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The European Patent Convention (EPC) is part of Turkish domestic law and is enforced in Turkey under Article 90 of the Constitution. As an international agreement, it cannot be declared unconstitutional.

The EPC can be applied directly in Turkey and is legally binding. Under it, Turkey recognises the competence and decisions of institutions established under the EPC. Member states cannot declare their preference for decisions of European Patent Office (EPO) bodies (eg, the EPO Examination Division or Appeal Board). In a major Turkish IP case an IP court held that EPO decisions are binding in Turkey only if the decision can be grounded in an explicit provision of the EPC.

Interpreting the EPC

However, in some cases the IP courts interpret the EPC in a way that renders it ineffective. For example, in an invalidation action against a European patent, the IP court in question did not examine the patentability requirements. While it held that the patent was null and void as the first independent claim was a second medical use claim, the patent was granted before the EPC 2000 revisions (ie, before Articles 54/4 and 54/5 on second medical use claims were introduced in the EPC).

As Turkey is a party to the EPC, European patents granted by the EPO Examination Division enter into the national phase before the Turkish Patent Institute (TPI). Further, with regard to filing the Turkish translation of the *Official Bulletin* entry, the European patent is granted by the TPI as a final granted national patent.

However, a European patent validated and granted in Turkey via this route falls somewhere between the EPC and Turkish national law, due to the differences between two systems. Unfortunately, the IP courts' interpretation cannot be used to solidify the position of a European patent. The main reason for this is that Turkish patent law introduces a pre-grant opposition system, and therefore does not allow the patent to be amended after grant (with

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the exception of material mistakes made in the patent). In contrast, the opposition procedure starts after grant by the EPO and the applicant can amend or limit the European patent during this period.

As an international agreement, the EPC is applied with priority in Turkey, and therefore a European patent can be amended or limited due to amendments made before the EPO. This does not apply to national applications. This conflict in the system is mostly apparent in invalidation actions filed against European patents validated in Turkey.

According to Turkish law, only a granted patent can be subject to an invalidation action. With this provision the legislature has avoided the effects of a pre-grant opposition system and the possibility of amending the patent up until a final decision has been made. This would result in uncertainty in the scope of protection in the case of a court action.

On the other hand, European patents granted in Turkey after the EPO's first grant decision are immediately subject to invalidation actions. This is because although EPO first grant decisions appear to be final, the final scope of protection is not determined until ongoing opposition or appeal proceedings have been concluded.

In this type of action the European patent holder refers to the ongoing EPO procedure and requests a delay for invalidation proceedings. However, in most cases this request is rejected without considering what will happen if the patent is maintained in amended form by the EPO after a national court orders the invalidation of the Turkish grant. The patent maintained by the EPO is entitled to be revalidated in Turkey, making redundant the IP court suit based on the earlier version of the patent. The same applies if the patent is revoked by the EPO before the national invalidation action has been concluded.

In a similar case where a European patent was prematurely subjected to an invalidation action, the Supreme Court overruled the first-instance decision on the grounds that the first-instance court should have asked the TPI whether a European patent subject to an invalidity action in Turkey should be deemed to be in the application stage or to have granted status if the procedure before the EPO is still ongoing during the action.

The first-instance court has not yet issued a decision on this matter; however, it was discussed at an international conference by a highly experienced IP court judge. In answer to the question of whether judges should consult the TPI on this issue, as per the Supreme Court decision, the judge stated that judges can rule on this issue for themselves, and moreover that European patents under an EPO proceeding should not be subject to invalidity actions. In other words, such actions should not take place until the EPO proceeding has been concluded.

However, the same judge stated that the decision to await the conclusion of the EPO proceedings may prove problematic due to the lengthy opposition and appeal processes, which can take four to six years. He also commented on the balance provided by the German system in such cases. As Turkey does not have a bifurcated system, unlike Germany, delaying the invalidation action may give the patent holder an unfair advantage, since the same patent can be enforced against third parties following final grant.

Although there may be timing issues in applying the EPO decision or delaying a national decision, the IP courts and the Supreme Court both hold that the EPO should make decisions on European patents, and that EPO decisions are binding on Turkey.

One notable IP court decision related to the legitimacy of European patents granted under Enlarged Board of Appeal case law. The court held that Turkey was bound only under the EPC, and not by Enlarged Board of Appeal decisions. Enlarged Board of Appeal decisions are binding on the Board of Appeal and on the department, Provided that the facts on which the decisions are based are the same, a dissenting decision may be issued only on new grounds. Therefore, it could not be said that the EPO's decision to grant a patent in line with Enlarged Board of Appeal case law lacked legal basis, and therefore the patent in question was null and void.

Comment

Although there are discrepancies in the interpretation of the power of the EPC by different IP courts, thanks to the Supreme Court's ruling the EPC still maintains its supranational position and sway over national law.

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