

International report - Square pegs in round holes: invalidation actions against unexamined patents

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The Turkish patent regime has a pre-grant opposition system and recognises two types of patent: unexamined patents and examined patents. Unexamined patents are granted without a substantive examination and are protected for seven years, while examined patents are granted only after passing the substantive examination and are protected for 20 years. Unexamined patents can also be converted into examined patents if a request for examination is made during the seven-year protection period.

In a recent invalidation action against an unexamined patent, the owner of the unexamined patent filed a conversion request with the Turkish Patent Institute (TPI) while an invalidation action was pending against its patent. To date, the courts have not considered the issue of the legal status of a converted patent. However, the courts must evaluate the legal status of an unexamined patent for which an application for conversion has been filed. Is such patent a granted patent or a pending patent application? Can an invalidation action be filed against an unexamined patent while conversion to an examined patent is pending?

The Patent Decree-Law does not state that an examination request converts an unexamined patent into an examined patent application. Nonetheless, based on the wording of the relevant sections, it is arguable that an unexamined patent can no longer be treated as a granted patent following the conversion request, but should rather be regarded as a pending application for an examined patent, with all the relevant legal consequences.

Article 60(9) reads:

"The provisions of Article 62 pertaining to granting of patent with (substantive) examination shall apply where a request for substantive examination is filed within seven years, at the latest, from the date of filing of the application. In order to enable third parties to raise objections as of the patentability requirements, in accordance with the provisions of Article 62,

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paragraph two, the request for substantive examination filed in respect of a patent granted without (substantive) examination shall be published in the related Bulletin.” (Emphasis added.)

Since Article 62 describes the process that an examined patent application goes through, Article 60(9) suggests that an unexamined patent must now be treated as a pending application.

This interpretation is also supported by Article 72(2), which reads:

“The term of a patent granted without (substantive) examination shall be seven years. Where the (substantive) examination request is made within the period of seven years and the patent is granted after such (substantive) examination is conducted, the term of the patent shall be completed to 20 years as of the date of filing the application.” (Emphasis added.)

The owner of an unexamined patent does not lose its rights by filing a conversion request, as the patent application is protected in the same way as a granted patent. However, due to the 'pending application' status of the patent following the conversion request, it should not be possible to file an invalidation action between filing of the conversion request and the issue of the TPI's decision.

However, in the recent case the invalidation action was filed against the unexamined patent and the patent owner filed the conversion request while the invalidation action was pending. Under the law, on conversion the unexamined patent becomes a patent application. As such, it should not be possible to file a new invalidation action against the pending application after conversion. However, if the invalidation action is already being heard before conversion takes place, the court should continue to hear the case. This is because, under general Turkish procedural law, cases should be evaluated according to the conditions present at the date of filing.

The argument is even stronger in cases of bad faith – for example, where the patent owner is about to lose an invalidation action and converts its unexamined patent only to avoid an adverse verdict. Similarly, an invalidation action should not be allowed where the owner of the unexamined patent makes an examination request towards the end of the seven-year protection period in order to extend its monopoly while the converted application is pending. These may be seen as applications of the principle of good faith enshrined in Article 2 of the Civil Code. Therefore, the court should continue to hear an ongoing invalidation action which was filed before the conversion request.

The situation would be clarified by the introduction of a post-grant opposition system and the abolition of unexamined patents. Most jurisdictions do not have unexamined patents, for good reason. In fact, the draft Patent Law proposed to introduce a post-grant opposition system (similar to that before the European Patent Office) and to abolish unexamined patents. However, since the draft

aw was not enacted before the general elections of June 2015, it became null and void. A new bill must now be drafted and reintroduced before the National Assembly; this new bill is likely to contain similar provisions for the abolishment of unexamined patents.

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