

Patent litigation in Turkey: overview

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A Q&A guide to patent litigation in Turkey.

The Q&A gives a high level overview of patent disputes, including sources of law; court systems; substantive law; parties to litigation; enforcement options; competition and anti-trust issues; procedure in civil courts; preliminary relief; final remedies; appeal procedure; litigation costs; and reform.

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Resource Type

Country Q&A

Jurisdiction

Turkey

Sources of law

1. What are the principal sources of law and regulation relating to patents and patent litigation?

Turkey is a party to almost all international treaties relating to intellectual property, including the:

- WIPO Strasbourg Agreement Concerning the International Patent Classification 1971.
- WIPO Paris Convention for the Protection of Industrial Property 1883 (Paris Convention).
- Patent Cooperation Treaty 1970 (PCT).
- European Patent Convention 1973 (EPC).
- WTO Agreement on Trade-Related Aspects of Intellectual Property Rights 1994 (TRIPS).

These agreements are directly applicable in Turkey and therefore sources of patent law. At national level, the main sources of patent law are the:

- Industrial Property Code No. 6769 (IP Code).
- Regulation on the Implementation of the IP Code.
- Regulation on Employees' Invention, Inventions Realised in Higher Education Institutions and Inventions Realised as a Result of Publicly Funded Projects.
- Regulation on the Implementation of the European Patent Convention Regarding the Grant of European Patents in Turkey.

The above legislation applies to all patents in Turkey, including pharmaceutical patents and software patents.

Court system

2. In which courts/government bodies are patents enforced?

A patent can be enforced before specialised IP courts. IP courts are found only in large cities such as Istanbul, Ankara and Izmir. If there is no IP court in a city, a patent can be enforced before the civil courts of first instance in that city.

The judges of IP courts are specialised in IP law, but do not have a technical background. Therefore, the technical aspects of patent disputes are handled with the assistance of court-appointed technical experts. The IP courts issue their decisions by considering the technical evaluations of these court-appointed experts.

Under Article 156 of the IP Code, there are three possible competent courts for actions filed by an IP right holder against third parties:

- The court of the domicile of the claimant.
- The court of the place where the infringing act was carried out.
- The court of the place where the act of infringement produced its effects.

However, in actions against an IP right holder by third parties, the competent court is the court of domicile of the defendant.

If the claimant is not domiciled in Turkey, the competent court is the court of the location of the business premises of the claimant's registered agent in Turkey. If the agent's entry in the agency register has been cancelled, the competent court is in Ankara, where the Turkish Patent and Trademark Office is located.

The Turkish courts cannot order cross-border relief or extra- territorial injunctions.

3. Do the courts/government bodies deal with infringement, invalidity and unenforceability simultaneously or must invalidity and/or unenforceability actions be brought in separate proceedings?

There is no automatic invalidity or unenforceability assessment in an infringement action. The courts only deal with invalidity if there is a submission of invalidity or unenforceability defence raised by the other party.

An invalidation action can be brought by the defendant in an infringement action as a counter action within the infringement action or as a separate action. In most cases, the invalidity and infringement actions are consolidated and dealt with by the same court simultaneously.

Similarly, an alleged infringer can allege that the patent owner cannot enforce its patent rights against them as a defence in the infringement action. However, the alleged infringer cannot file for a determination of non-infringement against the patent owner once an infringement action has been filed against them (*Article 154, IP Code*).

4. Who can represent parties before the court and/or government body?

Right holders can represent themselves before the courts and the Turkish Patent and Trademark Office. Apart from right holders, only attorneys at law can represent parties before courts. A patent/trade mark attorney must be registered with the Patent and Trademark Office to represent a party before it.

5. What is the language of the proceedings? Is there a choice of language?

The language of the proceedings before the Turkish courts and the Patent and Trademark Office is Turkish and there is no choice of language.

6. To what extent are courts willing to consider, or bound by, the opinions of other national or foreign courts, or other national or international bodies, that have handed down decisions in similar cases?

The Turkish courts are not bound by the decisions or opinions of other national courts. However, they are free to consider and/or take as example these decisions/opinions.

European Patent Office (EPO) decisions/opinions have a strong influence on the Turkish courts. In addition, the decisions of the EPO on European patents are valid and binding for a Turkish validation of that European patent under the EPC.

Substantive law

7. What does the claimant have to establish in a patent infringement claim?

Article 141 of the IP Code lists the acts constituting infringement of patent rights, as follows:

- Imitation of a patented product by manufacturing it fully or in parts without the permission of the patent or utility model owner.
- Selling, distributing or trading in any other way products manufactured in violation of ownership rights, importing or keeping for sale, using or offering to contract about such products with the knowledge that the products are complete or partial imitations or when in a position to know that they are such imitations.
- Using a patented process without the permission of the patent owner, selling, distributing or trading in any other way products that have been manufactured through the patented process without permission, or importing or keeping for sale, using or offering to contract about such products with the knowledge that they were manufactured through the patented process without permission or while in a position to know that they were manufactured in this way.
- Illegal appropriation.
- Extending contractual or compulsory licensing rights or transferring such rights to third parties.

Therefore, the claimant must establish that the defendant committed at least one of the acts described above.

The burden of proof mainly lies with the claimant. However, in cases involving a process patent for the production of a substance or product, the court has discretion to request the defendant to provide proof that substances or products that exhibit the same properties were produced without violating the patented process.

In cases involving a process patent for the production of a novel substance or novel product, every substance or product that exhibits the same properties is presumed by law to have been produced with the patented method. Parties who claim the contrary must provide proof of their claim.

A patent owner can also prevent third parties from providing the elements and instruments that enable the implementation of the patented invention and constitute the essence of the invention, to persons who are not authorized in the use of the invention which is subject to the patent (*Article 86, IP Code*). The third party must have known that these elements or instruments were sufficient to implement the invention and would be used for these purposes or this fact should be sufficiently clear in order for this provision to be applicable.

There are currently no provisions on inducement of infringement.

The doctrine of equivalents is governed by Article 89/5 of the IP Code. In determining the scope of protection conferred by a patent, the equivalent elements performing substantially the same function and performing that function in a substantially similar manner and giving the same result as the element as expressed in the claim(s), should generally be deemed to be equivalent to the element as expressed in the claim(s).

The doctrine of equivalents is frequently alleged in patent infringement actions. However, there are not many court precedents that provide guidelines on the doctrine. There are Court of Appeal decisions holding that the cumulative presence of the three conditions in Article 89/5 are essential and that failure to examine infringement claims under the doctrine of equivalents is a ground to overturn a decision (see, for example, decisions of the 11th Civil Chamber of the Turkish Court of Appeal, dated 12 June 2019 and numbered 2018/2353E. 2019/4346K and dated 24 December 2015 and numbered 2014/18840E. 2015/13906K).

8. What defences are available to an alleged infringer?

In practice, the most common tactical defence against infringement claims is filing an invalidity action against the patent. If an invalidation action is filed (even after the filing of the infringement action), the IP court prioritises the examination of the invalidity issue.

Equitable defences, such as laches and estoppel, are also available under the IP Code.

A defence relating to prior user rights can be raised under Article 87 of the IP Code. Patent applicants or owners do not have the right to prevent persons who began to use the invention in good faith, or have adopted significant and real measures for its use before the application date, from continuing or beginning to use the invention.

The "Bolar" exemption under Article 85/3(c) of the IP Code is the most frequently alleged defence in infringement claims for pharmaceutical patents. Article 85/3(c) of the IP Code states that experimental activities, including experiments involving an invention subject to a patent, licensing of pharmaceuticals and all necessary tests and experiments are outside the scope of the rights conferred by a patent.

Similarly, the exclusive rights of the patentee do not extend to experimental acts involving the patented invention (*Article 85/3(b), IP Code*).

The exhaustion of patent rights over a product is another defence. According to the new international exhaustion system, which was recently introduced into Turkish Law by Article 152 of the IP Code, the release of a product bearing an IP right anywhere in the world is sufficient for the exhaustion of the IP right in Turkey.

The farmer's privilege defence is set out in Article 85 of the IP Code. Small farmers can use production material obtained from a product resulting from production performed on land they have themselves cultivated with a patented product sold by the patent owner or used with its permission, or obtained through other commercial means. Farmers can also use for agricultural purposes patented breeding or other animal reproduction materials sold by the patent owner or used with its permission, or obtained through other commercial means.

Prosecution history estoppel can also be raised as a defence if the patent owner invokes the doctrine of equivalents (*Article 89/6, IP Code*).

In addition, the patent owner cannot bring civil actions against:

- Persons who, for their personal needs, possess or use infringing products released on the market by the infringing party.
- Persons who use infringing products for commercial purposes, brought to the market due to the patent owner's failure to confiscate them, by a person who pays compensation to the patent owner for their losses.

(*Article 153, IP Code*.)

The Turkish IP Code does not include defences related to standard essential patents or to patent-ineligibility of the claims.

The limitation periods under the Code of Obligations apply, which are the later of:

- Two years from the date of learning about the infringer and the infringing act.
- Ten years from the date of the infringing act.

The alleged infringer can claim that the action should be dismissed because the statutory limitation period has expired.

Case law indicates that the two-year term is renewed at each infringing act (that is, the limitation period does not start as long as the infringement is continuing).

9. On what grounds can a patent be invalidated?

A patent is declared invalid by the court where the:

- Invention does not meet the patentability requirements.
- 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.
- Patent exceeds the scope of the application or is based on a divisional application and exceeds its scope.
- Holder of a patent does not have the right to a patent.
- Patent exceeds the scope of its protection.

(Article 138, IP Code.)

The validity of a patent can only be challenged before an IP court or the civil courts (if there is no IP court in the jurisdiction) (see [Question 2](#)). A patent can only be invalidated by a court decision.

An invalidation action can be filed as a counteraction in an infringement action or as a separate action. However, in most cases, the invalidity and infringement actions are consolidated and dealt with by the same court simultaneously (see [Question 3](#)).

The general rules on the burden of proof apply. This means that a party must prove the facts that support its case, unless otherwise provided by law (*Article 190, Code of Civil Procedure*). Therefore, the claimant in an invalidation action must prove that one of the grounds listed above is present. However, the claimant can request the court to order the defendant to submit evidence in its possession. If the defendant does not comply with the court order, the claimant's submissions are deemed to be correct (*Articles 219 et seq, Code of Civil Procedure*). Similarly, the claimant can request the court to order the production of evidence from relevant authorities.

10. Can a court only partially invalidate a patent or transform it into a utility model?

Under Article 138/4 of the IP Code, a court can partially invalidate a patent for some claims. However, a single claim cannot be partially invalidated. The remaining claims of the patent must fulfil the patentability requirements, which are:

- Novelty.
- Inventive step.
- Applicability to industry.

It is possible to transform a patent application into a utility model application. However, this conversion can only be made at the application stage and through an application filed by the applicant before the Patent and Trademark Office. As an invalidation action cannot be filed against a pending patent application, conversion into a utility model cannot be a strategy during an invalidation action.

11. Is it possible to amend patent claims during enforcement proceedings?

A patent owner cannot amend patent claims during enforcement proceedings. However, a patent holder can make amendments to a patent where there are objections by third parties after the publication of the patent grant decision in the *Official Bulletin* (*Article 99/4, IP Code*).

Similarly, a patent holder can amend its patent application during the registration proceedings before the Patent and Trademark Office (*Article 103/1, IP Code*). To be valid, the amendment must not exceed the scope of the initial application.

Any material mistakes in the patent can be corrected at any time by applying to the Patent and Trademark Office (*Article 103/3, IP Code*).

European patents validated in Turkey can benefit from Article 138(3) of the EPC. Therefore, a European patent holder can file an application with the Patent and Trademark Office while an invalidation action is pending and

amend/limit the claims for defence purposes, provided the IP Court handling the invalidation action sends a writ to the Patent and Trademark Office, on request of the claimant.

12. Are there any grounds on which an otherwise valid patent can be deemed unenforceable?

The main rule is that a patent is valid and enforceable for a term of 20 years from the application date and until a final revocation decision on the patent.

There are no express legal provisions on when a patent becomes unenforceable. However, an IP court may grant a precautionary injunction decision, ruling that the patent cannot be enforced against a particular person.

Parties to litigation

13. Who can sue for patent infringement?

Patent holder

A person recorded at the Patent and Trademark Office registry as the owner of a patent can initiate a patent infringement action (*Article 149, IP Code*).

Co-owner

A patent can have more than one owner. Where a patent or patent application is owned by more than one person, joint ownership will be governed by the agreement concluded between the parties (*Article 112, IP Code*). In the absence of such agreement, the rights of the joint owners are determined in accordance with the general provisions of the Turkish Civil Code on joint ownership.

If the patent is co-owned by multiple bodies/persons, each co-owner can independently bring actions to protect the patent application or patent. A co-owner who files an action must notify the co-owners within one month, to allow them to join the action.

Exclusive licensee

Unless the licence agreement includes a provision to the contrary, an exclusive licensee can file the same actions against third parties as the patent owner, in its own name (*Article 158, IP Code*).

Non-exclusive licensee

A non-exclusive licensee with the right to bring actions for patent infringement that is not explicitly limited in the licence agreement can request the patent owner to file an infringement action (*Article 158, IP Code*). If the patent owner does not file the requested action within three months or declines the request, the non-exclusive licensee can file the action itself.

Distributor

Distributors cannot file patent infringement actions under the IP Code if they are not licensees of the patent holder.

Other

No other parties are entitled to file patent infringement actions.

14. Under what conditions, if any, can an alleged infringer bring proceedings to obtain a declaratory judgment on non-infringement or invalidity/unenforceability?

There is no list of specific conditions for bringing a declaration of non-infringement action. Any interested party can file such an action and request the court to determine that its acts or goods or services are not infringing the

patent rights of a patent holder. The claimant must show that it has the required legal interest for filing an action for a non-infringement declaration. A simple statement of the claimant that it plans to bring an action or has a good or service that may be related to the patent is deemed sufficient by the IP courts to establish a legal interest for filing the action.

An action for a declaration of non-infringement cannot be filed if the patent owner has already initiated infringement proceedings.

15. Who can be sued for patent infringement?

Under Article 141 of the IP Code, a patent infringement action can be filed against the direct or indirect infringers of a patent. The direct infringer of a patent is the person who:

- Produces the patented product wholly or partially.
- Knows or should have known that the product is a complete or partial imitation of a patented product and sells, distributes, carries or trades in the infringing product.
- Without permission or assignment of rights, grants a licence to a third party, or usurps patent rights.
- Uses a patented method or commercialises a product that is directly produced as a result of the patented method.
- Seizes the patent rights.

An infringement action can be filed before any of the following courts:

- The court of the claimant's domicile.
- The court of the place where the infringing act was carried out.
- The court of the place where the infringing act produced its effects.

16. Is it possible to add or remove parties during litigation?

Under Article 124 of the Code of Civil Procedure, the parties to litigation can be changed with the explicit consent of the counterparty. However, if there is a clear material mistake, the change can be made without consent of the counterparty. However, if the subject matter of the action (that is, the patent right) is assigned to another party during an ongoing action, the claimant can choose to continue with the action against the new right holder or can continue its action as a compensation action against the previous right holder (*Article 125, Code of Civil Procedure*). The Code of Civil Procedure does not impose any limitation on when parties can be added or removed, and there are dissenting opinions regarding this issue in the doctrine.

A third party can intervene in the action once notified (*Articles 61 et seq, Code of Civil Procedure*).

A third party can also intervene in the action without being notified of the action as a primary intervener (*Article 65, IP Code*) or as secondary intervener (*Articles 66 et seq, IP Code*). The court will hear and decide on the intervening parties' request. In principle, intervention requests can be made until the examination phase before the first instance court is finalised.

Where a third party wishes to intervene in the action as a primary intervener, its action will be heard and decided together with the main action. A minor official fee must be deposited to the court.

Where the third party is not a party to the action but a secondary intervener, it has limited rights and its main duty is to help the relevant party to the action to prove its arguments.

Enforcement options

17. What options are open to a patent holder when seeking to enforce its rights in your jurisdiction?

Civil proceedings

A patent holder can file a patent infringement action against alleged infringers before the competent IP courts, where it can request determination and termination of the infringing acts.

Persons who have commenced, or will commence, legal proceedings under the IP Code can request a preliminary injunction to ensure the effectiveness of the infringement action, provided that they bring evidence as to the actual use of the patent in Turkey or serious and effective preparations to use the patent in question (*Article 159, IP Code*). See [Question 31 to 34](#).

Criminal proceedings

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

Border measures

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

A patent owner or any other party entitled to file actions can apply to the competent IP courts and request the customs authorities to withhold the infringing products during exportation and importation as an interim measure (*Article 159/2, IP Code*).

18. Is it compulsory to provide notice to an alleged infringer before commencing patent proceedings?

It is not compulsory to provide notice to an alleged infringer before commencing patent proceedings.

19. To what extent do courts have jurisdiction or power to grant cross-border or extra-territorial injunctions (preliminary or permanent)?

The Turkish courts do not have jurisdiction over other countries. Therefore cross-border or extra-territorial injunctions are not available.

20. To what extent do courts recognise the blocking effect of "torpedo" actions abroad (proceedings between the same parties concerning the same subject matter that are pending in another jurisdiction)?

For European patents validated in Turkey, ongoing EPO opposition or appeal proceedings (and invalidity decisions in such proceedings) have a significant impact on national enforcement proceedings, as decisions in EPO proceedings are binding on the national validation of the patent in Turkey.

However, invalidity proceedings pending in foreign countries do not affect national enforcement proceedings.

21. To what extent are arbitration, and alternative dispute resolution (ADR) methods (such as mediation), available to resolve patent disputes?

Arbitration

The suitability of arbitration or ADR for patent disputes is a controversial topic in Turkish law. In principle, it is accepted that patent disputes, other than those relating to the invalidity of the patent, can be resolved by

arbitration, as the patent holder can exercise all rights arising from its patents, and selection of the dispute resolution method is one of them. However, some scholars argue that patent-related disputes should be handled by IP courts, which have special expertise.

It is widely accepted by scholars that patent invalidity disputes cannot be resolved by arbitration or ADR, as decisions in these proceedings are only binding for the parties, whereas the invalidation of a patent affects the rights and legal status of third parties and imposes duties on the Patent and Trademark Office to record the patent as invalid. It is also argued that registration of a patent is established by the state and that patent rights cannot be abolished by an arbitration decision to which the state is not a party.

The Regulation on Employee Inventions, Inventions Realised within Higher Education Institutions and Inventions Arisen from Projects Supported by Public Authorities provides that any dispute that falls within the scope of the Regulation must be resolved through arbitration. It is accepted that compensation actions arising from employee inventions must be resolved by arbitration. However, there is an ongoing cancellation action against some provisions of the Regulation, including the provision on mandatory arbitration, on the grounds that the provisions are contrary to the law and violate the Constitution.

ADR

See above, [Arbitration](#).

Competition and anti-trust

22. Can a patent holder bring proceedings claiming both patent infringement and unfair competition for the same set of facts?

A patent infringement act can cause unfair competition. Therefore, a patent holder can bring proceedings claiming both patent infringement and unfair competition for the same set of facts. However, the conditions for patent infringement and unfair competition are different, and the court must evaluate them separately.

23. To what extent can enforcement of a patent expose the patent holder to liability for an anti-trust violation?

In principle, enforcement of a patent does not expose the patent holder to liability for an anti-trust violation, as using a legal right cannot be deemed to be against the law. However, there can be liability in the case of an abuse of a legal right causing an anti-trust violation. In such a case, the anti-trust issues should be separately examined and evaluated. The pure use of a legal right cannot expose the patent holder to liability for an anti-trust violation.

There are no precedents of the Turkish Competition Authority (TCA) on the enforcement of patent rights and its relationship with anti-trust law. The TCA has published a pharmaceutical sector inquiry report evaluating the enforcement of patent rights from an anti-trust perspective, but there have been no clear findings or conclusion in this regard.

On 26 December 2019, the TCA issued its first decision regarding standard essential patents in the case of *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 anti-trust issues in the context of standard essential patents under Turkish law.

Procedure in civil courts

24. What are the main stages of patent infringement proceedings?

Patent infringement proceedings are mainly written proceedings. All arguments must be submitted to the court in written petitions.

The IP courts consist of one judge, who has no technical knowledge but has a good understanding of IP law.

The format of patent infringement proceedings is governed by the Turkish Code of Civil Procedure, which is valid for all other civil courts. The format of the proceedings does not differ from the proceedings in other civil courts. After filing the action petition and the notification of the action petition to the defendant, the defendant can file its defence petition. Once both parties have filed two petitions in response to each other's statements, the court holds a preliminary examination hearing and determines the allegations and demands of each party, as well as the subject matter of the dispute. At this stage, the court also evaluates if there is any procedural deficiency.

In patent enforcement proceedings, a court-appointed expert panel is appointed after completion of the pleadings phase, due to the judge's lack of technical knowledge. The expert examination can be repeated as many times as necessary to overcome the objections of the parties. In most cases, the IP court judge will come to a conclusion after the third examination at most. Therefore, patent enforcement proceedings are highly dependent on the outcome of the court-appointed expert examination.

25. What are the rules and practice concerning evidence in patent infringement proceedings?

Documents

Contested points must be proven with evidence. In principle, any type of evidence can be submitted to the court. However, evidence that is acquired through illegal methods will not be considered by the courts (*Article 187, Code of Civil Procedure*).

The burden of proof lies on the party that will benefit from the fact to be proven, except in certain circumstances (*Article 190, Code of Civil Procedure*).

The parties must submit the documents that they, or the opposing party, have cited as evidence, if they are in possession of the documents. If they fail or refuse to submit such documents, and they cannot give a plausible excuse for the situation, the court may accept the statements of the other party to be true as a sanction (*Articles 219 and 220, Code of Civil Procedure*).

The Turkish legal system does not recognise affidavits as evidence, but these can be considered as discretionary evidence.

Witness evidence

In principle, any type of evidence can be submitted to the court, and witness evidence also serves as evidence for proving the claims of the parties.

In principle, a witness must attend the court in person and answer the parties' attorneys' or judges' questions. The parties' attorneys can ask questions to the witness directly. The parties can direct their questions through the judge (*Article 152, Code of Civil Procedure*). However, if deemed necessary, the court can request a witness to submit its written responses to the questions.

In practice, witness evidence is not frequently used in patent infringement actions.

Expert evidence

The IP court judges in Turkey do not have a technical background. Therefore, almost every dispute regarding patent rights is referred to an expert panel.

Under Article 281/2 of the Code of Civil Procedure, parties to the action can file an objection against the expert report and request the court to obtain a new report from a new panel, an additional report from the same panel or invite the expert panel to a hearing to explain their opinion orally.

In practice, the experts have an important effect on the course of actions, especially in patent actions that have a highly technical nature. It is very rare for a court to render a decision that is contrary to the determinations found in the expert report.

Under Article 293 of the Code of Civil Procedure, the parties can also submit private expert reports on the technical aspects of the dispute. While such a report is not binding on the court and court-appointed expert panel, a report from a reputable academic from a reputable university may have a significant impact on the court and the panel.

The Code of Civil Procedure also allows cross-examination of the court-appointed expert panel.

26. Is evidence obtained in criminal proceedings admissible in civil proceedings and vice versa?

As there is no criminal enforcement of patent rights under Turkish law, this is not possible.

27. Is evidence obtained in civil proceedings admissible in other civil proceedings?

If a civil court has collected and/or determined evidence itself, this evidence is admissible in other civil proceedings. However, if a party filed evidence in a civil court proceeding and the evidence is taken into consideration by the civil court, that does not mean that the court has officially collected evidence. Such evidence does not have to be considered or accepted by another civil court.

28. To what extent is pre-trial disclosure permitted and what other mechanisms are available for obtaining evidence from an adverse party or third parties?

Pre-trial discovery

There is no pre-trial discovery under Turkish law. There is also no full disclosure obligation. After filing of the action, both parties are given a certain period of time to submit their evidence. If a piece of evidence is not publicly available or in another party's possession, the court can be requested to order the production of such evidence.

If there is a risk that evidence may change or be destroyed, the claimant can apply to a civil court and ask for discovery and preservation of the evidence under Article 400 of the Code of Civil Procedure. The discovery application can be made before or during the substantive action.

Under Article 402 of the Code of Civil Procedure, the discovery application must be made with a petition including the necessary information on the facts and the need for discovery.

The discovery application must be made before either:

- The court that is competent to hear the substantive action.
- The court of the place where the evidence is found.

For applications made during the substantive action, the only competent court is the court hearing the substantive action.

The court will appoint an expert to examine the evidence and prepare a report. The expert examination does not examine the dispute on its merits, but assesses and determines the evidence provided. This procedure can be used to secure any type of evidence, including printed materials, websites and domain name details.

In principle, the counterparty in the discovery application must be the party from which the evidence is requested and/or who possesses the evidence that is at risk of being changed or destroyed. This party does not need to be the party against which a main action can or will be sought.

The court renders its decision determining the evidence in line with the expert report obtained.

Other mechanisms

The parties must submit all arguments and evidence before the initial examination hearing, or within a peremptory additional time that may be granted by the court on request for the submission missing evidence.

The required evidence is only available to the defendant if the claimant requests the court to order the defendant to submit this evidence to the court (*Articles 219 and 220, Code of Civil Procedure*). If the defendant fails to submit the requested evidence, the arguments of the claimant are deemed to have been proven.

29. What level of proof is required for establishing infringement or invalidity/unenforceability?

In infringement actions, the law accepts reasonable doubt of infringement, especially if the infringing act is kept confidential and/or all evidence is only from the alleged infringer. There is no level of proof requirement to file an infringement action, but the claimant must prove a legal interest in filing the action.

In invalidation proceedings, there is no level of proof requirement to file the action. This also applies to the determination of non-infringement and/or unenforceability of a patent. Any party who has a legal interest can file the invalidation action.

For all types of actions, both parties must prove their arguments with concrete documents and evidence. Although there is no pre-determined level of proof, as infringement and invalidity actions are main actions on the merits, the level of proof is not low and strong and concrete evidence should be submitted. The courts have full discretion to evaluate whether the evidence submitted is sufficient to prove the claims of the parties (*Article 198, Code of Civil Procedure*).

30. How long do patent infringement proceedings typically last?

Proceedings generally take one and a half years before the first instance courts, about six to eight months before the district courts and about one to two years before the court of appeal.

The court generally sets a hearing every three months to:

- Check the status of the case.
- Determine deficiencies.
- Issue interim decisions that are necessary to continue proceedings without delay.

A new appeal system entered into force on 20 July 2016 introducing a double-step appeal system (see [Question 36](#)). It takes eight to 12 months for the district court to assess the merits of the case. This period may be longer if the district court decides to have a court-appointed expert examination.

The court of appeal is the third and final judicial authority. Decisions of courts of appeal are issued within one to two years, depending on the workload of the courts.

Fast-track procedures

There is no fast-track or expedited procedure for patent infringement actions.

Timetable

All the procedural aspects relating to civil litigations are governed by the Turkish Code of Civil Procedure. The court and the parties must comply with the timelines set out in the Code.

Under the Code of Civil Procedure, once an action is filed by the claimant, the defendant must file its first response petition within two weeks of the notification of the claimant's petition. It is also possible to demand a time extension within the same two-week period. After the parties exchange two sets of petitions and submit the relevant evidence on which they base their petitions and allegations, the court reviews the file and sets a hearing date for the first hearing called the "initial examination hearing". After this point, it is not possible for the parties to agree on a binding timetable for the proceedings and expect the court to abide by it.

Delay

Under Article 165 of the Code of Civil Procedure, the court can deem another pending action as a prejudicial question and wait for the decision in that action if it considers that the current action is dependent on that decision.

The most frequent route for a defendant seeking to delay proceedings is filing a counter invalidation action against the patent. As an invalidation action has retroactive effect, the local courts stay the proceedings until resolution of the invalidity dispute.

The defendant of an invalidation action can employ counter delaying tactics depending on the particular characteristics of the action.

A party who fails to meet the mandatory timelines imposed by the court and delays the proceedings will lose its right to perform the procedural steps in question. The court can also order a party to pay all or parts of the litigation costs if it has unreasonably delayed the litigation and caused unnecessary litigation costs.

Preliminary relief

31. Is preliminary relief available, and if so what measures are available and under what conditions?

Search and preservation/search and seize orders

Under Articles 288 *et seq* of the Code of Civil Procedure, the court, on request of the parties or on its own authority, can decide to carry out an inspection to gather information on the dispute. The inspection can be with or without the presence of the parties and the court may appoint an expert to accompany the judge and evaluate technical matters. Parties can apply for determination of the evidence before the trial (see [Question 28](#)).

Injunctions

Persons who have commenced, or will commence, legal proceedings under the IP Code can request a preliminary injunction to ensure the effectiveness of the infringement action, provided that they have evidence showing the actual use of the patent in Turkey or serious and effective preparations to use the patent (*Article 159, IP Code*).

Under Article 390/2 of the Turkish Code of Civil Procedure, the court can render a decision on a preliminary injunction request if it deems that there is urgency and need for an *ex parte* evaluation. If a preliminary injunction decision is granted *ex parte*, the party against whom the injunction decision is rendered can file an opposition against the decision.

Most preliminary injunctions are granted in *inter partes* proceedings, where the court appoints a hearing date for the evaluation of the preliminary injunction request and decides to confer the file to an expert panel for preparation of a report or to decide on the request. The counterparty does not have the right to file an opposition against the decision of the court on the preliminary injunction request. However, it can appeal the decision of the court before the district court.

Preliminary injunctions can be requested and granted before or during substantive proceedings. If the injunction is filed before filing the action on the merits and is granted, the claimant must file the main action within two weeks of the request for the preliminary injunction.

As the Turkish courts do not have jurisdiction over other countries, extra-territorial preliminary injunctions are not an option.

Other

The main preliminary relief applicable for IP rights is a preliminary injunction. Requests such as seizure of the infringer's assets or evidence are generally made in the framework of preliminary injunction and determination of evidence proceedings

Provisional attachment measures are also available, but are not frequently ordered in patent disputes.

32. Can a defendant file a protective writ?

Protective writs are not available under Turkish law.

33. What is the format/procedure of preliminary injunction proceedings?

General

The general provisions of the Turkish Code of Civil Procedure (Articles 389 to 400) apply to preliminary injunction requests regarding IP rights, in addition to the special provisions on preliminary injunctions in the IP Code.

A preliminary injunction request must be made with a petition including information on the facts and the need for the determination. The preliminary injunction must be requested from the court that is competent to hear the main action.

Ex parte preliminary injunctions are available but are rarely granted by the courts. The courts prefer to hear the defence of the other party before dealing with a preliminary injunction request.

As IP court judges in Turkey do not have a technical background, they usually resort to a panel of experts, where the number of experts depends on the nature and the complexity of the dispute. The courts usually decide on the preliminary injunction request in line with the expert report.

A reasonable deposit amount may be required to secure the rights of the defendant and third parties whose rights and positions may be prejudiced by the preliminary injunction (*Article 392, Turkish Code of Civil Procedure*).

The preliminary injunction is automatically lifted if the bond amount is not deposited within one week. The claimant must also request the implementation of the injunction within one week of the date of the granting decision.

If the preliminary injunction is requested before filing the action on the merits, the main action must be filed within two weeks, failing which the preliminary injunction is automatically lifted.

Level of proof

Under the Code of Civil Procedure, a party requesting a preliminary injunction must at least prove its case on the merits on an approximate basis.

Evidence

Success in a preliminary injunction request depends entirely on the quality of evidence that delay may cause irreparable and significant damage. All the types of evidence that can be submitted in an action on the merits (see [Question 25](#)) can also be filed in a preliminary injunction request.

However, the courts widely refer to court-appointed expert panels for technical evaluations, as they do not have a technical background. Private expert reports can also be submitted by the parties to explain the technical aspects of the matter to the court and the panel, if it is deemed necessary.

Patent validity

The most common defence submitted by counterparties faced with preliminary injunction requests is the invalidity of the patent. If there is ambiguity as to the validity of the patent as a result of an ongoing invalidation action, the IP courts generally take those actions into consideration and refrain from granting a preliminary injunction by taking the retroactive effect of the invalidation decision into consideration.

Length of proceedings

Preliminary injunction proceedings usually take one to four months, but can last up to eight months depending on when the expert report is submitted, if requested.

As preliminary injunction proceedings are handled as a priority by the courts due to their urgent nature, there is no separate fast-track or expedited procedure.

34. If a preliminary injunction is granted and the main infringement action is finally lost, can the defendant claim damages for the unjustified preliminary injunction?

Under the Code of Civil Procedure, an enjoined party can claim damages in a compensation action if there is found to be no justification for the preliminary injunction in the action on the merits.

A preliminary injunction is granted in return for a guarantee bond. The decision on the guarantee bond is at the discretion of the judge. However, it is quite rare for a preliminary injunction to be granted without a bond.

The guarantee bond is kept by the court as a guarantee for damages for a month from finalisation of the action on the merits or decision on lifting of the preliminary injunction. After expiry of the one-month term, the guarantee bond is returned to the party who deposited the guarantee amount. This does not mean that the enjoined party cannot file a compensation action. The one-month term is only for keeping or returning the guarantee bond. However, the compensation action must be filed within one year of finalisation of the action on the merits or decision on lifting the preliminary injunction. The action must be filed before the court that decided on the preliminary injunction.

Final remedies

35. What remedies are available against a patent infringer?

Permanent injunction

A permanent injunction is not available as a remedy. Only preliminary injunctions before an action on the merits are available. A permanent injunction may be the outcome of an infringement action where the court acknowledges that the acts of the defendant are infringing and decides to have them ceased entirely.

Monetary remedies

If a patent infringement is accepted by the court, the patent holder can demand compensation for damages. There is no other monetary remedy apart from compensation of damages. Damages are not awarded on a punitive basis.

The quantum of monetary remedies is assessed by the court after determining liability. Accordingly, liability and quantum of monetary remedies are not assessed by the court at the same time.

Damages are calculated as any of the following:

- Income that the patent owner may have possibly generated without the competition of the infringing party. The court-appointed expert panel then examines the patent holder's and infringer's commercial books and records to determine the loss of profit.
- Income generated by the infringing party from the use of the patent. Under this option, an expert examination is conducted on the infringer's commercial records.
- Licence fee that would have been paid if the infringer had lawfully used the patent under a licensing contract.

(Article 151, IP Code.)

The claimant should choose one of the above three options carefully, by considering the particulars of the infringement.

On request of the claimant, the court can also award interest on damages.

Delivery up or destruction of infringing goods

Under Article 149 of the IP Code, the owner of a patent whose rights have been infringed can ask the court to order the destruction of the infringing products. There is also a fast destruction process for infringing products under Article 163 of the IP Code.

The patent holder can also request the court to impound products whose manufacture and use are affected by penalties because of the violation of rights, as well as devices, machines and other instruments, provided that the production of other products that do not violate any rights is not obstructed.

Publication of the decision

A patent holder 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, if he/she has a justified reason or interest in that being done (*Article 149/1(g), IP Code*).

Recall order

A recall order can be issued for goods that constitute a danger to public health or that are not in good order. There is no specific recall order mechanism for patent infringement.

Declaration of infringement and validity

There are no declaration of infringement or validity mechanisms against a patent infringer under Turkish law.

Other

The patent holder can request the court to assign the property rights of seized infringing materials (*Article 149, IP Code*).

Appeal procedure

36. What avenues of appeal are available for a defeated party and on what basis?

A new appeal system entered into force on 20 July 2016 introducing a three-tier court system. All final decisions of the courts of first instance can now be appealed before the district courts, and the decisions of the district courts can be appealed before the courts of appeal. District court decisions on preliminary injunction decisions are final and cannot be appealed before the court of appeal.

District courts can examine the dispute both on procedural grounds and on the merits. District courts can also order an expert examination on the dispute, although this is not common in practice.

The Court of Appeal only reviews whether the law was implemented correctly, and not the merits of the decision.

Litigation costs

37. What level of cost should a party expect to incur to take a case through to a first instance decision, preliminary injunction proceedings and appeal proceedings?

The main costs arising in a typical patent case including both infringement and validity are judicial costs (expert fees) and fixed attorney fees. The courts typically set up an expert panel composed of three experts. The fee for each expert examination is around TRY3,000. Attorney fees are determined in line with the annual tariff declared by Turkish Bar Union of TRY4,910

Further costs incurred in the district court are related to judicial costs (approximately EUR100) and expert fees (EUR500). If the district court decides to conduct an expert examination, that will be around EUR600.

Under Article 326 of the Code of Civil Procedure, the losing party must bear the costs incurred during the litigation. However, if the winning party has unreasonably lengthened the litigation and caused unnecessary

litigation costs, the court may order them to pay a part or all of the litigation costs.

Reform

38. What are the important developing and emerging trends in your country's patent law that relate to enforcement?

Due to the 2019 novel coronavirus disease (COVID-19) pandemic, one of the trending issues is related to the enforcement of patent rights on inventions that will be used to fight the disease, and how these will be restricted by state. The Turkish IP Code has provisions on compulsory licensing, which can be used for such patents. However, the Turkish legislator has not issued any specific regulation on this issue, unlike other countries such as Israel, France and Canada.

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