

## Chambers and Partners Patent Litigation 2022 Guide – Law and Practice: Turkey Chapter

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### 1. Intellectual Property Rights and Granting Procedure

#### 1.1 Types of Intellectual Property Rights

The Turkish legal system provides for "patents" and "utility models" for the protection of inventions. Both of these forms of protection are based on statutory law, they are regulated in the Industrial Property Code (IPC).

#### 1.2 Grant Procedure

##### **Patents**

After a patent application is duly and completely filed, the Turkish Patent and Trademark Office (TPTO) conducts a procedural examination.

A priority claim either can be made on first filing or two months from the application date.

If the TPTO determines that there is a deficiency in the application documents, the applicant is given two months to correct it.

The applicant must request the TPTO to undertake a standard state of the art search within 12 months from the application date and pay the necessary fee for the search. If the applicant does not request such a search within the permitted time period, the patent application will be deemed to be withdrawn.

The search report is the first step in deciding whether or not an invention is patentable. Once the search report is prepared, the TPTO notifies the applicant regarding the report and relevant documents.

After a total of 18 months, as of the application/priority date, the patent application is published in the Official Patent Bulletin. The applicant may file a request for an earlier publication.

If the applicant decides to proceed with the application, it is entitled to request the preparation of the examination report within three months from the notification of the search report.

If the TPTO concludes that the application meets the patentability criteria, the TPTO will issue the patent (on payment of the necessary fees).

If the TPTO concludes that the application does not meet the patentability criteria, the applicant is allowed three months to either amend its claims or object to the TPTO's report. Applicants are limited to three rounds of this notification, response and amendment process.

Third parties are entitled to submit oppositions to the patent within six months of the publication of grant. The applicant has the right to file a response to a third-party opposition within three months.

If there is no third-party opposition, the patent becomes final and the final decision of the TPTO is published in the Bulletin.

### **Utility Models**

The grant procedure is shorter and easier for utility models.

After the procedural examination, if there is no deficiency or the deficiencies are corrected, the applicant is entitled to request a search report.

Once the search report is prepared by the TPTO, the applicant is notified in this regard.

The application is published in the Bulletin 18 months after the application date. The applicant may file a request for an earlier publication.

Third parties are entitled to submit their opinions and the applicant is entitled to file an opposition against the publication within three months of publication.

The TPTO examines these opinions and oppositions. If the TPTO's examination decision is positive, the application matures to registration.

### **1.3 Timeline for Grant Procedure**

Obtaining a patent takes approximately two to five years. Obtaining a utility model takes around two to three years.

Turkish citizens and Turkish residents do not need a representative to initiate grant proceedings; in other words, right-holders can file applications themselves. However, foreign applicants must assign a registered local patent attorney.

Official fees for granting a patent/utility model can be found on the [TPTO website](#).

In a smooth-running proceeding, the cost will vary from EUR4,000-6,000 (including official and attorneys' fees). These figures do not include the drafting of the patent application.

Since utility model registration procedures are shorter and less complex, the total cost of the whole registration procedure will vary from EUR2,000-4,000.

### **1.4 Term of Each Intellectual Property Right**

Patent protection lasts for 20 years, whereas utility model protection lasts for ten years as of the application date.

### **1.5 Rights and Obligations of Owners of Intellectual Property Rights**

Patent and utility model holders are entitled to:

- prevent others from using their inventions;
- seek legal remedies (such as infringement actions and compensation claims) to protect their rights, including the right to an injunction; and
- assign their intellectual property rights, sign licence agreements, or put pledges on the patent or otherwise dispose of it.

Right-holders are obliged to pay the annual renewal fees.

The patent file submitted to and registered with the TPTO becomes publicly available and may be reviewed by any interested person. The TPTO's online system allows the public to conduct searches of its [online database](#). One can conduct such searches for a patent based on its applicant, invention summary, invention headline, IPC class or Cooperative Patent Classification (CPC) class.

## 1.6 Further Protection after Lapse of the Maximum Term

There is no further protection after the expiration of protection dates.

## 1.7 Third-Party Rights to Participate in Grant Proceedings

Third parties are entitled to file third-party observations after the publication of the patent/utility model application. If these observations are filed before the preparation of the search report, they may be considered during the preparation of the report. Even so, the third party filing the observation does not become a party to the proceedings.

Third parties are entitled to oppose the patent within six months from the publication date of the grant of the patent. This post-grant opposition procedure is not available for utility models.

As for utility models, third parties are also entitled to submit observations and objections against the application within three months of the publication of the search report.

## 1.8 Remedies against Refusal to Grant an Intellectual Property Right

Applicants are entitled to file actions within two months of the notification date of the decision before the first instance intellectual and industrial property rights civil courts of Ankara for the cancellation of a negative and finalised decision of the TPTO.

## 1.9 Consequences of Failure to Pay Annual Fees

The failure to pay annual fees results in loss of rights.

- If the intellectual property right is granted, failure to pay the annual fees results in the loss of the rights arising from the patent/utility model.
- If the application process is ongoing, it results in the invalidity of the application.

Annual fees must be paid every year on the date that the application was filed, starting two years after the application date (when the second year is completed, and the third year starts). It must be noted that right-holders must pay the annual fees even if they are not notified in this regard. If the fee is not paid on this date, it is possible to pay within six months provided that an additional fee is paid.

Annual fees differ for patents and utility models, and also for every year. The fees can be found on the [TPTO website](#).

The IPC provides another option for patent holders and applicants, who are allowed to reinstate rights by paying the relevant fees. The IPC allows patent holders to revive a patent which has lapsed due to failure to pay the annual maintenance fee in time. To revive such a patent, the right-holder must deposit the penalty fee within two months of the TPTO notifying them that the patent has lapsed. The patent will become valid again for a further year, running from the fee payment date.

## 1.10 Post-grant Proceedings Available to Owners of Intellectual Property Rights

Article 99 of the IPC provides a post-grant opposition system, whereby third parties can oppose a patent within six months of the publication of the decision stating that the patent is granted. Upon the TPTO notifying the patent owner about an opposition, the patent owner can file a response or amendments to the patent within three months. If the Re-examination and Evaluation Board (Board) examines the opposition and finds that the patent conforms with the IPC, it will refuse the opposition. If the Board concludes that the patent partially conforms to the law, it will confirm the partial validity. It will inform the patent owner accordingly, requesting the amendment of the patent in line with partial approval. If no amendments are filed (or the amendments are not approved), the patent will be invalidated.

Otherwise, the claims of a Turkish patent cannot be amended by the patent holder after the grant of protection. However, Article 140 of the IPC states that the right-holder may restrict its right to the patent, either in full or partially, for one or more claims. The IPC allows for the cancellation of a whole claim; however, it does not provide the right to amend the claim. Where the patent is restricted in part, the patent remains in force for the claims which have not been cancelled.

## 2. Initiating a Lawsuit

### 2.1 Actions Available against Infringement

#### Settlement and Mediation

If the parties seem open to the discussion of a settlement, the right-holder may choose to contact the infringing party through a warning letter and may come to terms by signing a settlement agreement.

Moreover, under Turkish Law, mediation has recently become a prerequisite for filing lawsuits concerning commercial disputes with monetary claims, including IP-related disputes. If a lawsuit is filed without applying for mediation first, the case will be dismissed with respect to compensation claims ex officio on procedural grounds, without any further examination of the merits, and the examination will continue with respect to other claims such as elimination of the infringement and seizure of infringing items (if any).

#### Court Proceedings

The most effective way for a patent owner to enforce their rights is to initiate an infringement action against the alleged infringers before the specialised intellectual and industrial property rights civil courts.

Such infringement actions are generally started with a preliminary injunction claim and the discovery and determination of evidence.

To obtain an injunction, the requesting party must prove that, if the injunction is not granted:

- irreparable harm will arise; or
- the outcome the requesting party seeks in its main action will be unlikely to be achieved.

The preliminary injunction procedure may be initiated with or before the main action. However, if the court accepts the preliminary injunction claim, the main action should be filed within two weeks.

The right-holder is also entitled to request the discovery of evidence before filing the main action. According to Article 400 of the Civil Procedural Law, any party is entitled to request the court to conduct a site visit or expert examination, or to hear a witness, on the condition that the requesting party will receive a legal benefit in filing such a request. The condition of the legal benefit is deemed to be met if the evidence will be lost or very difficult to collect unless it is immediately secured. The determination of evidence is a preliminary measure and is therefore conducted immediately. After the evidence is examined, an expert report is obtained. An important point is that, during the determination of evidence procedure, no evidence (eg, infringing products) is seized.

Infringement actions may be subject to alternative dispute resolution (ADR).

## 2.2 Third-Party Remedies to Remove the Effects of Intellectual Property

### Invalidation Actions

According to the IPC, "Persons concerned, Public Prosecutors or the relevant public institutions and organisations may request the invalidity of patent". Therefore, third parties may initiate invalidation actions. While initiating these actions, third parties may also request a preliminary injunction to prevent the right-holder enforcing their rights. However, the courts are generally reluctant to render such preliminary injunction decisions.

The IPC also introduced a post-grant opposition system, whereby third parties can oppose a patent within six months of publishing the decision stating that the patent is granted. Within this opposition, they may argue that:

- the patent does not meet the patentability criteria;
- the invention is not disclosed in a sufficient manner; or
- the patent exceeds the scope of the initial application.

### Non-infringement Decisions

Obtaining a declaratory judgment in which a court determines that infringement has not occurred (a "non-infringement determination") is a key pre-emptive defensive measure.

### Compulsory Licensing

The IPC sets certain conditions for granting a Compulsory Licence (CL) in Turkish practice and regulates the following CL request/grant proceedings, respectively.

- In the case of non-use arguments - the courts are entitled to handle these requests.
- In the case of interdependency of the subjects of the patents - the courts are entitled to handle these requests.
- In cases where plant breeders cannot develop a new type of plant without infringing on a preceding patent.
- In cases where patent holders engage in activities that prevent, distort or restrict competition while using the patent - the Turkish Competition Authority is entitled to handle these requests.
- To meet the requirements of the Doha Declaration (the export of pharmaceutical products to foreign countries experiencing public health problems) - the courts are entitled to handle these requests.
- In the interest of public order - Turkey's Ministry of Health and the Ministry of National Defence are entitled to request these CLs and the President decides on the granting.

Even though actions for CLs are possible in Turkey they are very rarely seen.

## 2.3 Courts with Jurisdiction

### First Instance

All patent cases are handled by the specialised IP courts, which exist only in Istanbul, Ankara and Izmir. In other cities, the Third Civil Court of General Practice is authorised.

According to the general jurisdiction rules of the Civil Procedural Law No 6100 (CPL) and specific rules of the IP Law, several courts are authorised to handle disputes. These include:

- the court of the domicile of the defendant;
- the court of the domicile of the plaintiff;

- the court of the place where the infringing act was carried out; and
- the court of the place where the act of infringement produced its effects.

In addition, Article 156 of the IP Law determines the jurisdiction of the courts.

Accordingly, jurisdiction is determined on the following basis.

In actions which are initiated by the right-holder against third parties, if the plaintiff resides in Turkey, the courts in the following places have jurisdiction: the domicile of the plaintiff or the place where the infringement takes place (or the place where the infringing acts have their results).

Where the plaintiff is not domiciled in Turkey, the court of the place where the registered patent attorney resides has jurisdiction. If there is no registered attorney, the court where the TPTO is located has jurisdiction.

In actions initiated by third parties against the right-holders, if the defendant resides in Turkey, the courts where the defendant is domiciled have jurisdiction. If the defendant does not reside in Turkey, the court of jurisdiction is the court in the location of the business of the plaintiff's agent. If the agent's record has been deleted from the registry, the court of jurisdiction is one of the specialised IP courts of Ankara, where the TPTO is located.

Generally, both the plaintiff and the defendant will prefer the dispute be handled by the IP Courts - as long as the jurisdiction rules allow the action to be filed in Istanbul, Ankara or Izmir - since these courts have extensive knowledge of IP disputes.

## Second Instance

The first-instance courts' decisions can be challenged before the Regional High Court.

## Third Instance

The Court of Appeal is the third and final judicial authority.

## 2.4 Specialised Bodies/Organisations for the Resolution of Disputes

The parties are always entitled to settle the issue amicably at any stage of the proceedings. As to arbitration, it is widely accepted that the disputes regarding the invalidation of a patent cannot be subject to arbitration since the results of ADR are only binding on the parties, but such a dispute relates to the official registry and the TPTO is not a party to the invalidation action. However, it is accepted that a declaratory action for non-infringement, or infringement actions, may be subject to ADR. However, ADR is still not as effective as court proceedings.

Moreover, Turkey has recently adopted new legislation requiring an application to mandatory mediation for monetary claims arising from trade law disputes, including intellectual property disputes (see **2.1 Actions Available against Infringement** for further detail). In addition, during the period between the application to the mediation bureau and the preparation of the final report by the mediator, the statute of limitations will be suspended.

The parties can apply to the Mediation Bureau within the jurisdiction of the competent court with regard to the subject of the dispute at hand.

## 2.5 Prerequisites to Filing a Lawsuit

As explained in **2.1 Actions Available against Infringement**, mediation has recently become a prerequisite for filing lawsuits concerning commercial disputes with monetary claims, including IP-related disputes.

## 2.6 Legal Representation

It is not obligatory to be represented by a lawyer in IP matters, parties can therefore represent themselves. However, although representation is not mandatory, it is common/advisable given the complexity of the matters involved and the unique procedural law principles.

## 2.7 Interim Injunctions

Interim injunctions are available in Turkish Law.

As intellectual property rights can be irreparably and irrecoverably damaged by third-party acts, injunctions play a significant role in litigation. Injunctions are effective tools in patent litigation to preserve the results which plaintiffs hope to achieve.

The legal framework and criteria for injunctions in Turkey are outlined by the CPL and the IPC.

Injunctions can be obtained before or during a trial. To obtain an injunction, the requesting party must prove to the court's satisfaction that:

- irreparable harm will arise if the injunction is not granted; or
- the outcome which the requesting party seeks in its main action will be unlikely to be achieved unless the injunction is granted.

The IP courts are conservative in rendering preliminary injunction decisions, as such decisions generally lead to the restriction of property rights and/or commercial activities.

### Procedure

In patent litigation, upon receipt of a preliminary injunction request, a common approach for a court is to handle the preliminary injunction procedure as follows.

- Even though it is left to the discretion of the judge to conduct the preliminary injunction proceedings *ex parte* or *inter partes*, the judges generally determine a hearing date to hear both parties' arguments on the injunction; the hearing is generally scheduled within a month of the request.
- At the hearing, the judge decides to send the file for expert examination, as the merits of patent litigation generally involve technical issues; the report is prepared within one to two months.
- The judges generally grant their decision in line with the report in return for payment of a guarantee; this guarantee will be between EUR€5,000-100,000, or more depending on the value of the patent and the parties' economic situation.
- The expert report is notified to the parties, who then have two weeks to file objections.

These steps generally take around one to three months.

## 2.8 Protection for Potential Opponents

There are no options provided to a potential opponent. However, under Article 159/2-c of the IPC, the court may require the defendant to deposit a guarantee for the possible losses to the plaintiff from a preliminary injunction. Which type of preliminary injunction shall be applied is left to the sole discretion of the judge.

## 2.9 Special Limitation Provisions

There are no special limitation provisions for patent infringement actions. The general rules apply.

As for a patent invalidation action, the action can be filed during the patent protection term and up to five years afterwards.



As for patent infringement actions, these actions can only be filed following the publication of the patent. However, if the defendant has been informed about the patent and its scope, the action may be filed before the application date. The limitation period for infringement actions, including compensation claims, is two years as of the date on which the infringement and the infringer are discovered, and a maximum of ten years as of the infringing action(s). As long as the infringing actions continue, the limitation period does not start running.

## 2.10 Mechanisms to Obtain Evidence and Information

### Evidence Determination

Article 400 of the CPL describes the procedures concerning determination of evidence. According to these, any party is entitled to request the court to conduct a site visit or expert examination, or to hear a witness, on the condition that the requesting party will receive a legal benefit in filing such a request. The condition of the legal benefit is deemed to be met if the evidence may be lost or very difficult to set forth unless it is immediately secured.

The determination of evidence should be requested through a petition, either before filing or during the action. If the request is filed before filing the action, it should be filed before the competent court of jurisdiction to handle the main action. As to the timeline, the determination of evidence is a preliminary measure and is therefore conducted immediately. The counterparty has the right to oppose the determination of evidence decision of the court within one week as of the notification date. If the counterparty does not oppose, the determination of evidence is performed one week after the request.

### Expert Reports, Evidence Seizure and Other Issues

Generally, judges give around one month to the expert to prepare their report. The report should not include any conclusions as to the merits of the case, but the report should simply assess the existing situation or secure the evidence. It is important to underline that during the determination of evidence procedure, no evidence, such as infringing products, are seized.

In order to seize the evidence, a preliminary injunction decision should be granted by the court, as such a seizure directly affects property rights.

Additionally, under Article 288 of the CPL, the judge may decide that discovery should be conducted ex officio or upon the claim of one of the parties in the courts or in the place of the dispute. Within the scope of discovery, the judge can also decide to have expert assistance regarding the technical aspects of the dispute.

### Compensation

Moreover, according to Article 150/3 of the IPC, the right-holder:

- before instituting a legal proceeding for compensation related to infringement of an industrial property right, in order to determine the evidence; or
- if a legal proceeding for compensation has been instituted, in order to determine the amount of damages,

may ask the court to order the person responsible for compensation to submit to the court the documentation related to the use of the industrial property right.

## 2.11 Initial Pleading Standards

The procedures for intellectual property lawsuits are regulated in the CPL; therefore, no special provisions apply to pleading standards in patent litigation.



The parties must submit all arguments and supporting evidence before the preliminary examination hearing, which is held after the exchange of petitions phase. As the court invites the parties to the preliminary examination hearing, the court grants the parties two weeks' peremptory additional time as of the receipt of the notification to submit missing evidence. According to the CPL, the parties can change their arguments with their reply petitions; otherwise, widening and amending of the claims or defence are not allowed.

Additionally, after this limited time frame, if a party explicitly consents to it, the other party may change its claims or arguments. If one of the parties is not present at the preliminary examination hearing without any valid excuse, then the present party is permitted to change or extend their argument without seeking the counterparty's consent.

## 2.12 Representative or Collective Action

Turkey has no mechanisms for class or collective actions.

However, depending on the type of the action, plaintiffs and defendants may number more than one. For example, the plaintiffs may include the patent owner and the licensee and there may be multiple defendants.

## 2.13 Restrictions on Assertion of an Intellectual Property Right

In principle, the enforcement of a patent does not constitute an anti-trust violation, as using a legal right cannot be deemed to be unlawful according to the Turkish Constitution. However, there could be liability in the case of an abuse of a legal right causing an antitrust violation. In such a case, the antitrust issues should be separately examined. It must be noted that the Turkish Competition Authority (TCA) does not have any precedent for the enforcement of patent rights and its relationship with antitrust law.

The IP Law sets certain and exceptional conditions for granting compulsory licences, which are very rare. Such compulsory licence conditions may be interpreted as a restriction on IP rights.

# 3. Infringement

## 3.1 Necessary Parties to an Action for Infringement

According to the IPC, the patent owner is entitled to file infringement claims. Unless otherwise agreed in the licence agreement, the exclusive licensee is entitled to file an infringement action on behalf of themselves.

For non-exclusive licence agreements, by default, the licensee does not have direct rights to file an infringement action. The non-exclusive licensee can ask the patent owner to file an action against a patent infringement, unless it is otherwise limited in the agreement. If the patent owner does not take the requested action within three months, the non-exclusive licensee can file the action themselves.

Distributors cannot file patent infringement actions, unless they are licensees.

No other party can file patent infringement actions.

## 3.2 Direct and Indirect Infringement

Indirect patent infringement is not explicitly set forth under the infringement rules in the IPC. Instead, according to Article 86 of the IPC, the patentee is granted a right to prevent the factors or equipment regarding a part which makes the practise of the invention subject to a patent possible, and which constitute the basis of the invention, from being released by third parties to parties who do not have an authority to use the invention subject to a patent.

To apply this article:

- the third party must know such elements and means are sufficient to apply the invention;
- the third party must know such elements and means shall be used for infringement purposes; and
- these issues should be reasonably clear.

In cases of direct infringement, the infringing action should directly comply with the actions listed in the law and must include all features of the patent. In an infringement action, the defendant is the party who takes the mentioned infringing actions.

### 3.3 Process Patents

There are several provisions that the holder of a process patent can rely on during the proceedings.

According to Article 141/2 of the IPC, if the subject of a patent is related to a process for obtaining a product or material, the court may ask the defendant (instead of the plaintiff) to prove that the process used for obtaining the same product or material was different from the patented process.

Moreover, if the product obtained by using the patented method is new, it is deemed that the same product or material is produced by the patented method. Anyone who claims otherwise is obliged to prove it.

### 3.4 Scope of Protection for an Intellectual Property Right

The scope of protection of the patent is determined by its claims. The description and drawings are also taken into account when interpreting the claims. The claims are not interpreted word for word, but the scope of protection cannot be extended to the features that are obvious to an expert yet not clearly written in the claims.

When determining the scope of protection, all elements equivalent to those defined in a claim are also considered. If an element performs the same function and provides the same result as that specified in a claim, that element is accepted as equivalent.

Moreover, to determine the scope of the patent, the statements of the patent owner made during the prosecution history and the validity term of the patent are also considered.

### 3.5 Defences against Infringement

#### **Patent Cancellation**

The most common strategic defence is to request the cancellation of the patent. Even though there is no bifurcated system in Turkey, cancellation proceedings still affect infringement actions. In other words, the court awaits the outcome of the cancellation action regarding the patent before deciding on the infringement.

#### **Bolar Exemption**

The Bolar exemption is another common defence, especially in pharma litigation. Pursuant to this exemption, the patent owner cannot prevent third parties' experimental activities. These activities include performing experiments with an invention subject to a patent, the licensing of pharmaceuticals, and performing all necessary tests and experiments.

#### **Exhaustion of Rights**

Another defence might be the exhaustion of rights principle. Turkish Law adopts the international exhaustion principle; that is, if a product is sold anywhere in the world, the right to first sell is exhausted, and the original product can be sold by anyone.

## Personal Use

Personal or experimental use of the invention may be brought forward as a defence in an infringement action, as such actions are clearly excluded from the scope of protection of the patent.

## Prior Use

According to Article 87 of the IPC, prior use may also be used as a defence against infringement claims. If third persons have been using the patent in Turkey or taken real and serious measures in good faith at or before the application date, the patent holder cannot prevent such activities. Such activities should always be proportionate and cannot be extended to harm the rights of the patentee.

## Agricultural Defences

Additionally, farmers are allowed to use production materials resulting from production performed on land if they have themselves cultivated it with a patented product that is:

- sold by the patent owner;
- used with its permission; or
- obtained through other commercial means.

Farmers can also use patented breeding or other animal reproduction materials sold by the patent owner, or used with its permission, or obtained through other commercial means for agricultural purposes.

## 3.6 Role of Experts

The judges of the IP courts do not have a technical background and appoint experts to understand the technical merits of a case. As a result, these expert witnesses play a significant role in patent disputes. It is reasonable to say that these reports determine the judge's decision in most cases.

Experts submit their opinion in writing. If the judge deems it necessary, further questions may be addressed to the experts to shed light on the technical merits of the case or to clarify contradictions. Experts must attend the examination hearing if the judge orders them to do so and respond to questions put to them.

The experts are appointed by the court. However, if the parties agree on experts, they may suggest them to the court. In any event, their suggestions must be approved by the court.

## 3.7 Procedure for Construing the Terms of the Patent's Claim

There is not a separate procedure for construing the terms of the patent's claims. In the case of an invalidation action, the patent's claims are examined by the court. Generally, the judges appoint experts to prepare a report in this regard.

## 3.8 Procedure for Third-Party Opinions

Expert witnesses play a significant role in patent disputes. Please see **3.6 Role of Experts**.

Moreover, the CPL regulates that the parties to a lawsuit may obtain further information from an independent expert about the subject of the lawsuit. The judge, upon request or ex officio, may decide to invite and listen to the expert from whom this information is obtained.

Turkish Law does not set forth amicus briefs. Only the parties to the action or parties duly invited to the action to defend or plead can submit opinions and statements. The parties, however, are entitled to submit private expert reports as stated in **3.6 Role of Experts**.

## 4. Revocation/Cancellation

### 4.1 Reasons and Remedies for Revocation/Cancellation

Under Article 138 of the IPC, a patent is declared invalid by the court if the:

- patentability requirements are not met;
- invention has not been described in a sufficiently explicit and comprehensive way 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; and
- patent exceeds the scope of its protection.

### 4.2 Partial Revocation/Cancellation

Under the IPC, a court can partially invalidate a patent for one or more claims. However, a single claim cannot be partially invalidated.

For partial invalidation of a patent, the remaining claims of the patent must fulfil the patentability requirements, which are novelty, inventive step and applicability to industry.

If an independent claim is invalidated, the dependent claims remain intact if they meet the patentability criteria.

### 4.3 Amendments in Revocation/Cancellation Proceedings

During the post-grant opposition proceedings before the TPTO, it is possible to amend claims.

During invalidity actions before courts, where the grounds for invalidity concern only part of a patent, a partial invalidity shall be ruled by cancellation of the claims pertaining to that part. An individual claim may not be partially invalidated. In other words, a claim may not be amended, but may be cancelled as a whole.

On the other hand, a European patent validated in Turkey may be limited by amending those claims in proceedings before the courts or authorities that relate to the validity of the European patent under Article 138/3 of the European Patent Convention. The patent, thus limited, shall form the basis of the proceedings. It should be noted that the practice of this Article and the precedents whereby such requests are accepted are very few.

### 4.4 Revocation/Cancellation and Infringement

Turkey does not have a bifurcated system, and invalidity and infringement procedures are separated. Invalidation actions can be filed either separately or as a counterclaim within the timeframe to respond to the infringement claim in an infringement proceeding. If the invalidation is filed as a counterclaim, both the infringement and the invalidation claim are handled by the same court regardless of the jurisdiction rules. At the end of the case, the invalidation claim is concluded first since it is about the validity of the patent, which is also the basis of the infringement claim.

Even if the invalidation is filed separately, these actions are considered to be closely associated. The outcome of invalidation is awaited in the infringement action or the cases may be combined.

Generally, the proceedings before the first instance courts both for infringement and invalidation take around 18-24 months.

## 5. Trial and Settlement

### 5.1 Special Procedural Provisions for Intellectual Property Rights

The general procedural provisions are set out by the CPL and are the same for all civil proceedings.

Even though some steps may change based on the nature of the dispute, the phases of a civil action in general are as follows.

If there is a preliminary injunction request, such request is initially examined. The court will conduct such examination before or during a hearing.

Once the plaintiff's petition is duly served to the defendant, the defendant is obliged to submit a response within two weeks. Following the defence notification, the plaintiff is also obliged to respond within two weeks. Subsequently, the defendant can submit their second response to the plaintiff's counter-arguments within two weeks as of the receipt. The defendant's submission to the plaintiff's counter-statement concludes the exchange of petitions phase. The exchange of petition phase usually takes three months. After this phase, the judge determines a hearing date.

Upon the end of the exchange of the petition phase, the preliminary examination phase begins. In this phase, the court examines the conditions of the conflict between the parties. This examination is considered as a preparation for the analysis of the merits of the case. The parties should file their evidence and arguments within two weeks as of the receipt of the invitation to the preliminary examination hearing date. After that, new evidence and arguments may only be filed with the consent of the counterparty.

After the preliminary examination phase, the investigation phase begins. The court evaluates evidence submitted as well as investigating the accuracy of the facts alleged by the parties. In order to examine the submitted documents' accuracy, the court may decide to confer with an expert witness. After the expert witness report gets delivered to the parties, the parties are entitled to file comments or objections against the report. Prior to the decision, the court evaluates the report and comments. If the court finds the report adequate, it does not ask for an explanation and concludes the investigation phase. However, if the report is considered inadequate, further explanation can be requested from the expert, or another expert panel can be assigned. Expert examination is almost obligatory in patent cases due to case law, because of their technical nature. Expert reports are obtained in writing at investigation stage. The court is entitled to invite the experts to the hearing and in such cases, the attorneys of the parties are entitled to pose questions to the experts directly. However, generally the judges prefer this route, including patent litigation, with very limited exceptions. If there is a request for compensation, the file is also conferred to an accounting expert for calculation.

Following the conclusion of the investigation phase, the judgment phase begins. In this final phase, the judge renders a decision after examining the accuracy of the claims. The judge then prepares the reasoned judgment, which is then served to the parties upon request. According to the Turkish Procedural Law, the plaintiff bears the costs of the proceedings. Once a final verdict has been proclaimed by the court, the legal proceedings' official expenses are paid by the losing party to the adverse party. If there is a compensation claim regarding damages caused by infringement, the case has to be referred to mandatory mediation before the case is filed. Generally, the proceedings before the first instance courts take around 18-24 months, after a series of hearings are conducted.

## 5.2 Decision-Makers

All patent cases are handled by the specialised IP courts, which exist only in Istanbul, Ankara and Izmir. In other cities, the Third Civil Court of General Practice is authorised. All first-instance courts, including the IP courts, consist of one judge. The parties are not allowed to choose the judge who will hear the case. Jury proceedings are not applicable under the Turkish legal system.

Regional courts and the Court of Appeals have a minimum of three judges.

While the judges in the specialised IP courts have a significant understanding of the Industrial Property Law, they do not have a technical background and commonly appoint experts to better understand the technical merits of a case.

## 5.3 Settling the Case

According to the CPL, during the preliminary hearing, the courts recommend settlement and mediation to the parties. In this regard, if the judge is of the opinion that the conflict could be resolved by settlement/mediation, the preliminary hearing will be postponed once.

For further detail regarding mandatory mediation, please see **2.1 Actions Available against Infringement**.

## 5.4 Other Court Proceedings

Please see **4.4 Revocation/Cancellation and Infringement** for discussion of the relationship between invalidation and infringement actions and how the outcome of one may affect the other.

The concept of the anti-suit injunction is not recognised in Turkish law, and courts are not obliged to consider foreign anti-suit injunctions. However, within the scope of patent invalidation or determination of non-infringement actions, the plaintiff can request the patent owner to be prevented from using its rights arising from the patent registration for itself or its clients as a preliminary injunction (PI). In case of such a PI, the patent owner is restricted from filing an infringement action and a PI request. Otherwise, its actions shall be considered as breaching the granted PI. In any event, such PIs are quite exceptional and granted very rarely.

# 6. Remedies

## 6.1 Remedies for the Patentee

Typical remedies granted to successful plaintiffs in main infringement actions include:

- compensation for damages (moral, material and reputational);
- the destruction of infringing products;
- the confiscation of manufacturing tools; and
- the publication of the judgment.

### Damages

As per the IPL, "damages" means actual damage and lost profits. "Actual damage" is the net decrease in the requesting party's assets. The requesting party may also ask for lost profits, which are calculated based on one of the following methods set out in the IPL:

- the income which the patent owner would have generated if the infringing party's competition had not existed;
- the infringer's income; and
- the amount that the infringer would have paid as an appropriate licence fee had the parties entered into a licensing relationship.

Generally, plaintiffs are reluctant to request compensation, as the calculation of the compensation may be problematic, considering the unrecorded nature of much of the economy and improperly kept trade books. It is common for plaintiffs to receive less compensation than they request. Thus, choosing the calculation method based on a licence fee is more common.

Punitive damages are not available under Turkish law. However, under Article 150/2 of the IPC, where the industrial property right is infringed, additional compensation may be claimed if the reputation of the industrial property right suffers damage because the products or services forming the subject of the right are used or produced in an inferior manner; or such products produced in this way are made available or launched to the market in an improper manner.

If losing party does not comply with the court order and pay compensation, it could be enforced through enforcement offices.

## **Other Remedies**

The most common remedies accepted at the end of an action are the destruction of the infringing goods and the prevention of the counterparty from committing infringing actions.

While the confiscation of manufacturing tools is executed, it is important to be proportionate and not to prevent the defendant from continuing its trading activities with respect to non-infringing goods.

## **Costs**

Losing parties bear the costs, including the successful party's official attorneys' fees. The official attorneys' fees are determined in line with the annual tariff declared by the Turkish Bar Union. The official attorneys' fees are also collectable through enforcement offices.

### **6.2 Rights of Prevailing Defendants**

The losing party bears the litigation costs and attorneys' fees.

### **6.3 Types of Remedies**

There are not different types of remedy for patents and utility models. The same remedies are valid for both types of IP right.

### **6.4 Injunctions Pending Appeal**

Decisions relating to intellectual and industrial property rights can only be enforced once they are finalised (after both stages of appeal).

Unless otherwise specified, the effect of the preliminary injunction continues until the decision regarding invalidity/infringement is finalised. According to the CPL, a preliminary injunction can be requested at any stage of the proceedings, and it can be re-evaluated if the conditions change. Thus, if the preliminary injunction was not accepted at the beginning of the action and then the action is accepted before the first instance, the plaintiff may request a preliminary injunction at the appeal stage. Still, the acceptance of preliminary injunction requests at the appeal stage is not common.

## **7. Appeal**

### **7.1 Special Provisions for Intellectual Property Proceedings**

There are no special provisions concerning the appellate procedure for intellectual property rights proceedings. It is regulated by the general provisions set out by the CPL.

### **7.2 Type of Review**

Second instance appeals before Regional High Court imply a full review, including the facts of the case as well as the legal review.

In third instance appeals against the Regional High Court's decisions, before the Court of Appeal, the examination is limited to legal review.



## 8. Costs

### 8.1 Costs before Filing a Lawsuit

There are no protective briefs available in Turkish law.

If parties send notarised letters or conduct e-determination, notarisation costs will arise. However, these costs may vary depending on the evidence determined or on the pages of the letter.

The average cost of a notarised letter is TRY 600-800, whereas average e-determination costs are TRY650-750.

### 8.2 Calculation of Court Fees

At first instance, the official fees and expenses - excluding the expert fee for patent actions without claiming damages - are around TRY4,000.

If the case is referred to an expert body, the expert fee can be around TRY2,000 - 5,000 per expert. Considering these cases are generally examined by an expert committee consisting of three experts, the expert fee can be around TRY6,000-15,000. The minimum attorneys' fee determined in line with the annual tariff declared by the Turkish Bar Union is TRY 7,375 in cases of invalidation actions and infringement actions without claims for damages. If there is a compensation claim, the official attorneys' fees are calculated in percentages depending on the amount requested.

Professional attorneys' fees may vary depending on the complexity of a case.

### 8.3 Responsibility for Paying the Costs of Litigation

In general, the plaintiff bears the litigation costs until the end. The losing party bears the official litigation fees and official attorneys' fees of the counterparty.

## 9. Alternative Dispute Resolution

### 9.1 Type of Actions for Intellectual Property

Disputes regarding the invalidation of a patent cannot be subject to arbitration since the results of ADR are only binding for the parties. An invalidity dispute relates to the official registry and public policy.

However, negative declaratory and infringement actions may be subject to ADR.

Moreover, under Turkish Law, mediation has become a prerequisite for filing lawsuits concerning commercial disputes with monetary claims. Please see **2.1 Actions Available against Infringement**.

## 10. Assignment and Licensing

### 10.1 Requirements or Restrictions for Assignment of Intellectual Property Rights

Assignment of patents and utility models must be in writing and notarised. Approval from the notary public is a validity condition for assignments. The recordal of the assignment to the registry is not compulsory, but rights arising from the assignments that are not recorded in the registry cannot be claimed against third parties acting in good faith. Therefore, it is highly recommended and good practice to have the assignments registered.

### 10.2 Procedure for Assigning an Intellectual Property Right

Initially, parties should execute an assignment agreement in writing.

The assignment agreement should be signed by the representatives of the parties and notarised.

After notarisation, the assignment is duly completed and valid.

As a rule, it is optional to record the assignment agreement with the TPTO. The recordal only has an explanatory effect.

If a party files a request and pays the fee, the assignment is recorded before the TPTO and published in the Official Bulletin.

### 10.3 Requirements or Restrictions to License an Intellectual Property Right

Licence agreements must be in writing. Notarisation or notification to the TPTO is not obligatory. Rights arising from licence agreements that are not registered in the registry may not be claimed against third parties acting in good faith. Therefore, it is highly recommended and good practice to register the licence agreement.

### 10.4 Procedure for Licensing an Intellectual Property Right

Initially, parties should execute a licence agreement in writing.

Notarisation or legalisation is not required for licensing.

As a rule, it is optional to record the licence agreement with the TPTO. The recordal only has an explanatory effect.

However, as with assignment agreements, it is advisable to record the licence agreement before the TPTO.

If a party files a request and pays the fee, licensing is recorded before the TPTO and published in the Official Bulletin.

Additionally, the patent applicant/patent owner can declare that they will issue a licence to anyone who wishes to use the invention subject to the patent with a written request to the TPTO. The TPTO publishes the licensing offer accordingly.

*\*This content was originally published in [Chambers and Partners' Patent Litigation Guide](#).*

## Related Practices

- [Patents and Utility Models](#)
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