

Three main problems regarding International Registrations filed through WIPO designating Turkey and our solutions to them

By Özlem Fütman, OFO VENTURA, Turkey

OFO VENTURA would like to share with you three main problems regarding IRs filed through WIPO where Turkey is designated and also provide our solutions to them; we believe they are important to know because particularly one of these problems may cause loss of rights in Turkey for the IR filers.

Problem 1

If you are Not aware of the fact that your IR is opposed in Turkey, then you would probably lose non-use defense right:

1- One of the important points in the New Turkish IP Code no 6769 which has been in force since 10 January 2017 is that; in opposition proceedings, the applicant has the right to invite its opponent(s) to prove serious and genuine use of its mark in Turkey in the past 5 years or submit justified reasons for non-use, if the opponent's mark passed the 5 year use term on the filing/priority date of opposed mark. If opponent cannot prove such use, then the opposition would be refused in terms of likelihood of confusion based on opponent's earlier mark.

After a mark is opposed, the Turkish Patent and Trademark Office (TURKPATENT) informs the opposition to the applicant while giving one month for submission of counter arguments and evidence. Within the same one month time frame, the applicant can file the related part in the necessary Form, asking the opponent to provide evidence of use while submitting his counter arguments, or such use can be sought by letter where the wording alternatives of it are stated in the TURKPATENT's Use Guideline, if the applicant does not submit any counter arguments.

So you believe that, as an IR filer, you would have no problem in terms of enjoying non-use defense, right? Not really, please keep reading.

2- The publication period for third party oppositions is 2 months in Turkey. During the publication period, if an IR is opposed then – unfortunately – TURKPATENT does NOT notify the opposition to WIPO namely to the filer, but informs the situation ONLY IF the third party opposition is partially or entirely accepted. In other words, if your IR is opposed in Turkey by third parties, you would Not be aware of that, may not submit a response to it but more importantly you would lose your non-use defense right.

3- Can you Not use non-use defense tool if you Appeal TURKPATENT'S decision accepting partially/entirely the third party opposition? Unfortunately NOT because you can invite your opponent(s) prove use only during the first step opposition but Not in Appeal stage.

4- Can you appoint a local counsel/agent so that the third party oppositions are informed to them by TURKPATENT where then the necessary steps are taken? The answer is; No.

There is No law binding you from appointing a local agent in Turkey. Yet, such an appointment does Not mean that a third party opposition would be informed /notified to the appointed local counsel. We know that most of our colleagues tell their clients that if they register themselves as agent for an IR, TURKPATENT would inform the opposition/s to our local colleagues; however, unfortunately, this information is Not correct. This is because, as a Madrid Protocol country, TURKPATENT sends notifications only to/through WIPO and does Not contact with local agents.

Solution: As soon as you file the IR, if you contact with us by giving the IR number of the application, we would be more than happy to assist you. As is known, it may take time to enter an IR into TURKPATENT records and we would follow that process for you too. Once the IR obtains a national number here, we would register ourselves as the representative for the file& our watch notice team will starts monitoring it. If the publication period is over without facing with any third party oppositions, this would also be reported to you.

Problem 2

If an IR is partially/entirely refused by TURKPATENT, after absolute grounds examination, it may take months for the filer to learn about it.

TURKPATENT examines all filings from the point of absolute grounds. Partial/entire refusals are also informed to the applicants' representatives through WIPO, if it is an IR. Yet, this process may sometimes take months& causes delays for brand owners.

Solution: If you contact with us, we can follow up your IR from this point of view.

Problem 3

Obtaining Registration Number for an IR may take long time in Turkey

Workload of TURKPATENT is getting heavier and heavier every year which brings new issues in practice. One of these problems is that; not always but in many cases TURKPATENT does Not give registration numbers to IRs, after the publication period is successfully passed. If you do Not check the situation, sometime for years, you may not be aware of the fact that the registration process for your client's IR is Not concluded in Turkey.

Solution: If you contact with us, we can follow up your IR from this point of view as well, and take necessary steps before TURKPATENT to have the IR obtain a Registration number.

If you need any assistance for your IR matters, we would be more than happy to provide you our services.

For more information, please contact:



Özlem Fütman

Founding Partner OFO VENTURA
IP Litigator-Trademark & Patent Attorney

OFO VENTURA

Halaskargazi Caddesi
Çankaya Apt, No; 150/2
34371, Şişli/Istanbul/Turkey
ofutman@ofventura.com.tr
www.ofventura.com.tr
Tel. +90 212 219 67 33
Fax +90 212 234 17 09