

Turkey

Turkey: Turkish court deals with indirect infringement case

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Indirect infringement is not explicitly dealt with in the Turkish IP Law. However, the legislator confers, via Article 86 of the Industrial Property Code (IPC), a right to the patent holder to prevent third parties from supplying essential elements of the invention to unauthorised people, which will eventually lead to the working of the patented invention. In order for this provision to be implemented, third parties must be aware that these elements or instruments are sufficient to work the invention, and should be aware that they will be used for this purpose, or this situation should be clear enough.

In a recent case, a generic company filed a determination of non-infringement (DNI) action against an originator company. The originator company responded asking for implementation of Article 86 of the IPC. The patent which was the subject of the DNI case was related to a second medical use claim, disclosing use of certain indications. The generic company carved out its summary of product characteristics (SmPC) and patient information leaflet (PIL) documents after the DNI action was filed in order to circumvent patent infringement.

The generic company asserted that all elements protected by the patent were taken into account while formulating the generic product, and it did not infringe the patent. The originator company asserted that even though certain indications were carved out from the SmPC and PIL of the generic product, it still infringed the patent as the formulation and the expected impact of the product are still the same.

The court appointed an expert panel which confirmed that carving out certain indications from the SmPc and PIL does not cause any difference to the technical impact of the product. Therefore the panel concluded that the so-called changes made to circumvent patent infringement “do not create substantial changes” and in this respect, implementation of Article 86 may be taken into consideration. However, as it is a legal matter, it is at the discretion of the court.

The court did not accept that the generic company infringed the patent literally or indirectly using the patented invention as per Article 86, and decided there was no infringement of the patent.

The reasoned judgment of the court is awaited, and the parties are entitled to appeal the decision before the district court. This case will be the first example of interpretation of Article 86 for second medical use claims in Turkish practice.

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