

**28th February, 2018**

**Roundtable Meeting Report on "invalidation of an EP by the national court while the opposition procedures continue before the EPO"**

FICPI-Turkey held its first roundtable meeting on the possibility of protecting a validated European Patent in Turkey (after being limited or amended by the EPO during the opposition process) where the EP case is invalidated by the national court prior to the conclusion of the opposition.

The Board of Directors of FICPI-Turkey chose the above subject as the topic for the opening roundtable meeting in order to canvas fair solutions to the problem, in line with the legislation and its implementation, considering that there can be a loss of rights for patent owners in cases where the courts do not suspend an action pending the conclusion of an opposition before the EPO.

Ms. Selin Sinem Erciyas, Vice President of FICPI-Turkey, moderated the meeting. There were 28 participants, including FICPI-Turkey members. Following an opening speech by Mr. Uğur Aktekin, President of FICPI-Turkey, Ms. Erciyas began the discussion by providing a brief introduction on the subject and bringing into question the fairness of invalidation of an EP by the national court while EPO opposition procedures are under way. It was noted that unfairness could arise if the EP were to be amended during opposition such that it was no longer identical to the EP being challenged in the court system. Ms. Erciyas also noted that the duration of the opposition procedures before the EPO makes it difficult for courts to suspend actions for extensive periods of time.

Ms. Selda Arkan, a Member of the Board of FICPI-Turkey and a European Patent Attorney, suggested that one option would be to officially inform the EPO of the court action as a means for potentially accelerating the opposition. Without some form of action, should the court arrive at an invalidation decision it will not be possible to revalidate the patent if the EP patent eventually is amended during opposition. Participants provided examples of situations in other countries where courts suspend actions under such circumstances.

Mr. Aydın Mutlu, a member of FICPI-Turkey and a European Patent Attorney, raised Article 138(3) EPC and suggested that the Turkish courts could allow an amendment of the claims during the court action for securing fairness. This then raised the question of whether the courts are capable of evaluating whether an amendment of the claims of a patent is made correctly, and how many times an applicant should be allowed to make such amendments.

There were also discussions regarding possible solutions within the Turkish Patent and Trademark Office, namely whether it would be possible to provide a new patent number to the amended EP and to thereby provide protection as a new patent. Most participants were of the view that under such a situation an invalidation decision would still have an effect on the amended claims.

Finally, there was a discussion as to whether it might be a solution to obtain a technical opinion from the EPO concerning the EP, which is the subject of the invalidation action, as per Article 25 of the EPC. It was concluded that this option might be worth considering in a future case.

Having achieved its goal with the holding of its first roundtable meeting, FICPI-Turkey will continue arranging roundtable meetings on various subjects in an effort to provide high-quality discussion platforms for patent and trademark attorneys, and to increase the profile of the section.