

Fending Off Tactical Patent Invalidation Actions

Filing patent invalidation actions for tactical purposes, such as jeopardizing patent infringement actions of patent owners and gaining time by complicating the infringement proceedings, has become a common strategy of infringers in recent years. With this strategy, the parties infringing the patent may cause the patent owner to suffer due to the inability to enforce their patent as they are entitled to during the limited protection period of 20 years, even if the invalidity claims do not have a solid basis and they are filed on a 'try your luck' basis.

In a recent infringement action in Türkiye, the defendant company responded to the action with a very brief defence comprising a couple of paragraphs, stating that it does not infringe the patent and the patent should be invalidated. The defence omitted any grounds or evidence for the invalidation demand. In this sense, the defendant did not concretise their case within the scope of the Article 297 of Code of Civil Procedure.

It has been observed that in many similar cases, intellectual property courts continued to hear cases even when the applicant party did not fulfil the obligation to concretise their demand. Instead, the courts often appointed an expert panel, which should be appointed only to assist the court in the technical aspects of a case, and made the panel perform the concretisation duty that the applicant party is expected to fulfil. Normally, assessing the invalidity without concretising the case and without matching the prior art documents/arguments with the alleged invalidity ground should not be possible.

In the one case, the patent owner, who was faced with a tactical invalidation action, filed a defence focusing on the procedural deficiencies in the counter party's invalidation request, thus ensuring the rejection of the strategic and essentially malicious invalidity action.

The patent owner explained in detail that the fact that the party infringing the patent merely requests patent invalidity does not fulfil its obligation to concretise the invalidation application within the meaning of Article 297 of the Code of Civil Procedure. Subsequently, the patent owner requested the Court decide on the separation of the invalidity case from the main infringement case and to impose a definite period on the defendant who infringed the patent for the concretisation of the separated invalidity case.

Considering the procedural objections of the patent owner, the court decided to separate the invalidity action from the main infringement action and to impose a definite period of time on the party requesting the invalidity of the patent to concretise their case.



However, the party requesting the invalidity of the patent, purely due to the patent infringement action, did not concretise the invalidation case within the definite period given by the court. Upon this situation, the Court deemed the separated the invalidity case to have not been filed.

This decision is important and will set a precedent in the prevention of future malicious and tactical invalidation actions that put unnecessary burden of concretising the case on the court and jeopardize the infringement action of the patent right holder without legitimate reason.