

Global Patent Litigation 2021

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Turkey

Morođlu Arseven

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Turkey



By Işık Özdoğan and Merve Altınay Öztekin, Moroğlu Arseven

Q: How can patent owners best enforce their rights in your jurisdiction?

The most effective way for a patent owner to enforce its rights is to initiate an infringement action against the alleged infringers before the specialised intellectual and industrial property rights civil courts.

Such infringement actions are generally started with a preliminary injunction claim and the discovery and determination of evidence to reach the final result that the plaintiff hopes to achieve or to collect evidence for complex patent cases. The parties may initially choose to contact the counterparty through a warning letter before taking legal action.

Q: Are mediation and arbitration realistic alternatives to litigation?

Disputes regarding the invalidation of a patent cannot be subject to arbitration since the results of alternative dispute resolution (ADR) are only binding for the parties. An invalidity dispute relates to the official registry and public policy.

On the other hand, negative declaratory and infringement actions may be subject to ADR.

Moreover, under Turkish Law, mediation has become a prerequisite for filing lawsuits concerning commercial disputes with monetary claims, including IP-related disputes. If a lawsuit is filed without applying for mediation first, the case will be dismissed with respect to compensation claims *ex officio* on procedural grounds without any further examination of the merits and the examination will continue with respect to other claims such as elimination of the infringement, or seizure of infringing activities (if any).

Q: Who hears patent cases – for example, individual judges, a panel of judges, a mix of judges and technical experts, judges and juries?

All patent cases are handled by the specialised IP courts, which exist only in Istanbul, Ankara and Izmir. In other cities, the Third Civil Court of General Practice is authorised. All first-instance courts, including the IP courts, consist of one judge.

Q: What level of expertise can litigants expect from courts?



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Işık Özdoğan leads Moroğlu Arseven's IP team. She is a prominent figure and thought leader in the global IP sector. Her expertise spans every aspect of IP advice, including counselling, enforcement, transactional and litigation matters. Ms Özdoğan advises and represents local, foreign and multinational clients about trademarks, industrial designs, patents, copyrights, domain names and seizures of counterfeit goods, among other things. Her work ethic, close communication and experience with innovative cases distinguish Ms Özdoğan from other IP professionals in Turkey. Her expertise encompasses a full spectrum of industries and she manages portfolios for several major multinational companies in Turkey.



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Merve Altınay Öztekin supports clients with complex IP disputes and litigation, and offers day-to-day advice about managing intellectual assets. She regularly assists clients to understand and navigate local regulatory rules, such as in the pharmaceutical sector, or for advertising and product liability. Ms Öztekin specialises in helping clients to protect, enforce and commercialise their trademarks, patents and designs. She has successfully represented many well-known brands and patents, on both sides of high-stakes and complex IP lawsuits.

While the judges in the specialised IP courts have a significant understanding of the Industrial Property Law, they do not have a technical background and commonly appoint experts *ex officio* to better understand the technical merits of a case.

Q: Are validity and infringement dealt with together in proceedings?

Turkey does not have a bifurcated system and invalidity and infringement procedures are separated. Invalidation actions can be filed either separately or as a counterclaim within the timeframe to respond to the infringement claim in an infringement proceeding. If the invalidation is filed as a counterclaim, both the infringement and the invalidation claim are handled by the same court regardless of the jurisdiction rules.

Even if the invalidation is filed separately, these actions are considered to be closely associated, then the outcome of invalidation is awaited in the infringement action or the cases may be combined.

Q: Who may represent parties engaged in a dispute?

Attorneys registered before the bar may represent parties before courts.

Q: To what extent is forum selection possible in your jurisdiction?

Forum selection by agreement between the parties is permitted according to Civil Procedural Law 6100 only for merchants and public entities. In the event of such an agreement, the action can only be filed before the court settled in the agreement.

Q: To what extent is pre-trial discovery permitted?

According to Article 400 of the Civil Procedural Law, any party is entitled to request the court to conduct a site visit or expert examination or to hear a witness on the condition that the requesting party has a legal benefit in filing such a request. The condition of the legal benefit is deemed to be met if the evidence is lost or very difficult to collect unless it is immediately secured.

The determination of evidence is a preliminary measure and is therefore conducted immediately. After the evidence is examined, an expert report is obtained. An important point is that, during the determination of evidence procedure, no evidence (eg, infringing products) is seized.

Q: To what extent is evidence written and oral at proceedings?

Patent litigation proceedings are handled in writing. The parties must submit their arguments and evidence in written petitions.

Experts submit their opinion in writing. If the judge deems it necessary, further questions may be addressed to the experts to shed light on the technical merits of the case or to clarify contradictions. Experts must attend the examination hearing if the judge orders them to do so and respond to the questions.

Q: What role, if any, can expert witnesses play?

The judges of the IP courts do not have a technical background and appoint experts to understand the technical merits of a case. As a result, the expert witnesses play a significant role in patent disputes. It is reasonable to say that these reports determine the judge's decision in most cases.

Q: Is the doctrine of equivalents applied by courts in your jurisdiction and, if so, what form does it take?

Yes, when determining the scope of protection, all elements equivalent to those defined in a claim are considered (Article 89 of the IP Law). Where an element performs the same function and provides the same result as the element set out in a claim, that element is accepted as equivalent.

Q: Are there problems in enforcing certain types of patent relating to, for example, biotechnology, business methods or software?

Under Article 82 of the IP Law, computer programs and business methods are not considered inventions, unless they also have technical aspects (providing that they meet all patentability requirements).

In the past, there have been questions in Turkish practice regarding the registrability of second medical use patents. Indeed, a European patent granted prior to the European Patent Convention (EPC) 2000 was found null and void by a first-instance court, which stated that the EPC 1973 did not provide the legal grounds for registering this type of patent and that the EPO Board of Appeal decisions were not binding on Turkish courts. The decision was appealed, and the Court of Appeal reversed the first-instance court's decision. It noted that the general patentability criteria should be applied considering the lack of any provisions in Turkish law allowing or prohibiting second medical use claims. Even though the first-instance court insisted on its previous decision, on further appeal of the patent owner, the court insisted on its first decision. Any questions on the enforceability of second medical use patents are, therefore, resolved.

Q: To what extent are courts obliged to consider previous cases that have covered issues similar to those pertaining to a dispute?

The decisions rendered by other courts are not binding. However, the decisions of the Court of Appeal set precedents to a certain extent. Only the decisions of the General Assembly on the Unification of Judgments are binding.

Q: To what extent are courts willing to consider the way in which the same or similar cases have been dealt with in other jurisdictions? Are decisions from some jurisdictions more persuasive than those from others?

Turkish courts and judges are not bound by decisions of foreign courts. Nevertheless, since Turkey is a party to the EPC, the decisions of the EPO may influence the Turkish courts to some extent, especially if the disputed patent is a European patent validation. Having said that, it is at the discretion of the IP court to suspend the infringement action in cases where there is a post-grant opposition proceeding before the EPO.

Q: What realistic options are available to defendants seeking to delay a case? How might a plaintiff counter these?

The most common defence that delays the outcome of an infringement action, is requesting the invalidation of the plaintiff's patent, as the infringement action cannot be concluded unless the invalidity claim is settled.

Moreover, courts can be asked to await EPO proceedings, although the courts have discretion to decide. In addition, procedural tools (eg, time extensions and objecting to the petitions) can be used to delay the proceedings.

Q: Under what circumstances, if any, will a court consider granting a preliminary injunction? How often does this happen?

To obtain an injunction, the requesting party must prove that if the injunction is not granted:

- irreparable harm will arise; or
- the outcome the requesting party seeks in its main action will be unlikely.

The IP courts are conservative in rendering preliminary injunction decisions. A common approach for a court during patent conflicts is to use an expert witness to evaluate the technical merits of the conflict. It is at the judge's discretion to decide on a preliminary injunction directly after the expert report and after receiving the parties' comments on the report, by holding a hearing or not, with or without a guarantee. The guarantee varies according to the value of the patent, the parties' economic situation and the nature of the preliminary injunction.

Q: What is the realistic timescale to get a decision at first instance from the initiation of proceedings?

In general, the proceedings take around 18 to 24 months. The length of proceedings will depend on several issues, such as how many times the file was referred to expert examination. Each examination takes around five to six months, and if there is a request for compensation, the file is also referred to an accounting expert for calculation. In addition, if the defendant resides abroad, the international notification procedures take around six months.

Q: How much should a litigant budget for in order to take a case through to a decision at first instance?

Professional attorneys' fees may vary depending on the complexity of a case. In general, the plaintiff bears the litigation costs until the end, and the losing party bears the official litigation fees and official attorneys' fees of the counterparty.

At first instance, the official fees and expenses – excluding the expert fee for patent actions without claiming damages – are around TL4,000. If the case is referred to an expert body, the expert fee can be around TL1,500 to TL2,000 per expert. Considering that cases generally are examined by an expert body consisting of three experts, the expert fee can be around TL4,500 to TL6,000. The minimum attorneys' fee determined in line with the annual tariff declared by the Turkish Bar Union is TL4,910 in cases of invalidation actions and infringement actions without claims for damages. If there is a compensation claim, the official attorneys' fees are calculated in percentages depending on the amount requested.

Q: To what extent are the winning party's costs recoverable from the losing party?

According to the Civil Procedural Law, the losing party bears the judicial costs and the official attorneys' fee. To recover other costs, the requesting party must file another lawsuit with a compensation claim.

Q: What remedies are available to a successful plaintiff?

Typical remedies granted to successful plaintiffs include:

- compensation for damages (moral, material and reputational);
- the destruction of infringing products;
- the confiscation of manufacturing tools;
- the publication of the judgment;
- invalidation of patent (in invalidation actions); and
- ruling that the plaintiff's activities do not constitute infringement (in negative declaratory actions).

Q: How are damages awards calculated?

As per the IP Law, 'damages' awards are available for actual damage and lost profits. 'Actual damage'

is the net decrease in the requesting party's assets. The requesting party may also ask for lost profits, which are calculated based on one of the following methods set out in IP Law:

- the income the patent owner would have generated if the infringing party's competition had not existed;
- the infringer's income; or
- the amount that the infringer would have paid as an appropriate licence fee had the parties entered into a licensing relationship.

Q: Under what circumstances will courts grant permanent injunctions?

A permanent injunction can be granted only at the end of a judgment. Such injunctions can be enforced only when the decision is finalised.

Q: Does the losing party at first instance have an automatic right of appeal?

Yes. The losing party may appeal the final decision rendered by the first-instance court.

Q: How long does it typically take for the appellate decision to be handed down?

Appeals before the Regional High Courts usually take around 12 to 16 months and 18 months to two years before the Court of Appeal.

Q: Is it possible to take cases beyond the second instance?

Yes. The first-instance courts can appeal before the Regional High Court within two weeks and a further appeal may be filed before the Court of Appeal within two weeks of the receipt of the Regional High Court's decision. The Court of Appeal is the third and final judicial authority.

Q: To what extent do the courts in your jurisdiction have a reputation for being pro-patentee?

The courts do not have a reputation for being either pro-patentee or anti-patentee. While decisions depend on the evidence presented in each particular case, sometimes first-instance courts are more favourably disposed towards domestic enterprises in disputes with overseas-based companies.

“If the Re-examination and Evaluation Board finds that the patent conforms with the IP Law, it will refuse the opposition”

Q: Are there other fora outside the court system in which it is possible to assert patents in your jurisdiction? If so, under what circumstances might it be appropriate to use them?

The IP Law introduced a post-grant opposition system, whereby third parties can oppose a patent within six months of publishing the decision stating that the patent is granted.

The grounds for such a patent opposition are:

- the patent does not meet the patentability criteria;
- the invention is not disclosed in a sufficient manner; and
- the patent exceeds the scope of the initial application.

The patent owner can file a response or amendments to the patent within three months of the date of TURKPATENT's notification about an opposition.

If the Re-examination and Evaluation Board finds that the patent conforms with the IP Law, it will refuse the opposition. If the board concludes that the patent partially conforms to the law, it will confirm the partial validity. It will inform the patent owner accordingly, requesting the amendment of the patent in line with partial approval. If no amendments are filed (or the amendments are not approved), the patent will be invalidated.

Q: Are there any other issues relating to the enforcement system in your country that you would like to raise?

The approach to preliminary injunctions needs to be revised and they should be granted more commonly since it takes a long time for a decision to be finalised and become enforceable. Without change, the benefit to be obtained from a patent

is significantly reduced given the lack of tools to extend the term of protection.

Another issue is the lack of clear provisions preventing judges from granting invalidation decisions for European patent validations as the EPO opposition process continues. This leads to a double standard for national patents, as the IP Law explicitly prohibits finalising the infringement claims until the post-grant opposition proceedings before TÜRKPATENT is finalised.

Finally, the covid-19 pandemic continues to spread, causing critical supply shortages of medical devices and medicines. The IP Law sets certain conditions for granting compulsory licences, the interests of public policy being one of these. Today, as covid-19 is an example of

‘extreme urgency’, it would be no surprise that this mechanism may be triggered in Turkey should it be needed. **iam**

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