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Law
Business
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Global Overview Stuart J Sinder <i>Kenyon & Kenyon LLP</i>	3
European Patent Convention Elard Schenck zu Schweinsberg <i>Vossius & Partner</i>	8
Angola António Vicente Marques <i>Raul César Ferreira (Herd) SA</i>	12
Argentina Mariano Municoy <i>Moeller IP Advisors</i>	16
Austria Peter Israiloff <i>Barger, Piso & Partner</i>	22
Belgium Ben Hermans <i>Monard-D'Hulst</i>	30
Brazil Alexandre Domingues Serafim, Lucas Garcia de Moura Gavião and Juliana Krueger Pela <i>Lilla, Huck, Otranto, Camargo Advogados</i>	37
Canada Gordon Freedman and Mark Weir <i>Freedman</i>	43
China Jianyang (Eugene) Yu <i>Liu, Shen & Associates</i>	51
Colombia Carlos R Olarte and Andres Rincon <i>OlarteMoure</i>	57
Cyprus Hermione Markides <i>Markides, Markides & Co LLC</i>	64
Denmark Johan Løje and Mette Højlund <i>Sandel, Løje & Partnere</i>	70
Ecuador María Rosa Fabara-Vera <i>Fabara & Guerrero Intellectual Property</i>	76
France Gérard Dossmann <i>Bureau Casalonga & Josse</i>	83
Germany Sandra Pohlman, Oliver Schulz and Rainer Friedrich <i>df-mp</i>	88
Greece Alkisti-Irene Malamis <i>Malamis & Malamis</i>	96
Honduras Ricardo Anibal Mejía M <i>Bufete Mejía & Asociados</i>	102
Hong Kong Hans Lee <i>ONC Lawyers</i>	108
India Archana Shanker and Gitika Suri <i>Anand and Anand</i>	114
Israel Sa'ar Plinner <i>Price Plinner Law Offices</i>	123
Italy Massimiliano Mostardini and Daniele De Angelis <i>Studio Legale Bird & Bird</i>	128
Japan Koichi Nakatani <i>Momo-o, Matsuo & Namba</i>	136
Macedonia Valentin Pepeljugoski <i>Pepeljugoski Law Office</i>	143
Malaysia Benjamin J Thompson <i>Thompson Associates</i>	149
Mexico César Ramos Jr, Alejandro Luna, Juan Luis Serrano and Erwin Cruz <i>Olivares & Cia</i>	157
Mozambique António Vicente Marques <i>Raul César Ferreira (Herd) SA</i>	164
Nigeria Olusola Mesele and Aderonke Adejuge <i>Strachan Partners</i>	168
Peru Carmen Arana Courrejolles <i>Estudio Colmenares & Asociados</i>	174
Poland Katarzyna Karcz and Jaromir Piwowar <i>Patpol</i>	182
Portugal Patricia Rodrigues <i>Raul César Ferreira (Herd) SA</i>	189
Romania Cosmina Fierascu and Mihaela Teodorescu <i>Rominvent SA</i> and Iulia Burbea-Milescu <i>Iulia Burbea Law Office</i>	195
Russia Vladimir Rybakov <i>ARS-Patent</i>	202
Sweden Kristian Fredrikson <i>Brann AB</i>	207
Switzerland Daniel Müller and Rainer Schalch <i>E Blum & Co AG</i>	213
Taiwan Yulan Kuo, Hsiaoling Fan and Charles Chen <i>Formosa Transnational, Attorneys at Law</i>	219
Turkey Hamdi Yasaman and Fülürya Yusufoglu <i>Yasaman Law Firm</i>	226
United Kingdom Nick Beckett and Jeremy Morton <i>CMS Cameron McKenna LLP</i>	232
United States Stuart J Sinder, Michelle M Carniaux and Shawn W O'Dowd <i>Kenyon & Kenyon LLP</i>	242
Venezuela Carlos Pacheco and María M Nebreda <i>Hoet Peláez Castillo & Duque</i>	256
Vietnam Pham Vu Khanh Toan <i>Pham & Associates</i>	262

Turkey

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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?

The current law governing patent practice in Turkey is Decree-Law No. 551 on the Protection of Utility Models and Patent Rights in Turkey, which has been in force from 27 June 1995. Patent rights can be enforced in Turkey against an infringer through civil proceedings. According to article 146 of the Decree-Law, special courts are established by the Ministry of Justice and have jurisdiction over all actions and claims provided for in this Decree-Law. The infringement actions are enforced by the Intellectual Property Courts. These courts are specialised in intellectual property rights such as trademark, intellectual property, patent, utility model and industrial design. But there is not a specialised patent court.

2 Trial format and timing

What is the format of a patent infringement trial?

Patent infringement trials in the Intellectual Property Courts usually take place in front of a single expert judge and the dispute issues are decided by this judge. The judge has the right to request a technical expert opinion if needed. Especially during patent infringement trials, the judge will require technical support from experts who are not linked to one of the parties. The witnesses and the expertise submitted by one of the parties are taken into consideration as discretionary evidence. The judge is not bound by the evidence brought by the parties. Cross-examination of witnesses is permitted, but is not considered as conclusive evidence. Cases heard in the Intellectual Property Courts follow a simpler procedure on the basis of written submissions. The length of the oral trial before the court lasts no more than half an hour.

3 Proof requirements

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

The person who claims infringement to the patent bears the burden of proving the allegations. Each party has the burden of proof of their allegations. But there is an exception related to the patents concerning the process. According article 84/2 of the Decree-Law, where a patent concerns a process for the manufacture of new products or substances, it shall be presumed, in the absence of proof to the contrary, that any product or substance having the same properties has been manufactured by means of the patented process. The burden of proof shall be on parties alleging the contrary. According to article 84/3, in legal proceedings over an allegation to the contrary under the second paragraph of the article, due regard shall be given to the legitimate interest of the defendant in the non-disclosure of his or her

manufacturing and trade secrets. Here, the burden of proof belongs not to the person alleging the infringement, but to the defendant.

In case of invalidity claims, the person alleging the invalidity of a patent shall bear the burden of proof that the invention does not meet the patentability requirements. The same rule applies to the unenforceability allegations; the person claiming that the patent is not enforceable shall prove its allegations.

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?

A patent owner whose rights are infringed may apply to the court and sue for patent infringement. If an infringement case is opened, the accused infringer has no right to bring a lawsuit to obtain a judicial ruling or a declaration on the accusation. But according to article 149 of the Decree-Law, any interested party may institute proceedings against a patent owner to obtain a ruling of non-infringement of patent rights.

Prior to the institution of proceedings under the foregoing paragraph, a notice shall be sent through a notary public for the attention of the patent owner to enable the said owner to express his or her views on whether industrial activities carried on in Turkey, or the genuine and effective preparations made to that end, infringe the patent rights.

Where the patent owner, on receiving such a notice, does not respond within a month of receipt thereof, or where the content of the response is not found acceptable by the party serving the notice, the latter shall have the right to institute proceedings as stated in the first paragraph above.

Persons against whom infringement actions have been brought in respect of patent rights may not institute proceedings under the first paragraph of this article.

The institution of proceedings shall be notified to all holders of rights taking place in the Patent Register.

5 Inducement, and contributory and multiple party infringement

To what extent can someone be liable for inducing or contributing to patent infringement? Can multiple parties be jointly liable for infringement if each practises only some of the elements of a patent claim, but together they practise all the elements?

The following are held responsible for inducing or contributing to patent infringement:

- a person, imitating the product to which the patent relates by manufacturing all or part of the said product without the consent of the patent owner;
- a person selling, distributing or otherwise marketing products, or importing them for such purposes, or stocking them for commercial purposes when it is known, or should be known, that the said products are complete or partial imitations;

- a person using the patented process or selling, distributing or otherwise marketing, or offering or importing for such purposes, products directly obtained by means of the patented process without the consent of the patent owner;
- a person broadening the scope of rights granted by the patent owner under a contractual or compulsory licence, or transferring such rights to third parties, without the consent of the patent owner;
- a person participating in the above mentioned acts or assisting or promoting them, or in any way and in any circumstances facilitating the performance thereof; and
- a person failing to declare the source from which, and the manner in which, unlawfully manufactured or marketed products found in his or her possession were obtained.

6 Joinder of multiple defendants

Can multiple parties be joined as defendants in the same lawsuit? If so, what are the requirements? Must all of the defendants be accused of infringing the same patents?

If multiple parties are jointly liable for infringement, they can be joined as defendants in the same lawsuit. However, if the alleged infringers are infringing the same patent independently, they cannot be joined as a defendant in the same lawsuit.

7 Infringement by foreign activities

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

Patent infringement activities taking place in Turkey are settled before the Turkish Intellectual Property Court. But even if the activities taking place outside Turkey produce an effect in Turkey, Turkish law is applied and the infringement action can be brought before the Turkish Intellectual Property Courts.

8 Infringement by equivalents

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

Interpretation of patent claims is a very delicate area, as it involves an interpretation defining a position between fair protection for the patentee with a reasonable degree of certainty for third parties. The doctrine of equivalents provides that the scope of a patent claim can extend beyond the literal words of the claim so that a device containing elements equivalent to that claimed may infringe the patent, but it cannot be interpreted in a manner that permits an expansion of the scope of a patent to cover variants outside the language of a claim. Therefore, the equivalents shall be interpreted narrowly.

9 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?

Any person legally entitled to bring an action for infringement of patent rights may request the court to determine and secure evidence of acts that may be regarded as infringing such rights. Besides, as mentioned above, where a patent concerns a process for the manufacture of new products or substances, it shall be presumed in the absence of proof to the contrary that any product or substance having the same properties has been manufactured by means of the patented process. The burden of proof shall be on parties alleging the contrary. In this case, the defendant should present evidence that he or she does not infringe the patent.

10 Litigation timetable

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

The average of the overall length of the judgement is from two to four years, including the appeal procedure.

11 Litigation costs

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

Litigation costs in Turkey are not expensive. Firstly, the claimant shall pay the basic fee amounting up to 700 to 750 Turkish lira as he or she files a suit. During the trial, some fixed fees and expertise rapport costs occur, which are not expensive compared to other European countries. The cost for one expert is approximately 1,000 Turkish lira. Usually, three experts take their place on the expert panel and usually the judge refers to the expert panel three times until the final award, depending on the complexity of the case. In the end, the total cost for a typical patent infringement lawsuit ranges between 2,500 and 3,500 Turkish lira.

12 Court appeals

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

The Supreme Court is the final instance for reviewing rulings and judgments rendered by justice courts and reviews the Intellectual Property Court's decisions.

13 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?

The enforcement of a patent may have anti-competitive effects if used, for instance, to coordinate or fix prices, or to discourage innovation. A patent that is likely to be invalid or unduly broad can deter innovation by making rivals take actions to avoid infringement. This can give rise to competition problems. Despite the fact that the patent is poor and likely to be invalid, if someone presents himself or herself as a monopoly holder, this may give rise to unfair competition.

14 Alternative dispute resolution

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

A person wishing to apply for a compulsory licence may first address a request for mediation to the Turkish Patent Office with a view to obtaining a contractual licence for the patent. Besides, there is no other provision related to the alternative dispute resolution. However, both parties can always reach an agreement outside the court.

Scope and ownership of patents

15 Types of protectable inventions

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

Inventions that are novel, go beyond the state of the art and applicable in industry can be protected by patents. Discoveries, scientific theories, mathematical methods, plans, methods and rules for performing mental acts, conducting business activities and playing games, literary and artistic works, scientific works, creations having aesthetic characteristics, computer programs, methods of collecting, arranging, presenting and transmitting information that have no technical features and methods of diagnosis, therapy and surgery applicable to the human or animal body are considered as not being inventions and remain outside the scope of the Decree-Law.

Despite the fact that methods of diagnosis, therapy and surgery applicable to the human or animal body are not protected by the patent law, the actual products and compositions used in connection with the said methods or to the manufacturing process thereof are protected under the patent law.

There is another provision stating that patents shall not be granted for inventions relating to the subject matter contrary to public policy or generally accepted standards of morality and plant and animal varieties or processes for breeding plant or animal varieties that are based mainly on biological factors.

16 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?

According to article 11 of the Decree-Law, the right to a patent shall belong to the inventor or to his or her successor in title and shall be transferable. Where an invention has been made jointly by two or more persons, the right to apply for a patent shall belong to them jointly unless they have agreed otherwise. Where an invention has been made independently by two or more persons at the same time, the right to a patent shall belong to the person who files the first application or who can claim an earlier priority right than the others. The person who is the first to apply for a patent shall be invested with the right to apply for the patent until the contrary is proved.

According to article 16, employee inventions are those inventions that qualify for protection under a patent or utility model certificate. For the purposes of the Decree-Law, an employee is a person who is in the service of another person and is responsible for carrying out the work specified by the employer with personal liability towards the employer, in accordance with the provisions of a private legal contract or legal relations of a similar nature. Trainees and students serving and undergoing practical training who are not receiving payment and are not bound to a specific work schedule are also considered employees.

Transactions between persons in relation to a patent application or patent shall be evidenced in writing. Patent applications and patents shall be registered in the Patent Register in accordance with the provisions of the regulations. Transfers and licences relating to applications or patents, or other acts, whether voluntary or mandatory, affecting patent applications or patents shall be binding on bona fide third parties as from the date of their entry in the Patent Register. The rights under a patent application or patent may not be invoked against third parties unless and until they have been duly registered in the Patent Register.

Defences

17 Patent invalidity

How and on what grounds can the validity of a patent be challenged? Is there a special court or administrative tribunal in which to do this?

A patent shall be declared invalid by the Intellectual Property Court, where it is established that the subject matter of the invention does not meet the patentability requirements:

- where it is established that the subject matter of the invention has not been described in a sufficiently explicit and comprehensive manner for a person skilled in the technical field concerned to carry it out;
- where it is established that the subject matter of the patent goes beyond the scope of the application or is based on a divisional application; or
- where it is established that the holder of the patent does not have the right to a patent.

The competent court is the Intellectual Property Court. After the grant of the patent, the Turkish Patent Office is no longer competent on validity grounds.

18 Absolute novelty requirement

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

There is an 'absolute novelty' requirement for patentability. Any invention that is not part of the state of the art shall be deemed novel. The state of the art shall be held to consist of information pertaining to the subject matter of the invention that has been made accessible to the public in any part of the world before the filing date of the patent application by disclosure either in writing or orally, by use or in any other way. Patent and utility model applications filed in Turkey prior to the filing date of the patent application and published on or after that date shall be considered included in the state of the art as from the first disclosure of their contents.

Some disclosures do not affect the novelty requirement. According to article 8 of the Decree-Law, disclosure in the following circumstances of information that otherwise would affect the patentability of the invention claimed in an application shall not affect the patentability of that invention where the information was disclosed during the 12 months preceding the filing date or, where priority is claimed, the priority date of the application:

- by the inventor;
- by an office when the information was contained:
 - in another application filed by the inventor and should not have been disclosed by the office; or
 - in an application filed without the knowledge or consent of the inventor by a third party who obtained the information directly or indirectly from the inventor; or
- by a third party who obtained the information directly or indirectly from the inventor.

19 Obviousness or inventiveness test

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

An invention shall be deemed to go beyond the state of the art (to involve an inventive step) when it is the result of action that cannot obviously be deduced from the state of the art by a person skilled in the technical field concerned.

20 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?

The fact that a patented invention cannot be used without the use of an invention protected by an earlier patent shall not be an obstacle to its validity. In such cases, neither the owner of the rights in the earlier patent nor the owner of the rights in the later patent may use the other's patent without his or her consent during the term of validity thereof. The patented invention cannot be enforced without infringing the rights of the other patent holder.

21 Prior user defence

Is it a defence if an accused infringer has been privately using the accused method or device prior to the filing date or publication date of the patent? If so, does the defence cover all types of inventions? Is the defence limited to commercial uses?

Acts devoid of any industrial or commercial purpose and limited to serving solely private ends remain outside the scope of the rights conferred by the patent. The private use is outside the scope of the patent. Besides, article 77 of the Decree-Law regulates the rights conferred by prior use.

The owner of a patented invention does not have the right to prevent a person or persons who, in good faith, between the filing date of the application and the priority date, have worked the invention in Turkey, or made genuine and effective preparations for working it, from continuing to do so in the same manner as before, or from commencing such working on the basis of preparations made to that end. However, third parties may continue to work the subject matter of the patent in the same manner as before, or commence such working on the basis of preparations made to that end, only to the extent necessary to meet the reasonable needs of their enterprise. This right to work the invention shall only be transferable with the enterprise itself.

Remedies

22 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 nominal, provide fair compensation or be punitive in nature?

A patent owner whose rights are infringed may apply to the court for the following particular remedies for infringement and compensation for material and moral prejudice suffered:

- a person who, without the consent of the proprietor of the patent, manufactures, sells, distributes or in any form markets a patented product, or imports it for those purposes, or stocks it for commercial purposes, or makes use of a patented process shall be liable to remedy the unlawful situation and to provide compensation for the prejudice caused; or
- a person who makes use of a patented invention in any other way shall be liable to provide compensation for the prejudice caused only if he or she has been informed by the patent owner of the existence of the patent and his or her infringement thereof, and has been requested to stop the said infringement, or if his or her action has been culpable or negligent.

According to article 140 of the Decree-Law, the prejudice suffered by the patent owner shall include not only the value of the actual loss, but also the lost profits due to the infringement of the patent rights. The lost profits shall be calculated according to one of the following criteria at the discretion of the patent owner who has suffered the prejudice:

- the profit that the patent owner might have been expected to realise if there had been no competition from the infringing party;
- the profit actually realised by the infringer through his or her use of the patent; or
- the licence royalties that would have been paid if the infringer had used the patent lawfully under a licence agreement.

When the lost profit is calculated, due account shall be taken in particular of the economic value of the patent, the term of protection remaining at the time of infringement and the type and number of any licences granted in respect of the patent.

Where the court finds that the owner of the patent rights has not fulfilled his or her obligation to use the patent, the lost profit shall be calculated according to that stated in the last bullet point above.

Damage awards tend to provide fair compensation.

23 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?

Persons who intend to file or have filed a law suit, in order to ensure the effectiveness of the main action, have the right to request the court to order a temporary injunction, provided that the person

requesting the temporary injunction brings evidence of actual use of the patent in Turkey, or of genuine and effective preparations for such use that would constitute infringement of the plaintiff's patent rights. The request for temporary injunction may be filed before or on the institution of the law suit or later.

24 Banning importation of infringing products

To what extent is it possible to block the importation of infringing products into the country? Is there a specific tribunal or proceeding available to accomplish this?

Temporary injunctions shall secure the effectiveness of the judgment and the intellectual property judge has the discretionary power to order the blocking of the importation of infringing products into the country.

25 Attorneys' fees

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

The successful party will recover its costs and attorney's fees. But it has to be noted that the unsuccessful party will be confined only to the formal rates of the attorney's fees as specified by the Bar Association. Apart from the formal rates, the fees designated by a contract between the lawyer and his or her client cannot be recovered by the unsuccessful litigant.

26 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 unlawful user of the patented invention is liable to provide compensation for the prejudice only if he or she has been informed by the patent owner of the existence of the patent and his or her infringement thereof, and has been requested to stop the said infringement, or if his or her action has been culpable or negligent, which means that the unlawful use by a person who ignores that the use is unlawful is not held responsible. But as of the date of information about the unlawful use, he or she will be held responsible if he or she continues to make use of the invention.

27 Time limits for lawsuits

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

Remedies for patent infringement can be sought as long as the infringement continues.

28 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? What are the consequences of false patent marking?

Patent holders are under no obligation to mark their products as patented. However, persons who falsely present themselves as the owner of a patent or as the owner of the rights in a patent application shall be sentenced to imprisonment for a term of between one and two years and to a fine of up to 27,000 Turkish lira. It is important to note that imprisonment to two or more years may be suspended for a definite or indefinite time (Turkish Penal Code, article 51) and in the case of an imprisonment for two or less years, the court may decide to delay the pronouncement of the judgment (Turkish Criminal Procedure Code, article 231/5).

Update and trends

The present decree law is to be replaced by the draft law on patent protection. It has to be noted that, according to the current patent system, there are two different systems for granting patents: the system for granting patent without (substantive) examination and the system enforced by most of the European countries – the system for granting patent with (substantive) examination. According to the draft law, the system granting patent without substantive examination is to be abolished. Also, according to the draft law, the 98/44/EC European Directive on the Protection of Biotechnological Inventions will be implemented.

Licensing

29 Voluntary licensing

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

Licensing practices or conditions may, in particular cases, constitute an abuse of intellectual property rights having an adverse effect on competition. For example exclusive grant-back conditions, conditions preventing challenges to validity and coercive package licensing constitute abuse of intellectual property rights.

30 Compulsory licences

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

A compulsory licence is granted in three cases: where the patent owner does not use the patent for more than three years as of the date of the publication in the Patent Bulletin announcing the grant of the patent; where there are dependant patents and on the grounds of public interest. A person wishing to apply for a compulsory licence should first address a request for mediation to the Patent Institute with a view to obtain a contractual licence for the said patent. When the patent office agrees to the mediation request, it will immediately summon the parties to contractual licence negotiations in which it shall act as a mediator. If the parties do not agree to reach a mutual decision or the patent office refuses the mediation request, the person may apply to the court. The court will give the final decision related to the compulsory licence.

Patent office proceedings

31 Patenting timetable and costs

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

Patent grant procedure lasts not less than 18 months if third parties do not object to the patent application. On the other hand, if a third party objects to the application, the procedure may last for three to four years. Concerning the patent grant procedure costs, it depends on the time and effort put into the application process. For instance, patents on pharmaceuticals involve more specific and intensive work. However, an average patent attorney's fee is approximately €4,500 to which the official IPO fees will be added (approximately €300). Renewal fees increase as long as the patent life and range between €60 and €740.

32 Expedited patent prosecution

Are there any procedures to expedite patent prosecution?

If the applicant pays an extra fee, the examination unit may accelerate its examination.

33 Patent application contents

What must be disclosed or described about the invention in a patent application? Are there any particular guidelines that should be followed or pitfalls to avoid in deciding what to include in the application?

In order to obtain a patent, it is necessary to file an application, the form and content of which shall be determined by the regulations. Accordingly, the written application shall comprise a description of the subject matter of the invention, a claim or claims covering the elements of the invention for which the protection is sought, the drawings referred to in the description, an abstract and a receipt attesting payment of the application fee.

34 Prior art disclosure obligations

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

The applicant shall give detailed information about the subject matter of the invention in the patent description. Moreover, the applicant shall give information about similar inventions in Turkey and abroad, the publications related to the invention and shall describe the novelty and the inventiveness of his or her invention.

35 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?

The patent holder or patent application holder may apply for additional claims (additional patents) relating to the subject matter of the main patent and that improve or develop the invention to which the main patent relates. The priority date of an additional patent shall be determined by the filing date of the application. The duration of the additional patent is limited to the duration of the main patent, as the additional patent is considered an integral part of the main patent.

36 Patent office appeals

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

No.

37 Oppositions or protests to patents

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

Within six months following the publication of the report related to the state of the art, third parties may, in the form laid down in the regulations, file objections to the grant of the patent, alleging non-compliance with the patentability requirements, including lack of novelty or inventive step or the inadequacy of the description. Documentary evidence in support of the allegation should be enclosed with the objections, which shall be made in written form.

When objections are raised by third parties, all such objections and the evidence in support should be immediately notified to the applicant. The applicant may respond to the objections within three months following the expiry of the period allowed for raising objections, or may submit reasons in support of his or her response with a view to removing the objections raised, or if deemed necessary, may amend the description, the drawings and the claims.

38 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 two or more persons at the same time, the right to a patent shall belong to the person who files the first application or who can claim an earlier priority right than the others.

The person who is the first to apply for a patent is deemed to be the rightful applicant, unless the contrary is proved.

The Turkish Patent Office does not provide any dispute resolution related to the priority claims.

39 Modification and re-examination of patents

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

With the exception of the rectification of obvious errors such as spelling errors or the submission of the wrong documents, the claims may be amended only in the course of the grant procedure and only where it is permitted by the Decree-Law. The scope of the application may not be broadened by amendment of the claims. If, in the course of the examination of the patent application, the subject matter of the

invention for which a patent is sought is changed, either entirely or in part, in such a way that the contents of the application as initially filed are broadened, the date of the request for the said change is deemed as the application date. If objections are raised by third parties, the applicant may amend the description, the drawings and the claims.

Where the grounds for invalidity concern only part of a patent, partial invalidity of the patent shall be declared by cancellation of the claims pertaining to that part. A single claim may not be partially revoked, which means that during a revocation proceeding before the court, the patent claim cannot be amended. Self-limitation by the patent proprietor is not recognised for Turkish patents. New article 138(3) EPC has changed this practice for European patents registered in Turkey. It is designed to give the patent proprietor the right in such proceedings to submit an amended, namely, limited, version of his or her claims, which in his or her view meets the objections to the validity of his or her patent. This limited version of the patent must then form the basis for subsequent proceedings. If the court or authority dealing with the case considers that the proprietor's own limitation is insufficient, it may further limit the patent or revoke it in full.

40 Patent duration

How is the duration of patent protection determined?

Patent protection is generally granted for 20 years.

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