International report - IP Court rejects Court of Appeal view on second medical use claims

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In 2014 the Istanbul IP Court held that second medical use claims granted by the European Patent Office (EPO) under the European Patent Convention 1973 were null and void (for further details please see "IP court finds second medical use claims to be medical treatment methods"). This surprising decision was the first issued by the IP Court and thus was closely followed by various stakeholders, particularly IP lawyers and pharma companies. In particular, Turkish patent law does not state that second medical use claims in Swiss-type claims and granted by the EPO before the European Patent Convention 2000 amendments cannot be patented.

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Court of Appeal decision

On the patent holder's appeal – which was based on strong grounds, including legal and technical analyses – the Court of Appeal overturned the IP Court's decision, indirectly ruling that Swiss-type second medical use claims are patentable. The Court of Appeal acknowledged that explicit provisions on second medical use claims were introduced to the European Patent Convention in the 2000 amendments; however, previously there were no explicit provisions on the non-patentability of second medical use claims. Therefore, the IP Court was wrong to rule on the validity of second medical use claims without deferring to court-appointed experts for a technical examination under the Code of Civil Procedure. The Court of Appeal therefore left it open for the IP Court to decide whether the second medical use claims subject to the action were patentable, after conducting the necessary technical court expert examination.

The Court of Appeal's decision was important as it removed the uncertainty regarding the patentability and enforceability of second medical use claims granted by the EPO and validated in Turkey before the European Patent Convention 2000 amendments. However, the Court of Appeal did not comment on the IP Court's reasoning that Turkey, as a member of European Patent Convention, is bound only by the written provisions of the European Patent Convention, and not by case law of the EPO Enlarged Board of Appeal.

IP Court rejection

Following the Court of Appeal's decision, the IP Court was expected to follow that decision and defer the case to a court-appointed expert panel for the patentability of the second medical use claims to be examined. However, surprisingly, the IP Court insisted on its previous decision and rejected the Court of Appeal's decision.

The IP Court's reasoning for resisting the Court of Appeal's decision was as follows:

- The patent disclosed use of a known drug for the same condition in a more effective way for a different period. It was a second medical use patent and had been granted relying on case law of the EPO Enlarged Board of Appeal, based on the European Patent Convention 1973, which did not allow second medical use patents.
- Decisions of the EPO Boards of Appeal and the Enlarged Board of Appeal were not binding on Turkish courts.
- Although the patent was a second medical use patent, since it related to dosing and posology, the subject matter of the invention was a medical treatment method and the grant of a patent for medical treatment methods is prohibited by Article 52/4 of European Patent Convention; therefore, the patent was invalid.
- According to case law of the Enlarged Board of Appeal, the provision of the European Patent Convention stating that treatment methods cannot be patented can be artificially bypassed. However, the claim format did not change the fact that the claim was a medical treatment method. Despite the mention of preparation of a medicament in the claim in an artificial manner, there was no production of a novel medicament; the medicament was the old medicament and there was no pharmaceutical composition, as claimed in the claim.
- The patent in question was a second medical use patent relating to dosing and posology. Dosing and posology constitute medical treatment methods under the European Patent Convention and the grant of a patent for medical treatment methods is prohibited. Since these patents are prohibited, in actions filed for the revocation of such patents the court cannot examine the patentability criteria (ie, no assessment of novelty, inventiveness and industrial applicability may be conducted). This assessment applies to inventions not prohibited under the European Patent Convention.
- In contrast to the Court of Appeal's decision, there was no need to seek an expert opinion to determine whether the patent was a dosing and posology patent under the category of second medical use patents. From the description it was clear beyond reasonable doubt that the patent was a dosing and posology patent.
- Turkey accepted the European Patent Convention amendment in 2007, which explicitly included an agreement that patents granted in accordance with case law of the EPO Enlarged Board of Appeal would not apply to patents granted before 2007. Therefore, the patent in question was void in accordance with Article 52(4) of the European Patent Convention.

- According to the Vienna Convention on the Law of Treaties, countries may not be forced to acknowledge the validity of patents not included in the initial version of the European Patent Convention 1973.

Next steps

As expected, the patent holder again appealed the IP Court's decision. As this was a second appeal of the IP Court's decision, the case was sent to the General Assembly of Courts of Appeal – the highest board of the Court of Appeal – whose decision will be final and binding.

The general assembly is expected to rule in line with the Court of Appeal, finally answering yes to the question of whether second medical use claims patentable and validly enforceable in Turkey, despite the lack of clear provisions in this regard.

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