

THOUGHTS ON INVALIDATION OF PATENTS IN TURKISH LAW

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SUMMARY:

When it comes to Principles of the EU law on the invalidity of patents ~~principals of EU law~~ and ~~the~~ related treaties ~~which are dealing it on this subject is are~~ similar ~~with to the provisions of~~ Turkish ~~Litigation~~ legislation. But there is not a centralized competent court ~~to run that hears~~ the invalidity ~~eased~~ disputes. ~~So~~ Thus, the ~~same~~ ordinary civil courts of first instance ~~civil court~~, and if it is available the same specialized ~~civil~~ court of first instance if any, is competent to ~~handle~~ hear both the invalidity ~~disputes and as well as~~ the other civil cases.

In a penal case ~~however, the~~ Judge ~~should has reach to to find~~ the concrete reality and ~~has a right to~~ evaluate ~~the -inter partes- the given~~ evidence about the patentability of ~~the~~ said invention. This is a limited search for the truth ~~of that case in respect to the alleged offense~~.

Granting ~~p~~ Patents ~~is has an incentive feature an expected return for on~~ investment ~~made in research and development and new prospective inventions an incentive for innovative work~~. However, the balance between ~~the interests of the right holders and holder and of the community in general~~ has to be ~~delicately taken into consideration~~ considered with utmost care.

INTRODUCTION:

Unlike ~~the position under~~ copyright law where rights arise ~~without formality ipso jure~~, patents are ~~only~~ granted ~~only after upon having complied with~~ a series of formal procedures ~~have been complied with~~. The process of registration plays a key role in defining many aspects of patent law and practice.¹ A patent will be granted ~~if (if (i) it does~~ consist of a ~~patentable~~ subject matter ~~that is patentable;~~ (ii) ~~it is~~ new (iii) ~~it~~ involves an inventive step and (iv) ~~if it~~ complies with the internal requirements of patentability. That system makes it possible for owner to enjoy monopolistic rights deriving from patent. A ~~certain~~ part of these rights are negative rights which give owner ~~the right~~ to hinder others ~~to use from using~~ the patent without ~~his~~ consent. These are ~~regulated provided in the Article 73 of Decree Law no N: 551 pertaining To Protection of Patent Rights~~ Pertaining to the Protection of Patent Rights, ~~article 73:~~ as amended ~~with by the law no Law N. 5194 at on~~ June 22, 2004. According to ~~that this~~ article, patent owner is entitled to prevent following actions ~~by of~~ others, if performed without permission;

- (i) Production, sale, use, or importation of patented products or keeping them in possession for purposes other than for ~~fair needs~~ personal needs;
- (ii) Use of a ~~patented~~ process ~~that is subject matter of the patent;~~
- (iii) Offers made by third persons to others for the use of a patented process of which the use is known or should be known to be prohibited;
- (iv) Putting or sale or making use or importing or keeping in possession for any such purpose other than for ~~fair~~ personal needs of products directly obtained through the patented process.

¹*Intellectual Property Judge in İzmir.

[?] BENTLY, Lionel - BRAD, Sherman; Intellectual Property, 3rd edition, 2001 London, p. 341.

Commercially exploitation of third parties can be an infringement if, owner did not give his consent.²

It is ~~harder~~ more difficult to defend and prove ~~that the validity of~~ a patent ~~is valid~~ which that is granted after ~~a consequence from~~ an administrative process, and often without substantive examination, than ~~solely~~ obtaining it. Examinations ~~of the court~~ will be more ~~delicate, meticulous and intensive~~ stringent, and ~~supported by~~ shall be based on concrete evidence ~~during the judicial phase~~.

Ottoman Empire was among the first countries in the world that ~~launching started~~ patent protection of inventions by enacting patent protection via adopting a patent law ~~at as~~ early as 1879. ~~After the proclamation of the Republic, studies were made in~~ Turkey, ~~after proclaiming the republic, did some actions~~ on patent protection and ~~thus the norms on international protection were adopted as a result of~~ by joining ~~the TRIPSTRIPS~~, ~~by and signing~~ acceding to the GATT, ~~and by signing the Customs Union agreement with the~~ EU adopted international protection norms.³

~~Invalidity~~ Invalidation of a patent means, to have a patent unregistered by a court order that would be passed that with entity of specific reasons that are regulated if and when the existence of the conditions provided in ~~in~~ Decree Law N.551 Pertaining to the Protection of Patent Rights ~~Decree Law No: 551 Pertaining To The Protection Of Patent Rights are established;~~ ~~deleting it from registry with a court decision~~ whereas; termination of a patent ~~right~~ means ~~with surrendering by~~ surrender of the ~~the~~ patent holder ~~of the patent~~ by the rightful holder; ~~either voluntarily or upon expiration of the patent term, or else upon having failed to pay expiring of term of protection or non payment of the annual and additional fees within the prescribed terms.~~⁴ ~~New~~ ovel; ~~inventive and industrially applicable inventions that surpass state-of-the art and which are protected by granting a patent document applicable in industry shall be protected by issuing patents.~~ The rights ~~that emerged would have been with granted by~~ obtaining a patent ~~are document~~ defined as rights which are deriving from patent. These exclusive rights entitle patent owner to prevent third persons from exploiting the invention commercially without patentee's permission. ~~That kind of illegal actions are regulated within the article~~ The actions that fall within the scope of such prevention are provided in Article 73 of ~~Decree Law N.551 -Pertaining to the Protection of Patent Rights~~ ~~Decree Law No: 551 Pertaining to The Protection of Patent Rights~~. According to this ~~provision~~ Article, patent owner can prevent the above mentioned ~~acts actions~~ and the possession of patented products, ~~with a reason for any reason~~ other than personal needs. In this article, the balance between the rights of patent owner and the rights-interests of the public, ~~will be discussed~~ which is the crucial point in ~~this issue is~~ the revoking-revocation or annulment of a patent ~~or invalidity of a patent in~~ by a judicial panel⁵, will be discussed.

A case for ~~The the~~ invalidity-invalidation of patent ~~case~~ is not ~~in a sense a~~ purely an ~~invalidity-invalidation~~ easedispute. It ~~is also at the same time constitute an executive decision in respect of related to that particular patent's future, which will have to be enforced.~~ ~~Beside~~ Not only private ~~benefits~~ interests, but also public interest ~~also~~ is ~~to take~~ taken into consideration ~~via evaluation of in accordance with the terms and~~ conditions on patentability ~~of as provided in Articles 5 - 10 of Decree Law No: 551, in article 5 to 10.~~ The case will be ~~ended-concluded with upon passing of a judgment both on the invalidation and also a decision which contain in a manner of execution not only specifying invalidity on the abandonment of the of~~ patent⁶. As a result of that case an examined patent may be held invalid within its the

² SARAÇ, Tahir; Patent Hukukunda Hükümsüzlük Davaları, İstanbul 2004, p. 1.

³ KAYACAN, Vildan; İlaçta Patent Korumasının Etkileri ve Korunma Tedbirleri, Ankara 2001, p. 1.

⁴ TEKİNALP, Ünal; Fikri Mülkiyet Hukuku, 3rd edition, İstanbul 2004, p. 568.

⁵ SARAÇ, p. 1.

⁶ TEKİNALP, p. 569.

protection term of 20 years and during the 5 years after following this term and; -if it is an unexamined patent, which starts from its registration and within 7 years, starting from its registration, and during the 5 years after following this term when it is unexamined one. However, in The Decree Law of N.551 there is not an article which shows as to the beginning of when this additional 5-years period starts-. Therefore, it must be accepted we can assume that it is from the end of the starts as soon as the protection time ends. Most of the invalidity invalidation cases occur are brought up as a counterclaims when patent owners use his/her/their deterrent rights coming that originate from the patent with an asserted by filing infringement cases⁷.

II- REQUIREMENTS OF PATENTABILITY

Article 5 of Decree Law of N.551; article 5 sets the norms of for the registration of a patent. These are novelty, inventive step and as well as industrial applicability and - as a negative one norm - not to being a kind of have fallen within the scope of a non-patentable subject matter matter and or inventions.

a) *Novelty*: Article 7 of the Decree Law defines novelty as “not being a part of the state of the art”. The benchmark of for being or not being a part of the state of the art is shall be set as of the date of application for the patent. Decree Law seeks an absolute and universal novelty.

It is impossible to accept to deem that that there is novelty exists when if the inventive information - written or orally - is is accessible available in a manner that to the public can obtain it in any where in part of the world before the application date for the patent⁸. However, Article 8 of the Decree Law article 8 sets the specific disclosures which are not destructive and deemed to have compromised novelty. According to that this article, disclosures that are made of 12 months before the application or the priority date, by the patentee or others under his control, can shall not impact the innovative character of said invention.

Technical features features, for which protection is sought, in other words, claims should have been sufficiently disclosed in the patent application form in such a manner that would allow to the public search public research in the application form of patent. To Whereas the make public is required to be be informed is enough and it has, there is no obligation about as to confidentiality. Board of Appeal of European Patent Office has held that disclose to the public means disclose to the persons who are skilled⁹ in the related area field. An Oral disclosure before a certain group of persons, who were unable to are not capable of understanding the technical teaching aspects, at a lecture will not constitute an enabling an enabling disclosure as intended in the Decree Law. - as That is because such a group they would have been not have been unable to reproduce such information before other skilled members of the public¹⁰.

Novelty requires that the invention to be quantitatively different from what has already been disclosed previously; that is, which means that the technical information disclosed by the patent is should not already have been made available to the public. In this sense, novelty is different from the requirement that in order to be patentable, an invention must ought to have involved an inventive step (or be non-obvious¹¹); which is basically a qualitatively examination to ascertaining whether the contribution is creative enough to warrant a monopoly¹¹.

⁷ SARAÇ, p. 13.

⁸ KESKİN, Serap; Patent ve Markanın Ceza Normları ile Korunması, İstanbul 2003, p. 43.

⁹ T877/90 Hooper-Cell Growth Factor (1993)E.P.O.R. 6,TBA.

¹⁰ TRITON, Guy ; Intellectual Property In Europe, London 2002, p. 89.

¹¹ BENTLY-SHERMAN, p.413.

b) *Industrial Applicability*: The invention should be ~~available to produce or application applicable in to every branch~~ all the branches of industry, including agriculture. In this sense, industrial applicability means ~~that the invention is available capable to of being used in produce production; and no need having a character of but not necessarily generating efficiency. Except for Other than some non-technical professionals that have not got a technical character like such as accountancy accountants or law office lawyers,~~ the term of industry must be interpreted as in a the broad sense¹².

c) *Inventive Step*: The invention should be a response ~~for seeking to the search for~~ a technical improvement in the related technical ~~area field~~ of the said invention. ~~When If~~ the invention is ~~realized made as a the~~ result of ~~an action endeavors~~ that can not be ~~understood told~~ from ~~the state of the art~~ by a skilled person who is an expert in the such art, then it is non-obvious ~~and so therefore~~ inventive¹³.

According to ~~the case law of EPO precedence (case law), state of the art is whole means all the~~ information that ~~can be available to is accessible by~~ the public, and it is defined in article 54.2 of European Patent Convention. The first step to decide whether an invention is new or not ~~on in the respect to the~~ case law, is to define the prior technical art in the related ~~area field~~. Further to this, the invention and prior art are compared in order to find novelty. If the said invention is ~~apart different~~ from the prior art, then ~~that it~~ means it has novelty¹⁴.

Although Decree Law ~~no. N.551~~ does not cite the term of “inventive step” ~~but, interpretation of the article Article 9 thereof, which is titled as “surpassing the state of the art”, shows can be interpreted as having implied that this element is admitted admissibility by in~~ our law¹⁵. This ~~element element~~ proves that the level of the quality of investigating novelty is very high ~~level~~.

~~But However~~, one can easily say that if ~~said an~~ invention is not a part of state of the art then it does have an inventive step; also meaning that so if it is new then there is inventive step. According to Article 7 of Decree Law ~~no N.551, held the exclusion not being of state of the art as a base on the definition of ought to be taken as a basis in the definition of~~ novelty. ~~Therefore, With by taking assist of~~ the concept of inventive step as a point of origin, one can ~~say tell that if the~~ subject matter of the application is new.

d) *Non-patentable Subject Matter and Inventions*: Not all inventions or inventions in all subject matters can get a patent. Subject matters ~~which that are Greek to do not comply with~~ concept of patent; ~~improvements on in unethical issues fields like such as~~ gambling; intellectual works without technical features; subject matters which are against public order ~~and and~~ public morality; ~~and the~~ methods for medical diagnostic and treatment are ~~excluded from patentable area not patentable~~. ~~When If the~~ subject matter of a patent application consists of discoveries, scientific theories, ~~or~~ mathematical methods; intellectual ~~and or trade trading~~ ~~and or~~ gambling methods; literary ~~and or~~ artistic works, aesthetic creations; non-technical methods of compilation ~~and or~~ servicing of data; methods for medical diagnostic ~~and or~~ treatment, ~~it~~ can not be awarded by patent.

European patents ~~also must must~~ carry also the specific criteria which ~~are coming originate~~ from European Patent Convention. But, the national office can not seek additional requirements for the registration of ~~said the~~ patent¹⁶.

¹² TEKİNALP, p. 500.

¹³ KESKİN, p. 44.

¹⁴ T 123/82, T205/92, T 590/94 ; Case Law of the Boards of Appeal of the European Patent Office, European Patent Office, 2001, p. 39.

¹⁵ TEKİNALP, p. 500.

¹⁶ CORNISH, William R ; Intellectual Property: Patents, Copyright, Trademarks and Allied Rights , 4th edition London 1999, p. 173.

III- THE CONCEPT OF INVALIDITY

Although in Article 129/3-4 of Decree Law no: N.551 ~~used the term of “annulment” is used beside along with the term of “invalidity” in the article 129/ 3-4, those are for they are intended to have~~ the same meaning. ~~T not on a special purpose and using different terms is all about carelessness~~ the ambiguity is unintentional and a result of bad phrasing¹⁷. As a matter of fact, in Article 112/2-3 of Spanish Patent Law, which is titled as “invalidation”, and from which source of Turkish Decree Law N.551 ~~On-on~~ the Protection of Patent Rights no: 551 ~~ishad been adopted from, Spanish Patent Law, article 112/2-3 which titled as “invalidation” uses in its content the term of “annulment” which is meaning as used to mean “cancellation, revocation, defusing”~~¹⁸. ~~That means translation of the source was not painstakingly done~~ This must have resulted from a careless translation.

~~In spite of the~~ Although ~~truth that the~~ grounds of invalidation were formulated ~~with-in~~ general terms, the biggest debates are ~~surrounded focused on around~~ that concept. So the ~~correct application implementation of the rule into the a~~ specific suit ~~properly is a great deal for depends on the~~ courts, tribunals and quasi courts¹⁹. In patent law litigation, ~~by using the terms “invalidation” term means – as an abstract concept – both that the patent is not invalid abstractly, and whereas as a concrete demand in practice it is claimed to remove from registry implies that it should be unregistered. So In other words, the meaning of what is intended with the term invalidity in patent law is the revocation of the patent by an administrative or a judicial decision as a result of law full grounds, to destruct of patent with an administrative or judicial decision taken if and when there are sufficient legal grounds~~²⁰. ~~As parallel to~~ According to the territorial registration principal, the decision ~~of for the~~ invalidity of a patent can be enforced within the ~~same~~ country ~~that in which the said registered said patent with related to said patent registration is registered, and in respect to the matters pertinent such registration~~. For instance, if ~~the same a~~ patent is ~~also~~ registered in Turkey and in some other countries ~~at the same time~~, Turkish Court’s decision ~~of for~~ invalidation ~~of patent can perform destructive effects shall be enforceable~~ only within our borders and ~~our registry in our national patent office, so that the whereas in other registries of said countries, the same~~ patent will ~~be valid~~ continue to be valid despite the judgment of the Turkish Court.

~~Just As as~~ the ~~case with~~ other industrial rights, patent rights are territorial and can ~~only~~ be enforced within the borders of ~~a that~~ state. Patent papers are interpreted ~~under according to~~ the national law, and protection time period ~~and as well as extent of the protection its extension are is specified by provided in the~~ national law. As for ~~that the~~ jurisprudence, also ~~will be~~ the same national law ~~shall apply~~²¹.

In reality ~~fact, protection of as a bundle of all patents in the~~ European Patents ~~patents, extent of the protection should be evaluated according to the falls within the scope article~~ Article 69 of ~~the EPCEPC. Although According to that convention’s article 69 this Article assumes that the –Members signatory states would have their own have a unique and homogenous laws, according to the prevailing opinion, or solely a framework where Members free in it~~ Article 69 does not only suffice by referring to these national laws. But the dominant view argues that article 69 is not being contented with making a reference to the national law,

¹⁷ TEKİNALP, p. 568.

¹⁸ Spanish Patent Law, www.jpo.go.jp/

¹⁹ CORNISH, William R. ; Intellectual Property: Patents, Copyrights, Trademarks and Allied Rights , 4th edition, 1999 London, p. 173.

²⁰ SARAÇ, p. 4.

²¹ BRİNKHOF, Jan ; “Cross-border Injunction in Europa and Parallel Infringement”, Eposcript, Sept. 2001 EPO Symposium, 2002 Munich, p. 521.

but, it also has an-its own independent meaning ~~which is harmonized with the interpretation of convention~~. Article 69 of the EPC does also apply to the national patents of EPC as a unique-uniform- way of legal base ~~basis~~ applied to the national patents. At the end In conclusion, national courts ~~can-should not resume refer to not only to their their previous jurisdictions~~ national rules and precedence, but, in their litigation they may pursue developed countries if latter's more effective and qualified they should also consider the deliberations of developed countries to the extent of their relevance, quality and persuasiveness²².

According to the Article 32 of TRIPSTRIPS-article 32, the registration that provides patent rights, ~~is-has~~ to be subject to inspection both administratively ~~on-at~~ the registration phase, and judicially after the patent is grant phasegranted. In here, the terms "judicial" does ~~not of by qualifying the authority as "judicially", that will make proper control is not only civil trial courts but, any board or court that uses judicial procedures is to be purposed refer to the tribunal itself, but to the legal rules that such tribunal should follow. That This eventually brings us to the idea that means that~~ no decision ~~can-be~~ is final and conclusive²³.

IV- GROUNDS FOR INVALIDATION GROUNDS

A- In Terms of Regarding National Patents :

aa) Invalidation Invalidating of Examined Patents:

~~In fact P, the defenses that possible arguments of the defense infringer may argue in the an infringement case and the grounds for refusal or grounds of of the invalidity invalidation of the patent are closely associated are in a close connection, as infringement of a patent A accepting the that has been invalidated can no longer be possible invalidity removes the accused person's action from infringement~~²⁴. The ~~i~~Invalidation argument can either be ~~claimed adduced~~ as a counterclaim in a defense in an infringement case ~~ease~~ or a separate lawsuit can be filed for it can be made a subject matter in an independent case. In Turkish Patent Law invalidation circumstances are examined as follows: possible grounds for invalidation are as follows.

1- ~~To p~~Proveing of said that patent has not got the conditions for patentability, that areas written provided in article 5 to 10 of Decree Law no: ~~551~~551 are not met.;

Such a lawsuit can be filed against a patent ~~In spite of nonexistence of any of above mentioned patentability elements if a patent registered as such may come across this action that had been registered despite having failed to meet one or more of the conditions for patentability. Nonexistence-Lack of inventive step and novelty are the arguments that are most frequently adduced for invalidation, because often seen in that kind of actions both of them are objections of strategic value which are raised against patents and those are the strategic grounds for defense~~²⁵. By the way In the meantime, -it must be stated that in German law, ~~defense of invalidity cannot be brought up as a defense and in the same court that hears the infringement case can not be held in the same case, at the same court. When-Whereas infringement cases run are heard in by civil courts of first instance, Invalidity-invalidity cases are asserted heard in by federal courts (Bundespatentgericht). The judge who trial-tries the infringement case for infringement can interpret the subject matter of the patent, but, depend upon he shall be bound by the claims and the patent~~²⁶. However, ~~on the other European laws there is no such t a differentiation distinction in terms of regarding jurisprudence jurisdiction in the legal systems of the other European countries.~~

²² KEUKENSCHRIJVER, Alfred; Extent of Protection – Interpretation and Application of Article 69 of the EPC: German Practice.

²³ TRITON, p. 59.

²⁴ SEHIRALI, Feyzan; Patent Hakkının Korunması, 1998 Ankara, p. 193.

²⁵ FIRTH, Alison, PHILLIPS, Jeremy ; Intellectual Property in Europe ,4th edition, 2001 England, p. 102

²⁶ MARSHALL, Hans; Patent Rights on German Law, translated by ÇOLAK, Uğur, FMR, 2005/2, p. 62.

2- *If disclosure is not sufficiently and clear written explanation on the application paper in the petition for person that can be comprehended by any person who is skilled in the art;*

If an industrially applicable invention is not properly defined in the patent application form, ~~then then~~ the ~~aim requirements~~ of the ~~legislators lawmaker~~ will not ~~have been realized materialized~~. There is no difference between a patent that is not sufficiently disclosed and a patent that ~~can is~~ not ~~be~~ applicable to industry. ~~Public interest will not have been served by Granting-granting~~ patent to ~~that such an kind of~~ invention ~~doesn't serve for public interest~~. On the contrary, ~~instead it will be suffocating of developments~~ by doing so, the path to further developments will have been blocked. That was the ~~reasoning rationale behind of the~~ adoption of ~~article Article~~ 129/1-b of Decree Law No: 551 pertaining to the Protection of Patent Rights²⁷.

~~When Since providing entitlement to exclusive monopoly monopoly~~ depends on sufficient disclosure, ~~awarding-granting the same to those~~ inventors whom ~~expect advantage~~ refrain from making such disclosure and thus press the advantage of secrecy in order to avoid the possibility of having their competitors manufacture their invention ~~by avoiding proper disclosure in order to prevent other competitors from using patent when the protection time is expired would be a wrong approach would not be appropriate~~. However, Surely ~~p~~patent owners ~~do has still~~ have an ace up their sleeves ~~got some cards to play~~. The scope of this ~~obligation on to~~ disclosure is ~~all about solely suffice about to produce the~~ provision of a model ~~the model invention~~ that would be good enough to manufacture the invention or to make it work. The Patentee ~~patentee~~ is ~~free not~~ obligated to disclose the information on how to best operate the invention ~~for invention's critic aspects in terms of optimum optimum~~ efficiency²⁸.

3- *If the subject matter of the of patent exceeds goes beyond the scope of the application extent of patent;*

Invalidation can be claimed for that ~~part of the patent, which exceeding part~~ according to ~~the a~~Article 129/1-c of Decree Law No: 551 pertaining to the Protection of Patent Rights ~~goes beyond the scope of the original application~~. If ~~the~~ court finds this claim ~~valid, rightful~~ then ~~it~~ will ~~give a decision namely patent is partially invalid~~ ~~decide for the partial invalidation of the patent~~, ~~And and~~ remaining part of the patent ~~that is not invalidated~~ will survive ~~with the remaining part which is not invalidated~~.

4- *Violation of the principle of on the unity of invention integrity of patent;*

If an application includes more than one invention ~~that do not realize around a principal inventive idea of general nature and which are not related to each other by said principal inventive idea, without integrity with each one of these other may disassociated inventions might~~ be subject to ~~the an~~ invalidation case²⁹. In fact, ~~according to the Article 45 of Decree Law N.551 pertaining to the Protection of Patent Rights, a patent application may contain a one substantive-principle invention and one or more related subordinate inventions around it. If according to the article 45 of Decree Law No: 551 pertaining to the Protection of Patent Rights. Those inventions are of independent each other nature and are not related with one another, can not the patentee cannot be patented as a sole patent under granted one single patent for all of them, as is explained in Article 129/3-4 of Decree Law No: 551 pertaining to the Protection of Patent Rights~~³⁰.

5- *Invalidation upon usurpation of patent right;*

²⁷ TEKİNALP, p. 570.

²⁸ FİRTİH-PHILLIPS; p. 102.

²⁹ YURTSEVER, Şaziye; Patentin Hukuki ve Cezai Korunması, Ankara 2005, p. 108.

³⁰ TEKİNALP, p. 571.

“The person who is the first to apply for a patent shall be vested with the right to request the patent until proof to the contrary is established” ~~A person who is first to file is a person who has the right to claim patent unless on the contrary is fixed under the says article~~ Article 11/4 of Decree Law No: 551 pertaining to The Protection of Patent Rights. Depending on the system the Countries-country might have can-adopted, the patent is given any system either to the first to file in which held first applicant or to the first to invent (real inventor) in which sought real inventor. As the other EPC members, Turkey also did accepts adopt the latter, just as the other EPC members had done. since a ~~Article 11/1 of Decree Law~~ says: *“The right to a patent shall belong to the inventor or to his successor in title and shall be transferable.”*

~~But However, before prior to~~ the adoption of Decree Law No: 551 pertaining to The Protection of Patent Rights, ~~under abrogated the superseded-~~ Patent Law had upheld system was the first to file system. In the first to file system, the real inventor had cannot no right to act that he was real inventor and claim to the transfer of the said patent application to him³¹.

Inventor or his successors ~~may might~~ argue that patentee had no right to claim a patent according to ~~the a~~ Article 11 of Decree Law No: 551 pertaining to The Protection of Patent Rights. In that case the provisions of a ~~Article 12 of Decree Law No: 551 pertaining to The Protection of Patent Rights are shall be implemented~~³². If the real inventor does, in an invalidation case, claims transferring-transfer of the patent as ~~to per article- Article 13 of Decree Law No: 551 pertaining to The Protection of Patent Rights within an invalidation case, with invalidation decision existing patent held the existing patent shall be invalidated invalid and a new patent shall be granted and registered to real to the owner real inventor. It is understood that both because According of to article Articles 12, and 13 and as well as article 129/1-d of Decree Law No: 551 pertaining to The Protection of Patent Rights, lawsuit for Usurpation-usurpation case should be asserted filed together with the claim for invalidation~~³³.

~~bb) Invalidation of ng~~ Unexamined Patents:

In Principally-principal a patent can, within the framework of ~~this~~ Decree Law No: 551 pertaining to The Protection of Patent Rights, ~~a patent can~~ be granted at the end upon the conclusion of an examination process. However, since investigation and examination is period is too long time consuming and costly, and also because most of the any inventions might can be evaluated only after having been launching-launched in market, legislator the lawmaker had adopted, as an exceptional way option, of a system of granting unexamined patents. It can be said An argument -in favor of granting the unexamined patent system is that; it enables allows the patentee to avoid from the examination fees for a specific-certain period (7 years) - which is also happens to be the protection time period - and thus -and to have buying him a time to decide whether the said invention is effective or not in terms of does indeed worth production³⁴.

When an unexamined patent does not carry the requirements of patentability, may it can be subject to challenged by filing a lawsuit for its the invalidation case as it is in the just as the case -event of with an examined patent is. In spite of this ~~natural-logical~~ inference, ~~under according to article- Article 70/2 of Decree Law No: 551 pertaining to The Protection of Patent Rights;- ,~~ “The lack of novelty or of inventive activity/-(step) of the patent granted without (substantive) examination shall not constitute the subject of such objection”. So, ~~one can say that; all any application for an inventions that does not meet the requirements for patentability might as well be concluded by the award of an unexamined patent, if Turkish Patent Institute could nothas not determined such absence of those requirements may~~

³¹ TEKİNALP, p. 506.

³² ŞEHİRALİ, Feyzan; p. 194.

³³ TEKİNALP, p. 571.

³⁴ SARAÇ, p. 11.

~~conclude as an unexamined patent shortcoming~~³⁵. But However, the aim purpose of this ~~Article~~, is to prevent ~~the oppositions objections towards against~~ unexamined patents at the administrative phase, ~~especially as a response to~~ in response to the needs of ~~the~~ industry and market. It ~~is certain goes without saying~~ that, ~~as whilst~~ a substantively examined patents can be ~~subject to the challenged in~~ invalidation a lawsuit for invalidation case, unexamined patents ~~all the more can be~~ *a fortiori* be subject to ~~such a~~ judicial ~~investigation~~ scrutiny.

~~Court of Cassation~~ High Court of Appeal did, in one of its judgments, also ~~gave verdict~~ conclude that a lawsuit could indeed be filed for the invalidation of an unexamined patent in this meaning and direction that ~~held unexamined patent can be subject to invalidation case~~.³⁶

cc) ~~Invalidation~~ Invalidating of Utility Models;

Utility models, or ~~In French name~~, “*petit patents*” ~~as the French call them the~~ *petit patents*, ~~do~~ also serve the same goal purpose as ~~the~~ patents do, and ~~so be~~ *therefore are* subject to ~~the~~ same legal rules³⁷. ~~A part part~~ from patent ~~though~~, the requirement of ‘surpassing state-of-the-art’ ~~is not necessary shall not be sought~~ for ~~the~~ utility model. However, ~~in my opinion~~, a technical innovation ~~novelty is should anyhow be deemed to have surpassed still a requirement~~ state-of-the-art³⁸, and ~~if if the invention it is to that is subject~~ be entitled to utility model application, ~~it has to be new, then that which also~~ means it ~~is has got to be~~ inventive. On the other hand, ~~the~~ provisions of ~~article Article~~ 166 of Decree Law No: 551 pertaining to The Protection of Patent Rights says:–, “*In the absence of provisions specifically applicable to utility model certificates, the provisions pertaining to patents as set forth in this present Decree-Law shall apply likewise, for utility model certificates, provided that they are not incompatible with the characteristic of utility model certificates*”. Absolute novelty is also a must for utility models³⁹.

~~The rules and procedures for the invalidation of utility models are provided in Invalidation of a utility model has been regulated in article Article~~ 165 of Decree Law N.551 pertaining to The Protection of Patent Rights, ~~and to be which happen to be the subjected to the~~ same ~~with those that~~ procedures apply to the invalidation of patents. Until ~~the~~ Constitutional Court’s ~~had decision revoked~~⁴⁰ of annulment of the ~~article Article~~ 165/3⁴¹ of Decree Law N.551 pertaining to The Protection of Patent Rights, ~~which there was a restricting restriction regarding the requesting challenge of the invalidation validity of the a utility model, Lawsuit for the invalidation of a utility model had to be filed was depend on an opposition that is raised within three months following after the publication of the announcement of the the~~ application.

B- In ~~terms of~~ Invalidation of respect to European Patents:

~~The By having been granted of a European patents, the applicant will have results in the obtaining of obtained~~ a “bundle” of national patents for the states designated in the application. Contracting states can stipulate that ~~the~~ owners of European patents ~~must should~~ be required to provide translations into ~~an the~~ official language of that ~~particular~~ state, and that ~~should they fail to do so, if they fail to do so~~, the patent ~~is would be~~ void *ab initio* in the

³⁵ SARAÇ, p. 11, YALÇINER, Uğur; “Türkiye’de Patent ve Faydalı Model Uygulamaları” , Symposium on effective enforcement of IP rights in Turkey.

³⁶ 11th Civil Law Chambers of Court of Cassation, 25th of April 2002, 2002/81-3895.

³⁷ Art.1 of Decree Law 551 pertaining to The Protection of Patent Rights.

³⁸ Art.154 of Decree Law 551 pertaining to The Protection of Patent Rights.

³⁹ Art. 156. of Decree Law 551 pertaining to The Protection of Patent Rights.

⁴⁰ Constitutional Court, 23rd of March 2004, 2001/1-2004/36.

⁴¹ Art. 165/3 “..In order to qualify to request the invalidation of the utility model certificate, third parties suffering damage/prejudice and the interested official authorities/bodies must have raised opposition in compliance with the provisions of Article 161”

relevant state:⁴² The EPC only provides a mechanism for the grant of national patents. As such, while the EPC is concerned with the validity of European patents, matters of enforcement, revocation, renewal and litigation are exclusively dealt with by national law⁴³.

The essential features of European patents are that they provide ~~for~~ protection for a period of 20 years starting from the date of filing of the application and; that they are granted for inventions which are new, which involve an inventive step and which are susceptible of industrial application⁴⁴.

A European patent may only be revoked under the law of contracting state, which will be effective only for within its territory.

If revocation of a European patent is brought as a matter of ~~opposition objection in front of before~~ EPO within ~~its time limit the provided time period~~, the decision can be evaluated ~~and in a way that would be~~ effective in ~~terms of all designated the~~ countries in which protection had been requested. According to ~~the a~~Article 99 of EPC, any person ~~may can oppose object~~ to a granted European patent ~~in before the~~ Board of Appeal, and ~~then can further file another objection after its against the~~ decision of this board, in before the Enlarged Board of Appeal as a kind of appeal procedure. ~~Then t~~The Board of ~~Appeal Appeal~~ or in next phase, the Enlarged Board of Appeal ~~shall gives take~~ a decision ~~of for or against~~ revocation ~~or maintenance of~~ the European patent. All ~~of the~~ evaluations at ~~this these~~ phases have ~~got~~ judicial ~~specifications characteristics~~. As a matter of fact, ~~in any proceeding before all the~~ Boardss do held hearings, listen to witnesses, obtaining or giving evidence means, hearing parties, request require the parties for informations submit information and documents, the production of documents, hearing the witnesses, and opinion by experts, inspection, written sworn statements consult to experts⁴⁵. There are three different Appeal Board; ~~s~~ Technical Board, ~~and~~ Legal Board and ~~as at~~ the top level, the Enlarged Board of Appeal⁴⁶.

Our country ~~is has been~~ a member of EPC since ~~1st Nov-ember the 1st~~, 2000. From that date onwards, the ~~convention Convention~~ enables us to adopt all the patents examined by EPO and designated for Turkey valid as national patents which granted in Turkey. Invalidation of a European patent ~~may be argued can be requested~~ by (1) filing an opposition objection within 9 months starting from the date of publication of the patent in the EPO bulletin of EPO, or (2) ~~suing a filing a lawsuit patent~~ for the invalidation of the patent in before a competent Turkish court. ~~When If the Opposition EPO Division is of the opinion concludes~~ that the grounds ~~of opposition for objection as~~ mentioned in ~~article Article~~ 100 of EPC did indeed prejudice the ~~maintenance of the~~ European patent, it shall revoke ~~the patent it on the direction of decision~~ partly or completely, in all designated countries. Invalidation of a European patent ~~may can also~~ be ~~subjected to hear in brought to the attention of~~ a Turkish Court. ~~that if~~ If the Court decides for the plaintiff and invalidates the patent held the case, that this decision ~~would shall~~ be valid enforceable only for in Turkey, and patent will be survive in ~~those the~~ other designated countries⁴⁷.

~~In At the~~ national ~~phase phase of the procedures, namely in other words~~ after registration of European patent for any designated ~~countries country~~, decision for its invalidation it shall be decided depended on can only be taken nonexistence of the grounds of in the event of the lack of the conditions provided in article Article 138 of EPC, only to be enforceable as for limited to in that designated particular country⁴⁸.

⁴² TRİTON, p. 143.

⁴³ BENTLY-SHERMAN, p. 316.

⁴⁴ TRİTON, p. 85.

⁴⁵ EPC Art. 116, 117.

⁴⁶ EPC Art. 21, 22.

⁴⁷ SARAÇ, p. 13.

⁴⁸ ORTAN, Ali Necip; Avrupa Patenti Sistemi , V.1, p. 195, Institute of Bank and Trade Law Search, Ankara 1991.

V- JURISDICTION THE COURT THAT IS COMPETENT AND DURATION FOR IN THE MATTER OF — INVALIDATION INVALIDATION ACTION; AND WITH JURISDICTION

According to ~~the article~~ Article 146 of Decree Law n.551 pertaining to The Protection of Patent Rights, all patent disputes ~~that mentioned in Decree Law 551 pertaining to The Protection of Patent Rights in this Decree Law are being held in front of~~ shall be heard by specialized civil courts of intellectual property courts⁴⁹ that are civil trial division. In an invalidation case, competency is not clearly stated in the relevant section of Decree Law. However in article 137 ~~of Decree Law 551~~ thereof, the competent court in pertaining to The Protection of Patent Rights, with the actions by third parties against the patent owner by third parties, competent court also is defined stated as follows; “The competent court, for the institution of legal proceedings, by the proprietor of a patent against third parties, is the court of the domicile of the plaintiff or of the place where the offence was committed or of the place where the act of infringement produced effect”. From the technical perspective, This this regulation provision is incorrectly spoiling has been incorrectly formulated and does not agree with the rest of the of the integrity of the issue law, in terms of law technicality⁵⁰. Apart from that Besides, invalidation case as a when a lawsuit for the invalidation of a patent is filed as a counterclaim counterclaim in an infringement case, will it shall be held in the same court that hearing hears the infringement claim.

A lawsuit for the It’s possible to sue a patent for i invalidation of a patent can be filed throughout the its protection time period and within from expiring date within 5 years after it expires⁵¹.

VI- PARTIES PARTIES TO THE CASE

Capacity to sue for invalidation of a patent belongs to prejudiced persons Persons who are adversely affected/prejudiced or interested official authorities, acting through the Public Prosecutor, may request from the court the invalidation of a patent., Public Prosecutors and related official authorities. Moreover, the invalidity of a patent may also, be put forward challenged by the persons who are entitled to claim the right to the patent⁵². The provision that shows plaintiffs has not is not of restrictive character nature. However, in for actions that brought lawsuits that are filed in accordance to with article Article 129/1-d⁵³ of Decree Law N.551 pertaining to The Protection of Patent Rights, plaintiffs are accounted restrictively only certain persons are entitled. This possibility provision is intended for the is regulated lawsuits for that would be filed by the real inventors and their successors to sue the usurper and their successors against the usurper.

Any real person or legal entity who is prejudiced or under the risk of that may be “prejudiced person” or the person who under the restriction of using a known patent and be plaintiff⁵⁴. The balance ~~that established between the inventors’ rights and the interests of the public’s right in the patent law; has been considered as a response for the innovative disclosure that submitted to public is tried to be realized by granting an exclusive, time limited right to the person who disclose the ideaby granting time limited exclusivity to the inventor in exchange for disclosing his technological innovation to the public⁵⁵.~~

⁴⁹ Art. 145 “Special courts to be established by the Ministry of Justice shall have jurisdiction for all of the actions and claims provisioned by this present Decree-Law...”

⁵⁰ SARAÇ, P. 16.

⁵¹ TEKİNALP, p. 570.

⁵² Art. 130/1 and 11. of Decree Law 551 pertaining to The Protection of Patent Rights.

⁵³ Art. 129/1-d “where evidence is brought in that the holder of the patent does not have the right to a patent in accordance with Article 11.

⁵⁴ TEKİNALP, p. 569.

⁵⁵ SARAÇ, Tahir; Patente Tecavüz ve Patent Hakkının Korunması, Ankara 2003, p. 38.

VII- EFFECTS OF THE ~~DECISION~~JUDGMENT-OF OF INVALIDITYINVALIDATION

The ~~decision that judgment that ruling rules said the~~ patent is invalid; shall have retroactive effect. ~~Thus, within the context of invalidation, the legal protection secured for an application for patent or for a patent under this present Decree-Law shall be deemed not to have been borne at all. Thus, within the context of invalidation, the legal protection secured for an application for patent or for a patent under this Decree Law no: 551 pertaining to The Protection of Patent Rights shall be deemed not to have been borne at all. But However,~~ there are exceptions to ~~that this~~ rule, which ~~are~~ stated ~~at in~~ article 131. ~~These Following are the situations that are exemptions:ted.~~

- a) Any final decision for infringement of the patent reached and enforced prior to the decision of invalidity;
- b) Contracts concluded and executed prior to the decision of invalidity. However, reimbursement, in whole or in part, of sums paid under the contract may be claimed on grounds of legitimate reasons and of equity to an extent justifiable by the circumstances.

~~But Still however, in the cases the event~~ -of termination ~~namely, non-for default of~~ payment of patent fees, ~~upon expiry expiration~~ of the term of protection, and ~~upon the surrender of the by patent by the patent owner, holder~~ there is no retroactive effect.

VIII- DILATORY QUESTION

~~The actions of dEstablishmentetermining of the infringement;- preventing prevention thereofinfringement and/or; damages there from depend-are contingent upon the upon solving resolution of the invalidity-counterclaim for invalidation or other invalidity cases-disputes for which separate lawsuits have been brought independently filed~~⁵⁶. If a patent or utility model is invalidated by a court ~~decision order, then it one can not say that there is an infringement in said eventsit will no longer be possible to adduce past infringements because of retroactive impact of the said judgment.~~

If ~~in a criminal patent infringement case the~~ accused person argues that patent is ~~was~~ invalid, ~~in a penal patent infringement case it is subject to hesitationit is not clear~~ whether ~~penal-the criminal~~ court ~~will should~~ examine this defense ~~or not~~. ~~As aThe~~ general rule ~~is that~~ in any ~~penal-criminal~~ case ~~the judge should should reach to theendeavor to discover the~~ concrete reality, ~~and the~~ facts, and ~~that he has shall have a-the~~ right to evaluate - *inter partes* - the ~~given-available~~ evidence about the patentability of ~~the~~ said invention. ~~However, This-this is shall still be~~ a limited search for the truth ~~of that case~~. ~~The Judge-judge shall~~ ex-officio collects ~~given-the available~~ evidence about ~~the~~ -e.g. lack of novelty, inventive step of said patent ~~etc~~. All evidence should be collected and freely examined by ~~penal-the criminal~~ judge ~~in order to evaluate-have~~ the elements of crime ~~evaluated~~⁵⁷.

In ~~terms of respect to~~ a ~~penal-criminal~~ case for patent infringement, there is no ~~need to leave reason for the judge not to follow from~~ the general principle of ~~the Penal Lawcriminal law~~ and ~~his~~ moral sense, ~~of proof-namely judgeHe~~ must ~~evaluate-review~~ the claim and ~~the~~ evidence, e.g. expert witnesses, ~~the~~ reports about invalidity. Article 218 of Penal Procedure Law that ~~is~~ titled "ancillary competency of ~~penal-criminal~~ courts" ~~does~~ already ~~entitles-entitle the~~ judge ~~for this to do this-competency~~. If evidences that ~~is~~ collected in ~~the penal-criminal~~ case proves that ~~the invention patent or utility model certificate has notlacked the~~ necessary elements ~~to get protectionwhich should have been sought for before granting the patent or the utility model, the then limited within the framework of that case, judge willshall, inter partes, give a-his verdict via-by also assessing men's reathe criminal~~

⁵⁶ 11th Chambers of Court of Cassation, 15 February 2005, 2004/449-2005/1212.

⁵⁷ KUNTER, Nurullah; ; Muhakeme Hukuku Dalı Olarak Ceza Muhakemesi Hukuku, 7. Bası, İstanbul s. 458.

~~intend, that accused person is and decide for the -acquittedal of the accused, and because patent protection would not be possible patent can not be protected inter partes-. So in penal the criminal case the judge does-shall not solve-resolve the invalidity problem, only says as limited with this case patent owners can not get a penal protection but he shall review the issue of patentability only to the extent it would be necessary for him to be able to give his verdict. However, in spite of this defence if already there is an a pending invalidity action in the civil court, then the judge is suggested that to wait for the decision of -that civil court's and thus adopt it.~~

CONCLUSION:

~~Whereas granting of patents is needed in order to Because of supporting science-scientific and technology-technological and improvements and inventions-get granted patents but, on the other hand it is a problem to save the genuine interests of those who are effected-affected by the exclusive rights coming from patents of the patent owners must also be considered. That's-That is why we need the invalidity action to constitute-maintain this a delicate balance. It is a reality It is a known fact that some right holders patent owners might be in a bad faith and be using patent for uncompetitive purposes.~~

~~So-Therefore, invalidity decisions decisions for the invalidation of patents must be supportive in respect of industry and not preventive-unrightfully prohibitive. There must be specialized lawyers, judges, public prosecutors and as well as experts-expert witnesses who are engaged in the-this field -to-and who deal with the issues-different aspects of patent protection like-such as applications, oppositionobjections, substantial examination etc-.~~

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