

TURKEY

Istanbul IP court rejects PI demand due to pending invalidation action

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One of the two IP courts of Istanbul rejected a crucial precautionary injunction (PI) demand of a patent owner on the ground that the demand requires a full trial due to the pending invalidation action against the relevant patent.

The patent subject of the PI demand is disclosing use of an active pharmaceutical ingredient (API) for the treatment of certain conditions of a disease. As per the summaries of product characteristics (SmPCs) of the defendant's drug, the infringement of the patent was obvious. The main defence of the defendant was the invalidation action filed against the patent slightly before the PI demand. It is understood that the invalidation action was still at the international notification process therefore the patent owner was not aware of the action.

It is known that pending invalidation actions do negatively impact a PI demand depending on the patent, due to the retroactive impact of a possible invalidity decision. However, the court may accept the PI demand considering the unrecoverable damages of the patent owner and therefore grant the PI.

It is the first time that a court has considered the possible retroactive impact of an invalidation action at such an early stage. The IP court ruled that "considering the ongoing invalidation action and the retroactive impact of an invalidity decision, it has been decided that the PI demand requires an action on merits". This seems to be an over implementation of the retroactive effect of a barely pending invalidation action. The first instance decision in this action can be given at the earliest within two years and yet the IP court rejected the PI demand without knowing the result of the invalidation ac-

tion.

The conditions for a PI are set in the law as "proving that the usage which is the subject of the case occurs inside the country and in a way that violates industrial property rights, or proves that serious and effective preparations are being made for the purpose of such a usage." The characteristic of a PI demand is being urgent and necessary to secure the efficiency of the decision on merits to be given in future. Therefore blocking this legal right depending on the probability of an invalidation decision is an over restriction of patent rights.

The court also determined that the defendant's drug was granted marketing authorisation but the defendant had not applied for the reimbursement list of the Social Security Institute. Upon this finding the court also evaluated the implementation of the so-called Bolar exemption and stated that all acts until launch of the drug should be exempted from the patent rights. However, at the ruling part of its decision the court did not rely on the Bolar exemption but rather on the pending invalidation action and asserted that the PI demand requires a full trial. The District Court's appeal evaluation on the decision of the IP court is awaited with curiosity.