

A WARNING GUIDE PROTECTING PATENTS OR UTILITY MODELS THROUGH PCT IN TURKIYE

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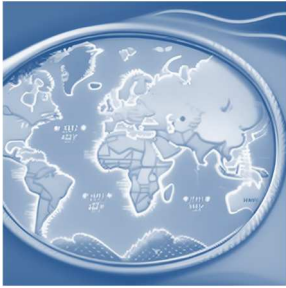
Innovation is vital, but protection is crucial. Without the "inventive step," "novel products" won't be safeguarded under the existing "patent" system. Don't let your invention go to waste or be freely copied by others. During the international phase of a patent application under PCT, decide and act swiftly to obtain timely protection through a "utility model" application if your clients are interested in Turkiye. This is, in fact, your last line of defense to shield your inventions with the same legal effect as, and sometimes more advantageous than, patent protection.



In the sophisticated patent ocean, a PCT applicant embarked on a journey to protect "his innovative embodiment of a four-cycle internal combustion engine". Pursuing a European patent application, he faced challenges due to the inventive step requirement. As uncertainty rose, the inventor sought alternative ways to safeguard his invention. Consulting an experienced patent attorney, the inventor regretfully discovered the missed opportunity to protect his invention in Turkiye by nationalizing and converting it into a utility model, granting 10 years of protection with the same legal effect as patent rights.

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KORDINAT: The Navigator

KORDINAT, based in Istanbul, is a boutique patent firm specializing in comprehensive intellectual property services for innovators, entrepreneurs, businesses, and foreign associates. Providing a diverse range of industries and technical fields, the firm's team of qualified Turkish IP attorneys boasts extensive experience with TURKPATENT, strong technical and legal backgrounds, and a commitment to Turkiye's innovative businesses, universities, and thriving entrepreneurial ecosystem.

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With over two decades of experience in intellectual property law and practice, Ersin has developed a wide range of expertise encompassing patent-driven R&D, branding, technological innovation, IP valuations, and commercialization. Ersin has presented at over a hundred seminars and authored articles in various domestic and foreign publications about the Turkish IP system.

Throughout his career, Ersin has provided counsel to universities, domestic and foreign clients, and famous global companies on patent, design, and trademark matters. His exceptional skill set has earned him the privilege of consulting as an expert on state IP projects and before the Istanbul Specialized IP Courts.

Ersin's diverse background in chemical engineering, coupled with his experience as a research scientist, has enabled him to offer valuable insights into polymer chemistry, organic chemistry, inorganic chemistry, food chemistry, and pharmaceuticals.

As one of the few certified trainers in Turkiye for the course "LES 100: Commercializing Technology through the Power of IP Licensing," Ersin has helped train professionals in the IP field.

He is also an active member of Licensing Executives Society International (LES) and European Patent Institute (EPI). Ersin played a pivotal role in establishing LES-Turkiye, serving as its founding president and later as a board member.

He was also instrumental in founding AIPPI Turkiye and remained a member of other international IP organizations until 2017, including JIPA, CIOPORA, and MARQUES.

INTRODUCTION: Setting Sail on a Patent Journey



As patent attorneys, we often embark on voyages across the vast seas of patent law, navigating uncharted waters in pursuit of safe harbors for our clients' valuable innovations.

In the vast ocean of global patent protection, **Turkiye** may appear as a distant, uncharted territory, not a popular destination for direct PCT entries or conventional patent filings, **with the European Patent validation route typically being preferred** instead.

Yet, beyond its enigmatic facade, **Turkiye** harbors **hidden treasures and strategic opportunities** for PCT nationalization.

This guide serves as your trusty compass, charting a course through the metaphorical Bosphorus of **Turkiye's** patent protection landscape. We'll blend captivating narrative with essential insights, exploring advantages and disadvantages, all tailored for IP business and foreign patent attorneys, maintaining a balance between professionalism and entertainment.

There are two main options for securing patent protection in **Turkiye** through international routes:

(1) nationalizing PCT applications directly in the country, or

(2) nationalizing before the EPO and subsequently validating in **Turkiye** upon receiving a grant decision.

Our journey highlights the importance of **considering the Turkish utility model option** before the expiry of the international phase of a PCT application, **especially when the inventive step criterion is not likely met**. This focus ensures patent professionals don't overlook the valuable opportunity of utility model protection when **Turkiye** is on their clients' radar.

Remember, even if a novel and non-chemical product (not process) falls short of the inventive step requirement for patent protection, it may still be eligible for **utility model protection** in **Turkiye**, **granting a 10-year exclusive right** and preventing unauthorized use **with the same legal effect as patent rights**.

Armed with this knowledge, we hope patent attorneys and IP business can confidently navigate the complexities of **Turkiye's** patent landscape, ensuring their clients' innovations receive the protection they deserve.

The information in this document is intended to be general information about the topic only and not to be relied on as legal professional advice. Readers are encouraged to reach out to us at ip@kordinatip.com for any further information, clarification, or consultation they may need based on the content provided therein.

I. Direct Entry into TR National Phase (PCT): The Golden Horn of Patent Protection



PCT nationalization is the well-known process by which an international patent application filed under the PCT (Patent Cooperation Treaty) enters the national phase in one or more PCT contracting states, including Turkiye.

During the international phase, a single PCT application is filed, which is then subject to an international search and possibly a preliminary examination. After the international phase, which typically lasts up to 30 months from the priority date, the applicant must decide in which PCT contracting states they want to pursue patent protection.

At this point, the PCT application is "nationalized" or enters the national phase in each selected contracting state. The national or regional patent offices then examine the application according to their respective patent laws and grant or refuse the patent. PCT nationalization is a crucial step for obtaining patent protection in multiple countries while streamlining the initial filing process.

Overview: Charting the Course

The first leg of our voyage leads us to the majestic Golden Horn of direct nationalization as the calm waters of Istanbul's iconic inlet. By steering your client's PCT application toward this route, you bypass the turbulent waters of prosecution and examination when the PCT written opinion or IPER cites positive patentability criteria. Like a natural, sheltered harbor, this strategy offers a straightforward path to patent protection.

Advantages: Smooth Sailing

- ✦ **Perfect for strong patentability criteria:** This route is ideal for PCT applications with robust patentability criteria, providing a streamlined and efficient path to patent rights.
- ✦ **Grant of patent rights:** Direct nationalization paves the way for unobstructed patent protection for those having favorable PCT written opinion or IPER, ensuring your clients' innovations remain safe and secure.
- ✦ **Expedited process:** By avoiding the stormy seas of prosecution and examination, you can reach your destination faster, saving your clients valuable time and resources.
- ✦ **Alternative route availability:** If your invention fails the inventive step criterion, you may convert your patent application into a utility model application.

Disadvantages: Choppy Waters

- ✦ **Limited Scope:** This route may not be ideal for PCT applications of chemicals or any processes without positive patentability criteria, and sailing first to the EPO route may be preferred instead.

I. Direct Entry into TR National Phase (Continued)



Procedure: Navigating the Golden Horn

To successfully navigate the Golden Horn of direct nationalization, adhere to the followings:

- ✧ **Understand the PCT written opinion and IPER:** The calm bay of direct nationalization is preferably accessible when the PCT written opinion or IPER provides a favorable assessment of the patentability criteria (novelty, inventive step, and industrial applicability). Alternatively, it paves the way for a utility model protection for certain inventions lacking inventive step, i.e. non-chemical products as explained in the next section. It is essential to carefully analyze these documents to determine whether this route is suitable for your client's innovation.
- ✧ **Hire the captain:** Contact a patent attorney registered before the TURKPATENT to respond your inquiries, and handle your filing requirements and translations. Power of attorney is not required.
- ✧ **Set sail and watch for deadlines:** Enter directly into the Turkish national phase (i.e. file the patent application) within 30 months from the earliest priority date. 3 months delay is excused by paying a fine.
- ✧ **Pay the toll:** Remit the relevant fees and submit the necessary documents. The filing cost typically includes filing fee, attorney's charge, translation charge, and payment of 3rd annuity.
- ✧ **Reach safe harbor:** Complete the national phase entry upon submission of required information.
- ✧ **Filing requirements:** As with any harbor, it's crucial to be aware of the local regulations and requirements, which include:
 - Full specifications of the PCT application to be nationalized in Turkiye
 - First page of the international publication
 - Name, address and nationality of applicant/s and inventor/s
 - Priority info (neither priority document nor its translation is to be required)
 - International Preliminary examination report (IPER) (Chapter II)
- ✧ **Process:** Typically, patents are granted within 2-3 years, contingent upon the availability of PCT/IPER and the favorability of the patentability assessment. A positive IPER results in direct granting in Turkiye. If negative considerations are cited in the IPER regarding patentability, the prosecution stage proceeds with the submission of responses and arguments. Should the national phase entry be made under Chapter I, an initial examination request must be filed at the TURKPATENT.

II. PCT Nationalization-Utility Model Conversion

The Galata Tower of Alternative Protection



A. Overview: A Towering Alternative

As we sail deeper into the Bosphorus of Turkiye's patent landscape, the impressive Galata Tower of utility model conversion looms on the horizon. This towering alternative stands tall when the invention claims meet the novelty and industrial applicability criteria but struggle against the tidal waves of the inventive step.

B. Advantages: A Sturdy Fortress

- ✦ **Optimal for strong novelty but uncertain inventive step:** If your client's innovation faces an onslaught of inventive step challenges, the Galata Tower of utility model conversion offers a secure alternative for protection.
- ✦ **Faster grant of protection:** Like the formidable Galata Tower, utility model conversion provides a swift and secure refuge for your clients' innovations.
- ✦ **Consolidated novelty search opinions:** TURKPATENT's novelty search, which is generally consistent with the PCT search

report, provides reinforced novelty validation from both the PCT authority and TURKPATENT.

- ✦ **Strong legal protection:** This alternative approach grants a 10-year protection (with the same legal effect as the patent rights) reinforced by dual-layered novelty search opinions, for a stronger defense against invalidation attacks.

C. Disadvantages: Limited Scope

- ✦ **Certain limitations:** Utility model protection does not cover methods, processes, chemical and pharmaceutical products, and biotechnological inventions.
- ✦ **Additional Novelty Search:** Awaiting TURKPATENT's search report is necessary for the final decision on the utility model grant.

D. Procedure: Scaling the Tower

Once you have entered the national phase, you are free to convert your patent application into a utility model application any time before the final decision, i.e., at a time when your invention is about to fail the inventive step criterion while meeting all other patentability requirements. Unlike patents, only novelty and industrial applicability criteria apply to utility models.

The application process involves a formal examination, novelty search request, search report preparation, publication, objections to the search report (if any), and the final decision if the utility model is granted or the application is rejected. The process takes about one year.

No substantive examination or accelerated procedure is available. No double protection is allowed.

III. European Patent Convention Route: The Grand Bridge of Europe



A. Overview: Connecting Continents

Our journey now takes us to the grand bridge of the European Patent Convention (EPC) route. Like a magnificent bridge that connects two continents, this strategy offers a comprehensive approach to patent protection. By seeking patent protection through the EPC, and once granted, validating the patent in Turkiye, you create a seamless passage between Europe and Turkiye, extending the reach of your clients' intellectual property fortifications.

B. Advantages: Spanning the Divide

- ✦ **Access to strong patent protection:** The EPC route allows your clients to extend their patent defenses across the European continent, creating a fortified bridge with Turkiye against infringement.
- ✦ **Single application process:** By consolidating multiple EP countries under one application, this strategy streamlines the process and simplifies the journey for your clients.

C. Disadvantages: Turbulent Seas

- ✦ **No further alternative route:** If the EP application is refused due to the absence of inventive step criterion, it is no way to navigate to Turkiye via utility model route. The sail goes to the bottom of the sea.

D. Procedure: Building the Bridge

To construct the grand bridge of the EPC route, follow these steps::

- ✦ **File patent application:** Submit the application with the European Patent Office (EPO).
- ✦ **Pay the toll:** Remit the relevant fees and submit the necessary documents.
- ✦ **Guard the gates:** Upon grant, validate the patent in Turkiye by translating the specification and paying the relevant fees.
- ✦ **Understanding the EPC process:** The grand bridge of the EPC route requires a solid understanding of the European patent application process, including the search, examination, and grant stages. Familiarize yourself with the EPO's procedures and requirements to ensure a successful crossing.
- ✦ **Validation in Turkiye:** Once the European patent is granted, it must be validated in Turkiye by submitting a translation of the specification and paying the necessary fees and submitting the necessary documents.

Keep in mind that Turkiye has its own validation deadlines and requirements, which must be adhered to for a successful entry into the Turkish patent landscape, details of which all explained in the next section.

III. European Patent Convention Route (Continued)



Once the European Patent Office (EPO) has issued a communication under Rule 71(3), the validation process must be started by considering and meeting the following basics and requirements:

- ✦ **Coverage:** Turkiye is not an EU member state but only bound to EPC. Therefore, Unitary Patent system is not applicable and a separate application for the validation must be filed at the TURKPATENT.
- ✦ **Translation requirement:** Turkiye is not a signatory to the London Agreement on translations. Therefore, the complete patent specification (i.e. description, claims and figures) of a European patent is required to be translated into Turkish and filed at the TURKPATENT in order to have an effect.
- ✦ **Delaying Translation:** It is possible to delay the translation up to two months and to file it by paying a fine provided that the request for validation is filed in due time.
- ✦ **Due date:** The “non-extendible” term for validating a granted European Patent in Turkiye is three months from the date on which the mention of grant is published in the EP Bulletin.
- ✦ **Representation by a Turkish Patent Attorney:** This is mandatory for applicants without residence or principal place of business in Turkiye. Power of attorney is not required.
- ✦ **Provisional protection:** A provisional protection can be obtained for a pending European patent application by filing claims only in Turkish.
- ✦ **Costs:** Filing fees, attorney charges, and translation costs should be considered, as well as the patent annuities which are due on the filing date must be paid.
- ✦ **Schedule of all fees** for patents and utility models as well as for other types of IP filings is regularly published and updated by the TURKPATENT, and available in English and Turkish at: <http://www.turkpatent.gov.tr/>
- ✦ **Procedure:** Once the validation of a granted European patent in Turkiye is requested in time, such a request is to be examined within 1 month simply on the availability of formal requirements and checked if the European patent is filed in Turkish as it is, i.e. in respect of translation and entitlement thereof. The European patent will have effect after the publication of the Turkish text in the patent bulletin within 1-2 months. A European patent certificate is electronically issued well after the publication.

IV. Combining Utility Model and EPC Route: The Dual Bridges of the Bosphorus



A. Overview: Spanning Two Worlds

Our voyage culminates at the dual bridges of the Bosphorus, where the utility model and EPC routes intertwine. By pursuing both strategies simultaneously, you span a harmonious connection between two forms of protection with similar legal effects, offering your clients unparalleled flexibility and adaptability.

The Turkish utility model system provides a valuable means for businesses to protect their innovations, particularly in cases where patent protection may not be suitable or reachable.

Utility model right holders enjoy similar rights to patent owners, providing businesses with a powerful tool to safeguard their intellectual property rights and maintain a competitive edge in the market.

In contrast to popular belief, utility models may offer greater benefits than patents, against invalidation attacks. Once novelty is established and TURKPATENT confirms it through a prior art

search report, there will be no contentious debates regarding the challenging inventive step criterion that need to be addressed by a panel of experts appointed in court proceedings.

B. Advantages: Double the Defense

- ✦ **Flexibility:** The dual bridges allow your clients to choose between the swift refuge of the utility model or the extensive fortification of the EPC patent protection.
- ✦ **Potential for extended protection:** If the EP application is granted, the utility model application can be withdrawn and your clients can secure a 20-year patent protection.

C. Disadvantages: Extra Load

- ✦ **Double Applications:** Additional costs of double filings except the later translations.
- ✦ **No double protection:** You should withdraw the utility model if the EP application is granted and then validated in Turkiye.

D. Procedure: Crossing the Bridges

To traverse the dual bridges of the Bosphorus, follow these steps:

- ✦ **File both applications:** Embark on both the Turkish utility model and EPC patent applications at the relevant patent offices.
- ✦ **Monitor progress:** Keep a watchful eye on both applications as they navigate the currents of the patent process.
- ✦ **Choose the path:** If the EP application is granted, withdraw the utility model application/grant and validate the EP patent in Turkiye.

Conclusion: Safe Harbor



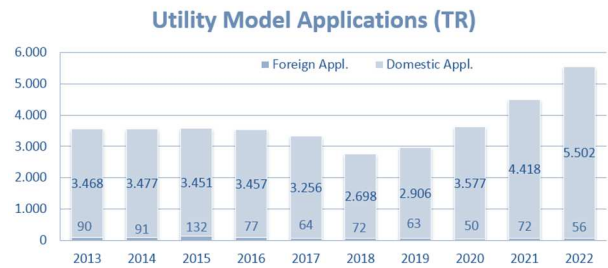
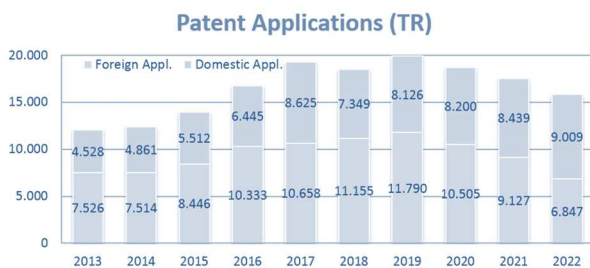
As our odyssey through Turkiye's PCT nationalization strategies draws to a close, we can reflect on the wealth of opportunities that lie hidden within this enigmatic landscape.

By guiding your clients through the Bosphorus of patent or utility model protection, you empower them to choose the best route for their innovations, ensuring their intellectual property remains secure and unscathed.

Armed with the knowledge gleaned from this journey, you are now prepared to set sail on new adventures, navigating the turbulent seas of global patent protection with confidence and grace.

Filing Statistics

Despite an overall increase of 31.1% between 2013-2022, total patent filings peaked in 2017 with 19,283 applications and decreased to 15,856 in 2022.. On the other hand, utility model filings have been increasing steadily with an annual growth rate of about 19.0% for the past five years, sourced by domestic filings made up 99% of the total utility model applications.



Patent and utility model filing statistics offer valuable insights into the innovation landscape and the interests of domestic and foreign entities in protecting their inventions in Turkiye.

Over the last five years, the average annual domestic patent filings have shown an upward trend, increasing from 7,114 in 2018 to 8,697 in 2022, reflecting the growth and strength of the local innovation ecosystem.

However, the foreign share of total patent filings has seen a decrease from 56% in 2020 to 43% in 2022, suggesting that domestic inventors and entities are becoming more prominent in the innovation landscape. The decline in foreign patent filings is particularly evident in the EPC validations category and may be attributed to the introductory phase of the new unitary patent system, changes in international patent strategies, or economic factors.