



International report - The new post-grant opposition system

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After years of discussions, the new draft IP Law – which is expected to be enacted this year – introduces a post-grant opposition system for national patent filings in Turkey.

The legislature is introducing a post-grant opposition system in order to bring Turkish law into line with the European Patent Convention system. However, the post-grant opposition system set out in the draft law has some small differences from the convention system.

Third parties may file an opposition against a patent within six months of publication of the grant decision. Available opposition grounds are that:

- the patent does not fulfil the patentability criteria;
- the invention has not been disclosed in a sufficient manner; or
- the patent exceeds the scope of the initial application.

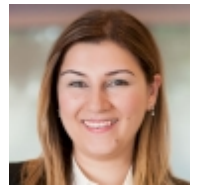
The patent owner should be notified of the opposition by the patent office, and the patent owner can file its response or amendments to the patent within three months of notification.

If the board concludes that the patent, as filed or as amended, conforms to the law, it will uphold its decision with respect to the patent. If it concludes that the patent, as filed or as amended, does not conform to the law, it will declare it null and void.

If the board concludes that the patent partially conforms to the law, it will confirm the validity of that part of the patent and inform the patent owner accordingly, requesting the amendment of the patent in line with partial approval. If no amendments are filed or the amendments are not approved, the patent will be declared null and void.

The post-grant opposition system is expected to lead to stronger patents or patents with a fairer scope of protections. However, as the system will extend the time needed to reach a decision on final grant, objections have been raised during parliamentary commission hearings, particularly by the Gx pharmaceuticals industry. The Gx industry argued that the ambiguity surrounding the patentability of inventions will prevent them from entering the market. In addition, the Gx industry argued that it is unfair to let patents benefit from the rights of a finally granted patent during

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opposition proceedings, despite the possibility of revocation or limitation. However, the legislature appears to have dealt with such unfairness arguments by ruling that the claims of a patent as filed or amended during opposition or invalidity proceedings determine the scope of patent protection retrospectively.

The draft law also governs what happens if an invalidation action is filed before the IP courts while an opposition on the same patent is pending. The draft law states that the court cannot issue a decision on the invalidation action until the outcome of the opposition has been published in the *Official Bulletin* or it has been confirmed that no opposition has been filed against the patent. This is routine for European patents validated in Turkey after a first grant decision of the European Patent Office (EPO) Examining Division. Referring to the fact that a patent subject to invalidity proceedings in Turkey may be revoked or amended, and that this will be directly binding on a European patent validated in Turkey, the Turkish IP courts are often asked to delay invalidation proceedings until completion of the opposition. However, as the law makes no explicit provision for this, the delay is at the discretion of the IP courts.

In fact, this is a routine scenario for European patents validated in Turkey after the first grant decision of the EPO Examining Division. Referring to the fact that a patent subject to invalidity proceedings in Turkey may be revoked or amended before the EPO, and this will be directly binding on a European patent validated in Turkey, the Turkish IP courts are often asked to delay the invalidation proceedings until completion of the opposition. However, as the law makes no explicit provision for this, the delay is at the discretion of the IP courts.

As the draft law does not cover European patents validated in Turkey for which the post-grant opposition is conducted before the EPO; it is still possible for an invalidation action to take place at the same time as a post-grant opposition for a European patent.

One key feature of the post-grant opposition system has not been included in the draft law. Like the existing decree-law, the draft law prohibits any amendment or limitation of the patent after the conclusion of the patent office proceedings. In other words, a patent can be amended or limited only during examination or opposition procedures before the patent office. This provision explicitly precludes the possibility of amending or limiting a patent during invalidity proceedings. As well as being inconsistent with Article 138/(3) of the European Patent Convention and creating bifurcation between European patents validated in Turkey and national filings, this provision makes the post-grant opposition system useless, or at least vulnerable to being used in bad faith.

However, it is inevitable that third parties will prefer to challenge the patent via an invalidation action, where the patent holder will have no right to amend or limit the patent, rather than via an opposition, where the patent holder may be able to maintain its patent through amendments or

limitations. Further, third parties may use this situation as a pre-invalidation action strategy to force the patent holder to limit or amend the claims to a certain scope and then to file an invalidation action.

Without enabling the patent holder to file amendments or limitations during the life of the patent, or at least on invalidation actions against the patent, the post-grant opposition system cannot achieve its aims, and may end up being used as a part of a strategy against a patent holder.

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