

# Patent Infringement

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In the absence of any patent protection in Turkey, it is only possible to take a legal action on the basis of unfair competition according to the general Unfair Competition provisions of the Turkish Code of Commerce where the concerned products are being offered for sale or sold in Turkey prior to those of the counterfeiters.

Where the client benefits of a patent in Turkey through a national registration or an European Patent having effect in Turkey, it is important to note that pursuant to the Article 92 of the Decree Law no.551 pertaining to the protection of patent rights “*rights conferred by an application for patent or a patent may not be invoked against third parties unless and until they are duly entered in the Patent Register*”. Accordingly, the patent holder or pursuant to articles 82 and 136 of the same Decree Law, where his national patent application or the Turkish translation of the claims of his European Patent application have been published in the Official Patent Bulletin (according to articles 8 to 10 of the Regulation on the granting of European Patents and the implementation of the European Patent Convention, the European patent applications are considered to acquire the same rights as a national application at this stage) or else where the infringer is notified of the existence of the application or of its scope without the application being published (through a cease and desist letter for example), the applicant, is entitled to institute before the courts civil and criminal proceedings on grounds of infringement of the invention.

- In the scope of a civil action, according to article 137 the patent holder/applicant whose rights arising from his patent/patent application are infringed has the right to apply to the court and ask for:
  - the infringement to be stopped and prevented
  - payment of compensation for material and moral damages sustained because of the infringement

- confiscation or transfer ownership of the counterfeit products as well as the tooling; materials and means used in their manufacturing
- taking the appropriate measures for preventing the continuation of the infringement and in this context the changing of the features of the counterfeit products and where this is not feasible the destruction of the counterfeit products and the tooling, material and means used in their manufacturing
- the publication of the Court decision on the infringement in a newspaper

Before instituting the main patent infringement and/or unfair competition action, the determination of evidences relating to the infringing acts may be requested by filing a specific action (“action en constatation”, “feststellungsklage”) before the newly established specialized “Court of Istanbul for Industrial and Intellectual Rights in determination of evidence that is of the ongoing infringement. The court will appoint to this effect a panel of 3 (three) experts with the task to establish a report as to whether the goods produced by the infringer constitute infringement of the rights arising from the patent or patent application of the plaintiff.

The main patent infringement and/or unfair competition action could be filed depending on the result of the action in determination of evidence which, if affirmative will serve as evidence within the context of the patent infringement and/or unfair competition action to be instituted subsequently.

The court may order or not an interlocutory injunction for stopping the infringing acts upon a favorable Experts’ Report issued by the panel of experts nominated by the court to this effect within the context of the action in determination of evidence. However, it should be noted that such interlocutory injunctions are rarely obtained as the courts have discretionary competence to order or not such injunctive measures considering that the courts tend to be rather conservative on the issue. It is further to be noted that the decision for interlocutory injunction is taken against a guarantee payment, the amount of which is determined by the court as of its discretionary competence. Therefore it is impossible for us to predict at this stage, even by giving a guesstimate, the amount of this guarantee to be paid by the plaintiff.

Upon decision of the Court ordering injunctive measures the main infringement action shall have to be instituted within 10 days as from the date of injunctive order. If the Court

decides not to order the injunctive measure despite the favorable Experts' Report in the second step the main action for patent infringement and unfair competition will have to be instituted. It is to be noted that a renewed request for interlocutory injunction can be made with the filing of the main action.

It is also possible to act against patent infringement by taking the penal route. To this effect a complaint is filed before the Public Prosecutor who, if convinced of the infringement, institutes directly the criminal action before the Criminal Court. The patent holder/applicant can only join such a criminal action but cannot directly institute it.

With regard to the penal route we would further like to inform you in the light of our recent experiences that such complaints before the Public Prosecutor are not favorable received where the patent is not granted yet and that the Public Prosecutors disregarding the above mentioned article 136 granting the same rights to the applicant upon publication of his application, state that the initiation of criminal proceedings for industrial property rights is not possible before their maturation into registration in accordance with the decisions of the Supreme Court.