

Measures to be Considered by Turkish Patent Institute in Joining the Madrid System

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OUTLINE

- Turkish Patent Institute in general
- Measures in Accession to the Madrid Protocol
 - Legislative Measures
 - Measures Concerning Trademark Attorneys and Other Relevant Parties
 - Institutional Measures
- Effects of Madrid Protocol
 - Effects of Madrid Protocol for TPI
 - Effects of Madrid Protocol for Trademark Attorneys and other relevant parties

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Turkish Patent Institute (TPI)



Establishment of Turkish Patent Institute (TPI)

- Established in 24 June 1994
 - Before that date the administration of industrial property legislation (only trademark and patent protection) was entrusted to a department of the Ministry of Industry and Trade.

Turkish Patent Institute

- A special government authority with administrative and financial autonomy
- Responsible for the administration of all industrial property rights
- Responsible for the administration of related international agreements to which Turkey is party

Turkish Patent Institute in General

- More than 400 staff
- Industrial property rights:
 - Patents
 - Trademarks
 - Industrial designs
 - Geographical Indications



Trademarks Department

- Head of Department (1)
- Division Directors (4)
- Trademark Examiners (43)
 - Board of Appeal (5)
 - Oppositions (7)
 - International Applications (Madrid) (3)
 - Substantive examination of national applications (28)
- Other staff (65)



Trademark Legislation

- Decree-Law No. 556 Pertaining to the Protection of Trademarks (1995)
- Implementing Regulation Under the Decree Law No.556 Pertaining to the Protection of Trademarks (1995)



International Agreements Related to Trademarks

Turkey is party to;

- Paris Convention (1925)
- TRIPs Agreement (1995)
- Nice Agreement (1996)
- Vienna Agreement (1996)
- **Madrid Protocol (1999)**
- Trademark Law Treaty (TLT) (2005)



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Measures in Accession to the Madrid Protocol

- Turkey acceded to the MP in January 1st, 1999
- Not party to the Madrid Agreement
- Main aims:
 - to promote the import and export regime
 - to make it more affordable mainly for SMEs to obtain TM protection abroad (Because, they have budget limit, language barrier etc)

Legislative Measures

- Madrid Protocol and Common Regulation published on Official Gazette in Turkish in 1999.
- After publication, they came into effect.
- 2 articles regarding the international applications were added to the trademark implementing regulation



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Measures Concerning Trademark Attorneys

- Some of the trademark attorneys were reluctant to the accession to the Madrid Protocol since international applicants would prefer direct application via MP rather than national application to the Offices by agents
- With cooperation of WIPO, TPI carried out some informing and awareness activities such as seminars and symposiums for trademark attorneys

Measures Concerning Other Relevant Parties

- Right holders, academicians, and judiciary were not aware of the Madrid Protocol. They were also informed with such awareness activities.
- Not a real resistance received from such parties

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Review of Organisation of the Office and Administrative Procedures

- A new division established under the Trademarks Department (Madrid Division)
- Started with 2 examiners and 2 supporting staff and reached to a maximum of 5 examiners and 4 supporting staff
- Selected examiners having language capacity were trained in WIPO

Duties of the Madrid Division

- Duties of division as an office of origin
- Duties of division as a designated contracting party
- Additional works (transformation, replacement, information notices etc.)
- Consultancy and information service

Review of Examination Process

- A special track and examination system for management of Madrid Protocol applications
- No need for formal examination (classification of goods&services /figurative elements of the marks) since these are made by IB

Review of Opposition and Appeal Processes

- No special examiners appointed for opposition and appeals
- Priority is given to the International applications to comply with time periods in appeal and opposition procedures.

Review of Office Resources and IT Infrastructure

- No special staff on IT Department assigned for Madrid Protocol
- Specifications and tools regarding the Madrid system procedures were included in the TM software.
- A national application number is given to the Madrid Protocol applications.
- International applications are placed in folders with a different colour than the national ones.

Basic Procedural Aspects

- Communication Language:
 - TPI preferred English as a communication language
 - Because, English is the most widely-spoken foreign language in Turkey

Basic Procedural Aspects

- Time period to notify refusals of applications:
 - TPI preferred 12 months at the beginning
 - After declaration in 2000, TPI preferred 18 months
 - Possible notification of refusals based on an opposition after the 18-month time limit

Basic Procedural Aspects

- Fee:
 - Till 2005, Turkey preferred to apply standard fees to encourage the designations in Turkey
 - After October 2005 , Turkey began to apply individual fee instead of a share in the revenue produced by the supplementary and complementary fee.

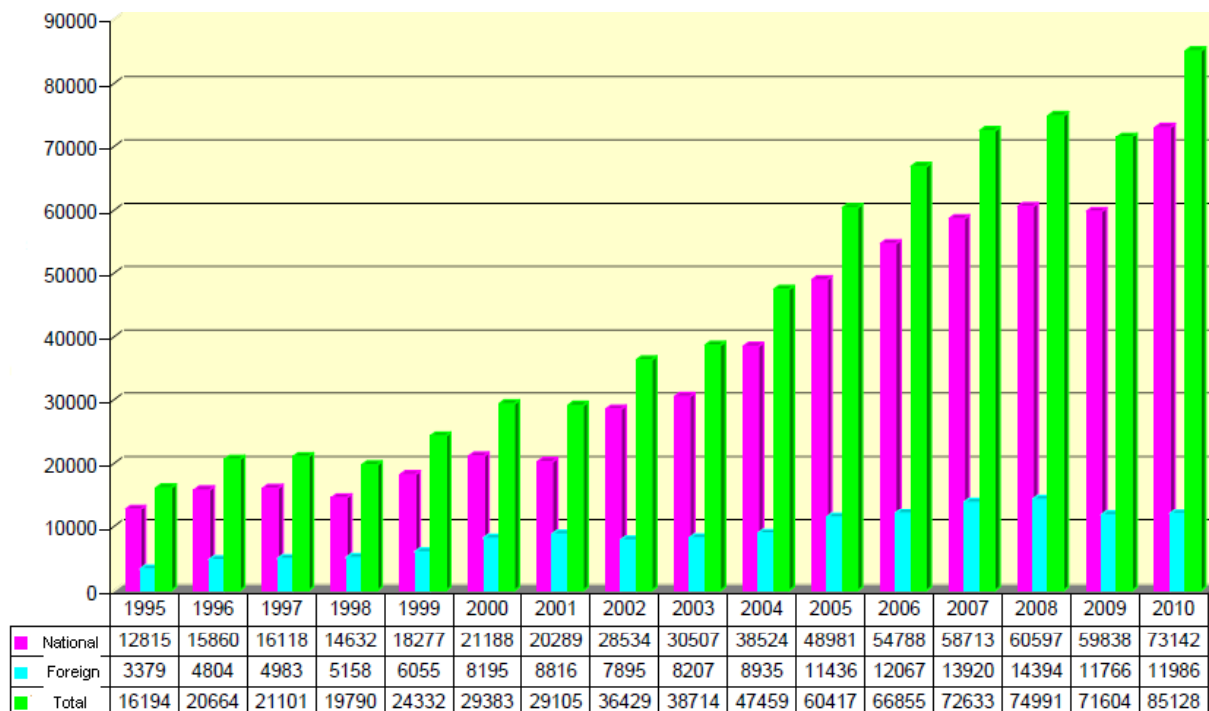
Basic Procedural Aspects

- Communication with WIPO
 - Till 2005, all notifications on paper
 - After 2005, TPI started to receive designations and subsequent designations online from WIPO database as well as on paper

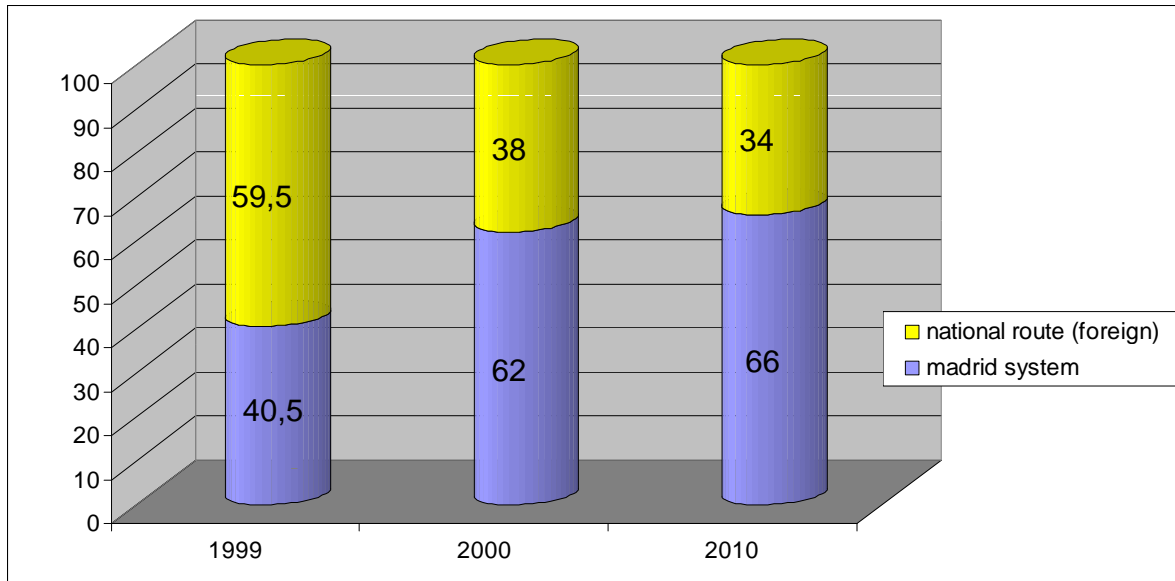
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Increase in the total number of applications from abroad



Madrid Protocol vs. National Route



Increase in number of foreign applications from related countries

- The number of applications coming from the countries, especially for those which export their goods to Turkey were increased.
- So, the foreign applicants accessed Turkish market easily.
- Competition in the market increased.

Top 10 countries that designates Turkey (2011)

Ranking	Country of holder
1	Germany
2	EU
3	Switzerland
4	US
5	France
6	Italy
7	China
8	Benelux
9	UK
10	Russian Federation

Increase in number of applications and designations originating from Turkey

- Turkish applicants designated, especially, the countries that import Turkish products.
- So, they
 - Met less procedures
 - Protected their marks in the countries that import their goods easily
 - Saved money
- This proves that Madrid system is a tool for strenghtening the import regime for Turkey

Turkey's top 10 designations (2011)

Ranking	Designated contracting party
1	Russian Federation
2	Azerbaijan
3	Iran
4	Ukraine
5	Germany
6	Egypt
7	Romania
8	China
9	Syrian Arap Republic
10	France

Harmonization of Trademark Practice of TPI with EU and Other Foreign Offices

- TPI examiners could follow the decisions of other contracting parties' examiners
- Turkish classification system also affected from the Madrid System both in terms of goods and services and figurative elements of the mark
- New declarations for time limit of provisional refusals and fee policy of the TPI

A considerable increase in the amount of work within the TPI

- 7-10 staff (trademark examiner+supporting staff) reserved for the Madrid Protocol procedures
- Madrid Protocol applications examined with priority to comply with time concerns
- However, no extra workload or staff for IT department.

Increase in the Revenues of TPI

- After accession to Madrid Protocol, revenues of TPI increased year by year regularly due to increasing number of international applications
- After declaration of individual fee in October 2005, a huge amount of revenue increase has been observed, almost 6 times increase

Increase in the Income from WIPO

Years	Income from EPO/ WIPO
2005	708.822
2006	5.967.556
2007	3.344.990
2008	7.071.388
2009	7.722.900
2010	7.308.735

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Effects of Madrid Protocol for Trademark Attorneys

- An increase in overall work load and revenue of the agents
 - No significant change in the number of individual trademark filings of foreigners via trademark attorneys
 - The number of objections against provisional refusals of international designations and oppositions increased

Effects of Madrid Protocol for Trademark Attorneys

- Networking with the foreign counterparts
 - They saved time thanks to Madrid Protocol
 - They had an opportunity to search and contact with overseas IP associates and saved extra professional fees

Summary

- Accession to Madrid Protocol has increased the number of applications/ workload of trademark department/ revenues of TPI/revenues of trademark attorneys.
- Effective, cheaper and simple Madrid system has simplified the application of international registrations, especially, for SMEs in Turkey.
- Turkish import and export regime has been supported by Madrid System.

Thank You !

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