

Question Q228

Natioanl Group	Turkey
Title	Prior User Rights
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Questions

I. Analysis of current law and case law

Groups are invited to answer the following questions under their national laws:

1. Is there a provision in your national patent law that makes an exception to the exclusive right of a patent holder for parties who have used the invention before the filing/priority date of the patent (“prior user rights”)?

Yes, according to Turkish Decree Law 551 (referred as “DL 551”), Art. 77 refers to rights conferred by prior use. Art.77 states for:

“The right holder of a patent shall not have the right to prevent person or persons who, in good faith, between the date of filing of the application and the date of priority, had worked the invention in Turkey or had made serious and effective preparations to work the said invention; from continuing to work the subject matter of the patent, in the same manner as before, or from commencing its working as of the preparations made to this effect. However, third persons may continue working the subject matter of the patent, in the same manner as before, or commence its working as of the preparations made to this effect, only to the extent necessary for meeting the reasonable needs of their enterprise. Such right to work the invention shall only be transferable with the enterprise.

The rights conferred by a patent within the meaning of Article 76 shall not extend to acts related to products put to sale by persons indicated in Paragraph one of this present Article.”

2. How frequently are prior user rights used in your country? Is there empirical

data on how often prior user rights are asserted as a defense in negotiations or court proceedings?

There is no information regarding the frequency of use of the prior user rights in Turkey. No empirical data is available on the frequency of prior user rights being asserted in negotiations or court proceedings. No relevant decisions are available.

However the group members have personal experience on use of the prior user rights during negotiations.

3. To what degree must someone claiming a prior user right have developed the embodiment which is asserted as having been used prior to the filing/priority date of the patent? Is it sufficient to have conceived of the embodiment, or must it have been reduced to practice or commercialized?

As set out in A (77) of Decree Law No. 551, those who claiming prior user right should have worked the invention in Turkey or have made serious and effective preparations to work the said invention. There is no case law in Turkey as regards the degree of development to benefit from prior user right. However, A (96) brings obligation to use/work the invention for patentees and A (97) explains how patentee prove that he/she has duly used/worked the invention under patent protection. In line with A (97) of D.L. (551) and A (40) of its implementing regulation, such an evidence of use shall be provided by an official certificate obtained from chambers of trade or industry or other related institutions. The certificate shall confirm the fact that the patented invention is being implemented or that the (goods) object of the invention is offered for sale.

In the absence of any case law on this issue, we believe that “working” requirement in A (77) should be correlated with “working the invention for patentees” in A (96). Thus, if the embodiment is implemented or offered for sale and if such an official certificate can be obtained, it should be accepted as working the invention and thus a prior user right should be granted. Related to this, it should not be sufficient to have conceived of the embodiment but implemented or offered for sale.

4. Does it make a difference in your country if
 - the prior use occurred before the priority date; or
 - it occurred after the priority date, but before the filing date?

Yes, it makes a difference. Prior use occurred before priority date is not defined under A (77) of Decree Law No. 551. Additionally, a public prior use be-

fore priority date would be considered state of the art and could be used to invalidate patent pursuant to A (129)(a).

A (77) clearly define the period for prior use is between the date of filing of the application and the date of priority.

5. Is there a territorial limitation with regard to the scope of prior user rights in your country? In other words, if a party has used the patented invention before the filing/priority date in a foreign country, can it then claim a prior user right in your country?

Yes there is a territorial limitation within the scope of the designation of the patent application. No, it shall be used against novelty (except private use and for purposes which are not commercial; done for experimental purposes relating to the invention) of the patented invention.

6. Is there a provision that excludes prior user rights for those who have derived their knowledge of the invention from the patent holder and/or the inventor?

There is no direct provision regarding the exclusion of the prior user rights for those who have derived their knowledge of the invention from the patent holder and/or the inventor. Further no case law is available. However in accordance with the general legislation and good faith principle it would be expected that those who have derived their knowledge of the invention from the patent holder and/or the inventor would indeed be excluded from the use of the prior user rights.

7. Is it necessary that the prior user has acted in good faith to be granted a prior user right?

A (77) explicitly mentions “good faith” requirement. Thus, the answer is yes.

8. Is there a material limitation with regard to prior user rights in your country? More specifically, if someone has used an embodiment of a patented invention before the filing/priority date of the patent, can he then claim a prior user right to anything covered by the patent? In particular, is the owner of a prior user right entitled to alter/change the embodiment of the patented invention used before the filing/priority date of the patent to other embodiments that would also fall within the patent’s scope of protection or is he strictly limited to the concrete use enacted or prepared before the patent’s application or priority date? In the event that changes/alterations are permitted by your national law, to what degree?

A(77) waive rights of a patent holder to assert against someone entitled with prior user right to continue using patented the subject matter in the same manner as before. The wording “same manner” of the article could be interpreted as a limitation to prevent alter/change first embodiment used by owner of prior user rights. However, there is no case law on this subject therefore it is not clear yet.

9. Does a prior user right in your country require the continued use (or the necessary preparations of the use) of the invention claimed by the patent at the moment in which the objection of the prior user right is asserted or is it sufficient if the invention claimed by the patent has been used before the priority/filing date of the patent but has been abandoned at a later stage?

According to DL 551, Art. 77 a prior user right has to occur between the date of filing of the application and the date of priority.

10. Is a prior user right transferable and/or licensable in your country? If yes, under what circumstances?

Article 77 of Decree-Law No.551 Pertaining To The Protection Of Patent Rights last paragraph specifically mentions that the prior user right shall only be transferable with the enterprise. Accordingly it is not possible to transfer and or license the prior user right per se. However in the event that the enterprise is transfer to another entity as a whole the prior user right can be transferred along with.

11. Does your national law provide any exceptions or special provisions with regard to a prior user right owned by a company within a corporate group? In particular, can a prior user right be transferred or licensed to another group company?

A (77) mentions that “a prior user right to work the invention shall only be transferable with the enterprise.” This should be interpreted in a way that the right cannot be transferred or licensed to another group company as long as there is no acquisition or merging process between the group companies. On the other hand, there has been no such case in practice so far.

12. Are there any exceptions for any specific fields of technology or types of entity with regard to prior user rights in your country?

No. There is no exception as such.

13. The Groups are invited to explain any further requirements placed on prior user rights by their national law.

II. Policy considerations and proposals for improvements to your current system

14. Should a prior user right exist in any legal system? If yes, what is the main legal justification for a prior user right?

Yes, a prior user right should exist in legal systems so as to protect the parties who have acted in good faith.

15. What is the perceived value of prior user rights in your country?

Since there is neither existent case law nor available statistical data regarding prior user rights in our country it is not possible to discuss the perceived value of prior user rights. The perceived value is rather low, if not zero.

16. Are there certain aspects that should be altered or changed with regard to the existing implementation of the prior user right in your country? In particular, are there certain measures or ways that could lead to an improvement and/or strengthening of your current system?

Limiting the right to the Turkish nationals/residents and technical field exceptions shall be considered.

III. Proposals for harmonization

Groups are invited to put forward proposals for the adoption of harmonized rules in relation to prior user rights. More specifically, the Groups are invited to answer the following questions:

17. Is harmonization of “prior user rights” desirable?

International harmonization is indeed desirable. The current legislation in Turkey is already drafted in a liberal point of view. Hence the international legislations can be harmonized around the current Turkish legislation and/or equivalents.

18. What should be the standard definition of “use” in relation to prior user rights?

Must the use be commercial?

Use shall be defined as “commercial use” and shall include “effective and serious preparations for commercial use.

Acts which do not constitute infringing acts therefore do not give right to prior user rights (e.g. done privately and for purposes which are not commercial; done for experimental purposes relating to the invention) shall be left out of the scope of the prior user rights.

19. What should be the definition of “date” (or “critical date”) for prior user rights? (*i.e.* when must the invention have been used to establish a prior user right?)

The invention should have been used prior to the filing/priority date of the application.

20. Should a prior user right persist in the event that the use and/or preparation for use of the invention has already been abandoned at the time of the patent application/priority date or should the prior user right lapse upon the termination of the use and/or preparation of use?

The prior user right shall lapse upon the termination of the use and/or preparation of use.

Even in the case that the use is existant in the date of the filing of the application, the prior user right should be limited to continue the use in the same manner as before, or commence its working as of the preparations made to this effect, only to the extent necessary for meeting the reasonable needs of their enterprise.

21. What should be the territorial scope of a prior user right? In particular, if a party has used the patented invention before the decisive date in a foreign country, should it then be entitled to claim a prior user right?

Territorial scope should be the country itself. If a party has used the patented invention before the decisive date in a foreign country, it should not then be entitled to claim a prior user right.

22. Should there be a provision that excludes prior user rights for those who have derived their knowledge of the invention from the patent holder and/or the inventor? If yes, should it be necessary that the prior user has acted in good faith to be granted a prior user right?

Yes, a provision that excludes prior user rights for those who have derived their knowledge of the invention from the patent holder and/or the inventor

shall exist. It should be necessary that the prior user has acted in good faith to be granted a prior user right.

23. Should there be material limitation with regard to prior use rights? In particular, if someone has used an embodiment of a patented invention before the filing/priority date of the patent, should he then be entitled to claim a prior user right to anything covered by the patent?

Yes, there shall be a material limitation to the extent of the prior user right. The person who have used a specific embodiment of the patented invention shall be entitled to continue to use that specific embodiment, however should not be further entitled to use any further embodiments covered by the patent.

24. Should a prior user right be transferable and/ or licensable?

The prior user right should only be transferable along with the transfer of the enterprise.

25. Should there be any exceptions for any specific fields of technology or types of entity with regard to prior user rights?

There should be no exceptions.

26. The Groups are also invited to present all other suggestions which may appear in the context of the possible international harmonization of "prior user rights".