

Patents 2021

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Published by

Law Business Research Ltd

Meridian House, 34-35 Farringdon Street

London, EC4A 4HL, UK

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First published 2004

Eighteenth edition

ISBN 978-1-83862-693-8

Printed and distributed by

Encompass Print Solutions

Tel: 0844 2480 112



Patents

2021

Contributing editors**Louis E Fogel and Shaun M Van Horn****Jenner & Block LLP**

Lexology Getting The Deal Through is delighted to publish the eighteenth edition of *Patents*, which is available in print and online at www.lexology.com/gtdt.

Lexology Getting The Deal Through provides international expert analysis in key areas of law, practice and regulation for corporate counsel, cross-border legal practitioners, and company directors and officers.

Throughout this edition, and following the unique Lexology Getting The Deal Through format, the same key questions are answered by leading practitioners in each of the jurisdictions featured. Our coverage this year includes new chapters on Israel, Singapore, Turkey and the United Kingdom.

Lexology Getting The Deal Through titles are published annually in print. Please ensure you are referring to the latest edition or to the online version at www.lexology.com/gtdt.

Every effort has been made to cover all matters of concern to readers. However, specific legal advice should always be sought from experienced local advisers.

Lexology Getting The Deal Through gratefully acknowledges the efforts of all the contributors to this volume, who were chosen for their recognised expertise. We also extend special thanks to the contributing editors, Louis E Fogel and Shaun M Van Horn of Jenner & Block LLP, for their continued assistance with this volume.



London

April 2021

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This article was first published in May 2021

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PATENT ENFORCEMENT PROCEEDINGS

Lawsuits and courts

- 1 | What legal or administrative proceedings are available for enforcing patent rights against an infringer? Are there specialised courts in which a patent infringement lawsuit can or must be brought?

Patent rights are enforced by an infringement action against the alleged infringers before the competent court. These rights can be enforced before the specialist IP courts. The specialist IP courts can handle IP-related lawsuits. However, IP courts exist only in larger cities (Istanbul, Ankara and Izmir). If there is no IP court in a city, the Third Chamber of the Civil Courts of First Instance (or the First Chamber where fewer than three chambers exist) can handle such lawsuits.

Infringement actions are generally started with a preliminary injunction claim and the discovery and determination of evidence, tools that are set out in the Civil Procedural Law.

To seek preliminary injunctions, the proceedings generally start by using these tools, which are effective during infringement actions, to:

- reserve the final result that the plaintiff hopes to achieve; or
- collect evidence for complex patent cases.

These tools can be used either before or during trial.

Within the scope of an infringement action, right owners can claim damages or request:

- destruction of infringing products;
- confiscation of manufacturing tools; or
- publication of the judgment.

Trial format and timing

- 2 | What is the format of a patent infringement trial?

The procedure and format of the patent infringement trial are set in accordance with Civil Procedural Law No. 6100 (the CPL).

Civil proceedings are initiated by the plaintiff submitting a complaint brief to the court. If there is a preliminary injunction (PI) request, the court evaluates this request as a first step and generally schedules a hearing. After the evaluation, the court decides to schedule a hearing date to decide in the presence of both parties. The court may also decide to convene an expert panel to examine the details of the conflict further before granting a PI. This is to say, the court does not examine the PI request as a first step and leaves it to the investigation phase. Upon the completion of the preparation and PI examination, the exchange of petitions starts. The defendant responds to the complaint brief of the plaintiff and the plaintiff files its counter arguments. The defendant's submission to the counter-statement concludes the 'exchange of petitions' phase.

At the end of the exchange of petition phase, the preliminary examination phase starts. During the preliminary examination, the

court examines the conditions of the conflict between the parties. This examination is considered as a preparation for the analysis of the merits of the case.

After the preliminary examination phase, the investigation phase starts. The court evaluates evidence that is submitted by the parties and investigates the accuracy of the facts alleged by the parties.

For the purpose of examining the accuracy of the submitted documents, the court confers with an expert witness.

After the expert witness report is delivered to the parties, the parties are entitled to file comments or objections against the report. Prior to the court's decision, the court evaluates the report and the parties' comments. If the court deems the report is sufficient, it does not ask for an explanation and concludes the investigation phase. However, if the report is not sufficient, further explanation can be requested from the expert, or other experts can be appointed.

After the investigation phase concludes, the judgment phase starts. During this final phase, the judge renders a decision after the examination of the accuracy of the claims.

The parties are free to submit any evidence to the court, unless a certain proof is required by law. There is no such limitation for patent infringement lawsuits. Therefore, expert opinions, witnesses or any documentation can be relied upon. The Turkish legal system does not recognise affidavits as evidence, but these can be considered as discretionary evidence. Site visits, discovery visits and determination of evidence proceedings are effective and commonly used tools to collect and preserve evidence either before or during the trial.

While cross-examination is not available, the court can, in principle, allow the parties to address questions to the counterparty through the Court. Additionally, one judge is appointed for each IP court. Jury trials do not take place in the Turkish legal system.

Proof requirements

- 3 | What are the burdens of proof for establishing infringement, invalidity and unenforceability of a patent?

As per article 190 of the CPL, the burden of proof belongs to the party that derives a right in its favour from the legal result linked to the alleged fact. In patent infringement, invalidity and unenforceability actions, this party is the plaintiff. Therefore, the burden of proof is on the plaintiff. However, this does not affect the responsibility of the defendant to rebut the arguments of the plaintiff and defend its position through filing its own evidence supporting its claims.

According to article 141/2 of the Industrial Property Law No. 6769 (the IPL), if the subject of a patent is related to a process for obtaining a product or material, the court may ask the defendant (instead of the plaintiff) to prove that the process used for obtaining the same product or material was different from the patented process.

As per article 150/3 of the IPL, before instituting a legal proceeding for compensation related to infringement of an industrial property right,

to determine the evidence or if a legal proceeding for compensation has been instituted, the right owner may, to determine the amount of damages, ask the court to order the person responsible for compensation to submit to the court the documentation related to the use of the industrial property right.

Standing to sue

- 4 | Who may sue for patent infringement? Under what conditions can an accused infringer bring a lawsuit to obtain a judicial ruling or declaration on the accusation?

The owner of the patent rights can bring a lawsuit for infringement. An exclusive licensee is also entitled to file an infringement action, unless otherwise agreed in the licence agreement. A non-exclusive licensee can request the patent owner to file an action against a patent infringement, unless it is stated otherwise in the agreement. If the patent owner does not take the requested action within three months, the non-exclusive licensee can file the action him or herself.

As per article 154 of the IPL, anyone who has an interest may request the right owner to provide his or her opinion about whether or not commercial or industrial activities being carried out or to be carried out or serious and actual attempts carried out for these purposes in Turkey would cause an infringement of his or her industrial property right. If no opinion is provided within one month after notification of this demand or if the opinion given is not accepted by the interested party, the interested party may institute a legal proceeding against the right owner for a decision on non-infringement. The claimant has to prove its legal interest for filing an action for a non-infringement declaration. The submission of an opinion by the right holder is not a prerequisite for the legal proceeding to be instituted.

Inducement, and contributory and multiple party infringement

- 5 | To what extent can someone be liable for inducing or contributing to patent infringement? Can multiple parties be jointly liable for infringement if each practises only some of the elements of a patent claim, but together they practise all the elements?

Indirect use is not explicitly defined as an infringing act in the IP Law. Article 141 does not list indirect use as an act of infringement. However, article 86 gives the patent owner the right to prevent such indirect use. Accordingly, the patent owner can seek protection against parties inducing or contributing to patent infringement.

Article 86 sets forth that:

The patent owner is entitled to prevent third parties from giving the elements and instruments related with a part of invention which enables the implementation of the invention which is subject to the patent and constitutes the essence of the invention, to persons who are not authorized in the use of the invention which is subject to the patent. It is necessary for the referred third persons to know that these elements or instruments are sufficient to implement the invention and that they will be used for these purposes or this condition should be sufficiently clear for this provision to be applicable.

The patent owner can seek protection against multiple parties jointly – provided that the situation meets the conditions in article 86 and the requirements of the procedural law.

Joinder of multiple defendants

- 6 | Can multiple parties be joined as defendants in the same lawsuit? If so, what are the requirements? Must all of the defendants be accused of infringing all of the same patents?

In accordance with article 57 of the Procedural Law, if the facts and the legal basis of the lawsuits are identical, multiple parties can be joined as defendants. Since the facts and the legal basis of the lawsuit must be identical, the defendants must be accused of infringing the same patent.

Therefore, separate actions will constitute separate facts for the lawsuits.

Infringement by foreign activities

- 7 | To what extent can activities that take place outside the jurisdiction support a charge of patent infringement?

Activities that take place outside Turkey do not directly constitute patent infringement in Turkey. The principle of territoriality applies to patents too. Having said that, the patent right owner is entitled to prevent infringing products to be imported or exported. Third parties can have a significant role in the course of import and export activities depending on the extent of their involvement.

Infringement by equivalents

- 8 | To what extent can 'equivalents' of the claimed subject matter be shown to infringe?

The doctrine of equivalents is applied in Turkey. As per article 89/5 of the IPC, when determining the scope of protection, all elements equivalent to those defined in the claim are also considered. If an element performs the same function in the same way and provides the same result as the one specified in a claim, that element is accepted as equivalent.

Discovery of evidence

- 9 | What mechanisms are available for obtaining evidence from an opponent, from third parties or from outside the country for proving infringement, damages or invalidity?

Article 400 of the CPL describes the procedures for determination of evidence. In accordance with this article, either party is entitled to request the court to conduct a site visit, discovery visit, expert examination or 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 met if the evidence may be lost or is very difficult to set forth unless it is immediately secured.

The determination of evidence is requested through a petition before or during the action. The determination of evidence is a preliminary measure and therefore conducted immediately. The counterparty has the right to oppose the determination of evidence decision of the court within one week as of the notification date of the decision. If the counterparty does not oppose it, the determination of evidence is performed. Generally, the experts are given one month to prepare the report on the evidence after determination. The report should not include any conclusions as to the merits of the case, but should simply state the existing situation. During the determination of evidence procedure, no evidence including the infringing products are seized.

Under article 288 et seq of the CPL, the court may decide to conduct discovery, ex officio or upon the request of one of the parties. The court may hear witnesses or experts during the discovery.

Moreover, according to article 150/3 of the IP Law, the right owner, before initiating a patent infringement lawsuit claiming compensation, can ask the court to request the documents regarding the use of the

patent to be submitted by the accused infringer, for the determination of evidence or to calculate the damages.

Because the jurisdiction of the Turkish courts is limited to the borders of the Republic of Turkey, the courts cannot directly order evidence to be seized or brought from abroad. However, Turkey is also a signatory of the Hague Evidence Convention on obtaining evidence from abroad. Therefore, certain evidence can be collected through the help of this convention and reciprocity principles.

The parties may also bring foreign official documents if the documents are legalised by the foreign government issuing the document.

Litigation timetable

10 | What is the typical timetable for a patent infringement lawsuit in the trial and appellate courts?

First-instance court judgments take approximately 18 months to two years in straightforward patent infringement cases. In complex patent cases, this procedure can take longer.

The decisions of the first instance courts can be challenged before the regional courts. The parties submit another set of petitions for the appeal phase. The regional court may invite the parties for a hearing if it deems it necessary. The decisions of the regional courts can be challenged before the Court of Appeals.

The appeal procedure before the regional court takes around one to one-and-a-half years.

The appeal procedure before the Court of Appeals also takes another one to one-and-a-half years. Consequently, civil actions take around three-and-a-half to five years until they are finalised.

Litigation costs

11 | What is the typical range of costs of a patent infringement lawsuit before trial, during trial and for an appeal? Are contingency fees permitted?

Prior to initiating a lawsuit, the parties may choose to send cease and desist letters through public notaries. The official notary cost is approximately 600 Turkish lira.

In general, the plaintiff bears the litigation costs until the end, and if it is successful, the losing party then bears the official litigation fees and official attorney fees of the counterparty. In first instance, the official fees and expenses including the expert fee for patent actions without compensation damages are around €1,000 to €2,000. If there is more than one expert panel appointed in the file, the costs may increase. For appeals handled by the regional courts, the official fees and expenses are around €1,000. If an additional expert report has to be obtained before the regional courts, the costs may increase. For appeals handled by the Court of Appeal, the official fees and expenses are around €1,000. Professional attorneys' fees may vary depending on the complexity of a case.

Court appeals

12 | What avenues of appeal are available following an adverse decision in a patent infringement lawsuit? Is new evidence allowed at the appellate stage?

First instance court decisions can be challenged before the regional courts.

The regional courts conduct a full review of the lawsuit, including legal and factual review. However, the parties cannot submit new evidence and cannot put forward new facts at this stage unless it is provided that the court has not considered the evidence or determined that it is not relevant, or the evidence has not been submitted earlier on for force majeure reasons.

The decisions of the regional court can be challenged before the Court of Appeal. The examination before the Court of Appeal is limited to the legal review of the case. Therefore, the Court of Appeal examines whether the law has been applied correctly to the case and new evidence cannot be submitted.

Competition considerations

13 | To what extent can enforcement of a patent expose the patent owner to liability for a competition violation, unfair competition, or a business-related tort?

In principle, enforcement of a patent does not constitute a competition violation, since using a legal right cannot be considered as unlawful according to the Constitution. However, the patent owner can be liable in the case of an abuse of a right, which results in unfair competition and business-related tort.

If infringement actions are linked to abusive behaviours of market domination, then company competition violation issues will arise. Standard essential patent-based infringement actions may lead to competition violations.

Alternative dispute resolution

14 | To what extent are alternative dispute resolution techniques available to resolve patent disputes?

Arbitration, mediation and out-of-court settlements are possible alternative dispute resolution methods; however, they are not as effective as court proceedings. Moreover, mediation has become a prerequisite for filing lawsuits concerning commercial disputes with monetary claims. Therefore, before initiating a lawsuit including monetary claims, the parties must meet at mediation proceedings.

SCOPE AND OWNERSHIP OF PATENTS

Types of protectable inventions

15 | Can a patent be obtained to cover any type of invention, including software, business methods and medical procedures?

According to the Industrial Property Law (IPL), the following are not considered inventions:

- scientific discoveries and theories;
- mathematical methods;
- schemes, methods and rules for performing mental acts, playing games and doing business;
- computer programmes;
- literary, scientific and aesthetic works or creations; and
- presentations of information.

Further, under the IPL, the following inventions are considered non-patentable:

- inventions that are contrary to public order or morality;
- inventions concerning plant or animal varieties or essentially biological processes for the production of plants or animals, excluding the microbiological processes or the products thereof;
- diagnostic methods that are practised on humans or animals and all such treatment methods, including surgical methods;
- the human body at various stages of its formation and development and the discovery of one of its elements, including the sequence or partial sequence of a gene; and
- the use of human embryos for industrial or commercial purposes, including processes for:
 - cloning human beings;

- modifying the germline or genetic identity of human beings; and
- modifying the genetic identity of animals in ways that are likely to cause them suffering without any substantial medical benefit to humans or animals.

Article 82 of the IPL establishes that business methods or computer programs are not inventions. Therefore, inventions that only comprise software or business methods cannot be patented. However, inventions including business methods or computer programs together with the other patentable elements can be patented.

Patent ownership

16 Who owns the patent on an invention made by a company employee, an independent contractor, multiple inventors or a joint venture? How is patent ownership officially recorded and transferred?

As a rule, the owner of the invention is the person who invented the invention or his/her successors. If the invention is created by multiple persons or as a joint venture, the right to request a patent for the invention belongs to all inventors jointly. The inventor must always be a natural person. The right to request a patent for an invention may be transferred to third parties.

If the invention is made by a company employee, it should be determined first whether the invention is a 'service invention' or an 'independent invention'. An invention is a service invention if it is created as a result of the duty undertaken by the employee or based on the experience and work of the employee, at the business or public agency where the employee has an employment relationship. Inventions not meeting these criteria are considered to be independent inventions.

The employee is obliged to notify the employer regarding a service invention. The employer may claim a full or partial right to the invention. All rights arising from the invention are transferred to the employer when the employer notifies the inventor-employee of the full claim on the invention. In this case, the employer is obliged to file a patent application and becomes the patent holder.

If the employer claims partial right on the invention, the invention becomes an independent invention. In such a case, the employer may use the invention based on the partial rights. The employee is entitled to file a patent application if the invention has become an independent invention.

Independent contractors are not considered to be employees. Therefore, the right to request a patent for their invention belongs to the contractors, unless otherwise agreed between the parties. As mentioned, the right to request a patent is transferrable.

The official record of the patent ownership is conducted based on the information included in the application. The transfer of the ownership of a patent is conducted through an assignment agreement that must be in writing and notarised. If the document is notarised by foreign offices, it should also be legalised by an apostille. Assignment agreements that have not been notarised will be invalid. Recordal of the assignment at the registry is not compulsory, but rights arising from assignments that are not recorded in the registry cannot be claimed against third parties acting in goodwill. Therefore, it is highly recommended and good practice to have the assignments registered.

DEFENCES

Patent invalidity

17 How and on what grounds can the validity of a patent be challenged? Is there a special court or administrative tribunal in which to do this?

A patent can only be invalidated by competent IP courts (apart from the post-grant oppositions). Under article 138 of the Industrial Property Law (IPL), a patent is declared invalid by the court if the:

- patentability requirements are not met;
- invention has not been described in a sufficiently explicit and comprehensive way to enable a person skilled in the concerned technical field to implement it;
- patent exceeds the scope of the application or is based on a divisional application and exceeds its scope;
- holder of a patent does not have the right to a patent; and
- patent exceeds the scope of its protection.

Under the IPL, a court can partially invalidate a patent for one or more claims. However, a single claim cannot be partially invalidated.

Any party who has a legal interest, as well as Public Prosecutors and relevant establishments and institutions, are entitled to request the invalidation of a patent.

Further, post-grant opposition proceedings are set out in the IPL. Accordingly, opposition proceedings open as of the grant of a patent. Third parties may file an opposition within six months of the date of a patent being granted. An opposition can be based on the following grounds:

- the subject matter has no patentability criteria;
- the patent does not disclose sufficient details of the invention to enable a person skilled in the art to apply it in practice; or
- the patent's subject matter extends the scope of the first version of the filing.

Absolute novelty requirement

18 Is there an 'absolute novelty' requirement for patentability, and if so, are there any exceptions?

Yes, patents must have absolute novelty.

The exception to this requirement is set in article 84 of the IPL, which defines the types of disclosure made within 12 months before the application or priority date that do not affect novelty as follows:

- disclosure by the inventor;
- disclosures by an office authorised to receive patent applications if:
 - the disclosed information was in another application by the same inventor and the information was required to be disclosed;
 - a third party discloses information directly or indirectly obtained from an inventor without their approval or knowledge; or
- disclosures by a third party that directly or indirectly obtains information from the inventor.

Obviousness or inventiveness test

19 What is the legal standard for determining whether a patent is 'obvious' or 'inventive' in view of the prior art?

There is no statutory provision on how to apply the obviousness test in the IP Law. However, as per case law, the obviousness criteria are not met if a hypothetical person who is an expert or skilled person in the field could expect reasonable success in reaching the invention subject to the patent by starting from the closest reference available in the state of the art and without conducting very complex or lengthy examination.

It is also seen that in certain cases, the 'problem-solution' approach is also used as in European Patent Office practice. If a skilled person would (not could) reach the solution by examining one or multiple documents on prior art to solve the problem, then the solution is recognised as obvious.

Patent unenforceability

20 | Are there any grounds on which an otherwise valid patent can be deemed unenforceable owing to misconduct by the inventors or the patent owner, or for some other reason?

No, there are no grounds regulated regarding whether an otherwise valid patent can be deemed unenforceable under the IP Law.

Prior user defence

21 | Is it a defence if an accused infringer has been privately using the accused method or device prior to the filing date or publication date of the patent? If so, does the defence cover all types of inventions? Is the defence limited to commercial uses?

As per article 87 of the IPL, the continuing or start of the use, in line with the measures adopted, of the persons who have been using the invention or have adopted significant and substantial measures for the use, in good faith, within the country, at the date of or before the application, cannot be prevented by the patent applicant or owner.

However, the continuation of the use of the invention subject to the patent or the use in line with the adopted measures is limited to the reasonable requirements of the establishment owned by the prior user. A right originating from previous use cannot be licensed and may only be transferred together with the establishment.

Additionally, actions regarding the products offered for sale by the prior user are out of the scope of patent protection.

REMEDIES

Monetary remedies for infringement

22 | What monetary remedies are available against a patent infringer? When do damages start to accrue? Do damage awards tend to be nominal, provide fair compensation or be punitive in nature? How are royalties calculated?

In patent infringement cases, moral, material or reputational damage can be compensated.

As per article 151 of the Industrial Property Law (IPL), actual damage and lost profits are covered by 'damages'. 'Actual damage' is the net decrease in the plaintiff's assets. The plaintiff may also ask for lost profits, which are calculated based on one of the following methods set out in article 152 of the IPL:

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

Generally, plaintiffs are reluctant to request compensation, as the calculation of the compensation may be problematic, considering the unrecorded economy and not properly kept trade books. It is common that plaintiffs receive less compensation than they request. Thus, choosing the calculation method based on a licence is more common.

Punitive damages are not available under Turkish law. However, under article 150/2 of the IPL, where the IP right is infringed, additional compensation may be claimed if the reputation of the IP right suffers

damage because the products or services forming the subject of the right are used or produced in an inferior manner; or such products produced in this way are made available or launched to the market in an improper manner.

Injunctions against infringement

23 | To what extent is it possible to obtain a temporary injunction or a final injunction against future infringement? Is an injunction effective against the infringer's suppliers or customers?

As IP rights can be irreparably and irrecoverably damaged by third-party actions, injunctions play a significant role in litigation. Injunctions are effective tools in patent litigation to obtain the results that plaintiffs seek. The legal framework and criteria for injunctions in Turkey are outlined by the Procedural Law and the IP Law.

Injunctions can be obtained before or during a trial. To obtain an injunction, the requesting party must prove to the court's satisfaction that:

- irreparable harm will arise if the injunction is not granted; or
- the outcome that the requesting party seeks in its main action will be unlikely unless the injunction is granted.

The injunction can be effective against the infringer's suppliers or customers only if the court renders the preliminary injunction decision against those parties as well.

The final injunctions can only be granted as part of the final judgment at the end of the litigation. These include:

- seizing the infringing products and the machinery, devices and other instruments to the extent that the production of the products that do not constitute infringement is not prevented;
- granting ownership on the seized machinery, devices and other instruments to the plaintiff; and
- transforming the shapes of or removing any trademarks from the seized machinery, devices, and other instruments, or destruction if it is necessary for preventing the infringement.

The decisions of courts including injunctions are enforced by Enforcement Offices. Decisions concerning IP rights must be finalised before being enforced.

Banning importation of infringing products

24 | To what extent is it possible to block the importation of infringing products into the country? Is there a specific tribunal or proceeding available to accomplish this?

It is possible to block the importation of infringing products into the country. Also, in accordance with the IP Law and Customs Code No. 4458, IP rights are also protected in the customs areas. For the protection of IP rights at Turkish Customs, a single application is filed through the online system of the General Directorate of Customs. This application will cover importation or exportation of infringing products as well as transit trade and shipment at any Turkish free-trade zones.

Patent owners bringing an infringement lawsuit can also request from the competent court that the customs authority seize the infringing products or the products used in the manufacture of the infringing goods. However, unless the patent owner identifies the infringing goods, the customs authorities may not be able to detect a product infringing a patent right. Therefore, the seizure procedure of the customs authorities is more effective for trademark infringement.

Attorneys' fees

25 | Under what conditions can a successful litigant recover costs and attorneys' fees?

The losing party bears the official litigation fees and official attorney fees of the counterparty. The minimum attorneys' fee determined in line with the annual tariff declared by the Turkish Bar Union is 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.

Wilful infringement

26 | Are additional remedies available against a deliberate or wilful infringer? If so, what is the test or standard to determine whether the infringement is deliberate? Are opinions of counsel used as a defence to a charge of wilful infringement?

No, additional remedies are not available.

Time limits for lawsuits

27 | What is the time limit for seeking a remedy for patent infringement?

Patent infringements are considered as tortuous acts as per the Turkish Code of Obligations numbered 6098. Therefore, general rules on limitations apply to patent infringement matters.

The remedy for patent infringement can be sought within two years of the date of discovering the damage and the infringer by the patent owner provided that the claim is made within 10 years of the date of the infringement action. If the infringement is ongoing, the time limit starts again with every infringing action.

Patent marking

28 | Must a patent holder mark its patented products? If so, how must the marking be made? What are the consequences of failure to mark? What are the consequences of false patent marking?

There is no requirement regarding patent marking in Turkish law.

LICENSING

Voluntary licensing

29 | Are there any restrictions on the contractual terms by which a patent owner may license a patent?

The contractual terms of a voluntary licence agreement are determined by the patentee freely. It is at the complete discretion of the patentee to limit or broaden the rights to be licensed on the patent. However, the moral rights on the patent cannot be transferred through a licence agreement. Competition Law requirements and special requirements on standard essential patents are reserved.

The licence agreements must be in writing.

Compulsory licences

30 | Are any mechanisms available to obtain a compulsory licence to a patent? How are the terms of such a licence determined?

A compulsory licence can be granted under six circumstances in accordance with article 129 of the IPL:

- non-use of a patented invention for three years starting from publication or four years as of the application;

- the patent is dependent on an earlier patent;
- public interest on the use or enhancement of the use of the patented invention;
- exportation of the patented invention due to the public health issues (in accordance with protocol amending the Trade-Related Aspects of Intellectual Property Rights Agreement);
- a plant breeder cannot develop a new plant variety without infringing a previous patent; and
- the patent owner engages in activities that prevent, distort or restrict competition while using the patent.

It is sufficient for one of the above-mentioned circumstances to occur for a compulsory licence to be granted. However, the list is exhaustive.

A compulsory licence is always granted by a public authority, such as the courts, President of the Republic or Competition Authority.

The terms of the compulsory licence are determined in accordance with the IP Law. A compulsory licence is granted non-exhaustively (except for certain conditions of public interest) and it is not allowed to subject the patented invention to exportation or importation (an exception may arise due to public health issues). The compulsory licence cannot be transferred or sublicensed. However, there is an exception if the public interest requires the patented invention to be imported, transferred or sublicensed.

The patent owner or the licensee can request the terms to be amended if the conditions have changed. The terms regarding a voluntary licence are applied to a compulsory licence provided that the terms do not contradict the articles regarding compulsory licences in the IP Law.

The licence fee is determined by courts in accordance with the economic value of the patent (except for the compulsory licence due to public health issues of foreign countries).

PATENT OFFICE PROCEEDINGS

Patenting timetable and costs

31 | How long does it typically take, and how much does it typically cost, to obtain a patent?

In a smooth-running proceeding, obtaining a patent takes approximately 30 to 36 months after filing an application.

The cost will vary between €4,000 and €6,000 (including official fees). This cost does not include the application drafting.

The total costs and timing – from the filing of the patent application to the grant of the patent – depend on:

- the complexity of the invention or application;
- the number of prior art documents cited; and
- the length of the examination proceedings.

Expedited patent prosecution

32 | Are there any procedures to expedite patent prosecution?

No specific procedures are available to expedite patent prosecution under the IP Law. However, currently a patent prosecution highway system is being established at the Turkish Patent and Trademark Office. Currently, the Patent Prosecution Highway is applied between the Japanese Patent Office and the Spanish Patent and Trademark Office as pilot offices.

Patent application contents

- 33 | What must be disclosed or described about the invention in a patent application? Are there any particular guidelines that should be followed or pitfalls to avoid in deciding what to include in the application?

The application is required to disclose or describe the invention sufficiently clearly and fully so that it can be applied by a person skilled in the art.

Claims are required to be built up in accordance with the description of the invention, and required to be clear and essential. Claims cannot expand the protection that is not covered by the description of the invention. Clear and reasonable information on the effects of the features of the invention is supportive for setting forth the inventive step.

Prior art disclosure obligations

- 34 | Must an inventor disclose prior art to the patent office examiner?

According to article 75/1(c) of the IP Regulation, the description of the invention must contain information related to the prior art that can be known by the patent holder for the purpose of examining and searching the application.

Pursuit of additional claims

- 35 | May a patent applicant file one or more later applications to pursue additional claims to an invention disclosed in its earlier filed application? If so, what are the applicable requirements or limitations?

Article 123 of the Industrial Property Law (IPL) allows an applicant to pursue additional claims while the main patent application is still being examined. These additional claims must perfect the subject matter invention or improve it, and they must also be in line with the subject of the main patent. An application for a supplementary patent can be filed until the publication of the granting certificate of the main patent application.

Patent office appeals

- 36 | Is it possible to appeal an adverse decision by the patent office in a court of law?

It is possible to object a decision of the Turkish Patent and Trademark Office (TPTO) within two months of the notification date of the disputed decision as per article 100 of the IPL. This opposition is evaluated by the Re-Examination and Evaluation Board of the TPTO.

Any final TPTO decision can only be challenged by a cancellation lawsuit before the Ankara Civil IP Courts within two months as of the notification of the decision.

Oppositions or protests to patents

- 37 | Does the patent office provide any mechanism for opposing the grant of a patent?

Post-grant opposition proceedings are set out in the IPL. Accordingly, opposition proceedings start once the patent is granted. Third parties can file an opposition within six months as of the publication date of a granted patent. An opposition can be based on the following grounds:

- the subject matter lacks patentability criteria;
- the patent does not disclose sufficient details of the invention to enable a person skilled in the art to apply it in practice; and
- the patent's subject matter extends the scope of the first version of the filing.

Priority of invention

- 38 | Does the patent office provide any mechanism for resolving priority disputes between different applicants for the same invention? What factors determine who has priority?

The right to apply for a patent belongs to the person who is the first to file the application in respect of the invention as per article 109/3 of the IPL. If two or more persons have made the invention independently of each other, the right to apply for a patent belongs to the first to file the application provided that the earlier application has been published. As a rule, the first applicant is considered to be the holder of the right to apply for a patent unless otherwise is proven.

Also, it cannot be argued before the TPTO that the applicant is not entitled to apply for a patent. However, a lawsuit can be brought against the holder of the patent by the person who claims to be the true owner of the patent, before the competent IP courts.

Modification and re-examination of patents

- 39 | Does the patent office provide procedures for modifying, re-examining or revoking a patent? May a court amend the patent claims during a lawsuit?

Patent applications can be amended during the application process or upon opposition provided that the scope of the application is not exceeded.

When a patent application is filed, the TPTO issues the patent if the patentability criteria is met. If the TPTO finds that the application does not meet the patentability criteria, the applicant is given two months to either amend its claims or object to the TPTO's report. The TPTO will consider the applicant's objections or amendments and if the TPTO stands by its previous decision, the applicant is allowed another two months to make a second round of objections or amendments. The TPTO's next decision on the matter is final.

Additionally, during the post-grant opposition procedure, the patent owner can file amendments within three months as of the notification of an opposition. The TPTO after examining the opposition can invalidate the patent, reject the opposition or request further amendments to be made.

The court cannot amend the claims of a patent.

Patent duration

- 40 | How is the duration of patent protection determined?

The maximum term of protection is 20 years from the filing date.

UPDATE AND TRENDS

Key developments of the past year

- 41 | What are the most significant developing or emerging trends in the country's patent law?

The implementation of some of the provisions adopted in line with the EPC has been a topic of discussion since the Industrial Property Law (IPL) entered into force in 2017. For example, the compulsory licence and rules on service inventions have been major discussion points. As the IPL has not been amended significantly since the adaptation, the implementation of certain points is left to case law. Notably, the remuneration methods for service inventions are raising debates.

Also, the law amending the Civil Procedural Law grants the possibility to obtain two weeks additional time to file objections to the expert report obtained during a court action. Before this amendment, the parties were required to file their objection following the notification; now they are entitled to ask for two weeks' additional time (which

prolongs the total time up to four weeks) meaning that it is 'very difficult or impossible to prepare' an objection brief.

Additionally, although it has been four years since the new IPL was adopted, the application of the law is still not unified between the specialised IP courts. This occurs mainly because of the different experience levels of the judges appointed at the IP courts. Therefore, expert reports are heavily relied upon. In 2021, it is expected that the unification of the IP Code's application will be expedited.

Further, the *Bolar* exemption and its limits are still hot discussion points for Turkey's patent law. Primarily in terms of infringement it is important to determine the timing – which is still being affected by the practice of the *Bolar* exemption.

Coronavirus

42 | What emergency legislation, relief programmes and other initiatives specific to your practice area has your state implemented to address the pandemic? Have any existing government programmes, laws or regulations been amended to address these concerns? What best practices are advisable for clients?

On 26 March 2020, the Law on Amending Several Laws No. 7226 was published in the Official Gazette No. 31080 to address the concerns of professionals about missing or meeting any legal deadlines during this pandemic. According to the law, to prevent any loss of rights amid covid-19 spread, all deadlines were suspended as of 13 March 2020 retrospectively until 15 June 2020 for all civil, criminal and administrative legal proceedings with limited exemptions. The suspension also covered the procedures before the Turkish Patent and Trademark Office.

As the seizure before the customs is ensured by a preliminary injunction decision from a civil court or a seizure decision from the criminal courts (classified as protective measure), the deadline for IPR holders continued running even during the suspension period foreseen by the Law.

Currently, the proceedings are ongoing as foreseen by the relevant legislation and no special precaution is in force.

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