

Appeal court rules on status of opposed European patents in Turkey

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The 11th Civil Chamber of the Court of Appeals recently issued a remarkable decision regarding European patents validated in Turkey – specifically, on the status of the validation of a European patent in Turkey where an opposition or appeal is pending before the European Patent Office (EPO).

The Turkish Patent Institute (TPI) operates a pre-grant opposition system and permits no amendments to a patent after the grant decision. The TPI system conflicts with the EPO system, which operates a post-grant opposition system. Consequently, a European patent validated in Turkey is treated as a granted patent right following the EPO's first grant decision, despite any ongoing opposition procedure at the EPO and any amendments following such opposition.

Facts

The conflict before the appeal court stemmed from a decision issued by the 2nd Civil Court of Intellectual and Industrial Rights of Istanbul in an invalidation action against a European patent validated in Turkey. However, EPO opposition proceedings related to that patent were ongoing during the lower-court trial. The patent owner decided to withdraw the patent before the TPI for commercial reasons. Upon the withdrawal of the patent in question, the first-instance court decided that it could not issue a decision in the case as the subject matter had been removed.

The plaintiff appealed the first-instance decision.

Appeal decision

The appeal court questioned the status of the patent subject to the action, pointing to the ongoing opposition procedures before the EPO. Considering that the patent could be subject to EPO amendments and that such amendments would affect Turkish validation of the patent, the court stated that it should be assumed that no granted patent existed in Turkey as patents cannot be amended following grant. The appeal court also emphasised that if the ongoing opposition proceedings before the EPO had been taken into consideration, the lower court should have held that a pending patent application existed. In such case the invalidation action would have been rejected at first sight, as a pending application cannot be subject to an invalidation action.

Therefore, the first-instance court should first have determined whether the TPI took the withdrawal demand of the patent holder to be the withdrawal of the "patent application" in line with Article 66 of the Patent Decree-Law or as the withdrawal of a "granted patent" in line with Article 133 of the decree-law.

Ultimately, the appeal court reversed the decision of the first-instance court on the grounds that the decision was granted as a result of insufficient inspection, in the absence of above-discussed examination and analysis.

Comment

The appeal court's decision is significant as it took a fresh and more appropriate approach to the status of registered European patents before the TPI. As a result, the TPI should consider European patents validated in Turkey to have application status until any opposition or appeal proceedings before the EPO have been completed. This will prevent premature invalidation actions and create an environment that is conducive to the TPI's pre-grant opposition system. However, the patent application will still be protected as the Patent Decree-Law states that a patent application is protected in the same way as a granted patent. Therefore, patent applicants will be able to protect their rights as if they held granted patents.

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