



International report - Declaration of use under new IP Law: consequences and timelines

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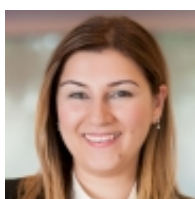
The new IP Law has abolished the Patent Decree-Law provisions regarding the use requirement of patents and evidence of use. Instead, the new law refers to the use requirement within the compulsory licence provision, stating that non-use of a patent could allow a third party to demand a compulsory licence over that patent.

Consequences of failure to file declaration

As the IP Law does not have clear provisions requiring the patent owner to file a declaration of use or non-use for legitimate reasons, there is no legal requirement to do so or provide proof of use. Nevertheless, it seems wise that patent owners should continue to file such declarations as they may be useful as evidence where a third party requests a compulsory licence and may even discourage a third party from doing so by alleging that the patent has not been used without legitimate reason.

Failure to file a declaration of use or non-use means that the patent will be published in the Turkish Patent Office's (TPO's) *Official Bulletin* within the list of patents for which no declaration was filed, as per Article 117/8 of the Regulation on the Implementation of the IP Law.

Article 130/2 of the IP Law rules that a compulsory licence can be requested if the patent is not used. Accordingly, a third party may consider applying to the patent owner for a licence if the patent is



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published on the non-use list in the TPO *Official Bulletin*. The publication of a patent in the *Official Bulletin* does not guarantee that a compulsory licence will be granted. However, if the patent owner rejects the request, the third party can apply to the IP court

Once an action has been filed, the IP court should initiate a notification procedure (or an international notification procedure for patent owners residing outside of Turkey) to notify the patent owner of the action. The owner will then have one month to file its defence and any necessary evidence. After the pleadings, the case will likely be referred to a court-appointed expert panel. The IP Law rules that the IP court should decide on the case within one month once the pleadings phase is complete. However, this is unrealistic even where the IP court does not refer the case to a court-appointed expert panel. Once the IP court makes a decision, it drafts its reasoning subject to appeal before the district court. If the patentee does not file an appeal against the decision, then it becomes final and the compulsory licence is granted or rejected.

Timelines

Article 117/8 of the regulation rules that a use or non-use declaration should be filed within the timelines provided by the IP Law (ie, three years from the date that the grant decision is published in the bulletin or four years from the application date, whichever expires later).

The bulletin referred to in this provision is the TPO's *Official Bulletin* for national applications or Patent Cooperation Treaty entries. However, in relation to the European patents validated in Turkey, a TPO examiner suggested that the bulletin mentioned is the *Official Bulletin* of the European Patent Office (EPO). If so, the timelines set in the provision should be calculated from the date that a European patent grant decision was published on the EPO's *Official Bulletin*. However, this interpretation seems incorrect, especially considering the related provision of the Regulation on Implementation of the European Patent Convention in Turkey.

On the other hand, a declaration of use should be filed as soon as the patent is used, even where the timeline has expired. This is because non-use may lead to a third party filing a request for a compulsory licence. In order to be eligible for a compulsory licence under Article 130/2, the patent must be:

- unused for three years after publication in the bulletin or at

the end of four years after the patent application date,
whichever expires later; and

- not in use at the date of the compulsory licence request.

Therefore, filing evidence of use where available may prevent a compulsory licence from being requested or granted.

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