



Patents 2009

Contributing editor

Stuart J Sinder
Kenyon & Kenyon LLP

Business development manager

Joseph Samuel

Marketing managers

Alan Lee
Dan Brennan
George Ingledew
Edward Perugia
Robyn Hetherington
Dan White
Tamzin Mahmoud
Elle Miller

Marketing assistant

Ellie Notley

Subscriptions manager

Nadine Radcliffe
Subscriptions@
GettingTheDealThrough.com

Assistant editor

Adam Myers

Editorial assistants

Nick Drummond-Roe
Charlotte North

Senior production editor

Jonathan Cowie

Subeditors

Jonathan Allen
Kathryn Smuland
Sara Davies
Laura Zúñiga
Ariana Frampton
Sarah Dookhun

Editor-in-chief

Callum Campbell

Publisher

Richard Davey

Patents 2009

Published by
Law Business Research Ltd
87 Lancaster Road
London, W11 1QQ, UK
Tel: +44 20 7908 1188
Fax: +44 20 7229 6910
© Law Business Research Ltd
2009

No photocopying: copyright
licences do not apply.
ISSN 1742-9862

The information provided in this publication is general and may not apply in a specific situation. Legal advice should always be sought before taking any legal action based on the information provided. This information is not intended to create, nor does receipt of it constitute, a lawyer-client relationship. The publishers and authors accept no responsibility for any acts or omissions contained herein. Although the information provided is accurate as of March 2009, be advised that this is a developing area.

Printed and distributed by
Encompass Print Solutions
Tel: 0870 897 3239

Law
Business
Research

| | |
|--|------------|
| Global Overview Stuart J Sinder <i>Kenyon & Kenyon LLP</i> | 3 |
| Argentina Mariano Municoy <i>Moeller IP Advisors</i> | 6 |
| Austria Peter Israiloff <i>Barger Piso & Partner</i> | 12 |
| Belgium Kristof Roox and Christoph De Preter <i>Crowell & Moring</i> | 19 |
| Brazil Márcio Merkl <i>Abreu, Merkl e Advogados Associados</i> | 25 |
| Canada Adrian M Kaplan <i>Dimock Stratton LLP</i> | 31 |
| China Jianyang Yu <i>Liu Shen & Associates</i> | 37 |
| Colombia Oscar Correa <i>Cavelier Abogados</i> | 42 |
| Cyprus Alecos Markides and Hermione Markides <i>Markides Markides & Co</i> | 48 |
| Denmark Johan Løje <i>Sandel, Løje & Wallberg</i> | 53 |
| El Salvador José Roberto Romero M and Jorge Enrique Méndez Palomo <i>Romero Pineda & Asociados</i> | 58 |
| France Gérard Portal <i>Cabinet Beau de Loménie</i> | 64 |
| Germany H Ulrich Dörries, David Molnia, Sandra Pohlman and Michael Eder <i>df-mp</i> | 70 |
| Greece Alkisti-Irene Malamis <i>Malamis & Malamis</i> | 78 |
| Hungary Michael Lantos <i>Danubia Patent & Law Office LLC</i> | 83 |
| India Archana Shanker <i>Anand and Anand</i> | 88 |
| Indonesia Augustaaf Bertus Rikin <i>Rikin & Rekan</i> | 96 |
| Israel D'vorah Graeser and Sa'ar Plinner <i>Plinner & Co Law-Offices</i> | 100 |
| Italy Massimiliano Mostardini <i>Studio Legale Bird & Bird</i> | 105 |
| Korea Yoon Bae Kim <i>Kims and Lees</i> | 111 |
| Malaysia Benjamin J Thompson <i>Thompson Associates</i> | 119 |
| Mexico César Ramos Jr, Alejandro Luna and Juan Luis Serrano <i>Olivares & Cia</i> | 126 |
| Netherlands Armand Killan <i>Bird & Bird LLP</i> | 132 |
| Nigeria Olusola Mesele <i>Strachan Partners</i> | 138 |
| Poland Katarzyna Karcz and Malgorzata Zielinska-Lazarowicz <i>Patpol</i> | 143 |
| Portugal Álvaro Duarte and Rui Duarte Catana <i>Álvaro Duarte & Associados</i> | 149 |
| Romania Razvan Dinca <i>Stoica & Asociatii</i> | 154 |
| Russia Vladimir Rybakov <i>ARS-Patent</i> | 162 |
| Singapore Alban Kang <i>ATMD Bird & Bird LLP</i> | 167 |
| South Africa Russell Bagnall <i>Adams & Adams</i> | 172 |
| Sweden Kristian Fredrikson and Peder Oxhammar <i>Brann AB</i> | 179 |
| Switzerland Rainer Schalch <i>E Blum & Co AG</i> | 184 |
| Taiwan Yu-Lan Kuo and Hsiao-Ling Fan <i>Formosa Transnational Attorneys at Law</i> | 190 |
| Thailand Chavalit Uttasart, Kallayarat Chinsrivongkul and Phatthrawat Nakaranuruck <i>Chavalit & Associates Limited</i> | 196 |
| Turkey M N Aydın Deris, Elisavet Yakovidis Cinlemez, Ayse Unal Ersonmez, Nazli Korkut and Banu Barbur <i>Deris Patents and Trademarks Agency AS</i> | 202 |
| United Kingdom Dispute Resolution and Technology Teams <i>Rouse</i> | 209 |
| United States Stuart J Sinder, Michelle M Carniaux and Shawn W O'Dowd <i>Kenyon & Kenyon LLP</i> | 215 |
| Venezuela María M Nebreda and Carlos Pacheco <i>Hoet Peláez Castillo & Duque</i> | 226 |
| Vietnam Pham Vu Khanh Toan <i>Pham & Associates</i> | 231 |

Turkey

M N Aydın Deris, Elisavet Yakovidis Cinlemez, Ayse Unal Ersonmez, Nazli Korkut and Banu Barbur

Deris Patents and Trademarks Agency AS

Patent enforcement proceedings

1 Lawsuits and courts

What legal or administrative proceedings are available for enforcing patent rights against an infringer? Are there specialised courts in which a patent infringement lawsuit can or must be brought?

It is possible to enforce patent rights against an infringer through civil proceedings and the suspension of release proceedings before Customs.

Civil actions for patent infringement are to be filed before the Specialised Civil Courts for Intellectual and Industrial Property Rights established in Istanbul, Ankara and Izmir. In other cities of Turkey, the third criminal or civil court will operate as the specialised court for IP matters. Together with the institution of a civil court action, an interlocutory injunction can also be requested by the patentee to be ordered by the court to stop the act of infringement and to obtain the seizure of the counterfeit products.

The suspension of release procedure is also possible before the Turkish Customs upon the complaint of the patentee to stop the counterfeit goods bound for importation or exportation at Customs. The withholding is lifted and the Customs formalities proceed further unless a court action for patent infringement is duly instituted or an interlocutory injunction is ordered by the court within 10 days from the date of the withholding by Customs.

According to the Decree Law No. 551 with regard to the protection of patents and utility models, patent infringement consisting also of a criminal offence until 31 December 2008, the patentee could also file a complaint against the infringer with the public prosecutor leading to criminal proceedings before the criminal court. However, since the Turkish Criminal Act stipulates that the crime of patent infringement and the criminal sanctions applicable to such acts need to be regulated by an Act and not by a Decree Law as per the general principle of criminal law ie, *nullum crimen sine lege* and since despite the legal provision authorising the application of the said provisions of the Decree Law until 31 December 2008, the Turkish parliament failed to enact a new provision in the form of an Act, these provisions are no longer applicable.

Turkish professionals are of the opinion that where the patent is registered in Turkey, patent infringement also consists of an act of unfair competition and since unfair competition acts are deemed a criminal offence according to the Turkish Code of Commerce, it should be possible to attack patent infringement through criminal proceedings on the basis of the unfair competition provisions. However, criminal law specialists are of the contrary opinion on the ground that the word 'patent' is not expressly cited in the provision describing the acts of unfair competition as a criminal offence whereas the word 'trademark' is cited therein, and the general principle of interpretation of the criminal provisions is in favour of the accused. Therefore, and in the absence of any case law on this particular point

to serve as a reference, the applicability of the criminal provisions and sanctions originating from the unfair competition provisions of the Turkish Code of Commerce is subject to interpretative uncertainty and cannot be predicted at this stage.

2 Trial format and timing

What is the format of a patent infringement trial? To what extent are documents, affidavits and live testimony relied on? Is cross-examination of witnesses permitted? Are experts used? Are disputed issues decided by a judge or a jury? How long does a trial typically last?

Before instituting the infringement action, the determination of evidence and facts relating to the acts of infringement may be requested by filing a non-adversarial action in determination of evidence and facts on infringement. The court will appoint a panel of experts to compile a report as to whether the goods produced by the infringer constitute infringement of the patent rights. In an action of similar nature, third parties may file an action for a declaration of non-infringement requesting the court to rule that their acts do not violate and infringe the defendant's patent.

Patent infringement proceedings are initiated with the filing of the writ of summons comprising all the plaintiff's claims, which is notified to the defendant who in return can either file counterclaims or institute a counteraction within 10 days of notification.

Thereafter the parties file their evidence with the court. At its discretion, the court may order an interlocutory injunction upon a favourable report issued by the panel of experts appointed by the court and may decide on the amount of a guarantee to be filed with the court. The request for an interlocutory injunction can be made before the institution of proceedings or during the course of the action.

Unless the main infringement action is instituted within 10 days of the date of the interlocutory injunction, the injunctive measures remain without effect.

Live witness testimony and cross-examination is permitted. It is, however, at the court's discretion to accept requests for such testimony. Affidavits may also be filed as evidence.

Criminal proceedings are also possible at the extent explained above by filing a complaint with the evidence with the public prosecutor, ie, citing the infringer. The public prosecutor can order the police to seize the infringing goods. The seized counterfeit goods will be kept under judicial custody until the end of the criminal proceedings. If the complaint is favourably received, the public prosecutor institutes the criminal action as a public action.

Disputed issues are decided by the judge. For the time of the trial please refer to question 9.

3 Proof requirements

What are the respective burdens of proof for establishing infringement, invalidity and unenforceability of a patent?

In cases of infringement, the patentee arguing that his patent right is infringed should provide evidence with every means of the act of infringement.

In cases of invalidity, persons adversely affected or prejudiced, or interested official authorities, acting through the public prosecutor may show the invalidity of the patent.

Moreover, the persons entitled to claim the right to the patent – namely the inventor or his successor – only show the invalidity of a patent on grounds that the patentee does not have the right to a patent.

For unenforceability, see question 19.

As to the burden of proof, this rests with the party who makes a particular claim and who is to bring evidence in support of his claims.

4 Standing to sue

Who may sue for patent infringement? Under what conditions can an accused infringer bring a lawsuit to obtain a judicial ruling or declaration on the accusation?

The patentee or applicant is entitled to sue for patent infringement. The patentee cannot institute a criminal action, but can only join it.

The exclusive licensee can institute in his own name the same legal proceedings as the patentee.

Holders of non-exclusive licences do not have the right to institute legal proceedings. However, the non-exclusive licensee can give notice through a notary public requesting the patentee to institute such proceedings. Where the patentee refuses to initiate proceedings, the non-exclusive licensee can institute proceedings in his own name.

The distributor is allowed to sue for patent infringement if he has concluded a licence agreement with the patentee whereby he will benefit from the above provisions.

According to article 149/1 of said Decree Law, any interested person can institute an action for a declaration of non-infringement against the patentee to obtain a judgment ruling that the acts committed by the defendant do not infringe the patent of the plaintiff or patentee. However the infringer or defendant of an ongoing patent infringement action cannot institute an action for a declaration of non-infringement.

5 Inducement and contributory infringement

To what extent can someone be liable for inducing or contributing to patent infringement?

As to contributory infringement there is no specific provision addressing it directly in said Decree Law, which on the other hand provides under article 136(e) that ‘participating in acts of sub paragraphs 1 to 4 of this present article [producing, selling, distributing, commercialising of products embodying a patent or manufactured according to a process patent, enlarging the scope of contractual licence], or assisting or inducing/encouraging them or facilitating, in any way and under any circumstances, their occurrence/perpetration’ are considered an infringement of patent rights.

In the absence of any case law on contributory infringement, it remains to be seen to what extent the courts will interpret the provision of article 136(e) to cover contributory infringement, the circumstances of the case permitting.

6 Infringement by foreign activities

To what extent can activities that take place outside of the jurisdiction support a charge of patent infringement?

The legal effects of a patent are normally limited to the Turkish territory. Activities that take place outside of the jurisdiction suit should be brought at the local courts where the infringing acts take place or produce effects.

However, as mentioned under question 5, importation of the patented products or those manufactured according to a process patent constitute patent infringement.

7 Infringement by equivalents

To what extent are ‘equivalents’ of the claimed subject matter liable for infringement?

According to article 83 of said Decree-Law, the scope of protection conferred by a patent is determined by the claim.

Claims should not be interpreted as being confined to their strict literal wording.

At the time of infringement, in determining the scope of patent protection, all elements being ‘equivalent’ to the elements expressed in the claim have to be considered.

Where, at the time that an infringement is asserted, the equivalent element performs substantially the same function in a substantially similar manner and gives the same result as the element expressed in the claims, such element shall be, generally, deemed equivalent to the element expressed in the claims.

8 Discovery of evidence

What mechanisms are available for obtaining evidence from an opponent, from third parties or from outside the country for proving infringement, damages or invalidity?

Article 139 of said Decree Law allows the patentee to request from the infringer the documents related to the use of the patent without his consent, for evaluation of the damage suffered resulting from the patent infringement.

Furthermore, article 150 permits any person legally entitled to bring action against the infringement of a patent right to request the court to determine and secure the acts which may be considered to infringe patent rights.

Moreover, a police raid ordered within criminal proceedings provides the possibility to collect evidence confirming the patent infringement, by seizing and placing under judicial custody the counterfeit goods.

Apart from the above, Turkish legislation does not provide specific rules on discovery of evidence having regard to the act of infringement and to the effective use of the patent within the statutory period.

9 Litigation timetable

What is the typical timetable for a patent infringement lawsuit in the trial and appellate courts?

The duration of a patent infringement suit from the filing of the writ of summons to the judgment depends on the circumstances, complexity and specificity of the case and on the extent of evidence filed.

Generally, the decisions of the Specialised Civil Courts issue within 18 to 24 months of the institution of the action, depending on the number of petitions exchanged, the number of experts reports issued, etc. For an appeal before the Supreme Court, another 12 to 18 months have to be added until the decision becomes final.

For criminal actions instituted by the public prosecutor, the first instance decision is rendered by the penal court within two years of their institution. Due to the nature and lower level of the criminal sanctions against acts of unfair competition, the first instance decision cannot be appealed.

10 Litigation costs

What is the typical range of costs of a patent infringement lawsuit before trial, during trial and for an appeal?

The range of costs of a patent infringement action can be as follows:

- for the institution of a civil action where no compensation is claimed the required official court fees will not exceed €100. Where compensation is required, the official court fees shall amount to 1.35 per cent of the claimed compensation amount for filing of the civil action;
- the expert's fees are directly paid to the court and depend on the number of the experts to be appointed by the court. The official fee for each expert is generally determined by the court to be around €200;
- the notification of the motions, evidence and the postage costs are not likely to exceed €300;
- for the guarantee payment, the court orders an interlocutory injunction against a guarantee payment determined at its discretion, which is submitted to the court as a letter of guarantee obtained from the bank;
- the translation and legalisation costs of the supporting documents in a foreign language;
- the expenses for travelling, accommodation or for correspondent attorneys attending hearings of the court in other cities of Turkey;
- official attorneys' fees are determined according to a schedule issued by the Bar Union of Attorneys, and are usually around of €600 if no compensation is claimed by the parties and are recoverable by the successful litigant; and
- private attorneys' fees are the real and effective fees charged by the attorneys-at-law on a private basis and are not recoverable by the successful litigant. These fees are charged by the attorneys according to their estimation of the complexity and duration of the case and may greatly vary depending on whether they take on the case on a fixed cost or on a time-spent basis.

11 Court appeals

What avenues of appeal are available following an adverse decision in a patent infringement lawsuit?

The first instance decisions of the civil courts concerning patent infringement and unfair competition or the invalidity of a patent may be appealed to the Supreme Court within 15 days of the parties being notified of the court decision.

The decision of the criminal courts with regard to unfair competition are final.

12 Competition considerations

To what extent can enforcement of a patent expose the patent owner to liability for a competition violation, unfair competition, or a business-related tort?

In general, the enforcement of a patent does not expose the patent owner to liability for a competition violation, unfair competition, or a business-related tort with the proviso that the patentee acts in good faith and not contrary to the laws, morality or public policy.

13 Alternative dispute resolution

To what extent are alternative dispute resolution techniques available to resolve patent disputes?

The Turkish legal system does not specifically legislate for alternative means of dispute resolution. However, recent changes to the Turkish Criminal Code have obliged public prosecutors and criminal courts to invite the parties to settle during the criminal proceedings.

Decree Law No. 551 refers only to the arbitration of the Turkish Patent Institute (TPI) for obtaining a contractual patent licence for someone wishing to apply for a compulsory licence.

Article 213 of the Civil Procedural Law allows a judge to invite the parties to reach an amicable settlement.

Finally, article 35/A of the Attorney Act, gives counsel the right to reach a settlement before the institution of civil action or before the first hearing, in which the articles of the settlement agreement may be registered with the court and become enforceable as a court decision.

Scope and ownership of patents

14 Types of protectable inventions

Can a patent be obtained to cover any type of invention, including software, business methods and medical procedures?

As per article 6 of the Decree Law, the following remain outside the scope of the patent:

- discoveries, scientific theories and mathematical methods;
- plans, methods, schemes or rules for performing mental acts, for conducting business or trading activity, and for playing games;
- literary and artistic works, scientific works, creations having an aesthetic characteristic and computer programs;
- methods involving no technical aspect, for collecting, arranging, offering or presenting and transmitting information or data; and
- methods of diagnosis, therapy and surgery applicable to the human or animal body. This provision applies neither to the products and compositions (per se) used in connection with these methods nor to their manufacturing process.

According to article 6, paragraph 4, inventions of the following subject matter are not patentable:

- inventions whose subject matter is contrary to public policy or to morality as is generally accepted; and
- plant and animal varieties or species, or processes for breeding plant or animal varieties or species, based mainly on biological grounds.

As per this provision, neither software nor business methods are patentable in Turkey. However, software interacting with other means or elements such as hardware and machinery to produce technical effects and contributing to the state of the art should normally be accepted for patent protection in Turkey. In this regard, owing to the absence of an established practice and experience in Turkey for want of cases or applications regarding software, the TPI does not automatically reject applications related to computer software.

Software is protected in Turkey according to the Law on Intellectual and Artistic Works (Copyright Act) No. 5846 of 5 December 1951 as amended by Law No. 5101 on 3 December 2004.

15 Patent ownership

Who owns the patent on an invention made by a company employee, an independent contractor, or multiple inventors? How is patent ownership officially recorded and transferred?

The Decree Law No. 551 classifies the employee's inventions as:

- 'service inventions', which are those made on duty by the employee during the term of his employment, while performing, pursuant to contractual obligation, the tasks he has been assigned to do or that are based to a great extent on the experience and work or activity of the employer; or
- 'free inventions', which are all inventions not falling under the scope of service inventions.

Where an employee makes a service invention, he should report the invention to his employer without delay in writing. In the report, the employee must disclose the technical problem, its solution and how the service invention was realised. Thereafter the employer can claim a right, in part or in whole, for a service invention.

Independent contractors are generally, unless the agreement includes a provision to the contrary, owners of the inventions they make during the execution of the contracts.

For multiple inventors, if not foreseen otherwise by the parties, the right to request a patent shall belong to them jointly.

Patent rights are transferred by a deed of assignment which shall be duly signed by the assignor and the assignee of the patent right with signatures of both parties notarially legalised.

The rights conferred by the patent may not be invoked against third parties in good faith if the transfer is not recorded on the patent register.

The ownership of a patent is also transferred by succession in title, subject to the same recordal formality on the patent register.

Defences**16 Patent invalidity**

How and on what grounds can a patent be invalidated?

As per article 129 of said Decree Law, a patent can be declared partially or totally invalid by the court in the following situations:

- where the subject matter of the invention does not meet the patentability requirements;
- where the subject matter of the invention has not been described in a sufficiently explicit and comprehensive manner to enable a person skilled in the concerned technical field to implement the invention;
- where the subject matter of the patent exceeds the scope of the application or is based on a divisional application or on an application filed by an applicant who is not vested with the right to request the patent and exceeds the scope of the application; and
- where evidence is brought that the patentee does not have the right to a patent, ie, is not the inventor or his successor in title.

The persons entitled to request the invalidity of the patent (see question 3) may come before the court during the term of protection of the patent or within five years of the termination of the patent right.

17 Absolute novelty requirement

Is there an 'absolute novelty' requirement for patentability, and if so, are there any exceptions?

According to article 7 of said Decree Law, 'absolute novelty' is one of the patentability requirements along with 'inventive level' and 'industrial applicability'.

However, article 8 provides a grace period concerning disclosures that do not affect the novelty of the invention. The disclosure of the invention within 12 months prior to the date of filing or of the priority claimed, is not fatal to the novelty of the application.

18 Obviousness or inventiveness test

What is the legal standard for determining whether a patent is 'obvious' or 'inventive' in view of the prior art?

Any invention that is not part of the state of the art is deemed to be novel.

The state of the art comprises information or data pertaining to the subject matter of the invention, accessible to the public in any part of the world, before the date of filing of the application for patent by disclosure whether in writing or orally, by use or in any other way.

Patent or utility model applications filed in Turkey prior to the date of filing the application for a patent, and published on or after that date, are considered to be comprised in the state of the art as of their first disclosure.

As to the inventiveness, the invention according to article 9 of said Decree Law is deemed to surpass the state of the art (to involve inventive activity or step) when it is the result of an activity that is not obviously realisable from the state of the art, by a person skilled in the relevant technical field.

19 Patent unenforceability

Are there any grounds on which an otherwise valid patent can be deemed unenforceable owing to misconduct by the inventors or the patent owner, or for some other reason?

Decree Law No. 551 is silent about the unenforceability of a patent for reasons of misconduct of the patentee or inventor.

However, independently from the misconduct of the patentee or inventor, a valid patent cannot be enforced against persons committing the acts cited in article 75, namely:

- acts devoid of any industrial or commercial purpose and limited to private ends or aims;
- acts involving, for experimental purposes, the invention or subject matter of a patent;
- extemporaneous preparations of medicines in pharmacies involving no mass production and carried out solely in making up a prescription and acts related to the medicines thus prepared; and
- acts involving, for experimental purposes, the invention that is the subject matter of authorisation including authorisation for pharmaceuticals and tests and experiments necessary for this purpose.

Remedies**20 Monetary remedies for infringement**

What monetary remedies are available against a patent infringer? When do damages start to accrue? Do damage awards tend to be only nominal, provide fair compensation or be punitive in nature?

It is possible to obtain compensation for material or moral damages from the person who, without the consent of the proprietor of a patent, produces, sells, distributes, commercialises, imports or keeps for commercial purposes, a patented product or makes use of a patented process.

For material damages, the plaintiff may freely choose between three methods for calculating compensation: reasonable licensing royalty, lost profits and non-realised gains. For the calculation of non-realised income, factors such as the economic value of the pat-

ent, the term of protection remaining at the time of infringement, and the type, nature or number of licences granted in respect of the patent shall be considered.

The compensation for moral damages as granted by the courts is of nominal value and rather symbolic whereas the compensation for material damages can be of fair value, subject to the bringing of evidence of the damages suffered.

Article 142 of said Decree Law provides that further damages may be additionally claimed where the reputation of the invention or subject matter of the patent is harmed or prejudiced owing to the poor quality of the infringing products or of their marketing.

The compensation for material or moral damages is not punitive even though it is significant. Whereas the fine sentenced by the Penal Court within the context of a criminal action is punitive as it may amount to a fine of between 27,000 Turkish lira (approximately €12,624) and 46,000 Turkish lira (approximately €21,507).

21 Injunctions against infringement

To what extent is it possible to obtain a temporary injunction or a final injunction against future infringement? Is an injunction effective against the infringer's suppliers or customers?

The act provides that injunctive measures can also be requested from the court against the 'danger' of infringement, not only against the direct infringer but also against all those involved in realising the act of infringement, namely the suppliers, importers, wholesalers and distributors but not customers.

The act makes no distinction between temporary and final injunctions because the court may at its discretion order and lift the injunctive measures at any time during the proceedings.

22 Attorneys' fees

Under what conditions can a successful litigant recover costs and attorneys' fees?

If the litigant has specified in the writ of summons filed with the court that the cost of judgment, prosecution and attorney has to be supported by the defendant and thereafter the action is decided in favour of the plaintiff, he can successfully recover costs and as well as the official attorneys' fees as mentioned under question 10.

The private attorneys' fees will not be recoverable by the successful litigant on the basis of the court decision, which mentions only the official attorneys' fees.

23 Wilful infringement

Are additional remedies available against a deliberate or wilful infringer? If so, what is the test or standard to determine whether the infringement is deliberate?

The provisions of the Decree Law do not provide for specific additional remedies in the case of deliberate or wilful infringement, as according to general civil and criminal provisions deliberately or wilfully committing acts of infringement may be held by the court, according to the circumstances of the case to constitute an aggravating cause and a heavy fault.

Moreover, the act of infringement is also an act of unfair competition and therefore a criminal offence, even when it is not deliberate or wilful.

Deliberate or wilful infringement may therefore affect the level of compensation in a civil action and of the penalties in a criminal action.

24 Time limits for lawsuits

What is the time limit for seeking a remedy for patent infringement?

The time limit for a civil action covers a period of one year from the date when the patentee knew or became aware of the infringement acts or 10 years from the date when the act of infringement took place.

For criminal proceedings based on unfair competition provisions, according to the general provisions of the Turkish Criminal Act, the complaint should be filed within six months of the date the patentee has known or become aware of the infringement act and the infringer.

According to the jurisprudence of the Supreme Court, as long as the infringement acts continue, the right to institute a court action against the infringing parties is not prescribed.

However, the patentee who is aware of the infringing acts and remains silent without taking any legal action (acquiescence) is considered to commit an abuse of right when filing his action after a relatively long time and his right will have prescribed in these circumstances, according to the case law of the Supreme Court. There is not an exact time limit (eg, five years or 10 years) for the acceptance of the 'abuse of right', as the determination of such behaviour will mainly depend on the general investment made by the defendant and how long the plaintiff has shown approval to such investment, usage and registration.

25 Patent marking

Must a patent holder mark its patented products? If so, how must the marking be made? What are the consequences of failure to mark?

There is no obligation for the patentee to mark its patented products in any way since Decree Law No. 551 contains no provisions in this regard.

Licensing

26 Voluntary licensing

Are there any restrictions on the contractual terms by which a patent owner may license a patent?

There are no restrictions whatsoever about contractual terms, other than that the clauses of the agreement should not be contrary to public policy or morality and not be in violation of the general provisions including those for unfair competition.

When the agreement is exclusive, no licences may be granted to third parties and the patentee may not use the patent unless such right is reserved in the agreement.

27 Compulsory licences

Are any mechanisms available to obtain a compulsory licence to a patent? How are the terms of such a licence determined?

As per article 99 of said Decree Law, the grant of a compulsory licence to an interested person may occur in the following situations:

- failure to use the patent within three years from the date of publication of the grant decision or in lieu thereof, to record a certificate of use, importation documents or declaration of legal excuse or to publish an offer for licensing;
- dependency of subject matter of patents; or
- on grounds of public interest by decision of the Council of Ministers in matters of public health and national defence.

Before the court grants a compulsory licence, the candidate can request the mediation of the TPI with a view to obtaining a contractual licence for the patent. If the parties fail to conclude the licence

Update and trends

The Decree Law No. 551 concerning patents and utility models in Turkey is expected to be repealed and replaced shortly – possibly in the year 2009 – by a new patent act, the draft of which has been submitted to the parliament and is currently in discussion before parliamentary commissions. We have uncertainties as to when the approval of this draft will be voted by the Turkish parliament which has been prepared in order to be in agreement with the provisions of the international and regional agreements such as the EPC as well as to be more in conformity with the needs and realities of the rightholders of patents or utility models in Turkey. Significant developments in the new draft comprises provisions regarding the cancellation of the grant of patent without (substantive) examination protected for seven years, the change of the examination procedure previously completed in three rounds, the system of post-grant opposition, and the patentability of biotechnological inventions.

The possibility to file an on-line patent or utility model application has been also activated as from 31 December 2007 in addition to the

possibility of making an online search and file inspection of patent or utility model and a published patent or utility model application on the website of the Turkish Patent Institute.

An important decision has been taken by the third Civil Court of Intellectual and Industrial Rights of Ankara in the field of a force-majeure claim filed for revalidation of patents or utility models and patent or utility model applications due to non-payment of annuities, which has restricted the acceptance of reasons such as the loss of data due to virus attack in the computer. According to the current practice of the TPI, documentary evidence should support the claim of force-majeure for assessment purposes and human errors shall not be evaluated as a reasonable ground to maintain the patent rights.

Finally, the examiners of the TPI have enlarged the diversity of IPC codes for which they conduct search and examination regarding patentability criteria for the applications, previously limited to IPC codes A, B and E.

agreement within the term of the mediation, the court may be asked to grant a compulsory licence. The candidate shall indicate the equipment, installation and materials that he possesses to effectively put the invention to use and guarantee he will be able to produce if the licence is granted. After the engagement by the court of the procedure, a copy of the request and documents are sent to the patentee. The patentee may raise objections against these documents, within one month of the date of receiving them. If no objection is raised, the court shall grant the compulsory licence.

It is worth noting that since 27 June 1995 and the coming into force of the Decree Law, we have not come across a single case where the grant of a compulsory licence was requested through the mediation of the TPI or through the court.

However one compulsory licence exists on the records of the TPI granted by court.

Patent office proceedings**28 Patenting timetable and costs**

How long does it typically take, and how much does it typically cost, to obtain a patent?

An application prosecuted for a patent with substantive examination is normally granted within 36 months of the application date in Turkey. Whereas an application prosecuted for patent without substantive examination is normally granted within 24 months.

As for the costs, the length of the specification and claims will affect the total cost for securing the right, because of the translation charges. Indicatively, a national patent or national phase of a PCT application having an average text of around 30 pages would cost approximately US\$20,000 for the entire life of 20 years including official fees, attorneys' fees, translation fees and maintenance fees. As for validation of European patents, the total cost for the duration of 20 years will be around US\$14,000.

29 Prior art disclosure obligations

Must an inventor disclose prior art to the patent office examiner?

Prior art disclosure obligation does not exist under Turkish patent law and practice.

30 Pursuit of additional claims

May a patent applicant file one or more later applications to pursue additional claims to an invention disclosed in its earlier filed application? If so, what are the applicable requirements or limitations?

It is possible to pursue additional claims on the basis of an application of patents-of-additions which should have unity with the subject matter of the main application and which improve or develop the invention, subject to the main application. To the contrary of novelty, inventive step is not a requirement for patent-of-additions. The applications for patent-of-additions can be filed until the date when the decision to grant the patent is reached and even when the same is not accepted to issue as a patent.

31 Patent office appeals

Is it possible to appeal an adverse decision by the patent office in a court of law?

According to general provisions of administrative law, it is procedurally possible firstly to lodge an objection with the TPI against its decisions within 60 days of the official decision which will be examined by the Higher Council of Re-evaluation and Re-examination. If this Council rejects the objection, it will be possible to institute a court action before the Specialised Ankara Court of Intellectual and Industrial Property Rights for the withdrawal of the TPI's decision within 60 days of the official notification of the above-mentioned final decision of the Council.

32 Oppositions or protests to patents

Does the patent office provide any mechanism for opposing the grant of a patent?

The Decree Law provides for pre-grant opposition only during the application proceedings after the search report has been published. The Turkish Act does not provide for post-grant opposition.

33 Priority of invention

Does the patent office provide any mechanism for resolving priority disputes between different applicants for the same invention? What factors determine who has priority?

Where an invention has been made independently by several persons at the same time, the right to a patent belongs to the person who has filed the first application or can claim the earlier priority right. The person who is the first to apply for a patent is vested with the right to request the patent until proof to the contrary is established. The TPI provides no specific mechanism for resolving such disputes, which should be handled by the courts.

34 Modification of patents

Does the patent office provide procedures for modifying, re-examining and revoking a patent? May a court amend the patent claims during a lawsuit?

No tools are available under the Decree Law to introduce amendments to claims after grant, whether as a patent of addition or divisional patent, both of which should be filed during the prosecution phase until the decision of grant of the principal patent. However, on the occasion of court proceedings instituted for the cancellation of the patent, the number of the claims could be restricted and the court may decide to partially cancel the patent by excluding some of the claims but not by amending the claims to restrict their scope.

35 Patent duration

How is the duration of patent protection determined?

- patent granted after substantive examination: 20 year term;
- patent granted without substantive examination: 7 year term; and
- utility model (granted without inventive step examination): 10 year term.

Deris Patents and Trademarks Agency AS

M N Aydın Deris

deris@deris.com.tr

Inebolu Sokak
Deris Patent Building, No. 5
Setustu Kabatas 34427
Istanbul
Turkey

Tel: +90 212 252 6122/23, 212 249 7010/11,
212 292 6000 (6 lines)
Fax: +90 212 293 7676, 212 292 5994
www.deris.com.tr



GETTING THE DEAL THROUGH®

Annual volumes published on:

| | |
|-----------------------------------|------------------------------|
| Air Transport | Merger Control |
| Anti-Corruption Regulation | Mergers & Acquisitions |
| Arbitration | Mining |
| Banking Regulation | Oil Regulation |
| Cartel Regulation | Patents |
| Construction | Pharmaceutical Antitrust |
| Copyright | Private Antitrust Litigation |
| Corporate Governance | Private Equity |
| Dispute Resolution | Product Liability |
| Dominance | Project Finance |
| e-Commerce | Public Procurement |
| Electricity Regulation | Real Estate |
| Environment | Restructuring & Insolvency |
| Franchise | Securities Finance |
| Gas Regulation | Shipping |
| Insurance & Reinsurance | Tax on Inbound Investment |
| Intellectual Property & Antitrust | Telecoms and Media |
| Labour & Employment | Trademarks |
| Licensing | Vertical Agreements |

**For more information or to
purchase books, please visit:
www.GettingTheDealThrough.com**



Strategic research partners of
the ABA International section



THE QUEEN'S AWARDS
FOR ENTERPRISE
2006



The Official Research Partner of
the International Bar Association