

**VERIFICATION OF PATENT INFRINGEMENT IN PRACTICE AND RELEVANT
PROVISIONS OF THE INDUSTRIAL PROPERTY ACT**

**UYGULAMADA PATENTE TECAVÜZÜN BELİRLENMESİ VE SİNAİ MÜLKİYET
KANUNU’NUN KONUyla İLGİLİ DÜZENLEMELERİ**

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Abstract:

Thanks to registration, novel and industrially applicable inventions with inventive step, and the novel and industrially applicable utility models that lack the inventive step are protected against unlawful users. Verification and assessment of the consequences of the infringement of patents and utility model rights requires a high level of technical and legal expertise. In this article, the issue of infringement of patent and utility model rights is examined in the light of fundamental principles and especially the practice, and the scope of the rights conferred by patents and utility models, as well as verification of infringement are discussed with reference to practice.

The relevant provisions of the latest act on industrial property rights on patents are compared with the provisions of the preceding legislation, Decree Law 551 that also pertained to patents. The relevant provisions of the latest Act dated 10.01.2017 on Industrial Property are compared with the provisions of the previous legislation, Decree Law 551 on patents.

Key words: *infringement of patent, claims, industrial property rights law, damages, utility model*

Özet;

Yenilik, buluş basamağı ve sanayiye uygunluk taşıyan buluşlar; buluş basamağı şartına uymayan yeni ve sanayiye uygun modeller tescillenerek yasa dışı kullanımlara karşı korunmaktadır. Patent ve faydalı model haklarına tecavüzün belirlenmesi ve sonuçlarının değerlendirilmesi ise değerli bir teknik ve hukuki uzmanlık gerektirmektedir. Bu çalışmada, patent ve faydalı modele tecavüz konusu ele alınmakta, temel ilkeler ve özellikle uygulama boyutu üzerinde durulmaktadır. Ayrıca, patent ve faydalı modelden doğan hakkın kapsamı ve tecavüzün tespiti konusundaki uygulama da ele alınmaktadır.

10.01.2017 Tarihinde yürürlüğe giren Sınai Mülkiyet Kanununun konuyla ilgili hükümleri de 551 sayılı PatHKH kapsamındaki kurallarla karşılaştırılmaktadır. Kanununun konuyla ilgili hükümleri de mevcut kurallarla karşılaştırılmaktadır.

Anahtar sözcük: *patente tecavüz, istemler, sınai mülkiyet kanunu, tazminat, faydalı model*

INTRODUCTION

Among the industrial property rights, the patent right is of pivotal importance is for the needs of technical improvement. Decree Law 551 Pertaining to Protection of Patent Rights (hereinafter will shortly be referred to as Decree Law 551), which was, to a great extent, composed of translations of the EU legislation, has applied until lately. It appears that the Act on Industrial Property (IPA)¹ will bring Turkish patent law more in line with the EU patent laws. In this article, the topic of patent infringement including the provisions of the new act, the approaches and the methods that will referred to in practice and the legal remedies will be discussed with references to the IPA.

I. RIGHTS UNDER PATENT AND LEGAL PROTECTION

A. IN GENERAL

The right over an invention accrue automatically upon successfully achieving such invention, without being subject to any requirement as to the form². Patent is a limited monopolistic right granted in exchange for the disclosure of a special technical knowledge³ which, after a thorough examination, is decided to be an invention. The patent registration institution does, according to the preset legal principles, examine the application it receives, and if these conditions have been met, grant the patent or the utility model certificate. If what has been granted is a patent or a utility model registration certificate, then it will be deemed, in regard to validity, to have a confirmatory nature, whereas in regard to protection, a provisional nature⁴. Otherwise, lack of interest in the inventor is incompatible with human nature and; this would mean that potential inventors, who know their intellectual efforts and labor would not be rewarded, will not endeavor for innovation. This will also mean conceding beforehand to the stagnation and lack of development of the humanity and its environment.

Absolute rights that a patent provides to its owner are – except for some restrictions that are associated with public order, public health, time etc. – similar to the tangible property ownership right in the property law⁵. Absolute rights will be in effect for the entire term of a patent with substantive examination, which is twenty years. In the IPA, the duration of the protection term is not changed and; in Article 101, a twenty-year protection term is provided for patents, and a ten-year term for utility models. Here, it is also stated that these “terms cannot be extended”. In the provision, the reason for this emphasis it not clearly expressed. However, it is understood that, though not obviously, this might function as an impediment preventing issuance of extension certificates, which are used in the EU countries to make up

¹ Industrial Property Act no: 6769 was published in 10.01.2017 in the Official Gazette.

² Whether the right over an invention accrues automatically when the invention is made, or if it is created upon registration is a controversial issue in jurisprudence.

³ BENTLY, Lionel/ SHERMAN, Brad; Intellectual Property, 2002, p. 310.

⁴ OZTURK, Ozgur; Turk Hukukunda Patent Verilebilirlik Sartları (Patentability Requirements in Turkish Law), Istanbul 2008, p. 15.

⁵ Whereas tangible property right applies to concrete movable items, intangible property right is associated with patented ideas and doctrines, designs, works and signs in trade.

for the protection time losses in the case of drug patents⁶. Also in the repealed Decree Law 551, it was provided that the terms would not be extended.

In order to know the scope of a particular patent, it is necessary to know and to analyze the invention that is the subject matter of the patent. The first step to understand the invention is to know the relevant technical field as well as the existing state of the art. The scope of the rights that is granted by patent is specified in Article 85, and the actions listed therein are considered stoppable by the patent owner. In Article 85 of the IPA, the scope of the patent right is provided in more detail, and conducts that are excluded are, unlike Article 73 of the repealed Decree Law 551, listed in the 3rd subparagraph of the same provision. This will understandably be more convenient to apply.

In practice, the scope of patent protection that will have an impact on both infringement lawsuits and invalidation lawsuits is included in Article 89 of the IPA. According to this provision, the scope of the right that originate from patent application or the patent is determined by the claim or the claims. In IPA, the same principle that is provided in Article 69 of the European Patent Convention⁷ has been adopted.

IPA provides that the descriptions and drawings have, unlike they were in the repealed Decree Law 551, do not play a direct role in specifying the scope of the protection, and that they are auxiliary elements (IPA, Art. 89/1). Claims are the texts that clearly express the elements of the invention that would be protected. The inventor should obtain the protection he expects from the patent fairly and proportionately, and at the same time the expectations of the competitors and the public for transparency should be met. Since the claims draw the perimeters of the scope of the protection, the use of the knowledge and the idea explained in the claims, without permission constitutes infringement of the patent and; in the event of the use of the same protected knowledge or idea or of its equivalent, infringement of the patent will be in question. The scope of the protection is determined according to the claim or claims

⁶Whereas patent protection is legally valid for 20 years, when it comes to patenting of the products of drug industry, no matter how much it might be desired by the patent owner, this term cannot be used entirely; the protection time and the commercialization cannot be started simultaneously. The competent bodies of the EU had introduced a complementary protection system by Regulations 1768/92 and 1610/96. Acceptance of the application of the patent process might, for reasons like the delay of the product development time because of administrative difficulties, and especially the requirement for market entry permission, affects the duration of the viable fraction of the patent protection term. In order to make up for the time lost by the patent owner when obtaining the market entry permission, normally an additional term of 5 years, and in the case of pediatric drugs, 5,5 years is given.

⁷ European Patent Convention (EPC) was signed in 1973, and our country acceded to it by Resolution 2002/42, dated 7.6.2000, of the Council of Ministers (Official Gazette 24107, 12.7.2000); The European patent, the registration process for and the principles of protection of which are stipulated in this Convention, can be defined as a bundle of patents that allows synchronous protection upon single application and examination; thus, stating the examination phases and the countries in which protection is sought. In the said Article 69 it is also provided how, in the event of amendment of claims, the scope of protection that the patent applicant would benefit from during the time between the date of the patent application and the date of registration ought to be interpreted and; what would its effect on third persons be. In respect to European patent applications, the scope of protection given upon such application for the time that elapse until the European patent is granted, is determined by the last submitted patent claim mentioned in the publication made in accordance with Article 93 of the Convention. However, the granted European patent in the form it is granted or as amended after the objection will, provided that the scope of protection is not expanded, incorporates the former form. Description and drawings on the other hand, can be used for but do not play a direct role in specifying the scope of the protection.

and when a thorough examination is conducted during the process that follows the application, the focus will be directed on the invention characteristics of the claims. Protection provided by a patent⁸, which had been granted with substantive examination, is very strong, because such a patent has a hypothetical characteristic, the validity of which cannot be disputed until a court decides for its deregistration. Although the patent without (substantive) examination in the repealed Decree Law 551 did grant the same protection, in the event of an infringement dispute, it will nevertheless have to be scrutinized as it would not have undergone a substantive examination prior to its registration. Indeed, according to Provisional Article 1 of the IPA, these patents would be treated as per these repealed provisions.

Meanwhile, inventions that are “novel and applicable in industry” but that do not go beyond the state of art are protected by a certificate which does not long term protection. Utility model certificate can be obtained more easily than a patent, and with it, petty inventions that are novel and applicable in industry are protected. Unlike the repealed Decree Law 551, in the IPA, the technical characteristic criterion is added to the other two registration criteria, which are novelty and applicability to industry. for utility models. According to Article 142/2 of the IPA, technical properties that do not contribute to the invention will not be taken into consideration⁹. This wording leads to comments that, even though to a lesser extent, inventive step would be sought as a condition for the registration of the utility model. Hence, possession of technical characteristics is considered, in an implied way, as a criterion for a patentable invention. The emphasis here, on technical contribution, is about the innovation in the technical field with which the utility model is associated. On the other hand, in Article 82 of the IPA, the same criterion is not openly mentioned, but implicitly pointed out. Still, for an invention, technical characteristics is considered as a prerequisite as it is stated that patents can be given in any field of technology, and in paragraph 2 of Article 82, non-technical fields are excepted. As a matter of fact, in European Patent Law practice, it is a well-established understanding that inventions should have technical characteristics¹⁰. Carrying out activities that are proportional to their R&D, and production capacities, and depending on the characteristics of the inventive efforts, choosing the utility model method can be deemed as rational for the firms and enterprises that are at about the size of a Small and Medium Sized Enterprise. Since in practice thorough examinations are not conducted during the registration processes of utility model certificates, attribution of undue significance to them can nevertheless result in adverse consequences. That is because utility models are scrutinized for conformity with the registration requirements only when a dispute as to their validity arises; then the court can, for example, ask the experts in the relevant technical field to submit a report on the absolute novelty criterion, and where it is concluded that novelty did not exist, declare the certificate null and void as if it had never been issued. For this reason, the repealed Decree Law 551’s Article 158/2 that pertain to the qualified protection of these certificates contains provisions which can be characterized as an assurance for the system. The provision

⁸ By making a choice that is in line with the European Patent Convention and the contemporary international texts, the method of giving patents without substantive examination is not included in the IPA.

⁹ To be precise, the provision reads as follows: “(2) When appraising the innovativeness of the utility model, technical properties that do not contribute to subject matter of invention will be disregarded.”

¹⁰ European Patent Office, Case Law, 2013, p. 2; T 22/85 OJ 1990, T 154/04 OJ 2008

of Article 158/2 of the repealed Decree Law 551 was revoked by the judgment of the Constitutional Court, dated 21.9.2014, numbered 2013/100 – 2014/14 and; in Article 143/13 of the IPA, the same principle is included, but this time without any correlation with any probable action for invalidity. Accordingly, “*Issuance of the utility model [certificate] cannot be construed as a guarantee given by the [Turkish Patent] Institute as to the validity and usefulness; neither does it confer responsibility on the Institution.*” Therefore, it is evident that if the owner of the registered utility model had developed it by acquiring the essence of the invention from a third person without permission, such owner cannot enforce the rights conferred by that certificate on such third person.

B. SCOPE OF PROTECTION – CLAIMS

In lawsuits for patent infringement, in order to establish the scope of the protection, and therefore to understand if the defendant’s actions fall under the scope of the patent, referring only to the summary, title, description and drawings of the invention will not be sufficient. What is essential is the section on the claim or the claims. For this reason, patent claims must be drafted in such a way that would enable a clear understanding of the invention and the perimeters of the protection. Every patent application and the patent certificate that follows, contains at least one claim. Where there is more than one claim, the first claim is named as the main claim or the independent claim. The main claim contains the gist of the main elements of invention.

In Article 6 of the Patent Cooperation Treaty¹¹ (*Patent Cooperation Treaty*) – the purpose of which is worldwide cooperation on matters pertaining to the registration of the inventions, uniformity of the protection and obtaining of patent rights – it is stated that the matter of the claim or the claims, for which protection is sought, should be written clearly and concisely, and that they should be fully supported by the description.¹²

Writing of the claims that specify the legal perimeters requires expertise and experience. A correct approach would be using the words that are appropriate and in sufficient number to express how the invention operates and what kind of a result it produces. In that sense, a patent application can include one or more claims. When determining the scope of the protection, the main source is the claims, and the description and the drawings are auxiliary. The provision of Article 89 of the IPA is, in this sense, similar to that of the repealed Decree Law 551 and the EPC¹³.

¹¹ Turkey became a party to the PCT, signed on the date of 19.6.1970, by Resolution 96/7772 of the Council of Ministers of 5.1.1996 (OG 8.2.1996, 22548).

¹² European Patent Office, Case Law, Munich 2013, p. 250.

¹³ Considering the Article that reads as follows “The scope of the patent application or of the protection provided by the patent is determined by the claims. In addition to this, the description and the drawings are used for the interpretation of the claims.”

“Claims cannot be interpreted as being confined to their strict literal wording. However, for determining the scope of the protection, the claims cannot be broadened in a way that would include the characteristics, though contemplated by the inventor, are not expressed in the claims, but which can be revealed from the interpretation of the description and the drawings by a person skilled in the technical field”, it is concluded that the principle on determining the scope of protection is retained.

Expressing the claims in a clear and understandable language will be effective in specifying the scope of the protection, in clarifying the statuses of third persons in regard to the patent, and in ensuring that the action space limits are known¹⁴. No claim should contain any conflicts in it, or neither should it be in conflict with other the claims¹⁵. An independent claim alone defines the invention and does not refer to another claim. Dependent claims, on the other hand, are claims that refer to an independent claim, and that adopts its characteristics. With dependent claims, the perimeters and the secondary characteristics of the invention are manifested more clearly¹⁶.

The claim or the claims complement(s) the invention's elements, protection of which is desired. Each claim must be clear and brief¹⁷. The claim and the claims are based on the description. The claim and the claims cannot extend beyond the scope of the invention. This principle is, at the same time, a basis for invalidity. Filing a lawsuit for invalidity after the final decision of Turkish Patent and Trademark Office (TPTO) is possible. In addition to lack of the conditions for registration, the phrase in Article 138/1(c) of the IPA that reads, "if the subject matter of the patent exceeds the scope of the application..." is also a cause for invalidity. In that case, the coherence of the invention will break down, and the need to invalidate the patent will arise as freedom of enterprise and competition of third persons will unjustifiably be impaired.

The practical role of the claims is that they determine whether the invention worth protection; in other words, whether the claims satisfy the conditions. By looking into the claims, it will, in the lawsuit for infringement, be established whether if there is such infringement, or, in the lawsuit for invalidity, whether if the state of art is surpassed and; the claims and the previous state of art will be compared. This comparison will be made between the certificates regarding the state of the art, and the claims. The second significant role is determining the valid scope of protection of the patent. The boundaries of the scope of protection are drawn by the claims¹⁸. The infringement allegations will be examined and a conclusion will be reached by taking these boundaries as bases. In infringement and invalidation lawsuits an assessment will eventually be made by taking the claims as bases, and a judgment will be reached as to if an infringement exists, and on damages as well as the matters associated therewith¹⁹. These claims will also be referred to when examining the invalidity allegation.

¹⁴ T 165/84, T6/01; European Patent Office, Case Law, p. 250.

¹⁵ T 2/80, OJ 1981, 431; European Patent Office, Case Law, 2013, p. 250.

¹⁶ European Patent Convention, which affects our national law and to which we are a party, does in its Article 69 include provisions that pertain to the extent of the protection conferred by a European patent application. The extent of the protection conferred by a European patent or a European patent application shall be determined by the contents of the claims.

¹⁷ UNAL, Onur; Patent Hukukunda Istemler (Claims in Patent Law), Bursa 2008, p. 30

¹⁸ SEHIRALI, CELIK Feyzan H.; Patent Hakkinin Korunmasi (Protection of Patent Right), Ankara 1998, p. 77

¹⁹ According to Article 83/1 of Decree Law 551, the scope of the protection is determined by the claim or the claims.

Where a patent includes examples of the functions or the results of the invention or of a composition of such invention, interpretation of the claim or the claims cannot be limited to such examples. In particular, if the additional components of the product or the procedure are absent in the examples explained in the patent, or if they do not include the properties of such examples, or else they fail to realize every purpose or property mentioned in such examples, then such product or procedure can't be deprived of the protection that is provided by these claim or claims. The provision of Article 89/2 of the IPA on this matter is based on the same principle. Matters that have been thought, but not been demanded in the claim or the claims by the inventor cannot be assumed or interpreted to have included the characteristics, which would unfold upon interpretation of the description and the drawings by an expert in the relevant technical field. In that sense, the description and the drawing must be prepared in such a way to support the claim²⁰.

Use of the exactly same claims fall under the scope of the protection. Use of the equivalent of the claims, if not the same, consists infringement. The word equivalent has the same or a very close meaning with the words like equipollent, matching, equal, and stands for those with equal values, with identical values and functions²¹.

The doctrine of equivalents is recognized also by the IPA. Article 89/5 of this law pertains to this matter, which reads as: *“In determining the scope of protection provided upon patent application or by the patent, also the elements that are equivalent of the elements stated in the claims at the time an infringement is alleged, will be taken into consideration. Where an element virtually performs the same function as the one asserted in the claims; if it performs such function it in the same way and generates the same result, it will, in general, be deemed to be equivalent of the element asserted in the claims.”* According to this provision, in determining the scope of the protection, if an element virtually performs the same function as that of the patent claim, performs in the same way and generates the same result, by and large, it will be deemed to be the equivalent of the protected function in the claims.

When determining the scope of the protection that results from the patent application or the patent, the elements that have equivalent characteristics with those of the elements indicated in the claim or the claims as of the date on which the infringement was alleged, will be taken into account. The elements and the characteristics for which the inventor principally demands protection are included in the section of the patent certificates regarding the claims. They constitute the scope of the protection and are decisive for identifying whether the infringement had been committed. If there is an element that performs the same function and produces the same result with the element for which protection is sought, this will be deemed to be the same with, in other words, the equivalent of the claim for which protection is sought²². When determining the scope of the protection, to reach at a conclusion by sufficing to interpret only the words in the contents of the claim or the claims creates significant

²⁰ European Patent Convention, Art. 84; T133/85, EPO Case Law, p. 213

²¹ tdkterim.gov.tr/; SENER, Esat; Hukuk Sözlüğü (Law Dictionary), p. 532

²² GÜNEŞ, İlhami; Uygulamada Sınai Mülkiyet Hakları ve Cezaî Koruma (Industrial Property Rights and Criminal Protection in Practice), Ankara 2009, p. 81

drawbacks. Elements that perform the same function in the same way and which produce the same result are equivalent elements. Where, within the scope of the protection under a patent application or a patent, the element used on the date of the infringement allegation and the element demanded in the claim or the claims are the same or equivalent, infringement of the right will be deemed to have existed.

On the contrary, if there is difference between the element that is used and the element that is demanded, in other words, where the elements are not equal or equivalent, no infringement exists. The fundamental principle on determining the scope of the protection under a patent application or a patent is taking the contents of the claim or the claims as the bases. Nevertheless, when interpreting the claim or the claims, the description and the drawings will be referred to²³.

Meanwhile, the patent owner can change or correct its claims only before the patent is granted. Except for obvious mistakes like spelling errors or submittal of the wrong documents, patent claim or claims can be changed only during the patent issuing procedures if and when the law does explicitly allow this. The scope of the application cannot be broadened by making changes to the patent claim or the claims²⁴. In the part of the IPA that is related to the patent process procedure, in Article 103/1, it is stated that the applicant can – during the time that elapses until application procedure is concluded by the TPTO – amend its application for as long as its scope is not expanded. In the event any objection is raised against the application, this can also be done before the TPTO makes its final decision on that objection, but again provided that the initial scope is not expanded.

C. RIGHTS AND POWERS OF PATENT OWNER

According to Article 85 of the IPA, the positive monopolistic right and power of the patent owner is that only he himself or the persons he allows will be able to use the patent and; the negative powers, on the other hand, are those which enables him to prevent production, sale and importation of the patented product, or to prevent others from keeping it for any reason other than personal needs. This provision applies also to utility models. In Article 145 of the IPA with heading that reads, “Applicability of provisions pertaining to patent to utility models and double protection”, it is provided that in the absence of an explicit provision on utility model, the provisions in this Law pertaining to patents will, where they do not conflict with the characteristics of the utility model, also apply to utility models and; that the utility model owner would benefit from the same rights.

It must not be forgotten that the monopolistic rights and powers are effective for twenty years starting from the date of the application, and that this period cannot be extended²⁵. In Article

²³ Decree Law 551 Art. 83/1; European Patent Office, Case Law, p. 263; ERDİL, Engin; Haksız Rekabet Hukuku, Istanbul, 2012, s. 997.

²⁴ Decree Law 551 Art. 64

²⁵ However, in the USA, Japan and the European Union, extensions for up to 5 years and 6 months can, in practice, be obtained under patent law, by taking into consideration the marketing licenses as well as the preparatory phase required for drug patents and plant protection chemicals. The reason for this is the impossibility of utilizing, from the start of the protection period until the licenses necessary for market access are obtained, the patent for production and sales, and in one sense waste of this period. Although the term of patent

101 of the IPA, the provision on protection period is the same as the provision in Article 72 of the repealed Decree Law 551 and; additionally, in the IPA Article, it is also provided that this period will not be extended. The patent owner benefits from the patent rights free of any exceptions in regard to the place of the invention, the field of technology, and as to whether the products have been imported or locally manufactured.

Decree Law 551 Art. 73/A, which pertain to the criminal protection of patent rights had been repealed by the Constitutional Court, and no statutory provision has yet been enacted to fill the resulting legal gap²⁶.

Besides, the provisions on unfair competition have been redrafted in such a way that would include new offenses, and Turkish Commercial Code 6102 which contain them had taken effect on the date of 1.7.2012. While accordingly the argument that the penal provisions on unfair competition cannot be applied to patents, designs and utility models, and that they were tacitly made obsolete by the Decree Laws and the special penal laws added to them²⁷ should not be adopted without discussing. Indeed, the complaints regarding unfair registration of patents, utility models and designs are investigated under the scope of unfair competition offense, and heard by the Criminal Courts of First Instance.

In order to protect his novel design, patent or utility model product, the owner of these can take recourse to the provisions on unfair competition, without bringing the issue of registration forward. Thus, protection of precious knowledge that is obtained as a result of thought, effort and investment is a general principle of law, and first and foremost of good faith. The provision of Article 54 of Turkish Commercial Code 6102 on the general principle

protection is by law 20 years, in the case of patenting of pharmaceutical products, this term cannot be used entirely. The competent authorities of the European Union did set up a complementary protection system, by Council Regulation (EEC) No [1768/92](#) of 18 June 1992 concerning the creation of a supplementary protection certificate for medicinal products, and by Regulation (EC) No 469/2009 of the European Parliament And of the Council of 6 May 2009 concerning the supplementary protection certificate for medicinal products. Reasons like the patent application process, lengthening of the product development time, and especially the requirement for marketing license affects the yield that can be expected during the patent protection term. In the agricultural drugs and chemicals industry, the productive patent terms are getting shorter and shorter as verification of the feasibility and safety of the new drugs and pesticides requires more time consuming tests.

²⁶ As Decree Law 551 took effect, Turkish patent jurisprudence adopted the contemporary practices and took significant steps to protect the inventions. In order to penalize patent infringements, criminal provisions were, in violation of the no crime and punishment without law principle, inserted in Decree Law 551 by Law 4128 as Article 73/A; which were later on amended by Law 5194. However, the said violation of this principle resulted in the repeal of these provisions by the Constitutional Court. While civil law protection of patents and utility models is still in effect, the criminal provisions in Article 73/A – which was added to Decree Law 551 by Law 4128, and which was later on amended by Law 5194 on the date of 22.6.2004 – are not effective and cannot be applied since the judgment of the Constitutional Law, dated 5.2.2009 and numbered 2005/57 – 2009/19, that repealed it according to the no crime and punishment without law principle. However, the claim and the claims are what is essential when determining the scope of the patent application or of the protection under the patent whereas the description and the drawings are of auxiliary nature. No provision has since been enacted on patent infringement offense and penal sanctions against it. During this period, the results and effects of enforcing only civil law protection has been experimented and; neither no have provisions on penal protection regarding patents and utility models are included in the IPA Industrial Property Law. Although IPA has penal provision just for trademark infringement.

²⁷ The Court of Cassation was basing its judgments on the argument that the provisions on unfair competition were – in respect to patent, utility model and design infringement offenses – obsolete. 3.6.2015, 2015/4496-2015/2291 (National Justice Network -UYAP; Database of the Rulings of The Court of Cassation)

as well as subparagraphs “1-a.4” and “c” of Article 55 that pertain to special situations are applicable. Should the owner wish to protect his registered design, patent or utility model under criminal law, he can try the existing unfair competition provisions. Nationality of the owner will be irrelevant because according to Article 39 of the TRIPS Agreement, and to Article 10*bis* of Paris Convention, protection must be extended against unfair competition.

Instead of costly and difficult processes for the registration of the patent or the other industrial property, the protection of such idea or knowledge for an indefinite time is also possible by keeping it as a trade secret. As to the protection of unregistered inventions, although it is obvious that they cannot be protected under the provisions of the IPA on patent, the general provisions on unfair competition do apply also to the unregistered inventions²⁸.

II. LAWSUIT FOR PATENT INFRINGEMENT AND ISSUE OF VERIFICATION OF THE INFRINGEMENT

A. DETERMINATION OF THE INFRINGEMENT AND THE METHODS

The scope of the protection, explained in detail at above, indicates the very point where the infringement starts in the event any patent protected claim is used by third persons without permission. In the IPA, on the other hand, the scope and perimeters of the protection are provided in Articles 85 and 89, where the powers of the owner of the invention to benefit from it and to prohibit others are stated. In these Articles, the technical fields and the general restrictions such as those that are based on public order concerns as well as the way to interpret the provisions on protection are indicated.

In practice, verification of the infringement of the patent is deemed as a technical matter ²⁹. Usually, an expert who knows the principles of patent and the experts in the relevant technical field are required to make an assessment of the matter, and to make an explanation to the court about the said technical field, as to what the invention is and what the product and the process of the party who allegedly had infringed the right is. The patent certificate should be reviewed from the perspective of an expert of that technical field, by considering the

²⁸- Hence, in a dispute about the protection of unregistered patentable inventions or utility models, the 11th Civil Chamber of the Court of Cassation ruled that recourse could be taken to Article 56 of Turkish Commercial Code. In that incident reviewed by the Court of Cassation, the plaintiff alleged that the defendant had fully imitated without permission the model 4400/4500 labelers, which are registered in the USA; that it sold them in Turkey and in the Middle East countries and; that it filed an application for utility model registration of the imitated product. The plaintiff asked for the determination of the facts regarding such infringement as well as for the cessation and public announcement of the same. The local court decided against the plaintiff. The Court of Cassation did, in its reversal judgment, point that there was no provision in Decree Law 551 that says inventions not registered in Turkey would not be protected and; state that the unfair competition principles in Article 56 of Turkish Commercial Code ought to be referred to in regard to the assertion and defense arguments of the parties to the case. This judgment must not be construed as non-compliant with the principle of territoriality. Although according to Decree Law 551, protection cannot be extended to a foreign patent if it is not registered in our country, the right of the owner of the invention or the licensor to stop any unfair, mala fide competition under Turkish Commercial Code Art. 56 cannot be ruled out. (Court of Cassation, 11th Civil Chamber, 4.3.2008, 2006/11131-2008/2607, FMR (Intellectual Property and Competition Law Journal of Ankara Bas Association) 2009/2, p. 120)

²⁹ 11th Civil Chamber, 14.12.2015, 2015/6059-2015/13396; 11th Civil Chamber, 22.2.2016, 2015/7302-2016/1848 (UYAP)

circumstances of the time when it had been issued as well as the common and widely accepted knowledge, thus looking into whether or not an infringement exists³⁰.

By disclosing his invention, the patent or the utility model owner makes the valuable technical knowledge he had obtained public, and therefore exposes it to the risk of being accessed by those who intend to use them without permission. The filed application should, according to Articles 92 and 138/1(b), be sufficiently clear and understandable, and suitable for the implementation of the invention by the technical expert. Article 92/1 provides that the invention must be explained in the claims explicitly and clearly, in a manner so as to enable a person skilled in the technical field of the subject matter to implement the invention. It is underscored that in the summary only technical information would be given, and that it would not be used to determine the scope of protection. In this Article, nothing new is added to the rule that the invention should be explained explicitly and clearly. The owner who complies with the conditions for entitlement to registration will, for this reason, benefit from an equitable protection. The patent owner does, as an individual, take advantage of the right by making contribution to technological development, and also ensure that the researchers is informed by making the technical knowledge available to public. That is because the disclosed and announced patent applications are then included in the state of art. It goes without saying that despite such disclosure, the patent owner does for the duration of the protection term enjoy his monopolistic rights.

In Article 85 of the IPA, the patent or utility model owner's preventive rights are listed. The patent owner has the right to demand prevention of third persons from doing the following without permission:

- 1. Production, sale and importation of the patented product, or keeping it for these purposes for any reason whatsoever other than for personal needs;*
- 2. Use of a process that falls within the scope of the patent protection;*
- 3. Offering by third persons to others the use of process patents, which is known or should have been known to be prohibited;*
- 4. Production, sale and importation of the products that are obtained directly by the use of the patented process, or keeping them for these purposes for any reason whatsoever other than for personal needs.*

The legal provisions pertaining to the special kind of unfair competition that is defined as patent infringement, protect the intellectual efforts and the economic investments of the patent owner, the purpose of which were to materialize the invention. Protection against infringement is provided because the right to monopolistically enjoy the benefits of the invention belongs to its owner.

³⁰ BENTLY/SHERMAN, p. 499

Those who overstep the patent owner's domain of protection can be considered as infringers. The provisions on patent infringement on the other hand, are included in Article 141/1 of the IPA. The acts that constitute infringement of patent rights are as follows:

- ← 1. *To imitate the product to which the patent relates, entirely or partly;*
- ← 2. *To commercialize, import, or stock and/or use by way of implementation, the products that had been produced by infringing the patent right, when such infringement is known, or should have been known;*
- ← 3. *To use the patented process or to commercialize the products directly obtained by means of the patented process;*
- 4. *To broaden the scope of rights granted under a contractual or compulsory license, or to transfer such rights to third parties;*
- 5. *Usurpation of the patent or utility model rights.*

In order to be able to speak of a patent right infringement, the invention must have been patented or the announcement of a valid patent application must have been published. Therefore, to pass a final judgment on an alleged infringement of a patent, for which an application had been filed but not yet decided, the court will wait for the decision of the Turkish Patent Institution for registration or refusal.

In this provision, both the patent and the utility model certificate are discussed. From this expression, it is deduced that both certificates entitle the owners to same kind of rights. In Article 141/1(ç) of the IPA, unlike the provision of the repealed Decree Law 551, the acts of “*usurpation of the patent or utility model right*” and overstepping of license as well are included in the definition of infringement. Again, the first of the acts of infringement is about production. Then follows the provisions pertaining to the commercial actions of those who knows or should have known the patent, and where infringement of a process patent is alleged, to the burden of proof on the user that he had not used the patented process. According to Article 141/3 of the IPA, the patent or utility model applicant is entitled to file civil lawsuit for infringements that occurred after the date their application had been published. Where the infringer had been informed about the patent or the utility model, it will not be necessary to refer to the publication of the application as a prerequisite. In the event of bad faith, infringement will be deemed to have occurred before the publication. However, in the provision, it is not clear whether registration should be waited for. Certainly, as a customary practice, the decision of acceptance or rejection of the registration is deemed as a dilatory question, considering a possible rejection. It is because the first condition for the infringement of a patent or utility model is to be able to assume their validity.

Hence, the act of infringement is, first of all, committed by using the claims. As a rule, the action that gives rise to infringement is the one that comprises the basic elements of the main claim of the patent. If the product which is alleged to have constituted infringement contains the basic elements, protection of which under a patent is desired, infringement will be deemed

to have existed. Acts of sale and commercialization of the products that constitute infringement can be committed also by those other than the makers of the imitation products.

← B. LAWSUITS THAT CAN BE FILED IN THE EVENT OF PATENT INFRINGEMENT

← a. Verification of the Patent Infringement and Lawsuit for Prevention of Infringement

A declaratory lawsuit is filed to verify if a legal relationship does or does not exist. Physical facts that have a particular legal consequence or that give rise to a particular relationship can be the subject matter of such verification, but unlike a lawsuit for performance, a declaratory judgment cannot be enforced³¹. In the repealed Decree Law 551, there are no provisions that pertain to the verification and prevention of patent infringements. However, in the *shared provisions* section of the IPA, in Article 149, this matter is regulated in a uniform way so as to include trademarks, designs and geographical signs.

Nevertheless, first of all verification of the infringement that will have to be prevented is the logical step to take. The patent owner or the licensees, who are empowered to file the lawsuit, have a legal interest in filing the said declaratory lawsuit in order to have the infringement verified. Where the patent owner or the licensees incur or face incurring damages because of the patent infringement, they too have a legal interest in doing the same. Furthermore, even if the infringement has ended, a declaratory lawsuit can still be filed, this time for the verification of its continuing effects.

Although the right to demand prevention of infringement is not explicitly provided, this does not mean that it does not exist. If there are serious indications and the risk of an infringement even if has not yet started, a lawsuit for its prevention can be filed. In respect to verification and prevention of infringement, the provisions of Turkish Commercial Code on unfair competition do apply as general provisions. Whereas a special legislation on this matter, is suitable source and grounds for this issue, basing the lawsuit also on these provisions of Turkish Commercial Code would be useful.

In practice, for verification and prevention of infringement of patent or utility model as well as for damages, one lawsuit is filed, and eventually one judgment is passed.

In Article 149/1 under the *shared provisions* section of the IPA, it is provided that in the lawsuits that can be filed, verification that the action constitutes infringement; prevention and stopping of the infringement; transfer of title to the infringing products; compensation of tangible and intangible losses; seizure and destruction of the equipment, machines and apparatuses used to produce the infringing products and; announcement of the infringement can be demanded.

b. Cessation and Elimination of Patent Infringement

³¹ For further information, please see: KURU, Baki/YILMAZ, Ejder/ARSLAN, Ramazan; Medeni Usul Hukuku (Civil Procedure Law), Ankara 2011, p. 275 et.al.

In the event of an ongoing patent infringement, cessation of the infringement can be demanded. This lawsuit is a lawsuit for performance, and the judgment is enforceable. The plaintiff may demand the prevention of the infringement even in the same lawsuit for cessation of patent infringement. The provision of Article 149, on the other hand, eliminates any possible hesitation.

In order to be held responsible for patent infringement, no fault is required and the plaintiff does not need to have incurred any loss either. Statute of limitations will not commence as long as the infringement continues. On the other hand, where the infringement has already stopped, remedying of its consequences and; solutions like seizure and destruction of the product that constitute infringement, transfer of title, announcement and publicity is possible.

The lawsuit for cessation the infringement can be filed against those who manufacture, sell, distribute the products that are subject of such patent infringement, and those who keep them for commercial purposes or who trade them.

A provision on the compensation of the loss incurred by the owner of the patent or utility model right is included also in the IPA, as a general rule; it will be possible to ask for the compensation of the damages caused by those who are unauthorized to use the patent or the utility model,. Article 151 regulates, the issue of non-realized profit and the methods for calculation. According to the IPA, as it was in Decree Law 551, the patent or utility model owners are allowed to select the method for the calculation of the profit that could not be realized because of the infringement. However, there is a restriction as to the methods that can be preferred. That is, if the holder of such right did not exercise it, non-realized profit will be calculated as provided in Article 151/5 – meaning that as it would, had the infringer used the patent or the utility model under a valid license. When the non-realized profit is to be calculated, the court should consider especially the economic significance of the intellectual property right or the number, the time periods and types of the licenses associated with the said industrial property right; the characteristics and the magnitude of the infringement, and other similar factors (IPA Art. 151/3).

In the event of infringement of the patent, a judgment with as much wider scope as possible will serve the interests of the patent owner. In other words, the patent owner will primarily expect a judgment in which minor variations of the act of infringement are encapsulated. However, potential problems that might be associated with the enforcement of such a judgment should not be underestimated³². The right of litigation of the patent owner with the intention of stopping the infringement as soon as possible, and thus preventing the increase of loss does also include the right to request for injunction along with the judgment. In patent law practice, requesting an injunction to obtain any result that could otherwise be obtained by a judgment is, unlike the general understanding, possible. Article 159 of the IPA allows those, who had filed or would file a patent infringement lawsuit, request an injunction to ensure effectiveness of the lawsuit. The scope of the injunctive order will be determined by the court, depending on the characteristics of the particular incident. In this context, such order can

³² PETERSEN, Anja; “The Wording of Requests for Injunctive Relief in Patent Infringement Proceedings” EPO Script, 2002, Munich, p. 458

require delivery to the trustee; protection; seizure of the tools, equipment, molds and machinery used for the infringement, to take a guarantee, or other similar measures.

Eliminating the infringement, however, means the elimination of the unlawfulness that arises as the result of that infringement. Enforcement of such judgment will ensure restoration of the conditions prior to the infringement. For example, by recalling from the market the products that constitute infringement and by destroying them, such infringement may be remedied and the restoration of the prior conditions may be ensured. Therefore, in order to have the counterfeit products recalled from the market, requesting cessation of the infringement will not be sufficient. In that case, the defendant's actions which constitute infringement will be ceased, but the previously manufactured and marketed products will still be on the market.³³

← aa. Method Followed in Infringement Lawsuits

In these lawsuits, it must primarily be verified that the plaintiff's case is based on a valid patent. Deliberations pertaining to remedying the infringement and returning to the former legal condition will be held, and a judgment will be passed on this matter. The characteristics of the patent owner's invention must be identified and the explanation of the invention must be made as a first step, following which the patented product and the defendants' product must be compared in order to establish whether or not infringement exists. Since the scope of the protection is determined by the claim or the claims, such claim or the claims will primarily have to be looked into rather than the product that the plaintiff alleges to have manufactured according to the patent. Although examination of the plaintiff's product will not be essential and neither will it produce conclusive results, this may nevertheless help understanding of the matter.

If the patent application is still being processed or the owner of a patent issued without substantive examination applies for such examination, the court must wait for the outcome of the procedure at TPTO. If the TPTO rejects the application or if the court decides for the invalidity of the patent, infringement cannot be deemed to have existed. Without disregarding the fact that since IPA has taken effect, patents without substantial examination will no longer be issued, the following judgment of the Court of Cassation is an example to such outcome at the time when Decree Law 551 was still in force:

"The plaintiff's attorney alleged that his client had his invention, named by him "Card Pass System", registered with numbers 2007/08940 and 2008/05766 at TPI; that in a residential compound called "Bahcesehir Regnum Elit Kent" a card pass system was installed, and that to enter the compound and to use the community facilities therein, the residents used these credit cards distributed by the defendant Denizbank; that this application of the defendant was exactly the same with that of his client's registered "Card Pass System"; that also the credit cards, named "Seamiles", which can be used as ticket for inner-city sea transport, and "Pasobonus", which is intended for students, both of which marketed by Denizbank, were general purpose contactless pass card products that constituted the subject matter of his client's patent and; demanded and sued for, by reserving his rights for more, the collection of TL 1,000.00 tangible

³³ CELIK, p. 160

damages, and together with the highest rate rediscount interest that would run starting from the date this lawsuit is filed, TL 10,000.00 intangible damages, from the defendant.

Defendant's attorney demanded dismissal of the main lawsuit and; in the joinder lawsuit, declaring the defendant's registered patents, numbered TR 2007/08940 and TR 2008/05766 B, invalid.

The court decided for the dismissal of the main lawsuit and; in the joinder lawsuit, decided that since the application for the conversion of the patent without (substantive) examination, which is numbered 2007/08940, into a patent with substantive examination had been rejected because, although in the examinations it had been discovered that the patent was applicable to industry, it nevertheless lacked the inventive step and did not meet the innovative characteristics criteria, and thus that was the legal status of the referred patent with respect to both the infringement allegations as well as with respect to the demand in the joinder case file for declaring it invalid and; that since the registration of the plaintiff's patent was no longer valid, there was no need to pass a judgment on this now irrelevant demand. The court did, at the same time, declare the patent 2008/05766 invalid and decide for its deregistration, because it lacked innovative [characteristics] and the inventive step. The plaintiff of the main lawsuit, and the defendant of the joinder lawsuit appealed the judgment.

As upon discussing and considering information and documents in the case file, and all evidences on which the court based its arguments for its judgment, no aspect that is against the procedural rules and the law was found, none of the appeal arguments of the attorneys of the plaintiff of the main lawsuit, and of the defendant of the joinder lawsuit is deemed appropriate.

CONCLUSION: It is unanimously decided on the date of 1.6.2016 to reject, for the reasons explained at above, all appeal arguments of the attorneys of the plaintiff of the main lawsuit, and of the defendant of the joinder lawsuit and; to AFFIRM the judgment that is found in compliance with the procedural and substantive law and; to have the appeal fee balance of TL 30.70 collected from the appellant.”³⁴

Whereas substantiation of copying of the patent claims is a technical matter, technical details are not by themselves sufficient for determining whether or not infringement exists. In order to make an assessment of the legal consequences of the infringement, knowledge of the principles on patent right as well as the examination of the financial aspect are also necessary³⁵.

In infringement cases, reading of the claims by referring to the descriptions and drawings in the patent certificate can help understanding of the invention as it should. However, grammatical interpretation of the claims will usually prove insufficient, and a purposive interpretation will have to be made. Starting with the examination of the latest created documents can be more useful when such an examination is needed for the explanation of the invention. By this way, the nature of the invention will be understood, and a better comparison can be made. Such assessments are primarily technical, and at the same time legal. In order to comprehend the invention, the judge can take the professional opinion of a technical expert of that particular field. Thus, Article 266 of Civil Procedure Law provides the

³⁴ 11th Civil Chamber, 1.6.2016, 2015/10882-2016/6059

³⁵ MILLER, R. Arthur/DAVIS, H. Michael; Intellectual Property, US, 2000, p. 351

statutory basis of this. When the resolution of the dispute requires special and technical knowledge, the opinion of one or more expert witnesses can be taken. The expert witness should make a comparison of the patent claims and the product of the allegedly infringing party. The point of reference is not the patent owner's product; it is the patent. The patent owner might not yet have manufactured the product or he might have manufactured the product without using the patent.

Use of the claims exactly as they are or the use of their equivalents will not make any difference; in both cases the infringement will be deemed to have occurred. However, occasionally some of the claims might not have been used, or features that are not written in the patent might have been added. In this eventuality, discovering of the essence of the invention will be decisive. Lack of inventive characteristics of the secondary or the additional features will not enable an assessment in favor of the defendant. Nevertheless, even if they are not associated with the essence of the patent, the missing features, the claims which are not used, will not overrule an infringement. Should, regardless of the missing features, the resulting product produce the same results with the invention, the patent will be deemed to have been infringed³⁶.

Verification of as well as stopping and remedying patent infringement can be requested in the same lawsuit. In fact, most of the lawsuits are indeed prepared and filed in such a way to include these requests. In an actual dispute, the patent owner plaintiff made such a request. The part of the judgment, which pertain to this matter is as follows:

*"...that it was about the invention titled 'liquid container cap mechanism', that the defendant is engaged in the business of cap manufacturing and marketing and, alleging that the bottle caps which the defendant manufactured and marketed constituted infringement of his client's patents, thus filed this lawsuit for the verification, stopping and prevention of the infringement of the rights of his client as well as of the unfair competition; for the seizure of the caps the manufacture of which constituted infringement of the patent rights, and also unfair competition; for stopping the promotion, manufacturing, importation and exportation, marketing, distribution and all kinds of trading of the bottle cap that infringe the patents as well as for public announcement of the judgment. Forwarding the same allegations in the joinder lawsuit, he asked for TL 15,000 tangible damages, TL 50,000 [damages] for loss of reputation TL 50,000 intangible damages, and any interest that would accrue..."*³⁷

The characteristic features of the act of infringement should be indicated in the court's judgment and; such judgment must be drafted so as to allow a full enforcement like stopping of the production, sale, promotion and trading of the infringing products. Therefore, the dispute between the parties will have been resolved and the plaintiff patent owner will not have to file another similar lawsuit. Indeed, the infringer might try to circumvent the judgment by making minor adjustments on the product. For this reason, the main and the characteristic features of the act of infringement must be indicated in the final judgment. In its

³⁶ BENTLY/SHERMAN, p.503

³⁷ 11th Civil Chamber, 24.12.2015, 2014/18840-2015/13906 (UYAP)

judgment, the court can state and explicitly define the claims that the defendant had used, and by this way, it will virtually have photographed the very act of the infringement.

← bb. Application of Method and Exceptions in Process Patent Infringement Lawsuits

In the event of a process patent, it will be examined whether or not the defendant had used the patent duly; if he had manufactured the products that had been obtained by employing such process, and if he had marketed them. The patent owner will be entitled to request the measures, which are necessary for the registered patent, to be taken. However, it must be proven that the defendant had used the process provided in the patent owner's patent.

In Article 141/2, the provision in the matter of infringement of the process patent reads as follows: *'Where the subject matter of the patent is about a process for obtaining a product or substance, the court can require the defendant to prove that the process for obtaining the same product or substance is different from the process, which is the subject matter of the patent. Where the product or substance obtained by using the process that is the subject matter of the patent is new, every same product or substance that is produced without the permission of the patent owner will be deemed to have been obtained by using the process that is the subject matter of the patent. The burden of proof falls on whoever claims otherwise. In that case, the legitimate interest of the defendant in keeping his production and business secrets undisclosed will be taken into consideration.'*

There are some actions that are confused with patent infringement, and for which lawsuits for their prevention are filed. In practice, drug license applications are correlated with patent, and they can be the subject matter of infringement cases, which might also include request for injunction. On the other hand, according to Article 85/(3) of the IPA, the procedure for licensing of drugs is an exception to patent rights. A provision that is similar with this provision of the IPA was also included in Decree Law 551's Article 75/f on the scope and perimeters of this right. As it is mentioned with regard to matters about the limits of patent rights, monopolistic protection does not work where certain reasons exist. One of them is licensing of the drug, and actions that also involve the tests and experiments that are required for this reason. In a particular case it reviewed, the 11th Civil Chamber of the Court of Cassation stated that the defendant had filed an application for a drug, which was the same as the drug named "Efexor" that was already protected under patent No. 1997 00190. The plaintiff, who was the owner of the patent, argued that this action constituted an infringement and that it was the indication of the fact that the defendant would most probably exploit the plaintiff's registered patent. The court of first instance did not agree with these arguments, and based on Article 75/F of the Decree Law 551, concluded that the applications for licensing of the drugs as well as their testing, experimenting and experimental production constituted an exception to the patent right, thus affirming the local court's judgment ³⁸. The fact that the remaining protection term of the patent was long (11 years), was not deemed as confirmation of the patent owner's allegations. Besides, the Ministry of Health had stated that this application had not yet been decided, and the Court concluded that the action should be deemed within the scope of the exception.

³⁸ 11th Civil Chamber, 24.6.2013, 2012/14850-2013/13172 (UYAP)

Likewise, in another similar case, the judgement of a Civil Court of Intellectual and Industrial Property Rights that had passed a similar judgment was affirmed³⁹. In this file, it was taken into consideration that the defendant had not yet started to manufacture and sell, and thus the patented process applications could not be compared. The court had decided that in patent infringement lawsuits, primarily, the scope of the plaintiff's patent should be verified, and then the defendant's action should be analyzed, thus concluding in its judgment that in that particular case nothing had not yet been manufactured and sold, and the fact that the same active substance had been used did not alone prove infringement.

CONCLUSION

Although the examination and resolution of patent infringement allegations is a legal matter, the technical support of an expert witness is also needed. Being able to understand and interpret the patent claims requires knowledge in that technical field. Eventually, this means that since, as mentioned in Article 266 of the Civil Procedure Law, the judge's legal and general knowledge would obviously not be sufficient to resolve the case, the help of a technical expert will be needed. The expert witness that would be selected must currently be practicing and following the developments in that particular technical field, and have an average level of expertise. The general understanding is that any technical personnel who makes repairs and performs maintenance work would not be a suitable expert.

While verification of copying of the plaintiff's patent that is still valid, or of a counterfeit product, is a technical matter, technical knowledge alone will not be sufficient to review the question of infringement. Assessment of the legal consequences of infringement requires knowledge of patent right and the principles on its protection, and in many cases examination of the financial aspect. In this respect, in infringement and compensation cases, experts who know the patent principles as well as financial experts should be assigned along with technical experts.

The expert will have to explain to the court, both the technical information known on the patent application date and the improvement or the solution provided by the patent; compare the claims with the allegedly infringing product or the use of process and; submit a report on how the infringement had occurred. In practice, difficulties are encountered when selecting and assigning the expert witnesses and; in most cases the problem arises from the lack of knowledge of the expert witness on the principles of patent law, as technical knowledge alone is not enough for the resolution of the patent dispute. When interpreting the claims, the balance between the legitimate expectations of the patent owner and the public domain that must be protected should be maintained. For this reason, the technical expert is required to work in collaboration with another expert or other experts with knowledge in patent law.

Nowadays, inventions are usually associated with computer programs, and many of them are computer aided. In cases of infringement of such patents, the term technical expert will naturally include software experts. Resolution of such disputes requires the help of software engineers as well as the experts in the pertinent technical field.

³⁹ 11th Civil Chamber, 17.2.2011, 2009/859-2011/1835 (UYAP)

IPA, on the other hand, does not bring anything substantially new with respect to cases for the verification of patent and utility model infringements and; regarding the legal consequences of infringements. Considering the predominantly technical aspect of the matter as well as the complex technical nature of the patent cases, giving a thorough training to the practitioners of this field will be very useful.

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