a distinctive character if the overall impression it creates on the informed user is significantly different from the overall impression created on the same user by any design referred to in the second paragraph of this Article (Article 7). In the second paragraph of Article 7, it is mentioned that; In order for any other design to be compared for the purposes of determining the distinctive character of a design; a) It should have been made public in Turkey or in the world before the application date. b) It should have been published by the Institute (TPI) as a registered design, and that the protection period has not expired at the application date of the design with which it shall be compared (Article 7).

As it was mentioned before, both the differences and the similarities should be taken into consideration in the assessment of novelty and distinctive character. The

existence of many differences does not always indicate a significant difference between the overall impressions. Also, there can be some similarities between the compared designs. This does not mean that there is no significant difference between the overall impressions.

As it was mentioned before, the Directive reveals how a design can have individual character. Relevant definitions in the Regulation¹⁶ also run parallel with the Directive:

“The assessment as to whether a design has individual character should be based on whether the overall impression produced on an informed user viewing the design clearly differs from that produced on him by the existing design corpus, taking into consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs and the degree of freedom of the designer in developing the design”.

The assessment of distinctive character particularly becomes important while evaluating a design which is not identical with a previous design, but creates a similar impression. Here, another important question is, ‘between which designs are we going to make a comparison?’. The legislation limits this frame by making out some cases (Korkut 1996, 31).

ALRC (1994, 65) proposed that a test was needed for ‘distinctiveness’ in addition to the test of novelty, and adds

“the expression ‘distinctive’ has been frequently used by the courts in design cases to express the quality that a design must have to sufficiently differentiate it from previously published or used designs. Distinctiveness as a test on its own might include novelty but the Commission believes that identical designs applied to slightly different products may create a different overall impression”.

Besides, in the same source, some key questions were determined for judging whether a design is distinctive. These four questions are:

¹⁶ Objective no. 14 on Article 5

- “Who is to assess distinctiveness?”
- “What is to be considered?”
- “What degree of difference from a previously known design must be exhibited by a registrable design?”
- “What geographic and temporal limitations are to apply?”

Miniotas (2002, 20) emphasizes the importance of individual character in Community Design protection, by quoting the remarks from the EC Green Papers;

“It is very important how the design is perceived in the market. Designs worthy protection should be recognized for their differences and individuality against any previously known design”,

and he connects the subject to “overall impression” (2002, 21);

“the product to which the design is applied or incorporated to must look different to the degree that it gives different overall impression. Therefore designs that have some differences but give similar overall impression shall not be protected”.

According to some discussions made on the “overall impression” in ALRC,

“‘impression’ is a word used in design law already. It is said, for example, that ‘first impressions’ are important in determining whether there is an infringement of a design”¹⁷, and “it is important to take account of the overall impression that a design creates since it clearly signals that minor or insignificant changes to a design are not relevant if the overall impression remains one of substantial or significant similarity”¹⁸.

Although the overall impression is one of the most important measures in the assessment, it is not that easy to find clear definitions related to this notion in the said legislations.

¹⁷ Wanem Pty Ltd v John Tekiela. (1990). 19 IPR 435, 440. summarising the decision in Dart Industries Inc v Decor Corp Pty Ltd. (1989). 15 IPR 403.

¹⁸ Lift Verkaufsgerate Gmbh v Ficher Plastics Pty Ltd. (1993). AIPC 91-015.

Informed user

In ALRC (1995, 59) it was mentioned that,

“the ‘eyes of relevant public’ is the second half of the test proposed in the EC Green Paper. There the design was assessed by the ordinary consumer”,

and a quotation was added from the Green Paper

“..at the level where the economic value of the design product is exploited, ie on the market, where purchasers are ordinary people, lacking the knowledge of the ‘skilled designer’” (ALRC 1995, 59).

Substantially, the assessment of novelty and distinctive character is made from the viewpoint of an informed user. ALRC quotes a discussion held in Brussels with European Union staff:

“an informed user knows the product to which the design is applied or in which it is incorporated, and the relevant trade or industry to which it belongs” (ALRC 1995, 59).

As it is emphasized in ALRC (1995, 59), in many cases, judges can be placed in the position of the person to assess distinctiveness. However, some submissions were made on this point. In one submission¹⁹ declared in ALRC, it was stated that

“ ‘new and original’ should be first judged in the eyes of the consumer, secondly from the expert’s point of view and the courts only as a last choice”.

Besides, ALRC rejects the “design expert” as an informed user (ALRC 1995, 71).

There have been many discussions made on the notion of “informed user”. As quoted from Horton (1995, 59) in ALRC,

“the informed user test has been criticised for being a subjective test, giving the impression that the ‘informed user’ assesses individual character only by reference to his or her own knowledge”.

However, in a discussion²⁰ this assessment process was criticised as follows:

¹⁹ Queensland Guild of Furniture Manufacturers Ltd. (1993).

²⁰ Malleys v JW Tomlin Pty Ltd. 35 ALJR 352.

“it is, in fact, intended to be an objective test by which the issue is ultimately decided by the court, which puts itself in the place of an informed user” (ALRC 1995, 59).

Informed user may be considered as a person who has knowledge of the assessed design’s available types, but is not an expert (Korkut et al. 2006, 388).

In theory, the expected characteristics of informed user may differ in some circumstances,

“the informed user test is that it is flexible enough to be applied to any product. In many circumstances the informed user will be fully aware of international developments in the product concerned. On the other hand, it is not expected that the informed user will have detailed knowledge of the appearance of the product, its history and availability throughout the world at any period. In other words, it should not be possible for a similar design for the same product that was once but is no longer available in a remote region, to anticipate the design. A compromise is required” (ALRC 1994, 67).

In the Regulation, the informed user was regarded as the fictive person to make this assessment.

According to Hasdoğan (2005, 2), the informed user is therefore a notional person, who knows the design in question and has an opinion about its usage, and is conversant to its variations in the market. In most cases, the court experts assume the role of informed user, by gathering information about the product to which the design is applied.

Informed user can be the consumer of the product, but this is not a necessity in all cases. As mentioned before, in most of the cases, the judges or experts put themselves in the place of the informed user while assessing a design. Thus, the courts need to determine who the informed user is, for the said design. Because informed user is neither an expert, nor the man in the street (Suluk 2003, 258).

A design also does not have to reflect its owner's characteristics. It is important to determine whether there is a significant difference between the overall impressions created on the informed user, or not. A sufficient difference shall reflect to the design, and create a differing character (Suluk 2003, 250).

Degree of freedom

In the assessment of distinctive character, the 'degree of freedom' emerges as another important aspect. Occasionally, the function of a three-dimensional design may dictate the form of the whole body. In other words, the appearances of some products are directly coupled to their function. Thus, if the designer does not have a chance to alternate the design, the design may not be protected²¹; and this aspect also plays a considerable role in the assessment.

Many legal arrangements, including the Directive and the Decree-Law point out the importance of the designer's degree of freedom. In the Directive it was mentioned that "in assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration"²². Similarly, the Decree-Law involves such an explanation, "in the assessment of the individual character, the emphasis of evaluation shall be on the common features of the designs and the degree of freedom of the designer in developing the design shall also be taken into consideration"²³.

Therefore, some particular terms were found to be important in the assessment, which shall, from now on, lead the rest of the study. These are:

- Novelty
 - Identical designs and immaterial details
- Distinctive character
 - Overall impression
 - Significant difference
 - Informed user

²¹ Decree-Law Article 10, Directive Article 7, Regulation Article 8

²² Directive, Article 5

²³ Decree-Law, Article 7

- Common features and differences between the designs
- Designer's degree of freedom

2.3.2 Assessment process in Turkey: Current situation

In Turkey, the registration system does not involve an examination process; except for a formal examination made at the application stage. The four-stage registration process can be briefed as formal examination, registration, publication and opposition, and certification (www.tpe.gov.tr).

The applicants may file an application for a design individually, or may receive help from patent or trademark agents, as there have been still no entities such as design agents. As well as the TPI, the agents are not obliged to examine the novelty or distinctive character of the design in question. However, they have the right to examine those qualities upon design owner's request.

Thus, the assessments of novelty and distinctive character are either made by TPI, when a design is subjected to an opposition or if taken much further, within the scope of lawsuits, by judges and court experts. In other words, the need of an assessment generally arises when the validity of a design registration is opposed after its publication or challenged by a court case.

CHAPTER 3

METHODOLOGY OF THE FIELD STUDY

In order to approach the aim and scope of the study, the participant groups were clarified as judges, court experts, experts working at the TPI (hereinafter referred to as TPI experts), attorneys, and patent and/or trademark agents (referred to as agents).

Face-to-face interview method was found to be appropriate for the collection of data, which is thought to be useful for observing the ways of assessment of the parties in question. Interview questions (given in A.1 and A.2) were determined by the derivation of the research questions.

3.1 Data Collection

3.1.1 Interviewing

Interviewing, structured or unstructured, is a convenient and established method of research (Bauer 2000), and is one of the most common and powerful ways in which we try to understand each other (Fontana and Frey 2003). It can be structured, semi-structured or unstructured. In structured interviews, the interviewer asks all interviewee the same pre-established questions with a limited set of response categories; thus, all the respondents receive the same questions asked in the same order with very little flexibility in the way the questions are asked. Unstructured interviewing, including in-depth interviewing and participant observation, provides greater breadth of data than the other types (Fontana and Frey, 2003).

In this study, semi-structured interviews were conducted, where the questions remained the same for each group and directed to all participants in the same way,

but the answers were open-ended. As it was stated before, the interview schedule is given in Appendix A (in Turkish) and Appendix B (in English).

The first and the introductory section of the interview schedule consists of a short information about the interviewer and the scope of the thesis. The questions start in the second section, “novelty”. This section consists of two questions: the assessment of novelty, and that of identical designs and immaterial details. The third section is the part in which the examination of distinctive character assessment is made. Seven questions were addressed in order to get into the ways of assessment. The fourth section consists of four questions about the registration process. The question related to the assessment guideline, which is thought to be useful for assessors, is also among them. Personal information about the interviewee is gathered in the fifth section. The interview ends in the sixth section, where the contact information about the interviewee is asked. The seventh and the last section consists of a space reserved for the interviewer’s observations and notes on the interview.

3.1.2 Sampling

Probability sampling and non-probability sampling are two major types of sampling. According to Brewer and Hunter (1989), probability sampling is based upon the idea that one could take repeated samples of the same population and compare the samples. In this method, the choice is made by some mechanical procedure involving lists of random numbers, or the equivalent; alternatively, the choice can be made by non-probability methods such as invoking elements of judgement (Doherty 1994, 21). In this study, non-probability sampling methods were employed.

The first step in the determination of the number of interviewee was to find out whether the size of entire population for each group can be determined, or not. The judges and the TPI experts were the groups with exact and small population size; in Turkey, currently, there are 12 *civil* courts specialized in intellectual property, and seven TPI experts in the re-evaluation and examination board. The remaining groups –attorneys, court experts, and agents present serious challenges concerning the

population size and the qualifications of the members. Attorneys constitute the largest group; it is estimated that there are over 20.000 attorneys in Ankara and İstanbul only, and there are no databases or official records relating the type of cases (or specializations) and attorneys. Court experts constitute a group for which there is no official list or registration system; however, it was observed that in courts each section registry has its own informal list of experts. Patent and/or trademark agents who can act as representatives for industrial design registration applicants constitute a heterogeneous group, and there are over 700 trademark and nearly 400 patent agents listed by TPI. Therefore, it was decided that TPI experts and judges in particular would act as informants for forming an accessible up-to-date list of court experts, attorneys and agents experienced in industrial design registration.

While conducting interviews with the members of these two groups, snowball method –a non-probability sampling method– was used for determining the potential participants from other groups. Thus, for each group a list consisting of all proposed names were formed.

When it is taken into account that there are five groups to be examined, the sample sizes for the three remaining groups (attorneys, court experts, and agents) were arranged in parallel with the whole population of the two formerly mentioned groups. Thus, the sample size was limited to 12 for each group, and 51 interviews, consisting of 12 judges, 7 experts from TPI, 11 court experts, 9 attorneys, 3 TPI attorneys and 9 agents were conducted. The interviews were voice-recorded by getting permission from the interviewee. The distribution of the interviews by towns can be found in Table 4. ‘*’ sign in some cells in the “duration” column indicates that the particular interviewee did not accept voice recording.

The views of 12 judges, 11 court experts (consisting of nine designers and two jurists-legists, bachelors of law-; since, jurist court experts are also assigned in the panel of experts, as well as designers), 7 experts working at the Re-evaluation and

Examination Board of TPI, 12 attorneys (including three attorneys working in the TPI) and 9 agents were represented and discussed.

The term “court expert” shall stand for a designer court expert unless it was specified that he/she is a jurist court expert. Also, the term “TPI attorney” shall be used for the attorneys working in TPI, while citing their comments and the term “attorney” shall be used for the rest. In the group of agents, some of the participants are patent agents, some are trademark agents, and some are either patent or trademark agents as the agents in both positions can deal with industrial designs. They all are to be mentioned as “agents” under this title.

Table 5 Interviews and durations

	Interview Location	Interviewee	Duration (minutes)
Judges	Ankara	AH1	59
		AH2	45
		AH3	23
		AH4	19
	İstanbul	IH1	35*
		IH2	40*
		IH3	41
		IH4	16
		IH5	23
		IH6	25
İzmir	IH7	19	
Court Experts (Designer& jurist)	Ankara	IZH1	17
		ATB1	39
		ATB2	37
		ATB3	26
		ATB4	18
		AHB1	45*
	İstanbul	AHB2	34
		ITB1	54
		ITB2	42
		ITB3	31
İzmir	ITB4	16	
	IZTB1	24	
Experts (TPI)	Ankara	AY1	20
		AY2	33
		AY3	80
		AY4	27
		AY5	38
		AY6	42
		AY7	33
Attorneys	Ankara	AA1	64
		AA2	47
		AA3	86
		AA4	23
		AA5	20
	İstanbul	IA1	30
		IA2	57
İzmir	IA3	14	
Attorneys (TPI)	Ankara	IZA1	30
		TA1	23
		TA2	15
Patent and/or Trademark Agents	Ankara	TA3	15
		AV1	64
		AV2	22
		AV3	19
	İstanbul	AV4	21
		IV1	33
		IV2	15
		IV3	16
İzmir	IV4	17	
IZV1	32		

3.2 Data Analysis

As it was mentioned before, the interviews were voice-recorded. In reference to Gill (2000), a good transcript should be as detailed as possible, should not summarise the speech, nor should it “clean it up” or correct it; it should record verbatim speech. Thus, the audio files of the interviews, which were stored on a PC, were transcribed verbatim (word by word).

Another reason for preferring verbatim transcription was that some essential parts of the answers given in the interviews may not be found relevant and can be designated as of no standing while listening; or some immaterial parts can make sense in time, even though they do not, in the beginning of the process. Verbatim transcription also gives a chance to reread and evaluate material parts, and to assess them within the whole context.

It is accepted that there are two major types of analysis of data which come in the form of free-flowing texts (Ryan and Bernard, 2003): In the first one, the text is segmented into its most basic meaningful components, words; in the second one, meaning are found in blocks of text. In this study, the second type of analysis has been carried out.

The major tasks associated with analysing parts of texts (coding) include identifying themes, constructing models and testing these models (Ryan and Bernard, 2003). In this study, the units to be analysed have been selected according to the identified themes and grouped under main themes which are explained in the following section.

3.2.1 Individual and Comparative Analyses of Interviews

“The spoken or written word has always a residue of ambiguity, no matter how carefully we word the questions and how carefully we report or code the answers” (Fontana and Frey, 2003).

Coding is accepted as the heart and soul of whole-text analysis. Identifying the *corpus of texts*, and selecting *the units of analysis within the texts* are the fundamental steps (Ryan and Bernard, 2003). For that purpose, after the transcription of the data (including all the spoken words, but not the paralinguistic characteristics), the related parts of the answers of the respondents were selected. In this selection process, the main approach was to gather the material blocks of texts under certain themes. In other words, the intention is to find out themes, which shall form the basis of the study.

Ryan and Bernard (2003) also emphasize the importance of this phase as follows:

“No matter how the researcher actually does inductive coding, by the time he or she has identified the themes and refined them to the point where they can be applied to an entire corpus of texts, a lot of interpretive analysis has already been done”.

In this context, a pilot study was made to determine the main themes that have been mentioned. 10 of the interviews were selected randomly by casting lots, and the texts were reread thoroughly. Every potential theme was written down with the code numbers of the respondents, so that the repeatedly mentioned themes could be detected. The potential themes were grouped so as to show the interrelationships among them. This list kept flexible during the entire analysis process, and the findings of the pilot study are given below under four main themes (Table 6).

Table 6 Themes identified in the pilot study

<p>1. NOVELTY</p> <p>1.1. General comments on the assessment of novelty.</p> <p> 1.1.1. Insufficient number of concerned cases.</p> <p> 1.1.2. Case-specific assessments.</p> <p> 1.1.3. Time spent for each case.</p> <p>1.2. Identical designs and designs differing in immaterial details.</p>
<p>2. DISTINCTIVE CHARACTER</p> <p>2.1. General comments on distinctive character.</p> <p> 2.1.1. Assuming novelty as the first step, and distinctive character as the second.</p> <p>2.2. Overall impression.</p> <p> 2.2.1. First impression.</p> <p>2.3. Significant difference.</p> <p>2.4. Informed user.</p> <p>2.5. Differences/common features.</p> <p>2.6. Degree of freedom.</p> <p>2.7. “Urban legends”</p>
<p>3. PROBLEMS FACED/SUGGESTIONS</p> <p>3.1. Designs not fulfilling the conditions of novelty and distinctive character.</p> <p> 3.1.1. Fulfilling only one condition.</p> <p> 3.1.2. Copy designs (infringement)</p> <p>3.2. Documents without dates/insufficient documents.</p> <p> 3.2.1. Being limited with documents.</p> <p>3.3. Differences in assessment.</p> <p> 3.3.1. Subjectivity of the assessment process.</p> <p>3.4. Problems in accessing/identifying suitable court experts/ quality of court experts.</p> <p>3.5. Registration system without examination.</p> <p>3.6. Need of common criteria.</p> <p>3.7. Non visible designs.</p> <p>3.8. Lack of communication.</p> <p>3.9. Misuse of the unexamined registration system.</p> <p>3.10. Work-load.</p> <p>3.11. Suggestions.</p>
<p>4. AREAS OF EXPERTISE/INCOMPREHENSIBILITY/USE OF WRONG TERMINOLOGY</p> <p>4.1. Confusion between designs and trademarks.</p> <p>4.2. Insufficient competence in the field.</p> <p>4.3. Conceptual confusions (incomprehensibility)/using wrong terminology.</p>

As cited from Miles and Huberman (1994) in Ryan and Bernard (2003), “once the researcher identifies a set of things (themes, concepts, beliefs, behaviours), the next step is to identify how these things are linked to each other in a theoretical model.”

Gaskell (2000) suggests keeping the aims and objectives of the research to the fore, looking for patterns and connections, looking for the larger picture that goes beyond the specific details; and he emphasizes that this analysis is not a purely mechanical process. This approach was adopted in every stage of the analysis.

As our codes are *values*, instead of *tags*²⁴ in this study, content analysis method has been carried out in the analysis of the texts, and in building conceptual models.

Bauer (2000) regards content analysis as the only method of text analysis that has been developed within the empirical social sciences. He also mentions that, most classical content analyses finalise in numerical descriptions of some features of the text corpus, considerable thought is given to the kinds, qualities and distinctions in the text. Thus, statistical formalism and qualitative analysis can come together in an integrated approach.

During the pilot analysis process, the blocks of texts which shall be assessed, were cut out manually from the printouts, and pasted on boards. The code numbers of the respondents and the line numbers were indicated on the cut-out text blocks. For this purpose, a separate board was prepared for each theme.

This process shows parallelism with the “scissors-and-sort technique”, which is a quick and cost-effective method for analysing the transcripts of focus groups, and in which the first step is to go through the transcripts and identify the sections of them that are relevant to the research questions. After this initial reading, a classification system for major topics is developed (Steward et al. 2007; 116)

²⁴ Ryan and Bernard (2003, 277) make a distinction between these two purposes in qualitative analysis. Codes as tags are assumed to be associated with grounded theory and schema analysis, where codes as values are associated with classical content analysis and content dictionaries.

Within this scope, selected parts of the transcripts were cut out manually from the printouts, gathered under potential themes, and pasted on boards. A separate board was prepared for each theme. Unlike a computer screen, this method enables the researcher to see the whole picture under a particular theme. The analysis process is shown in Figure 1.

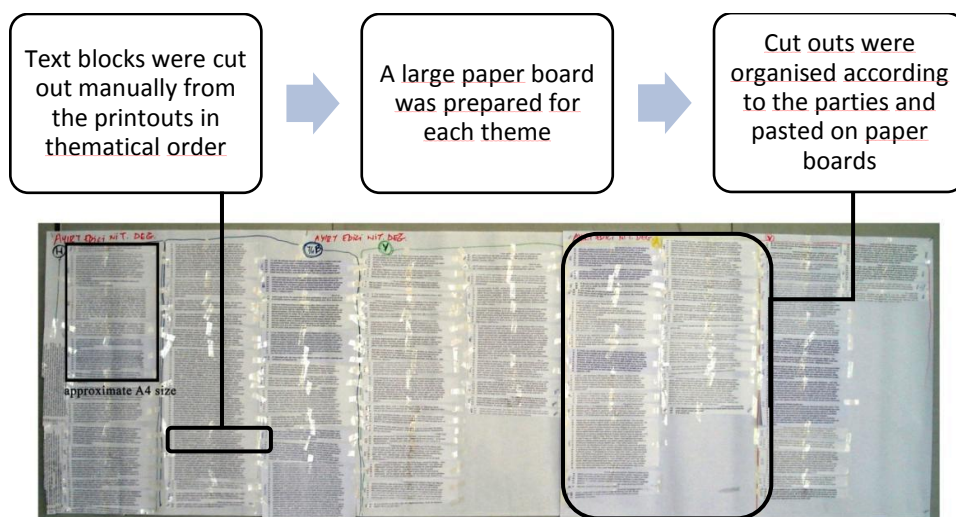


Figure 1 Analysis process

The code number of the respondent and the line numbers were also indicated on the cut-out text blocks. An exemplary board is given in Appendix C. Some themes were tackled under close subjects in order to keep the whole contexts of the main concerns. Furthermore, newly confronted themes were also assessed and analysed, and shall be discussed under latter sections. Final list of themes were as follows:

- Novelty
 - Identical designs and immaterial details
- Distinctive character
 - Overall impression
 - Significant difference
 - Informed user
 - Common features and differences
 - Degree of freedom

- Problems faced during the assessment
- Suggestions
- Differences among parties in terms of assessment
- Views on common guiding principles
- Misunderstandings about the assessment
- Misconceptions (wrong use of terms)

CHAPTER 4

FINDINGS: ASSESSMENT OF NOVELTY

4.1 Novelty

As it was mentioned in the previous chapter, “novelty” is defined in the Article 6 of the Decree-Law no 554 as follows: “a design shall be considered new if before the date of reference no identical design has been made available to the public in the world”. Within the scope of the interviews, a question related to this notion was addressed to the participants in order to understand the way they assess the novelty of a design.

4.1.1 Views on the notion of “novelty”

- **“New”, “novel” or “novelty” as a term.** In this assessment, the quality that some judges look for was stated as “being different ” from formerly encountered products with a similar function. The term “different” [*değişik, farklı*] was used by two judges. Another term used by one of these judges was “original”. Nevertheless, the said judge and another judge stated that “original” was, respectively, neither “unprecedented” [*eşi benzeri bulunmayan*] nor “a design that has never been produced” [*hiç üretilmemiş, hiç yapılmamış*]. The design’s *being different* was found to be sufficient instead. Similarly, a court expert mentioned that when a design is not considered to be “original” [*özgün*], it does not mean that it is not “new”.
- **Being not “exactly the same” with a previous one.** A court expert emphasized that a design which is “exactly the same” [*tıpatıp aynı*] with a previous one could not be considered new at all. Another court expert related novelty to a design’s divergence from its “essence” [*öz*]. He mentioned that

the assessment of the degree of this divergence may be subjective. This court expert also attracted attention to the idea that the notion of novelty is not a static one; it continually evolves within a cultural context, and the subjective notion of novelty is related to the assessor's competency in the design field.

Similarly, two TPI experts, an attorney and an agent mentioned that if a design is "exactly the same" [*bire bir aynı*] with a previous design, it is not considered to be new. Besides, the attorney noted that the assessment of immaterial details may differ according to the assessor. Thus, according to him, the assessment of novelty shall differ. According to another attorney, a new design should have a really different appearance. However, he stated, the product that the design is applied on does not have to be totally new; it can be a composition of various designs, and can even be a "bad" design, since its use is of no consequence.

Two agents stated that if the "small differences" [*ufak tefek, küçük farklılıklar*] do not affect the whole design, the latter design should not be considered new. Another agent stated that the assessment of the differences is a case specific activity; further, the differences may be interpreted in many different ways in accordance with the benefit of the client.

- **"Novelty" as absolute novelty.** Novelty was designated particularly as "absolute novelty" or strict novelty [*mutlak yenilik*] by three out of 12 judges. According to them, in order for a design to be considered new no identical designs should have been made available to the public anywhere in the world. An agent also designated novelty as "absolute novelty".

4.1.2 Assessment of novelty

- **Assessment of "novelty" is the first step.** Two court experts considered novelty as the first step to be passed before the assessment of distinctive character. They stated that they generally subject the design to a distinctive character assessment after they become sure of its novelty.

A TPI expert stated that she also regards the assessment of novelty as a first step in an assessment system where the second step is assumed to be the assessment of distinctive character. Two TPI experts mentioned that assessing novelty is a simple action since a design is not considered to be new if it is “exactly the same” [*bire bir aynı*] with a previous one.

- **Making available to the public.** Four judges emphasized the importance of a design’s “being made available to the public”, which was also accepted as one of the main concerns of the novelty assessment in the Decree-Law. The participants mentioned especially the following ways of making a design available to the public:
 - **Previously registered designs.** All four judges stated that a design shall not be considered *new* if it has already been registered as an industrial design anywhere in the world.
 - **Being introduced into the market.** One of these judges mentioned the importance of being sold or introduced into the market.

Six court experts similarly emphasized that they assess novelty firstly by considering the date the design made available to the public. One of these court experts also mentioned the twelve-month grace period²⁵ and stated that this period is seen as a favourable situation for the owner of the design.

This topic was also found to be important by five TPI experts. They pointed out that in the assessment of novelty, their main approach is to determine the exact date on which the design has been made available to the public. In this assessment, they stated, grace period or date of priority is also considered.

Here, a TPI expert said that the reliability of the document(s) -including the

²⁵ Grace period was dealt in the Decree Law a.8; “if a design for which protection is claimed has been made available to the public during the twelve-month period preceding the date of the filing of the application or if a priority is claimed **twelve month period preceding the date of priority**, by the designer or his successor in title or by a third person having their approval or in abuse of the relation with the designer or his successor in title, such disclosure shall not effect the novelty and individual character as specified in Articles 6 and 7”

visual representation- becomes important because the exact date on which the design in question was made available to the public is determined according to these documents.

Likewise, six attorneys, including two TPI attorneys, emphasized the importance of the date on which the designs in question have been made available to the public. They stated that they firstly assess novelty on the basis of these dates. However, another TPI attorney noted that she attends to the dates only if there is a similarity between the designs in question.

Three agents in this group also touched on this frequently mentioned subject; making available to the public. One of these agents stated that she regards the assessment of novelty as a test in which the state of “being made available to the public” is examined. Another agent stated that difficulties mostly emerge when one of the designs is unregistered, in other words when the design’s date of being made available to the public is not clear. Also, two of these agents emphasized the importance of the grace period, which allows a design to be published within a twelve-month period as from the date of making available to the public. This was found to be an advantageous situation for designers, as it was found to be so by a court expert.

- **Novelty and the product category.** A judge emphasized that the assessment depends on the product on which the design is applied; in other words, the way of assessing novelty was considered to be case specific. For example, it was stated that the assessment of novelty for a drinking glass could not be made in the same way as of an industrial machine.

Three judges mentioned that the assessment is easier for the designs applied on products commonly used in daily life. These judges also noted that in cases concerning such products they should be regarded as legally capable of reaching a verdict by themselves without consulting a court expert. Three

judges, including two of the aforementioned judges, emphasized that the general tendency of the Supreme Court [*Yargıtay*] is that disputes should be resolved by the contributions of court experts. Including these three, five judges stated that they make court experts do this assessment rather than making the assessment themselves. One of these judges noted that he firstly filters the designs with respect to his own knowledge and experiences before consulting court experts.

Two court experts also related the assessment of novelty to this external factor, the product category itself. One of these experts emphasized that innovations may be rather limited in certain areas where there have been a lot of designs available. In other words, in some product categories, small changes in designs can be sufficient for a design to be considered new.

- **The assessment is based on visual representation.** Two judges emphasized that an industrial design registration protects solely the appearance, hence the function of the product that the design is applied on is not considered. One of these judges underlined that this assessment was necessarily based on *visual representation*. Likewise, three more judges touched on this topic and mentioned that they have also been making this assessment based on documents, including the visual representation submitted by the litigants.

Similarly, an attorney and a TPI attorney also mentioned that they make this assessment on the basis of visual representation.

- **Common features and differences.** Two court experts shared that they evaluate the common features and differences of the designs in question while assessing novelty, just as in the assessment of distinctive character. They stated that, at the end of this assessment, if the differences are deemed immaterial, the designs may be considered identical.
- **Intention of the designer.** A court expert mentioned that while he makes this assessment, what constitutes his main concern is the intention of the owner of

the design in dispute. He outlined that he may assess the designs in a less strict way in case of a good will. He stated that in such cases, assessing the common features in a very strict way would mean to undermine the manufacturer's labour and goodwill.

- **Product morphology.** “Product morphology” was mentioned by a court expert. He pointed out that “the geometry and the character of the product” should be analysed and identified while assessing the novelty of the design in question.
- **Novel as a new idea, a new application or a new morphological integrity.** A court expert stated that, he looks for a new idea, a new application or a new morphological integrity in order to consider a design as new. He also mentioned that the product's relationship with the environment and the benefits it provides to the user are also matters to be taken into account, and this approach, he stated, results from his/her profession. However, he added that he/she makes this assessment principally in accordance with the legal provisions. He also noted that the basic geometrical forms should not be protected, and a colour change alone, for instance, should not bring innovation to a design.
- **Assessment of novelty is easier compared to the assessment of distinctive character.** Two TPI attorneys mentioned that they regard novelty assessment as an easier assessment compared to the assessment of distinctive character. One of these two TPI attorneys mentioned that the assessment of novelty is a very clear process as the assessment is made according to the dates.
- **Type of law suit and assessment.** Another topic mentioned by a judge was that different ways of assessment may be involved for different types of lawsuits. He stated that in infringement cases [*tasarıma tecavüz davası*] the emphasis is on the validity of the documents submitted by the litigants, whereas in invalidity cases [*tasarımın hükümsüzlüğü davası*] a more detailed examination is necessary for assessing the *absolute novelty*.

- **Who is to assess?** An attorney stated that this is an assessment which should be made by the designers (court experts). Some notions, such as immaterial details and the “essence” of design, he stated, should especially be assessed by designers instead of jurists. An attorney mentioned that she makes an examination for the novelty of the design in question at the beginning of the process. Another attorney presented an opinion in the same vein and also added that he gets support from patent agents for this purpose.
- **Is the client always right?** An attorney emphasized that they rely upon the claims of their clients. Nonetheless, they think over the design in question by putting themselves in the place of a court expert, a judge and finally in the place of a “consumer with an average intelligence level” [*orta zekalı tüketici*]. Another attorney shared that sometimes they are faced with clients telling that they have made some changes on a previously seen design in order to register it in favour of their firms; in such cases, the attorney sometimes appeals to an expert for his/her opinion. Another attorney humorously confessed that “the client is always right”.
- **Are the agents going to examine the novelty of the design?** As agents play a role especially in the application process, a topic that they frequently touched on was the examination of novelty. Five agents stated that they do not make such an examination for the designs subjected to an application unless the client asks for it. Nevertheless, one of them mentioned that they look through the client’s design and try to assess its novelty with her own knowledge and experiences. She also stated that after this preliminary assessment, if she becomes sure that the design is not new, she does not accept to fulfil the application of the design for the client. Another agent also stated that if he thinks that the design in question is not new, he forewarns the applicant. On the other hand, two agents said that when they are to make an application for a client’s design registration, they search their own databases according to the Locarno Classification for Industrial Designs, in order not to make an application for a previously registered design.

- **Assessor's area of expertise and the assessment.** A jurist court expert noted that she has been making the assessment of novelty solely based on the dates designs made available to the public. The reason of such an approach, she stated, was that, she considered the designer court experts as the authorities for making this assessment because of their professional background. Another jurist court expert also had a similar approach and stated that she delimits her assessment with formal and legal issues.

4.1.3 Discussion on the notion and assessment of novelty

It was observed that the views of the participants particularly centre on the *notion* of novelty and the *assessment* of novelty; and two subgroups, in terms of the understanding of novelty, appeared within the participants who acted as evaluating bodies in the quest of novelty. These two groups revealed different opinions as to what novelty means.

The first group, consisting of three judges and an agent, were found to be in search of an *absolute novelty*. Nevertheless, considering the opinions of these participants on the assessment and understanding of novelty, it is possible to state that, novelty did not stand for *originality* or *being totally new* for them.

The participants of the other group, consisting of a court expert, two TPI experts, two attorneys and an agent, defined novelty as *not being exactly the same* with a previous design. It is possible to state that the assessment of novelty is being made according to the definition given in the Decree-Law in our country; however, no other definition except for “a design shall be considered new if before the date of reference no identical design has been made available to the public in the world” exists in the said legislation.

Assessing the novelty was assumed to be the first and relatively the easier part of the assessment, since in the assessment of this notion, the prominent issue was found to be the *date of making available to the public*. This aspect was found important by 24 participants, nearly the half of the total number of participants. Thus, it is possible to say that the date of making available to the public can be assumed as one of the most

important queries in the assessment of novelty. It was observed that the participants pay utmost attention to the date which shows the exact day on which the design has been made available to the public. It can also be said that the *visual representation* of the design plays a vital role in the assessment of novelty, as the participants stated that they assess the novelty on the basis of these images.

It was observed that the court experts were in tendency to assess the designs in question according to their differences and common features. That is to say, for the designers, the *morphology* of the design plays an important role in the assessment of novelty as well as the date of making available to the public. It was also asserted that basic geometric forms should not be protected, and a colour change alone would not bring innovation to the design.

The product category was regarded as another aspect which influences the way of assessment. The assessment of novelty was found to be a case specific act. For instance, assessing more complicated designs were found to be difficult, but assessing novelty was thought to be easy in some categories such as in the designs applied on commonly used in our daily lives. In such cases, especially the judges would like to have power to give verdict without consulting court experts. It follows from this argument that they may not regard all *designs* as products which have to be assessed from the viewpoint of a designer. In other words, it is conceivable to say that they may find it unnecessary to assess a *simple* design profoundly, since themselves, according to them, are also able to analyse such designs in terms of novelty and distinctive character. In contrary, the attorneys defended the opinion that the assessment of novelty should particularly be made by court experts.

Another important discussion was that whether the agents examine the novelty of the design at the beginning of the process or not. Three different approaches were observed. The first group of agents were found to be in tendency to scan their own databases in order not to file an application for a design which is identical with another one that they have previously filed. The second group of agents stated that they try to convince their clients about not filing an application for the design if they *know* that the design which is subjected to the application is not new. However, the

last and the most preferred attitude was that *not examining* the novelty of the design unless it is asked by the client. It can be said that, this differentiation results from the lack of a regulation which clarifies the authorities and responsibilities of the agents in terms of examining the novelty of the designs. Under the circumstances, such an inquiry seems to be under the initiative of the agents.

4.2 Identical designs and immaterial details

According to the Decree-Law, “Designs differing only in immaterial details shall be deemed to be identical” (Decree-Law no 554, Article 6). The opinions of the participants on the assessment of identical designs and immaterial details were taken through a relevant question addressed in the interview.

4.2.1 Views on “immaterial details”

A TPI expert noted that, even though immaterial details are discussed within the assessment of novelty, they cannot be assessed independent from “distinctive character”. Another TPI expert stated that the notion of “immaterial details” is not defined or explained in the Decree-Law. They, he stated, try to settle these notions in a place in practice.

4.2.2 Which designs are deemed “identical”?

- **Being “exactly the same”.** According to a judge, “identical designs” are the designs which are “exactly the same” [*birebir*] or “twins” [*birbirinin ikizi*]. A court expert also defined that designs are deemed identical if they are “exactly the same” [*birbirinin tüpatıp aynı*] or if there aren’t any differences between them. Three TPI experts used the same phrase, and mentioned that designs are deemed identical if they are “exactly the same” [*birebir*]. One of these TPI experts pointed to the fact that in fields where the designer has a wide degree of freedom designs are less likely to become “exactly the same” of another; so a similarity which is counted as identity becomes more obtrusive in such cases. Another TPI expert stated that, designs should be considered identical even if the assessor deliberately tries and finds any minor differences between them. Five attorneys –three of them were TPI attorneys-

had a similar attitude and stated that if two designs are “exactly the same” [*birebir, tüpatüp aynı*], they are deemed “identical”. An agent defined “identical” designs as designs which are “exactly the same” [*birebir aynı*] as well as many participants. He also stated that designs, as well as artworks and inventions, bear the characteristic of the designer; thus, according to him, it seems almost impossible for a design to become identical with another unless there is an infringement. In other words achieving an identical design coincidentally is off chance or such a design can only result from a technical function. Another agent had a similar attitude; to her, identical designs generally indicate a bad faith.

- **“At first glance”**. Two judges stated that if the design in dispute does not seem to be different from the previous one, “at first glance”, they shall be deemed identical.
- **Can not be linked to templates**. A court expert mentioned that these terms are very hard to define, and the assessment can not be linked to templates.
- **Assessment of “identical designs”**. According to a court expert, a design, which seems like a variation of a previous design, is deemed “identical” with the former one. An attorney noted that a technical assessment -how a designer assesses this notion- is essential here instead of a juridical definition. Nevertheless, according to him, if there aren’t any differences between the “essences” [*öz, esas*] of two designs, they are deemed identical. Another attorney had a different attitude; he stated that if an ordinary consumer -not an informed user- confuses two products standing side by side on a market shelf; it very easy to say they are identical. However, according to him, differences between these two designs may be remarkable for an informed user. Three attorneys including a TPI attorney mentioned that there aren’t any problems in the assessment of “identical designs”, though the main problems are confronted in the assessment of “immaterial details”.

4.2.3 Assessment of “immaterial details”

A jurist court expert stated that the assessment of identical designs and immaterial details may involve subjective aspects, so designer court experts, she stated, should assess these notions. Also an attorney had a similar approach and stated that technical court experts should assess the details of designs.

In the same vein, an agent mentioned that this assessment should be made by technical court experts. Another agent contrarily stated that she shapes her assessment in such a manner in which the argument of her client is strengthened. Another agent approached this topic with a technical view and explained the way he makes this assessment. He stated that, if there are two different pens with “identical” caps, the caps can no more be considered as “immaterial details”; rather, they indicate a similarity between the designs in question. He also mentioned that the immaterial details may gain importance as they go beyond the inevitable results of technical functions.

- **Assessment of “identical designs” and “immaterial details” is subjective and case specific.** According to a judge, two TPI experts and an attorney, assessing the differences in immaterial details can be accepted as a subjective task. The judge stated that this is so because the notion of “similarity” [*benzerlik*] depends upon the assessors.

As one of these TPI experts pointed out, this assessment is not expected to be objective. The attorney, as he stated, had questions about the notion of “immaterial details”, and stated that he would like to know “for whom the differences should be ‘immaterial’”.

- **The eye of the “informed user” or the eye of the “ordinary persons/users”?** Five judges emphasized that the differences between the designs in question should be recognizable from the viewpoint of the “informed user” so as to be accepted as appreciable differences instead of differences in immaterial details. In other words, differences are deemed immaterial if they can not be noticed by the “informed user”. According to

another judge, the design in dispute should involve some differences which are recognizable by an “ordinary person” [*normal bir insan*] in order not to be deemed “identical” with the former design. However, a point that she and one of the five aforementioned judges mentioned is that, if the differences involved in the latter design can only be recognized by an expert, these differences are deemed immaterial.

Similarly, two court experts mentioned that designs are deemed identical if they are identical in the eye of the informed user. However, they used the term “user” as well and one of the court experts used the term “consumer” to identify this fictive assessor. They stated that they look for a change, which can be distinguished by an informed user -or user- in order for the design not to be deemed identical with the former ones. The court expert, who used the term “user”, specified that “if a user cannot see any difference between two products, when he sees them standing side by side in a store, then they are deemed identical”.

Two agents also noted that the assessment of immaterial details is based on the eye of the “informed user”. According to one of these agents, immaterial details are the differences which cannot be recognized by the “informed user” at first glance.

- **“It depends on the attention paid and the time spent”.** The attention paid and time spent was found to be important by two judges. These two concepts, as they assumed so, are related with the action of purchase; and the details of a design are estimated according to the buying behaviour and the time spent on this purchasing activity. According to one of these judges, a person, for instance, may not see the differences, if he/she is in a hurry while buying the product that the design is applied on.
- **Product category alters the assessment of details.** Four judges mentioned that this assessment, especially the assessment of differences in immaterial

details, depends on the product category that the design in question is applied on.

Four court experts and an attorney also emphasized that the importance of the details may vary from product to product. According to one of them, the legs of a sofa, for instance, may not influence the overall impression of the sofa; whereas in another case, only the legs can change the whole design and may seriously influence the overall impression of the sofa. One of these four court experts noted that the segment of the product that the design is applied on, the line of business and even territorial factors may influence the assessment of the importance of a design's details.

A TPI expert similarly stated that this assessment may change according to the design segment and the size of the product on which the design is applied. For instance, according to him, the details of a kitchenware can be realized easily compared to those of an automobile. Likewise, seven attorneys, including a TPI attorney, focused on the view that details of a design may be assessed differently in separate segments. Two other attorneys also explained their opinions by examples. One of these attorneys mentioned that, if we are faced with two seating furniture with same form, a colour change shall be deemed an immaterial detail; whereas in some cases the colour change itself can be sufficient for a design to become different from the others.

Two agents similarly stated that the immateriality of the details depends on the product category that the design is applied on.

- **The details gain importance in “crowded art”²⁶ fields.** A court expert touched on this point and stated that, more emphasis is placed on the details of a design in a branch of industry where a wide range of designs are formed.

²⁶ “This refers to an area of technology in which there have been a large number of prior inventions. In a crowded art, it takes less of an advancement to obtain a valid patent. Otherwise, one would have to conclude that there can be no further patenting in that art” (Silverman and Stacey 1996, 77)

In other words, in some fields, designs may collide within limited ranges of variety; in such cases even a small difference can play an essential role.

4.2.4 What kinds of differences are accepted as differences in immaterial details?

- **Differences which do not change the “overall impression”.** Three judges emphasized that if the differences between two designs are not sufficient to create a different “overall impressions”, these designs are regarded as designs differing only in immaterial details. In other words, a design, they stated, should involve some obvious differences distinguishing its overall impression from that of the former one. Another judge had a similar approach and stated that if a design “continues the appearance” of a former design, the differences between them are considered as immaterial details.

Four court experts and a TPI attorney also put emphasis on this aspect. Similarly, they stated that, a component or a fact is deemed an immaterial detail if it does not have an influence on the overall impression of the design in question. In other words, a component -which is not accepted as an immaterial detail- is expected to alter the overall impression of the design in question compared to that of a previous one. According to one of these four court experts, it is important to assess the components’ impact on the whole design.

Two TPI experts, in a similar vein, stated that differences which do not change the “overall appearance” are considered as immaterial details. One of these TPI experts added that he tries to think the whole design as an abstract drawing –without colours- and to make the assessment through these images. According to an agent, the assessor starts to see the immaterial details when he/she shows more attention towards the design in question. Two other agents stated that the differences which do not differentiate the whole design are deemed immaterial details. As they stated, the important thing for them, similarly, is that how much a detail influences the “overall appearance”.

- **The importance of the designer’s “degree of freedom”.** A judge emphasized the importance of the “degree of freedom” that the designer has. He stated that the assessor should not ignore this fact while assessing the designs. Designer’s degree of freedom was also found important by two attorneys. A question one of these attorneys took into consideration was that “how much a design adds on the forms resulting from the technical functions”. The other attorney had a similar approach; he stated that the importance of the details is indirectly proportional with the degree of freedom that the designer has. In other words, to him, in categories where the designer has limited degree of freedom, the details become more important.
- **Physical size of the detail.** A TPI expert mentioned that some differences may not be noticed when we look through the product from a distance, but we start to realize them when we get closer to it. Such differences, as he stated, are deemed “immaterial details”. Contrarily, another TPI expert mentioned that a detail’s being material or immaterial is not related with the detail’s physical size. For instance, he stated, the handle on a cabinet does not always have to be an immaterial detail, just because it is a small component considering the volume of the entire body. An attorney, in a similar vein, mentioned that the physical size of the product that the design is applied on does not have an importance in the assessment of details. Besides, he stated that if the only difference in two sofas is the number of seats -for instance, if we are to assess two armchairs, one with two seats and the other with three seats- the difference is deemed an immaterial detail.
- **Identity and distinctive character.** Two TPI experts indicated that details except for the elements that form the design’s identity may, in some cases, be considered as immaterial details. Another TPI expert had a similar approach; he stated that the design elements, which fall outside the components constituting the distinctive character of the design, may be deemed immaterial details. An attorney and a TPI attorney mentioned that, the details may sometimes be assessed associated with the “distinctive character”.

According to them, if the differences do not bring distinctive character to a design, they are deemed immaterial details.

- **Differences which cannot be seen at a glance.** Three attorneys, including two TPI attorneys, stated that the differences which can not be seen at a glance are deemed immaterial details. According to one of these attorneys, details that can only be realized when the design is “turned over and over” [*evirip çevirip baktığınızda*] are assessed as immaterial details. A TPI attorney connected this topic with the time elapsed for a detail to be noticed. If we are not able to notice a detail in a short time, he stated, it may be deemed an immaterial detail.
- **Where we stand is important.** An attorney approached the assessment from a different viewpoint and noted that he sometimes needs to act according to the point that he has to stand. In other words, he stated, they can overrate or underestimate a detail according to the side they need to defend.
- **Scope of the protection.** According to a judge the scope of the protection, shortly, which component that we protect, is important; for instance, a detail may be assessed differently if we are to protect every component of the design in question.
- **Small differences may change the whole design sometimes.** Two judges noted that they place emphasis on the similarities between two designs instead of small differences while assessing the designs. However, a judge mentioned that it may be a faulty approach to ignore the immaterial details every time in all designs; since an immaterial detail may be redesigned and improved, and finally become a considerable component of the design in terms of distinctiveness. Likewise, another judge stated that small details sometimes can change the design entirely.

Three court experts stated that sometimes very small changes made on designs may differentiate the whole design. Thus, adopting the idea that every small detail should be deemed immaterial was not found to be appropriate for

all cases. Rather, as one of these court experts stated, a designer can create new designs by utilizing these small hints.

4.2.5 Discussion on identical designs and immaterial designs

The assessment of identical designs and immaterial details may be regarded as an assessment which is made within the scope of the assessment of novelty, as these terms take part in the provisions²⁷ regarding *novelty*. Nevertheless, it is possible to state that the assessment of identical designs and immaterial details can sometimes be made correlatively with the assessment of distinctive character. In other words, it was observed that some participants from each group assess, particularly the immaterial details, regarding some principles related to the assessment of distinctive character. For instance, taking into account the influence of the details of a design on the “overall impression” of it can be accepted as an indicator of such an approach. Assessing the details considering the designer’s “degree of freedom” is also an example for such an attitude.

The assessment of “identical” designs was found to be an easier assessment compared to the assessment of “immaterial details”, since a considerable number of participants regarded the designs, which are “exactly the same”, as “identical” designs. In this point of view, *any* difference would draw away a design from being identical with a previous design. According to some other views, the designs, which are seen as *variations* of previous designs or bear similarities in terms of *essence*, would be counted as identical with the previous ones. Here, the assessment of the differences in details gains importance.

Another discussion was found to be the quality of the *fictive* assessor whose viewpoint is taken into consideration in the assessment of identical designs and immaterial details. A question arises: for whom the differences should be noticeable in order for them to be assumed as differences which are *not* immaterial details? For a group of participants including judges, court experts and agents, such a difference should be noticeable for an “informed user”. However, an opposing view was that a

²⁷ Decree-Law no 554, Article 6.

difference should be seen as a “difference” instead of an “immaterial detail” when it is noticeable even for an “ordinary consumer” or an “ordinary people”. That is to say, according to this point of view, recognition of a difference should be *easy* in order *not* to assume it as an “immaterial detail”, since in their opinion; an ordinary consumer would hardly notice the small differences between the designs. In a sense, they promote the idea that the differences between the designs need to be more obvious. Nonetheless, according to the provisions in the Decree-Law, the assessment of novelty should be made from the viewpoint of an “informed user”. That means there is no need to be in search of such a difference which is *more* obvious than expected.

As it can be understood from the discussions, the assessment of the identity of the designs involves subjective aspects; also some participants have already mentioned that. The reasons of this subjectivity can be discussed in several ways. For instance, the notion of *resemblance* varies from person to person, the assessment would change according to the time spent or above all, the level of expected differentiation would vary from case to case. Here, the viewpoint of a group of participants involving members from all parties was that the assessment would differ according to the product category.

Within this context, two opposite views were presented about the influence of the physical size of the product or the component, on which the design is applied, on the assessment. According to one of these viewpoints, the physical size of the product was found material. Contrarily, for the other group, the details which are small in size do not have to be immaterial every time; small changes may change the whole design, instead. The idea of a group of jurists fits for this purpose; they defended the idea that this assessment has to be made by the technical court experts, since the impact of the details on the whole design would, by this way, be evaluated properly.

Over and above these, it was observed that the representatives of the parties may be obliged to make a biased assessment related to the details of a design. All these discussions lead us to the conclusion that, such deficiencies result from the lack of guiding criteria.

CHAPTER 5

FINDINGS: ASSESSMENT OF DISTINCTIVE CHARACTER

According to the Decree-Law no 554 a.7 “a design shall be understood to have an individual character if the overall impression it creates on the informed user is significantly different from the overall impression created on the same user by any design...”.

5.1 Distinctive character

5.1.1 Views on the notion of “distinctive character”

- **A different appearance.** Four judges stated that a design may be deemed to have a distinctive character if it presents a different appearance compared to the ones which have already been in the market. One of these judges used the term “significant difference” to define this differentiation, whereas another one of these judges stated that she expects a design to go beyond the ordinary so as to be deemed to have a distinctive character. However, she added, a very high level of creativity is not expected from the designers while assessing the distinctive character.
- **A design which has never been done before.** A judge connected this topic to copyright; she and an agent stated that similar to the artistic works, a design should bear the author’s characteristic. She also added that if a design which has never been done is in question, it can be found interesting; and, she stated, that is what we call “distinctive character”. An attorney and an agent had a similar approach; they specified that distinctive character is the “originality of the idea”; in a sense, according to the attorney, what makes us say “wow!” is the distinctive character of a design.

- **Designs attracting attention at first glance.** The term “at first glance” [*ilk bakışta, ilk anda*] was used by three judges. They mentioned that the feature which is to bring distinctive character to a design should attract attention at first glance, since, as one of these judges stated, the aim is to impress the user.
- **The “distinctive character” of a design arises from the cultural context.** According to a court expert, if the assessor is acquainted with the cultural context that the design belongs to, he/she will also be knowledgeable with the characteristic features of the design in question. He also stated that introducing some different versions of a design as “new” designs may be counted as a “deception” [*aldatmaca*].

5.1.2 Assessment of “distinctive character”

- **Assessment involves subjective aspects.** Four TPI experts and two agents stated that the assessment of distinctive character involves subjective aspects. Two of these TPI experts also specified that they are not able to outline their assessment procedure step by step. According to one of these TPI experts and to one of these agents, the assessment of distinctive character is an unclear analysis process which cannot be formulised mathematically. He added that, the assessor’s competence in that field also influences the way of assessment. According to him, for instance, an assessor who has seen many designs in the sector in question could perceive the distinctive character of the design much better.
- **Product category and the familiarity with the product category alter the assessment.** Two judges emphasized that this assessment depends on how much is the design in question known by the assessor. In other words, the product category that the design in question is applied alters the way of assessment as well as the person to assess. Also four TPI experts, two attorneys and three agents touched on this subject and stated that the assessment differs according to the product category.

- **The probability of confusion when the products are seen side by side.** The issue of the probability of confusion when the products are seen side by side was put forward by two judges. They stated that while assessing the distinctive character, they try to find the answer of the question that “can we distinguish the products that the design in question is applied, or could we confuse them when we see them side by side?”. According to one of these judges, “an average consumer” [*ortalama tüketicisi*] or “conscious consumer” [*bilinçli tüketicisi*] is assumed as the fictive person who is to assess the distinctive character of the design. Contrarily, according to an agent, “ordinary consumers” [*sıradan tüketicisi*] may confuse the products as they generally distinguish them due to their brands; and according to him, this is why we should look from the viewpoint of the “informed user” instead of an “ordinary consumer”.
- **Interactions with the user.** Another court expert noted that a design’s form is closely related to its interactions with user; and this relationship was found to be important in the determination of “distinctive character”.
- **The assessment of “distinctive character” and the assessment of “novelty” are interrelated.** According to a court expert the assessment of “distinctive character” is a more critical assessment that requires a more sensitive evaluation compared to that of “novelty”. Four TPI experts and four attorneys -including a TPI attorney- mentioned that the assessment of “novelty” and “distinctive character” should be conceived as a two step assessment process. Two of these TPI experts and one of these attorneys stated that a higher level of differentiation is required in the assessment of distinctive character. Also one of these TPI experts defined this idea by suggesting a metaphor: in comparison to the assessment of novelty “the ‘colander’ in the assessment of distinctive character involves smaller ‘holes’”. Similarly, an agent also stated that “distinctive character” is something different from “novelty”; according to him, it should be at the forefront as well.

An attorney stated that the assessment of novelty and the assessment of distinctive character cannot be made independent from each other.

- **The assessment is based on the visual representation.** A court expert stated that he finds the definition given in the Decree-Law no 554 for the “distinctive character” comprehensive and affirmative; nevertheless, she stated, as the distinctive character is evaluated considering the appearances, the assessment is thereby based on the visual representations. However, an attorney noted that the Supreme Court promotes the idea of considering the design descriptions as well as the visual representation.
- **Functional, artistic or aesthetical contribution is not important.** A court expert noted that neither artistic nor aesthetical aspects influence the assessment of distinctive character. In other words, it was stated that aesthetic concerns don’t make any sense in the assessment of distinctive character. According to an attorney, functionality, as well, is not discussed.
- **The designer’s contribution should be obvious.** A court expert stated that the effort that a designer made can be an important indicator for the design’s distinctive character. Because, he stated, this shows the designer’s will to make the design look different from others. A TPI expert showed a similar approach; according to her, designs made up without any endeavour do not deserve to be protected.
- **The time spent by the consumer during the purchasing phase should be taken into consideration.** A jurist court expert stated that the assessor may find various differences between the designs in question, if he/she tries to do so. However, she noted that the consumer shall not spend this much time on the product on which the design is applied, when he/she buys it. According to her, this is an important factor considering the fact that industrial designs are commercial means.

A TPI attorney also touched upon this issue. He approached the subject from a different perspective and stated that the time spent while buying is important, and it depends on the economic value of the product that the design is applied on. In other words, the time that the consumer spends during the purchasing phase shall become an important aspect in the assessment of distinctive character.

- **Are the differences in details or in the major parts or components of the design?** A judge and a court expert noted that while assessing the distinctive character, an important question is that whether the differences are in details or in the main components of the design in question. The court expert added that if the design does not involve fundamental changes, it can be said that the design does not have distinctive character. However, according to an attorney, the accumulated differences in details may indicate the existence of distinctive character. Similarly, another attorney stated that, making additions to standard forms may bring the design a distinctive character.

Three TPI experts and an agent also touched on this topic. The agent stated that if the designs seem different for the most part, it can probably be said that the former one has distinctive character. According to one of these TPI experts even a considerable extent of change on the design cannot be sufficient to bring the design a distinctive character. According to him, for instance, 70 percent of the features might have been amended, but this would not mean that the design shall have distinctive character. The design, he stated, shall remain the same unless the character that distinguishes it from others change. According to another of these TPI experts, if the differences are presumed as immaterial details of the design in question, it is not necessary to quest the distinctive character.

- **The assessment should be made by court experts.** A court expert, a jurist court expert, an attorney and two agents mentioned that court experts should assess the “distinctive character” as well as “novelty”. The jurist court expert

specified that, they exclude themselves from the process when it comes to evaluate the design in terms of distinctiveness. Likewise, according to one of these agents, as assessing the distinctive character with the eye of the “informed user” does not always seem possible for all assessors, the assessment had better be made by the court experts.

Four judges stated that they, in any case, assign court experts to make this assessment; it becomes necessary particularly when the product that the design is applied on is not a commonly used product in daily life, as one of these judges noted.

- **The eye of the informed user.** A judge stated that the eye of the “informed user” should be taken into account while assessing the distinctive character. Nevertheless, he stated that the viewpoint of the “ordinary people”, in short, “the public” [*halk*], is taken into consideration when the product on which the design in question is applied is a commonly used item. Three court experts and two attorneys mentioned that they put themselves in the place of the “informed user” while assessing the distinctive character of a design. Thus, as an attorney stated, identifying the informed user becomes an important concern. Similarly, three TPI experts stated that the assessment should be made from the viewpoint of informed user instead of the eye of an expert.
- **“Degree of freedom” influences the assessment.** According to a court expert and a TPI attorney, bringing distinctive character to a design becomes more difficult in fields in which the designer has a limited degree of freedom. For instance, he noted, a small difference made on the handle of a common table knife can bring the design a distinctive character. Two TPI experts approached the topic from a different angle although it adds up to the same point; they mentioned that they assess the design more strictly in fields which serve a wide degree of freedom to the designer. An attorney and two agents also emphasized the importance of the “degree of freedom”. According to the attorney, standard forms -such as a rubber sole for shoes- should not be

protected, as they can be assumed as forms dictated by their technical function. Similarly, one of the agents specified that such parts -dictated by their technical function- should be eliminated before initiating the assessment.

- **Morphological similarities between designs.** Three court experts, including a jurist court expert, dealt with the similarity between the designs in question. One of these court experts stated that the interrelations and proportions of blocks (masses, bodies), differences between them, the interaction between the added parts, differences in surfaces (differences in textural properties), and colour differences -only if an effect on the main bodies is discussed- are considered. The other court expert had a different attitude; according to him, the important questions are “does the latter design evoke a former one? If so, what is the level of the association? And also, can one of them be replaced by the other, in terms of morphology?”. According to an attorney, if many of the features of a design are used in the design in question as well, then the latter design would not be deemed to have a distinctive character.
- **“Significant difference” between the designs is important.** A court expert, an attorney and an agent emphasized the importance of the “significant difference” between the designs in question. The court expert stated that the significant difference can be *perceived easily* in order for it to bring a distinctive character to the design. Similarly, the attorney who touched this subject noted that if the design in question can be distinguished “significantly” when it is put side by side with the ones in the market, it can be deemed to have a distinctive character.
- **Partial protection/partial invalidity.** According to a TPI expert, a part of a design can bring distinctive character to it; so this part shall be the feature to be protected. Else, he stated, this feature may be sufficient for the whole design to be protected. However, an attorney mentioned that, in accordance with the EU (European Union) law, a common design, despite the fact that some of its components are new and distinctive, shall not be protected.

According to him, the reason for this was that, what matters for the EU law is the “overall impressions” of the designs. However, in Turkey, he stated, the tendency is towards partition; for instance, a table with only some parts bearing novelty and distinctive character, might be declared partially invalid. Nevertheless, according to him, this means that the protection is provided for “something else”, not for the “table design” itself.

- **It is an easy task, since very few really deserve protection...** According to an agent, assessing the distinctive character is not a troublesome process as in our industrial structure, a limited number of entities really deserve the right of protection.

5.1.3 Participants’ priorities in the assessment of distinctive character

As well as these discussions, some methods and strategies related to the assessment process of distinctive character were observed. Some participants gave clues about the way they assess the distinctive character of a design; thus, how the participants prioritise the five major aspects -overall impression, significant difference, informed user, common features and differences, degree of freedom- constituted the first quest in terms of assessment strategies.

The counts given in the tables and figures show the number of participants who *did* present an opinion about the quest. It should be noted that some participants *did not* mention anything about this issue; therefore, the total number of participants is not same for each group in the tables and figures presented below. Another important fact is that the counts do not make sense statistically, and the discussions should not be understood as generalization. They also do not reflect the tendency of the whole population; only the viewpoints of the participants who expressed their ideas were presented.

Table 7 and Figure 2 show the priority given to these five major aspects in the assessment of the distinctive character. The assessment orders were given regardless of the participant groups.

Table 7 The order of five major aspects in accordance with the priority given to them in the assessment of the distinctive character

		aspects (count)				
		overall impression	significant difference	informed user	common features and differences	degree of freedom
priority	1 st	11	3	12	6	1
	2 nd	5	2	3	3	2
	3 rd	3	0	1	3	1
	4 th	1	1	0	3	0
	5 th	0	0	0	0	1

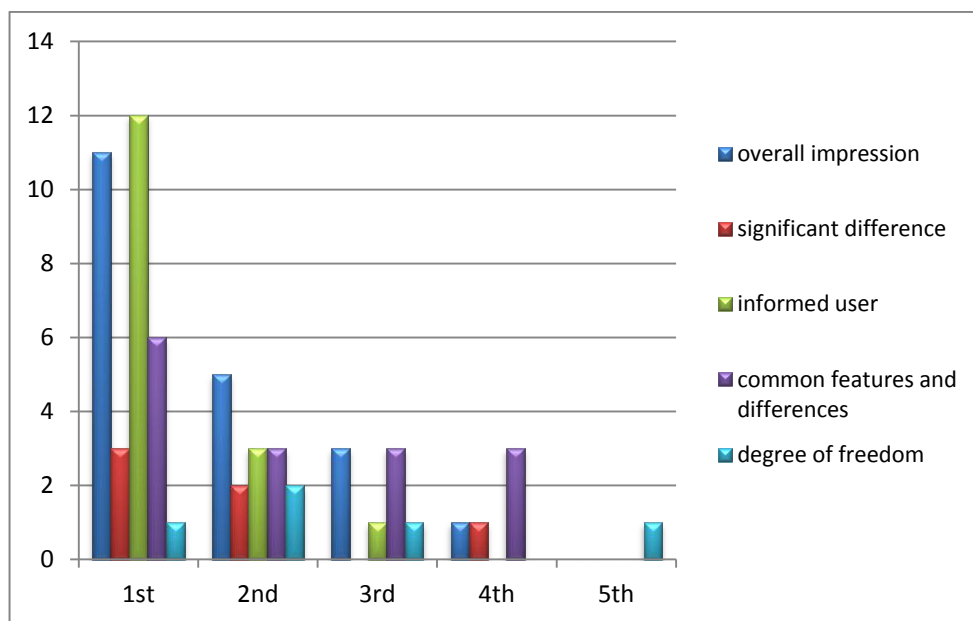


Figure 2 Priority of the aspects throughout the assessment process

As it can be seen in Table 6 and Figure 1, “informed user” and “overall impression” rank at the top in the assessment of distinctive character, as 12 participants stated that they take into account the aspect of “informed user” first of all, and 11 participants mentioned that they primarily consider the “overall impression” of a design while they assess the distinctive character. According to this assignment, it can be said that during the assessment process, parties take into consideration these two aspects

principally. The distribution by the participant groups can also be seen at Table 8 and Figure 3.

Table 8 The aspects assessed in the first place -distribution by parties

		Participant groups (count of participants who presented an opinion within the total number of participants in the group)							Total
		Judges (9 out of 12)	court experts (3 out of 9)	jurist court experts (2 out of 2)	TPI experts (6 out of 7)	Attorneys (6 out of 9)	TPI attorneys (3 out of 3)	Agents (3 out of 9)	
1 st place	overall impression	3	0	0	3	2	1	1	10
	significant difference	2	1	0	0	0	0	0	3
	informed user	3	1	0	2	4	1	1	12
	Common features/ differences	0	1	2	1	0	1	1	6
	Degree of freedom	1	0	0	0	0	0	0	1
Total		9	3	2	6	6	3	3	32

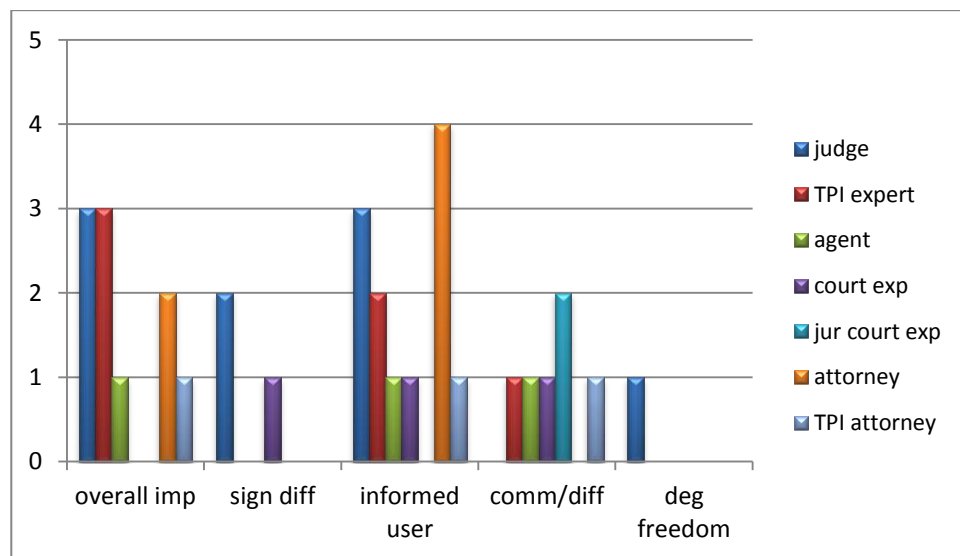


Figure 3 The aspects assessed in the first place -distribution by parties

As it can be understood from Figure 3, the “informed user” of a design was assessed in the first place by particularly the judges and the attorneys. It was also seen that “overall impression” of a design was commonly considered in the first place. The “significant difference” between the designs was found to be the first aspect to be assessed by two judges and two court experts. However, it was observed that the designer’s “degree of freedom” is not commonly ranked in the first place throughout the assessment process.

It was also seen that the participants’ statements supported this idea; both these views and the opinions of the other participants on the other aspects are briefed below.

- **“Overall impression” in the first place.** Three judges, three TPI experts, three attorneys (including a TPI attorney) and an agent emphasized the importance of the “overall impression”, and mentioned that they assess the distinctive character principally with regard to the “overall impression” of the designs in question. One of these judges stated that the important thing is the overall impression of the design, instead of its details. Another one of these judges added that she assesses the “overall impression” in accordance with the eye of the “informed user”. One of these TPI experts noted that even though they take into consideration all the visual elements of the design in question, they particularly base the assessment on the “overall impression”.
- **“Significant difference” in the first place.** According to two judges and a court expert the first step is the examination of the “significant difference”. While examining this aspect, the viewpoint of the “informed user” is taken into account. A jurist court expert, in the same vein, stated that a comparison should be made first of all. In other words, she explores the “significant difference between the overall impressions” amongst the list of “common features” and “differences”.
- **“Informed user” in the first place.** Three judges, a court expert, two TPI experts, five attorneys (including a TPI attorney) and an agent emphasized

that the first notion to be specified is the “informed user”. In other words, they firstly try to determine the figure -informed user- for the design in question, as its nature would dominate the way they assess the design. Also, one of the attorneys regarded the notion of “informed user” as the “breaking point” [*kırılma noktası*] of the assessment of distinctive character.

- **“Common features” and “differences” in the first place.** A court expert, two jurist court experts, a TPI expert, a TPI attorney and an agent noted that they principally take into consideration the common features and differences between the designs in question. According to the TPI expert, the “common features and differences” of the designs remain at the forefront of the assessment. In other words, as he stated, he makes a comparison between the designs in the beginning of the assessment.
- **The “degree of freedom” in the first place.** A judge specified that he begins the assessment with the determination of the designer’s degree of freedom for the design in question, since the degree of freedom, as he stated, indicates how much can a design differentiate in terms of appearance. He also takes into consideration the “common features” and “differences” of a design within the framework of “degree of freedom”. In other words, while assessing the designs in question, he stated, assessor should know whether the common features are counted within the technical constraints or not.

5.1.4 Discussion on the notion and assessment of distinctive character

As this section deals with distinctive character as a notion and its assessment, considering both the opinions of the participants and the way they assess the distinctive character was found to be important. In other words, specifying the sequence in which the aspects are assessed was found considerable instead of determining solely the priority given to them. Even though no specific questions were addressed for the determination of such strategies, the statements of the participants were analysed for that purpose.

The assessment strategies of the participants. Observed strategies are represented below. However, it has to be respecified that some participants *did not* express anything related to the strategy they follow; therefore, the total number of participants *are not* equal to the counts given in the tables presented in the former section. Another important fact is that the counts given in the figures also do not make sense statistically, and the strategies presented should not be understood as generalization. They also reflect only the strategies of the participants who explained the way they assess the distinctive character. These strategies are discussed below. The numbers within the boxes, as well as the line weights, represent the number of participants who follow the way coming up to that box, and each colour represents a different aspect.

In Figure 4, the process is handled in a broad sense; the figure shows the strategies followed by the participants without considering the groups respectively. It was seen that, there have been strategies originating from all of the five aspects, but the most common tendencies were found to be to assess the “overall impression” of the design or to determine the “informed user” principally.

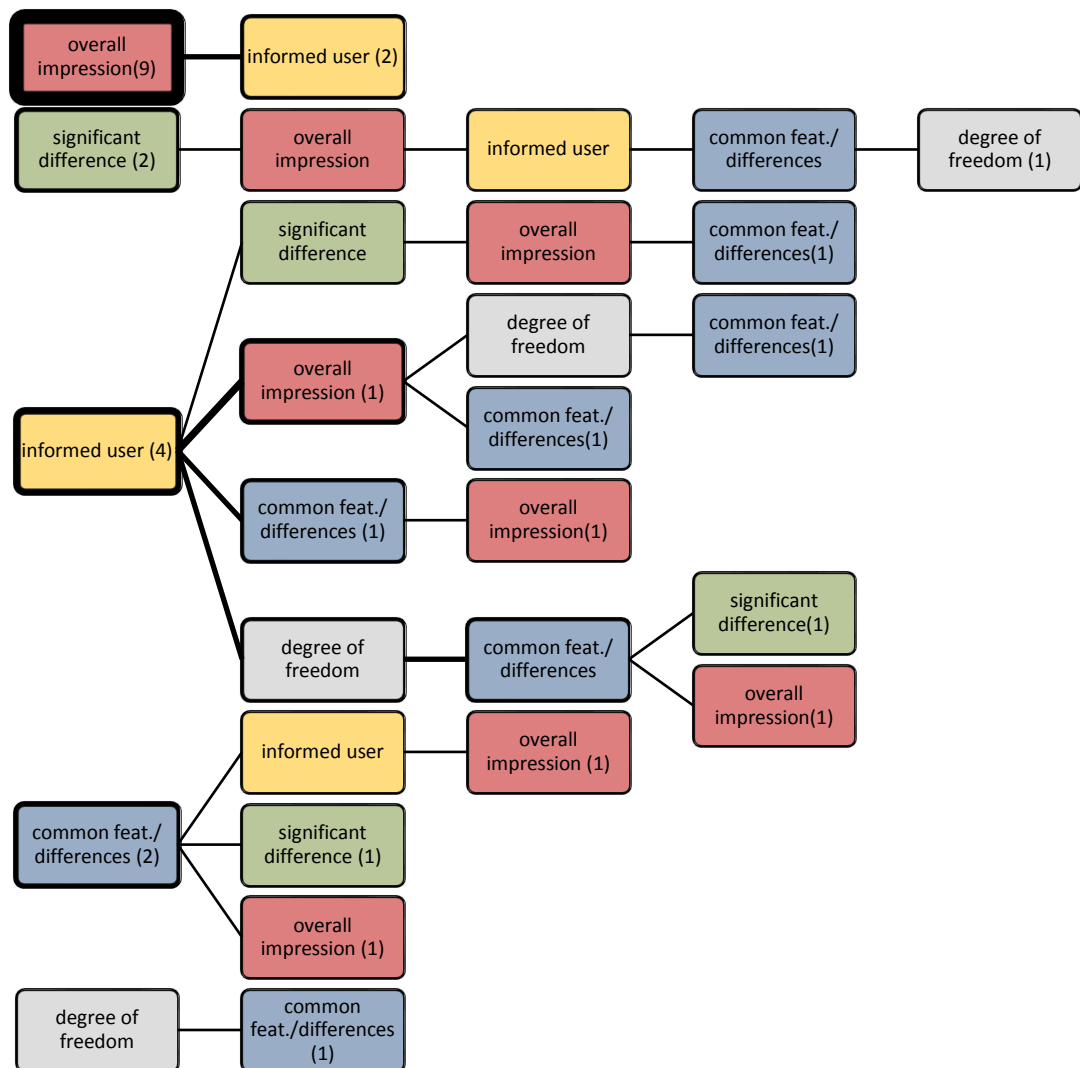


Figure 4 Observed strategies related to the assessment of distinctive character

As it can be seen in Figure 4, nine participants prefer to consider only the “overall impression” of the design. Only two participants tend to determine the informed user for the design in question after looking through the overall impression of it. This situation gives a clue about the effectiveness or about the ease in the evaluation of this aspect -overall impression- in the assessment of distinctive character. In other words, it is possible to say that the participants who preferred to look through the overall impression of a design do not find it necessary to consider any other aspect; considering only the overall impression of a design may be sufficient for them, since

the overall impression says a lot about a design. Nevertheless, a close relationship between the aspects of “overall impression” and “informed user” is also observed when the whole diagram is considered, since these notions generally appear side by side within the paths. Similarly, a close relationship between the aspects of “overall impression” and “common features and differences” can also be observed.

As it was mentioned before, another tendency was to determine the “informed user” of the design in question. Contrary to the former approach, it was observed that the participants, who put the act of identifying the informed user in the first place, follow various ways throughout the whole process. In fact, they follow up several strategies continuing with all the remaining aspects -overall impression of the design, assessment of the significant difference, specification of the common features and differences, and the determination of the designer’s degree of freedom. That is to say, identifying the informed user of the design is naturally not found to be sufficient to hold a view about the distinctive character of the design in question, since it only offers a viewpoint for the assessment; nevertheless, it is deemed a very important issue, since 12 of the participants start the assessment from this point.

Another approach was to start the assessment by specifying the common features and differences between the designs in question. It is possible to say that the common features and differences are specified in order to obtain concrete outputs needed for assessing the overall impression of the designs in question; since the relationship between these two notions can also be observed from Figure 4.

It was seen that only one of the three participants, who start the assessment by specifying the significant difference between the overall impressions of the designs in question, expressed how he assesses the distinctive character in detail. He explained the whole procedure; however, the other participants only stated that they consider the significant difference between designs. This may also give us an idea about the efficiency of this notion. In fact, it is possible to state that discerning a significant difference between designs may lead an idea which accepts the existence of the distinctive character.

The examination of the degree of freedom as a first step was found to be the least mentioned strategy. It is possible to state that the notion of designer's degree of freedom do not come to mind when talking about the assessment process even though it plays a very important role particularly in the assessment of common features and differences. The close relationship between these two notions can also be observed in the diagram, since every box referring to the "degree of freedom" appears nearby the boxes of "common features and differences".

These strategies were also analysed and discussed respecting the groups. Observed assessment strategies of the judges are given below in Figure 5.

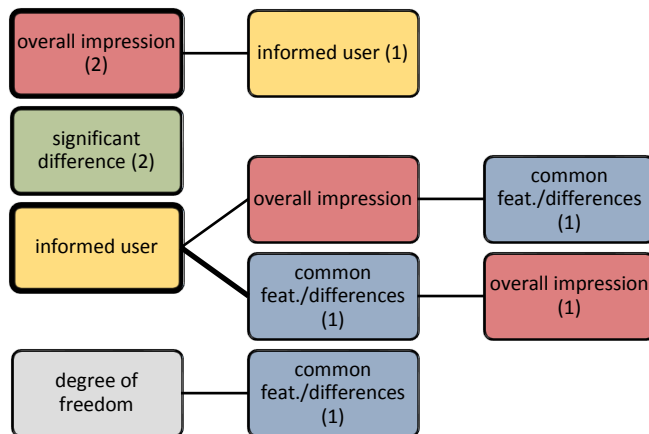


Figure 5 Observed assessment strategies of the judges

As it can be seen from Figure 5, there are roughly four strategies which were expressed by the judges. One of these strategies was to look through only the overall impression of the design, or to examine the existence of a significant difference. It was seen that the only supplementary consideration for the judges who consider the overall impression in the first place is the "informed user". It is possible to state that, once one forms an opinion about the overall impression of a design, or is convinced of the existence of a significant difference; he does not need additional considerations. In this context, the identification of the "informed user" and the specification of the "common features and differences" between designs are seen as supporting considerations, even when the identification of "informed user" itself is

seen as the first step of the assessment. Likewise, the determination of the designer's degree of freedom is seen as a supplementary consideration.

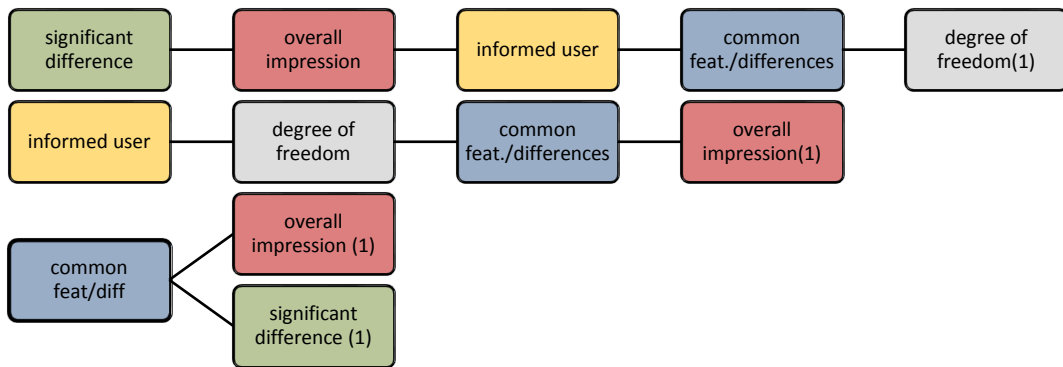


Figure 6 Observed assessment strategies of the court experts

Figure 6 shows the attitudes of the court experts. It was observed that court experts are not in tendency to look through the overall impression in the first place. Instead, it is possible to say that they are in search of concrete inputs for the assessment of overall impression. Contrary to what is expected, degree of freedom also appeared in the latter phases although it refers particularly to technical issues, which can only be assessed by technical court experts.

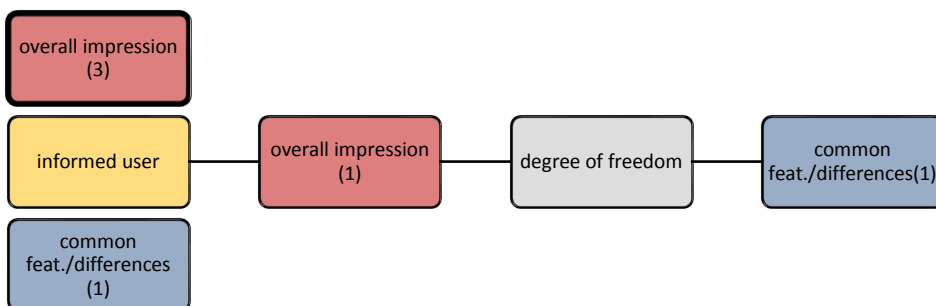


Figure 7 Observed assessment strategies of the TPI experts

As it can be observed in Figure 7, TPI experts are also in tendency to consider the three commonly mentioned aspects; overall impression, informed user, and common features and differences. Besides, it was seen that only one TPI expert presented a

more detailed strategy, and three TPI experts grounded the assessment on the overall impression.

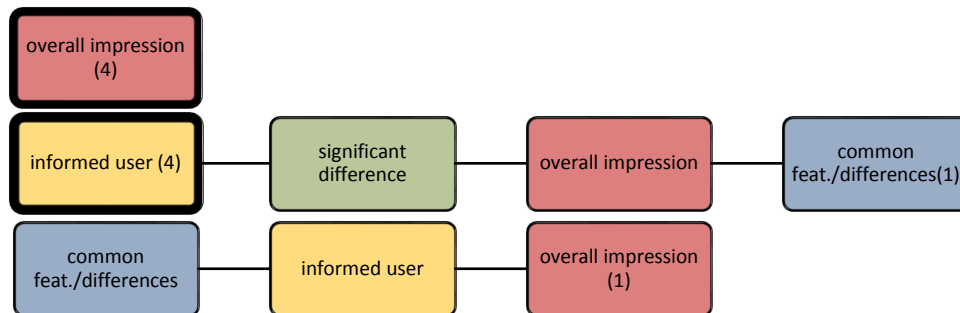


Figure 8 Observed assessment strategies of the attorneys

According to the Figure 8, it is possible to state that the attorneys particularly give weight to the aspects of overall impression and informed user as well as the general tendency. It was seen that they did not point to the designer’s degree of freedom. The reason for such an attitude was thought to be that the assessment of this aspect requires a designing background.

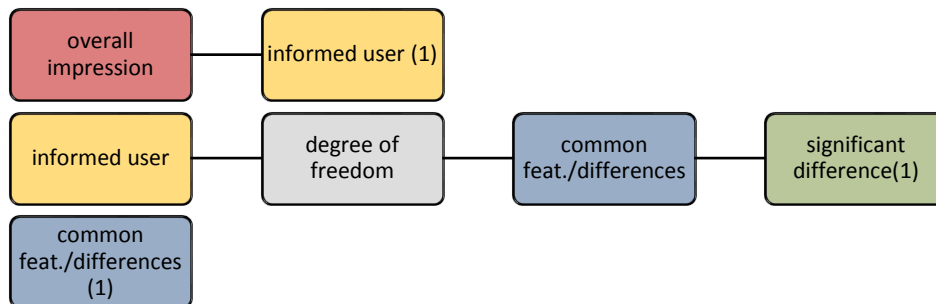


Figure 9 Observed assessment strategies of the agents

As well as the two previously mentioned groups, it was observed that agents *did* give weight to the same three aspects: overall impression, informed user, and common features and differences. It can be said that TPI experts, attorneys and agents are in

tendency to put themselves in the place of informed user, and assess the common features and differences between the designs in question from that viewpoint.

Discussion of the opinions of the participants. It was observed that there has been a view particularly among the jurists, according to which, the presence of distinctive character can be possible when a *different appearance* is achieved. It was also thought that a design should *attract attention at first glance*, even though the said phrase is not involved in any of the available definitions. In short, contrary to what is believed, according to the current legal provisions, *attracting attention at first glance* is not necessary in order for a design to have distinctive character.

Another misconception was to examine the *confusability* of the products on which the designs in question are applied on. This consideration is also not mentioned in the current legislations related to the registration of industrial designs, but it is known that “confusion” [*iltibas*] is an issue mentioned in the legislations related to the unfair competition, which becomes essential only when a design is not protected with a special legal arrangement such as an industrial design registration or patent. Therefore, it would be better to note that the possibility of confusion between the products does not also have an importance in the assessment of distinctive character.

The identification of the fictive person who is to assess a design’s distinctive character was also found to be an important issue. According to a group of participants, the assessment of distinctive character has to be made in the eye of an average consumer or the public. It was seen that such an approach was adopted particularly by the participants who consider the possibility of confusions important. This approach was also thought to be originating from the issue of unfair competition. On the other hand, a larger group of participants defended the idea that assessment of distinctive character of a design should be made from the viewpoint of an informed user, as it is defined so in the current legislations.

Another problematic issue was found to be the relation between the assessment of novelty and that of distinctive character. According to one point of view, these two assessments cannot be made independent from each other. In other words, the

assessment novelty and distinctive character was regarded as a single assessment. However, according to a larger group of participants, these two notions should be assessed individually. In short, the assessment is regarded as a two-step process, in which the second and the more critical step is accepted as the assessment of distinctive character. This approach, when compared to the contrary one, was found more compatible with the current legislations, as the novelty and distinctive character are dealt separately in the Decree-Law no 554.

Nonetheless, there have been common acceptations, such as the subjectivity of the assessment. As a result of this, by almost all groups, court experts were counted as the authorities to assess the distinctive character of a design.

Another common view, which was mentioned by participants from all groups except for the court experts, was that the assessment changes according to the product category. In other words, according to them, the assessment depends on the product on which the design in question is applied, and on the familiarity of the assessor. Interestingly enough, none of the court experts were of the same mind, they, even though, are the bodies who generally make the assessment of distinctive character.

5.2 Overall Impression

5.2.1 What is “overall impression”?

- **The “appearance” of the product.** Three judges, two court experts, three TPI experts and two attorneys (including a TPI attorney) described the “overall impression” as the “appearance” [*dış görünüş, görünüm*] of the product on which the design is applied. The TPI experts mentioned that the assessment of overall impression is made regarding only the appearance, in a sense, according to the visual presentation of the design.
- **The visual impression that the design creates “as a whole”.** According to a judge, three court experts, two attorneys (including a TPI attorney) and two agents, the “overall impression” is the visual impression that a design makes. The judge who is of such an opinion noted that while assessing the overall impression of a design, no extra attention should be drawn on any part of the

design; the design should be assessed as a whole. One of the agents also had a similar attitude and stated that this assessment should be made without going into a detailed evaluation.

- **First image or the impression left at first glance.**
 - **The “image” generated in mind at first glance.** Two judges and a TPI attorney regarded the “overall impression” as the “image” the design generates in mind at first glance.
 - **The “first impression” made by the design.** As it was mentioned before, many participants connected the notion of “overall impression” to the face value of the design, and expressed this idea by using different phrases. However, an attorney used the term “the first impression” for defining the overall impression of the design. According to him, the overall impression is the first impression made by the design at first glance.
 - **Feelings aroused at first glance.** A judge and a court expert stated that they count the overall impression of the design as the feeling it arouses in someone at first glance.

- **A rough image created in mind.** Two judges, a court expert, a TPI expert and two agents had the opinion that the overall impression of the design is an “image” created in mind in various ways. For instance, one of these judges who touched on this subject stated that the overall impression of a design is a “rough image” [*kaba imaj*] kept in the mind of a consumer who does not have a chance to see the designs in question side by side; or, he stated, the “silhouette” [*silüet*] generated in mind during the process of purchase. The other judge used the term “embodiment” [*şekillenme*] for this formation. Similarly, one of these agents specified that the overall impression of a design is the “trace” [*iz*] it leaves in mind.

- **The “mien” or the “essence” of design.** A judge, a TPI expert and an agent regarded the “overall impression” of a design as the mien of the design. The

TPI expert particularly used this term and stated that the “mien of the design” [*tasarımın havası*] constitutes the “overall impression” of the design. She expressed this idea by specifying that the overall impression is something like the “face” of a person; since each looks different despite consisting of the same organs like a mouth, a nose and two eyes. The agent showed a similar approach; he specified that it is possible to notice the difference between designs due to their overall impressions just as we can identify people even if they wear identical clothes. According to the judge who was of the same mind, the overall impression is the “essence” [*öz*] of the design.

- **A “generic” image.** According to a judge, two court experts, a TPI expert and an attorney, the overall impression of a design is directly connected to the well-known image of that design. The term “generic image” [*jenerik görüntü*] was particularly used by a court expert. The judge expressed this idea by using a phrase such as “state of art” which is a concept used in the process of assessing novelty and inventive step in patents. For instance, she stated, the Turkish alcoholic drink glasses generally have long-narrow forms, and this state creates a well-known image in our minds. The other participants who had parallel attitudes gave similar examples such as the forms of the bottle of Coca-Cola, and Mercedes and BMW automobiles.
- **The main components of a design.** Two judges defined the overall impression as “the main components” of the design. In other words, according to him, the prominent parts of a design constitute its overall impression.

5.2.2 Views on the assessment of “overall impression”

- **It is a subjective assessment.** Two TPI experts, a TPI attorney and an agent stated that the assessment of the “overall impression” of a design is a subjective task. One of these TPI experts noted that this subjectivity is by this notion’s nature. Similarly, the other TPI expert stated that the

assessment varies from person to person. According to the agent, the assessment of the overall impression depends on the product category.

- **It is hard to develop criteria.** An agent mentioned that the assessment process of the overall impression is not as simple as it is in the trademarks. For instance, he stated, in trademarks, it may be possible to deem a trademark distinctive among the existing ones, if it has two or more different letters. However, according to him, developing such criteria for the assessment of the overall impression of a design is, contrarily, a very difficult task; since it depends also on the experiences of the assessor.
- **It is related to “perception”.** According to a court expert, two TPI experts, an attorney and an agent, the assessment of overall impression is closely linked with perception. To one of these TPI experts, overall impression is the appearance that the assessor perceives when he/she looks through the design. The attorney who touched on this topic noted that the perception of the assessor even depends on the climate, region or nationality. For instance, he stated, the perception of an Italian would not be the same with that of a Swiss.
- **It is related to the area and level of expertise.** A court expert mentioned that the assessment of the overall impression of a design depends on the assessor’s area and level of expertise. For instance, he stated, a designer may see the details and notice even the smallest differences –such as the bending radiuses or some rotative stripes on them, if any- between two flowerpots and find them dissimilar; however, someone else may consider them as identical or resembling designs.
- **From which side we approach the design is important.** A court expert touched upon the significance of the visual representations within the framework of the assessment of overall impression. To him, the applicants

generally take the photos (or any other means of representing their designs) from specific angles so as to show the most characteristic part of their design. However, he noted, the assessor should assess the overall impression of a design principally by considering the view that comes into sight when the user starts to approach the product on which the design is applied.

- **Components of a complex product are assessed individually.** This topic was dealt by a court expert. She stated that the overall impression of a design applied on a component of a complex product is assessed individually if the component on its own is to be handled as a design; whereas, a complex product is to be assessed in terms of overall impression as a whole if the components are not individually subjected to a registration.
- **Whose eye is to be taken into consideration?** A judge, two TPI experts and an attorney specified that while assessing the overall impression of a design, the assessor should put him/herself into the place of an informed user. Contrarily, a jurist court expert and two agents mentioned that they put themselves in the place of a person who has “no idea” about the design in question, while they assess the overall impression of that design.
- **The primary measure is the “degree of freedom”.** According to a judge and an agent, the primary measure in the assessment of overall impression is the designer’s degree of freedom. The agent noted that the designs of the parts dictated by their technical function should be taken into consideration.
- **Differences between designs are important.** A TPI expert explained the way he assesses the overall impression of a design. He stated that he firstly determines the “common features” and “differences” between designs. To him, the most important inquiry is that whether these differences exist in the other designs on the market or not. If these differences are common between the other designs in the market, he stated, they are not considered as

material differences. In other words, these kinds of differences are of no use in the assessment of overall impression.

- **Is it possible to confuse the designs while purchasing?** Two court experts (including a jurist court expert) and an attorney connected the assessment of overall impressions of designs to, as they stated, that of trademarks. In other words, the possibility of buying another one while trying to buy a specific product constituted their main concern.
- **A preliminary look solves everything.** An attorney specified that a preliminary look may solve everything about the design in question. That is to say, the overall impression of a design can be assessed even with a quick overview performed at the beginning of the process.
- **When the client says that it is different...** An attorney admitted that she counts a design as “different” in terms of overall impression when the client claims so; particularly in cases where she has no idea about the product category on which the design in question is applied.
- **The overall impression of a non-visible design is not important.** The overall impression of the non-visible parts of a design or a design for products which are not visible in normal use found to be of no consequence by a judge and a TPI expert.

5.2.3 Factors influencing the “overall impression” of a design

- **To attract attention “at first glance”.** Attracting the attention of the user was found to be an important feature by two judges, an attorney and an agent. What also matters for one of these judges is that whether the design (or any of its components) impresses the consumer at first glance or not.

- **The differences which are noticed “at first glance”.** A TPI expert touched on this topic and stated that the differences which are noticed at first glance influence the overall impression of the design.
- **What attracts the consumer specifies the overall impression.** According to two judges, components attracting the consumers influence the overall impression of designs. In other words, the feature which actually attracts the consumers was found to be the determinant of the overall impression.
- **Sometimes the designer makes such a difference...** An attorney noted that, sometimes a designer creates such a difference that absolutely changes the overall impression of the design. In other words, in such cases, to him, it is quality of the design that counts, not the quantity. Also a TPI expert showed a similar attitude and stated that two bedside tables, one with two drawers and the other with three drawers, create almost the same overall impressions on the user.
- **Design elements.** According to three court experts, a TPI expert and an agent, some features particularly influence the overall impression of a design. According to one of these court experts, proportions, blocks (masses), volumes and emptiness-fullness ratios influence the overall impressions of designs. Similarly, the other court experts stated that the visible and tangible features of design (such as its form and texture) have impact on the overall impression of it. The agent also noted that texture, colour and kind of material used in design all together constitute the overall impression of it.
- **The material used is not important.** A TPI expert stated that the “material used” itself is not found to be a satisfactory fact to create difference between designs in terms of overall impression. According to him, a design, bearing a resemblance to a previous design but made up of different materials may

fulfil the condition of “novelty”, however it shall probably fail in the assessment of “distinctive character”.

- **Colour.** Two judges specified that solely “a colour change” does not change the overall impression of a design. However, “colour” was found material by an agent. According to him, sometimes colour may influence the overall impression of a design.
- **Dimensional differences.** According a court expert, major dimensional differences may influence the overall impressions of designs.

5.2.4 Discussion on overall impression

One of the prominent issues observed within the scope of the assessment of overall impression was that the misconception between the notions of “overall impression” and “the first impression”. It was observed that the overall impression of a design is sometimes regarded as a “rough image left in mind”, a “silhouette” or an “image left in mind at first glance”. It is known that no definite description related to the notion of overall impression is available in the current legislation -Decree-Law no 554. Thus, every stakeholder puts his own interpretation on this issue, and assigns different meanings to this aspect. However, the term “overall impression” does not stand for “the first impression”, since the evaluation of this aspect requires some considerations such as the degree of freedom, common features and differences, which cannot be evaluated in a split second or “at first glance”.

The phrase “at first glance” was also used for another situation. Attracting the attention at first glance was regarded as a significant factor on the overall impression of a design. However, a design does not have to attract attention in order to present a different overall impression. Besides, contrary to what is believed, the differences between the designs do not have to be noticed *at first glance*. Because, as it was mentioned before, there are several considerations that require in depth evaluations such as the designer’s degree of freedom. In short, a difference may draw a

distinction the overall impressions of two designs although it is not noticed at first glance.

Another problematic issue was the identity of the fictive assessor, whose viewpoint shall serve as basis for the assessment. In other words, for some participants the assessment should be made from the viewpoint of an informed user, while for another group of participants, the fictive assessor should have *no idea* about the design in question. Having such an attitude was thought to have resulted from an understanding that adopts a more strict evaluation in terms of the differences between the overall impressions. Because according to this approach, a difference has to be such obvious that it could be noticed even by a person who knows nothing about the design in question. However, as it is mentioned in our current legislations, the designs should be assessed from the viewpoint of an informed user.

Besides these misconceptions, there are common views related to this aspect. For instance, it is possible to say that the overall impression of a design was associated with the “appearance” of a design. Also, it was regarded as a visual impression, which is created by the design as a whole. Furthermore, the impact of proportions, volumes, emptiness-fullness ratios and some tangible features such as texture were found important.

Another assignation was the subjectivity of the assessment of the overall impression of a design. As it is particularly based on perception, developing guiding criteria related to this issue was also found to be a hard and complicated work. Subjectivity was also observed in some relevant aspects such as the impact of colour, dimension and materials. For instance, some participants thought that a colour change itself is not sufficient to differentiate the overall impression of a design, but some participants were not of the same mind.

5.3 Significant Difference

5.3.1 What is the “significant difference”?

- **Differences which are “out of the ordinary”.** Three judges, a TPI expert, three attorneys (including a TPI attorney) and an agent interpreted the “significant difference” between designs as the differences which are out of ordinary. A judge especially used the term “out of the ordinary” [*alışılmıŷın dıŷında*] while defining the significant difference. Similarly, another judge used the term “not banal” [*banal olmayan*] for a design which bears significant differences. The other judge defined the significant differences as the differences which have not seen before. The TPI expert made a similar definition as “the differences that make the design go beyond the common overall impression stuck on people’s minds”, and he gave a specific example: “Dyson” vacuum cleaners, which did not *look like* any other previously produced vacuum cleaners.
- **Differences which do not evoke a previous design.** According to a judge, two TPI experts and an attorney, if a design has a significant difference, it does not evoke a previous design. In other words, they stated, existence of a significant difference indicates that a previously known design shall not come to the mind of the assessor when the design in question is to be assessed.
- **Differences effecting the purchasing decision.** A judge and two agents stated that the significant difference is a difference that effects the purchasing decision of the consumer. Because, according to one of these agents, it is the “significant difference” that makes people choose *that* design, particularly in some product categories such as automobiles and mobile phones. According to the other agent, the significant difference is the feature rendering the design different from the others in the market.
- **Differences attracting attention at first glance.** A judge and an attorney defined the significant difference as the differences “attracting attention” at first glance. According to the judge who touched on this subject, a difference,

even though it is not significant, shall be deemed sufficient if it is an eye-catching feature.

- **Differences that enable the design to be perceived differently.** A judge stated that a significant difference shall enable the design to be perceived differently from the previous ones.
- **What brings the design its “mien”.** According to a TPI expert, the significant difference is the feature that constitutes the design’s “mien” [*hava*].
- **Something like “state of the art”.** A judge stated that the significant difference is something like the “inventive step” assessed within the “state of the art” in patents.
- **The thing that makes one say “wow!”.** This interpretation was made by an attorney. According to him, the features that make those who see the design say “wow!” can only be regarded as “significant difference”.

5.3.2 Views on the assessment of the “significant difference”

- **Having an impact on the “overall impression”.** It was seen that this aspect has become one of the frequently mentioned topics. Ten participants consisting of three judges, a court expert, three TPI expert, two attorneys (one of these attorneys is a TPI attorney) and an agent stated that the important thing is whether the difference in question influences the “overall impression” of the design or not. In other words, according to them, a difference can be deemed significant only if it has an impact on the overall impression of the design. Also to one of the TPI experts, while assessing the significant difference, the assessor should consider all the components of the design as a whole. Besides, an attorney stated that the components may individually bear a similarity, however the whole may present a different appearance; or vice versa.

- **The impact of function on appearance may affect the assessment.** Two attorneys (one of them is a TPI attorney) and an agent stated that the “function” itself is not taken into consideration in designs, however if it has an impact on the appearance of the design, according to them, the functional contributions may be taken into account in the assessment of the significant difference.
- **Significant difference should be obvious.** A TPI expert and an attorney specified that a difference should be obvious in order to be deemed significant. According to the TPI expert, the assessor needs to realize the difference without taking a look for it in order to accept that it is significant. For instance, he stated, if an expert finds a difference between designs, but thinks that it would not be realized by a consumer, the difference shall not be regarded as significant. Similarly, the agent stated that the significant difference should be “apparent” [*aşikar*] for “everyone”.
- **The assessment should be made according to the prominent feature.** According to an attorney, in the assessment of significant difference, the prominent features of the design, such as colour or materials used, should be taken into consideration. Because according to him, some features of a design generally come to the forefront, and have an impact on the overall impression of it.
- **It depends on the product category.** Two court experts, three TPI experts, three attorneys and an agent noted that the significant difference varies by the product category that the design is applied. According to them, this notion is assessed in different ways for each design.
- **A subjective assessment.** This assessment was found subjective by a TPI expert and three agents. They also stated that there have been no specific criteria for the assessment; and noted that they make this assessment case-based.

- **The perspective of the “informed user” is an important factor.** A judge, three attorneys and an agent considered the view of the “informed user” as a material factor in the assessment of significant difference. Further, according to the judge who touched on this topic, looking from the perspective of the informed user is the most important factor in this assessment. One of these attorneys also emphasized that the assessment of significant difference should not be made with the eye of an ordinary person or a consumer.

- **The assessment should be based on the views of court experts.** An attorney mentioned that this assessment should be based on the views of designer court experts. In other words, according to her, decisions such as the existence of the significant difference should be made by the court experts. Similarly, a jurist court expert stated that the jurists should not get involved in the assessment of design based criteria such as the assessment of significant character.

- **The degree of “inspiration”.** According to a TPI expert, being inspired is an inevitable act in designing; nevertheless, to him, the fact that has to be taken into consideration in the assessment of significant difference is the “degree of inspiration” [*esinlenmenin derecesi*].

- **EU repealed the term “significant”.** This topic was mentioned by an attorney and an agent. They stated that the term “significant” has not been used by the EU since the regulation²⁸ had come into force in year 2001. The attorney stated that the term “significant” raises the level of distinctiveness that is looked for in the assessment of distinctive character. To him, the level in Turkey is higher compared to that in OHIM.

²⁸ The said phrase, which was termed “significant difference” in the Draft Regulation was then changed into “difference” in year 2002 as the COUNCIL REGULATION (EC) No 6/2002 of 12 December 2001 on Community designs came into force.

- **The strictness of the assessment.** A judge emphasized that this notion should be assessed in a “strict” way [*kati*]; nevertheless, according to an agent, the assessment of significant difference should be made more flexibly.
- **The degree of freedom should be taken into account.** The notion “degree of freedom” was found material in this assessment by a judge and a court expert. According to the court expert, if the common features are resulting from a technical function, it shall not be a righteous approach to regard them as “similar” features.
- **The “common features” are important.** A judge and an agent noted that the existence of common features between the designs play an important role in the assessment of significant difference. In other words, they stated, they determine the common features before they regard a difference as significant.
- **“Underlying idea” is important.** Two court experts noted that the newness of the underlying idea in a design is an important issue. Also one of these court experts touched on what the design provides to the user; to say more clearly, the morphological solutions offered for an idea constitutes one of his main concerns.
- **The way it looks on the shelf.** According to a court expert, how the product that the design is applied on looks on the shelf is important in the assessment of significant character. In other words, to him, the visible contributions made on a design and influencing one’s perception threshold also influences the significance of a difference.
- **Bearing the characteristic of the author.** According to an agent, a design should bear the characteristic of its creator in order for it to be deemed to have significant difference. In other words, the design is regarded as a fine arts work and assessed according to these criteria as well as the conditions of “novelty” and “distinctive character”.

- **Visual representation should be of good quality.** An agent touched on this subject. She stated that the assessment is based on the visual representation, and in order to make a righteous assessment, the visual representation of the design should be of good quality.
- **It is hard to object to the claim of the client.** An attorney mentioned that sometimes she naturally disagrees with the claim of her client. However, she stated that it becomes very hard to express an opposite opinion particularly when the product category that the design is applied on is not familiar.

5.3.3 Factors that have an impact on the “significant difference”

- **It is related to both form and feelings recalled.** According to a court expert and an agent, the significant difference should not only be assessed in respect of form, but also the feel the design revives. The attorney stated that in addition to the five senses, “feelings aroused” were taken into consideration.
- **A superior creativity is not needed.** A judge touched upon this topic and specified that a designer is not expected to be fantastically creative in order to obtain a significantly different design. According to her, reaching some degree of distinctiveness is sufficient.
- **Do the former designs involve the differences existing in one of the compared designs?** A TPI expert and two agents found this query important; to them, if the differences between two compared designs also exist in a former design, they should not be regarded as significant differences.
- **Differences in basic geometrical forms.** This factor was found to be important by three judges, three court experts and an agent. According to them, differences made on the basic geometrical form of the design (or product that the design is applied on) notably influence the significant difference. One of the judges expressed his opinion by using the term “silhouette”; to him, the most important factor that has an impact on the

significant difference is the differences made on the “silhouette” [*silüet*] of the design.

- **Colour.** 11 participants touched on this factor. There have been two groups showing contrary approaches. The participants in the first group, consisting of four jurists -three judges and an attorney- asserted that a “colour change” itself cannot be considered as a significant difference. Contrarily, the participants in the second group -a judge, three court experts, two attorneys and an agent- mentioned that a change in colour may be effective in some cases. The judge in this group stated that “different colour combinations” may, in some cases, be regarded as significant difference. Two of these court experts and one of these attorneys mentioned that not regarding the “colour change” itself as a significant difference is a righteous approach; nevertheless, they gave such good examples promoting the idea that colour may sometimes be important. For instance, one of these court experts specified that a colour change made on two paper cups with same forms may be regarded as a significant difference between them. Similarly, the attorney stated that two similarly shaped Turkish tea glasses made up of different colours of glass are deemed to have a significant difference, since, according to him; the colour change in this case brings the said glass into a different state.
- **Ornaments and patterns.** Seven participants consisting of a judge, two TPI experts, three attorneys (including a TPI attorney) and an agent mentioned that “ornaments” [*motifler*] and “patterns” [*desenler*] added on designs play an important role in the assessment of the significant difference. According to some of these participants including the judge, two TPI experts and the agent, the added ornaments and the differences made on common forms have particular influence on the significant difference. According to the agent, the patterns made on a standard shaped plastic bottle set a good example for this situation.

- **Materials used.** A difference concerning the materials used was found to be immaterial in the assessment of the significant difference by two judges and a TPI expert. However, an attorney stated that in some cases, a change in materials may seriously influence the overall impression, and consequently the significant difference. For instance, he stated, a kettle made up of plastic material seems quite different from the similar shaped kettle made up of metal. Therefore according to him, differences regarding materials may sometimes be deemed a significant difference.
- **Dimensional differences are not important.** According to a judge, a TPI expert, two attorneys and an agent, the dimensional differences between designs are not regarded as a significant difference. In other words, to them, two *similar* designs with different sizes should be regarded as *similar* designs; the size of the design does not count.
- **Changes in proportions.** Proportions of the designs are found important by two court experts and an attorney. According to them, difference between the proportions of two designs may be regarded as a significant difference.
- **Graphics.** Two court experts specified that graphics play a considerable role in the assessment of significant difference. For instance, according to one of these court experts, the drawings and patterns on paper cups may be regarded as significant differences.
- **Texture.** According to a court expert, the textural differences made on some surfaces of designs may be counted as significant differences.
- **Solid/void.** This notion was also regarded as an important consideration. According to a court expert, the differences between the solid/void proportions of designs in terms of morphology can have an impact on the significant difference.

- **Having round-edges or hard-edges.** This issue was also found important by a court expert. According to her, the said features may influence the assessment of significant difference.
- **Concavity/convexity.** These features were found material by a court expert and an agent. According to them, a change in the concavity/convexity of the curves on a design may be assumed as a significant difference.
- **The physical size of the differences.** A TPI expert stated that in the assessment of significant difference, the physical size of the difference is never taken into consideration, as it does not have any impact on significant difference.
- **Changes made on the major components.** According to an agent, the changes made on the major components of a design play an important role in the assessment of significant character. Besides, the differences between the basic components of two designs may also be deemed as a significant difference.
- **Sales appeal.** This notion was found considerable by a judge and an attorney. According to the judge, when a design is sorted out from the yields of its trademark, the leading factor becomes the “sales appeal” [*albeni*] in the assessment of significant difference.
- **The differentiation of the product does not always mean the differentiation of design.** A judge stated that, a product that the design is applied on may show an alteration in terms of some factors such as material or colour; however, this would not amount to the differentiation of the design. For instance, according to him, some parts of two tables bearing the same forms but produced from different materials may be counted as different products; nevertheless, their design would remain the same.

5.3.4 Discussion on significant difference

First of all, it must be noted that, the subjectivity of the assessment and its variability according to the product category constituted a basis for the discussions, since it was observed that a considerable part of the comments were established on these assertions.

It is possible to state that the significant difference between the overall impressions of two designs is examined either visually or abstractly. In other words, it is possible to state that a significant difference may exist physically or may refer to the embodiment of an intellectual contribution.

While assessing the physical appearance of a difference, it was observed that some aspects become prominent. For instance, the proportional changes, the graphics, ornaments and patterns on a design, texture, differences between the solid/void ratios, being round-edged or hard-edged, concavity/convexity and the differences related to the major components of a design were found to be influential in the assessment of significant difference. In other words, changes in such features are found to be more likely to differentiate the overall impression of a design.

A colour change, solely, was not found important by a group of participants consisting of jurists; however, it was also stated that it may, in some cases, constitute a significant difference between the overall impressions of the designs in question. The same discussion also goes for the differences in the materials used.

It was observed that some participants found the underlying idea important while assessing a difference in terms of significance. For instance, a difference made on a design may reflect a new functional contribution, and this may be the reason for it to be deemed a significant difference. It was also stated that the significance of a difference is related to both form and feelings it evokes.

Apart from all these, according to one opinion, a difference should be obvious and sightful in order for it to be significant. One of the reasons for showing such an approach was the motivation of affecting the purchase decision of the consumers. In other words, raising the sales appeal of a design was found important.

Furthermore, some participants were in search of a difference which is out of ordinary or of a difference which involves *something* like an inventive step. For some participants, the basis is not evoking a previous design in terms of appearance. Attracting attention at first glance and bearing the characteristics of the designer were also regarded as considerable preferences. Only the court experts were found to be the assessors who are not in tendency to assess the designs in such ways. Besides, it must be noted that *none* of these notions -being out of ordinary, involving inventive step, attracting attention at first glance and bearing the characteristics of the designer - are compulsory for a design to be protected by means of an industrial design registration.

Contrary to the abovementioned view, it was accepted that a superior creativity is not needed to generate a significant difference. A difference, enabling a design to be perceived differently, may instead be sufficient for it to be accepted as a significant difference. What matters is: *does the said difference has an impact on the overall impression of the design in question?*

5.4 Informed User

5.4.1 Views on the notion of “informed user”

- **An important criterion.** The notion of “informed user” was found important in the assessment of distinctive character by 14 participants consisting of three judges, two court experts, four TPI experts, four attorneys (including a TPI attorney) and an agent. According to one of these judges and one of these court experts, the difference between the viewpoints of an informed user and an *uninformed* user is regarded as a considerable difference. Besides, a judge, a TPI expert and an attorney placed special emphasis on this notion, as they stated that the informed user is one of the most substantial criteria in this assessment. According to the attorney who had such an attitude noted that the viewpoint of the informed user is the “critical point” [*kırılma noktası*] of the assessment.

- **A controversial topic.** 11 out of 51 participants, including two court experts, two TPI experts, six attorneys (one of them is a TPI attorney) and two agents, regarded the “informed user” as a controversial topic. Even though the cited points varied upon the participants, it was seen that many of the queries have converged on the definition or the identification of this fictive person. A group of participants, consisting of two TPI experts and two attorneys stated that they find it hard to get a clear definition for this notion; in other words, they found the notion of “informed user” ambiguous and unclear. The other group, including two attorneys and two agents, insisted on “who” this entity was. It was also understood from their expressions that they are in search of a real person who is to be assigned to make this assessment. For instance, one of these attorneys and one of these agents stated that most of the case files she gets do not involve a real user as an assessor. Also, it was seen from the answers of the participants that there were confusions between the notion of “informed user” and a “court expert”; still they are to be discussed further under more relevant titles.
- **There is no clear definition of it.** According to a judge and three TPI experts, there is a need for a clear definition for the “informed user”. The judge specified that laying down average criteria shall be useful for this notion to be understood by all parties more clearly. The TPI experts also stated that there is no clear definition made for the informed user in both national and international legislations.
- **Good for prevarication.** Two attorneys regarded this notion as a phrase used for making things easier in arguments. They stated that many people tend to use this term only when they try to vindicate their clients.

5.4.2 Who is (not) an “informed user”?

- **Not a wholly irrelevant person** [*Hiçbir ilgisi olmayan, tamamen alakasız birisi değil.*]. Two judges, two court experts (including a jurist court expert), two TPI experts, three attorneys (two of them are TPI attorneys) and an agent stated that the informed user is not someone wholly irrelevant to the product

on which the design is applied. The court expert also specified that the informed user is not assumed to be a mentally deficient person.

- **Not an expert.** 19 participants specified that the viewpoint of an informed user is not the viewpoint of an expert. They noted that an expert would consider every possible difference between the designs; however, the eye of an informed user, according to them, is not that precise.
- **Not an “ordinary user”.** According to two court experts, four TPI experts, an attorney and two agents,, “informed user” is different from an “ordinary user “or an “average consumer”. They also stated that the informed user is assumed to be a more qualified entity compared to an ordinary user/consumer. The attorney who touched upon this issue expressed his idea by emphasizing that the informed user is a more qualified person from a “good family father” [*bonus pater familias*²⁹, *iyi aile babası*], who, according to him, is assumed as a person with an average care, and leading a standard life.
- **It is in between an ordinary user and an expert.** Two TPI experts, two attorneys (including a TPI attorney) and an agent specified that the notion of informed user stands between an ordinary user and an expert. According to the agent, it is also assumed to be someone “above average” [*vasatın üstü*].
- **Someone who has an average knowledge about the product.** By two judges and three court experts (including a jurist court expert), an informed user was assumed as a person who has an average knowledge about the product on which the design is applied. One of these judges stated that an informed user is accepted as a person who knows the sector in question more or less. For instance, according to him, a housewife may be accepted as an

²⁹ In Roman law, the term *bonus pater familias* (good family father) refers to a standard of care, analogous to that of the reasonable man in English law (http://en.wikipedia.org/wiki/Bonus_pater_familias)

informed user for kitchenware. One of the court experts also gave the same example, and stated that a housewife would be an informed user for a grater.

- **Someone who is knowledgeable with the design.** 17 participants consisting of three judges, three court experts, five TPI experts, three attorneys (including a TPI attorney) and three agents emphasized that the “informed user” is assumed to be a person who has particular knowledge about the design in question. According to one of these judges, an informed user is someone who analyses the designs in order to be informed about them. To one of these court experts, an informed user is a person who can also hash out the design with other people, and make comments about it. One of the agents, in a similar vein, mentioned that it is a person who has comprehensive knowledge in the field of the design in question. Two TPI experts and an agent noted that it is someone who can make comparisons between designs.
- **Someone relevant to the market.** This point was found material by 13 participants consisting of four judges, two court experts (including a jurist court expert), four TPI experts, two attorneys (one of them is a TPI attorney) and an agent. According to them, the informed user can be someone who shops in the relevant sector. According to one of these judges, an informed user can also be person who sells the product that the design is applied on or anyone who is relevant to the sector of the design in question. Similarly, another one of these judges specified that it is someone who regularly deals with the design in question in the market or carries on a business in the relevant sector. According to him, for instance, while assessing the design of a window profile, the informed user can be assumed as a contractor. Another important issue which was pointed out by a jurist court expert and three TPI experts was keeping up with the market. In their opinion, an informed user follows the market and keeps himself/herself informed of the innovations and latest trends.
- **People who “use” the product in question.** Three judges, two court experts, a jurist court expert, a TPI expert, three attorneys and an agent specified that

an informed user is assumed to be a person who uses the product on which the design in question is applied. However, “usage” was not counted in the narrowest sense, as two of these judges gave the same specific case as an example for this topic; according to them, while assessing a dentist’s chair, the informed user should be assumed as the dentist, not the patient. Besides, one of these judges also stated that if a design of an armchair is in question, the informed user would be assumed as the *purchaser* of it. The other judge, in the same vein, stated that if a chocolate design is in question, the informed user can be assumed to be a child. One of the attorneys and the agent who touched upon this topic also specified that an informed user is assumed to be an “experienced” [*deneyimli*] and “careful” [*dikkatli*] user. Another one of these attorneys stated that the informed user is someone who “consciously” [*bilinçli olarak*] uses the product on which the design is applied on.

- **It depends on the product category.** Four judges, two court experts (one of them is a jurist court expert), a TPI expert, an attorney and three agents mentioned that the entity of informed user alters according to the product category related to the design in question. Also, according to one of these judges, the quality of the informed user differs according to the product category as well; for instance, if the design is related to a chewing gum, then the informed user would be assumed as an end user.
- **Anybody can be assumed as an informed user in designs of products commonly used in daily life.** Two judges, a court expert and a TPI attorney mentioned that anybody can be considered as an informed user if we are to assess a design applied on a product which is frequently used in our daily lives. For instance, according to one of these judges, any person can be assumed as an informed user while an ashtray design is being assessed.
- **The “end user”?** A court expert stated that the informed user does not have to be the end user of the product that the design in question is applied on. According to her, for instance, it can be assumed as a wholesaler in the

relevant sector. On the other hand, two TPI attorneys noted that the informed user can be counted as an “end user/consumer” [*nihai tüketici*] in some cases.

- **Someone familiar to the product in question.** According to an agent, an informed user may be assumed as a person who, in the everyday life, is familiar to the product on which the design is applied.
- **Someone who intends to buy it.** According to a court expert, an informed user can in some cases be supposed as a person who only intends to buy the product on which the design in question is applied; as he/she, for that purpose, would tend to gather information about it.
- **Someone who knows how to use it.** A court expert and a TPI attorney touched upon this subject. According to them, if a design for special-purpose products -particularly technical products- are in question, the informed user is supposed to be person who knows how to use it. For example, if we are to assess a design for a welding machine, then the informed user is assumed to be the operators of such machines. He also gave another example to express the idea; if a “lithotripter-a kidney stone crushing equipment” [*böbrek taşı kırma makinesi*] design is in question, the informed user should be assumed as the physician who uses it.
- **Someone who knows the technical requirements and limitations.** A TPI expert noted that an informed user is assumed to be a person who knows the technical requirements and limitations of the product that the design in question is applied on.
- **It doesn’t have to be a trained person.** Two judges noted that an informed user can be assumed as a trained/skilled person or not. Similarly, an agent stated that an informed user may be assumed as an uneducated mechanic’s helper in some cases.
- **Not the manufacturer.** According to two TPI experts, informed user is not the person who manufactures the product on which the design is applied.

- **A “highbrowed” person.** A judge regarded the informed user as a “highbrowed” [*kültür seviyesi yüksek*] person.
- **A “high school graduate”.** An attorney specified that he regards the informed user as an ordinary “high school graduate” [*lise mezunu*].
- **Not a fixed user.** Two TPI experts emphasized that the informed user is not a pre-determined, fixed user. The term “fixed user” [*sabit bir kullanıcı*] was particularly used by one of these experts; according to him, instead, “informed user” is an adjective used for describing the anticipated viewpoint of the assessor.
- **It is a “fictitious” person.** A judge mentioned that the informed user is a “fictitious” [*farazi*] person.
- **“Attitude” of an informed user.** According to a TPI expert and an attorney, an informed user neither misses the details nor gets swamped with them. An agent also had a similar opinion; according to him, an informed user should be assumed as a person who shows an integrated approach during the assessment, and as an objective person who controls himself even though he tends to go into particulars.
- **There is no such consideration as the “informed user” in practice.** Two attorneys and an agent noted that the notion of informed user finds no place in practice. According to the agent, a person may be knowledgeable with a product category but may not be so in another category. Thus, he stated, it becomes almost impossible to find an informed user for each design. One of the attorneys also stated that assessing the designs with the eye of the informed user does not have an importance, since, according to her, in most of the cases, the *real* informed users are not involved in the assessment process. Another attorney stated that the notion of informed user is used only when people need to prevaricate. Over and above this, according to her, it does not make any sense.

5.4.3 Views on assessing the design from the viewpoint of an “informed user”

- **Designs should be assessed from the viewpoint of an informed user.** 16 participants consisting of four judges, a court expert, three TPI experts, three attorneys (including a TPI attorney) and five agents emphasized the importance of the viewpoint of informed user. According to them, the assessment of distinctive character should be made from the eye of an informed user. A judge also stated that keeping the level of the assessor higher or lower than the anticipated -the level of informed user- may create an unfair situation for one of the parties.
- **A higher level of assessment compared to that of trademarks.** According to three judges, a court expert, two TPI experts, an attorney and an agent, the assessment of designs involves a higher threshold compared to that of trademarks. In other words, an “informed user” is assumed to be a more qualified person in comparison with an “average consumer” [*ortalama tüketicisi*], who is assumed as the fictive assessor in trademarks.
- **The “target group” of the product is important.** Two judges and an attorney emphasized the importance of the “target group” [*hedef kitle*] of the products on which the design in question is applied. As the informed user shall be assumed to be a person figured among this group, the target audience, to them, play an important role in the assessment. For instance, according to a judge, if an automobile design is to be assessed, a child cannot be assumed as an informed user.
- **What the court expects is not the viewpoint of the court expert himself.** Two judges mentioned that, in the assessment of distinctive character, they are not looking for the views of the court experts representing their own viewpoints as a “court expert”; contrarily, they would like the court experts to put themselves in the place of an informed user and then to assess the design from that viewpoint. A TPI expert also had a similar attitude and noted that it is not the viewpoint of the court expert that the court wants.

- **The viewpoint of the assessor changes according to some factors.** A judge stated that the life style and social status of the assessor influences the way he/she assesses the designs. Similarly, another judge mentioned that the viewpoint of the assessor would change according to his/her education level and knowledge. A court expert also considered the assessment process as a subjective act, and noted that age and nationality of the assessor may influence the attitude of him/her. Two attorneys (including a TPI attorney) also shared the same opinion. Thus, the viewpoint of the informed user was found to be a subjective aspect by five participants, due to the reasons given above.
- **The assessment had better be made from the viewpoint of an “uninformed user”.** According to an agent, the viewpoint of an “uninformed” [*bilgilenmemiş*] user is more important than that of an informed user. According to him, the distinctive character of the future designs shall be more obvious and clear if we assess them with the eye of an uninformed user.

5.4.4 Discussions on the notion of informed user

Pursuant to the comments made, it is possible to say that “informed user”, either as a notion or as a means of assessment, ensues as one of the most important issues. It was also observed that the notion of informed user is one of the most problematic topics. Even though many participants were conscious of making the assessment of distinctive character from the viewpoint of an informed user, there were major deficiencies in terms of the identification and interpretation of this notion. It was also thought that the act of assessing the designs from the viewpoint of an informed user involves subjective aspects.

The first and the foremost issue was that *no* clear definitions related to the notion of informed user do exist in the current legislations. Thus, the identification of this notion was regarded to be an ambiguous act and the identity of this fictive assessor was found unclear. It was also seen that the participants are more likely to be sure of

who is *not* an informed user. For instance, it was accepted that an informed user is not a wholly irrelevant person, not an expert and naturally, not a fixed person suitable for *every* case. However, there were some views, according to which, the viewpoint of the informed user is underestimated; or a *real* person is sought, particularly in position of a court expert. This indicates a deep misconception, and shall be discussed under more relevant titles.

Still, it is possible to say that many participants do know that an informed user is a fictive person, whose eye is taken into consideration while assessing the distinctive character of a design, and his viewpoint is substantial in the determination of the distinctiveness threshold for a design. The general view was that, an informed user is someone who is knowledgeable with the design in question, is familiar to the relevant market, and may be a user of the product on which the design in question is applied on, and in between an ordinary user and an expert. However, according to another view, *anyone* can be deemed an informed user when a design, applied on a commonly used product, is in question.

5.5 Common features and differences between designs

“In determining the scope of protection, common features shall be given more weight than differences...” (Decree-Law no 554, Article 11)

5.5.1 Views on the assessment of “common features and differences” between designs

- **There are hardly any novel designs.** According to a judge, a TPI expert, an attorney and an agent, parties are not in search of producing really new designs. The judge stated that there are hardly any “original” designs; many people, according to her, observe new designs in fairs organised abroad, and get inspired by them. The TPI expert noted that there has been a lack of intend of creating new designs.
- **It is an ambiguous statement.** Two TPI experts emphasized the ambiguity of the expression stated in the Decree-Law. One of the experts specified that such an expression does not exist in the international legislations.

- **It is a useful way for preventing counterfeiting mechanism.** A court expert specified that giving weight to the common features between designs is a useful approach for preventing counterfeiting.

5.5.2 How are the “common features” and “differences” assessed?

- **Firstly the common features are assessed, and then the differences.** Two judges, four court experts (one is a jurist court expert), a TPI expert and a TPI attorney specified that they principally try to determine the common features between the designs in question, and then they designate the differences between them. Three court experts noted that they generally make lists for common features and differences respectively in order to clarify them.
- **They both are assessed at a single glance.** A judge and two court experts specified that they actually assess the common feature and differences between the designs at a single glance. According to the court experts, everything falls into place when the overall impression is created in mind. Also to one of them, it also depends on the feeling the design evokes.
- **Weight is given to the “common features”.** Nine participants, consisting of three judges, three court experts, a TPI expert, an attorney and an agent, mentioned that they give weight to the common features, as it is suggested so in the Decree-Law.
- **Differences have importance, as well.** Contrary to the approach referred above, nine other participants, including three judges, two court experts (one of them are a jurist court expert), two TPI experts and two attorneys stated that they place emphasis on the differences as much as the common features. According to one of these judges, showing such an approach is promoted in the Decree-Law; however, although this act seems to be in favour of the owners of former designs, it shall be also useful to look from different points of view. He also stated that such an approach would not limit the following designs; instead, it will ramp up the will to make innovations. Similarly, another judge found it necessary for justice to consider the differences as well

as the common features. One of the court experts approached the topic from a different standpoint; to him, giving weight to the common features shall bring the assessor to a point where he/she rates every design as the identical of another. For instance, according to him, every human being has the same organs on his/her face, and if we regard them as the common features of two individuals, we shall infer that they are “identical” even though they are not. Two attorneys also noted that they give more importance to the differences compared to the common features between the designs in question.

- **Are the differences significant or can they be counted as immaterial details?** A judge and a court expert touched upon this issue. They stated that while they are assessing the differences, they try to answer the question: “Are the differences significant or can they be counted as immaterial details?”. According to the judge, if the differences found are to be regarded as immaterial details, the design would then not be assumed to have a distinctive character.
- **What is the degree of inspiration?** This issue was found important by a TPI expert. According to him, the fundamental query is the intent of the designer. He stated that if he sees the contribution of the designer of the latter design, he may, in some cases, underestimate the common features between the designs in question.
- **We take into account the statements of both parties.** A TPI expert stated that he reads the statements of both parties before he starts to assess the common features and differences between their designs.
- **If we *try* to find differences, we can.** According to a court expert, if she wants to find some differences she would. However, according to her, this does not have an importance in the assessment, as the opposite would be possible as well. Thus, she stated, such an approach would not indicate the designs’ being different.

- **The assessment depends on the case.** A judge and two attorneys noted that the way of assessment alters from case to case. Also, according to two TPI experts and two agents, the assessment depends on the category of the design in question. According to the agents, in the same vein, it depends on the design's Locarno class and subclass.
- **Expressing “every” common feature should not be necessary.** A court expert stated that while preparing the expert report, they are obliged to write down all the common features between the designs in question, even the circularity of the brims of two drinking glasses, in order to satisfy both parties. To her, the assessment can be made in a more refined way.
- **Visual representation should be of good quality.** A jurist court expert touched upon this topic and noted that the visual representation of the designs should be of good quality, as the assessment is generally made through these documents.
- **The attitude of the assessors while assessing the common features and differences.** Two attorneys and an agent stated that the client has to make them believe that the design in question is new and has distinctive character. Otherwise, they stated, they do not accept the case. Thus, the way they assess the common features and differences, they stated, do not change according to their positions. Another agent noted that he tries to make his client empathise with the opposite party by posing the question “what would you do if you were in the position of the opposite party?” or for instance, he asks the question “what would you do if *your* design was the former one?” when he is faced with a design having many features in common with a former design. Contrarily, an attorney and an agent acknowledged that their attitude changes due to their position. For instance, they stated, if they are the claimant in a case, they focus on the common differences; in the contrary case -if they are defendant- they generally be in tendency to underline the differences.

5.5.3 Which factors influence the assessment of “common features and differences” between designs?

- **Quantity is not important.** A judge, two court experts, two TPI experts and two TPI attorneys mentioned that the number of differences or common features does not have an importance in the assessment. The court experts and one of the TPI experts stated that in some cases, even one difference can bring the design a distinctive character despite many common features.
- **The “overall impression”.** 11 participants consisting of three judges, three court experts, a TPI expert, three attorneys (including a TPI attorney) and an agent emphasized that the impact of the differences or the common features on the overall impression of the design is deemed significant. In other words, they stated, they assess the designs’ common features and differences by considering the design’s overall impression. One of the judges expressed that the resemblance between the “silhouettes” [*siliüetler*] of the designs wipes off [*siler atar*] the differences between them.
- **The “first impression”.** The first impression created by a design was found to be essential by a judge and an attorney. According to the judge, for instance, if the design, as a whole, evokes a pre-existing design, it can be said that it has a lot of common features.
- **The “appearance” of designs.** According to two judges and a court expert, the “appearance” [*dış görünüş, genel görünüş*] of designs is found to be influential in the assessment of differences and common features. One of the judges added that the “contours” [*ana hatlar*] of the designs are also taken into account in this assessment.
- **The differences bringing “originality” to the design.** A judge noted that the differences bringing originality to the design are taken into consideration in the assessment of differences and common features.
- **Differences attracting attention.** According to a judge and an attorney, if the differences of a design “attract the attention” of the “consumer” or

“impress” him/her, the design shall be regarded as new or to have distinctive character. For instance, according to the judge, a square plate is regarded as a new design. Another judge and an agent approached the topic from a different viewpoint; to them, the differences which can be realised by an “informed user” are taken into account in the assessment.

- **Differences which go beyond an immaterial detail.** A judge and an attorney touched upon this issue; to them, the differences should be more than an immaterial detail in order for them to be considered in this assessment.
- **If the common features are “publicly known”...** According to a judge and a TPI expert, whether common features between the designs in question are publicly known is an important issue. According to the TPI expert, one of the significant queries is that whether these common features are already known in the relevant sector or not. Another judge and an attorney stated that if the common features between the designs are “publicly known” [*harcialem*], even small differences may be considered as significant differences between the designs in question, and play an important role in the assessment of distinctive character. According to the judge, for instance, the handles or some other ornaments of a simple, rectangular wardrobe may be regarded as a “difference” while comparing the designs in question.
- **Designer’s degree of freedom.** Eight participants consisting of a judge, a jurist court expert, three TPI experts, two attorneys and an agent touched upon this topic and mentioned that they take into consideration the technical necessities and the designer’s degree of freedom while assessing the common features and differences between designs. The judge and one of the TPI experts specified that common features which are dictated by their technical functions would not indicate a resemblance between the designs. In other words, they stated that they take into account the features which fall outside the technical necessities.

- **Differences which have not been seen before.** A judge and two TPI experts noted that they take into consideration the differences which are not made in previous designs. One of the TPI experts specified that the important thing is that whether these differences are familiar in the relevant sector or not. According to the other TPI expert, asserting the idea that “this design cannot change anymore, that’s the end of it” would be an inadvisable approach, as the design field does not have limits. Thus, according to him, expecting unseen differences is natural.
- **The point that brings distinctive character to the design.** An attorney and a TPI expert mentioned that if they see a point bringing distinctive character to the design, they fix upon it and no longer assess the common features and differences between them one by one.
- **A fundamental change is needed.** An agent stated that what he is looking for is a fundamental change. To him, the design should become different to the core.
- **Function.** Three judges mentioned that they place no emphasis on the “function” of the products on which the designs in question is applied while they are assessing the differences and common features between them. However, a court expert stated that he assesses the designs according to the efficacy they bring to the user as well. For instance, according to him, a design may provide an ergonomic solution to a problem by a very small difference made on it; in such situations, he stated, this small difference gains importance.
- **Colour.** Two judges stated that very special colour combinations in a design can be regarded as a difference, and by this way, can be protected. However, another judge and an attorney stated that “colour” by itself cannot be counted as a difference between designs. According to the attorney, colour can only be considered if the forms of the designs in question are similar.

- **Dimensional differences.** A judge noted that the dimensional differences between two designs would not be considered as a difference between them.
- **The location (position) of the elements.** This topic was touched by a court expert and an agent. According to them, the position of the formal elements on the main body plays an important role in this assessment.
- **Proportions.** An attorney stated that the proportions of the designs play an important role while determining the common features and differences between the designs in question.

5.5.4 Discussion on the assessment of common features and differences between designs

Firstly, it is possible to say that the logic of giving weight to the common features was not comprehended enough by some participants. This ambiguity may have resulted from the lack of a justified definition, explaining the underlying reasons for proposing such an approach.

It is known that the logic of placing emphasis on the common features between the designs instead of differences is nothing more than prompting the assessor to notice possible counterfeiting cases by revealing the resembling points. However, it was seen that this purpose was understood differently by a group of participants; and it was regarded as an approach according to which, the differences between designs are neglected. Thus, two opposing views emerged. According to the first view, the weight has to be given to the common features, since they are regarded as the main indicators of unfavourable resemblances. Contrarily, a group of participants defended the idea of giving weight to the differences, as well as the common features.

According to them, this is the only way to lead up new designs, since, for them; giving weight to the common features would block most of the new attempts made with the intention of creating new designs.

In the assessment, it was observed that making lists for both the common features and differences is a preferable method for presenting all the features objectively. In

this stage, writing down *all* the common features was, in some cases, found unnecessary. However, considering that these lists may be read by many people including non-experts, being non-selective while putting forth the features, would be a righteous approach.

It is also possible to state that some features such as the ones resulting from a technical function and the ones, which are publicly known, are not considered as the *common* features between two designs, although they are involved in the list of common features. Besides, the *quantity* of the common features or differences was found insignificant, as the *quality* of them is what matters. For instance, in a case, only one difference may bring a design distinctive character, while a large number of differences may not in another case; also the same goes for a common feature in terms of revealing a counterfeiting.

Apart from all these, a common approach was to consider the impact of the common features and differences on the overall impression of a design. This was found to be righteous approach after revealing all the features without being selective.

5.6 Designer's degree of freedom

“In the assessment of the individual character, the emphasis of evaluation shall be on the common features of the designs and the degree of freedom of the designer in developing the design shall also be taken into consideration” (Decree-Law no 554, Article 7).

5.6.1 Views on the notion of “degree of freedom” of the designer

- **A very important notion.** 21 participants, consisting of four judges, five court experts (including a jurist court expert), five TPI experts, four attorneys (three of them are TPI attorneys) and three agents emphasized the importance of the designer's “degree of freedom” in developing a design. They stated that this notion plays a significant role in the assessment of distinctive character.
- **No degree of freedom means, there exists *no* alternative, and the design in question *has to be* designed as it is.** According to 16 participants

involving five judges, four court experts, three TPI experts, two attorneys and two agents, to be lacking in “degree of freedom” means that in developing the design, the designer has *no* other choice except for using the existing figuration, which has already been used in former designs. This obligation was connected to the technical necessities. For instance, according to an agent, the designs dictated by their technical function leave no degree of freedom to the designer. Similarly, a court expert noted that every part defined by a function narrows down the designer’s degree of freedom.

- **Technical/functional contributions should be protected by other means.** A judge, a court expert, two attorneys (one of them is a TPI attorney) and two agents touched upon this topic. According to them, industrial design registrations deal with the appearance of the design instead of its function; thus, the functional contributions should be protected by the other branches of intellectual property rights such as patents or utility models.
- **This notion is disregarded in practice.** Two attorneys and an agent stated that the notion of “degree of freedom” is unfortunately not considered important in practice. According to them, the paragraph related to the “degree of freedom” of the designer (last paragraph of a.7 in the Decree-Law) is out of use.

5.6.2 Views on the assessment of the “degree of freedom” of the designer

- **It depends on the product category.** According to three TPI experts, an attorney and two agents, the assessment of the designer’s degree of freedom changes according to the category of the product on which the design in question is applied. For instance, according to two of these TPI experts and an agent, the degree of freedom is wider in two dimensional designs, such as pattern designs and drawings.
- **The degree of freedom should be assessed by the technical court experts.** Six judges, a jurist court expert and an agent specified that the assessment of the degree of freedom should be made by the technical court experts, as it is a

technical issue more than a juridical act. They and a TPI expert also stated that the court experts should clearly explain the technical requirements with their grounds. According to the jurist court expert, the TPI expert and the agent, the court expert who is to assess the designer's degree of freedom has to have knowledge of the field that the design is included. One of the judges also stated that the court experts should benefit from their professional knowledge without being limited with the submitted evidences, as absolute novelty is required.

- **Designs *solely* resulting from technical necessities are not protected.** A judge, two court experts, three TPI experts and two attorneys (including a TPI attorney) specified that the designs or the parts of designs solely resulting from features dictated by technical necessities fall out of protection. Another attorney noted that nonetheless there are many designs just like that. Eight participants consisting of a judge, a court expert, four TPI experts, an attorney and an agent gave the same example for explaining the features dictated by their technical function: “car wheels”. According to them, a car wheel has to be circular, and its form cannot be protected as it's solely dictated by its function; whereas the tread patterns of tires can be protected. Another judge and another court expert explained this approach by giving another example: drinking glasses. According to them, drinking glasses have to involve a space to hold the liquid inside of it, thus this feature shall not be protected. Similarly, according to an attorney, the design of the lip of a bottle opener can be considered as a component dictated by its technical function, whereas the handle part leaves the designer a particular degree of freedom.
 - **Features dictated by a technical function are excluded.** According to a judge, two court experts, a TPI expert and an attorney design features resulting from technical functions are sorted out before the assessment of distinctive character. According to the attorney, such features may be used in a design; nonetheless the remaining parts should be differentiated. A court expert mentioned that the outdated

technologies should be excluded from the scope of technical constraints. For instance, she stated, the technical features of a “bin blender” [*hamur karma makinesi*], designed as it was in the 1800s, should not be considered as a technical necessity. Today, according to her, there have been various advanced models such as power-operated ones; so, saying “that’s all, this feature cannot be improved in no way anymore” in all cases shall not be an entirely righteous approach. Similarly, a judge gave the mobile phone designs as an example for this approach. Also another court expert stated that she considers the modifiability of a feature while she assesses the designer’s degree of freedom.

- **Excluding such designs/features is a righteous approach.** Four judges, three court experts, an attorney and an agent stated that protecting the designs of the components dictated by a technical function and giving the right of using the forms resulting from technical necessities to one entity would not be an equitable manner, as it may, in time, cause monopolisation. According to one of these judges, the reason why these features are excluded from protection is to enable the other parties to develop new designs involving these obligatory features as well.
- **Functional designs versus aesthetical designs.** A TPI expert presented her opinion about the design types; according to her, designs split up into two groups: functional designs (such as machines) and aesthetical designs (such as furniture, textiles etc.). In aesthetical designs, she stated, the designers generally have a wide degree of freedom, while in functional ones, just the contrary. For instance, according to her, while developing a lawnmower, the designer has a limited degree of freedom.
- **The degree of freedom is limited in spare part designs.** According to an attorney, the notion of “degree of freedom” emerges in spare part designs or designs of components. According to him, the designer’s degree of freedom is very limited while developing a spare part or a component.

- **Product typology should be taken into consideration.** A court expert, three attorneys and three agents touched upon this issue. The court expert stated that the degree of freedom should not be assessed before the typological differences are reviewed. Similarly, one of these attorneys noted that the product range in the relevant sector should be reviewed before assessing the degree of freedom. According to another one of the attorneys and one of the agents, the typology of the product that the design is to be applied on, generally limits the designer. According to the attorney, some products need to be designed in particular typologies; for instance, a car needs to be designed like a “car”.
- **“Standards” play important role.** According to a TPI expert and an agent, the industrial standards influence the degree of freedom as well as the technical constraints. For instance, according to the TPI expert, no technical constraints exist in a power socket design; in fact, it may be designed in various forms; however, the standards here narrow down the designer’s degree of freedom. The agent, in the same vein, gave another example; according to him, the design of a gas cylinder does not involve technical constraints in terms of form; however, the designer’s degree of freedom is also limited because of the industrial standards.
- **“What is the reason for developing such a design, while there is a wide degree of freedom?”** This query was found to be important by two judges and an attorney. They stated that they ask this question to themselves while they are assessing the designs. According to them, a wide degree of freedom gives the designer an opportunity to create many new designs, so the coinciding similarities gain importance in such cases.
- **Small differences gain importance as the degree of freedom decreases.** 12 participants consisting of three judges, two court experts, a TPI expert, four attorneys (including three TPI attorneys) and an agent made such an interpretation about the assessment of the designer’s degree of freedom. According to them, small differences or immaterial details gain important as

the degree of freedom decreases. The term “crowded art”- a term related to the patent law- was also used by a court expert and an attorney in order to explain another approach close to the mentioned attitude. According to the 12 participants who have stated such an opinion, in the fields in which there have been a lot of designs, small differences may bring the design in question a distinctive character.

- **Size of the product.** An attorney mentioned that the size of the product on which the design is to be applied influences the designer’s degree of freedom. According to him, the degree of freedom is directly proportional with the size. For instance, he stated, the designer’s degree of freedom decreases as the product gets smaller; and it gets wider as the product enlarges in size.
- **The designer has freedom almost in every case.** Two court experts and two attorneys asserted that designers have freedom in developing new designs in almost every field. According to one of these court experts, a designer is capable of developing *something* even for the most complicated functions enabling limited forms. Contrarily, a jurist court expert stated that, today, it is more difficult to have such a freedom, as there have been a large number of designs in many fields which are also available for everyone. Thus, to her, such a medium allows a designer a very little freedom, and coincidences become inevitable. Also, two court experts, an attorney and an agent stated that one would not say “that’s all, there’s no other way of designing this”, as the designs may, in time, be developed somehow.
- **Good will/bona fides is important.** According to a judge, one of the substantial issues is the good will. According to him, it plays an important role in the assessment.
- **Only the visual influences of the technical contributions can be protected.** A judge and an agent stated that the technical contributions can be considered only if they redound on the appearance of the product. In other words, to them, only the appearance of the technical contribution is protected.

According to the agent who touched upon this issue, the appearance of the technical contribution shall not be protected if it is composed of solely the required technical function.

5.6.3 Discussions on the designer's degree of freedom

Considering the statements of the participants, it can confidently be said that this notion was regarded as an important issue. Having *no* freedom meant the designer has *no* any other chance while developing a design; and some participants did not agree with this idea, instead, they stated that a designer *has* another chance almost every time.

On the other hand, it was also observed that the designer's degree of freedom can be limited in practice by three means: technical constraints, national and international standards, and product typology. In the first circumstance, the designs dictated by technical functions were not considered as designs to be protected by a design registration. This approach was found righteous as it is noted so in the current legislations³⁰. Nevertheless, the design in question may involve some new embodiments related to new functional contributions. In such cases, the *designs* of these contributions may be protected with a design registration. However, if the functional contributions do not make sense in terms of design, then they should be protected by other means such as patents or utility models.

Another constraint was found to be the national and international standards. Contrary to the abovementioned situation, in such a circumstance, a technical limitation does not exist. Instead, the designer may have freedom in terms of satisfying the function, but be limited while complying with the standards.

The last limitation was found to be the product typology. Similar with the former condition, when developing a design, a designer may feel himself limited when being in accordance with the product typology is necessary. Apart from the fact that

³⁰ Decree-Law no 554, Article 10.

designs develop and change shape continuously in time, creating a design free from current typologies may not be that easy for a designer.

Another important assignment was that the relationship between the small differences and the degree of freedom. According to this assumption, small differences in a design gain importance as the designer's degree of freedom gets narrower. For instance, only one small difference may be sufficient for a design to have distinctive character if the degree of freedom is narrow. The inverse proportion between these two aspects is represented roughly in Figure 10.



Figure 10 The relationship between the designer's degree of freedom and the importance of small differences

Thus, the designer's degree of freedom was found to be changeable according to the product category. This is why the assessment of the degree of freedom was regarded as an assessment which should be made by technical court experts.

CHAPTER 6

FINDINGS: PROBLEMS AND SUGGESTIONS

6.1 Problems indicated by the participants

The participants were asked about the problems they face during the registration process. The problems which they are confronted with are mentioned below under four categories. The problems cited are also discussed under this subtitle.

6.1.1 Problems related to the registration system

- **Registration system without examination.** According to 13 participants, consisting of three judges, a court expert, two jurist court experts, four attorneys and three agents, the registration system in Turkey brings about many related problems, as the registration process does not involve an examination for the novelty of the designs submitted for registration. Two judges mentioned that the system, as it stands, gives rise to “bad faith” [*kötü niyet*]. Also according to another judge, registration without examination causes thousands of lawsuits. An attorney noted that she understands the reason for not conducting such an act; however, to her, “every” design had better not be registered immediately. Two agents specified that the system in many countries do not involve an examination process, either; according to one of these agents, examination of novelty would cost a lot, and would also be time-consuming. Contrary to these 13 participants, a TPI expert asserted that there have been greater problems in the systems which involve an examination process; similarly, to another TPI expert, our system, as it stands, is more proper when compared to other registration systems involving examination.

- **The designs which do not fulfil the conditions of novelty and distinctive character are being registered easily.** This problem was found to be the most cited issue within the whole study. 27 participants including eight judges, three court experts, two jurist court experts, three TPI experts, seven attorneys and four agents stated that the registration of designs lacking novelty and distinctive character constitutes a major problem. To them, it also causes many other problems. Three of these judges emphasized that designs which are known for many years are being registered easily as if they are new. According to eight participants consisting of two judges, a court expert, a jurist court expert, two attorneys and two agents, the reason for this is the registration system itself, as it does not involve an examination process for the designs' novelty.
- **The system is abused.** This issue was mentioned by 20 participants consisted of four judges, four court experts (including two jurist court experts), a TPI expert, six attorneys and five agents. According to them, the system is abused by several means. They stated that some design owners use their registration certificates to claim possession on the designs even they do not belong to them. For instance, the judges specified that some applicants register some designs which do not fulfil the conditions of novelty and distinctive character, and attack the others in the sector pretending as if they claim their rights. A jurist court expert and an agent connected this situation to ethical problems.
- **Limited number of experts works in TPI.** According to a jurist court expert and an attorney, the number of experts working in TPI is insufficient.
- **Registration *with* examination is demanding.** Four agents found this issue considerable; to them, examining the novelty of the designs of their clients before filing their applications is demanding and time consuming. One of these agents specified that data bases and sources are difficult to access. In a similar vein, another agent complained about the lacking archives and databases related to particular sectors.

6.1.2 Problems related to the judicial system

- **Filing a court case is easy.** According to a judge and a jurist court expert, filing a court case is easy; and this was also counted as one of the causes of the increment in the number of lawsuits.
- **Lawsuits take longer than expected.** A judge, two court experts, a jurist court expert and two agents mentioned that the processes of the lawsuits take too much time; and to the jurist court expert, the credibility of the judicial system is therefore damaged. Also, one of these judges and one of the agents specified that a lawsuit process lasts for several years, and this causes a delay in justice. According to the other agent, the reason for this delay is the registration system, as it does not involve an examination process. The court expert also connected this delay to a related issue, that is, registration of designs not fulfilling the conditions of novelty and distinctive character.
- **The Supreme Court makes the assignment of court experts obligatory in all cases.** The attitude of the Turkish Supreme Court was criticized by four judges and an attorney. According to them, assigning court experts for each court case should not be obligatory, as to them, in some cases judges should be entitled to give verdict without consulting an expert. One of these judges also added that there is no such enforcement in Europe. Contrarily, a TPI expert and an attorney found the approach of the Supreme Court righteous, as the system enables the judge to assign alternative court experts if he/she is not satisfied with the previous reports.
- **How can a court expert be knowledgeable about every item?** Two judges and an agent touched upon this issue; according to them, it is not a righteous approach to expect a court expert to be knowledgeable about every design. To the agent, a court expert may have a strong theoretical background in a field; however he naturally may not in another one. Thus, to them, assigning the same court experts for all designs may cause problems in some cases. Likewise, a TPI expert noted that they may also not be knowledgeable about the designs in question, and have difficulty in assessing them.

- **Problems related to proofs.** This issue was touched by 18 participants consisting of five judges, six court experts (including two jurist court experts), four TPI experts, two attorneys (one of them is a TPI attorney) and an agent. Five judges, a court expert, two jurist court experts and an agent specified that they have various problems in disproving a design's novelty and distinctive character in some cases. One of the judges and the court expert connected this problem to the "unrecorded (hidden) economy"; in other words, to them it becomes quite difficult for an assessor to find evidence to disprove the novelty of a design, particularly in the sectors where the designs and sales related to them are not recorded. Similarly, two court experts, a jurist court expert, three TPI experts and two attorneys (one of them is a TPI attorney) specified that the major problem related to the verification process is that sometimes the documents submitted to prove that the design in question is made available to the public are undated. Shortly, according to them, the undated documents pose a problem while assessing particularly the novelty of a design. A court expert also stated that he sometimes cannot claim that the design in question is "not new", even when he is sure about it.

A judge, a court expert and a jurist court expert added that in some cases, the documents submitted by the parties in order to prove the date on which the design in question made available to the public are unfortunately not reliable. For instance, according to the judge, sometimes one of the parties may print fake catalogues in order to show a made up date for the design's being made available to the public.

- **Do the court experts have the right to make examination?** This query was found important by seven participants. A judge stated that he has doubts about the examination authorisation of the court experts. The answers of the rest were dealt in two discrete groups. The participants in the first group, consisting of three judges, mentioned that the court experts have the right to examine the design's novelty by all available means; to them, a court expert

can even reveal and submit some other designs made available to the public before the filing date of the design in question in order to invalidate the novelty of the said design, if necessary. However, according to the participants in the second group, including a court expert, a jurist court expert and a TPI expert, the court experts are unfortunately limited with the documents submitted in the case file; in other words, to them, the court experts do not have the right to examine the novelty of the design in question. These court experts also specified that, simply because this reason, they do not tend to submit any precedential documents even though they know that the design in question is not new.

- **Work load.** Two judges and two jurist court experts complained about their work load. Two of the judges emphasized that they work intensively even at weekends. One of these judges also added that they hesitate to tell the number of case files that they conclude in a year in order not to raise doubts about their consistency. According to him, one of the reasons for this is that opening a lawsuit is easy. One of the jurist court experts, likewise, connected the workload to the number of lawsuits.
- **Jurists work under hard conditions.** According to a judge, particularly the jurists work under bad conditions. For instance, she stated, the physical circumstances of many of the court houses are really bad. Also to her, how they give such right decisions under these conditions is an unbelievable success.
- **Expert fees are low.** A judge noted that the expert fees in Turkey are lower compared to many European countries. Also according to him, the fees paid in Ankara are lower than the fees in Istanbul. He regarded this as an important issue, because to him, a court expert plays a considerable role in a court case.
- **It is difficult to find qualified court experts for assessment.** Five judges touched upon this problem. They specified that finding qualified court experts

to assign poses a problem for them. To one of these judges, finding a court expert who has comprehensive knowledge of the relevant design's development process.

6.1.3 Problems related to the assessment process

- **Insufficient visual representation.** Three court experts, a TPI expert and four attorneys (including a TPI attorney) mentioned that the visual representation submitted in the application files of the designs in question may sometimes be poor and insufficient. They also placed emphasis on the quality of the visual representation as well as their quantity. For instance, an attorney noted that she cannot make a detailed assessment when the submitted visual representation is poor. A court expert and an attorney stated that submitting just a few images in the application phase found to be enough by some applicants.
- **Poor design descriptions.** According to a court expert and two attorneys, descriptions partaking on the application forms are sometimes poor and deficient. According to them, these descriptions should involve some explanations related to the features which bring the design novelty and distinctive character; however, they stated, these parts are usually filled by *cliché* sentences simply because it is obligatory.
- **Unsatisfactory expert reports.** Five judges, a TPI expert, an attorney and an agent stated that they sometimes find the expressions in the expert reports unsatisfactory. According to them, some court experts, while writing down the report, may not clearly explain some points such as identical designs, the common features between them and the designer's degree of freedom. The TPI expert also specified that some court experts do not make the technical evaluations satisfactorily. According to him, the technical features are not clearly defined in some reports. The attorney and the TPI expert who touched upon this issue also noted that, such reports increase the subjectivity of the assessment.

- **The assessment involves subjective aspects.** Nine participants consisting of two judges, two court experts, a TPI expert, an attorney and three agents emphasized that the assessment of novelty and distinctive character involve subjective phases. According to them, the assessment varies between the groups who make these assessments, even between the court experts themselves. A judge noted that the way of assessment may alter between towns; for instance, between Ankara and Istanbul. Two agents and an attorney connected this situation to the viewpoints of the assessors; however, according to the TPI expert, the reason of this subjectivity is the “ambiguity” [*muğlaklık*] of the provisions.
- **Who is “informed user”?** A court expert, a TPI expert and an attorney stated that they sometimes face problems related to the notion of the “informed user”. According to the court expert and the TPI expert, who the informed user is, in itself constitutes a problem. The attorney noted that in some expert reports, the features of the fictive person who is assumed to be the informed user for this case is not dealt and explained satisfactorily.
- **What the court looks for is not the viewpoint of an expert.** Two judges and an attorney touched upon this issue and mentioned that some of the court experts reflect their own ideas and views while writing down the report; however, to them, the courts try to see the viewpoint of an informed user instead of an expert.
- **It is difficult to find the “absolute truth”.** According to two judges, contrary to some other branches of law, achieving the “absolute truth” [*mutlak gerçek*] is very difficult in this field as the assessment do not involve certain rules.
- **When do we regard “an immaterial detail” as a difference?** A judge and a TPI expert noted that one of the main problems encountered in the assessment of novelty and distinctive character is the evaluation of the “immaterial details”. The judge emphasized that whether the differences are

to be regarded as “differences” or “immaterial details” constitutes an important problem during the assessment. Similarly, the TPI expert also stated that the most “fatiguing, weary” [*yoran*] point is the assessment of immaterial details.

- **Inspiration or counterfeiting?** A TPI expert and an attorney mentioned that deciding whether the resemblance shall be regarded as an inspiration or a counterfeiting act constitutes a considerable problem. They specified that some people purposively make changes on existing designs, and try to register them on their own behalf. In such cases, assessing the design, to them, becomes a difficult job.
- **“Non visible” designs.** There have been two discrete views on the protection of “non visible” designs. The first group consisting of a court expert, a TPI expert and an attorney asserted that the designs related to the non visible parts should not be protected by industrial design registrations. According to the attorney, the contributions made on the non visible parts of a design can be protected by other means such as patents or utility models, as they would probably be technical contributions instead of contributions made by aesthetic concerns. Contrarily, another court expert and an agent focused on the term “visible”. They specified that the term “visible” is not mentioned in any provision in the Decree-Law. According to the agent, not protecting the non visible designs (or non visible parts of designs) is not a righteous approach, since they also have suppliers.

A related topic was the protection of profile designs. The aforementioned court expert, who asserted that the designs related to the non visible parts of designs should also be protected, stated that the sectional views of the profiles can be protected by industrial design registrations. However, two other court experts and two TPI experts (one of them is the aforementioned TPI expert) mentioned that the sectional views of the profiles should not be registered as industrial designs. According to one of these court experts, designs applied on profiles should be registered as they come into sight, not solely as the

sectional view. The other court expert noted that designer's degree of freedom also plays an important role in the assessment of profile designs.

- **Assessment of two dimensional designs.** An attorney noted that he is sometimes faced with problems in assessing two dimensional designs such as designs related to textiles and invitation cards. In such cases, he stated, they receive help from designers, because for them, it is hard to determine the distinctive character in such designs.
- **The registration of industrial designs is confused with unfair competition practices.** A judge and an attorney touched upon this topic; they stated that this notion -registration of industrial designs- is being confused with unfair competition, even though the registration of an industrial design provides a wider protection compared to unfair competition rules. In other words, according to them, some assessors assess the industrial designs regarding the criteria related to the unfair competition law.
- **Partial invalidity.** According to an attorney, in the EU there isn't an approach that promotes the partial invalidation of designs. However, in Turkey, to him, the assessors tend to divide the designs into their components while assessing them.

6.1.4 Miscellaneous problems

- **Unethical conduct.** Two agents, a TPI expert and an attorney specified that some of the agents unfortunately do not behave ethically. According to one of these agents, some of her colleagues make applications for the designs that he/she knows that they do not fulfil the conditions of protection. The other agent and the TPI expert noted that they sometimes see that the agent of the defendant and claimant is the same person (or agency).
- **"It is difficult to persuade the client".** This issue was found important by three attorneys. According to them, arguing the client into not filing applications for designs which do not fulfil the conditions of novelty and

distinctive character constitutes a considerable problem. They stated that they try to persuade their clients in such cases, but generally fail.

- **Level of public awareness.** This issue was found considerable by a judge, a TPI expert, two attorneys and three agents. According to them, the awareness level of the public in industrial designs, even in all the intellectual property rights, is quite low. The judge specified that some people even do not know that counterfeiting constitutes a crime. According to two of these agents, the manufacturers also are unaware of the protection system; people may use the term “patents” when talking about industrial designs.
- **Some designs are not “industrial”.** A court expert noted that he sometimes encounter with designs which are not “industrial”; in other words, not suitable for mass production.
- **Knowledge level of the assessors.** According to a judge, a court expert, an attorney and four agents, the court experts may sometimes not be knowledgeable about the registration and assessment processes. One of the judges stated that court experts may sometimes confuse the industrial designs with trademarks or patents. The court expert stated that there have been no training programs for the court experts in this field. The attorney remarked that in provincial cities, some court experts may not be knowledgeable about even the industrial design registrations, in a broad sense, about the intellectual property rights, and their protection.
- **There are no educational institutions on intellectual property.** An agent called attention to the fact that there haven’t been any educational institutions operating in the field of intellectual property rights, in terms of undergraduate and graduate studies. For instance, according to him, a person is, in the circumstances, is not able to become a professor or associate professor on intellectual property rights.
- **“Industrial design registrations” are used as “utility models” or “trademarks”.** Two judges, a court expert, a TPI expert, an attorney and an

agent stated that the industrial designs are treated as utility models. For instance, according to one of these judges, many people suppose that the function of the design is also protected with an industrial design registration, but this is, for him, a common mistake.

Similarly, an attorney mentioned that people sometimes utilize the industrial designs as trademarks. For instance, according to him, they register some package designs as industrial designs, just because they cannot register them as trademarks as they do not fulfil the conditions for the protection of trademarks.

- **Lack of communication among parties.** Two judges, a TPI expert, an attorney and an agent drew attention on the communication problems between the relevant parties. According to one of these judges, the designers and jurists sometimes may not get each other's drift because of this. The attorney and the agent also stated that parties do not communicate with each other. According to the agent, the reason for the said problem is that there are very few platforms where the parties can make discussions on the issues related to the protection system. One of the judges also noted that she sometimes have problems in accessing the relevant documents, or in hearing from the events and activities to be arranged.

6.1.5 Discussions on the problems faced

When the problems are considered as a whole, it can be said that there has been a relationship between them. Figure 10 shows the connection between these problems, and eventuates in an undesired result: the registration system loses credibility.

It was observed that there are two major problems, which can be accepted as the main causes of the final point, and as the results of many other problems mentioned. The first crucial point is the registration of the designs which do not fulfil the protection conditions. In other words, the registration of designs, which are not new and do not have distinctive character, poses many other problems such as the problems related to the proofs or the increase in the number of lawsuits. This

situation naturally creates work load and slows down the system. As a result of this, lawsuits take longer than expected, and the system starts to lose credibility.

The main reasons for filing applications for such designs are observed to be the system's being without examination, and the abuse of it. Even though our law involves an unexamined registration system for designs, it offers a publication mechanism, which lets parties see the new applications; and allows a 6 months time³¹ for possible oppositions. However, it was seen that the system is sometimes regarded as if it is an unchecked practice, and applications for designs which do not fulfil the protection conditions have been filed continuously. This situation may result from either unethical conduct or from the low level of public awareness related to this issue.

Another major problem was observed as the difficulties related to the assessment of novelty and distinctive character. Many problems may be listed as the reasons of such a difficulty, but more importantly, the results of such a problem extend over the final point: system's reliability; since, the major output of this problem emerges as the delays, causing lawsuits to take longer than expected.

The relationship between all these problems and their connections with the other problematic issues are represented in Figure 11.

³¹ The Implementing Regulations Under The Decree-Law No 554 Pertaining To The Protection Of Industrial Designs, Article 13.



Figure 11 The relationship among the problems

6.2 Suggestions made by the participants

The suggestions which were made by the participants were specified below; these proposals were also tried to be used in the preparation of common guiding criteria.

6.2.1 Suggestions related to the system

- **Examination.** 18 participants consisting of nine judges, four court experts (including a jurist court expert), three attorneys (including a TPI attorney) and two agents stated that making an examination for the novelty and distinctive character of designs at the beginning of the application process would be a useful solution for several problems faced throughout the whole process. According to three of these judges and a court expert, this amendment would substantially decrease the number of lawsuits. Nevertheless, one of these attorneys and one of these agents noted that making examination is a hard job, and systems of very few countries involve an examination process. Thus, according to three judges, a jurist court expert, an attorney, a TPI attorney and two agents, the registration process need to involve at least a preliminary examination which shall be made only for the novelty of the design. One of the judges, in the same vein, stated that the designs which are “obviously not new” [*yeni olmadığı çok belirgin olanlar*] can also be eliminated. He and one of the court experts also indicated that the applications should be eliminated at least according to the definition of “design” made in the Article 3 in the Decree-Law. Similarly, another judge noted that scanning the existing databases would also be a useful remedy.

Another group of participants, consisting of two TPI experts, an attorney and an agent, contrarily mentioned that making examination for designs is almost impossible. According to them, the examination process is not only a hard work, but also an unnecessary task. One of the TPI experts stated that they make elimination according to the definition of “design” given in the Article 3 of the Decree-Law, and to public order and morality, mentioned in the Article 9 of the said document. The other TPI expert emphasized that it is almost impossible to have access to all the images of designs made available

to the public until that day; also, this duty should be fulfilled at the beginning of the process by the applicants in order to see whether or not there are resembling designs. The attorney also specified that, in designs, examination would not be limited with just the databases of previous registered designs, it would rather involve a wide range of designs which have been made available to the public before that day.

- **Having access to the court decisions.** This issue was found important by a judge, a court expert and an agent. The judge stated that even though there is an online information network, they have problems in accessing some documents such as court decisions given in various courts. Similarly, the court expert and the agent mentioned that having access to the court decisions is necessary for some parties, as these documents are anticipated to be useful guides for both the agents and the court experts in the assessment process.
- **TPI needs to employ designers and jurists.** According to a judge, a court expert, an attorney and two agents, TPI should employ designers. The judge stated that designers should particularly be employed in the Re-evaluation and Examination Board of the TPI. According to him and to one of the agents, designers to be employed should be subjected to a training programme in order to comprehend the legal issues. A TPI expert and an agent, likewise, indicated that jurists should also be employed in the Re-evaluation and Examination Board.
- **TPI should involve a board of appeal.** An agent specified that a “board of appeal” [*temyiz birimi*] should be established within the structure of the TPI in order to assess the decisions regarding the oppositions.
- **Designers may be assigned in courts.** According to a court expert, designers may be assigned in the courts, as it is so in some foreign countries. Likewise, an attorney suggested that court experts may attend the court hearings and assess the design in question on the spot, together with the parties.

- **At least one designer court expert should be assigned in the panel of experts.** An attorney mentioned that at least one designer should be assigned as court expert in the panel of experts in each case.
- **An autonomous establishment for court experts.** Two judges suggested an autonomous establishment in which the court experts are staffed. Because according to one of these judges, in the current situation, it is not easy to find specialised court experts. For instance, she noted, they appoint the same court experts for trademarks and industrial designs.
- **A training program for court experts.** A jurist court expert specified that the court experts should be trained before they are assigned in a lawsuit. Thus, according to her, assigning a jurist court expert would then be unnecessary because the court experts would have knowledge of the legal issues.
- **Draft law.** A TPI expert, a TPI attorney and four agents touched upon the draft law. They stated that the Decree-Law is going to be legislated in the near future and according to them, this would be a substantial amendment related to the protection of industrial designs. According to two of these agents, with the new law, the unregistered designs shall be protected as well, and the obligation of submitting descriptions for the designs will be removed.
- **Opposition period.** A court expert and an agent indicated that, six months of opposition period should be reduced to three months, roughly, as it is so in the trademarks and patents. On the other hand, two TPI experts, an attorney and two agents stated that the opposition period shall be extended to five years according to the new law; in other words, filing an opposition shall become possible during the first five years of protection period. The attorney and one of the agents found this approach incorrect since, according to the agent, the duty of the TPI ends with the submission of the registration certificate; and according to them, this new implementation would pose many

problems; on contrary, the TPI experts and the other attorney leaned towards this amendment.

- **TPI should not wait until the last day of the opposition period.** According to an agent, the TPI should not keep the oppositions suspended until the end of the opposition period. In other words, according to him, TPI should inform the applicant about the opposition without waiting for the expiration of the period since the applicants generally start to utilize the rights, which are to be granted by the registration, as soon as their design is published.
- **An extra legislation is needed for the designs of short-lived products.** A judge and a jurist court expert noted that a separate legislation related to the designs of short-lived products would be useful as some designs need faster lawsuit processes.
- **Abuse of the system should be prohibited.** A judge, a jurist court expert, a TPI expert and an attorney touched upon this aspect. According to them, each party should behave ethically. The TPI expert stated that penalties may be disincentive. The attorney approached the problem from a different perspective and suggested to enact some articles related to “bad faith” [*kötü niyet*] to the law.
- **Partial invalidity.** An agent indicated that even though the partial invalidity is a problematic issue, our system is in need of such an implementation.

6.2.2 Amendments for the further improvement of the assessment

- **There is a need for objective criteria.** According to a court expert and an agent, the assessment of novelty and distinctive character should be based on objective criteria. The agent stated that this would be possible if the parties can meet on a common ground.
- **The invoices should involve product codes.** A judge and a TPI expert touched upon this issue; they emphasized that the invoices, which are submitted to the court within the scope of a court case, should involve the

code of the product on which the design in question is applied. According to them, this obligation would ease the assessment of novelty.

- **Visual representation should be of good quality.** This issue was found important by four court experts and two TPI experts. According to them, the quality of these documents has importance as the assessment is made on the basis of visual representation. According to one of these court experts, the TPI should control the quality of those documents more seriously. According to another court expert, TPI can prepare illustrative guides for the applicants, explaining how these representations should be. Another court expert indicated that the visual representations should be standardised. One of these TPI experts also approached the topic from a different viewpoint and stated that the visual representation should show the parts which are to be protected.
- **The context of use.** A court expert noted that, in component designs, the place of use of the component should be represented clearly in the submitted documents so that the design can be assessed healthily in terms of the designer's degree of freedom.
- **Product samples.** According to a TPI attorney, they sometimes are not able to see the concrete products, particularly when they are large sized. However, according to her, the assessment can be made more clearly when the sample products are available.
- **“Originality” and “novelty and distinctive character” should come to the same thing.** As a court expert stated, “novelty and distinctive character” should come to the same thing with the notion of “originality” [özgünlük]. In other words, according to him, the assessors should infer something like “originality” from the term “novelty”.
- **Judges should have jurisdiction (power) to give verdict without referring to the expert report.** According to two judges, they should be empowered to give verdict without referring to the expert report in some cases. According to one of these judges, the opinions of the court experts can be received

particularly in the assessment of designs related to technical products; however, according to him, in some cases it is also possible for a judge to assess the design with the eye of an informed user.

- **Court experts have the power to make examination.** An attorney and an agent emphasized that the court experts have the power to examine the novelty of the design by all available means, thus this issue should be known in this way.

6.2.3 Suggestions regarding the parties

- **Agents should guide the applicants.** This suggestion was made by 10 participants consisting of a judge, two court experts (one of them is a jurist court expert), three TPI experts, three attorneys and an agent. According to them, the agents play an important role in the registration system, since they, in respect of their duty, are able to prevent many problems generating from the application of designs which do not fulfil the conditions of novelty and distinctive character. A TPI expert and an agent asserted that an agent should not file an application for a design which he/she knows for sure that it is not new. By the same token, the judge stated that agents should advise their clients in such cases by explaining the reasons why they should not file an application for his/her design. The said TPI expert also stated that the agents should behave more ethically; for instance, he noted, he sometimes sees that the agent who had filed the application of the defendant is the same with that of the claimant. Similarly, one of the attorneys noted that the agents should be more conscious of their duty.

Two agents, on the other hand, mentioned that they try to forewarn their clients when their designs do not fulfil the conditions; however, according to one of these agents, some other office would do the work even if *they* do not.

- **An audit system for agents.** A jurist court expert suggested an audit (control) system for agents. According to her, for instance, establishing a disciplinary board may be a useful amendment for supervising the agents.

- **The applicants may scan the databases.** According to a judge, an attorney and an agent, the applicants may review the existing databases before they make an application for their designs. According to the agent, they also should view the official bulletins in order to see the formerly published designs.
- **Some databases should be built.** A TPI expert and two agents stated that manufacturers or suppliers may create databases presenting the designs which have already been made available to the public. The TPI expert also noted that, the databases had better be sector-specific. According to them, this would help the applicants and the assessors to see the existing designs, and would prevent people from trying to register an already existing design.

6.2.4 Miscellaneous suggestions

- **The awareness of the public should be raised.** Seven participants consisting of a judge, a court expert, a TPI expert, two attorneys and two agents emphasized that the awareness of the public should be raised. According to the court expert, the TPI expert and the attorney, the manufacturers and applicants need to be informed about the protection system. One of the attorneys specified that universities can undertake this task, and train the manufacturers. In the same vein, one of the agents noted that the mission falls to the ETMK (Industrial Designers Society of Turkey).
- **Meetings, seminars and workshops for the parties.** Seven participants consisting of a judge, two TPI experts, two attorneys and two agents mentioned that parties' meeting in some shared platforms such as meetings, seminars, workshops and conferences would strengthen the coordination and dialogue between the relevant parties. The judge suggested creating mail groups for this purpose. One of the TPI experts stated that they try to arrange such meetings; however, according to him, they generally are faced with a limited participation.

- **Undergraduate and graduate programs regarding “intellectual property”.** An attorney and an agent emphasized that in universities, departments regarding intellectual property should be established. According to them, there is a need for undergraduate and graduate programs on this issue. The agent also stated that the studies made on this issue remain at the level of a post graduate thesis.
- **The TPI experts need to be paid more.** A judge stated that the TPI experts should be paid better in order for them to work more productively. According to him, in the present circumstances they work very intensively with a low salary.
- **Comfortable working conditions.** A judge touched upon this issue and indicated that particularly the judges need more comfortable working spaces, because according to her, the courthouses are generally in bad condition.
- **Court experts can meet at TPI.** A court expert suggested that a room can be allocated for the court experts; and according to her, the court experts may meet here to hash the court cases over with each other.
- **The effects of the lated justice on the community need to be investigated.** An agent mentioned that how the lated justice influence the community should be investigated. According to him, parties need to see how the delays in justice affect the relevant entities.

6.2.5 Discussion on the suggestions

As it can be understood from the comments of the participants, many suggestions were made; some of which refer to the mentioned problems. These suggestions and problems they refer are briefed below in Table 8, Table 9, Table 10 and Table 11.

Table 9 Suggestions regarding the system

Suggestion made	Problem it refers	How will it serve?
System may involve an examination (at least a preliminary examination) process	Abuse of the un-examined registration system	An examination process may avoid the abuse of the system
Having access to the court decisions should be easier	Difficulties in the assessment	Exemplary court decisions may guide the assessors
TPI may employ additional designers and jurists	Work load	It would lessen the work load of TPI, and accordingly that of courts
TPI may involve a board of appeal	High number of lawsuits, work load, long lasting lawsuits	It would lessen the number of lawsuits, as some of the oppositions would be submitted to such an entity before going to law
At least one designer should be assigned in the panel of court experts	Insufficient expert reports	The reports would probably be more satisfactory, as some aspects would be discussed professionally in terms of designing activity
An autonomous establishment for court experts may be founded	Difficulties in finding qualified court experts	Such an establishment may provide qualified court experts
Training programs for court experts can be organised	Difficulties in finding qualified court experts, insufficient expert reports	It would rise the quality of the expert reports, and would rise the number of qualified court experts
Decree-Law should become a Law	Credibility losses of the system	It would rise the credibility of the system
Extending the opposition period	High number of lawsuits	It would decrease the number of lawsuits
Extra legislations may be arranged for categories referring short-lived products	Long lasting lawsuits	It would provide effective protection of designs for short-lived products
Bad faith should be prohibited	Abuse of system	Disincentives may avoid abuse

It was observed that many suggestions were made regarding the registration system. The ones of primary importance were found to be the advancement of the Decree-Law no 554 into a Law, the employment of designers and jurists in the TPI, the idea of establishing a board of appeal within the TPI, and the establishment of training programs for court experts.

The reason for considering these amendments significant was that they refer to more critical problems such as the credibility losses of the system, work load, high number of lawsuits, long lawsuit periods and facing difficulties in finding qualified court

experts, and insufficient expert reports. Thus, such solutions may contribute to solve these problematic points completely.

Table 10 Suggestions for the further improvement of the assessment

Suggestion made	Problem it refers	How will it serve?
Objective criteria (common guiding principles) may be developed	Difficulties in the assessment of novelty and distinctive character, subjectivity of the assessment	Common criteria may guide the assessors
Invoices should involve product codes	Problems related to proofs	Product codes would establish the connection between the design in question and the product while determining the date of making available to the public
Visual representations should be of good quality	Difficulties in the assessment of novelty and distinctive character, insufficient visual representation	Good quality visual representation would facilitate the assessment
Sample products may be submitted	Difficulties in the assessment of novelty and distinctive character	Seeing the sample products up close would facilitate the assessment
Judges should have power to give verdict	Obligation of appointing court experts	Judges may assess some designs without consulting to a court expert and shorten the lawsuit period

Similarly, it was seen that essential suggestions were made for the further improvement of the assessment. Almost every suggestion was found considerable, as they offer solutions for many important problems. For instance, common guiding criteria would lessen the subjectivity of the assessment and ease the assessment of novelty and distinctive character. Similarly, good quality visual representation and invoices involving product codes would lessen the difficulties in the assessment of novelty and distinctive character and may solve the problems related to the proofs.

Table 11 Suggestions regarding the relevant parties

Suggestion made	Problem it refers	How will it serve?
Agents may guide the applicants	Level of public awareness, using industrial design registration for protecting trademarks or utility models	Applicants, by this means, may chose the best way to protect their works
An audit system for agents may be developed	Unethical conduct	A control system would prompt the agents to behave more ethically
Applicants may search the official bulletins.	Registration of designs which do not fulfil the protection conditions	By this means, the applicants would test the novelty of their designs
Databases may be built	Registration of designs which do not fulfil the protection conditions	The applicants would test the novelty and distinctive character of their designs

It was observed that some missions fall to the agents. Since they are the designated authorities to file applications, their attitudes and actions become important in the process. For instance, agents should guide the applicants at the beginning of the process concerning the design's novelty or about the protection means suitable for this work; by this means, the applicants, would not file applications for designs which are not new, or chose the best way to protect their works. Another suggestion was that the applicants should follow the publications in order not to file an application for an already existing design.

Table 12 Miscellaneous suggestions

Suggestion made	Problem it refers	How will it serve?
Raising the awareness level of the public	Low level of public awareness, using industrial designs as trademarks or utility models, registration of designs which do not fulfil the protection conditions	It would prevent the abuse of the system, applicants would decide the way of protection by himself
Meetings, seminars and workshops may be arranged	Lack of communication between the parties	It would gather the parties and provide idea exchanges
Undergraduate and graduate programs regarding intellectual property should be established	Difficulties in finding qualified court experts, awareness level of the assessors	By this means, intellectual property would be handled as a profession
Comfortable working conditions should be provided	Jurists work in hard conditions	This would rise the efficiency of jurists

Raising the awareness level of the public was considered as another important issue. This would not only prevent the abuse of the system, but also help the applicants to decide the way of protection (industrial design registration, patent or utility model) by themselves. Arranging meetings, seminars and workshops would also gather the parties together. Also, establishing undergraduate and graduate programs regarding intellectual property was to be an essential solution for several problems.

6.3 Misunderstandings about the assessment by the applicants

Some misunderstandings were noticed while analysing the answers given by the participants. Such common mistakes were cited below.

6.3.1 Seven differences

Six participants consisting of four TPI experts and two attorneys pointed out an interesting approach they heard. One of the attorneys also stated that this rumour has become an urban legend. According to this approach, 7 differences made on a previous design would bring the latter design novelty and distinctive character. The participants emphasized that this is a wholly wrong thought, and according to them, such a generalization does not make any sense.

6.3.2 “How many” differences would be enough?

In a similar vein, two TPI experts stated that some of the applicants try to learn the *quantity* of the differences that they have to make in order to obtain a design which is new and has distinctive character. According to these TPI experts, such an approach is also faulty, as to them, the *quality* of the differences is important, not the quantity.

6.4 Issues related to the wrong terminology used by the participants

The instances where the researcher noticed inconsistent, confusing or wrong use of terminology are mentioned and discussed below.

- **The use of the phrase “conscious user”.** A judge and a court expert used the phrase “conscious user” [*bilinçli kullanıcı*] instead of “informed user”. The same judge also mentioned that “a conscious user is generally an academic”; in other words, she used the phrase “conscious user” to mean a “court expert” as well.

- **The use of the phrase “conscious consumer”.** Another judge and an attorney used the expression “conscious consumer” [*bilinçli tüketici*] instead of “informed user”. The same judge used “conscious consumer” in place of a “court expert”.
- **The use of the phrase “average care user”.** A judge used the phrase “average user” [*orta dikkatteki kullanıcı*] while explaining the fictive person which is to constitute a basis for the viewpoint of the assessor. In other words, he used this phrase instead of the “informed user”.
- **The use of the phrase “elucidated consumer”.** An attorney used the expression “elucidated consumer” [*bilgilendirilmiş tüketici*] instead of “informed user” [*bilgilenmiş kullanıcı*].
- **The use of the phrase “user”.** A court expert used the term “user” instead of “informed user”.
- **Industrial designs and trademarks.** Three judges and two court experts used some phrases related to trademarks such as “average user”, “differentiation of letters within the *words*”, “registration of colour combinations”, “pronunciation differences between *words*” while talking about industrial designs.
- **Industrial designs and artistic works.** A judge used some expressions related to intellectual and artistic works such as “to bear the characteristic of its author” while talking about industrial designs.

6.4.1 Discussions on the wrong uses of terminology

On the strength of the statements mentioned by the participants, it is possible to state that the major misconceptions are related to the notion of “informed user”. This phrase was misused in two ways. One of the starting points of these misuses was semantic. To be honest, the meaning of this phrase was confused with the fictive assessor of another industrial property -trademarks. In other words, some participants

regarded the notion of informed user as an average consumer, just as it is so in the trademarks. Thus, they use some other terms standing for such an entity. However, the reason for instructing to assess the designs from the viewpoint of a fictive “informed user” was thought to be to determine the distinctiveness threshold. Thus, using such phrases instead of “informed user” may be regarded as indications of some inaccurate assessment policies.

Some structural errors regarding the term “informed user” were also observed. Participants who used such terms as “conscious user”, “conscious consumer” or “elucidated user” were thought to have been aware of the meaning of informed user, but mix up the said phrases with some other words, as they mistake the word “conscious” for “informed”, and “consumer” for “user”.

CHAPTER 7

FINDINGS: ASSESSMENT DIFFERENCES AMONG THE PARTICIPANT GROUPS AND THE RELEVANCE OF COMMON GUIDING PRINCIPLES FOR THE ASSESSMENT

7.1 Assessment differences among the participant groups

One of the questions addressed within the scope of this study was that whether the participants see some differences between the parties in terms of assessment of novelty and distinctive character. The answers of the participants were stated and discussed below.

7.1.1 Differences observed by the participants

- **“Sometimes we judge in just the opposite way”**. Four judges and a court expert mentioned that they have noticed some differences between the judgements of judges and those made by the court experts. For instance, the judges stated, the court experts may regard a design, which was not, by them, counted as a design bearing the protection conditions, as new and bearing distinctive character. Similarly, the court expert specified that the judges may not distinguish some differences which, by the designers, may rather be found sufficient to bring a design novelty.
- **“We don’t understand the same thing from the notion of ‘design’”**. Three judges, two court experts and two attorneys emphasized this view. According to one of these judges, designers can hardly comprehend legal issues. Similarly, the judge stated that a designer may count even a small change as a difference; however, this change may not be considered as a difference in terms of the intendment of law. One of the attorneys noted that the jurists, as well, are not acquainted with designing. According to the other attorney,

designers and jurists do not understand the same thing from the notion of “design”, and according to him, this is the reason why they assess the designs differently.

One of the court experts who touched upon this issue mentioned that jurists do not look at the fact from a designer’s standpoint. According to him, the jurists may see an industrial design case as clear as a “divorce” suit; nevertheless, designing act, according to him, involves flexibility. Likewise, the other court expert stated that jurists assess the designs solely according to the legal provisions.

- **“Designers tend to consider every detail”**. Three judges and two attorneys stated that designers tend to go in further detail while assessing the novelty and distinctive character of the design in question. According to one of these judges, this tendency results from their profession.
- **“Designers keep the bar low”**. According to six jurists consisting of three judges and three attorneys, compared to the jurists, designer court experts keep the bar low while assessing the designs in question. According to them, designer court experts regard the design as different from the existing designs even when they have little differences. One of these judges and one of these attorneys stated that designers also consider even the immaterial details as differences. The other attorneys in the same way specified that they assess the designs in a more strict way. Contrarily, a TPI expert and an attorney noted that designers have high expectations from designs; thus, according to them, designers may not regard designs bearing little differences worth protecting.
- **“What is to be protected is important for us”**. This query was found important by a judge and an attorney. They stated that everything may be counted as a “design” for a designer. For instance, according to them, designers may consider irrelevant facts, such as being favoured in the market or the market needs, within the scope of protection. However, for the jurists,

they stated, the scope of the industrial design registrations is narrower, as they are solely related to the appearance.

- **“There are differences between groups, it is inevitable”**. 15 participants consisting of two judges, three court experts, three TPI experts, five attorneys (including two TPI attorneys) and two agents mentioned that there are differences between the viewpoints of the parties; nonetheless, according to them, this is a natural and inevitable variation. One of these TPI experts attributed this variation to professional differences, while one of the agents connected this situation to the legal provisions which have not been brought up-to-date and are accordingly interpreted in different ways. Another judge, one of the attorneys and one of the TPI attorneys stated that this differentiation results from the fact that the assessment of novelty and distinctive character involves subjective aspects.
- **“There can be differences even between the viewpoints of the court experts”**. According to two judges, an attorney and an agent, there can be differences between the court experts in terms of the assessment of novelty and distinctive character. According to the attorney, the assessment may vary even between the court experts from Ankara and from Istanbul.
- **“There are two main groups”**. A court expert stated that there are roughly two types of assessors: ones who say “no” to all designs, in other words “naysayers” [*olmazcılar*], and the ones who generally say “okay, this is acceptable too” [*bu da olur yahu’cular*]. According to him, it can be said that the first group respectively, involves inexperienced designers, while the second group generally consists of experienced designers. According to him, the reason for the assessors in the second group to have such an attitude is that they know the variety of designs in the relevant field.
- **“The most objective assessors must be judges and experts”**. A TPI expert, an attorney and a TPI attorney mentioned that judges and experts (both court experts and TPI experts) are the parties who make the most objective and

healthy assessment. Similarly, an agent noted that the court experts must be the most objective assessors.

- **Absolute novelty.** According to a court expert, the jurists seek for “absolute novelty”, while the designers defend the opinion that in today’s world, achieving “absolute novelty” is almost impossible.
- **Assessment of the descriptions.** An attorney mentioned that court experts do not consider the descriptions related to the designs in question while assessing them; however, according to her, the descriptions should be taken into consideration. Contrarily, a TPI expert stated that they defend the idea according to which, the design descriptions are not included in the scope of protection; while the courts, according to him, count them considerable.
- **“It is difficult for an attorney to be objective”.** Four judges, two TPI experts and a TPI attorney mentioned that it is very hard for an attorney to treat impartial while assessing a design, since they have to defend their clients. Nevertheless, this attitude was found natural and inevitable. In a similar vein, one of the agents and an attorney noted that agents also may not be objective sometimes.
- **“We assess the designs more strictly compared to OHIM”.** According to an attorney, in Turkey, the designs are assessed in a more strict way compared to that in Europe. According to him, this difference can be seen by looking into the decisions made by OHIM. He also stated that we regard designs as resembling designs even though they bear many differences.
- **“No one goes above and beyond his/her duty”.** Three court experts including a jurist court expert specified that they share works before they assess the designs in questions, thus no one goes beyond his/her duty. Therefore, according to them, no differences occur between their assessments.

7.1.2 Discussion on the differences between the parties in terms of assessment

It was seen that there have been some differences between the parties in terms of assessment of novelty and distinctive character. This diversity was found inevitable by a considerable amount of participants. The participants also made comments about the viewpoints of all parties except for the agents. The reason for this was thought to be that they do not generally be in an assessor position. In other words, they do not need to assess the designs in terms of novelty and distinctive character except for the period they file an application for a design. The factions are roughly represented below in Figure 12.

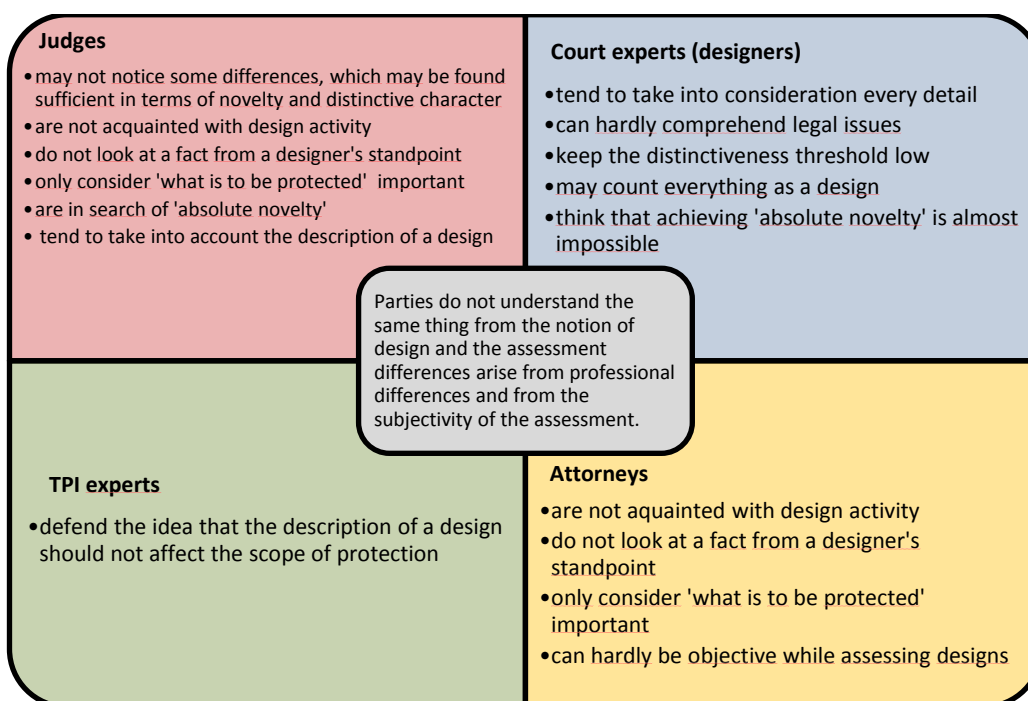


Figure 12 Differences among the parties in terms of assessment

As it can be seen in Figure 12, it is possible to state that there have been some major differences, which were found to natural and inevitable. It was thought that these differences probably arise from the professional backgrounds of the parties, and from the subjective nature of the assessment process. It was also stated that no one goes above and beyond his duty while assessing.

On the other hand, one of the main differences was found to be that the parties do not understand the same thing from the notion of ‘design’. In other words, they are in different expectations while assessing the designs in terms of novelty and distinctive character. However, the assessment of novelty and distinctive character, in some stages, needs common interpretations. In short, some stages of the assessment may not excuse such opposing views. Thus, the differences regarding the assessment of novelty and distinctive character indicate a need of common guiding principles.

7.2 Common guiding principles for the assessment of novelty and distinctive character

The views of the participants about common guiding principles were investigated. The participants were addressed to a question which asks whether they are in need of additional guiding principles. The answers were mentioned and discussed under this title.

7.2.1 Common guiding principles (guideline) is necessary

30 participants out of 51, consisting of six judges, eight court experts (including two jurist court experts), five TPI experts, five attorneys (including three TPI attorneys) and six agents emphasized the need of common guiding criteria. According to them, a guideline would facilitate the assessment of novelty and distinctive character. Two of these TPI experts noted that they have been working on some manuals related to the registration system.

- **It is needed because the provisions are not descriptive enough.** According to one of these TPI experts, additional common criteria are needed because the provisions in the Decree-Law can sometimes be nondescriptive for several parties.
- **First of all, the new law must be enacted.** A judge mentioned that before the preparation of such a guideline, the new law must be enacted.
- **It would strengthen the dialogue between parties.** Two of these judges and one of these court experts also noted that such an implication would strengthen the dialogue between the parties.

- **It would bring transparency to the process.** One of the judges and one of the TPI experts mentioned that common criteria would bring objectivity and transparency to the assessment process.
- **They can be sector-specific.** One of these judges and one of the jurist court experts noted that guidelines can be prepared for various sectors. To them, such an approach would be beneficial for both applicants and assessors.
- **Something like a checklist.** Three of these court experts mentioned that the expectative guideline had better be in a checklist format. One of these court experts also stated that such a checklist can guide the applicants as well as the assessors.
- **It can be a detailed version of the general principles.** To one of the judges, one of the court experts and one of these attorneys, such a guideline can be developed by elaborating the general principles signified in the Decree-Law. For instance, the judge stated, definitions such as the “informed user” and “overall impression” can be detailed and explained clearly. He also stated that this method would be useful since such a guideline should be in accordance with the law in force.
- **They should be updated regularly.** Another TPI expert and one of the jurist court experts stated that such criteria should be prepared in a manner that enables them to be updated regularly in order to meet the needs.
- **It should involve examples.** According to a judge and an agent, such a guideline may involve illustrative examples and sample cases.
- **It should not limit the designers.** An agent noted that such a guideline should not limit the design owners and assessors by prescriptions.
- **It would serve various parties.** According to one of the court experts and one of the agents, such a guideline would be useful for the court experts. One of the judges noted that such common criteria would also guide the designers. One of the TPI experts stated that a guideline would serve the TPI experts

and facilitate the assessment process. Also, according to one of these TPI experts and an agent, some common criteria are particularly necessary for the agents.

7.2.2 Challenges of a guideline and objections made against the common guiding principles

11 participants consisting of three judges, a court expert, a TPI expert, five attorneys and an agent stated that there is no need to develop new criteria for the assessment of novelty and distinctive character. According to one of the judges and another judge, the court expert, two of the attorneys and another attorney, and another agent mentioned that it is very hard for such a guideline to be adaptable to *all* designs in *all* product categories.

- **The law is the only guide.** According to two of these judges, only the law can guide the parties. In other words, according to them, there can be no guide except for the law.
- **The law maker can only enact general provisions while making a law.** Three of these judges and an attorney emphasized that the general principles (provisions given in the Decree-Law) cannot be elaborated more than how they are in the present. In other words, they found the provisions in the Decree-Law enough, because according to them, elaborating the general principles would be a restrictive implementation, as each case is specific.
- **The regulation would be enough if the new law enters into force.** One of these attorneys mentioned that the regulation which will be prepared after the enactment of the new law would be enough for the assessment.
- **The decisions can be archived.** The TPI expert noted that the court decisions can be archived instead of preparing such a guideline. According to him, benefiting from such an archive would also be helpful the assessment process.

- **Some exemplary cases can be exposed instead of developing a guideline.**
According to the TPI expert and two attorneys, some exemplary cases can be shared instead of a guideline. According to them, this would facilitate the assessment more than a guideline.

7.2.3 Discussions on common guiding principles

Roughly two groups emerged concerning the participants' attitudes to the preparation of common guiding principles. One of the groups, consisting of 30 participants, supported the idea of preparation of common guiding principles; whereas 11 participants found it not necessary to prepare such guiding principles. Nevertheless, a general view was that, the new law should be enacted before preparing such principles. In other words, the Decree-Law should become a law as immediate as possible.

According to the first group, preparing such guides is necessary, as the assessment process requires objective criteria and additional guiding principles. One of the reasons of such an attitude was that the provisions, involved in the current legislations, were found to be not descriptive and clear enough. Common guiding principles can be counted as a checklist or a guideline; or may be a detailed version of the current provisions. It also may be considered as a sector-specific reference, involving exemplary cases and being updated regularly. Such a reference is expected to serve particularly the court experts, (freelance) designers, TPI experts and agents, since they generally assess the designs in terms of novelty and distinctive character. No doubt, it would also bring transparency to the assessment process, and would strengthen the dialogue between the parties, on condition that it does not limit the designers by giving strict instructions.

According to the other group, there is no need to prepare such guiding principles, since it was found very hard to develop such principles for all product categories. Besides, it was thought that some participants, particularly the jurists, considered such guides as if they are legal documents; and gave reaction to this suggestion. They stated that only the law can be a guide for parties, and the present provisions were

found sufficient. However, the objective of developing such a guide was not to create a rival to the existing law; instead, a supplementary guide, which operates in accordance with the law, is suggested.

Furthermore, some alternatives were offered instead of preparing such a guide. For instance, archiving and opening the court decisions to public were offered for that purpose. Also, according to an opinion, exposing only exemplary cases would be useful for the assessment of novelty and distinctive character.

CHAPTER 8

CONCLUSION

This study has investigated the assessment of novelty and distinctive character in the context of design registration system in Turkey through a literature survey and a field study. The field study focused on the parties actively involved in the assessment process –judges, court experts, TPI experts, attorneys and agents. The research questions identified for the whole study were as follows:

- How is the assessment of ‘novelty’ and ‘distinctive character’ made?
- Which considerations are taken into account in the assessment of ‘novelty’ and ‘distinctive character’?
- What are the challenges and difficulties faced in the assessment of ‘novelty’ and ‘distinctive character’?
- What are the similarities and differences among the assessment perspectives of the parties involved?
- What is the relevance of a common guideline or some guiding principles to the assessment process?

There are various studies made on intellectual property rights in general, and the legal protection of designs in particular; however, this study tried to find answers to the abovementioned questions, and presented a holistic and in-depth analysis of the assessment of novelty and distinctive character by the relevant parties. The assessment strategies of the parties regarding the novelty and distinctive character have been studied for the first time in a comprehensive way. Even though the total number of participants does not represent a statistically significant sample size, the data gathered from the interviews are considered to be insightful, since a

considerable number of interviews were conducted, and the sample size for two participant groups -judges and TPI experts- represented the whole population.

Furthermore, the study highlighted an issue which has recently started to gain importance, an assessment guide for industrial designs. Thus, the outputs of this study are also expected to contribute to the development of such a guide. The study also puts forward the problems identified and the solutions suggested in relation to the registration system in general, and the assessment process in particular.

The field study highlighted two weaknesses in the registration system of industrial designs in Turkey.

- The registration system is open to abuse because it is a system without examination. Therefore, designs that do not fulfil the conditions of protection may get registered.
- The assessors experience some difficulties in the assessment of novelty and distinctive character because it involves some subjective aspects.

It was also observed that the findings of the field study gather around three major issues. These issues can be briefed as the assessment of novelty and distinctive character, the problems faced and the suggestions made. Conclusions on the mentioned issues are presented below under relevant subtitles.

8.1 Conclusions on the assessment of novelty and distinctive character

When the results are discussed in terms of the assessment of novelty, it was seen that the assessment of 'novelty' is regarded as an easier process compared to that of distinctive character. In the assessment of novelty, the major consideration was found to be *being not exactly the same with a previous design*. It is also possible to state that novelty did not stand for *originality* or *being totally new*. Within this framework, two aspects come to the forefront; the first one is the determination of the *date of*

making available to the public, and the second one is the *morphological* assessment made upon the design, regarding the visual representation.

In the determination of the dates on which the designs in question have been made available to the public, the proofs gain importance. To say more clearly, the undated and insufficient proofs, such as undated invoices or catalogues, would not serve the purpose; so, they have to be *dated* and have to involve *good quality visual representations* and *product codes*.

In the assessment of novelty, there are a few questions to be answered, regarding the determination of dates and the designs' being or not being identical. Thus, it is possible to state that the applicants or assessors may form an opinion about the novelty of a design by following the steps given in Figure 13.

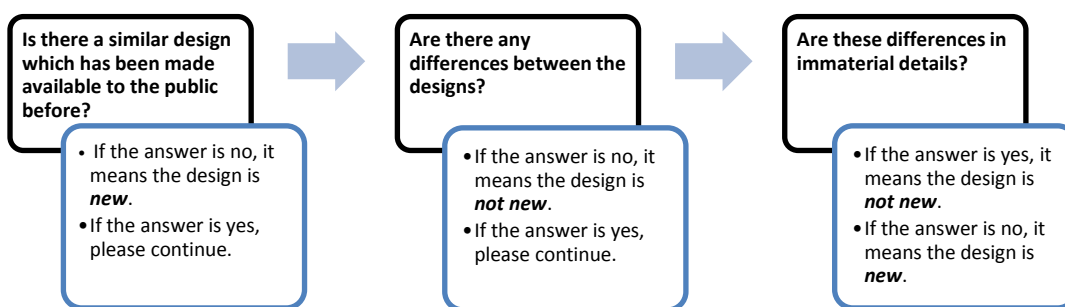


Figure 13 A proposal for the applicants regarding the assessment of “novelty”

Figure 13 shows the basic steps, which may be followed by the applicants while checking the novelty of the design they would like to file application for. However, it must be noted that these steps do not stand for an entire assessment process, since the differences between the designs should be assessed in terms of being material or not. The assessment in the opposition (with TPI) and lawsuit processes involves different considerations.

Different from invalidity cases, the assessment involves some other considerations in oppositions or infringements. For instance, before filing a court case, oppositions can

be made for designs having been published within the past 6 months from that date. In such a situation, the assessment of novelty and distinctive character are being made by TPI. Here, the date, on which the design, which was shown as the reason for the opposition has been made available to the public, gains importance. In infringement cases, the novelty of the claimant's design may come into question with a counterclaim. Thus, it is possible to state that the assessment of novelty is based on the dates on which the designs in question have been made available to the public, and requires some design-based assessments for the differences between them.

In the assessment of distinctive character, five aspects are taken into consideration: the overall impression of design, significant difference, informed user, common features and differences between the designs, and the designer's degree of freedom. It was observed that the assessment usually focuses on the *overall impression* of the design in question. In other words, the overall impression is thought to be the determinant attribute of the assessment. Even though such an approach is not regarded wrong, to consider solely the overall impression is thought to result in a shallow assessment, since there are some other factors to be considered, such as the designer's degree of freedom. Nevertheless, it was also observed that the designer's degree of freedom is underestimated within the assessment process. Such an attitude might have resulted from the fact that the assessment of the degree of freedom can only be made by technical court experts. To say more clearly, it might have been neglected because the assessment of degree of freedom requires a technical assessment well beyond a visual examination made on the appearances.

The notion of *informed user*, about which major misconceptions were encountered, also emerges as another important aspect in the assessment. Contrary to the abovementioned approach, the determination of the informed user appears as a starting point. Here, it is possible to state that the assessor firstly puts himself in the place of an informed user, and then starts to assess the other aspects. It was also observed that, in both of the approaches, the notion of informed user and the designer's degree of freedom are regarded as supplementary considerations in the determination of common features and differences between the designs. However,

the common features and the differences between the designs should be specified objectively, without being selective. The evaluation would then be initiated by putting oneself in the place of the informed user and giving weight to the common features. Also the designer's degree of freedom should, at this stage, be assessed. Finally, the assessor tries to answer to the last and probably the foremost question: *Is there a significant difference between the overall impressions of the designs in question?* An exemplary flow chart for the assessment of distinctive character is given below in Figure 14.

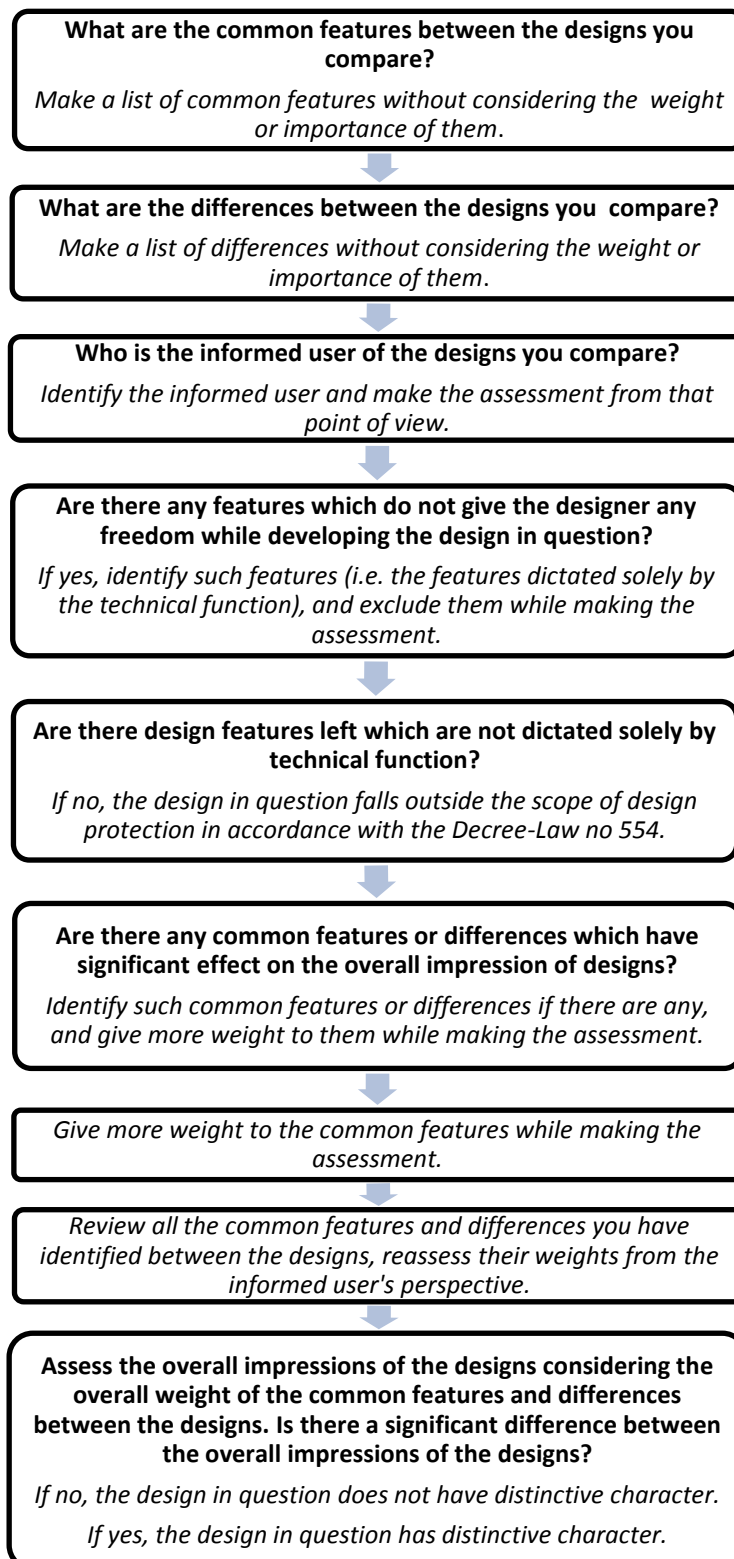


Figure 14 A flow chart proposal for the assessment of distinctive character

8.2 Conclusions on encountered problems and suggestions made

During the interview process the parties not only mentioned problems which were within the scope of this thesis, but also touched on several other problems beyond the subject matter of this study. The inferences made from these problems have been discussed formerly.

However, it was observed that some problems are directly related to the subject of this study; and need to be discussed in such a manner that concludes the whole process in three ways: assessment process, encountered problems and suggestions made. The assessment process was dealt in the former section; the major problems are to be tackled through Figure 15 -which is a review of Figure 11-, and the fundamental suggestions shall be presented subsequently.

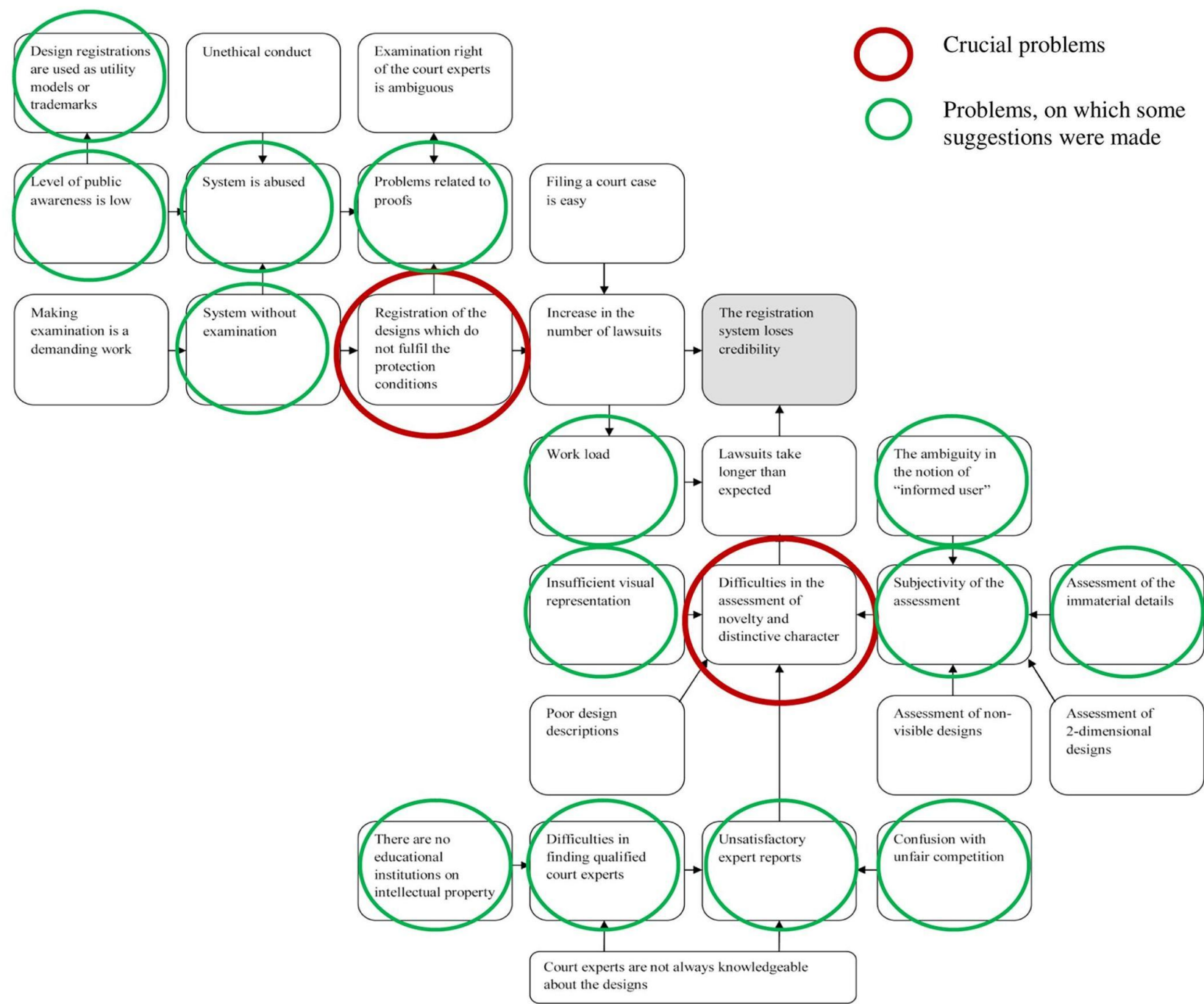


Figure 15 Crucial points of the problems

Considering Figure 15, it is possible to state that, this study not only reveals the major problems encountered, but also puts forward some suggestions related to them. In Figure 15 the problems which are closely related to the end point were circled in red. One of these crucial points was the registration of the designs which do not fulfil the protection conditions. The other one was found to be the difficulties in the assessment processes of novelty and distinctive character, which already constitutes the main concern of this study. It was observed that, these two major problems result from some other problems, which may be solved by some of the suggestions mentioned formerly in 4.10. The green circles, in Figure 15, indicate the problems, on which some suggestions were made. Thus, it would be useful here to recapitulate the most important suggestions:

- The Decree-Law no 554 should become a law
- The system may involve a preliminary examination process for the assessment of novelty
- At least one designer should be assigned in the panel of court experts
- Training programs can be organised for court experts
- Common guiding principles, which may serve both the applicants and assessors, may be developed for the assessment of novelty and distinctive character
- Visual representations should be of good quality
- Invoices and catalogues of the firms should involve accurate dates and product codes
- Agents may guide the applicants about the novelty of their designs
- Applicants may scan the publications in order to examine the novelty of their designs
- The awareness level of the public should be raised

These suggestions are thought to contribute to the present state of the registration system. Besides, it was specified that more than half of the participants found the idea of a guideline (common guiding principles) beneficial, and it was observed that many participants feel the lack of such a frame. Nevertheless, it must be noted that

this study does not aim to offer an entire guideline model. However, some suggestions for the development of such a document which can be named as a *guideline* are made below:

- It can be a detailed version of the general principles, and may involve clear and descriptive definitions of essential terms, such as
 - novelty,
 - differences in immaterial details,
 - distinctive character,
 - overall impression,
 - significant difference between the overall impression of designs,
 - informed user,
 - common features and differences between the designs,
 - designer's degree of freedom.
- It may be developed according to the sectors
- It may involve checklists
- It may be updated regularly
- It may involve example cases, decisions and expert reports
- It should not limit the designers by giving strict instructions

These guidelines should also be reviewed in the preparation process of a guideline for our system. Also, it has to be noted that, even though a guideline would not be a legislative text, the preparation process would require legal knowledge, as well as design background. Thus, the guideline preparation stage has to be regarded as an interdisciplinary process, in which designers, jurists and many other professionals are employed. Nevertheless, it is possible to say that a guideline would

- strengthen the dialogue between parties
- bring transparency to the registration and assessment processes
- and serve various parties such as court experts, applicants, agents, and TPI experts
- prevent misconceptions.

8.3 Further studies

This study paves the way for some further studies by touching on various points, which could arouse the interest of both designers and jurists. For instance, the six major aspects that play important roles in the assessment of novelty and distinctive character -immaterial details, overall impression, significant difference, informed user, common features and differences between designs, and the designer's degree of freedom- can be investigated individually in terms of assessment or as a notion. Also, some of the mentioned problems which surpass the scope of this study may be dealt separately in future studies. Issues related to the effects of delayed justice may also be taken into consideration as individual further studies. Besides, studies based on discussions related to concrete cases including visual images can be made.

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APPENDIX A

INTERVIEW SCHEDULE (in Turkish)

Anket Kodu:

Tarih:

ENDÜSTRİYEL TASARIM TESCİLİNDE YENİLİK VE AYIRT EDİCİ NİTELİK DEĞERLENDİRMESİ

GÖRÜŞME KILAVUZU

1. GİRİŞ

Adım Cankız Elibol. Orta Doğu Teknik Üniversitesi Endüstri Ürünleri Tasarımı Bölümünde doktora öğrencisiyim. Bu araştırmayı, endüstriyel tasarım tescilinde yenilik ve ayırt edici nitelik değerlendirmesinin nasıl yapıldığını, değerlendirmeyi yapanların ne tür sorunlarla karşılaştıklarını öğrenmek ve değerlendirmeye ilişkin öneriler geliştirmek amacıyla gerçekleştiriyorum.

Yapacağımız görüşmede size araştırma konusuyla ilgili bazı sorular soracağım. Görüşme sırasında anlattıklarınızı yalnızca bilimsel amaçlarla kullanacağım; kimliğinizle ilgili bilgileri saklı tutacağım. Konuştuklarımızı daha sonra tam olarak hatırlayabilmek ve gözden geçirebilmek için görüşmemizi kaydedeceğim.

Görüşmemize başlamadan önce sormak istediğiniz herhangi bir şey var mı?

2. YENİLİK

2.1 Bildiğiniz gibi 554 sayılı Kanun Hükmünde Kararnameye göre yeni ve ayırt edici niteliğe sahip tasarımlar korunuyor. Bir tasarımın aynısı başvuru veya rüçhan tarihinden önce dünyanın herhangi bir yerinde kamuya sunulmamış ise o tasarım “yeni” kabul ediliyor. Siz “yenilik” değerlendirmesini nasıl yapıyorsunuz? Örnek bir vaka üzerinde konuşabilir miyiz?

2.2 “Aynı” ve “küçük ayrıntılarda farklılık” kavramlarıyla ilgili düşünceleriniz neler?

3. AYIRT EDİCİ NİTELİK

3.1 Kararnamedeki tanıma göre, bir tasarımın ayırt edici niteliğe sahip olması, bu tasarımın bilgilenmiş kullanıcı üzerinde yarattığı genel izlenim ile diğer tasarımın yarattığı genel izlenim arasında belirgin bir farklılık olması anlamına geliyor. Siz “ayırt edici nitelik” değerlendirmesini nasıl yapıyorsunuz? Örnek vaka üzerinde konuşabilir miyiz?

3.2 Ayırt edici nitelik tanımında karşımıza çıkan “genel izlenim” sizce nedir? Unsurları nelerdir?

3.3 Genel izlenimler arasındaki “belirgin farklılık” üzerinde etkili olduğunu düşündüğünüz faktörler neler?

3.4 Ayırt edici nitelik değerlendirmesinde geçen “bilgilenmiş kullanıcı” kavramı hakkında ne düşünüyorsunuz?

>Sizce bilgilenmiş kullanıcının ayırt edici nitelik değerlendirmesindeki rolü nedir?

3.5 Düzenlemeye göre ayırt edici nitelik değerlendirmesinde, kıyaslanan tasarımların farklılıklarından çok ortak özelliklerine ağırlık verilmesi bekleniyor. Farklılıkları ve ortak özellikleri değerlendirmede siz nasıl dikkate alıyorsunuz?

3.6 Düzenlemeye göre, teknik fonksiyonun gerçekleştirilmesinde, tasarımcıya, tasarıma ilişkin özellik ve unsurlarda hiçbir seçenek özgürlüğü bırakmayan tasarımlar koruma kapsamı dışında kalıyor. Siz “seçenek özgürlüğü” hakkında ne düşünüyorsunuz?

>Sizce seçenek özgürlüğünün ayırt edici nitelik değerlendirmesindeki rolü nedir?

3.7 Tasarım tescilinde “yenilik” ve “ayırt edici nitelik” değerlendirmesi yaparken yaşadığınız en önemli sorunlar nelerdir?

4. TESCİL VE DEĞERLENDİRME SÜREÇLERİ

4.1. Yenilik ve ayırt edici nitelik değerlendirmesinde avukat, hakim, bilirkişi gibi çeşitli gruplar arasında değerlendirmenin yapılışı açısından farklılıklar gözlemlediniz mi? Bu farklılıklar nelerdir?

4.2 Sizce endüstriyel tasarım tescil sürecinin işleyişinde ne gibi iyileştirmeler yapılabilir?

4.3 “Yenilik ve ayırt edici nitelik” değerlendirmesinde, süreci ve görüş oluşturmaya kolaylaştırıcı, yol gösterici ortak ilkelerin oluşturulması sizce yararlı olur mu?

>Sizce ne tür ilkelere ihtiyaç var?

4.4 “Yenilik ve ayırt edici nitelik” değerlendirmesine ilişkin eklemek veya söylemek istediğiniz, eksik kaldığını düşündüğünüz herhangi bir şey var mı?

5. GÖRÜŞME YAPILAN KİŞİYE İLİŞKİN BİLGİLER

Son olarak sizinle ilgili birkaç kısa sorum olacak.

5.1 Doğum tarihiniz

5.2 Mezun olduğunuz lisans / yüksek lisans / doktora programları:

Lisans (üniversite/bölüm)

Yüksek lisans (üniversite/ABD)

Doktora (üniversite/ABD)

5.3 İşiniz ve göreviniz

5.4 Ne kadar süredir tasarım tescili konusunda (bilirkişilik / hakimlik / vekillik / avukatlık / YİDK üyeliği) yapıyorsunuz?

5.5 Fikri ve sınai haklar konusunda özel bir eğitim aldınız mı?

6. GÖRÜŞMENİN SONLANDIRILMASI

Araştırma tamamlandıktan sonra sonuçların bir özetini size iletmemi ister misiniz?

Elektronik posta:

.....@.....

veya

Adres:

.....
.....
..

Araştırmaya katkıda bulunduğunuz ve zaman ayırdığınız için çok teşekkür ederim. Daha sonra görüşmeye ilişkin herhangi bir şey sormak ya da söylemek isterseniz, bana bu karttaki telefonlardan veya elektronik posta adresinden ulaşabilirsiniz. Yardımlarınız için tekrar teşekkür ederim.

Üzerinde konuştuğumuz vakaya ilişkin bilgileri alabilir miyim? Tasarımların fotoğraflarını çekmem de çok yararlı olur.

7. BÖLÜM: GÖRÜŞME SONRASI İZLENİMLER VE NOTLAR

APPENDIX B

INTERVIEW SCHEDULE (in English)

Interview Code:

Date:

ASSESSMENT OF NOVELTY AND DISTINCTIVE CHARACTER IN INDUSTRIAL DESIGN REGISTRATION

INTERVIEW SCHEDULE

1. INTRODUCTION

My name is Cankız Elibol. I am a doctoral student in the Middle East Technical University, Department of Industrial Design. I have been studying on this subject in order to investigate the assessment processes of novelty and distinctive character, to determine the problems faced, and to develop solution proposals for the assessment.

During the interview, I will ask you some questions about the subject. I shall use your answers only for scientific purposes, and keep your personal information confidential. I am going to record our interview to remember and re-read the entire conversation later.

Is there anything you would like to ask before starting the interview?

2. NOVELTY

2.1 As you know, according to the Decree Law No 554, novelty and distinctive character are the protection conditions of a design. A design shall be considered new if before the date of reference no identical design has been made available to the public in the world. How do you make the assessment of novelty? Can we talk over a case?

2.2 What do you think about “identical” designs and designs “differing only in immaterial details”?

3. DISTINCTIVE CHARACTER

3.1 According to the definition in the Decree Law; a design shall be understood to have a distinctive character if the overall impression it creates on the informed user is significantly different from the overall impression created on the same user by any design. How do you make the assessment of distinctive character? Can we talk over a case?

3.2 What is the term “overall impression” mentioned in the definition of distinctive character? What are its factors?

3.3 In your opinion, what are the factors that influence the “significant difference”?

3.4 What do you think about the notion of “informed user” referred in the definition of distinctive character?

>In your opinion, what is the role of the informed user in the assessment of distinctive character?

3.5 According to the legislation, in the assessment of distinctive character, the emphasis of evaluation shall be on the common features of the designs instead of differences. How do you consider the differences and common features?

3.6 According to the legislation, designs resulting from a technical function which does not leave to the designer any freedom in the design characteristics and elements fall outside the scope of protection. What do you think about the “degree of freedom”?

>What is the role of the degree of freedom in the assessment of distinctive character according to you?

3.7 What are the main problems that you are faced with, during the assessment of novelty and distinctive character?

4. REGISTRATION AND ASSESSMENT PROCESSES

4.1 Have you noticed some differences between various groups such as attorneys, judges and court experts in terms of assessment of novelty and distinctive character? If yes, what are these differences?

4.2 What kinds of amendments can be made in the registration process?

4.3 Do you think that some guiding common criteria could be useful in facilitating the process and in forming opinions?

>What kind of amendments is needed?

4.4 Is there anything you would like to add related to the assessment of novelty and distinctive character?

5. INTERVIEWEE INFORMATION

Finally, I would like to ask some personal questions.

5.1 Date of birth.....

5.2 Education (Bachelor's Degree/ Master's Degree/ PhD):

Bachelor's Degree.....

Master's Degree.....

PhD.....

5.3 Your job and position.....

5.4 How long have you been working as a(n) court expert / judge / patent and/or trademark agent / attorney / expert in TPI?.....

5.5 Have you received a special training in the field of intellectual and industrial property rights?

6. FINALISING THE INTERVIEW

Would you like me to send you a copy of the results at the end of the study?

E-mail address:.....@.....

OR

Address:.....

.....

Thank you for allocating time, and for your contribution to the study. If you would like to ask or add anything about the interview afterwards, please contact me through the telephone number or the e-mail address given on this card. Thank you again for your cooperation.

Would you mind giving me the information about the case we talked over? If possible it would also be helpful to take photos of the designs.

7. IMPRESSIONS AND NOTES

APPENDIX C

AN EXEMPLARY BOARD USED IN THE ANALYSIS

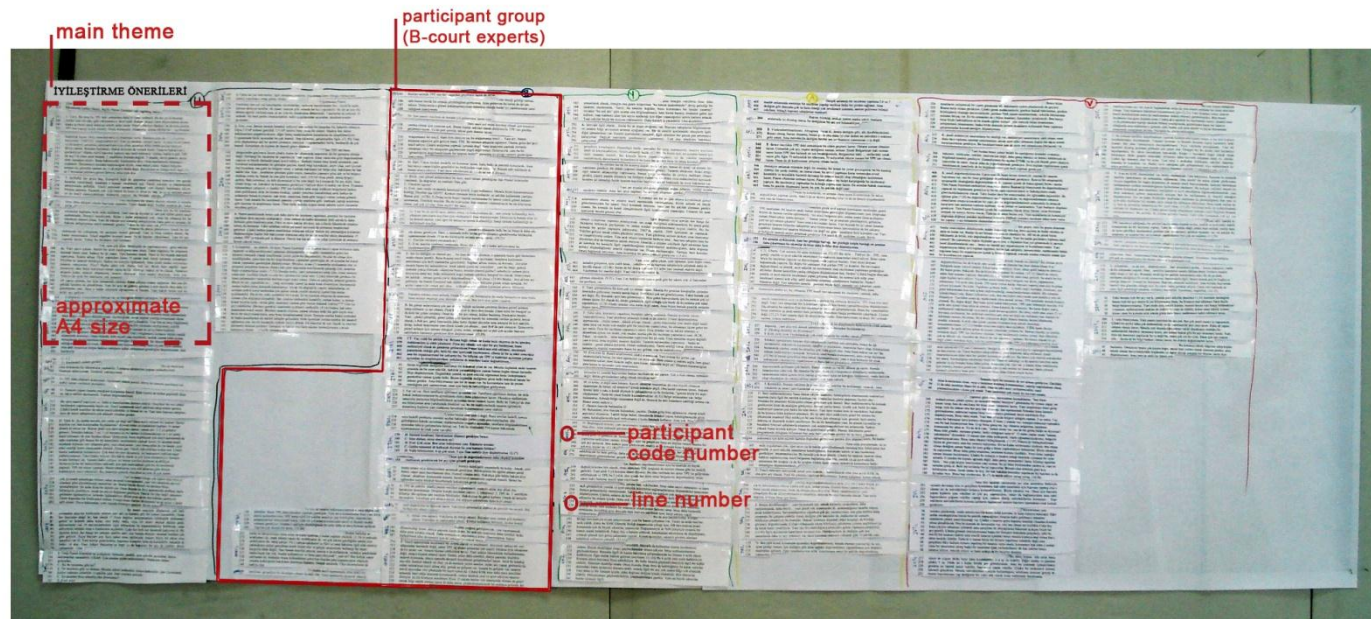


Figure C An exemplary board used in the analysis

CURRICULUM VITAE

PERSONAL INFORMATION

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EDUCATION

Degree	Institution	Year of Graduation
MS	Hacettepe University, Wood Products Industrial Engineering	2005
BS	Hacettepe University, Wood Products Industrial Engineering	2002
High School	TED Ankara College, Ankara	1996

WORK EXPERIENCE

Year	Place	Enrollment
2007- Present	Hacettepe University, Faculty of Fine Arts, Department of Interior Architecture and Environmental Design	Research Assistant
2002-2007	Hacettepe University, School of Vocational Technology, Department of Wood Products Industrial Engineering	Research Assistant
2002 July-August	Persan Home Studio	Designer/Engineer

FOREIGN LANGUAGES

Advanced English, Beginner German

PUBLICATIONS AND PROCEEDINGS

1. Burdurlu, E., Kılıç, Y., İlçe, C., Elibol, G.C., Yener, G.,2004, Okul Öncesi Çocuk Mobilyaları ile İlgili Ebeveyn Görüşleri ve Öngörülen Mobilya Tasarım Ölçütleri, ZKÜ Teknik Eğitim Fakültesi Teknoloji Dergisi, Sayı 1, 139-149
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HOBBIES AND INTERESTS

Drawing, caricatures, cars, swimming, old Turkish movies, non-fiction books, cooking.