

## Turkey

### Administrative procedure

#### Opposition

On 10 January 2017, the new Turkish Industrial Property Law (Law No. 6769 of December 22, 2016, on Industrial Property, hereinafter Law No.6769) entered into force, replacing Decree-Law No 551 of 1995 and introducing a number of new features, one of which is the post-grant opposition system. The name of the “Turkish Patent Institute” has been changed to “Turkish Patent and Trademark Office” (hereinafter “Patent Office”).

Law No. 6769 introduced a system of both pre-grant observations and post-grant oppositions.

#### Pre-grant observations

Following publication of the patent application under Art. 97, any person may present observations concerning the patentability of the invention. The person filing them may not be a party to the proceedings before the Patent Office.

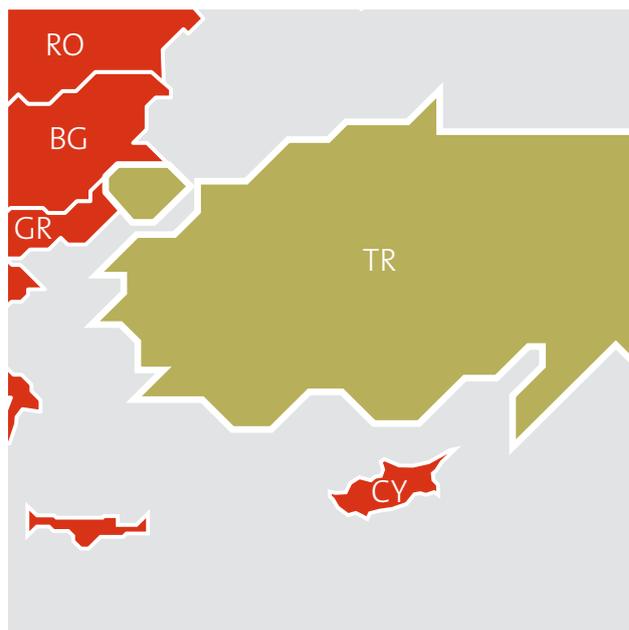
#### Post-grant oppositions

Art. 99 Law No. 6769 on post-grant opposition corresponds to Art. 99 EPC. Post-grant opposition conforms to the procedure provided by the EPC. According to Art. 99 Law No. 6769, opposition to any patent granted by the Patent Office may be filed by third parties. Opposition must be filed within six months of the publication of the mention that the patent has been granted, time period for opposition is shorter than the one in Art. 99 EPC, which is nine months. The proprietor of the patent has the opportunity to amend his patent during the opposition procedure (Art. 99(6) Law No. 6769).

There are three possible outcomes at the end of the opposition proceedings (Art. 99(5) and (6) Law No. 6769):

- a) the opposition is rejected and the patent is maintained as granted,
- b) the patent is maintained in an amended form, in which case a new patent specification is published,
- c) the patent is revoked.

Turkish courts wait for the outcome of opposition proceedings at the Patent Office before making a decision relating to the validity of affected patent claims (Art. 138(2)



Law No. 6769). However, this provision is only applicable for national patent applications, as European patents being validated in Turkey will not be subject to post-grant opposition proceedings.

The procedures of “further processing” and “reestablishment of rights” are now introduced into the new law to offer remedy for patent applicants or patent holders in case of loss of rights.

#### Further processing (Art. 107(1) Law No. 6769):

If a patent application is to be refused or is refused or deemed to be withdrawn following failure to reply within a time limit, the application may proceed if the applicant makes a request for further processing of the application. If the applicant does not comply with the time limit regarding the processes of patent application, he may request, with a paid fee, the processes to be continued within two months as of the date of notification of outcome of non-compliance with time period. Otherwise, the request shall be refused. If the request is approved, the legal consequences of non-compliance within a specific time period shall be considered as not having occurred.

#### Re-establishment of rights (Art. 107(2) Law No. 6769)

An applicant for or proprietor of a European patent who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis the Patent Office shall have his rights re-established upon request if the non-observance of this time limit has the direct consequence of causing the refusal of the patent application or of a request, or the deeming of the application

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to have been withdrawn, or the revocation of the patent according to Art. 99, or the loss of any other right or means of redress. Any request for re-establishment of rights shall be filed within two months of the removal of the cause of non-compliance with the period, but at the latest within one year of expiry of the unobserved time limit. This request shall be made with a fee paid within two months as of time of elimination of the conditions causing non-compliance with the time period, on condition that the time period with which it was failed to comply is not exceeded more than one year. Otherwise, the request shall be refused. In case the request is approved, the legal consequences of non-compliance within a specific time period will be considered as not having occurred.

#### Restoration of a previous stage of the proceedings (Art. 108 Law No. 6769)

Except from the grounds for nullity specified in Arts. 138 and 144; in case of an incorrect continuation of processes of the application or the certificate, even though the patent or the utility model application or certificate does not meet the conditions; and in case of this situation being detected upon an objection or as a matter of course; the incorrect transaction and the following transactions shall be cancelled and the process shall restart from the phase at which the mistake was made.

#### Appeal

With respect to decisions taken by the Patent Office in registration procedures, an applicant or third party may appeal to the Re-examination and Evaluation Board. The Board shall consist of the Head of the Review and Evaluation Department and at least two expert members who are not charged with the decision.

Board decisions are final decisions of the Patent Office and cannot be appealed against these decisions again before the Patent Office. However, persons who are parties to the Board's decision may request the correction of material errors in the decision by stating their reasons in writing. If the Board detects material errors without any request, it shall correct the material errors *ex officio*.

An appeal may be filed against the final decisions of the Board within two months after the notification of the decision to the Ankara Specialised IPR Civil Court. The court examines the decisions of the Re-examination and Evaluation Board on points of both law and fact.

#### Civil procedure

There are 21 specialised IPR courts in Ankara, İstanbul and İzmir (five civil and seven criminal IPR courts in İstanbul, five civil and one criminal in Ankara, one civil and two criminal in İzmir). They are the first-instance courts dealing with all intellectual and industrial property cases. General civil courts of first instance and general criminal courts at first instance are competent to deal with IPR cases where specialised IPR courts do not exist. If there are one or two general civil or criminal courts, the first is competent to deal with IPR cases. If there are three or more general civil or criminal courts, the third is competent to deal with IPR cases. Although Law No. 6769 contains criminal sanctions in case of trademark infringement, it does not provide criminal penalties for patent infringement.

The Regional Courts of Appeal examine the decisions taken by the courts of first instance on points of law and points of fact. Regional Courts of Appeal have civil chambers and criminal chambers. The relevant civil chamber examines appealed decisions in IPR civil cases.

The Supreme Court is the final instance for reviewing decisions and judgments rendered by civil and criminal courts and which are not referred by law to other judicial authorities. The 11th Civil Chamber of the Supreme Court reviews the decisions in IPR civil cases.

#### Infringement

Actions can be brought to specialised IPR Civil Courts in Ankara, İstanbul and İzmir and to the general civil courts of first instance (numbered first or third) where specialised IPR civil courts do not exist, depending on the domicile of the claimant or on the place where effects of infringement have occurred.

Proceedings may be instituted by the patent owner or an exclusive licensee, unless otherwise provided in the contract; in any case the patent owner must be informed (Arts. 149 and 158 Law No. 6769)

#### Nullity/counterclaim for revocation

In any infringement proceedings, the court may not take into consideration any defence regarding invalidity unless the defendant brings a counteraction based on invalidity. According to Turkish law, counteraction however means an separate case rather than an ordinary defence.

Patents can be invalidated only by decision of a court (Art. 138 Law No. 6769), competent specialised IPR courts or the general civil courts.

Interested parties, public prosecutors, relevant public institutions and organisations may seek the invalidity of patent. If the patent owner does not have right to demand patent according to the Art. 109, invalidity of the patent may only be requested by right holder of invention or successors of holder of the invention (Art. 138(6) Law No. 6769).

Invalidity proceedings may be instituted against those who are registered in the register as the patent owner for the duration of patent protection or within five years following termination of the right. Notification shall be made to those who are deemed as right holders in the register to ensure that they may participate in the actions (Art. 138(5) Law No. 6769).

The court's decision has retroactive effect. If it decides that a patent is invalid, the decision takes effect retroactively and protection shall be deemed as null and void (Art. 139(1) Law No. 6769).

Partial nullification is allowed (Art. 138(4) Law No. 6769). If causes of invalidity are related to only a part of a patent, the claim or claims relating to only that part shall be cancelled and the partial invalidity of the patent shall be decided. Partial invalidity for a claim shall not be decided. If the claim or claims that are not revoked meet the patentability requirements in accordance with Arts. 82 and 83, the patent shall remain valid for this part. If the independent claim is revoked, each dependent claim that is subject to an independent claim does not separately have patentability conditions in accordance with Arts. 82 and 83, claims that are subject to the independent claim in question shall also be revoked by the court.

## Remedies

A patent owner whose patent is infringed may request the following from the court to:

- (a) determine the existence of infringement;
- (b) prevent an imminent infringement;
- (c) stop the infringing actions;
- (d) remedy infringement and compensate material and moral damages;
- (e) seize the products causing infringement or requiring penalty payments, as well as seizing instruments, such as devices and machines exclusively used in their production, without preventing the production of products other than infringing products;
- (f) be granted appropriation on products, devices and machines seized in accordance with subparagraph [(e)];
- (g) take measures to prevent the continuation of infringement, in particular at the expense of the infringer to change the shapes of products and instruments such as devices and machines seized according to subparagraph [(e)], to erase the trade marks on them or to destroy them if it is inevitable for preventing the infringement of industrial property rights;
- (h) if there is any justified reason or interest, announcement of the final judgment at the expense of the defendant in full or in part in daily newspapers or other means or notification to relevant parties;

Defendants found liable for infringement shall be obliged to compensate the damages to the patent owner.

Damage suffered by the patent owner includes actual loss and loss of revenue (Arts. 149 to 151 Law No. 6769).

## Other actions

Declarations of non-infringement may be issued by the court (Art. 154 Law No. 6769). Anyone who has an interest may request the right owner to provide an opinion on whether or not commercial or industrial activities being carried out or to be carried out or serious and actual attempts carried out for these purposes in Turkey would cause an infringement of his industrial property right. In the event that no opinion is given within one month after notification of this demand or if the opinion given is not accepted by the interested party, the interested party may institute a legal proceeding against the right owner for a declaration on non-infringement. The submission of an opinion shall not be a prerequisite for legal proceedings to be instituted. Proceedings may not be filed by a person against whom an infringement proceeding has already been instituted.

## Appeal

An appeal may be submitted to the Regional Courts of Appeal. These courts will have the authority to examine files coming from the first instance courts in terms of form and substance. Regional Courts of Appeal may either uphold or quash the decision of the first instance courts. In the latter situation, it may either send the case file to the relevant court of first instance for a rehearing or retry the case itself.

The Supreme Court is the final instance for reviewing decisions and judgments rendered by civil and criminal courts and which are not referred by law to other judicial authorities.

## Parallel proceedings

There is no provision in the law regarding parallel proceedings between national court and the EPO. Considering the facts of each case, it is at the court's discretion to decide whether proceedings will be stayed or not.

## Arbitration/mediation

The amendments to Law no. 7155 "Law on Commencement of the Proceedings Relating to Pecuniary Claims Originating from Subscription Contract" which entered into force on 19 December 2018, introduced a mandatory mediation process before litigation for commercial disputes starting from 1 January 2019. Within the framework of this law, mediation is mandatory for patent-related disputes that deal with the following:

- a) payments and damages compensation;
- b) licence agreements; and
- c) transfer of IP rights.

Arbitration is not mandatory for patent-related disputes. However, disputes regarding employee inventions, amount of compensation, mode of payment and any other dispute that falls under the scope of the Regulation on Employee Inventions, Inventions Realised within Higher Education Institutions and Inventions Arisen from Projects Supported by Public Authorities, must be solved via arbitration.

## Enforcement

Following the court's decision, the bailiff is responsible for enforcing orders during the proceedings (e.g. preliminary injunctions, orders for preserving evidence, freezing orders, etc.).

## Compulsory licence

The competent courts (specialised IPR civil courts or the general civil courts of first instance) may grant compulsory licences in cases of non-working, dependent patents, public interest, exportation of pharmaceutical products for export to countries with public health problems, compulsory licences for plant breeder and anti-competitive practices (Art. 129 Law No. 6769)

## Relevant national law

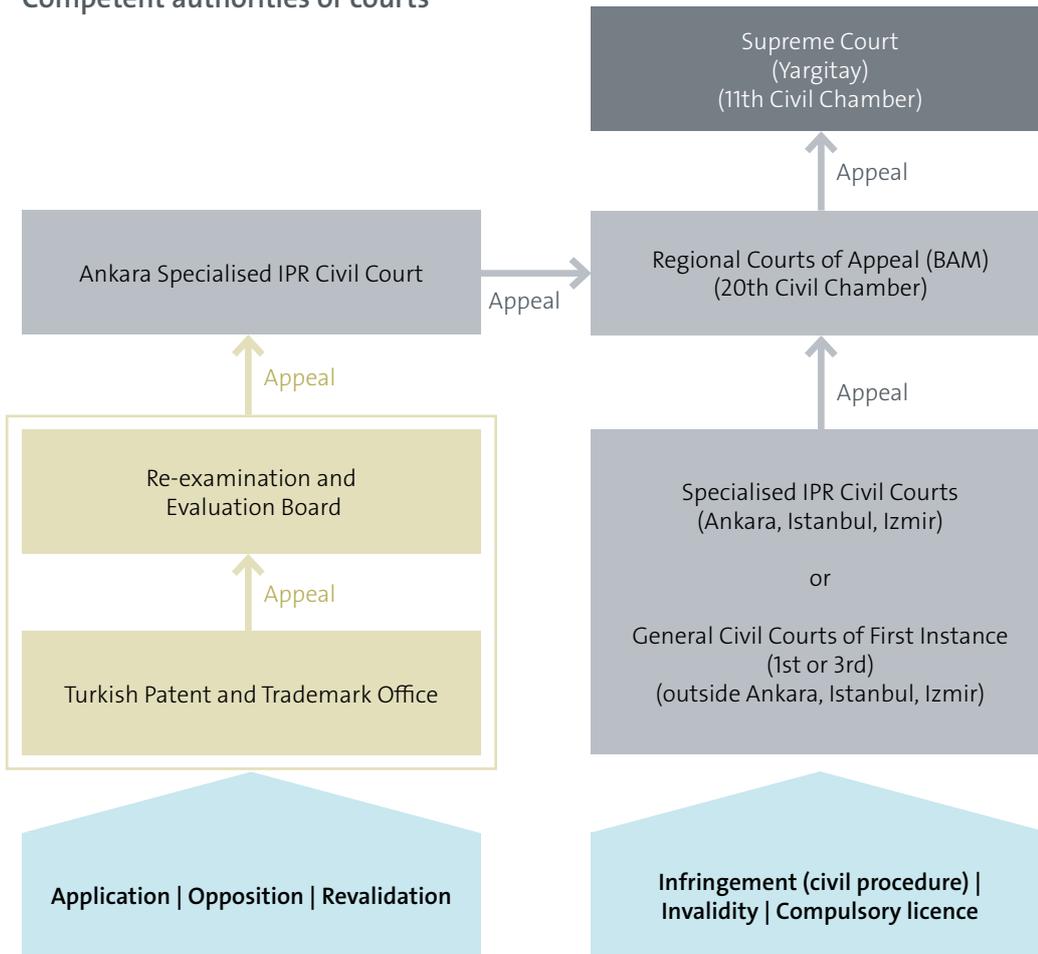
Law No. 6769 of December 22, 2016, on Industrial Property [cited as: Law No. 6769];

Regulation on the Implementation of Industrial Property Law No. 6769 (published in the Official Gazette No. 30047 on April 24, 2017);

Regulation Regarding the Implementation of the Convention on the Grant of European Patents (EPC) in Turkey (published in the Official Gazette No. 24282 on January 09, 2001);

Regulation on Employee Inventions, Inventions Realized within Higher Education Institutions and Inventions Arisen from Projects Supported by Public Authorities (published in the Official Gazette No. 30195 on September 29, 2017).

## Competent authorities or courts



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