

International report - Direct applicability of European Patent Convention while invalidation actions pending

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Turkey became a signatory to the European Patent Convention (EPC) on November 1 2000. The enactment of the Law on Joining the European Patent Convention on the Grant of European Patents and Its Protocols (4054) brought the EPC provisions into force in Turkey. Accordingly, the EPC is directly applicable to European patents validated in Turkey. However, few of the EPC provisions bind the national courts. For example, Article 138/3 gives a European patent owner the right to limit the patent in case of an invalidation action and orders the national court to take the limited version of the patent as the basis of invalidation proceedings.

This provision is inconsistent with Turkish national patent law. However, national law permits amendment in the patent document only during proceedings before the Turkish Patent and Trademark Office (TPTO), and explicitly forbids any amendment – including limitation – after grant of the patent.

Therefore, the IP courts and the TPTO have previously refused to apply Article 138/3 in national invalidity proceedings. However, the Istanbul IP Court recently applied Article 138/3 and accepted claim limitation in national proceedings.

The invalidation action was filed immediately after the first grant decision issued by the European Patent Office (EPO), but the EPO continued with opposition and then appeal proceedings, which are still pending. The patent was maintained on the basis of an auxiliary request, which limits the scope of the patent. However, as the appeal was ongoing the limitation had not yet been published in the *Official Bulletin*, and therefore could not be validated in Turkey.

The patent owner was forced to defend the patent based on its originally granted scope, despite the limitation before the EPO. In such cases, the question is what will happen if the national court decides to invalidate the patent before the EPO's final decision is published and, as a result of the final decision, the patent is maintained with limited scope. Will the TPTO consider the limited scope not to have been the subject matter of the invalidation action, and thus bypass the court decision and revalidate the patent in Turkey with the limited scope?

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The solution may be found in delaying proceedings, particularly if the opposition is ongoing. However, in principle Article 138/3 should be applied during the life of the patent, irrespective of any ongoing opposition or appeal before the EPO.

In the case at hand the patent owner first requested the court to await the outcome of the EPO proceedings and not to render a final decision until they had been concluded. However, although the Opposition Division maintained the patent on the basis of the auxiliary request, the patent owner believed that the first granted claim set met the patentability criteria, so he also applied to appeal with other opponents.

Since the IP Court decided not to wait for conclusion of the EPO proceedings but rather to render its final decision, as a final attempt to save the patent the patent owner filed an application to limit the claim set under Article 138/3 of the EPC. Limitation was based on the claim as allowed by the Opposition Division.

Finally, the court accepted to apply Article 138/3 of the EPC where it would usually render a final decision pursuant to the civil procedural law. The court emphasised that the claim set had become identical to the limited set of claims before the EPO.

Surprisingly – but fairly – the IP Court and the TPTO accepted the patent owner's claim limitation request. This was the first example of the acceptance of the limitation of claims during a national invalidation action and direct application of Article 138/3 of the EPC.

This decision may lead to a new era in which there is parallelism between the EPC and Turkish patent legislation, and where the procedures to obtain a patent will complete each other, resulting in consistency between the claims of Turkish and referred European patents.

The TPTO's decision may also reduce the number of invalidation cases and save patent owners in the same situation from the invalidation of their patents by limiting the claims of Turkish and referred European patents before the conclusion of EPO proceedings or, more importantly, after EPO proceedings have already been finalised.

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