

International report - IP Court applies European Patent Convention in national invalidity proceedings

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The general practice of the Turkish IP Court is to continue with invalidation proceedings brought against the Turkish validation of a European patent even where the patent is still under opposition or appeal before the European Patent Office (EPO).

Although it is obvious why it may not be effective for a local court to evaluate the validity of the patent before the EPO has issued its final decision, the Turkish IP Court has based this practice on the length of EPO proceedings and the legal status of the validated patent in Turkey. However, it is unclear what the approach of the Turkish Patent Institute (TPI) will be if the national validation of a European patent is invalidated by the Turkish IP Court but later maintained in amended form by the EPO.

In principle, the patent maintained with amendments should be revalidated before the TPI; however, there is no precedent for such case. Will the revalidation be registered with the same national patent number, and how will the TPI deal with it given that the local court has held the patent to be invalid? Will a different patent number be given to the national validation after the EPO first grant decision and after opposition or appeal proceedings, or will the TPI conduct a special examination on the revalidation of the European patent so as not to breach the court's decision and to evaluate whether the IP Court's invalidity decision also influences the amended patent?

These issues may have been the grounds for Article 138/3 of the European Patent Convention, which states that in proceedings before the competent court or authority relating to the validity of the European patent, the patent owner shall have the right to limit

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the patent by amending the claims. The patent as limited shall form the basis for the proceedings.

However, if the patent holder is given the opportunity to limit the national validation of the European patent during the local invalidity proceedings, this complicated situation may be avoided.

Recent decision

In a recent invalidation action against the national validation of a European patent, the patent holder asked the IP Court to delay the proceedings due to ongoing EPO proceedings. Rather surprisingly, the IP Court granted this request referring to Article 138/(3) of the European Patent Convention. Accordingly, the IP Court interpreted the patent holder's right to limit the patent during national invalidity proceedings as grounds for delaying the national proceedings until the EPO's final decision.

Comment

The decision is remarkable as it is the first time that a national court has applied Article 138/(3) of the European Patent Convention. However, the decision was not a literal application of Article 138/(3), but rather an interpretation of it in order to delay national proceedings until the EPO's final decision. Although there was no reasoned decision, the court appeared to interpret Article 138/(3) as intending to prevent the evaluation of different scopes of protection for the same European patent by the national courts and the EPO.

But what if the IP Court had applied Article 138/(3) literally rather than interpreting it? In that case the patent holder would have had the right to limit the claims of the national patent and the invalidation proceedings would depend on this new set of claims. This would then have raised issues around how the national court would deal with Article 64 of the Patent Decree-Law, which prohibits the amendment or limitation of claims after the grant decision. This leads to major questions regarding whether the national court would ignore Article 64 of the Patent Decree-Law as it appears to conflict with the European Patent Convention, which is an international treaty with effect in Turkey. As Turkish constitutional law provides that in cases of conflict with national law, international treaties should prevail, the situation seems clear in case of conflict between national and international law. However, in this recent case it appears that the IP Court intentionally refrained from exposing this conflict, as such decision would have affected many other terms of national patent law which are also in conflict with the convention. This may have been another reason why the IP Court did not apply Article 138/(3) directly, but rather interpreted it in a way to delay national proceedings until the EPO's final decision.

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