

# Turkey

by  
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Özge has been involved in leading numerous patent infringement and validity actions against generic pharmaceutical companies. She was involved in the first-ever pharmaceutical data exclusivity actions in Turkey. She has been a member of Turkish and Istanbul Bar Unions, International Bar Association (Vice-Chair Patent Sub-committee, Co-chair World Life Sciences Conference), AIPPI, INTA and LES.

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*Gün + Partners*

*Gün + Partners* is a full-service institutional law firm with an international and strategic vision.

The firm is one of the oldest and largest law firms in Turkey with over seventy lawyers and is ranked among the top tier legal service providers.

The firm is based in Istanbul, with working offices in Ankara, Izmir. It provides services to local and international companies throughout Turkey.

The firm's lawyers are fluent in Turkish and English and also work in German, French and Russian.

The firm's core areas of expertise are corporate and commercial, dispute resolution and IP. It represents clients in numerous sectors with a particular focus on life sciences, insurance and reinsurance, energy and natural resources, Technology, Media and Telecommunication.

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# Turkey

## (1) APPLICABLE LAWS

**1** The Industrial Property Code No. 6769 (the IP Code), which was prepared by the Turkish Patent and Trademark Office (the Office), is the main legislation in Turkey codifying all kinds of IP rights in Turkey. The IP Code which has abolished previous IP related Decree-Laws entered into force on 10 January 2017 upon publication in the Official Gazette.

**2** The IP Code regulates all IP rights in a single code. It is divided into five chapters, and the first four chapters of the law relate to trademarks, geographical indications, designs and patent rights, respectively. The principles, rules and conditions regarding the protection of patents are stated in Book 4 of the IP Code.

**3** Even though the Law abolished the IP related Decree-Laws, according to provisional Article 1 of the IP Code, provisions of the Decree-Laws will be implemented for applications filed before the enforcement date of the Code until their registration processes complete.

**4** Indeed, the IP Code was prepared to achieve harmony with recent developments in European Union (EU) IP law, to restore the gaps due to the decisions of the Constitutional Court annulling various provisions of the Decree-Laws and to make the relevant regulations clearer, more understandable and more systematic, as stated in its preamble.

**5** The IP Code also refers to the provisions of the Code of Civil Procedure numbered 6100 (CCP) which is the main legislation regulating the procedural rules for civil actions; thus, CCP also applies in IP matters.

**6** Turkey, as a member of Customs Union, has acceded to almost all international treaties relating to the field of IP. Of these treaties, the Strasbourg Agreement, the Budapest Treaty, the Paris Convention, the Patent Cooperation Treaty, the European Patent Convention, and the World Trade Organization (WTO) and Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement are the most well-known.

**7** In the event of a conflict between international agreements on fundamental rights and freedoms that have properly been ratified and other domestic regulation, Article 90 of the Constitution provides for the prevalence of the provisions of the international agreement.



## (2) ENTITLEMENT

### (2.1) COMPENSATION

**8** Articles 113 *et seq.* of the IP Code govern employee inventions and foresee compensation for inventors who are employees.

**9** If an employee makes an invention in the course of his duties for an enterprise or public administration, or an invention that is based to a large extent on the work and experience of the enterprise or public administration, or makes an invention in the course of an ongoing work relationship, this invention is acknowledged to be a service invention. In either case, the invention must have been completed in the course of the employment relationship to be categorized as a service invention.

**10** According to the IP Code, the inventor employee is obliged to notify the invention made to the employer in writing without any delay. Upon service of this notification to his side, the employer should notify the employee whether he claims full or partial right on the service invention, in writing within four months as of the date the employee's notification reaches him.

**11** If the employer claims full rights to the invention, the inventor may claim a reasonable payment from the employer. On the other hand, if the employer claims partial rights to the invention and uses it, the inventor will have the right to claim a reasonable payment from the employer. The calculation of such payment is based on how well the invention can be commercialized, the position of the inventor in the enterprise and the contribution of the enterprise to the invention.

**12** The Regulation on Employee Inventions, Inventions Realised within Higher Education Institutions and Inventions Arisen from Projects Supported by Public Authorities entered into force on 29 September 2017.

**13** It should be highlighted that the new regulation establishes rules foreseeing that any dispute that falls under the scope of the regulation must be solved via arbitration; however, the particulars of such arbitration dealing with employee invention is not regulated until today. Having said that, it is legally impossible to introduce compulsory arbitration via regulations. Section 8 of the new regulation and many other provisions that will be affected by it are subject to cancellation actions before the Council of State on the grounds that the regulation exceeds the authority permitted by law and violates the Constitution. These actions are still pending before the Council of State.

**14** It is important to note that, after claiming rights on the service invention, the employer cannot free himself from paying the claimed amount by arguing that the invention is not worth protecting unless a court decides that the patent is not worth protecting. The IP Code foresees that the amount and method of the payment will be determined in accordance with the contract or other legal agreement between the employer and employee if there is any.

**15** In Turkey, there is no significant precedent regarding employee inventions and relevant payments; most of the disputes between the employee and employers are resolved amicably.

## (2.2) DERIVATION

**16** Article 109 of the IP Code foresees that the person submitting the initial application for a patent has the rights in relation to the patent unless the contrary is proven. That is to say, the IP Code contemplates a ‘first to file’ as opposed to a ‘first to invent’ system. Inventors or their successors are entitled to allege derivation of the patent entitlement

**17** The allegation that an applicant is not entitled to claim patent rights on the invention may be brought before the competent IP courts, and the Office must be notified of the action. If the court accepts the action filed by the third party claiming to have entitlement and accepts his entitlement on the patent, then, remedies available against the abusive patent applicant will differ depending on whether the patent is registered or pending before the Office.

**18** If the abusive patent application is still ongoing at the time of the Court decision, then, the court-approved right owner will have three rights of choice. He may (i) request the Office to register and process the patent application in his name, (ii) submit a new patent application for the same invention making use of the same priority right or (iii) request the Office to reject the application, by applying to the Office.

**19** In case the court-approved right owner wants to submit a new patent application for the same invention making use of the same priority right, this application will be processed as of the date of the initial abusive application, and the said application will be considered invalid. The court-approved right holder should apply to the Office within three months as of the finalization of the Court decision about the true right holder. A Court decision will be accepted as final if no appeal is filed in due time, or, when the Court of Appeal renders a final decision on the appeal(s) filed. If no application is made to the Office, within three months, the disputed application will then be considered as withdrawn.

**20** As per Article 111 of the IP Code, if the abusive patent application is finalized and the patent is registered in the name of the deriver, then the right holder can request the re-assignment of the patent to himself. In principle, the entitled person should file the action on the derived patent within two years of the publication of the patent as registered; however, this limitation does not apply for malicious patent registrations.

**21** As detailed under section 2.1 Compensation, if an employee makes an invention that would be accepted as a service invention and the employee claims ownership on the invention by following the route set out in the IP Code, the patent owner would be legally registered as the employer and the employee should be compensated reasonably. However, in case the employer does not claim rights on the invention within legal terms once it is notified of the invention, then the invention will be accepted as a free invention. After this point, the employer cannot file a patent application for that invention and the employee can start entitlement proceedings against the employer (*see* Smart Chart: Compensation).

## (2.3) APPLICANT

**22** According to Article 109 of the IP Code, the rights to a patent will belong to the inventor or his successor in title and will be transferable. Where an invention has been made jointly by more than one person, unless foreseen otherwise by the parties, the right to request a patent will belong to them jointly. Where an invention has been made

independently by several persons at the same time, the right to a patent will belong to the person who files the first application or who can claim an earlier priority right.

**23** The person who is the first to apply for a patent will be vested with the right to request the patent until proof to the contrary is established. As per Article 138 of the IP Code, the filing of the patent application by a non-entitled person may result in the invalidity of the patent.

## **(2.4) EMPLOYEE**

**24** As per Article 2 of the Labor Code No. 4857, an employee is defined as a person working based on an employment contract. According to the IP Code, employee inventions may be classified as service inventions or free inventions.

**25** Service inventions are inventions that are made by the employees during the term of their employment, in either a private enterprise or public authority, while performing, as of their obligation, the tasks they have been assigned to or which are based to a great extent on the experience and work or activity of the private enterprise or public authority. An employee that has made a service invention will be under the obligation to report, without delay, the invention to his employer in writing.

**26** An employer may claim rights, in part or in whole, to a service invention. The employer should notify the employee of such a claim in writing and must make his claim within four months from the date of receipt of the employee's report by the employer. Where the employer claims rights of ownership on the service invention, the employee will have the right to a reasonable fee. For further information, *see* Smart Chart: Compensation.

**27** Employee inventions not falling under the scope of service inventions will be deemed to be free inventions. An employee who has made a free invention during the term of an employment contract must notify the employer without delay. Where the invention falls within the field of activity of the employer's enterprise or where the employer's enterprise was in serious attempts to become active in the field of the invention, the employee will be under the obligation to make an offer to the employer, on a non-exclusive basis, to benefit from the invention on reasonable terms.

**28** The above-described rules regarding the employee inventions apply to the inventions made by employees of universities and public administrations having a task of research or to inventions that are the outcome of projects supported by public institutions and organizations unless they contradict with the special provisions foreseen in the Article 121 and Article 122 of the IP Code. For further information, *see* Smart Chart: Education/Research.

## **(2.5) EDUCATION/RESEARCH**

**29** The IP Code foresees great amendments on the provisions regarding the inventions made by employees of universities as a result of their scientific work and researches of the abolished Patent Decree-Law.

**30** Article 41 of the abolished Patent Decree-Law, was foreseeing that the inventions made by the university employees as a result of their scientific work and research, were free

inventions. That is to say, the university employees were the owner of all of the material and moral rights on the invention. However, with the new IP Code, the system which is similar to the employee invention system is adopted. *See* Smart Chart: Compensation and Smart Chart: Employee.

**31** According to Article 121 of the IP Code, university employees are obliged to immediately report the invention and the patent application, if any, in writing to the university. If the university claims rights on the invention, it is obliged to file a patent application for the inventions made by the university employees. Failing to file such application will convert the employee's invention to a free invention. The income from the invention is shared among the institution of higher education and the inventor, with the inventor receiving at least one-third.

**32** According to Article 121 of the IP Code, with respect to inventions made by members of the academic staff, by internees or students as a result of contract-based work at other public institutions or for private organizations, the rights ownership is defined on the basis of the contract provisions, with the provisions of other laws reserved. The provisions regarding employees, which are not university staff, also apply to the inventions of students and internees who work without pay and without a defined time limit, working in the workplace of the Employee.

## **(2.6) TEAMWORK**

**33** According to Article 109 of the IP Code, if the invention is the work of more than one person, each of them has rights with respect to a patent for such invention, unless otherwise agreed by the parties. If a patent application or a patent is owned by more than one person without being divided, the co-ownership is governed by the agreement between the parties, if no such agreement exists, by the provisions of Turkish Civil Code on shared ownership.

**34** According to Article 112 of the IP Code, every right holder is entitled to (i) freely dispose of his share, (ii) use the invention upon notification to the other co-owners, (iii) take necessary measures to protect the patent application or the patent and (iv) initiate legal proceedings against third parties suspected to violate any rights granted with the patent application or the patent. However, in filing such an action, the plaintiff is obliged to inform the other right holders of the action within one month from the date of filing of the action.

## **(2.7) ENTITLEMENT CLAIMS**

**35** In relation to disputes on ownership of the invention, Article 110 of IP Code reads:

- (1) Allegations that an application owner has no patent claim right cannot be made to the Institute. Until the contrary is proven, the application owner is considered to have a claim to the patent right.
- (2) Persons who, during patent application procedures, in accordance with the provision of Art. 109, paragraph 1, claim to be the true patent owners have to file a lawsuit against the application owner and notify the Office about it. The court may decide to suspend the patent granting procedures until the court's ruling has become binding.

- (3) If the plaintiff wins the rights ownership case, the court-approved rights holder must, within three months of the ruling becoming binding, proceed as follows with respect to the still valid application:
  - (a) request the Office to register and process the patent application in his/her name.
  - (b) submit a new patent application for the same invention making use of the same priority right, if applicable.
  - (c) request the Office to reject the application.
- (4) Applications under paragraph 3b are processed as of the date of the initial application. In this case, the initial application is considered invalid.
- (5) If the plaintiff and true rights owner fails to apply to the Office within three months of the court ruling becoming binding, the disputed application is considered withdrawn.
- (6) Persons who claim a partial right in the patent as co-inventors have the right to take the matter to court in accordance with paragraph 2.
- (7) The provisions of paragraph 3 also apply to divided applications in accordance with Art. 91.
- (8) 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 binding.
- (9) If a patent is granted while court proceedings are ongoing, the case of unlawful application appropriation becomes a case of unlawful patent appropriation.

**36** On the other hand, as per **Article 111 of the IP Code**, if a patent has been granted to a person other than the rightful owner, the person who alleges to be the legitimate proprietor of such right may file an action claiming the transfer of ownership of the patent without prejudice to his/her 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.

**37** 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 an effect against third parties.



### **(3) SCOPE OF PROTECTION**

#### **(3.1) CLAIMS, DESCRIPTION AND DRAWINGS**

**38** According to Article 89 of the IP Code, the scope of protection of a patent application or patent is determined by its claims. It is important to interpret the claims in a manner so as to provide protection to the applicant or patent owner and reflect a reasonable degree of precision in terms of the scope of the protection also for third parties.

**39** On the other hand, description and drawings should be used in the interpretation of the claims; they disclose means for performing the invention and therefore have a different role than the claims. According to Article 92 of the IP Code, claims should be grounded on the description and should not exceed the scope of the invention defined in the description.

**40** The interpretation of the claims should not be limited to the meaning assigned by the words used. In the designation of the scope of protection, the claims may not be expanded to include also features which have been considered by the inventor but not requested in the claims, yet may arise in the interpretation of the description and pictures by a person skilled in the relevant art.

#### **(3.2) PATENT AS GRANTED**

**41** In accordance with the framework foreseen in Article 101 of the EPC, a post-grant opposition system has been introduced to the Turkish Law with Article 99 of the IP Code. The aim of this is to lead to stronger patents or patents with a fairer scope of protection and adopt a system similar to the EU.

**42** The patent owner starts to enjoy the rights arising from the patent application as of the date of the publication of the patent application in the Bulletin. With the new post-grant opposition system introduced, the scope of protection of the patent application is determined by the claims in the application as published, for the time until the grant of the patent. However, if any amendment is made on the claims of the granted version of the patent or any amendment is made on the claims due to objections or invalidity claims of third parties, then, the scope of protection of the patent will retrospectively change in accordance with the new claim set.

**43** According to Article 103 of the IP Code, patent applications may be amended by the applicant owner while procedures regarding the application at the Institute are ongoing. In order to make a valid amendment, the amendment made should not exceed the scope of the initial application.

#### **(3.3) INTERPRETATION OF STATE OF THE ART**

**44** According to Article 83 of the IP Code, determination of the state of the art is important to determine whether the patented invention is novel and/or meets the inventive step criterion. Indeed, an invention which is not included in the state of the art is accepted

to be novel, and an invention that is not obvious to the skilled person in light of the state of the art and common general knowledge is accepted to be inventive.

**45** It is regulated that the state of the art is accepted to comprise information or data pertaining to the subject matter of the invention, accessible to the public in any part of the world, before the date of filing of the application for a patent by disclosure whether in writing, or orally, by use or in any other way. Other than this, the disclosures of national patent and utility model applications published on the date of the application or thereafter but dated back to before the application date are also considered as state of the art. However, pursuant to Article 83(5) of the IP Code, the content of these applications and documents which are considered to form the state of the art is not taken into account in the evaluation of the inventive step.

**46** Likewise, Article 84 of the IP Code regulates the ‘grace period’ for declarations made before application for a patent. Accordingly specific declarations are not deemed to destroy patentability of an invention under certain conditions, if:

- (1) the declaration is made by the inventor;
- (2) if the declaration is made by an authority to which patent application is submitted and the information declared by this authority comprises the following:
  - (a) the inventor has made another application and the referred application is disclosed by an authority although this should not have been disclosed;
  - (b) a third party who has acquired information directly or indirectly from the inventor has filed an application without the knowledge or permission of the inventor;
- (3) the declaration is made by a third person who has acquired information directly or indirectly from the inventor.

**47** Although Turkish IP Code does not specifically contemplate, for the purposes of determining the scope of protection, the extent to which the state of the art must be interpreted, it is accepted in the Turkish Patent and Trademark Office Examination Guidelines and in the 11th Civil Chamber of the Turkish Court of Appeals’ decision dated 24 April 2019 and numbered 2018/302E, 2019/3175 K that the state of the art should be evaluated without falling into a hindsight bias and the state of the art should be evaluated by considering the state of the art before the applicant’s contribution.

### **(3.4) CRITERION FOR SCOPE OF PROTECTION**

**48** As elaborated above in section 3.1, the scope of protection of a patent application or a patent is determined by its claim(s) which are in turn interpreted in consideration of the description and drawings. Claims should be interpreted in a manner so as to permit, on the one hand, fair protection for the rights holder of a patent application or of a patent, while, on the other hand, providing a reasonable degree of certainty to third parties about the scope of protection.

**49** Claims should not be interpreted as confined to their strict literal wording. However, for determining the scope of protection of a patent application or of the patent, where those features, though contemplated by the inventor, are not expressed in the claim(s) but are only revealed upon interpretation of the description and drawings by the person skilled in the art, the claim(s) should not be deemed to include/cover those features. On the other

hand, while determining the extent to which protection is conferred, due account must be taken of any statements made by the applicant during the patent granting procedures or by the holder of the patent during the term of validity of the patent.

**50** Where a patent contains examples of the embodiment of the invention or examples of the functions or results of the invention, the claims must not be interpreted as being limited to those examples. The mere fact that the product or process has features not explained in the examples in the patent document or features that do not comprise the characteristics explained in the examples or that do not achieve each and every result indicated in the examples does not bring the product or process outside the scope of protection granted by the claims.

### **(3.5) ROLE OF PROSECUTION HISTORY**

**51** According to Article 89(6) of the IP Code, the declarations of the patent applicant or patent owner will be taken into account in the designation of the scope of protection during the transactions related to the grant of the patent for designating the scope of the claims or throughout the period of validity of the patent.

**52** However, in considering the statements and explanations made by the patent owner in the process of the examination and registry of the patent application, the provision aims to prevent the inclusion in the scope of protection of elements disowned by the patent applicant or holder that might otherwise have been considered to be within the scope of protection in accordance with the ‘doctrine of equivalents.’

**53** According to case law of the Court of Appeal dated 8 March 2012 with merit number 2012/9682 and decision number 2013/11217 and Istanbul 2nd Civil Court of Intellectual and Industrial Property Rights’ decision dated 9 July 2015 with merit number 2012/226 and decision number 2015/169 (similar to the doctrine of ‘prosecution history estoppel’), the holder’s position on the patent scope at the moment of assessing the validity of the patent is relevant when deciding on the existence of infringement and, in particular, when applying the doctrine of equivalents.

**54** In other words, prosecution history is not considered when determining the scope of protection of a patent, but, it is considered within the framework of ‘doctrine of equivalents’ when there is an infringement allegation grounding on the doctrine of equivalents.

### **(3.6) EQUIVALENTS**

**55** The protection granted by a patent is not limited to the products or processes that are covered by the literal meaning of the claims but extends to realizations of the claimed teaching with equivalent means.

**56** Article 89(5) of the IP Code foresees that the elements qualified as equivalent to the elements indicated in the claims on the date when the existence of infringement was asserted shall be taken into account in determining the scope of protection provided by the patent application or the patent. The decision of the 11th Civil Chamber of the Turkish Court of Appeals, dated 29 March 2017 and numbered 2015/14058E, 2017/1789 K reveals the fact that the so-called *element by element* approach is accepted in Turkish Law.

**57** If an element actually has the same function as an element requested in the claims, performs that function in the same manner and provides the same result, that element is generally accepted as the equivalent of the element requested in the claims. The decision of the 11th Civil Chamber of Turkish Court of Appeals, dated 24 December 2015 and numbered 2014/18840E, 2015/13906K, and the decision dated 18 December 2017 and numbered 2016/5160E, 2017/7347K, reveals that the cumulative presence of these three conditions is essential for the acceptance of equivalency.

### **(3.7) NON-INVENTIVE APPLICATION OF STATE OF THE ART**

**58** It is legally possible for a party who allegedly infringes a patent to show that he practices the prior art or a non-inventive variant of the prior art so that no infringement can be found, however, there is no explicit provision governing this defence or any reported precedent in Turkish Law.

### **(3.8) TRANSLATIONS**

**59** According to Article 90 of the IP Code, the description, claims, abstract, and pictures, where available, may be submitted in one of the official languages of the states which are party to the Paris Convention or the Treaty Establishing the WTO or apply the principle of reciprocity. However, according to Article 95 of the IP Code, the Turkish translation of the patent documents should be submitted to the Office within two months as of the application date without requiring any notification, and the failure to submit the translations within this term will result in the consideration of the application as withdrawn.

**60** The translation of a patent document has significant importance for the determination of the scope of protection of a patent filed in Turkey through the European Patent Convention. With regards to a patent application filed in Turkey through the European Patent Convention, the legal framework has been regulated with the Regulation on the Application of the European Patent Convention in Turkey.

**61** According to the Regulation on the Application of the European Patent Convention in Turkey, if the conditions in Articles 12 and 13 of the Regulation are fulfilled, a European Patent will be treated as a national patent in Turkey.

**62** Article 12 of the Regulation states that ‘the Turkish translation of European Patent certification including the description claims and the drawings should be submitted to Turkish Patent and Trademark Office within three months from publication of the acquisition of European Patent right.’ According to Article 13 of the Regulation, the translation of the European Patent should be published by the Turkish Patent and Trademark Office and announced in the Official Journal of the Turkish Patent and Trademark Office. The holder of the European Patent will start to enjoy the rights arising from its patent application as of the publication of the translation of the patent document.

**63** Where an amendment is made on the patent document as per European Patent Convention Article 101 or the scope of protection of the patent is limited as per the European Patent Convention Article 105a, the patent holder should submit the revised

Turkish translation of the patent document to the Turkish Trademark and Patent Office within three months starting as of the publication of the amendment in the European Patent Journal.

**64** Most importantly, if the scope of protection of a European Patent derived from the Turkish translation of the patent document is narrower than the original language of the patent document, then the Turkish translation will prevail when determining the scope of the protection of the patent.

### **(3.9) NATIONAL (NON-EUROPEAN) PATENTS**

**65** Patent registrations may be obtained either through a direct application to the Turkish Patent and Trademark Office, through the Patent Cooperation Treaty, or through the European Patent Convention. If the application is filed directly with the Turkish Patent and Trademark Office, the Turkish Patent and Trademark Office examines the patent applications with regards to the required formalities within one to two months of the application date. There is no significant difference for the purposes of this chapter between European Patents and Turkish National Patents.



## (4) INFRINGEMENT

**66** The statutory provisions on infringement are found in Article 141 of the IP Code.

### (4.1) DIRECT INFRINGEMENT

#### (4.1.1) Products

**67** A broad protection has been conferred to the patent holder with Article 141 of the IP Code. It should be noted that although there are a few exceptions (*see* Smart Chart: Further Exceptions to Infringements), almost every unauthorized use of a patented invention or every unauthorized transaction regarding the patented invention constitutes an act of infringement.

**68** The most common infringement to patent rights occurs with partial or complete production of a patented product by a third party without the consent of the patent holder. However, there is ambiguity regarding the meaning and scope of 'partial production of a product' and there is no case law shedding light on the issue in Turkish Law.

**69** Other than the production of a patented product, if a third party who knows or should have known due to their position, education, etc. that the product at hand is a complete or partial imitation of a patented product, then, selling, distributing, carrying the product, or trading is also accepted as infringement to patent rights. This provision is in line with Article 45 of the TRIPS which reads:

The judicial authorities shall have the authority to order the infringer to pay the right holder damages adequate to compensate for the injury the right holder has suffered because of an infringement of that person's intellectual property right by an infringer who knowingly, or with reasonable grounds to know, engaged in infringing activity.

**70** The expansion of a licence or a compulsory licence without permission or assignment of the licence right to the third party without permission and the usurping of the right of patents are listed as acts of patent infringement (*see* Smart Chart: Licensing).

**71** The patentee has the right to control the import and export of products which fall within the scope of the patented invention. If third parties import the infringing product outside of Turkey, notwithstanding their use or production of the product in Turkish territory, this will constitute the infringement of patent rights.

**72** Likewise, although there is no provision for it in Turkish Law, the transit of patented products must be considered as an act of patent infringement. Although there is no established Court of Appeal precedent on this matter, there are several precedents putting forward that the transit of products subject to trademark protection will infringe trademark rights.

**73** Although there is no reported precedent for patent rights, the decision numbered 2002/553E, 2002/753K and dated 1 February 2002 of the 11th Civil Chamber of Court of Appeal regarding the transit of the products under trademark protection makes it clear that the transit of patented products would also infringe patent rights. It is clear that no exemption has been granted in the related code for the use and protection of the trademark right with regards to the principle of territoriality.

**74** In addition, it is regulated when the rights born from trademark rights are counted in Article 9/2-c of the Decree-Law numbered 556 that the goods which bear the marks related to a registered trademark can be prohibited from importing and exporting. Also, it is accepted in the doctrine that the manners of infringement counted in the article are not exhaustive and the transit of counterfeit goods bearing this brand without the consent of the trademark holder will constitute an infringement of the brand. It is regulated in Article 61/c of the mentioned Decree-Law that if the individuals using the trademark itself or indistinguishably similar who know or can know the fact that the trademark is being imitated hold these products for commercial purposes, it also infringes the trademark right.

#### **(4.1.2) Processes**

**75** Article 141/1(c) of the IP Code stipulates that using the patented process or selling, distributing, or commercializing in any other way, importing for such purposes, or using by applying the products directly obtained through a patented process, without the consent of the patent holder, are deemed as acts of patent infringement. Importing an infringing product, even when the activities are carried outside of the jurisdiction, falls within the scope of the infringing acts regulated under Article 141 of the IP Code.

**76** In cases of process patents leading to the production of a new product, where that product is produced by a third party without permission from the patent holder, the product is presumed to have been produced via the patented process. This is a rebuttable presumption. In this case, the burden of proof is automatically reversed, and it is for the defendant party to prove that the patent containing the process has not been infringed. However, if the product manufactured with a patented process is not a new product, it is up to judge's discretion to decide whether the burden of proof is on the defendant.

#### **(4.1.3) Absolute Product Protection**

**77** There is no concept of absolute product protection under Turkish Law.

#### **(4.1.4) *De Minimis***

**78** '*De minimis*' defences are not stipulated in Turkish Law and there is not any relevant reported case law on the subject.

#### **(4.1.5) Biological Material**

**79** Biological material is defined in Article 2/(c) of the IP Code as material including genetic information which can reproduce by itself or can be reproduced in a biological system.

**80** Directive 98/44/EC on biotechnological inventions, aiming at harmonizing issues concerning patentability and scope of protection of patents regarding biological material, is not implemented in Turkey, which is not a party to the EU. However, Turkey is a party to the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure (1977). The legislation regarding biological materials adopted in the Turkish IP Code is similar to the legislation of the EU.

**81** Article 82/2 of the IP Code lists non-patentable findings. Accordingly, in Article 82 of the IP Code, it is regulated that except for microbiological processes or the products, plant

or animal varieties or biological processes for the production of plants or animals are not patentable. Microbiological process refers to any process comprising a microbiological material, performed with a microbiological process or as a result of which a microbiological material is composed and a plant or animal production method occurring essentially in a completely natural manner such as biological process, hybridization or selection.

**82** In other words, in principle, inventions related to biological materials are patentable under Turkish Law. However, limits and exceptions are also introduced in Turkish IP Law. Before anything else, an invention should not be violating public order or morality. Other than this, Article 82/3 of the IP Code foresees that inventions that are incongruous to public order and public morality, plant and animal species, essentially biological processes for the production of plants and animals, discovery of human body parts and cloning or genetic modification procedures for humans and animals are excluded from the patentable matters.

**83** If an invention related to a biological material does not face an obstacle in terms of Article 82 of the IP Code, it is patentable. However, special conditions are contemplated in Article 92 of the IP Code for the patent application procedures of an invention related to biological material. Accordingly, if the invention is related to a biological material which is not accessible by the public and which cannot be sufficiently defined in the patent application so as to be implemented by a person who is an expert in the technical field associated with the subject of the invention or involves the use of such material, it shall be accepted that the invention has been described sufficiently, if the referred material is deposited to an international depositary authority, in line with the provisions of the Budapest Treaty.

**84** A side note is that, if the biological material which has been deposited as per clause 3 of Article 92 of the IP Code is no longer accessible in the establishment of deposit, it shall be accepted that this access is not interrupted provided that this material is re-deposited in accordance with the Budapest Treaty and that a copy of the certificate issued by the deposit institution indicating that the material has been received is submitted to the Institute within four months as of the date of deposit upon specifying the number of the patent application or certificate.

#### **(4.1.6) Products Containing or Consisting of Genetic Information**

**85** Article 82/3(d) of the IP Code foresees that inventions related to human cloning processes, processes for modifying the germ line genetic identity of human beings, the use for human embryos for industrial or commercial purposes, processes for modifying the genetic identity which are likely to cause them suffering without any substantial medical benefit to man or animal and also animals resulting from such processes cannot be protected by a patent in Turkey.

**86** Other than the ones mentioned above, inventions containing genetic information are accepted as 'biological material'. Indeed, biological material is defined in Article 2/(c) of the IP Code as material including genetic information which can reproduce by itself or can be reproduced in a biological system. For detailed information regarding 'biological materials', *see* Smart Chart: Biological Material.

**87** Unfortunately, there is no case law regarding inventions containing or consisting of genetic information in Turkish Law.

## **(4.2) INDIRECT (CONTRIBUTORY) INFRINGEMENT**

**88** In Turkey, a party can be liable for infringement as an indirect infringer if a third person hands over to persons unauthorized to work 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, as per Article 86 of the IP Code. 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.

**89** Exactly what are ‘means relating to an essential element of the invention’ will be a question of fact in each case. Unfortunately, there is no established case law which sheds light on the meaning of this article.

## **(4.3) UNFAIR COMPETITION**

**90** IP Law and Unfair Competition Law have a complementary nature and are implemented cumulatively when an infringement to an IP law is at stake. The unfair competition provisions are contemplated under Articles 54 *et seq.* Turkish Commercial Code (TCC) in Turkish Law.

**91** The first condition of benefiting from the special and monopolistic rights arising from the IP Code is to have a registered patent right before the Turkish Patent and Trademark Office (The Office). On the other hand, the unregistered IP rights can benefit from the general unfair competition provision of the TCC.

**92** Indeed, an infringement to registered IP right constitutes a special appearance of an unfair competition; yet, rights arising from the IP Code are broader and directly applicable, compared to the protection arising from TCC. A person who wishes to ground their claims on the unfair competition provisions needs to prove unfair competition constituted to his detriment and his previous usages, rights, etc. proving his rights on a specific usage, trade dress, invention, etc. within the boundaries of the TCC.

**93** It should be noted that the IP right proprietor can benefit from the protection arising from the TCC and the IP Code at the same time. This is called the cumulative implementation of the Unfair Competition Law and IP Law, by some commentators. This cumulative implementation principle is put forth in the decision of 11th Civil Chamber of the Turkish Court of Appeals dated 11 February 2016 and 2015/3115E, 2016/1333K.

**94** However, although a person can ground his claims on the TCC and the unfair competition provisions and rights arising from the IP Code, the punitive consequences of these provisions will not be accumulated, as per the decision of 11th Civil Chamber of the Turkish Court of Appeals dated 14 July 2006 and 2005/5095E, 2006/8411K.

#### (4.4) UNJUSTIFIED THREATS

**95** In Turkish Law, there is no special provision regulating the unjustified infringement claims and its consequences. A patentee has the right to enforce its patent against infringers even if opposition and/or invalidity proceedings have been started either before the national Turkish Courts or before European Patent Office if an EP patent is at stake.

**96** However, in such cases, it is at the discretion of the court to continue to hear the patent infringement claims or a preliminary injunction request despite the ongoing opposition, appeal or invalidation action against the patent. It should be noted that Turkish IP courts confer a greater importance to invalidation actions ongoing against national patent registrations and tend to wait for the outcome of such action before continuing to hear the infringement claims or preliminary injunction decision, considering the retroactive effect of an invalidation decision.

**97** As per Article 139 of the IP Code, with compensation claims of aggrieved parties in case of bad faith or gross negligence on the part of the patent owner reserved, the retroactive effect of invalidity does not affect the following:

- (a) Final and executed decisions, regarding the infringement of patent rights, made prior to the patent invalidity ruling.
- (b) Contracts executed and implemented prior to the patent invalidity ruling.

**98** Although there is not a direct and explicit definition of bad faith in the TCC or the IP Code, commentators accept that a person who knows or should have known the fact that the granted patent right is unjustified and does not show reasonable care acts in bad faith. The commentators also accept that the degree of negligence of the right holder is not important for the acceptance of the bad faith, if he has not shown the necessary prudence in order to avoid the unlawful consequence, this shall be sufficient to accept the bad faith. The degree of his negligence, on the other hand, is important for the calculation of the compensation.

**99** It should be noted that the Turkish IP courts, in practice, tend to confer broad protection to patent holders and ignore whether they act in bad faith or not and deem their acts lawful if there is a valid patent right at the date of the claims asserted against third parties.

**100** On the other hand, in case an injunction is obtained, and the patent is later revoked, the patentee may be liable for damages as per general provisions of the Turkish TCC and Turkish Code of Obligations.

**101** Indeed Article 399 of the CCP, rules that, if it is later understood that the party requesting preliminary injunction was acting in bad faith at the time of the preliminary injunction request, or if the preliminary injunction decision is revoked ex officio, or upon the objection of the enjoined party, then the party who enjoyed the preliminary injunction decision will be liable of the damages incurred by the party receiving the injunction due to unfair preliminary injunction.

**102** Similarly, according to Article 329 of the CCP, the party who filed an action in bad faith or without having any rights may be held liable of the litigation expenses and the professional fee paid by the defendant to his lawyer. Moreover, the plaintiff may be condemned to pay a disciplinary penalty between TL 500 and TL 5,000.

## (4.5) ANTITRUST ISSUES

**103** IP courts do not handle competition law-related arguments. Interested parties may deploy antitrust law before the Turkish Competition Authority (TCA), or file an action for damages based on the Competition Act before commercial courts after the Competition Authority rules for the infringement of competition law.

**104** Turkish competition law legislation is very much in line with the relevant EU legislation (in other words, most parts of the Turkish competition legislation are almost direct translations of the relevant EU legislation). Furthermore, while preparing its decisions, the TCA is influenced by the relevant decisions of the EU Commission. Under certain circumstances, the exploitation or the enforcement of patents may be contrary to competition law.

**105** The TCA evaluates antitrust issues from two perspectives:

- (1) Article 4 – Agreements, Concerted Practices and Decisions of Associations of Undertakings limiting Competition between competitors.
- (2) Article 6 – Abuse of Dominant Position.

**106** Article 4 of the Competition Act prohibits all agreements and concerted practices between undertakings, and decisions of associations of undertakings which have as their object or effect the prevention, distortion or restriction of competition directly or indirectly in a relevant market for goods or services.

**107** However, according to Article 5 of the Competition Act, acts caught by Article 4 of the Competition Act may be exempted if one of the four conditions is met one of which is ‘ensuring new developments and improvements, or economic or technical development in the production or distribution of goods and in the provision of services.’ This provision must be taken into account when drafting patent licence agreements.

**108** On the other hand, Article 6 of the Competition Act prohibits the abuse, by one or more undertakings, of their dominant position in a relevant market.

**109** Enforcement of patent rights and its implications on competition law has become very important after the European Commission’s abuse of dominance case on AstraZeneca. The TCA published a pharmaceutical sector inquiry report having similar statements with respect to possible anti-competitive effects of enforcing patent rights, but there have been no clear findings or conclusion nor any precedent of the TCA in this regard. On the other hand, the TCA closely follows the case law in the EU and has a great amount of data regarding the activities of pharmaceutical companies practising in Turkey, thanks to the questionnaire answered by the companies during TCA’s sector inquiry.

**110** On 26 December 2019, the TCA issued its first decision regarding standard essential patents in *Koninklijke Philips N.V. v. Türk Philips A.Ş.* and decided that Koninklijke Philips N.V had abused its dominant position. The TCA imposed a penalty of 0.75% of its annual gross income generated by the end of the fiscal year 2018. The TCA decided that Turk Philips Ticaret A.Ş. had not violated the Competition Law No. 4054. The decision of the TCA will serve as a guideline for the evaluation of antitrust issues in the context of standard essential patents under Turkish law.

*Antitrust Concerns Regarding the Prevention of Parallel Imports*

**111** With Article 152 of the IP Code, a new system regarding the exhaustion of IP rights has been introduced into Turkish Law and the international exhaustion principle has been adopted with the national exhaustion system abandoned.

**112** According to the new international exhaustion system, the release of a product bearing the IP right anywhere in the world will be deemed sufficient for the exhaustion of the IP right in Turkey. In this respect, the parallel import of the goods into the Turkish market could not be prevented based on a patent or any other IP right and any attempt to do so can be deemed as a violation of the competition law.



## **(5) FURTHER DEFENSES TO INFRINGEMENT**

### **(5.1) INVALIDITY**

**113** Defence of patent invalidity may be raised either in a counteraction or in a separate action against the enforcement of the same patent. A patent may be invalidated on the grounds set forth in Article 138 of the IP Code. The counteraction should be pursued within the time period of filing the first response petition in the infringement action, as per Article 133/1 of the CCP. A separate invalidation action may be filed at any time (*see* Smart Chart: Invalidation Proceedings).

**114** It should be noted that it is at the discretion of the court to continue to hear the patent infringement claims or preliminary injunction requests despite an ongoing invalidation action against the patent. It should be noted that Turkish IP courts confer greater importance to invalidation actions ongoing against national patent registrations and tend to wait for the outcome of such action before continuing to hear allegations of infringement or preliminary injunction requests, considering the retroactive effect of the ruling for the invalidation of a patent.

**115** There is a restriction brought to invalidation actions in Article 138/2 of the IP Code. Accordingly, if the invalidation action is filed at a time where the post-grant opposition against the same patent is pending, the IP court must delay the invalidity proceedings until the outcome of the opposition or if an invalidation action is filed against the patent before the grant decision of the patent is published in the Official Trademark Bulletin; the Court should wait for the publication of the grant decision of the patent before handling the infringement action.

### **(5.2) RESEARCH EXEMPTION**

**116** According to Article 85/3(b) of the IP Code, the exclusive right of the patentee shall not extend to experimental acts including the patented invention. However, there is no reported case law regarding this exemption.

### **(5.3) BOLAR EXCEPTION**

**117** Article 85/3(c) of the IP Code rules that ‘the experimental activities including the experiments involving the invention being subject to a patent, licensing of pharmaceuticals and all necessary tests and experiments’ shall be left outside the scope of the rights conferred by a patent. This regulation is also known as the ‘Bolar Exemption’. This exemption was ruled under Article 75/1(f) of the abolished Patent Decree-Law Pertaining to the Protection of Patent Rights No. 551.

**118** The aim of the Bolar exemption is to prevent the indirect extension of the 20-year patent term which is granted to the patent holder by law as a consequence of the requirements of marketing authorizations and waiting periods for generics. In other words,

this exemption is intended to ensure commercialization of generic products right after the expiry of the protection term granted by a patent and without delay.

**119** The so-called Bolar exemption is the most frequently sought defence in infringement claims to the pharmaceutical patents. The Bolar exemption shall be deemed to have been exceeded once the commercial activities regarding the pharmaceutical subject to experimental activities are initiated. However, there are contradictory decisions rendered by different Turkish IP courts regarding the limits of this exemption. Indeed, while some of the IP courts evaluate entry into the reimbursement lists as a line crossed, some seek price approval, and some seek actual sales of the product.

#### **(5.4) LICENSE**

**120** In Turkish Law, there is no explicit provision defining licences as a defence to an infringement action; however, considering the nature of licence agreements, the existence of such an agreement is a very strong defence to a possible infringement claim indeed.

**121** According to Article 141/1(d) of the IP Code, '*extending contractual or compulsory licensing rights or to transferring such rights to third parties*' is counted as one of the acts infringing the patent rights of the patent holder. In other words, if the manufacture or marketing of the products exceeded the rights conferred on the licensee, e.g., in terms of territory or field of use, infringement may be found. The patent holder has, therefore, the right to sue based on patent infringement and, as regards the licensee, based on breach of contract as well.

#### **(5.5) COMPULSORY LICENSE**

**122** In Turkish Law, there is no explicit provision regulating compulsory licence as a defence to an infringement action; however, considering the nature of licence agreements, the existence of such agreement is a very strong defence to a possible infringement claim indeed.

**123** A licence agreement proves that the acts covered by the licence agreement, which would infringe the patent rights in normal conditions, would not infringe the patent right since some of the rights regarding the patent are exclusively or non-exclusively transferred to the licensee with a legal agreement.

**124** However, similar to a contractual licence, a compulsory licence also has its legal limits specified by the courts or the TCA, depending on the nature of the patent subject to the compulsory licence request (*see* Smart Chart: Compulsory License). In this respect, according to Article 141/1(d) of the IP Code extending compulsory licensing rights or transferring such rights to third parties is counted as one of the acts infringing the patent rights of the patent holder.

#### **(5.6) PRIVATE PRIOR USE**

**125** According to Article 87 of the IP Code, 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 or begin to use it in line with the measures adopted.

**126** However, the continuation of the use of the invention contained in the patent by the referred persons or its use in line with adopted measures shall be at a degree that fulfils the reasonable requirements of the establishment they own. The right originating from previous use cannot be licensed and may only be transferred with the establishment.

**127** Although there are several Turkish Court of Appeal decisions where this private prior use defence is put forth by the defendants who are faced with infringement claims such as the decision of the General Assembly of Civil Chambers dated 22 January 2014 and numbered 2013/11-1830E, 2014/31K, and the decision of the 11th Civil Chamber dated 4 December 2008 and numbered 2005/12087E, 2006/12725K, both of these decisions fail to evaluate this defence.

### **(5.7) EXHAUSTION**

**128** With Article 152 of the IP Code, a new system regarding exhaustion of IP rights was introduced into Turkish Law and the international exhaustion principle was adopted and the national exhaustion system abandoned.

**129** Article 76 of the abolished Patent Decree-Law Pertaining to the Protection of Patent Rights No. 551 titled 'Exhaustion of the Rights Conferred by a Patent' said that 'the acts relating to the patented products shall fall outside the scope of protection of the patent; after the product has been introduced into the market in Turkey by the holder of the relevant patent or with his/her consent.'

**130** However, Article 152 of the IP Code rules that 'after protected products have been brought to market either by the rights owner or, with the rights owner's permission, by third persons, actions regarding those products are not included in the scope of rights.' The preamble of this provision explicitly puts forth that the new legislation adopts the international exhaustion principle.

**131** Due to the recent change in the exhaustion system, there is not any updated TCA or Turkish Court of Appeal decision regarding the matter.

### **(5.8) FARMER'S PRIVILEGE**

**132** Farmer's Privilege, as a defence to patent infringement, has been codified in Article 85/4 and 85/5 of the IP Code. These provisions are newly introduced into Turkish Law; the abolished Patent Decree-Law Pertaining to the Protection of Patent Rights No. 551 did not regulate Farmer's Privilege as a defence.

**133** Accordingly, small farmers defined in Protection of Breeders' Rights for New Plant Varieties Act, dated 8 January 2004, No. 5042, are entitled to use the production material obtained from a product resulting from the production performed on the land he has cultivated himself with a patented product sold by the patent owner or with his permission or via another commercial method for new productions to be performed again on the land he is cultivating.

**134** Farmers are entitled to use for agricultural purposes the patented breeding or other animal reproduction materials sold by the patent owner or with his permission or obtained via other commercial means. However, this usage is limited; indeed, the right shall encompass the use of the animal or other animal reproduction material by the farmer for enabling him to maintain his agricultural activities.

**135** Due to the fact that the Farmer's Privilege system is a newly introduced system in Turkish Law, there is no Turkish Court decision regarding the matter.

### **(5.9) FURTHER EXCEPTIONS TO INFRINGEMENT**

**136** Apart from the above-mentioned exceptions to infringement, according to Article 89/6 of the IP Code, prosecution history estoppel arguments may be raised if the patent owner depends on infringement under the doctrine of equivalents (*see* Smart Chart: Role of Prosecution History).

**137** Another exception to infringement is regulated under Article 153 of the IP Code. Accordingly, the industrial property rights owner can neither file civil charges against persons who possess or use products, brought to market under violation of industrial property rights, to the extent of their personal needs only, nor can the industrial property rights owner report the case to initiate criminal charges.

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

## (6) LICENSING

### (6.1) VOLUNTARY LICENSE

**139** Article 48 of the Constitution of the Republic of Turkey titled ‘Freedom and Contract’ reads: ‘everyone has the freedom to work and conclude contracts in the field of his/her choice. Establishment of private enterprises is free’. Voluntary licence is a type of agreement signed between the patent right owner and a second party with their free will; it is an exercise of their constitutional right to contract.

**140** The general terms regarding voluntary licences are set forth in Article 125 of the IP Code. The Article reads as follows:

- (1) The patent application or the patent may become the subject of a licensing agreement.
- (2) Licences may be exclusive or non-exclusive. Licences are non-exclusive unless stated otherwise in the licensing agreement. The licensor can use the patented invention for own purposes or can issue licences to third parties. In the case of an exclusive licence the licensor can neither grant licences to other third parties nor use the licence himself unless this right has been explicitly reserved.
- (3) The contractual licence owners are neither allowed to transfer the licence rights to third parties nor to grant secondary licences, unless agreed otherwise in the licensing agreement.
- (4) The contractual licensee can freely use the patented invention for the entire patent term, unless agreed otherwise in the licensing agreement. The licensee must comply with the terms of the licensing agreement. In case of contravention, patent owners can claim their patent rights against their licensees.

**141** Accordingly, patent licence agreements transfer the rights to exercise some or all of the monopolistic rights to a third party, yet, the moral rights on the patent cannot be transferred with this agreement, and the patent owner preserves his title as a rights holder. It is at the complete discretion of the patentee to select the rights that will be subject to the licence agreement and limit the agreement as he wishes.

**142** The licensee should abide by the limits of the licence agreement and should not try to exercise rights that he is not authorized to exercise. Indeed, Article 141/1(d) of the IP Code, defines ‘*extending contractual or compulsory licensing rights or transferring such rights to third parties*’ as acts constituting an infringement to patent rights.

**143** Voluntary licence agreements do not have a fixed context, and they appear in different forms depending on the rights transferred to the licensee, the term of the agreement, its exclusivity, etc. The most common distinction in voluntary licences is the exclusive and non-exclusive licences, which is also referred to in the above-cited wording of Article 125 of the IP Code. A voluntary licence agreement is accepted to be non-exclusive, in principle, if there is no explicit provision determining the contrary.

**144** The exclusive licence agreement is the type of licence where the patent owner undertakes to refrain from granting licences on the same rights to third parties apart from the licensee and refrain from using the patent subject to the exclusive licence agreement. A non-exclusive licence agreement, on the other hand, does not confer these rights to the licensee, and the patent owner will be entitled to sign other licence agreements with third

parties about the same rights, and continue to use the patent that is the subject of the licence agreement.

**145** The rights conferred to an exclusive licensee are broader compared to non-exclusive licensees. Indeed, unless the licence agreement includes a provision to the contrary, the exclusive licensee is entitled to file actions, that the patent owner can file, against third parties engaging with the acts infringing the patent rights in its own name.

**146** However, the non-exclusive licensee cannot file infringement actions against infringers directly. As per Article 158 of the IP Code, the licensee must request the rights owner to file the necessary action for the termination of the infringement. If the patent owner does not file the requested action within three months or declines the request, then, the non-exclusive licensee will be entitled to file the necessary actions for the termination of the infringement. The licensee should enclose his initial notice to the patent owner with the action petition and inform the patent owner of the action filed.

**147** Regarding preliminary injunction requests, if there is a severe damage risk at stake, the non-exclusive licensee is entitled to file a preliminary injunction request and the main action following the preliminary action, if the request is accepted, before the competent IP courts. In this scenario, the non-exclusive licensee should fulfil the notification procedure, while the litigation is ongoing.

**148** As per Article 139 of the IP Code, the invalidation of a patent is retroactive in effect except for the following:

- (a) Final and executed decisions regarding the infringement of patent rights made prior to the patent invalidity ruling.
- (b) Contracts executed and implemented prior to the patent invalidity ruling.

**149** In this respect, if there is an executed and implemented licence agreement, this agreement will not be affected by the invalidation of the patent. However, compensation claims against the patent holder grounding on his bad faith will be preserved. Moreover, according to the same provision, the licensee may demand the partial or full return of the fee paid for the licence agreement.

**150** On the other hand, if it is determined that the alleged patent owner who has signed a licence agreement with a third party was not the rightful owner of the patent, with the recording of the new patent owner to the Official Patent Registry, the patent-related licences and other rights granted to third parties will lapse. However, Article 111/(6) of the IP Code rules that the licensee or the previously registered patent owner may request the true patent owner to grant them a non-exclusive licence provided they have begun to use the invention or have made serious preparations for its usage. This request must be placed by the previously registered patent owner within two months, and by licence holders within four months.

**151** As mentioned under Smart Chart: Antitrust Issues, Article 4 of the Competition Act prohibits all agreements and concerted practices between undertakings, and decisions of associations of undertakings which have as their object or effect the prevention, distortion or restriction of competition directly or indirectly in a particular market for goods or services. However, according to Article 5 of the Competition Act, acts caught by Article 4 of the Competition Act may be exempted if one of the four conditions is met one of which is *ensuring new developments and improvements, or economic or technical development in the production or*

*distribution of goods and in the provision of services*'. This provision must be taken into account when drafting patent licence agreements.

## (6.2) COMPULSORY LICENSE

**152** According to Article 129 of the IP Code, a compulsory licence will be granted, where any one of the following six circumstances exists:

- (i) Non-use of the patent.
- (ii) Dependency on the subject matter of patents.
- (iii) 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 through the 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.
- (vi) The patent holder engages in activities that prevent, distort or restrict competition while using the patent.

**153** Non-use of a patent by the patent owner has been set as a ground for the grant of a compulsory licence on a patent. The general outline of this ground was also present in the abolished Patent Decree-Law Pertaining to the Protection of Patent Rights No. 551, but it was limited to where the patent holder refrained from using the patent for three consecutive years. However Article 130 of the IP Code, titled 'Compulsory licensing in case of non-usage' extends the use criteria to hold that even if a patent has been used to some degree, if the use of the patent is not at a level that satisfies 'the needs of the national market', a compulsory licence may be granted.

**154** Further, with regards to compulsory licensing on grounds of non-use, Article 136 of the IP Code provides that if the patent holder later grants a commercial contractual licence to another in more favourable conditions than those in the compulsorily granted licence, the compulsory licence holder may ask for an alteration of the terms and conditions of the licence.

**155** In case of a breach of the compulsory license agreement, the licensor may apply to the court for the revocation of the licence where there is abuse or breach of the licence conditions. Indeed, Article 141/1(d) of the IP Code foresees that '*extending contractual or compulsory licensing rights or transferring such rights to third parties*' is an act constituting an infringement to patent rights. The Turkish Patent and Trademark Office published a list of patents for which no use declaration was filed within the time period foreseen in the IP Code. The list implied that a compulsory license opportunity might exist for those patents. Even if the term foreseen in the IP Code has expired and justification for not working is not submitted, it does not lead to an automatic compulsory licence as the patent holder may prove working or justify not working during court proceedings.

**156** Article 129 of the IP Code rules that the patent holder is allowed one month from the date of application for a compulsory licence to file submissions on his own position. Following this, the court will render a decision on whether to grant the licence within one month immediately following the filing of submissions. One set of circumstances

introduced entirely by the new Code is contained in Article 129(1)(e), which provides that compulsory licensing may be requested where the patent holder engages in anti-competitive behaviour when making use of his patent rights.

**157** Anti-competitive behaviour includes restricting, distorting or eliminating competition, which highlights the fact that intellectual and industrial property rights are contrary to the principles of competition law (*see* Smart Chart: Antitrust Issues).

**158** In practice, until today, compulsory licensing has been very rarely used. Only one case back in 1974 has been published about granting a compulsory license in a matter related to national security.

## (7) PATENTS AS PART OF ASSETS

### (7.1) ASSIGNMENT

**159** According to Article 148 of the IP Code, a patent application or a patent can be assigned to a third party. This assignment can be done without assigning the legal entity holding the patent rights.

**160** The assignment agreement should be in written form and notarized in order to be a valid agreement. Moreover, Article 125 of the Regulation on the Implementation of the IP Code foresees that an assignment fee should be provided in the assignment agreement; however, no upper or lower limit is set for the fee that should be paid. In practice, providing a symbolic amount is deemed to be sufficient to fulfil this requirement.

**161** Article 148 of the IP Code provides that the assignment will be recorded in the Register. The assignment is published in the Official Patent Bulletin upon request of one of the parties when the official fee is paid, and all other conditions are fulfilled. If the assignment is not registered in the Registry, then the rights arising from the non-registered transaction cannot be enforced against bona fide third parties.

**162** If there is more than one owner of a patent and (one of) the co-owner(s) wants to fully or partially assign their rights to a third party, the other owners have the right of pre-emption (*see* Smart Chart: Entitlement). The assignment should be notified to the co-owner(s) of the patents either by the assignor or by the assignee, and the right of pre-emption will end three months after the notification by the rights owner about the intended assignment, and in any case two years after the assignment.

**163** According to Article 127 of the IP Code, if, after the assignment of the patent application or registration, it is understood that the assignor was not authorized to carry out this transaction, that person will be held liable for his actions with respect to the related parties.

### (7.2) CO-OWNERSHIP

**164** According to Article 112 of the IP Code, where a patent application or a patent is owned by more than one person without segregation, this joint ownership will be governed by the agreement concluded by and between the parties. In the absence of such agreement, the rights of the joint owners will be determined according to the general provisions of the Turkish Civil Code on joint ownership.

**165** Independently from the other joint owners, every rightful owner is entitled to dispose his share on the patent, use the invention following the notification to the other joint owners, take the necessary measures to protect the patent application or patent and file civil or criminal actions against third parties who infringe, in any way, the rights conferred by the jointly filed application or the jointly owned patent.

**166** It is important to note that the party initiating such legal proceedings must notify the other right holders of the action taken within a month of filing, in order to enable them to join the action.

**167** A licence, on the other hand, may be granted to third parties to use the invention upon a joint decision by the rights holders. However, the court may grant this authorization to one of the right holders alone in consideration of the existing circumstances and equity.

**168** According to Article 147 of the IP Code, if a patent application is owned by more than one person, all procedures, with the exception of withdrawal and waiver requests, are carried out by a joint representative of the rights holders, unless a patent representative has been appointed. However, if the rights owners do not appoint a joint representative, the first named rights owner in the application form is considered their joint representative.

**169** There is not much reported precedent regarding this topic in Turkish Law.

### **(7.3) SURRENDER**

**170** The owner of the patent who is entitled to dispose of the rights arising from the patent is entitled to surrender his patent. Surrender of the patent is listed under Article 140 of the IP Code as one of the termination reasons of the patent right.

**171** The patent holder may surrender his rights on the patent, in whole or in part for one or more than one claim. However, if the patent is surrendered in part, the remaining claims of the patent must be sufficient to constitute the subject matter of another patent, and the surrender of rights will not result in any extension of the scope thereof.

**172** Article 140 of the IP Code also foresees formal requirements for a valid surrender of patent rights. Accordingly, the transaction of surrender must be notified to the Turkish Patent and Trademark Office in writing. However, the consent of the licence holders and other right owners on the patent, such as co-owners, is required for the acceptance of the request to surrender a patent.

**173** The transaction of surrender will be effective as of the date of publication of the transaction in the Official Patent Bulletin.

### **(7.4) SECURITY RIGHTS**

**174** According to Article 148 of the IP Code, a patent application or a patent may be used as security.

**175** The agreement regarding usage of the patent as security should be in written form and notarized. Moreover, Article 148 of the IP Code foresees that the assignment will be recorded to the Registry and published in the Official Patent Bulletin upon request of one of the parties if and only if the fee is paid and all other conditions are fulfilled.

**176** If the transaction is not registered in the Registry, then the rights arising from the non-registered transaction may not be enforced against bona fide third parties. Since the payment of a fee is set as a condition for a registrable transaction related to security rights, providing a symbolic amount will be sufficient to meet this criterion.

**(7.5) ATTACHMENT**

**177** There are no special provisions governing the attachment of a patent registration or application in the Turkish IP Code. However, a patent, which is a form of property, may be subject to attachment provisions governed in the Turkish Civil Code.



## **(8) PATENT LITIGATION**

### **(8.1) PLAINTIFF**

#### **(8.1.1) Owner**

**178** The owner of the patent is the person entitled to enforce its rights arising from the patent against third parties. Indeed, as per, Article 149 of the IP Code real or legal entities whose IP rights are infringed are entitled to file an infringement action.

**179** Article 109 of the IP Code foresees that the person submitting the initial application for a patent has the patent claim right unless the contrary is proven. In this respect, the registered owner of the patent is accepted to hold the right to file actions regarding the patent. In such case, the inventors or their successors are entitled to allege derivation of the patent entitlement (*see* Smart Chart: Derivation).

#### **(8.1.2) Co-owner**

**180** According to Article 112 of the IP Code, each co-owner can independently from the other co-owners take the necessary measures to protect the patent application or patent and file civil or criminal actions against third parties who infringe, in any way, the rights conferred by the jointly filed application for patent or the jointly owned patent. The party initiating such legal proceedings should notify the other right holders of the action taken within one month as of the date of filing of the action to enable them to join the action.

#### **(8.1.3) Exclusive Licensee**

**181** As per Article 158 of the IP Code, unless the licence agreement includes a provision to the contrary, an exclusive licensee is entitled to file actions that the patent owner can file, against third parties engaging with the acts infringing the patent rights in its own name.

#### **(8.1.4) Non-exclusive Licensee**

**182** The non-exclusive licensee cannot file actions against infringers directly. As per Article 158 of the IP Code, the licensee should request the rights owner to file the necessary action for the termination of the infringement. If the patent owner does not file the requested action within three months or decline the request, then, the non-exclusive licensee will be entitled to file the necessary actions for the termination of the infringement. The licensee should enclose the request made to the right owner with the action petition of the infringement action and inform the patent holder of the action filed.

**183** Regarding preliminary injunction requests, if there is a severe damage risk at stake, the non-exclusive licensee will be entitled to file a preliminary injunction request and file the main action following the preliminary action, if the request is accepted, before the competent IP courts. In this scenario, the non-exclusive licensee should fulfil the notification procedure while the litigation is ongoing.

### **(8.1.5) Other**

**184** Determination of non-infringement actions, which are stipulated under Article 154 of the IP Code has commonly filed actions by third parties against patent holders. According to Article 154 of the IP Code, any interested party may institute proceedings against the proprietor of a patent to obtain a decision ruling that his activities do not constitute an infringement of the rights arising from the patent. Institution of proceedings should be notified to all the rights holders on the patent and whose names appear in the Patent Register. Recently the 11th Civil Chamber of the Court of Appeal rendered a decision numbered 2016/14642E, 2018/6811K, and dated 6 November 2018, where it was determined that a determination of non-infringement action could not be filed by third parties who have pending marketing authorizations before the Ministry of Health against patent holders. The court reasoned its decision that third parties who have not obtained their marketing authorization at the time of the action do not have a legal interest to file a determination of non-infringement action. Since the decision is very new, it is still vague how it will affect the procedures and the determination of non-infringement actions filed by generic firms who have not obtained a marketing authorization yet.

## **(8.2) LIMITATION PERIODS**

**185** In the Turkish IP Code, different limitation periods are foreseen for different claims. That is to say, according to Article 111 of the IP Code, entitlement claims may be alleged within two years as of the publication of the grant of the patent. However, in line with the general principle adopted by the IP Code, this limitation period will not apply, and the entitlement claim can be alleged until the expiry date of the patent if the registered patent owner acted in bad faith.

**186** Another limitation period is foreseen for the invalidation claims against registered patents in Article 138 of the IP Code. Accordingly, patent invalidity actions can be filed against the person recorded as the patent owner in the Register during the term of the patent and within five years after the patent has expired.

**187** A special provision for the limitation period for infringement actions has not been regulated under the Turkish IP Code. Acts infringing patent rights are accepted as a tort, and the general provisions regarding the limitation period in the Turkish Code of Obligations are applied in patent infringement actions.

**188** A claim for patent infringement may be raised as long as the infringement and the protection term of the patent continue. However, if there is a terminated infringing act at stake, according to Article 72 of the Turkish Code of Obligations, the infringement action has to be filed within two years as of the day of notice of the terminated infringing act and within ten years as of the notice of the infringing act in any case.

## **(8.3) COMPETENT COURT/VENUE**

**189** Article 156 of the IP Code governs the competent courts in different actions related to IP rights.

**190** A patent can be enforced before specialized IP courts which are established to deal with IP disputes. Specialized IP courts dealing with IP disputes are only present in three large cities that are Istanbul, Ankara and Izmir. If there is no IP court in a city, the patent can be enforced before the third chamber of the non-specialized commercial courts of first instance in that city. It should be noted that if there are fewer than three chambers, then the first chamber deals with IP litigation actions.

**191** There are three competent courts in patent infringement matters, which can be chosen by the plaintiff and these are: (i) the court of the domicile of the plaintiff, (ii) the court of the place where the infringing act was carried or (iii) the court of the place where the act of infringement produced its effects. On the other hand, the competent court is the court of domicile of the defendant in invalidation actions.

**192** Both for invalidation and for infringement actions, if the plaintiff is not domiciled in Turkey, the competent court is the court of the location of the business premises of the registered agent and if agent's entry in the register has been cancelled, the competent court is in Ankara which is where the Turkish Patent and Trademark Office is located.

**193** The number of the IP courts is determined by the Ministry of Justice in consideration of the workload and the needs of the city. If there is more than one IP court in a city, the court to hear the case is determined by the distribution offices available in courthouses.

#### **(8.4) PATENT OFFICE**

**194** The Code regulating the establishment and duties of the Turkish Patent and Trademark Office (The Office) numbered 5000 was abolished with the Decree no. 703 dated 2 July 2018. The abolishment of the Code numbered 5000 has caused ambiguity with regards the legal grounds of the establishment of the Office as new legislation has not been enacted constituting the grounds of the Office with the abolishing Decree no. 703. With the Articles 358 *et seq.* Decree of Presidency numbered 4, published on the Official Gazette dated 15 July 2018 and numbered 30479, the legal grounds for the establishment and duties of Turkish Patent and Trademark Office has been regulated once again.

**195** The Office is under the duty to examine patent applications, grant patent registrations to the suitable applications, preserve the rights arising from the patent, work as a mediator in compulsory license applications, serve as a court-appointed expert at IP disputes to which they are not a party, register and record license and assignment agreements, examine and resolve oppositions filed against granted patents and serve other duties assigned to the Office with various legislation.

**196** However, the Office is not entitled to review and resolve infringement claims of the right owners. Such infringement claims must be raised before the competent IP courts (*see* Smart Chart: Competent Court/Venue).

**197** According to Article 156 of the IP Code, final decisions rendered by the Re-Examination and Evaluation Board of the Office regarding all industrial property rights, including those related to patents, can be subject to a cancellation action that will be filed before the Ankara IP courts within two months as of the notification of the decision to the concerned parties.

## **(8.5) PROVISIONAL MEASURES**

### **(8.5.1) Attachment**

#### **(8.5.1.1) General Comments**

**198** Provisional attachment as a provisional measure is regulated in Articles 257 *et seq.* of Turkish Bankruptcy and Enforcement Code numbered 2004. Accordingly, the provisional attachment can be requested by the payee from the competent enforcement court if there is a due and payable monetary debt at stake. In that case, an attachment decision can be enforced on the assets of the payee, in which his patent and other IP rights are also included, which restricts its disposal rights on the attached goods. On the other hand, there are no special provisions governing the attachment of a patent registration or application in the IP Code. However, a patent, which is a form of industrial property, can be subject to attachment provisions governed in the Turkish Civil Code.

**199** However, it should be noted that provisional attachment measure is not frequently implemented, as mentioned above; its implementation will be at stake, in case of a monetary debt of a party. On the other hand, seizure orders in patent cases are often granted in the framework of preliminary injunction proceedings (*see* Smart Chart: Preliminary Injunction Proceedings). Indeed, the Turkish IP Code only codifies preliminary injunction proceedings but does not regulate provisional attachment.

#### **(8.5.1.2) Assets**

**200** It is possible to seize the assets of the infringer for the security of the damages incurred due to patent infringement, however, in practice, these claims are asserted in the framework of preliminary injunction proceedings (*see* Smart Chart: Preliminary Injunction Proceedings).

#### **(8.5.1.3) Evidence**

**201** The patent holder may request the Court to determine and seize the evidence proving the infringement of his patent rights. However, this claim will need to be asserted within the framework of the preliminary injunction and determination of evidence proceedings (*see* Smart Chart: Preliminary Injunction Proceedings and Smart Chart: Preservation/Seizure of Evidence).

### **(8.5.2) Preliminary Injunction Proceedings**

**202** If there is a likelihood of infringement and irreparable damages, the courts will grant a preliminary injunction. Preliminary injunctions can be requested and granted before or during the substantive proceedings. The preliminary injunction instrument has been regulated under Article 159 of the IP Code. The said provision reads as follows:

- (1) Persons who, under the provisions of this law are entitled to file actions, may request the issue of injunction orders in order to ensure the effectiveness of the ruling to be passed. For this purpose, they must prove that the usage which is the subject of the case occurs inside the country and in a way that it violates their industrial property

rights, or they must prove that serious and effective preparations are being made for the purpose of such a usage.

- (2) Injunctions must include, in particular, the following measures:
  - (a) The actions that constitute a violation of the industrial property rights of the plaintiff must be prevented and stopped
  - (b) Products that have been manufactured under violation of industrial property rights or imported, or the equipment exclusively used for their production, or equipment used to perform a patented method without permission must be impounded – but only to the extent that the production of other products that do not violate any rights is not obstructed – where they are found within the border of Turkey, including at customs or in free-trade ports or zones, and be safely stored
  - (c) Issue of securities for the purpose of future compensation of losses.
- (3) In the case of injunction-related aspects not dealt with in this law the provisions of Turkish CCP No. 6100, of 12/01/2011, apply.

**203** The claimant must prove that he is the holder of the patent, that his rights are being infringed or there is a high likelihood of infringement, and that he may incur an irreparable loss as a result of the infringement, in order to convince the Court to grant the preliminary injunction. The general provisions of the Turkish CCP Articles 389–400 apply to procedures of such preliminary injunction requests regarding IP rights residual to the special provisions on preliminary injunctions in the IP Code.

**204** IP court judges in Turkey do not have a technical background. Thus they usually resort to a panel of experts where the number of experts will depend on the nature and the complexity of the dispute. IP courts, in most cases, will decide on the preliminary injunction request upon assessment of the expert report prepared by the court-appointed expert panel. The urgency of the matter and the easiness with which the court may detect likely infringement may lead the court to award the injunction without resorting to experts.

**205** The party requesting the preliminary injunction should prove the rightfulness of their request on a balance of probabilities by submitting evidence supporting their allegations. The court may or may not hold a separate hearing for the evaluation of the preliminary injunction request and listen to the parties before making a decision on the preliminary injunction request (*see* smart Chart Ex Parte Proceedings). The procedure usually takes one to four months, yet it may extend up to eight months depending on the submission speed of the expert report if obtained any.

**206** Rights holders may apply for a preliminary injunction for the prevention of the infringing activities, as well as for the seizure of the infringing goods. Goods seized under preliminary injunctions are safeguarded under the court's custody until the final decision is obtained in the substantive action. According to Article 392 of the Turkish CCP, a reasonable deposit amount may be required in order to secure the rights of the defendant and third parties whose rights and positions may be prejudiced by the preliminary injunction.

**207** If the preliminary injunction is granted, the petitioner should request the implementation of the injunction within one week as of the notification date of the grant thereof. If the implementation request is not made in this time, then the injunction will lift automatically.

**208** Preliminary injunction requests placed before the substantive action should be filed before the courts which are competent to hear the substantive action regarding the same

dispute (*see* Smart Chart: Competent Court/Jurisdiction). In these preliminary injunction requests, the main action should be filed within two weeks term as of the date of the request for the implementation of the injunction decision. If the substantive action is not filed within this term, the injunction will automatically be lifted.

**209** Preliminary injunction orders are subject to appeal before the competent District Courts, and the decision rendered by the District Court is final and binding (*see* Smart Chart Appeal). Whereas the preliminary injunction request filed before the substantive action can be repeated as many times as desired, the preliminary injunction requested during the main action can be repeated only where there is a change in the circumstances.

#### **(8.5.2.1) Ex Parte Proceedings**

**210** According to Article 390/2 of the Turkish CCP, the court may render its decision on the preliminary injunction request *ex parte* if it deems that there is urgency and need for an *ex parte* evaluation. In this scenario, the court will review the preliminary injunction request, and conduct the expert evaluation if it deems fit, and render its decision. If the decision is executed by the petitioner, the minutes of execution should be notified to the counterparty.

**211** According to Article 394 of the Turkish CCP, if a preliminary injunction decision is granted *ex parte*, the party against whom the injunction decision is rendered will be procedurally entitled to file an opposition against the decision.

**212** The opposition term is one week and starts as of the execution of the preliminary injunction decision if the counterparty is present during the execution and as of the notification date of the minutes of execution if the counterparty is not present during the execution.

**213** The opposition will be evaluated by the Court that rendered the preliminary injunction decision and the decision on the opposition can be appealed before the District Court. However, as per Article 394/2 of the Turkish CCP, if an action on the merits is filed, the opposition against the *ex parte* injunction decision will be decided by the Court handling the action on merit.

#### **(8.5.2.2) Inter Partes Proceedings**

**214** Most of the preliminary injunction proceedings in patent litigation take the form of *inter partes* proceedings. In such proceedings, the Court appoints a hearing date for the evaluation of the preliminary injunction request at the closest convenient date, hear the parties' arguments at the hearing, examine the evidence submitted and either decide to confer the file to an expert panel for preparation of a report or decide on the request on the file.

**215** Contrary to the *ex parte* proceedings, the counterparty does not have the right to file an opposition against the decision of the Court on the preliminary injunction request, yet, it can appeal the decision of the Court before the District Court of the Appeals (*see* Smart Chart: Preliminary Injunction Proceedings).

## **(8.6) EVIDENCE**

### **(8.6.1) Preservation/Seizure of Evidence**

**216** In addition to the interim orders available for the preservation and seizure of the evidence explained above, if there is a risk that evidence may change or can be destroyed within time, the plaintiff may apply for the discovery of evidence per Article 400 of the CCP in order to secure the evidence.

**217** The party requesting a determination of evidence should prove his legal interest for such determination. The Courts accept that such legal interest is present if it concerns evidence that may be destroyed or changed within time or it will be considerably difficult to obtain that particular evidence at a later stage.

**218** The determination of evidence application can be done before or during the substantive action. In case there is the determination of evidence application at stake, the application shall be made before the Court which is competent to hear the substantive action or the Court of the place where the evidence subject to application is found. On the other hand, with regards to the determination of evidence applications made during the substantive action, the solely competent court is the Court hearing the substantive action.

**219** As per Article 402 of the CCP, the determination of evidence application shall be made with a petition, and the petition shall include the necessary information regarding the facts and the need for the determination. Subsequently, the court appoints an expert to examine the evidence and prepare a report. The expert examination should not examine the dispute on its merits, but it should assess and determine the evidence provided. This procedure can secure any kind of evidence, including printed materials, websites and domain name details.

**220** In principle, the determination of evidence will be made *inter partes*; in other words, if the Court accepts the determination of evidence application, then it shall notify its decision to the counterparty. In that scenario, the counterparty will be informed of the date and place of the examination and will be granted one week term to file its questions to the experts and objection to the Court.

**221** However, the Court may also evaluate the determination of evidence application *ex parte*. According to Article 403 of the CCP, if notifying the determination of evidence application will obstruct the preservation of the rights of the petitioner, the determination of evidence examination can be done without notifying the counterparty. In this scenario, after conducting the examination, the determination of evidence request petition, examination minutes and a copy of the expert report will be notified to the counterparty. The counterparty can file an opposition against the Court's decision as to determine the evidence within one week as of the notification is made to him.

**222** Another way of securing evidence is for the plaintiff to conduct a notarized purchase. During the notarized purchase, the party demanding the evidence first applies to a notary, and the notary goes to the other party's address and purchases or collects the evidence sought. Following the purchase, the notary prepares a statement confirming that he or she witnessed the collection of evidence.

### **(8.6.2) Gathering Evidence**

**223** As per Article 139 the parties have to submit all arguments and evidence within two weeks' term as of notification of the initial examination hearing date.

**224** As per Article 187 of the CCP, the contested points should be proven with evidence. In principle, any kind of evidence can be submitted to the Court as evidence; however, evidence which is acquired through illegal ways would not be considered by the Courts, and in cases where the CCP requires certain types of evidence, evidence other than the required one will not be considered by the Court.

**225** Article 190 of the CCP foresees that the burden of proof lies on the party, which will benefit from the fact that will be proven unless the contrary is regulated with the Law.

**226** The plaintiff may request the Court to summon evidence from relevant authorities if they are not available to the plaintiff. If the evidence cannot be sent by the relevant authorities, the evidence may be examined by the Court-appointed experts where it is found.

**227** As per Articles 219 and 220 of the CCP, the needed evidence may be available to the defendant only; in such case, the plaintiff may request the Court to order the defendant party to submit this evidence to the Court. If the defendant fails to submit the requested evidence, it is deemed that the arguments of the plaintiff have been proven.

**228** According to Articles 288 *et seq* of the CCP, the Court, upon request of the parties or its ex officio decision, may decide to carry out an inspection in order to gather information regarding the dispute at hand. The inspection can be done with or without the presence of the parties, and the court may appoint an expert who will accompany him and evaluate the technical matters. The Turkish Law system does not recognize affidavits as concrete evidence, but these can be considered as discretionary evidence.

### **(8.6.3) Experts**

**229** The general principles for expert examination are set between Article 266 and Article 287 of the CCP. Accordingly, Courts are entitled to refer a dispute to an expert panel in order to obtain their written opinion along with all the evidence and submission found in the file if the dispute requires technical information and background in order to be resolved. It should be noted that the IP court judges in Turkey do not have a technical background. Thus, almost every dispute regarding patent rights is referred to as an expert panel.

**230** There is an Official Expert List which is prepared and published by the expert regional board. People having expertise on various areas register their names to this expert list, and the Courts refer to those lists when they are appointing experts to the actions pending before them. The expert regional board seeks experts to meet specific criteria which are regulated by the Expert Law No. 6754, such as completing the fundamental expert education.

**231** In principle, the Courts appoint the experts from the Official Expert List that they deem to have the necessary expertise to evaluate the matter, ex officio; however, in some cases, Courts ask suggestions of the parties during the hearing or request the parties to submit their suggestions with a separate petition.

**232** According to Article 267 of the CCP, the Court should appoint one expert for expert examination, and if it can provide its justification, it can appoint more than one expert and form a panel; however, the number of the experts should be uneven, so that majority opinion can be formed. In practice, Courts mostly appoints an expert panel consisting of three.

**233** Considering the fact that the role of the expert panel is to evaluate and shed light on the technical aspects of the dispute, Article 279 of the CCP forbids the experts from making legal evaluations, since only the Courts are entitled to make the legal evaluation and decide on the dispute, and this authorization cannot be conferred to any other institution. However, in practice, the experts have a drastic effect on the course of actions, especially in the patent actions which have a highly technical nature. Indeed, it is very rare for a Court to render a decision to the contrary of the determinations found in the expert report.

#### **(8.6.4) Inspection**

**234** According to Articles 288 *et seq* of the CCP, the Court, upon request of the parties or its ex officio decision, may decide to carry out an inspection in order to gather information regarding the dispute at hand. The inspection can be conducted with or without the presence of the parties, and the court may appoint an expert who will accompany him and evaluate the technical matters.

### **(8.7) PROCEEDINGS ON THE MERIT**

#### **(8.7.1) Infringement Proceedings**

**235** Patent infringement proceedings are governed as per the general civil procedural law provisions set out in the Turkish CCP. A patent holder whose rights are infringed, or who faces the danger of infringement, may file an infringement action as set forth under Article 149 of the IP Code.

**236** There is no mandatory step that should be fulfilled before initiating an infringement action. The plaintiff may send a notarized warning letter to the potentially infringing party in order to settle the dispute in an amicable matter. However, such letters are not a pre-condition for initiating action.

**237** The patent infringement action will be commenced with the filing of the action petition to the distribution offices found in the courthouses of the competent court. The determination of the competent court in patent infringement actions has been explained above (*see* Smart Chart: Competent Court/Venue). The distribution office will automatically appoint the action to one of the IP Courts or Civil Court if there is no IP court established in the city. The Court fees should be deposited to the Court, which is approximately EUR 250.

**238** The Court will prepare its preliminary minutes after examining the action petition where it decides to notify the action petition to the defendant and summon necessary documents such as patent registration documents from the Turkish Patent and Trademark Office, marketing authorization dossiers of the allegedly infringing pharmaceuticals from the Ministry of Health.

**239** The defendant should file its first defence petition against the action petition within two weeks as of the notification of the plaintiff petition to its side. Procedurally, the defendant is entitled to request a time extension from the Court for filing its responses. This time extension request shall be made within this two weeks term. The Court may extend the response term up to one month, which will start as of the termination of the two weeks legal response term, at the maximum. It should be noted that it is at the whole discretion of the Court whether to grant the additional term or not.

**240** If the defendant has domiciled abroad, action petition, the preliminary minute and the evidence, should be translated to the official language of the defendant and the official fee for official notification of approximately EUR 20 should be deposited. The international notification procedure is commenced via the General Directory of the International Law and Foreign Affairs. Once the translation and the official fees are deposited, the international notification of an action petition takes around two to three months.

**241** According to Article 128 of the CCP, in case of failure of filing a response within the response period, it is accepted that the defendant denies all the allegations of the plaintiff, which are asserted in its action petition. 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' or 'pre-examination hearing' in the Turkish CCP.

**242** Turkish patent proceedings are fragmented in a number of hearings. The number of hearing depends on the workload of the Court, the speed of preparation of the expert report and the complexity, defences of the arguments.

**243** The parties have to submit all arguments and evidence until the initial examination hearing, which is held once the petition exchange phase is completed. At the pre-examination hearing, if requested by the parties, the Court will grant two weeks' peremptory additional time to submit missing evidence (*see Smart Chart: Gathering Evidence*).

**244** Pursuant to Article 141 of the Code Civil Procedure, the parties cannot extend the scope of their claims and defences after the submission of their second petitions which are rebuttal and rejoinder petitions. The parties have the right to correct/amend their demands until the end of the action, for once, as per Articles 176 and 177 of the Code Civil Procedure.

**245** Both the patent infringement litigations are heard by a single judge, both by IP courts and the Civil Courts. As explained above, although the Court judges have a deep understanding of IP Law, they do not have the technical background; thus, almost every dispute related to patents is conferred to an expert panel (*see Smart Chart: Experts*).

**246** Once the expert report is submitted to the Court, the report is notified to the parties, and the parties are procedurally entitled to file their statements and/or objections against the expert report within a two weeks peremptory term. After evaluating the objections and statements filed by the parties, the Court may or may not obtain a second expert report from the same expert panel or from a newly appointed second expert panel in order to resolve the objections of the parties.

**247** In practice, if the two main expert reports or the main and the additional expert reports contradict each other, the Court may obtain the third report in order to resolve the contradiction. After the Court is satisfied with the technical examination of the dispute, it

will set a hearing date and ask last statements of the parties; it will terminate the examination phase and render its decision on the merits.

**248** The average timeframe for ordinary proceedings until a decision in the first instance is one and a half years, depending on the court and its workload, the number of the expert reports obtained and as well as the complexity of the case.

**249** After the Court renders its decision orally during the hearing, it prepares its reasoned decision within a one or two-month timeframe. The dissatisfied party is entitled to appeal against the decision of the Court of First Instance before the competent District Court (*see* Smart Chart: Appeal). The decision of the District Court may be further appealed before the Court of Appeal if the conditions of the CCP are fulfilled (*see* Smart Chart: Supreme Court).

### **(8.7.2) Invalidity Proceedings**

**250** According to Article 138 of the IP Code patent will be declared invalid by the court where:

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

**251** The court action for the invalidation of a patent may be instituted during the term of protection or within five years subsequent to the termination of the patent right. There is no mandatory step that should be fulfilled before initiating an invalidation action.

**252** With regard to the proceedings, the invalidity proceedings and the infringement proceedings are highly similar and have no significant distinction in Turkish Law. Both of these proceedings are governed by the general rules of the Turkish CCP with the addition of some special procedural provisions contained in the IP Code (*see* Smart Chart: Infringement Proceedings).

### **(8.7.3) Entitlement Proceedings**

**253** The procedure followed for the actions related to entitlement claims does not differ on any relevant aspect from that followed by infringement or invalidity claims (*see* Smart Chart: Infringement Proceedings and Smart Chart: Invalidity Proceedings).

**254** As per Article 111 of IP Code, 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 the only partial right to the patent is claimed, court action may be filed claiming joint ownership on the patent.

**255** 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 an effect against third parties.

#### **(8.7.4) Suspension of Proceedings**

**256** According to Article 138/2 of the IP Code, if the invalidation action is filed at a time where the post-grant opposition against the same patent is pending, the IP court must delay the invalidity proceedings until the outcome of the opposition, or if an invalidation action is filed against the patent before the grant decision of the patent is published in the Official Trademark Bulletin, the Court should wait for the publication of the grant decision of the patent before handling the infringement action.

**257** Other than the above, in Turkish Patent Law, there is no specific provision requiring the Courts to stay infringement proceedings due to a pending invalidation action before another local court or pending opposition or appeal matter before a Patent Office such as the European Patent Office (EPO).

**258** It is at the Courts' discretion to stay infringement proceedings and wait for a decision to be rendered regarding the invalidity question. The approach of the Courts to national and international invalidity attacks differ from each other. However, considering the retroactive effect of the invalidation of a patent, the Courts are inclined to stay the infringement proceedings and wait for the result of the invalidation action filed before the national courts or to consolidate the infringement and invalidation actions under single litigation.

**259** With regard to EPO proceedings, the Courts consider the stage of the validity proceedings before the EPO and will be inclined to stay the infringement proceedings grounded on the national designation of the contested European Patent before the national courts if a decision can be expected soon. If the proceedings before the EPO are at an early stage, then the Courts are inclined to give more importance to the national valid patent registration.

**260** The procedural rules of staying litigation are put forth in Article 165 of the CCP, and these general provisions apply in patent-related litigations.

### **(8.8) CUSTOMS SEIZURES**

**261** Turkey has an IP rights protection system in the customs areas that are in line with EU regulations and the international agreements to which Turkey is a party.

**262** There is an official system for the protection of IP rights by Turkish Customs that requires only a single application, to be filed through the website of General Directorate of Customs, and these IP applications cover all shipments made subject to importation and exportation, as well as transit trade and shipments located in any Turkish free-trade zones.

**263** As per Article 159/2 of the IP Code, the patent owner or the ones entitled to file actions as per the Turkish IP Code can apply to competent IP courts and request the customs authorities to withhold the infringing products as an interim measure during exportation and importation.

**264** Moreover, as per Article 57 of the Customs Code no. 4458, upon request of the right holders, infringing goods can be withheld by the customs authorities, yet the request of the right holder is not mandatory if there is clear evidence regarding the violation of IP rights, indeed, in such cases the customs authorities can withhold the goods for three days on their own initiative.

**265** Customs authorities can seize suspected goods ex officio, and they will inform patent right holders of the situation, invite them to check the seized goods and take necessary action regarding the infringing goods. Customs authorities that discover suspected goods entering the country will grant a temporary suspension decision, and the rights holder will be requested to check the products, obtain samples or take pictures of those products and provide a preliminary injunction decision or a criminal seizure order within ten working days starting from the notification of the decision. If needed, the patent right owner can request an additional ten working days' time from the customs authorities if he has a valid reason for such a request.

**266** It should be noted that customs seizures are not very effective in Turkey due to the technical nature of the patented products, and it is difficult for customs officials to understand and detect patent infringement.

## **(8.9) REMEDIES**

### **(8.9.1) Injunction**

**267** According to Article 26 of the CCP, Courts are bound with the request of the parties. Accordingly, the Courts cannot grant an injunction exceeding the request of the plaintiff, yet it can decide for something less. Article 149 of the IP Code, on the other hand, sets the legal frame of the claims that can be asserted by the right owner and the scope of the injunctions that can be granted by the Court as a result of the infringement action.

**268** Accordingly, during an infringement action, the Court can grant an injunction where it can:

- determine whether or not the action in question constitutes a rights violation;
- decide on the prevention of the infringement;
- decide to stop the action that constitutes infringement;
- decide to impound the products, whose manufacture and use are sanctioned by penalties because of the infringement of rights, as well as the devices, machines and other instruments to the extent that the production of other products that do not infringe any rights is not obstructed;
- decide to take measures that prevent a continuation of the infringement; in particular: decide to change the form of the materials impounded, to destroy them if this is unavoidable for the prevention of industrial property rights infringement;
- decide to publish the final ruling fully or as an abstract in a daily newspaper or similar medium, and to notify the final ruling to the interested parties, the expense of the other party, if a justified reason or interest exists.

**269** The decisions of courts are enforced pursuant to the Turkish Bankruptcy, and Enforcement Code numbered 2004 by Enforcement Offices. Parties should apply to Enforcement offices to enforce a decision rendered by the Court. In principle, the reasoned

decisions of the Courts can be enforced anytime, and there is no need to wait for the finalization of the decision. According to Article 350 of the CCP, if the subject matter of the case is not related with family law, property law or personality, the finalization of the decision is required in order to be enforced.

**270** With regards to the decisions regarding IP right, although there are some case laws to the contrary, the established case law requires the finalization of the decision in order to enforce it by accepting the IP right as a form of property right. The decision of the Ankara 4th Civil Enforcement Court dated 30 October 2009 and numbered 2009/1322E, K 2009/1292K clearly states that decisions regarding IP rights cannot be enforced before they are finalized.

### **(8.9.2) Intermediaries**

**271** According to Article 141 of the IP Code, the intermediaries, who sells, distributes imports or exports the goods which they know or should know to be infringing patent rights accepted to infringe the patent rights. An infringement action may be filed against them, and the right owner can enforce his patent rights against the intermediaries.

### **(8.9.3) Right to Information**

**272** According to Article 31 of the CCP, the Civil Courts are entitled to direct questions to the parties. However, the main principle adopted for the civil litigations is set out in Article 25 of the CCP, and, accordingly, the Court is limited by the evidence submitted and referred by the parties and thus if it is not required for the resolution of the dispute the Court would not request information that is not requested by the parties.

**273** As per Articles 219 and 220 of the CCP, the needed information may be available to the defendant only, in such case, the plaintiff may request the Court to order the defendant party to submit this evidence and information to the Court. If the defendant fails to submit the requested evidence, it is deemed that the arguments of the plaintiff have been proven.

### **(8.9.4) Corrective Measures (Recall, Destruction, Etc.)**

**274** Pursuant to Article 149 of the IP Code, the owner of a patent whose rights have been infringed may ask the court to order destruction of the infringing products and means permitting the use of a patented process, modification of the shape of the infringing product, removal of the infringing part or confiscation of the infringing products. The destruction of the infringing goods should only be ordered if it is not possible to prevent the infringement in any other means.

**275** With Article 163 of the IP Code, the new IP Code has introduced a fast destruction process for the infringing products. Accordingly, the prosecution is entitled to deliver the seized counterfeit products to the local fiscal administration for storage after having samples delivered to the legal trustee's office. The prosecution may also request a destruction order from the criminal court if there is a risk of damage or serious value loss or if the storage incurs the considerable expense, provided that the counterfeit nature of these goods is confirmed by an expert report. The competent court can also decide on destruction during the criminal trial. The owner of the patent may also apply for the proprietorship over the products and means seized.

### **(8.9.5) Reasonable Compensation**

**276** There is not any explicit provision regarding ‘reasonable compensation’ in Turkish IP Code, unlike some other foreign legislations, however, it is ruled under Article 150 of the IP Code that the losses of the right owner occurred due to the patent infringement should be compensated. The detailed explanations regarding damage and compensation claims are provided under ‘8.9.6: Damages’ heading.

### **(8.9.6) Damages**

**277** There are three types of action for damages, which are: (i) damages for pecuniary loss, (ii) damages for loss of prestige and (iii) damages for mental anguish. The first and second damages are regulated in Article 150 of the IP Code. As per Article 20 of the Commencement of Execution Proceedings in Monetary Receivables Arising from Subscription Agreements Code, Article 5/A was incorporated into the Turkish Commercial Code on 1 January 2019. The article introduces mandatory mediation for claims involving commercial receivables. Mediation is necessary for patent-related disputes that deal with payments and damage compensation, licence agreements and transfer of IP rights.

**278** Article 150/1 of the IP Code regulates the pecuniary loss and states that the person who infringes the IP rights of the right owner is obliged to compensate the losses of the right owner. Moreover, as per Article 150/2 of the IP Code, if the reputation of the industrial property right suffers as a result of misuse by the violator, bad production or the inappropriate way the products or services, produced in this way, are procured or brought to market then the damage for loss of prestige can be requested. The damages for mental anguish, on the other hand, can be requested as per Article 58 of the Turkish Code of Obligations.

**279** The IP Code lists the following three methods for the calculation of the pecuniary loss in Article 151 of the IP Code:

- The damages claim is calculated according to the income which the patent owner might have possibly generated if the competition of the infringing party did not exist.
- The damages claim is calculated according to the income, which is generated by the infringing party from the use of the patent.
- 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 used through a license agreement by the infringer.

**280** The plaintiff should choose one of the three methods. It should be noted that the plaintiff does not have to choose the method he prefers as he files the action; he can notify his choice during the litigation upon the inquiry of the Court.

**281** In the first option, the 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. While in the second option, the examination of the infringer’s commercial books solely would satisfy. In practice, the third method is usually preferred since this method usually constitutes a higher amount and is easier to calculate by taking a sample licence agreement to the consideration.

**282** The compensation of the damages can be requested with the main action or with a separate action. In most cases, due to the complexity of the calculations, the damage claims can delay the delivery of the decision on the infringement action, thus, filing a separate action will be more feasible in most cases.

### **(8.9.7) Disclosure of Judgment**

**283** According to Article 149 of the IP Code, if a justified reason or interest exists, the right owner can request the Court to publish the final ruling fully or as an abstract in a daily newspaper or similar medium and to notify the final ruling to the interested parties, at the expense of the other party.

**284** This request of the defendant may or may not be accepted by the Court, however, if it is accepted, the publication of the decision should be requested within three months term as of the finalization date of the decision.

### **(8.9.8) Order of Costs**

**285** The costs of patent litigation vary considerably depending on the complexity of each case. However, the main costs arising from a typical case can be divided into two as judicial costs and fixed attorney fee.

**286** The judicial costs mainly include all the fees paid during the litigation and the fee paid off the court-appointed experts. As explained in detail above (*see* Smart Chart: Experts), almost all Courts refer their cases to an expert panel. The fee for each expert examination will be approximately EUR 500. On the other hand, the official attorney fee is set with the annual tariff declared by the Turkish Bar Union, and the most update official attorney fee is EUR 520. Accordingly, the total official cost for patent litigation will be around EUR 1,600 to EUR 2,500.

**287** As per Article 326 of the CCP, the losing party should bear the costs incurred during the litigation. However, according to the same provision, if the winner party has unreasonably lengthened the litigation and caused unnecessary litigation costs, then, the Court may order to winner party to pay a part of the whole of litigation costs.

## **(8.10) CRIMINAL ENFORCEMENT**

**288** There is no criminal enforcement of patent rights under Turkish Law.

### **(8.11) APPEAL**

**289** All final decisions of the Courts of First Instance can be appealed before the District Courts, and the decisions of the District Courts can be appealed before the Court of Appeal. Although some disputes are excluded from the District Court examination, none of these is related to the IP related matters. However, it is important to note that the District Court's decisions regarding preliminary injunction decisions of the Court of First Instance are final, and they cannot be appealed before the Court of Appeal.

**290** After a First Instance Court renders its reasoned decision, a party dissatisfied with the decision may file an appeal before the competent District Courts within two weeks starting as of the notification of the reasoned decision to his side before the competent District Courts. The Lawmaker listed some disputes, against which parties cannot file an appeal against in Article 341 of the CCP.

**291** The appeal will be heard by the territorially competent District Court. The District Courts are entitled to examine the dispute both on procedural grounds and merits; indeed, the District Court can appoint a new expert panel to examine the appeal. In principle, the District Court should examine the appeal during a hearing, except in the cases stated in the CCP; however, in practice, it is very rare for District Courts to set a hearing.

**292** It takes eight to twelve months for the District Court to assess the merits of the case. This period may be longer in case the District Court decides for a court-appointed expert examination.

## **(8.12) SUPREME COURT**

**293** According to Article 361 CCP, following the decision of the District Court, a further appeal is possible to the Court of Appeal, but only on points of law. The appeal has to be filed within two weeks as of the date of service of the decision of the District Court to the party. Some disputes are excluded from the Court of Appeal examination; none of these is related to the IP related matters. However, it is important to note that the District Court's decisions regarding preliminary injunction decisions of the Court of First Instance are final, and they cannot be appealed before the Court of Appeal.

**294** The Court of Appeal is the third and final judicial authority in the new three-level system of civil procedure. The decisions from the Court of Appeal can be expected within one to two years term depending on the workload of the Courts.



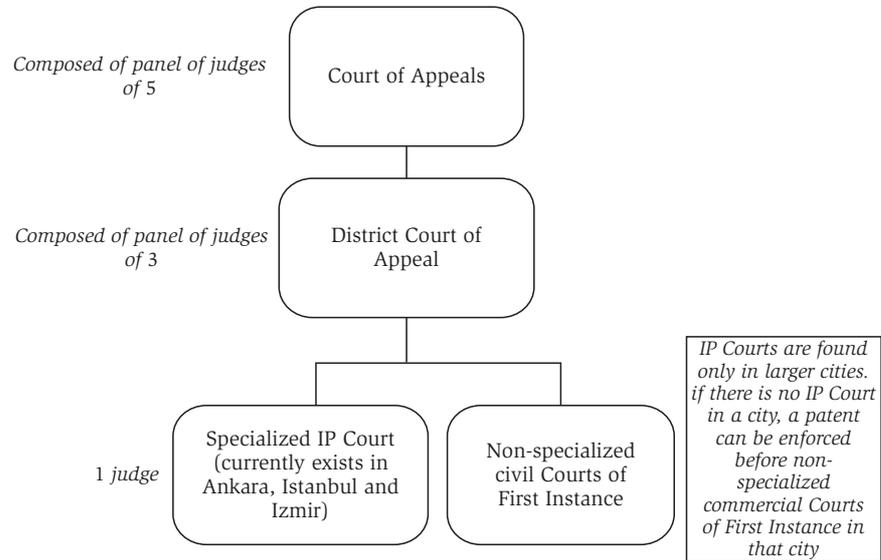
## (9) CONCLUSION

**295** With the new IP Code having entered into force on 10 January 2017, a new era has begun for industrial property rights, including patents, in Turkey. It is stated in the general preamble of the IP Code that it aims to harmonize national IP Law with international agreements, as well as recent developments in EU IP Law.

**296** In this respect, relatively new provisions have been introduced regarding patents in line with the European Patent Convention, such as the post-grant opposition system, the abolishment of the unexamined patent registration, clearer provisions regarding rights due to prior use, use requirements of patents, the international exhaustion principle and new provisions regarding compulsory licensing.

**297** The IP Code and the systems introduced with it are fairly new, and its pros and cons will be observed and experienced in time. Although the new IP Code is in force in Turkey for approximately two years, more time is required in order to have a more settled and foreseeable environment in Turkey in terms of IP related issues. It is expected that the Court decisions will enlighten many aspects of the provisions of the Code, especially in questioned areas.



**(10) TABLES****Court Structure for Patent Litigation in Turkey**

### **Preliminary Injunction (PI) Proceedings: Ex Parte Injunctions [Compulsory]**

<b>Introduction</b>	<b>Oral Hearing</b>	<b>Judgment</b>
<p>A PI can be requested from the court that is competent to hear the main action [Article 390/1 of CCP].</p> <p>A PI may be rendered in cases where it is considerably difficult or impossible to acquire a right due to a change that may occur in the present case, or if it is worried that a delay or a serious injury will result [Article 389/1 of CCP].</p> <p>This is also adopted by Article 159 of the Turkish IP Code; persons who have commenced, or will commence, legal proceedings under the Turkish IP Code, can request for a PI in order to ensure the effectiveness of the infringement action, on conditions 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.</p> <p>The PI requests are accepted when any delay might cause irreparable and significant damage.</p> <p>The party requesting the PI has to prove his or her rightfulness to a certain degree in relation to the merits of the case [Article 390/3 of CCP].</p> <p>Although the application is filed ex parte, the Court is not bound with this request and may notify the defendant of the application.</p>	<p>The Court may hold a hearing and listen to the parties before making a decision about the PI. In most cases, the Court appoints expert(s) to prepare a report on the matter to assist the Court to make a decision and then render its decision.</p> <p>In case there is an urgency of the protection of the claimant's rights, the judge may render its decision without hearing the other party [Article 390/2 of CCP].</p> <p>In such cases, the party in which the decision is rendered in their absence may oppose to that PI decision within one week [Article 394 of CCP].</p> <p>However, as per Article 394/2 of the Turkish CCP, if an action on the merits is filed, the opposition against the ex parte injunction decision will be decided by the Court handling the action on merit.</p> <p>[Article 394/2 of CCP].</p>	<p>Once the application is filed, it may take from a couple of weeks to a couple of months to obtain a judgment depending on the Court's approach to the application; i.e., handling the case ex parte or not, holding hearing/s, appointment of experts and timing of the delivery of the expert report.</p> <p>If the PI is granted, the main action must be filed within two weeks as of grant of the PI. Otherwise, PI will be automatically lifted [Article 397/1 of CCP].</p> <p>The PI is mostly granted in return to a guarantee amount, which must be deposited to the Court (either in cash or as bank guarantee letter) within one week as of grant of PI. Otherwise, the PI will be automatically lifted [Article 392/1 of CCP].</p>

### **Preliminary Injunction Proceedings: First Instance [Compulsory]**

<b>Introduction</b>	<b>Oral Hearing</b>	<b>Judgment</b>
<p>The PI request can be filed together with the substantive action. In that case, the <i>inter partes</i> PI request of the plaintiff will be notified to other parties, and the defence of the defendant party will be requested within a two-week term.</p> <p>The application can be filed ex parte as well. But the Court is not bound with this request and may notify the defendant of the application.</p>	<p>The Court may hold a hearing and listen to the parties before making a decision about the PI.</p> <p>In most cases, the Court appoints expert(s) to prepare a report on the matter to assist the Court to make a decision and then render its decision.</p> <p>In case there is an urgency of the protection of the claimant's rights, the judge may render its decision without hearing the other party [Article 390/2 of CCP].</p> <p>In such cases, the party in which the decision is rendered in their absence may oppose to that PI decision within one week [Article 394 of CCP].</p> <p>However, as per Article 394/2 of the Turkish CCP, if an action on the merits is filed, the opposition against the ex parte injunction decision will be decided by the Court handling the action on merit.</p> <p>[Article 394/2 of CCP].</p>	<p>Once the application is filed, it may take from a couple of weeks to a couple of months to obtain a judgment depending on the Court's approach to the application; i.e., handling the case ex parte or not, holding hearing/s, the appointment of experts, the timing of the delivery of the expert report.</p> <p>PI decisions mostly stay in force until the judgment, to be rendered in the main action, becomes final. However, the Court may lift the PI decision in case the conditions are changed, and it is brought to the attention of the court by the enjoined party.</p> <p>However, if new conditions arise, the PI request can be renewed even if the first PI request is rejected.</p>

**Preliminary Injunction Proceedings: Appeal (Normal Appeal)  
[Compulsory]**

<b>Introduction</b>	<b>Oral Hearing</b>	<b>Judgment</b>
<p>In case the (both <i>inter partes</i> and <i>ex parte</i>) PI request is rejected, the decision can be appealed before the District Court [Article 391/3 of CCP] within two weeks of the notification of the decision [Article 345 of CCP].</p> <p>The party in which the decision is against its favour may appeal the decision of the court.</p>	<p>As per Article 356 of CCP, in principle, the examination is made with oral hearing.</p>	<p>The appeal is examined primarily, and the decisions of the District Court regarding PI requests are final and binding and cannot be further appealed [Article 391/3 of CCP].</p>

**Preliminary Injunction Proceedings: Appeal to Court of Appeal [compulsory]**

<b>Introduction</b>	<b>Oral Hearing</b>	<b>Judgment</b>
<p>Since the decisions of the District Court regarding PI requests are final and binding, there is no appeal phase before the Court of Appeal.</p>		

### **Proceedings on the Merit: First Instance [Compulsory]**

<b>Introduction</b>	<b>Litigation</b>	<b>Judgment</b>
<p>A patent holder whose rights are infringed, or who faces the danger of infringement, may file an infringement action as set forth under Article 149 of the IP Code.</p> <p>A claim for patent infringement can be raised as long as the infringement and the protection term of the patent continue before the competent specialized IP courts.</p> <p>If there is a terminated infringement act, then the infringement action shall be filed within two years as of the acknowledgement day of the infringing act and within ten years as of the realization of the infringing act anyway.</p> <p>Defence of patent invalidity can be raised by filing either a counteraction against the infringement action or a separate action can be brought. However, the counteraction must be filed within the time period of filing the first reply petition.</p> <p>An invalidity action can be brought before the competent specialized IP courts grounding on the situations stated under Article 138 of IP Code.</p>	<p>The patent infringement / invalidation action will be commenced with the filing of the action petition to the distribution offices found in the courthouses of the competent court. The distribution office will automatically appoint the action to one of the IP courts or civil court.</p> <p>The Court will prepare its preliminary minutes after examining the action petition where it decides to notify the action petition to the defendant and summon necessary documents.</p> <p>The defendant should file its first defence petition against the action petition within two weeks as of the notification of the action petition to its side.</p> <p>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 'pre-examination hearing' in the CCP.</p> <p>Turkish patent proceedings are fragmented in a number of hearings. The number of hearing depends on the workload of the Court, the speed of preparation of the expert report and the complexity, defences of the arguments.</p>	<p>After the Court renders its decision orally during the hearing, it prepares its reasoned decision within a one- or two-month timeframe.</p> <p>The unsatisfied party is entitled to appeal against the decision of the Court of First Instance before the competent District Court.</p> <p>The decision of the District Court may be further appealed before the Court of Appeal if the conditions of the CCP are fulfilled.</p>

<p>The court action for the invalidation of a patent may be instituted during the term of protection or within five years subsequent to the termination of the patent right.</p> <p>With regard to the proceedings, the invalidity proceedings and the infringement proceedings are highly similar and will be explained together in the next column.</p>	<p>Generally, the file will be delivered to an expert panel. Once the expert report is submitted to the Court, the report is notified to the parties, and the parties are procedurally entitled to file their statements and/or objections against the expert report within two weeks peremptory term.</p> <p>After the Court is satisfied with the technical examination of the dispute, it will set a hearing and ask the last statements of the parties; it will terminate the examination phase and render its decision on the merits.</p>	
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### **Proceedings on the Merit: Appeal Before the District Court [Compulsory]**

<b>Introduction</b>	<b>Oral Hearing</b>	<b>Judgment</b>
<p>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.</p> <p>District Court of merits of the case indeed makes another expert examination before rendering a decision.</p>	<p>The general rule for the District Court is to examine the case with oral hearings [Article 356 of CCP]; however, there are some exceptional situations in which the District Court can examine the case on the file without oral hearing [Article 353 of CCP].</p>	<p>District Court renders its decision on the merits of the case.</p> <p>The appeal examination before the District Court may take up to three to six months. This period may be longer in case the Court decides for a court-appointed expert examination.</p>

### **Proceedings on the Merit: Appeal to Court of Appeal [Compulsory]**

<b>Introduction</b>	<b>Oral Hearing</b>	<b>Judgment</b>
<p>The decision of the Court of Appeal can be appealed before the Court of Appeal within two weeks of the notification of the decision [Article 361/1 of CCP].</p>	<p>In principle, the Court of Appeal makes the appeal examination on file [Article 369/2 of CCP].</p> <p>Article 369/2 of CCP lists a number of disputes, which should be evaluated by setting a hearing upon requests of the parties; however, disputes regarding IP rights are not among them.</p>	<p>The Court of Appeal may uphold or reverse the decision of the District Court.</p> <p>The decision of approval of the Court of Appeal is final and binding.</p> <p>However, if the reversing decision of the District Court is reversed by the Court of Appeal, the file will be sent to the first instance.</p> <p>If the re-issued decision of the District Court is reversed by the Court of Appeal, the file will be sent back to the relevant District Court of Appeal.</p>

### **Relationship Between Infringement and Validity [Compulsory]**

<b>Introduction</b>	<b>The Effect of Invalidation Action to Infringement Action</b>	<b>National Proceedings while EPO Opposition Is Pending</b>	<b>In Cases of Post-Grant Opposition</b>
In cases of an infringement claim, the invalidity action can be brought as a separate court action or can be brought as a counter claim.	If there is an ongoing infringement action and an invalidity action is brought, the Court may wait to render a decision for the invalidity action to be finalized since if the invalidity action is accepted, the patent will be revoked retroactively.	If an infringement action is brought in national while an EPO opposition is pending, the Court may wait for the opposition to be finalized. However, this will depend on the situation and the stage of the opposition before EPO.	If there is a post-grant opposition, the Court cannot render a decision regarding the invalidation action and should wait for the opposition to be finalized [Article 99/2 of the Turkish IP Code].

### **Role of Experts [Compulsory]**

<b>Private Expert</b>	<b>Experts Appointed by Court</b>
The parties may take scientific/technical opinion from the expert in relation to the case [Article 293 of CCP].	The IP court judges in Turkey do not have a technical background thus they confer the file to a technical expert panel consisting of one or three, depending on the nature and the complexity of the dispute requests regarding patent rights, in order to obtain an expert report. The expert report has a key role in a proceeding. It usually effects the decision of the judge at the end.

**Duration of Preliminary Injunction Proceedings [Compulsory]**

<b>First Instance</b>	<b>District Court</b>	<b>Court of Appeal</b>
It takes one to four months for the court to render its decision. However, this term may extend up to eight months depending on the submission speed of the expert report, if obtained any.	<p>The District Court began its duty as of July 2016, and it is expected that it takes two to four months for the District Court to assess the merits of the case.</p> <p>This period may be longer in case the Court decides for a court-appointed expert examination.</p>	Since the decisions of the District Court regarding PI requests are final and binding, there is no appeal phase before the Court of Appeal.

**Duration of Proceedings on the Merit (Infringement and/or Invalidity) [Compulsory]**

<b>First Instance</b>	<b>District Court</b>	<b>Court of Appeals</b>
It takes one and a half years for the court to render its decision. However, this period may vary on the amount of the hearings and expert reports.	<p>The District Court began its duty as of July 2016, and it is expected that it takes eight months to twelve months for the District Court to assess the merits of the case.</p> <p>This period may be longer in case the Court decides for a court-appointed expert examination.</p>	It takes about one to two years before the Court of Appeal to render a decision on the appeal.

### **Costs of Infringement and Invalidity Proceedings [Compulsory]**

<b>PI</b>	<b>Normal Proceedings</b>	<b>Appeal to District Court or Court of Appeal</b>
<p>The official costs for filing a PI before the competent IP courts will be around TL 250-400 (approximately EUR 70).</p> <p>Courts set up an expert panel composed of three experts. The fee for each expert examination is around TL 3,000 (approximately EUR 500).</p>	<p>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.</p> <p>Courts set up an expert panel composed of three experts. The fee for each expert examination is around TL 3,000 (approximately EUR 500). The second panel of experts is also likely to be appointed if the first one's report is not found to be satisfactory.</p> <p>The attorney fee, which is determined in line with the annual tariff declared by the Turkish Bar Association is TL 3,145 (approximately EUR 520).</p> <p>Therefore, the total cost for such litigation is around EUR 1,600 to EUR 2,500.</p> <p>The losing party shall bear the judicial cost and the fixed attorney fee.</p>	<p>Appealing a decision before the District Court or Court of Appeal that will be around TL 250-400 (approximately EUR 70).</p> <p>The District Court may also set up an expert panel. The fee for an expert examination is around TL 3,000 (approximately EUR 500).</p> <p>District Court or Court of Appeal can determine for attorney fee as well in line with the annual tariff declared by Turkish Bar Association.</p>

## **Annex 1**

Turkish IP Code

Agreement on Trade Related Aspects of Intellectual Property Rights

Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure (30 November 1998)

Strasbourg Agreement Concerning the International Patent Classification (1 October 1996)

Patent Cooperation Treaty (1 January 1996)

Convention Establishing the World Intellectual Property Organization (12 May 1976)

Paris Convention for the Protection of Industrial Property (10 October 1925)

European Patent Convention 2000

