

Turkey



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1. What are the most effective ways for a European patent holder whose rights cover your jurisdiction to enforce its rights in your jurisdiction?

If a European patent owner successfully validates its patent in Turkey, it enjoys the same rights as a conventional Turkish patent holder. Thus, it has several options to enforce its rights, the most common of which are:

- sending a cease and desist letter (preferably via a Turkish notary, although this is not mandatory);
- initiating civil and/or criminal proceedings before the courts;
- requesting an interlocutory injunction before or together with civil court proceedings; and
- obtaining border seizure at Customs and then initiating proceedings.

Turkey is a civil law country. The first specialised IP court was established in 2000 and there are now 22 civil and criminal IP courts in Ankara, Istanbul and Izmir; elsewhere, only appointed courts are responsible for hearing IP matters, including patent cases. Civil and criminal proceedings cannot be held at the same court.

A preliminary injunction to stop the infringement and/or to seize the infringing products can be claimed before or alongside civil proceedings. However, such an injunction is rarely granted, unless very strong evidence of infringement is available.

For criminal proceedings, a rights holder must file a complaint against the infringer

with the public prosecutor. Although criminal actions were previously a commonly used and effective tool in patent enforcement, this course of action is no longer advisable due to legislative gaps and a major backlog at the criminal courts, both of which are expected to be resolved soon.

2. What level of expertise can a patent owner expect from the courts in your jurisdiction?

The judges at the specialised IP courts are trained in IP disputes. Although they hear cases on all aspects of patent infringement and thus are experienced in patent judgments, in principle they have no technical expertise.

The court usually appoints a panel of independent experts to examine all legal and technical facts, which are considered at first instance only.

3. How do your country's courts deal with validity and infringement? Are they handled together or separately?

As is common international practice, a patent infringement action is likely to face a counteraction by the defendant for the invalidity of the patent based on one of the grounds for nullification set out in the Patent Law (Decree-Law 551). There are no separate specialised courts for validity and infringement cases in Turkey. Both types of proceeding are generally joined and dealt with simultaneously in the first instance court where the first action is lodged.

The Turkish Patent Institute does not handle post-grant invalidation proceedings and administrative proceedings cannot be used to enforce patent rights in Turkey.

4. To what extent is cross-examination of witnesses permitted during proceedings?

Turkish patent litigation is always based on written evidence and does not normally involve the hearing or cross-examination of witnesses. However, it is at the court's discretion whether to accept cross-examination requests.

5. What role can and do expert witnesses play in proceedings?

Expert reports play a major role in Turkish patent judgments. Usually, a panel of independent experts is appointed by the court to examine the technical and legal facts, the costs of which are paid by the plaintiff.

Each panel of appointed experts usually comprises three professionals, (ie, an academic, a lawyer and a patent attorney). A printed copy of the case file is submitted to the experts once the petition exchange and submission of evidence stages have been completed. The experts or their reports can be challenged by either party on reasonable grounds, which would then lead to the preparation of a second and generally final report.

However, the parties may adduce external expert reports in support of evidential and legal facts at a very early stage in the proceedings. These may rarely be relied on by the courts, but the facts raised therein and thus included in the case file may be considered by the official experts appointed by the court.

6. Is pre-trial discovery permitted? If so, to what extent?

Disclosure of evidence is the first step of patent infringement proceedings. In addition to pre-trial discovery, in the absence of sufficient evidence of infringement it is possible for the plaintiff to initiate a separate lawsuit before the civil court to find and secure evidence of infringing acts.

The judge then assigns a panel of experts and assesses the infringing acts without notifying the infringer (*ex parte* proceedings). The expert report is strong evidence of infringement and can be used later for the main civil and criminal proceedings.

7. Do the courts in your jurisdiction apply a doctrine of equivalents?

The Turkish patent legislation accepts the doctrine of equivalents to some extent. According to the Patent Law, the scope of patent protection is determined by its claims. Claims cannot be interpreted as being confined to their strict literal wording. When determining the scope of patent protection at the time of infringement, all elements that are equivalent to the elements expressed in the claim(s) are taken into consideration.

Where such an equivalent element performs substantially the same function in a substantially similar manner and gives the same result, that element shall generally be deemed to be equivalent to the elements as expressed in the patent claim(s) at issue.

8. Are certain patent rights (eg, those relating to business methods, software and biotechnology) more difficult to enforce than others?

Neither business methods nor software constitutes patentable subject matter in Turkey. Software can be protected under the Copyright Code. Although software for technical effects may enjoy patent protection, the scope of such protection is still disputable in Turkey, as in most European countries. Any patent for software characteristics can be subject to an invalidity action due to the non-patentable nature of software under the patent law.

However, it cannot be said that certain patent rights are harder to enforce than others in Turkey, due to the fact that, in principle, each case requires examination by a panel of experts specifically selected and appointed by the court after considering all legal and technical facts and requirements of the case.

9. How far are the courts bound by previous decisions in cases that have covered similar issues?

The Turkish courts are not bound by the decisions of other national or foreign courts. Nevertheless, decisions of the Supreme Court of Appeals are authoritative and are usually followed by the first instance courts.

10. Are there any restrictions on who parties can select to represent them in a dispute?

Only lawyers who are registered with one of the Turkish bars can represent parties before

the courts. Patent attorneys cannot represent a party in legal proceedings or formally appear before the Turkish courts.

11. Are the courts willing to consider the reasoning of courts in other jurisdictions that have dealt with similar cases?

Turkish courts are not bound by the decisions of other courts. It is at the judge's discretion to take foreign decisions on the same issues into consideration; such decisions can be submitted as complementary facts and evidence in the early stages of proceedings.

12. How easy is it for defendants to delay proceedings and how can plaintiffs prevent them from doing so?

A defendant can delay proceedings by:

- counterclaiming the nullity of the patent at issue;
- filing objections against experts and their reports, and requesting a new panel of experts and new expert reports; or
- requesting time extensions at every possible stage.

In case of nullity actions, the court will first render a decision on the validity of the patent and then rule on the infringement issue. If the other attempts are not well reasoned, the defendant's intention to delay is usually spotted by the judge and is not allowed to continue to the next stages.

The plaintiff should be well prepared for the submission of all facts and evidence in advance, even before the start of proceedings, and should use the time allowed wisely without requiring further time extensions during the proceedings.

13. Is it possible to obtain preliminary injunctions? If so, under what circumstances?

According to the patent legislation, it is possible for a patent holder to seek preliminary injunctions before civil courts in order to forestall an imminent threat of infringement against a wide range of infringing parties, from direct infringers to suppliers, importers, wholesalers and distributors. However, such injunctions are rarely granted unless clear facts and strong evidence of infringement are

available. If this is the case, the plaintiff must provide a financial payment or a letter of bank guarantee as security.

The patent holder may request all possible options when a patent infringement decision is issued, including the investigation and cessation of production of infringing products and confiscation of all infringing products at Customs and other locations where the products are held for commercial reasons (eg, places where the products are produced, stored, sold, offered, exported or imported). The court will order an expert report to determine the infringement.

Precautionary measures should fully secure the effectiveness of the judgment, and particularly provide for the following measures:

- cessation of infringing acts;
- an injunction to seize within Turkey – including at Customs, free ports or free trade area – and to keep in custody goods produced or imported that infringe rights conferred by the patent or the means used to implement the patented process; and
- the placement of security or a guarantee for damages to be compensated.

14. How much should a litigant plan to pay to take a case through to a decision at first instance?

The litigation costs of first instance proceedings vary greatly, depending on the attorneys' charging policy, any translation costs, the down payment required for preliminary injunctions and any extra official fees for the compensation of damages.

The official costs, including experts' fees, range from €2,000 to €4,000 plus 1.35% of the amount of compensation, if claimed. All of these fees are reimbursed by the successful plaintiff. Attorneys' fees are the dominant factor in litigation costs, usually varying from €25,000 to €50,000, but may be much higher depending on the complexity of the case, the disclosure of evidence, a counteraction for invalidity by the defendant and other requirements for court jurisdiction, site visits and special reports from external professionals. These fees cannot be reimbursed.

15. What are the typical remedies granted to a successful plaintiff by the courts?

The Patent Law provides for several remedies, such as damages, injunctions and the recall and destruction of infringing goods. If infringement is proven, the court will usually grant damages and an injunction against the infringer.

16. How are damages awards calculated? Is it possible to obtain punitive damages?

There are three options for the calculation of damages in Turkey: the infringer's profit, the patentee's lost profits and reasonable royalties. However, if a patentee has not fulfilled the use requirement, the damages shall be calculated according to reasonable royalties (see Question 23).

When calculating damages, all circumstances having an effect on the case (ie, the value of the patent, the remaining patent protection term at the time of infringement and the number of licences granted) shall be taken into consideration.

The compensation for moral damages as granted by the courts is of nominal value and rather symbolic. Punitive damages are not available in civil proceedings, whereas the criminal courts may order a punitive fine of between €12,000 and €23,000.

17. How common is it for courts to grant permanent injunctions to successful plaintiffs and under what circumstances will they do this?

Permanent injunctions are often granted to the successful plaintiff at the end of the proceedings.

18. How long does it take to obtain a decision at first instance and is it possible to expedite this process?

The civil first instance IP courts usually issue a decision within 24 to 36 months, depending on the number of hearings and petitions exchanged and the number of expert reports (see Question 12).

19. Under what circumstances will the losing party in a first instance case be granted the right to appeal? How long does an appeal typically take?

Any party can appeal the case before the Supreme Court within 15 days of issuance of

the court decision; this stage takes another 15 to 24 months.

20. Are parties obliged to undertake any type of mediation/arbitration prior to bringing a case before the courts? Is alternative dispute resolution a realistic alternative to litigation?

The Turkish legal system does not specifically legislate for alternative dispute resolution. At an early stage of proceedings the parties are invited to negotiate for settlement, but a positive outcome is unlikely. The Patent Law refers only to arbitration by the Turkish Patent Institute in order to obtain a contractual patent licence for those parties wishing to apply for a compulsory licence.

21. In broad terms, how pro-patentee are the courts in your jurisdiction?

Most judges have been trained within the framework of a joint project between the Ministry of Justice and the European Commission. As the judges are harsh on infringement, they are likely to be pro-patentee when solid facts and supporting evidence are provided.

22. Has your jurisdiction signed up to the London Agreement on Translations? If not, how likely is it to do so?

Turkey has not yet signed up to the London Agreement and there is no appointed schedule for negotiations to ratify the agreement.

23. Are there any other issues relating to the enforcement system in your country that you would like to raise?

A patentee must put to use its protected invention and must file a certified document to the Turkish Patent Institute within three years of the date on which the patent was granted. Otherwise, any interested person may request that a compulsory licence be granted. Legitimate excuses for failure to meet this requirement include technical, economic or legal reasons beyond the control and will of the patentee, which may include officially required clinical test periods or delays in product registration procedures before the health authorities for pharmaceuticals. *iam*

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