



# ICLG

The International Comparative Legal Guide to:

## Patents 2018

**8th Edition**

A practical cross-border insight into patent law

Published by Global Legal Group, in association with CDR, with contributions from:

Advokatfirman Lindahl KB  
Agency TRIA ROBIT  
AnJie Law Firm  
Armengaud & Guerlain  
Bird & Bird LLP  
Chuo Sogo Law Office, P.C.  
Daniel Legal & IP Strategy  
De Beer Attorneys  
Elzaburu  
Finnegan, Henderson, Farabow,  
Garrett, and Dunner LLP  
Gilat, Bareket & Co.  
Gleiss Lutz  
Gorodissky & Partners (Ukraine)  
Gros & Waltenspühl

Gün + Partners  
Kadasa & Partners  
Lewis Roca Rothgerber Christie LLP  
Nestor Nestor Diculescu Kingston Petersen  
OLIVARES  
Pham & Associates  
PORZIO · RIOS · GARCIA  
Reinhold Cohn & Partners  
Reising Ethington P.C.  
Rouse & Co. International  
Subramaniam & Associates  
SyCip Salazar Hernandez & Gatmaitan  
TIPLo Attorneys-at-Law  
WhitneyMoore Solicitors  
Wikborg Rein Advokatfirma AS





**Contributing Editor**

Katharine Stephens,  
Bird & Bird LLP

**Sales Director**

Florjan Osmani

**Account Director**

Oliver Smith

**Sales Support Manager**

Paul Mochalski

**Sub Editor**

Nicholas Catlin

**Senior Editors**

Suzie Levy, Rachel Williams

**Chief Operating Officer**

Dror Levy

**Group Consulting Editor**

Alan Falach

**Publisher**

Rory Smith

**Published by**

Global Legal Group Ltd.  
59 Tanner Street  
London SE1 3PL, UK  
Tel: +44 20 7367 0720  
Fax: +44 20 7407 5255  
Email: info@glgroup.co.uk  
URL: www.glgroup.co.uk

**GLG Cover Design**

F&F Studio Design

**GLG Cover Image Source**

iStockphoto

**Printed by**

Ashford Colour Press Ltd.  
August 2017

Copyright © 2017

Global Legal Group Ltd.  
All rights reserved  
No photocopying

ISBN 978-1-911367-70-3

ISSN 2044-3129

**Strategic Partners**



**General Chapters:**

1	<b>Preparing for the Unitary Patent and Unified Patent Court: What to Consider Before Opting Out or Opting to Stay In</b> – Katharine Stephens & Audrey Horton, Bird & Bird LLP	1
2	<b>Method Claiming in the United States: The Who, What, and Where of Enforcement</b> – Scott A. Hogan & Shannon K. Smith, Reising Ethington P.C.	7
3	<b>U.S. Supreme Court Agrees Upon Restricted Venue for Patent Cases</b> – D. Stuart Bartow & Terry Ahearn, Lewis Roca Rothgerber Christie LLP	11
4	<b>Review of the Eurasian Patent System</b> – Maxim Sobolev, Rouse & Co. International (UK) Limited (Moscow Branch)	15
5	<b>Gulf Co-operation Council Countries – Patent Landscape</b> – Sara Holder & Mohammad Jomoa, Rouse & Co. International/Kadasa & Partners	19

**Country Question and Answer Chapters:**

6	<b>Australia</b>	Bird & Bird LLP: Jane Owen & Rebecca Currey	22
7	<b>Brazil</b>	Daniel Legal & IP Strategy: Rana Gosain & André Bastos Venturini	28
8	<b>Chile</b>	PORZIO · RIOS · GARCIA: Cristóbal Porzio & Marcelo Correa	36
9	<b>China</b>	AnJie Law Firm: Steve Song & Ying Wang	42
10	<b>France</b>	Armengaud & Guerlain: Catherine Mateu	49
11	<b>Germany</b>	Gleiss Lutz: Dr. Matthias Sonntag & Dr. Herwig Lux	56
12	<b>India</b>	Subramaniam & Associates: Hari Subramaniam	62
13	<b>Ireland</b>	WhitneyMoore Solicitors: Aoife Murphy & Robin Hayes	70
14	<b>Israel</b>	Gilat, Bareket & Co.: Eran Bareket Reinhold Cohn & Partners: Ronnie Benschafut	77
15	<b>Japan</b>	Chuo Sogo Law Office, P.C.: Naoko Nakatsukasa	84
16	<b>Latvia</b>	Agency TRIA ROBIT: Vladimir Anohin & Voldemars Osmans	91
17	<b>Mexico</b>	OLIVARES: Alejandro Luna Fandiño & Sergio Luis Olivares Lobato	96
18	<b>Norway</b>	Wikborg Rein Advokatfirma AS: Gunnar Meyer & Lars Erik Steinkjer	104
19	<b>Philippines</b>	SyCip Salazar Hernandez & Gatmaitan: Enrique T. Manuel & Vida M. Panganiban-Alindogan	110
20	<b>Romania</b>	Nestor Nestor Diculescu Kingston Petersen: Ana-Maria Baciú & Sorina Olaru	116
21	<b>Russia</b>	Rouse & Co. International (UK) Limited (Moscow Branch): Maxim Sobolev & Andrey Cherkasov	121
22	<b>Saudi Arabia</b>	Rouse & Co. International/Kadasa & Partners: Sara Holder & Mohammad Jomoa	127
23	<b>South Africa</b>	De Beer Attorneys: Elaine Bergenthuin & Ntombovuyo Bungane	133
24	<b>Spain</b>	Elzaburu: Colm Ahern	140
25	<b>Sweden</b>	Advokatfirman Lindahl KB: Ludvig Holm & Annie Kabala	145
26	<b>Switzerland</b>	Gros & Waltenspühl: Pascal Fehlbaum	151
27	<b>Taiwan</b>	TIPLo Attorneys-at-Law: J. K. Lin & H. G. Chen	157
28	<b>Turkey</b>	Gün + Partners: Selin Sinem Erciyas & Tuğçe Avcısirt Geçgil	165
29	<b>Ukraine</b>	Gorodissky & Partners (Ukraine): Nina Moshynska	173
30	<b>United Arab Emirates</b>	Rouse & Co. International: Sara Holder	180
31	<b>United Kingdom</b>	Bird & Bird LLP: Katharine Stephens & Audrey Horton	185
32	<b>USA</b>	Finnegan, Henderson, Farabow, Garrett, and Dunner LLP: Mareesa A. Frederick & Clara N. Jiménez	195
33	<b>Vietnam</b>	Pham & Associates: Pham Vu Khanh Toan	202

Further copies of this book and others in the series can be ordered from the publisher. Please call +44 20 7367 0720

**Disclaimer**

This publication is for general information purposes only. It does not purport to provide comprehensive full legal or other advice. Global Legal Group Ltd. and the contributors accept no responsibility for losses that may arise from reliance upon information contained in this publication. This publication is intended to give an indication of legal issues upon which you may need advice. Full legal advice should be taken from a qualified professional when dealing with specific situations.

# Turkey



Selin Sinem Erciyas



Tuğçe Avcısirt Geçgil

Gün + Partners

## 1 Patent Enforcement

### 1.1 Before what tribunals can a patent be enforced against an infringer? Is there a choice between tribunals and what would influence a claimant's choice?

A patent can be enforced before specialised Intellectual Property (“IP”) courts. It is worth noting that IP courts are found only in larger cities, i.e. Istanbul, Ankara and Izmir. If there is no IP court in a city, a patent can be enforced before non-specialised civil courts of first instance in that city.

Article 156 of the Intellectual Property Law no. 6769 (“IPL”) regulates which courts are competent to deal with patent disputes. Accordingly, if the patent owner is willing to start legal proceedings, the competent court is the court of the domicile of the plaintiff or of the place where the infringement took place (or of the place where the act of infringement produced effect). Where the plaintiff is not domiciled in Turkey, the competent court is the court of the location of the business premises of the patent attorney registered before the Turkish Patent and Trademark Institute (the “Institute”) and, where there is no registration of the patent attorney, the court where the headquarters of the Institute is located.

If there is more than one IP court in a city, the court which will hear the case is determined automatically by the distribution offices available in court houses. In other words, the plaintiff is not free to choose which IP court (e.g. first, second, etc.) will hear the case.

### 1.2 What has to be done to commence proceedings, what court fees have to be paid and how long does it generally take for proceedings to reach trial from commencement?

In order to commence proceedings, it is sufficient to file a plaintiff petition before the competent IP court. Court fees, including an advance on potential court expenses, should be deposited to the court to file an action. These fees amount to approximately EUR 250.

On the other hand, once a court action has been filed, the court notifies the action to the defendant party. If the defendant party is domiciled abroad, plaintiff petition and all evidences should be translated into the official language of the defendant party, and thereafter, the defendant party should be notified officially via an international notification route. In practice, the international notification proceedings may take six months to one year. The defendant should file its first response petition within two weeks

of the international notification. It is also possible to demand a time extension within the same two-week period. After the parties exchange two sets of petitions and submit relevant evidence on which they base their petitions and allegations, the court reviews the file and sets a hearing date for the first hearing which is called the “initial examination hearing” in the Civil Procedural Law no. 6100 (“Procedural Law”).

It is important to note that before starting legal proceedings, the patent owner may send a notarised letter to the potential infringer as per Article 141 of the IPL. However, this is not a pre-condition to starting proceedings before the IP court.

### 1.3 Can a party be compelled to disclose relevant documents or materials to its adversary either before or after commencing proceedings, and if so, how?

As per Articles 219 and 220 of the Code of Civil Procedure, the parties are obliged to submit the documents which they, or the opposing party, have cited as evidence, if they are in possession of such documents after the trial has commenced. If they fail or refuse to submit such documents, they must give their reasons for such failure or refusal. In the event that they cannot give a plausible reason for the situation, according to the circumstances of the case, as a sanction the court may accept the statements of the other party to be true.

### 1.4 What are the steps each party must take pre-trial? Is any technical evidence produced, and if so, how?

With enactment of the IPL, it was settled that there is no mandatory step that must be fulfilled before initiating a negative declaratory action. Article 154 of the IPL states that sending a notarised letter to the patent owner is an optional measure, not a pre-condition to filing an action.

According to Article 119 of the Procedural Code, the plaintiff has to demonstrate and submit all evidence supporting his case when filing the action. For instance, if the plaintiff requests the court to render an injunction, the plaintiff shall submit the necessary evidence with its plaintiff petition supporting the injunction request. If there is evidence which is not available to the plaintiff, the plaintiff is entitled to ask the court to summon such evidences from the relevant authorities. If such evidence is only available to the defendant, the plaintiff is entitled to ask the court to order the defendant to submit such documents to the court. If the defendant fails to do so, it is deemed that the arguments of the plaintiff have been proven.

In cases where there is a risk that evidence may change or be destroyed, the plaintiff may apply for discovery of evidence per

Article 400 of the Procedural Code. In this application, the court may discover evidences *ex parte*, and appoint experts where necessary.

### 1.5 How are arguments and evidence presented at the trial? Can a party change its pleaded arguments before and/or at trial?

The parties have to submit all arguments and evidence by the initial examination hearing, which is held after the petition exchange phase is completed. At the initial examination hearing, the court grants the parties two weeks' additional time to submit any missing evidence.

According to Article 141 of the Procedural Code, the parties are allowed to change their arguments with their reply petitions. Moreover, at the initial hearing, if a party explicitly consents, the other party may change its claims or arguments. If one of the parties is not present at this initial examination hearing and gives no reason for being absent, the attending party is allowed to change or extend its pleaded arguments freely.

In addition, the parties have the right to correct/amend their demand until the end of the trial, as per Articles 176 and 177 of the Procedural Code.

### 1.6 How long does the trial generally last and how long is it before a judgment is made available?

It generally takes one-and-a-half years before the first instance courts, and about two years before the Court of Appeals to reach a judgment. Recently, Turkey adopted a three-tier appeal system where there is one more stage between first instance courts and the Court of Appeals. This court, also known as the Court of Cassation, may examine the merits of the case and call for another expert examination before rendering a decision. The Court of Cassation has been in operation since July 2016 and it is expected that it will take six to eight months to assess the merits of each case. This period may be longer in case the Court of Cassation decides there is a need for a court-appointed expert examination.

### 1.7 Are judgments made available to the public? If not as a matter of course, can third parties request copies of the judgment?

According to Article 26 of the Procedural Code, in principle all hearings and decisions are public (Principle of publicity). However, there is no database that makes all judgments available to the public. Third party attorneys are allowed to review a file without obtaining a copy from the file, but only attorneys representing the parties with a power of attorney are allowed to obtain copies of a judgment and other documents from a court's file.

### 1.8 Are there specialist judges or hearing officers, and if so, do they have a technical background?

According to Article 156 of the IPL, specialised IP courts have jurisdiction for all of the actions and claims which arise out of IP Law. The judges in Turkish IP courts have a deep understanding of IP law, even if they do not have technical backgrounds.

In the early years of the IP courts, judges were given specific training on IP law, but since they have no technical background, they can also refer files to expert panels for technical evaluation. Therefore, the practice of the IP courts has evolved so that disputes are often solved with the help of expert examinations.

### 1.9 What interest must a party have to bring (i) infringement, (ii) revocation, and (iii) declaratory proceedings?

- (i) A patent holder whose rights are infringed, or who is under threat of infringement, may file an infringement action as set forth under Article 149 of the IPL.
- (ii) Article 138 of the IPL sets out that persons adversely affected/prejudiced, interested official authorities or the Public Prosecutor may request the invalidation of a patent. Moreover, the invalidity of a patent may also be put forward by persons entitled to claim the right to the patent.
- (iii) Lastly, pursuant to Article 154 of the IPL, any interested person may institute proceedings against the holder of a patent to obtain judgment of non-infringement of rights conferred by the patent. In practice, generic companies willing to enter the market with a product which could be within the scope of a patent begin such declaratory proceedings.

### 1.10 If declarations are available, can they address (i) non-infringement, and/or (ii) claim coverage over a technical standard or hypothetical activity?

The IPL explicitly rules on the declaration of non-infringement actions in Article 154 of the IPL.

Accordingly, any interested person may file a declaration action against the patent holder to obtain a judgment of non-infringement of rights conferred by the patent.

With regards to point (ii), there is no specific provision regulating declaration actions for claim coverage over a technical standard or hypothetical activity. On the other hand, in general terms the determination of the scope of protection of claims is a sub-issue dealt with in infringement actions.

### 1.11 Can a party be liable for infringement as a secondary (as opposed to primary) infringer? Can a party infringe by supplying part of, but not all of, the infringing product or process?

As per Article 86 of the IPL, a party can be liable for infringement as a secondary (indirect) infringer if a third person hands over to persons unauthorised to work on the patented invention elements and means related to an essential part of the invention, and the subject matter of the patent, and renders possible the implementation of the patented invention. In order for this provision to be applicable, the concerned third party has to know that such elements and means are sufficient for putting the invention to use, and that they will be used to such effect, or that the circumstances render such situations sufficiently evident.

### 1.12 Can a party be liable for infringement of a process patent by importing the product when the process is carried on outside the jurisdiction?

Yes; importing an infringing product, even when the process is carried on outside of the jurisdiction, falls within the scope of the infringing acts regulated under Article 141 of the IPL. Namely, Article 141/1(c) stipulates that using the patented process or selling, distributing or commercialising in any other way, importing for such purposes, or using by applying the products directly obtained through such patented process, without the consent of the patent holder, are deemed as patent infringement.

As a note for process patents, if the product manufactured with the patented process is new, each product manufactured without permission of the patent owner is considered as manufactured with patented process. In this case, the burden of proof is automatically reversed, and it is for the defendant party to prove that the patented process has not been infringed. However, if the product manufactured with a patented process is not new, it is left to the judge's discretion to decide whether the burden of proof is on the defendant (Article 141/2 of the IPL).

### 1.13 Does the scope of protection of a patent claim extend to non-literal equivalents?

Yes, as per Article 89/5 of the IPL, in determining the scope of protection conferred by a patent application or a patent at the time of an alleged infringement, all elements equivalent to the elements expressed in the claim(s) shall also be considered (doctrine of equivalence). To be an equivalent, the substitute element must match the function, way and result of the claimed element.

In addition, in order to determine the scope of protection of the patent, the declarations of the patent application or declarations of the patent owner which were given during the grant proceedings of the patent or during the validity of the patent will be taken into consideration (Article 89/6 of the IPL).

Finally, if the patent includes examples regarding the invention, the claims are not interpreted as limited to these examples. In particular, if the additional features of the product or process described in the patent are not in the examples or such additional features do not include the features described in the examples or the additional features cannot realise each purpose or feature described in the examples, the additional features cannot be excluded from the scope of protection (Article 89/7).

### 1.14 Can a defence of patent invalidity be raised, and if so, how? Are there restrictions on such a defence e.g. where there is a pending opposition?

Yes, a defence of patent invalidity can be raised either by filing a counter action or a separate action against enforcement of the same patent.

The counter action should be pursued within the time period of filing the first response petition in the infringement action, as per Article 133/1 of the Procedural Law.

A separate invalidation action can be filed at any time.

The restriction brought to the invalidation action is defined in Article 138/2 of the IPL. Accordingly, if the invalidation action is filed at a time wherein the post grant opposition against the same patent is pending, the IP court must delay the invalidity proceedings until the outcome of the opposition.

### 1.15 Other than lack of novelty and inventive step, what are the grounds for invalidity of a patent?

The grounds for the invalidity of a patent are ruled under Article 138 of the Industrial Property Law. Accordingly, a patent should be declared invalid by a court in the following situations:

- (a) where the subject matter of the invention does not meet the patentability requirements as specified under Articles 82 to 83 of the IPL (i.e. novelty, inventive step and applicability in industry);
- (b) where the invention has not been described sufficiently according to Article 92 of the IPL;

- (c) where the subject matter of the patent exceeds the scope of the application or is based on a divisional application filed in compliance with Article 91 (*unity of the invention principle*), or on an application filed in compliance with Article 110 (*Usurpation of the Right to a Patent*) and exceeds the scope of the same;
- (d) where the holder of the patent does not have the right to a patent in accordance with Article 109 of the IPL; or
- (e) where the scope of the patent is exceeded.

### 1.16 Are infringement proceedings stayed pending resolution of validity in another court or the Patent Office?

Under the IPL or the Procedural Law, there is no specific provision requiring the courts to stay infringement proceedings due to a pending validity matter before another court or Patent Office such as the EPO proceedings.

It is at the courts' discretion to stay infringement proceedings in order to wait for the invalidity issue to be resolved. In case of a national invalidity case, most IP courts either stay the infringement proceedings or decide to consolidate the infringement and invalidation proceedings and evaluate both cases together.

With regard to EPO proceedings, in practice if the patent concerns the validation of a European patent, depending on the status of the EPO proceedings, courts may decide to wait for the outcome of the EPO procedure, if it seems it will not be long until it is finalised. Apart from that, IP courts generally prefer not to wait for the EPO proceedings, considering the length of such procedures.

### 1.17 What other grounds of defence can be raised in addition to non-infringement or invalidity?

As discussed above, the most used tactical defence against infringement attacks is filing an invalidation action against the patent.

Additionally, the file history estoppel argument (defined in Article 89/6 of the IPL) can be raised if the patent owner is relying on infringement as per the doctrine of equivalents.

Another defence against an infringement case can be raised due to Article 87 which rules about prior user rights:

“The patent applicant or the patent owner shall not have the right to prevent the persons who began to use the invention in good faith or have adopted significant and real measures for its use prior to the application date from continuing to use the invention which is subject to the patent in the same manner or begin to use it in line with the measures adopted. However, the continuation of the use of the invention which is subject to the patent by the referred persons or its use in line with adopted measures shall be at a degree which fulfills the reasonable requirements of the establishment they own. This right for use may only be transferred along with the relevant establishment.”

Accordingly, if the conditions for prior user rights exist then the defendant of an infringement action may depend on this Article against infringement claims.

Finally, procedural grounds of the Procedural Law can be raised in addition to the non-infringement and invalidity defences. (For example, as per Article 114 of the Procedural Law, the court must have jurisdiction and the plaintiff must have legal benefit to file the action, etc.)

### 1.18 Are (i) preliminary, and (ii) final injunctions available, and if so, on what basis in each case? Is there a requirement for a bond?

In Turkish Patent Law, preliminary injunctions are available, and such injunctions mostly stay in force until the judgment, to be rendered in the main action, becomes final. However, the court may lift the injunction decision in case the conditions are changed and it is brought to the attention of the court by the party subject to the injunction.

According to Article 159 of the IPL, persons who have commenced, or will commence, legal proceedings under the IPL, can request for a Preliminary Injunction (“PI”) in order to ensure the effectiveness of the infringement action, on condition that they bring evidence as to the existence of actual use of the patent in Turkey or serious and effective preparations to use the patent in question. The PI requests are accepted when any delay might cause irreparable and significant damage.

The success of a PI request totally depends on the quality of evidence that a delay might cause irreparable and significant damage. In practice, the courts refer the file to the expert panels and obtain an expert report before rendering a PI decision.

The bond requirement is at the discretion of the court. The court evaluates the characteristics of each case to decide whether or not a bond is required. If the court decides that the party requesting PI shall deposit a bond, then it is obligatory to deposit said bond requirement so that the PI decision can be enforced. If it is not deposited, the decision cannot be enforced, and the PI decision will be revoked *ex officio*.

Security can be in the form of cash or a letter of guarantee. The court determines the amount according to the particulars of the case, i.e. the sales of the product, whether there are other generics in the market, etc.

### 1.19 On what basis are damages or an account of profits assessed?

There are three bases to calculate the damages according to Article 151 of the IPL:

- (1) Article 151/1(a) of the IPL: the damages claim is calculated according to the income which the patent owner might possibly have generated if the competition of the infringing party did not exist. The court-appointed expert panel would examine the patent holder’s commercial books and records along with the infringer’s, in order to determine the loss of profit.
- (2) Article 151/1(b) of the IPL: the damages claim is calculated according to the income which is generated by the infringing party from the use of the patent. In this case, the expert examination would be conducted on the infringer’s commercial records.
- (3) Article 151/1(c) of the IPL: the damages claim can be calculated according to a licence fee that would have been paid if the party infringing the patent would have lawfully utilised the patent under a licensing contract.

### 1.20 How are orders of the court enforced (whether they be for an injunction, an award of damages or for any other relief)?

The decisions of courts are enforced according to the Enforcement and Bankruptcy Law numbered 2004 by Enforcement Offices. Parties shall apply to enforcement offices to enforce a court’s decision, i.e. a preliminary injunction decision.

It is important to note that the Precautionary Injunction decision must be enforced within one week of the granting of PI. Otherwise, it is automatically lifted.

The reasoned decisions and decisions on merits of the courts can be enforced at any time. It is not necessary to wait for the finalisation of the decision (finalisation after appeal) if the subject matter of the case is not related to family law, property law or personal matters. Case law actions related to intellectual property rights are not deemed as a part of property law and therefore can be enforced without waiting for finalisation of the decision.

### 1.21 What other form of relief can be obtained for patent infringement? Would the tribunal consider granting cross-border relief?

In practice, reverse PI decisions are available as another form of relief that can be obtained for patent infringement. Indeed, we have observed that the IP courts may order PI decisions where the potential infringer is allowed to continue with trade or business, provided that he pays a guarantee amount corresponding to the potential damages of the patent holder. At the end of the proceedings, if the patent infringement is determined, the patent holder may refer to this guarantee amount and also ask for further damages exceeding the guarantee amount.

Turkish courts do not have jurisdiction on other countries. Therefore cross-border reliefs are not an option.

### 1.22 How common is settlement of infringement proceedings prior to trial?

Settlement of infringement proceedings prior to trial is very rare; although it may be the case, especially if the patent holder sent a warning letter to the potential infringer and disclosed its intention to start an infringement trial. This may lead the parties to come together and seek an amicable solution. In particular in pharmaceutical patent disputes, parties mostly refrain from settlements due to the sensitivity of the Competition Authority.

### 1.23 After what period is a claim for patent infringement time-barred?

A claim for patent infringement can be raised as long as the infringement is ongoing (and within the duration of the patent protection). The logic behind this is that the damages occur with each and every infringing act; therefore, lapse of time is renewed with every infringing action.

As the patent infringement act is a kind of unfair act, after the infringement has ceased, the general provisions of the Turkish Code of Obligations determine the period after which a claim for patent infringement will become time-barred. According to these provisions, after two years as of learning about the infringer and the damage or in any case after 10 years as of the occurrence of the unfair act, a claim for patent infringement becomes time-barred.

### 1.24 Is there a right of appeal from a first instance judgment, and if so, is it a right to contest all aspects of the judgment?

Yes. Turkey adopted a new appeal system which entered into force on July 20, 2016. The new system introduced a three-tier court system; namely first instance courts, Courts of Cassation and Courts of Appeal. In principle, all final decisions of the courts of

first instance can be appealed. Interim decisions, however, can only be appealed along with the final decision. The Court of Cassation examines judgments, including judgments regarding PI requests, as well as the merits of the case. The decision of the Court of Cassation can be appealed to the Court of Appeals.

### 1.25 What are the typical costs of proceedings to first instance judgment on (i) infringement, and (ii) validity? How much of such costs are recoverable from the losing party?

The main costs arising in a typical patent case including both infringement and validity would be judicial costs (i.e. expert fees) and a fixed attorney fee. Courts set up an expert panel composed of three experts. The fee for each expert examination is around TL 3,000 (approximately EUR 900). A second panel of experts is also likely to be appointed if the first one's report is found not to be satisfactory. The attorney fee which is determined in line with the annual tariff declared by Turkish Bar Union is TL 2,600 (approximately EUR 665). Therefore, the total costs for such litigation are around EUR 3,000 to EUR 4,000. The losing party shall bear the judicial costs and the fixed attorney fee.

### 1.26 For jurisdictions within the European Union: What steps are being taken in your jurisdiction towards ratifying the Agreement on a Unified Patent Court, implementing the Unitary Patent Regulation (EU Regulation No. 1257/2012) and preparing for the unitary patent package? For jurisdictions outside of the European Union: Are there any mutual recognition of judgments arrangements relating to patents, whether formal or informal, that apply in your jurisdiction?

There is no mutual recognition of judgment arrangements relating to patents that apply in Turkey for the time being.

## 2 Patent Amendment

### 2.1 Can a patent be amended *ex parte* after grant, and if so, how?

According to Article 99/4 of the IPL, the patent owner may amend the patent upon objections of third parties after publication of the patent grant decision in the Official Bulletin. Article 103/3 of the IPL stipulates that the patent application may be amended during the proceedings before the Institute provided that changes shall not exceed the scope of the application. Further, it stipulates that if the patent is objected to, the patent owner may amend the patent until the Institute gives a final decision on the objection, provided that the amendments do not exceed the scope of protection. Any material mistakes can be amended at any time.

The IPL also foresees that regulations will be published on procedures and principles on amendments and relevant applications; such regulations have not yet been published.

### 2.2 Can a patent be amended in *inter partes* revocation/invalidity proceedings?

Please refer to question 2.1.

Additionally, as Turkey is a contracting state of the EPC, if a patent is revoked before the EPO, Turkish validation of such a European patent is automatically revoked in Turkey too.

As concerns amendments, if a European patent is amended, for instance at the opposition stage, such amendment will be reflected in the Turkish validation patent, and if at that stage there is a pending invalidation action in Turkey, such amendment should be taken into account. Therefore, it is very important that Turkish courts stay the invalidation proceedings if there is a pending opposition or appeal process before the EPO.

### 2.3 Are there any constraints upon the amendments that may be made?

Please refer to question 2.1.

## 3 Licensing

### 3.1 Are there any laws which limit the terms upon which parties may agree a patent licence?

Licensing a patent is described under the IPL. There are no provisions limiting the terms upon which parties may agree to a patent licence.

### 3.2 Can a patent be the subject of a compulsory licence, and if so, how are the terms settled and how common is this type of licence?

Yes. According to Article 129 of the IPL, a compulsory licence can be granted where any one of the following circumstances exists:

- (i) non-use of the patent;
- (ii) dependency of the subject matter of the patent;
- (iii) it is in the public interest;
- (iv) the export of pharmaceutical products to foreign countries experiencing public health problems in line with Law no. 6471. The protocol amending TRIPs was accepted in Turkey as of 22 May 2013 by means of Law no. 6471 for the Acceptance of the Protocol Amending the TRIPs Agreement;
- (v) a plant breeder cannot develop a new type of plant without infringing a previous patent; or
- (vi) the patent holder engages in activities that prevent, distort or restrict competition while using the patent.

In practice, compulsory licensing is very rarely used. We could detect only one case back in 1974 about granting a compulsory licence in a matter related to national security.

## 4 Patent Term Extension

### 4.1 Can the term of a patent be extended, and if so, (i) on what grounds, and (ii) for how long?

The term of a patent cannot be extended in Turkey.

## 5 Patent Prosecution and Opposition

### 5.1 Are all types of subject matter patentable, and if not, what types are excluded?

According to Article 82 of the IPL, the following, which are not inventions by their very nature, shall remain outside the scope of this law:

- (a) discoveries, scientific theories and mathematical methods;

- (b) plans, methods, schemes/rules for performing mental acts, for conducting business activity and for playing games;
- (c) computer programs;
- (d) creations having an aesthetic characteristic and literary and artistic works; and
- (e) presentations of information/data.

Patents shall not be granted for inventions in respect of the following subject matter:

- (a) inventions whose subject matter is contrary to the public order or to morality as is generally accepted;
- (b) plant and animal varieties/species or processes for breeding/plant or animal varieties/species, based mainly on biological grounds, except microbiological processes and products obtained as a result of microbiological processes;
- (c) diagnosis methods and surgical methods including all treatment methods to be applied on the human and animal body;
- (d) the human body in various stages of its formation and evolution and invention of one of the elements of the human body including a gene sequence or partial gene sequence; or
- (e) human cloning processes, process of changing genetic identity of human sexual line, use of human embryo with industrial or commercial purposes, processes of changing genetic identity causing pain to animals without any medical benefit for humans or animals and animals obtained as a result of these processes.

### 5.2 Is there a duty to the Patent Office to disclose prejudicial prior disclosures or documents? If so, what are the consequences of failure to comply with the duty?

No, there is no duty to the Institute to disclose prejudicial prior disclosures or documents.

### 5.3 May the grant of a patent by the Patent Office be opposed by a third party, and if so, when can this be done?

According to Article 99 of the IPL, within six months following the publication of the decision of the patent grant, third parties may file oppositions to the grant of the patent. Oppositions and replies of a patent owner to these oppositions are examined by the Re-Examination and Evaluation Board. There is no administrative appeal procedure, so the decision of the Board is final. However, the parties can apply to the IP courts within two months as of the notification of the decision of the Board and demand for the cancellation of the decision.

### 5.4 Is there a right of appeal from a decision of the Patent Office, and if so, to whom?

First of all, in principle the Patent Office decisions can be appealed before the Re-Examination and Evaluation Board within two months as of notification of the decision.

Post grant oppositions are filed before and evaluated by Re-Examination and Evaluation Board. The IPL does not allow the decision of the Re-Examination and Evaluation Board to be appealed before the same Board again. Therefore, Article 99 of the IPL rules that the decisions on post-grant oppositions are final.

Every decision of the Re-Examination and Evaluation Board can be subject to a cancellation action before the IP Court. Such an action should be filed within two months as of notification of the

Re-Examination and Evaluation Board decision and before Ankara IP Courts.

### 5.5 How are disputes over entitlement to priority and ownership of the invention resolved?

There is no rule in the IPL defining a specific route to be followed in case of a dispute over entitlement to priority. In principle, the priority claim of the applicant is examined and evaluated by the Patent Office. The decisions of the Patent Office can be appealed before the Re-Examination and Evaluation Board and the Board decision can be subject to a cancellation action before the Ankara IP Court.

On the other hand, there is no specific route where third parties are involved with the priority claim of the patent owner, as non-entitlement of priority is not listed as one of the grounds for opposition or an invalidation action of third parties. However, third parties may challenge the novelty or inventive step of a patent depending on the document on which the patent owner claims priority, by claiming that the patent owner is not entitled to priority over such document and therefore it should be accepted as prior art for the patent in question.

In relation to disputes on ownership of the invention, Article 110 of the IPL explicitly rules that:

“Allegations, that an applicant of a patent application in fact does not have the right to claim the patent, should not be made before the Patent Office. Until the contrary is proven, the applicant is deemed to have the right to claim patent.

Persons, who claim to be the true patent owners during patent application procedures, in accordance with the provision of Art. 109, paragraph 1, have to file a lawsuit before the competent court against the applicant and notify the Patent Office of such action. The court may decide to delay the patent granting procedures until the court’s ruling has become final.

In case the decision of the court is finalised in favour of the plaintiff (who claims ownership), within three months of the finalisation of the court decision the plaintiff can:

- (a) Demand that the pending application should be accepted as the patent application of his own.
- (b) File a new patent application for the same invention and claim priority from the same priority right. In this case, the date of patent application is accepted as the filing date of the first application and the first application is deemed invalid.
- (c) Demand that the pending application be rejected.

If the plaintiff fails to apply to the Patent Office within three months of the finalisation of the court’s decision, the patent application is considered to be withdrawn.

Persons who claim a partial right over the patent as co-inventors have the right to take the matter to court in accordance with paragraph 2.

Patent applications that are taken to court in accordance with paragraph 2 cannot be withdrawn without the approval of the plaintiff before the ruling becomes final.

If a patent is granted while court proceedings are ongoing, the case of unlawful application appropriation becomes a case of unlawful patent appropriation.”

On the other hand, as per Article 111 of the IPL, if a patent has been granted to a person other than the rightful owner, the person claiming to be rightfully vested with such right may file an action claiming the transfer of ownership of the patent without prejudice to his other rights and claims conferred by the patent.

Where only partial rights to the patent are claimed, a court action may be filed claiming joint ownership of the patent.

The right to raise such a claim and file such a court action as described above shall be exercised within two years following the date of publication of the patent or, in cases of bad faith, until the expiry of the term of protection of the patent.

At the request of the interested party, the court action and the claims put forward therein, the final ruling or any other action concluding the court action shall be registered in the Patent Register in order to have effect against third parties.

## 5.6 Is there a “grace period” in your jurisdiction, and if so, how long is it?

The IPL defines a priority period of 12 months in Article 93. Accordingly:

“Any person or his successor who has duly filed an application for a patent or utility model in any state that is party to the Paris Convention or the Treaty Establishing the World Trade Organization, including Turkey, may benefit from the priority right within a period of twelve months as of the date on which the first application is filed for the purpose of submitting an application for the same invention in Turkey.

Real persons or legal entities who display the product comprising the subject of the patent or the utility model in the national or international exhibitions held in Turkey or in official international exhibitions or those regarded as official held in the countries party to the Paris Convention may benefit from the priority right on filing an application for receiving a patent or utility model in Turkey within twelve months as of the date of display in the relevant exhibition.”

## 5.7 What is the term of a patent?

The term of a patent is 20 years from the date of filing the application. It cannot be extended. (Article 101 of the IPL.)

## 6 Border Control Measures

### 6.1 Is there any mechanism for seizing or preventing the importation of infringing products, and if so, how quickly are such measures resolved?

Yes, a patent owner may apply to the Customs Office to seize or prevent the importation of infringing products. Such applications are very common but, in practice, not easy to enforce, because Customs staff are more familiar with trademark-related matters and it is difficult for them to understand and detect patent infringement.

## 7 Antitrust Law and Inequitable Conduct

### 7.1 Can antitrust law be deployed to prevent relief for patent infringement being granted?

IP courts do not handle antitrust law-related arguments. Interested parties may deploy antitrust law before the Turkish Competition Authority, or claim a damages action based on the Competition Act before commercial courts.

### 7.2 What limitations are put on patent licensing due to antitrust law?

To the extent of our knowledge, there has not yet been any case where patent licensing is limited due to antitrust law.

## 8 Current Developments

### 8.1 What have been the significant developments in relation to patents in the last year?

The Industrial Property Law (referred to as the IPL above) entered into force on 10 January 2017 and replaced the Patent Decree Law numbered 551. The IPL includes provisions regarding patents and also trademarks, geographical indications, designs and utility models.

With regard to patents, the major changes are:

- (i) The introduction of post-grant opposition proceedings, as explained under question 5.3 above.
- (ii) The abolition of seven-year patents.
- (iii) A revision of the compulsory licensing system, as explained under question 3.2 above.

### 8.2 Are there any significant developments expected in the next year?

We are awaiting developments regarding the functioning of the new three-tier appeal system. Since the appellate courts have only recently started to work and grant decisions, there is no established procedure for examination proceedings (e.g. expert examinations). We will discover procedural practice of the appellate courts in the following months.

In addition, we expect Regulations on the Implementation of the IPL to be published as there are many issues which are yet to be decided.

### 8.3 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

Very recently, in a patent invalidation action where the IP Court decided not to wait for the EPO proceedings and decided to render its final decision, as a last attempt to save the patent, the patent owner filed an application for the limitation of the claim set under Article 138/3 of the EPC. Limitation was based on the claim as allowed by the Opposition Division.

Surprisingly, but fairly, the court and the Institute accepted the claim limitation request of the patent holder. It was important to emphasise to the court that the claim set has become identical to the limited set of claims before the EPO.

This may lead us to a new era where there is a parallel between EPC and Turkish patent legislation and also the procedures to obtain a patent will complete each other, resulting in consistency between the claims of Turkish and referred European patents.

The recent decision of the IP Court and the Institute may also reduce the number of invalidation cases and save patent holders in the same situation from the invalidation of their patents by limiting the claims of the patent before EPO proceedings have been finalised or, more importantly, after they have been finalised.



### Selin Sinem Erciyas

Gün + Partners  
Kore Sehitleri Cad. No. 17  
34394 Zincirlikuyu  
Istanbul  
Turkey

Tel: +90 212 354 0000  
Email: [selin.yalincakli@gun.av.tr](mailto:selin.yalincakli@gun.av.tr)  
URL: [www.gun.av.tr](http://www.gun.av.tr)

Selin is a partner in the Intellectual Property Department, specialising in IPL and Life Sciences issues. Selin has been involved in a number of advisory and litigation matters in all fields of IP, and has handled hundreds of both contentious and non-contentious administrative oppositions, and court actions involving patents and trademarks. Selin has been involved in a number of patent infringement actions, declaration of non-infringement actions and nullity actions.

She represents a number of multinational pharmaceutical companies before the Ministry of Health in relation to regulatory issues and assists pharmaceutical companies in regulatory examinations before the MOH.

Selin also served as a counsel to the Association of Research-Based Pharmaceutical Companies ("AIFD"). She represented the AIFD at the commission meetings of the Turkish Parliament on the draft IPL in Turkey.

Selin is a graduate of Ankara University and holds an LL.M. degree in European and International Commercial Law from Ludwig Maximilian University of Munich.



### Tuğçe Avcisert Geçgil

Gün + Partners  
Kore Sehitleri Cad. No. 17  
34394 Zincirlikuyu  
Istanbul  
Turkey

Tel: +90 212 354 0000  
Email: [tugce.avcisert@gun.av.tr](mailto:tugce.avcisert@gun.av.tr)  
URL: [www.gun.av.tr](http://www.gun.av.tr)

Tuğçe is a senior associate in the Intellectual Property Department and the Life Sciences working group of Gün + Partners. She has been involved in many trademark and patent law disputes as an IP litigator, and represented clients in numerous patent infringement, invalidation and declaratory of non-infringement actions.

She advises corporate clients from the life sciences sector, especially multinational pharmaceutical and medical device companies, the Association of Research-Based Pharmaceutical Companies ("AIFD") in Turkey. In her regulatory practice, she advises and represents her clients on a wide range of issues including clinical trials, marketing authorisation procedures, pricing and reimbursement regulations, and promotion practices. She assists clients in their day to day business activities; indeed she provided secondment to a global pharmaceutical company lately.

Tuğçe graduated from Österreichisches St. Georgs-Kolleg, Istanbul in 2006 and Koç University, Faculty of Law in 2011 with a "dean's honor" degree.

## GÜN + PARTNERS

AVUKATLIK BÜROSU

Gün + Partners is a full-service institutional law firm with a strategic international vision, providing transactional, advisory and dispute resolution services.

It is one of the oldest and largest law firms in Turkey, and is internationally recognised among the top-tier legal service providers in the country. The firm is based in Istanbul, with working and correspondent offices in Ankara, İzmir and the major commercial centres in Turkey. The firm advises a large portfolio of clients in numerous fields of activity, including life sciences, energy, construction & real estate, logistics, technology, media and telecoms, automotive, FMCG, chemicals and the defence industries. Lawyers in the firm are fluent in Turkish and English and also work in German, French and Russian.

The firm is ranked among the top-tier legal service providers in Turkey by international legal directories for a period surpassing 10 years, including being consistently ranked as the leading IP practice firm. Senior associates and partners in the firm are recommended as key individuals in their respective fields of expertise.

### Other titles in the ICLG series include:

- Alternative Investment Funds
- Anti-Money Laundering
- Aviation Law
- Business Crime
- Cartels & Leniency
- Class & Group Actions
- Competition Litigation
- Construction & Engineering Law
- Copyright
- Corporate Governance
- Corporate Immigration
- Corporate Investigations
- Corporate Recovery & Insolvency
- Corporate Tax
- Cybersecurity
- Data Protection
- Employment & Labour Law
- Enforcement of Foreign Judgments
- Environment & Climate Change Law
- Family Law
- Fintech
- Franchise
- Gambling
- Insurance & Reinsurance
- International Arbitration
- Lending & Secured Finance
- Litigation & Dispute Resolution
- Merger Control
- Mergers & Acquisitions
- Mining Law
- Oil & Gas Regulation
- Outsourcing
- Pharmaceutical Advertising
- Private Client
- Private Equity
- Product Liability
- Project Finance
- Public Procurement
- Real Estate
- Securitisation
- Shipping Law
- Telecoms, Media & Internet
- Trade Marks
- Vertical Agreements and Dominant Firms



59 Tanner Street, London SE1 3PL, United Kingdom  
Tel: +44 20 7367 0720 / Fax: +44 20 7407 5255  
Email: [info@glgroup.co.uk](mailto:info@glgroup.co.uk)